



Intellectual Property & Technology Transfer



Government | University | Industry
RESEARCH ROUNDTABLE

COGR
Council On Governmental Relations

**Health
Research
Alliance**
Working together to optimize investment in health research and training.



FasterCures
A CENTER OF THE MILKEN INSTITUTE

Welcome to the Sub-group on IP and Tech Transfer

We are delighted you have joined us!

Fred Reinhart

University of Massachusetts

Robert Hardy

Council on Governmental Relations

Amy Laster

Foundation Fighting Blindness

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HHMI

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Georgia Institute of Technology

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IP and Technology Transfer is one of the central themes in the research funder-performer relationship.

From the Pre-meeting Survey Results we know that the major challenges regarding IP policy are a key concern for both funders and performers.



Recognizing the Common Purpose The IP and Tech Transfer Sub—group Was Formed.

Finding Cures



Meeting
National &
Global
Challenges



Stewardship of
Resources for
Research



Making the
World a Better
Place



Purpose and Goals

Intellectual Property and Technology Transfer Sub-group

.....explore enhancing and improving research engagements and collaborations between research-funding foundations and research-performing institutions.

.....focus on developing common understandings, identifying opportunities to streamline processes, examining policies and costs, and exploring ways to foster effective technology transfer.



Purpose and Goals

Intellectual Property and Technology Transfer Sub-group

Goals:

- Identify agreed-upon principles that underlie the parties' mutual interests.
- Identify areas of divergence in needs, policy, and practice between funders and research performers.
- Examine best practices and examples of innovative relationships.
- Endeavor to identify approaches that respect the constraints and missions of both parties while achieving the common goals.



The IP and Technology Transfer Survey

Now that we know intellectual property terms are a concern for both research funders and researcher performing entities, what specifically are the issues that are most significant?

What topics or issues are problematic?

What are your constraints?

What topics or issues are usually not a concern or easy to resolve?

What delays or prevents coming to agreement?

For a range of provisions typically found in research agreements, which are:

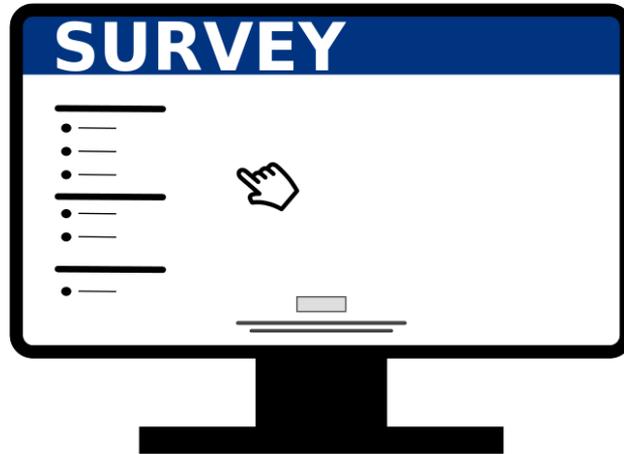


- ✓ Rarely the topic of negotiations; the parties generally agree
- ✓ Sometimes the topic of negotiations; the parties are generally able to come to agreement easily
- ✓ Sometimes or frequently the topic of negotiations; the parties often have difficulty coming to agreement



Respondents

40
responses



Entities:
27.5% funding
72.5% performing



Key Findings: Group 1

3 issues were considered “rarely” an issue by more than 58% of respondents and were seen as “sometimes or frequently” a difficult topic by less than 11%:

- Disclosure requirements (e.g., disclosing inventions to the sponsor)
- Conflicts of interest
- Disposition / Abandonment of patent protection



Key Findings: Group 1

≥58% Chose Rarely a Difficult Topic
≤10% Identified as Sometimes or Frequently a Difficult Topic

64.1% ●	10.3% ●	Conflicts of Interest
56.4% ●	10.3% ●	Disclosure Requirements
55.3% ●	5.3% ●	Disposition/Abandonment of patent protection

● Rarely the topic of negotiations; the parties generally agree

● Sometimes or frequently the topic of negotiations; the parties often have difficulty coming to agreement



Key Findings: Group 2

≥40% Chose Sometimes a Topic/Generally Able to Agree
<16% Identified as Sometimes or Frequently a Difficult Topic

60.5% ●	7.9% ●	Patent decisions and patent costs; Costs for protection of IP
60.5% ●	15.8% ●	Ownership/disposition of other research results
57.9% ●	13.2% ●	Publication Rights
56.4% ●	12.8% ●	Sharing of research materials
52.6% ●	15.8% ●	Research use of IP by funder or performer
48.7% ●	15.4% ●	Ownership of new IP

● Sometimes the topic of negotiations; the parties are generally able to come to agreement easily

● Sometimes or frequently the topic of negotiations; the parties often have difficulty coming to agreement



Key Findings: Group 3

≥40% Chose Sometimes a Topic/Generally Able to Agree
≥16% Identified as Sometimes or Frequently a Difficult Topic

63.2% ●	18.4% ●	Control of Licensing
53.8% ●	25.6% ●	Scope of definition of IP
45.9% ●	18.9% ●	Access to background IP
43.2% ●	16.2% ●	Disclosure of licensing efforts
41.0% ●	17.9% ●	Joint ownership of IP absent joint inventorship

● Sometimes the topic of negotiations; the parties are generally able to come to agreement easily

● Sometimes or frequently the topic of negotiations; the parties often have difficulty coming to agreement



Key Findings: Group 3

To borrow from UIDP, “Moderately Contentious”

More than 40% find these sometimes the topic of negotiation and a number of characterize them as difficult to resolve.

