

Functions of the Technology Transfer Office

Purpose of the Technology Transfer Office

The mission of the Technology Transfer Office (TTO) is to facilitate and enhance the transfer of intellectual property (IP), resources and information between San Diego State University and the business community in an effort to continue to develop our IP and enable it to increase the quality of life in all of the communities that we participate including the academic, commercial, and social communities. The TTO was established to serve the IP needs of the faculty and the University. The TTO helps foster research partnerships with the business sector and other collaborators when IP is likely to be created. Visit the TTO website at www.tto.sdsu.edu/ for additional information about the Office and samples of the documents described below for download.

Management of Intellectual Property

The TTO works with the administration and faculty to provide counsel and management of creative works for the University. In this capacity the TTO helps to identify, assess, protect and develop IP with commercial potential; further, the TTO performs market research, markets, licenses and manages revenues from licensed IP for the University. Protection of IP begins with a document trail, including the following:

Documents

Confidential Disclosure Agreement (CDA):

This document is used when someone (e.g. a faculty member) is providing an enabling description of their technology or disclosing other proprietary or confidential information to another person or group. A CDA formally maintains the disclosure as a confidential matter rather than a public disclosure; you cannot patent an idea that has been disclosed to the public. Further, a CDA prevents the recipient from using the disclosed information for their own gain.

Materials Transfer Agreement (MTA):

When research materials (usually biological materials like cell lines, vectors, antibodies, etc.) or other proprietary materials are transferred from one laboratory or institution to another, it should be done after an MTA is executed. An MTA stipulates what material is being transferred, how it can be used by the recipient and provides liability and intellectual property rights protection for the sender.

Invention/Copyright Disclosure:

An invention or copyright disclosure is the official University form used for informing the University administration about the nature of the creativity and details of IP that has been created by a University employee. The disclosure initiates a series of events that lead to the patent or copyright protection of the work.

Assignment of Invention/Author Work:

After the Copyright & Patent Committee has reviewed and approved a disclosure as appropriate for commercialization, it is necessary for the author/inventor to assign the ownership to the University/Foundation so the TTO can devote time and effort on patent/copyright protection, marketing research and licensing the work to an outside company.

Collaborative Sponsored Research Agreement (CSRA):

Companies sponsor research programs in universities to further research and development (R&D) of programs of commercial interest. Furthermore, many academic creations require additional R&D activity to advance them to a stage that is appropriate for commercialization. The TTO draft CSRA provides an example of the usual terms and conditions of a sponsored program agreement with appropriate clauses for protecting the IP and creative works which are derived from the R&D effort.

New Business Venture Guidelines:

Some new technologies are best commercialized by starting a new business which may be owned by the faculty member. Since most faculty do not have experience with such business activities and there are many documents that need to be created to establish the relationship between the University and the new business, we provide some guidelines for starting a new business.

Other Functions of the TTO

Technology Assessment:

Some technology or other creative works of University employees have commercial potential and others do not. The first step in the technology transfer process is assessing the creative work for commercial potential. The TTO assesses the technologies for patentability, market size, general marketability and potential licensees. It is not practical for the TTO to invest time and money into works that have limited commercial potential. With the approval of the University Copyright & Patent Committee, these works are then returned to the author or inventor.

Market Research and Marketing:

After assignment of the technology, the TTO does a more comprehensive and thorough market research analysis of the commercial viability of the technology/authored work. Potential licensees and their capabilities and market characteristics are identified.

Negotiate and License IP:

As soon as a licensee is identified and qualified, the TTO initiates discussions to define the terms and conditions of a license agreement, based on our market research data. An agreement is drafted and negotiated until there is agreement on the language and details of the document.

License Revenue Management:

The TTO tracks expenses and income on all technologies and authored works. License fees and royalty payments are collected by the TTO and distributed to inventors/authors and to the colleges and other recipients of the revenues. University policy specifies that the author/inventor gets 50% of this revenue.

Other Activities of the TTO

Business and Technology Liaison:

The TTO is the Adoor@ through which certain technologies and resources move in and out of the University to the business sector. It provides a linkage with local, regional, state and national agencies and professional associations to acquire and maintain information relevant to technology transfer and commercialization activities.

Faculty Education and Development:

When the faculty is informed about IP management and commercialization, the identification of technology, its effective protection and licensing work most efficiently. Thus, an important role of the Office is faculty education. The TTO provides workshops to faculty, staff and students regarding technology transfer, patent and copyright issues, topics related to patenting, licensing, starting new businesses, financing new businesses and research,

and new technologies from SDSU. In addition, there are technology transfer related texts, presentations, and other information available in the TTO reference library. Faculty members are encouraged to visit the TTO to ask questions and seek information on technology transfer issues of their interest.

Community Education and Outreach:

In conjunction with some of the faculty education activities, the TTO brings in individuals from the business community to participate and network with faculty and the University in an effort to build cooperation and collaboration between the academic and business communities.

For more information:

Visit the Technology Transfer Office website:

www.tto.sdsu.edu/.

Information on patents can be found in the SDSU 2004

University Policy File document located at website:

http://senate.sdsu.edu/policy/policy_file.pdf.

Contact:

Michael Rondelli, Program Manager
Technology Transfer Office
San Diego State University Research Foundation
5250 Campanile Drive
San Diego, CA 92182-1998
Telephone: (619) 594-3336 FAX: (619) 594-5774
email: tto@foundation.sdsu.edu



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Background **Intellectual Property**

University faculty, staff and students have creative ideas that are translated into tangible creations such as inventions, authored works, computer programs, and digital media; collectively these creations are referred to as intellectual property (IP). Creation of IP is the natural consequence of creative people working within universities and other institutions of higher education. One of the mandates of universities is to serve the public. Making the tangible creations from the university available to the public is one way to address this mandate. For example, if a faculty research program discovers a cure for heart disease, it is the obligation of the university to make that discovery available to the medical community for the treatment of patients with heart disease. The process of protecting (patenting), licensing and transferring the technology to a company that will develop, test, market and sell the technology to the medical community is called technology transfer.

History of Technology Transfer

Before 1980, the U.S. government was assigned ownership of all government funded research. The government made it available to any company that wanted to license the technology on a non-exclusive basis so any company could license and sell these technologies. There were very few companies who took advantage of the opportunity to license these technologies - meaning thousands of technologies sat idle and unused. In 1980 the Bayh-Dole act and several subsequent congressional legislations assigned the responsibility for management of intellectual property (patents, copyrights, licensing, etc.) to the universities; it is now the mandate of the university (or its foundation) to manage intellectual property. In 1998, San Diego State University Foundation (SDSUF) opened the Technology Transfer Office (TTO) to develop and manage the IP for the University.