

# Intellectual Property and Technology Transfer

# About ME!



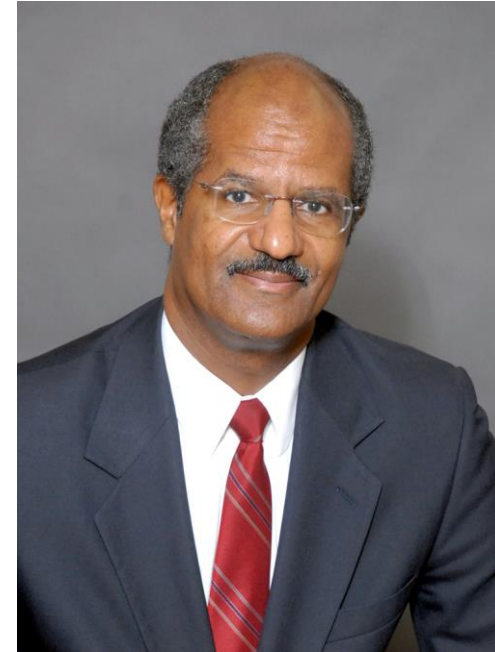
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- Senior Intellectual Property Counsel with Nokia, Inc.
- Intellectual Property Counsel at Snell & Wilmer, LLP.
- Georgia Institute of Technology (BEE)
- Morehouse College, (BS, Mathematics)
- Howard Taft School of Law, University of Cincinnati (J.D.)

I have research that I  
believe is valuable.

Now what?



Let's make some  
money!

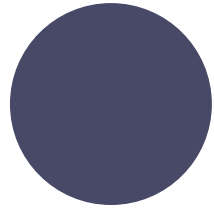
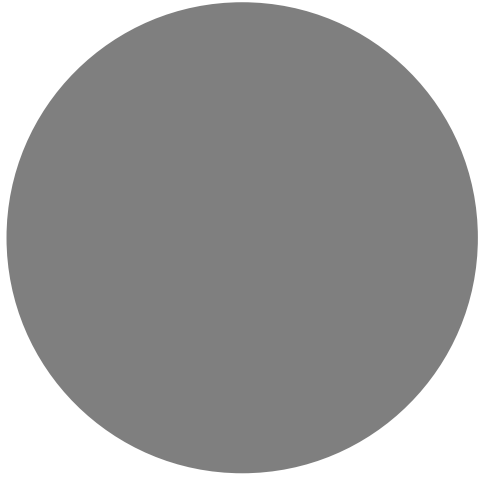


**Stephen C. McGuire, the James and Ruth  
Smith Endowed Professor of Physics,  
Southern University Baton Rouge**

**2017 Nobel Prize in Physics**

**The LIGO Scientific Collaboration (LSC)**

***“Laser Interferometer Gravitational-Wave  
Observation”***



But how?

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We take advantage of  
the Bayh-Dole Act!



Birch Bayh



Bob Dole

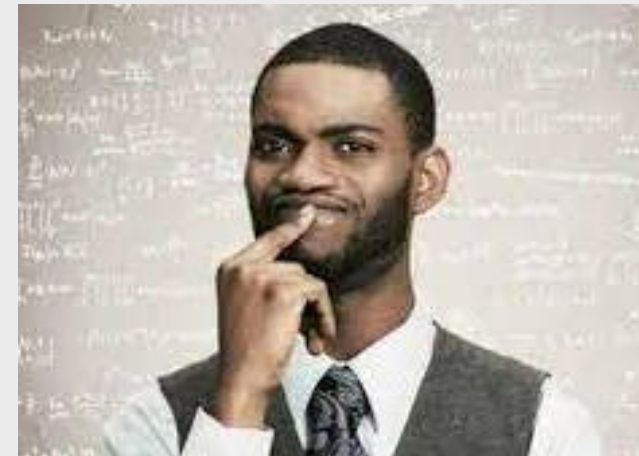


In 1980, Congress passed the “**University and Small Business Patent Procedures Act**”, also called the Bayh-Dole Act.

Universities can take ownership of its research and commercialize it!

In response to Bayh-Dole, universities created **Technology Transfer Offices (TTOs)**.

Why does a university want to have a Technology Transfer Office?





The university wants to commercialize the

**BIG HIT Blockbuster Patent!**

- A blockbuster discovery can alter a university's fortune!
- **The university's portion of the "royalty" income is unrestricted.**
- On average, universities make more than **4,000 patent licensing agreements annually** and collect about **\$2 billion a year in licensing revenue.**

**Innovation**

**Amount of Unrestricted Revenue from Innovation**

**Remicade**

\$1 billion to Columbia university

**Gene Splicing method of Cohen-Boyer**

\$255 million to Stanford university and UCSF

**Axel patents for method for inserting DNA in eukaryotic cells**

\$790 million to Columbia university

# Bahy-Dole Act also requires the university to share its royalties with the “researcher.”

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\*The Southern University Intellectual Property Policy Requires “**the net royalty distribution:**

Forty percent (40%) to the originator for personal use.

Sixty percent (**60%**) to the Intellectual Property Fund for academic and research use.”

The net royalties must be “used for research, development, and other scholarly activities...”

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Southern University System Intellectual Property Policy, Revised 3/25/2010



It depends....

If the research was done outside any university employment or sponsorship then the student owns it

## What about research produced by students enrolled in school?

If the research was done while employed or sponsored by the university, then the research is owned jointly.

Graduate thesis and dissertations are always owned by the student, but the University receives an irrevocable, non-exclusive, royalty free, world-wide license



# Does Southern University's Have a TTO?

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# Offices of Research and Strategic Initiatives & Sponsored Programs



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2020 Outstanding Researcher,  
Award to Dr. Banadaki

# What does a TTO need to be successful??

**Patents!**

## **Quick Notes on University Research**

University inventions are usually *embryonic*.