Publication Rights

(right of performers to publish research results; Right of funders to review publication for potentially patentable subject matter)

Access to background IP

Joint ownership of IP
absent joint inventorship

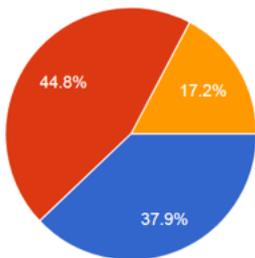
Ownership & disposition of
other research results



Joint ownership of IP absent joint inventorship

17.2%

- Sometimes or frequently the topic of negotiations; the parties often have difficulty coming to agreement

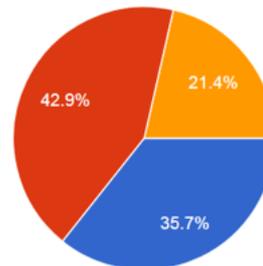


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Access to background IP

21.4%

- Sometimes or frequently the topic of negotiations; the parties often have difficulty coming to agreement



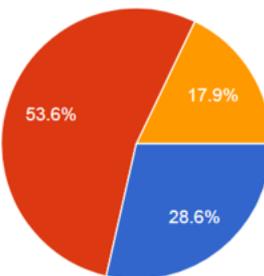
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Publication Rights

(right of performers to publish research results; Right of funders to review publication for potentially patentable subject matter)

17.9%

- Sometimes or frequently the topic of negotiations; the parties often have difficulty coming to agreement



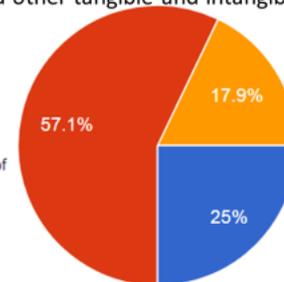
- Rarely the topic of negotiations; the parties generally agree
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Ownership & disposition of other research results

(e.g., data, prototypes, and other tangible and intangible research results)

17.9%

- Sometimes or frequently the topic of negotiations; the parties often have difficulty coming to agreement



- Rarely the topic of negotiations; the parties generally agree
- Sometimes the topic of negotiations; the parties are generally able to come to agreement easily
- Sometimes or frequently the topic of negotiations; the parties often have difficulty coming to agreement

Group 3 Details

Key Findings: Group 4

Two items in the survey were identified as sometimes or frequently the topic of more intense negotiation:

- Provisions for patient access
- Royalty sharing, distribution, and use for research



Rarely; Generally Agree	Sometimes; Generally Able to Agree	Sometimes or Often; May be Difficult	<ul style="list-style-type: none"> ● Rarely the topic of negotiations; the parties generally agree ● Sometimes the topic of negotiations; the parties are generally able to come to agreement easily ● Sometimes or frequently the topic of negotiations; the parties often have difficulty coming to agreement
33.3% ●	40.7% ●	25.9% ●	Patient access to resulting drugs, devices, diagnostics and cures including requirements to flow license terms to licensees that require: (1) reasonable effort to assure patient access, (2) reasonable efforts to establish patient assistance program, (3) mechanism to assure patient access.
10.3% ●	41.4% ●	48.3% ●	Royalty issues / sharing / distribution; Use of royalties for future research



These findings are consistent with those of the larger group pre-meeting survey which found:

Non-Profit Funders

Objectives:

- Strengthen rights to royalties/equity
- Maximizing the impact; make sure treatments reach people

Uncertainty in negotiations:

- What is reasonable to ask for?
- Recoup our investment?
- Negotiate case-by-case?

Restrictions:

- Board mandates for IP treatment

Research Performers

- IP may come from mixed funding
- "March-in" complicates licensing
- State laws create challenges
- Non-profit funders are representing for-profits, where the for-profit terms are restrictive on IP policy and provide lower IDC.
- Willingness to find "middle ground"
- Impact of NERF on marketability
- Overreach on return on investment
- Compliance difficulty?
- Do requirements compromise mission?



This is not the first time or only group considering these issues.

Cultivating, Negotiating, and
Managing Research Agreements with
Philanthropic Organizations

Kathy Ku, Stanford University

<http://techtransfercentral.com/marketplace/distance-learning/managing-research-agreements-with-philanthropic-organizations/>



Discussion for Today

- Are the results of the survey generally valid?
- Are there other considerations that should be added?
- Priority of issues to address.
- For Group 3, is it possible to identify model clauses and provisions?
 - Would it be useful for Group 1 & 2?
- Can we identify the principles and perspectives of each party for Group 4 issues?



Next Steps?

