

Topic 24: Managing TTOs

WIPO

Bangkok, Thailand

June 12-16, 2017

Day 5 – 60 min.

Mr. John A. Fraser

President, Burnside Development & Associates, LLC

HOW DO YOU DO TT ?

- You need an academic IP Policy,
- You need an IP structure - the TTO,
- You need people in the TTO,
- You need a TTO budget,
- You need an involved Faculty,
- You need Time,
- You need to recognize how Corporations think.

Organizing the Office:

MISSION Statement

- Mission: Helping the University meet their goals, while helping the Faculty reach their career goals by commercializing Inventions and Works by working with the Private Sector (existing or new companies) to create products and services that Save Lives, Improve the Quality of Live and Increase corporate competitiveness and productivity. Many times, government and private sector financial support is critical at different stages of the process.

Governance

- Most TT Offices in North America report to the VP Research, not the VP Finance.
- Why ? Because experience has shown that this is not a way to make a lot of money, and if ,once a decade somewhere in them world a Massive License payment is made, it is like a Lottery Ticket – all by chance, not planning.
- See the FSU Taxol Story - <http://www.rinr.fsu.edu/fall2002/taxol.html>.

Responsibilities

- Create an Office or activity that is branded / recognized for what it does:
 - Outreach to Faculty, to Companies, to local Community.
 - Create Standard Operating Procedures:
 - obtain disclosures; evaluation; IP protection;
 - market input; create further development plans;
 - with faculty decide strategy: licensing to existing or to a start-up company; approach companies;
 - education discussions;
 - negotiations including research collaborations; closing the deal;
 - tracking the process of each deal; collecting royalties and reports;
 - Communicating results.

Responsibilities

- Outreach
- Personnel
- Budget
- Results
- Compliance to laws/disclosures
- Communications of Results
- Engagement with on-campus Entrepreneurship
- Engagement with the local community

Outreach

- 1st priority: Faculty researchers (and their postdocs and grad students): tell how you can assist them to further their research careers – then tell them again. Offer help with IP terms in commercial research contracts and commercialization grants.
- Group research meetings are best. Special Faculty wide seminars work. Department meetings can work, but are usually very busy.
- Outreach to companies: simply tell them that you can help them find expertise/facilities to help them solve their problems.
- Create a national/regional network of TTOs.
- Offer to help government.

Personnel

- Skill sets – some technical background, some business background, show initiative, can build personal relationships, detail oriented.
- An adult family member that has raised children is qualified to work in a TTO.
- Why?

Budget

- Salaries and Patent costs.
- Salaries are controlled centrally in the U.
- Set up expected performance guidelines with external patent firms. Show FSU doc.
- Track Patent costs by Disclosure so you can recover Patent costs from future Commercialization Revenues.
- Other Items: Professional Association fees; Prototype/GAP Fund; student/postdoc Interns; marketing videos; external evaluations, etc.



THE FLORIDA STATE UNIVERSITY

Intellectual Property Budget Cost Savings Program (aka IP BuC\$ 2015 rev. 12/19/2014)

The FSU Office of Commercialization (OoC) has established procedures for working with patent firms to maximize its intellectual property budget and to ensure invoices are received by FSU and paid within a reasonable timeframe. The guidelines below apply to areas that include, but are not limited to, methods of correspondence, the filing of patent applications, and billing practices.

Correspondence Guidelines

- a) Effective March 2012, the OoC converted to a paperless office. All correspondence related to patent, copyright, and trademark prosecutions are sent electronically to Eric McNair's attention at emcnair@fsu.edu. This is an integral part of our program and is a necessary measure to save money, boost productivity, save space, facilitate the sharing of documentation and information, keep personal information more secure, and help the environment.
- b) Notwithstanding the above, we request that the following types of documents be sent to FSU in hardcopy format:
 - i. Ribbon copies of issued patents;
 - ii. Official amendments to issued patents.
- c) Firms **MUST** include FSU's reference number in either the body or the subject line of all e-mail correspondence.
- d) Any formal documentation required for patent prosecution (i.e., assignments, declarations, powers of attorney, affidavits, etc.) will be returned back to your

Results: COMMUNICATE Progress not Activities

- Achieve and Report progress, not activities. Show results.
 - Show FSU Pipeline doc.
 - Show FSU Office Budget doc.
 - Show FSU Royalties / Related Grants doc.
- Ensure that Faculty can discover progress on their projects easily. (CC on emails, dbase).
- Contribute to, and Use the 'AUTM Better World Project' to tell stories of Impact in other places. Tell your own stories.

FSU Product Pipeline 2005

260 Invention Disclosed; 320 Provisional/Utility Patent Apps; 143 US Patents since FY 1995
75 CDA's completed; 22 Deal Opportunities*

PRODUCT	LICENSEE	APPLICATION	PRE-LICENSE	LICENSED TO CORPORATIONS		
				Product Development	In Market	Terminated
EDUCATION						
Job Skills Education Program (JSEP)	NCS Pearson Publishing	basic job skills army training	████████	████████	████████	
WebPath	FSU	medical pathology	████████	████████	████████	
Fl Center Academic Advisory Servi	State of Florida	high school - university	████████	████████	████████	
Partners for Healthy Baby Books	FSU	early child care	████████	████████	████████	
Womens' Self Esteem Book	FSU	consumers	████████	████████	████████	
Science Tobacco & You	TSI	grade 4 - 8 science education	████████	████████	████████	
MagLab Alpha	Sempco Inc.	grade 4 - 8	████████	████████	████████	████████
Ethics Course	LearnSomething.com	state government	████████	████████	████████	████████
PHARMACEUTICAL						
synthetic-Human Growth Factor	GAP Funding	tissue growth	XXXXXX			
Taxol analogs	Taxolog (S)	cancer	████████	████████		
Metronidazole	SDR Pharma	antibiotic - vs ulcers	████████	████████		
Metronidazole	SDR Pharma	Xray radiosensitizer	████████	████████		
Taxol production method	Bristol-Myers Squibb	cancer	████████	████████	████████	████████

