

Technology Transfer at NCSU – kickin’ it up a notch!

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What does the Office of Technology Transfer do?

Manage the intellectual property developed at NCSU

Intellectual property includes:

patentable inventions
plant varieties
biological materials
other unique materials
copyrights
trademarks, service marks
know-how
software
other innovations

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What does it mean to “manage” intellectual property?

- Prevent early or unintended public disclosure (potential loss of rights)
- Protect by patenting, copyright/trademark registration (if needed)
- Facilitate confidential discussions with potential collaborators, sponsors
- Make the innovation available to the public
 - encourage publication
 - develop sponsored research relationship
 - formalize collaborations
 - license to an established company or start-up
- Negotiate agreements with collaborators, companies
 - material transfer
 - confidentiality
 - collaborative research, inter-institutional
 - licenses

Why Does NCSU Engage in Technology Transfer?

To Grow the Research and Education Enterprise!

Successful Technology Transfer:

- raises the visibility of University research, facilities, and expertise
- creates new funding opportunities
 - SBIR, industry, multi-disciplinary, collaborative
- helps recruit and retain employees and students
 - financial incentive to invent
- benefits the public and stimulates economic development
 - new products, new companies, new jobs

How can I get involved in technology transfer?

Identify your innovative and useful ideas, developments, or tools

Disclose them to the Office of Technology Transfer (OTT)

Forms are at www.ncsu.edu/ott

Inventions, copyrights, software, plant varieties, materials, marks

What the University does:

Intellectual Property Committee or Copyright Committee reviews

Case manager assigned in OTT

Work with the inventors/creators to identify best way to “transfer” the innovation

NCSU Policies and Procedures

Who Owns This Invention?

NCSU owns all inventions of University personnel and students that are made as a part of or as a result of: a) University research; b) activities within the scope of the inventor's employment by, or in official association with, the University; and c) activities involving the use of University time, facilities, staff, materials, University information not available to the public, or funds administered by the University.

Note: Joint Ownership is not a problem, but our policy is that ownership follows inventorship, and inventorship is determined by U.S. Patent Law.

Inventions developed while someone is employed by NCSU or is a student at NCSU must be disclosed, even if the inventor believes NCSU does not own the invention.

The Intellectual Property Committee determines ownership.

Disclosure does not mean the University will own the invention.

Why Does the Source of Funding Matter?

Government Compliance

If an invention is made with the use of federal funds, the invention **MUST** be reported to the funding agency -

- *EVEN IF THE INVENTION MADE FALLS OUTSIDE OF THE RESEARCH PLAN*

Compliance with Industry Sponsored Research Agreements and Contracts

Industry sponsors are often granted the first option to obtain rights in the technology. Inventions must be reported to the sponsor

- *AVOID MINGLING FUNDS FROM MORE THAN ONE COMPANY*
- *AVOID PAYING STUDENTS, STAFF FROM MORE THAN ONE INDUSTRY SOURCE*
- *IF THE RESEARCH PLAN CHANGES, HAVE THE AGREEMENT MODIFIED*

What About Consulting with Companies?

At NCSU, faculty members can consult and perform other external activities for pay BUT:

- They must complete conflict of interest forms and propose a method for handling any potential conflicts of interest.
- Conflict of interest forms and management of potential conflicts must be reviewed and approved by department head and dean of the college.
- University facilities and resources may not be used in consulting or other external activities (unless available to the general public).
- No external activity may conflict or interfere with the timely and effective performance of the professor's primary University duties.
- The consulting agreement **MUST NOT** conflict or interfere with the employment obligations of the researcher and/or with the policies and procedures of the University.

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If I make an invention, will I still be able to publish? (Are patenting and publishing mutually exclusive?)

Publish or perish – At NCSU, under no circumstances will researchers be prevented from publishing the results of their research nor will students be delayed in receiving their degrees.

- Universities (especially public universities) do not have trade secrets
- Research results must ultimately benefit and be made available to the public
- Researchers must publish to advance their career (employment, tenure, and promotion)
- Researchers must publish to be able to obtain funding
- Students must publish their theses to graduate

However:

- Publications can be delayed to provide for the preparation and filing of patent applications
- Publications can be subject to review (but not approval) by a sponsor or licensee
- Confidential information belonging to a sponsor or licensee will be deleted upon request

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What is a Public Disclosure?

Public disclosures may include:

- posters
- abstracts
- funded grants
- grant applications
- manuscripts
- theses
- research reports to funding agencies
- seminars
- press releases
- interviews

A disclosure happens as soon as something is:

- presented
- put into print and made available
- posted “on line” (on the web)

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How does a Public Disclosure affect Patent Rights?

In all countries other than the United States, once something is publicly disclosed, it cannot be patented – absolute novelty is required

In the United States, there is a one year “grace period” after public disclosure for a patent application to be filed

How can the need to publish be balanced with protecting patent rights?

Contact the Office of Technology Transfer early and often!
Protect “patentable” information under confidentiality agreements
Facilitate collaborations without loss of patent rights
Manage the timing of patenting vs. publishing

Providing OTT with too much information is better than too little

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Can I sign this Agreement Myself?

Signature authority

At NCSU, the Chancellor delegates signature authority for the University to certain administrative positions.

NCSU does not recognize contracts signed by University employees as binding on the University unless the employee who signed the contract has duly delegated signature authority.

Employees who sign contracts purporting to bind NCSU without authority properly delegated may be personally subject to legal action by the contractor, and may be subject to University disciplinary action.

http://www.ncsu.edu/policies/governance_admin/delegation_authority/deleg_signature_authority-contracts.php

http://www.ncsu.edu/policies/governance_admin/delegation_authority/REG01.20.2.php

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What's New in Tech Transfer?

Innovator's checklist as part of Invention Disclosure Form

Lists information required

Defines terms such as "public disclosure"

Designed to help Inventors, Dept. Heads, Deans

"Quality Control" for Invention Disclosures

Annual Reports to Colleges on Invention Disclosures, Patents, Licenses, and Start-ups

Commercialization of Copyrightable Works

Trademarks, Service Marks, Logos (in collaboration with Trademark Licensing Office)

Full-time Service Agreement Negotiator

4 FTEs working on Compliance

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There's value in working with Tech Transfer!

20 years of licensing and commercialization experience

Network of industry contacts, venture capitalists, attorneys, resources on and off campus

Advice on consulting agreements, other interactions with companies

Manage the timing of patenting vs. publishing and protecting patent rights

Copyright protection, software protection, commercializing educational works

Help with grant-writing (intellectual property language)

Presentations for colleges, departments, and guest lectures in the classroom on request

Mentoring for new Innovators – call anytime (even if you haven't invented yet)!

Thank You for the Invitation to Speak!

Break Service



- 10:35 - 10:50
 - That's 15 minutes
- Refreshments are in
 - Dining Room
- No Food, Drink or even Water is to leave the Dining Room