**Florida State University
Office of Commercialization**

FY 2015 Staff Meeting Update

11/5/2014

Tech Transfer Activity	previous year	
	FY 2015	FY 2014
Invention Disclosures	13	57
Work Disclosures	4	4
Patent Applications Filed	30	99
US Patents Issued	9	39
L/O Agreements (Done)	9	25
L/O Agreements (Pending)	14	

Revenue projections (Deals signed only)		
	FY 2015	FY 2014
Royalties (non-Taxol) ¹	\$ 1,121,960	\$ 1,841,136
Grants ²	\$ 345,344	\$ 2,829,989
SBIR/STTR ³		\$ 124,000
Other ⁴	\$ 253,934	\$ 526,472
Subtotal	\$ 1,721,238	\$ 5,321,597

FSU Internal Investments		
	FY 2015	FY 2014
GAP I ⁵	\$ -	\$ 197,000
GAP II ⁶	\$ -	\$ -
Subtotal	\$ -	\$ 197,000

	FY 2015		FY 2014	
	Number	Amount	Number	Amount
STTR/SBIR ⁷ Applications Grants	6	\$ 393,000	4	\$ 124,000
CDA/NDA/PIA Interinstitutional Agreements	15		2	\$ 99,000
MOUs			84	
Jack's Contract Reviews			1	
			1	
			100	

Future License Payments prior to Royalties on Sales

		FY 2014			FY 2015		
Title	Licensee	14 Royalties	14 Grants	14 Other	15 Royalties	15 Grants	15 Other
Assessment 2 Instructions software	Rubicon Partners, LLC	\$ -			25,000		
software	LECO Corporation	\$ -			beta test license		
software	Lexia Learning, Inc.	\$ -					253,934.44
ADHD therepeutic	Avekshan, LLC	\$ -			not a license	345,344	
CDK5RAP2 antibody	Millipore Corporation	\$ 94			\$ 100.00		
ah Cell Stage Identifier Antibodies	Millipore Corporation	\$ 209			\$ 200.00		
Assay and treatment technologies for Hepatitis C virus	BioFront Technologies	\$ 1,139					
Various nut allergens	BioFront Technologies	\$ -					
Human IgE Protein	KeraFAST	\$ 225			\$ 200.00		
Live Tissue Preservation Chamber	KeraFAST	\$ -			\$ -		
Circadian Rhythm antibodies	KeraFAST	\$ -			\$ -		
HGF-1 Protein; Mouse KLK-1 Recombinant	KeraFAST	\$ 203			\$ 200.00		
Human Growth Factor research	Trefoil, E&B	\$ -			15,000		Option fee

Compliance

- Discover and ensure that your TTO operation comply with University or Government reporting and compliance requirements.

Communication of Results

- Tell stories to show impact and acknowledge role of all parties (very useful when there are problems).

Communication of Results - 1

- Hold an internal Faculty Recognition Event (hosted by the President or VC-R) to recognize and thank faculty at all stages of commercialization for their participation.
 - FSU held a social evening event with grad students, etc. involved (and significant others). Hand out scientific prizes and small desktop awards. Pictures with VC-R.

Communication of Results - 2

- FSU had a Community Event to ‘Celebrate Creativity’. Evening affair with the other University and Community college participating.
 - Audience were local business people and city officials interested in how the higher ed. entities could contribute to local economic development and Jobs.
 - Booths and posters and walk-arounds.
 - Covered by TV & papers.
 - Helped break down the isolated Ivory Tower Image.
 - Outside Sponsors covered 50% of costs (Patent Firms).

Communication of Results - 3

- FSU has a Prototype/GAP program with awards up to \$50,000 based on an open competition
- Press Release and follow-up interview/videos of awardees.
- Outside Cttee members were decision makers and a communication vehicle.

Engagement with On-Campus Entrepreneurship

- Work with Business school to help with selected student start-ups.
- Organize Boot Camps
 - 1-faculty/postdocs interested in start-ups;
 - 2-grad student/undergrad start-ups.
- Participate in similar community based activities.

Engagement with the local community

- See above.
- Your President will love the TTO because it is the one place on campus which creates understandable stories of how the University is helping solve real problems.
- Offer to assist with company relocations / expansions in community.
- Offer to have articulate researchers talk about community social clubs (e.g. Rotary).

REMEMBER the Time Frames
Show Oren's Video

REMEMBER

- You are undertaking an Program which has time horizons like the University – years and decades, not months.
- You **MUST** communicate that you are making Progress towards Goals, not simply undertaking Activities (University Goals, Faculty research career Goals, etc.).
- To ensure that you are seen to be contributing to the University long term Goals, you **MUST** gather and communicate – METRICS, STORIES and be involved in the Community (on and off campus).
- Address but do not fixate on cash flows.

SUMMARY

- Help the University achieve its Goals.
- COMMUNICATE in various ways and often.
- COMMUNICATE Progress not just Activities.
- Create Tools to COMMUNICATE.
- Track your Budget expenditures. This is what everyone else looks at. Include this in your COMMUNICATIONS.
- Be seen to be engaged in the on-campus and off-campus Community.

RESOURCES

- ‘Lessons Learned’ Article
- Examples of Talking about Success Stories:
<https://www.research.fsu.edu/research-offices/oc/success-stories/>
- Various FSU Communication Tools
- Columbia Video re Time to Market

THANK YOU !

Q & A

John Fraser

E: jfraser@burnsidedev.com