- They require 5-7 years of privately funded development to transfer the innovation into commercial products.
- New drug discoveries take double the time and add about \$1 billion in company investment.

Unfortunately, universities cannot afford to commercialize every invention from its researchers!



How does a TTO pick the right patent on which to use its limited resources?

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# Idea-People- Opportunity Model

## IDEA

- 1. Quality of the idea/based on good science/solid technology**
- 2. Clear indication of innovation potential**
- 3. Is the idea 'really real' or an 'unformed idea'**

## PEOPLE

- 1.** Passion/commitment to project
2. Team strength if applicable
- 3.** Receptivity to advice and constructive criticism
- 4.** Genuine concern to understand domain/market factors or barriers
- 5.** Propensity for introspection and self-analysis
6. Domain expertise or at least access to it.

## OPPORTUNITY

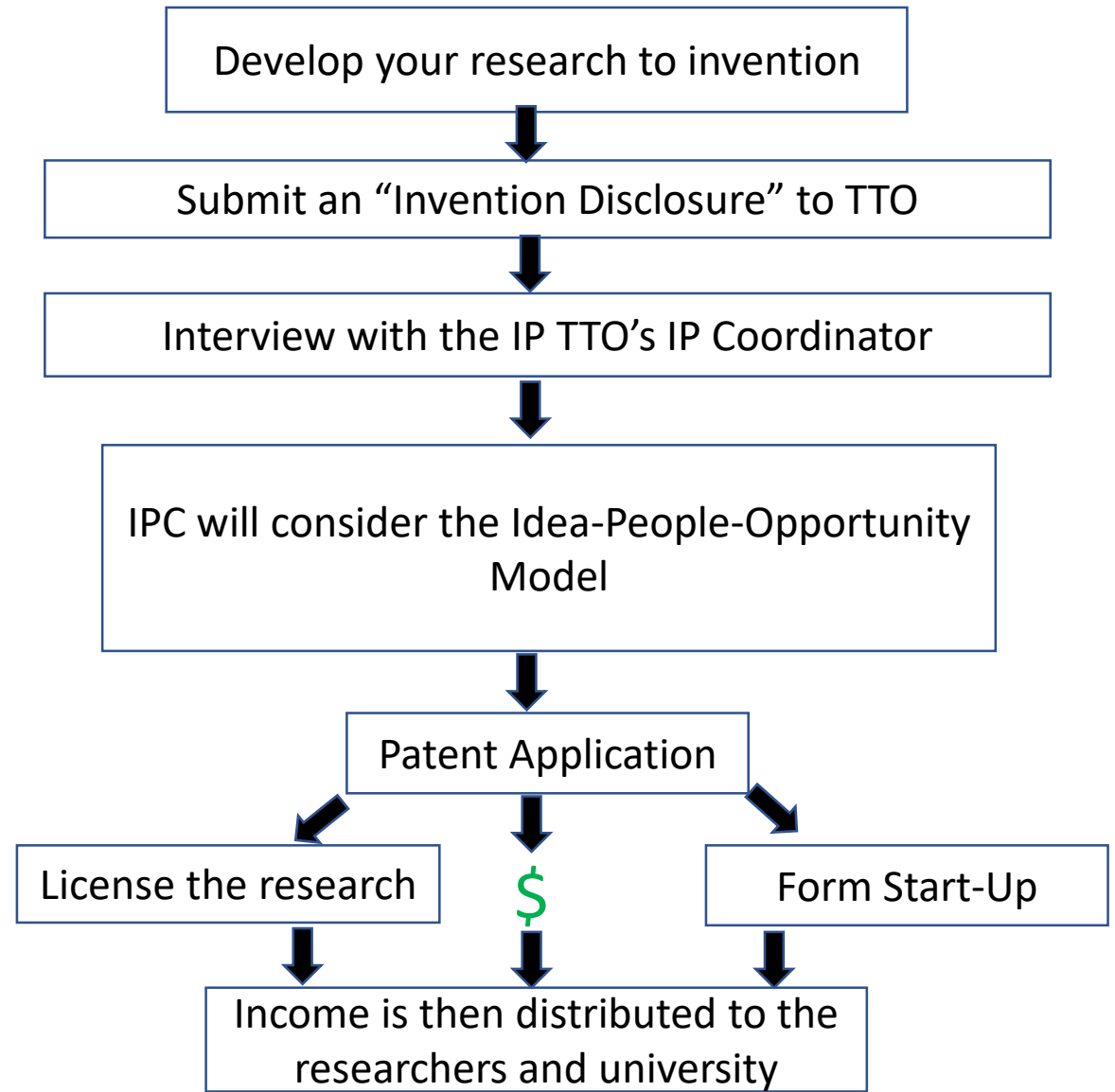
1. Potential for commercial application (current or emerging markets)
2. Strong positioning relative to competitive technologies/products
3. Potential to attract early adopters or users
4. Sensible commercialization path
5. No obvious fatal flaws

What steps does Southern  
University take to  
commercialize its research?





# What is the typical *review* and *revenue* model researchers can expect?



# The evaluation process is structured

All Universities in the  
Southern University  
System  
must follow  
the  
*Southern University  
System Intellectual  
Property Policy (IPC)*

Southern University and A&M (SUBR)

Southern University at New Orleans (SUNO)

Southern University at Shreveport (SUSLA)

Southern University Law Center (SULC)

Southern University Agriculture Research and  
Extension Center (SUAREC)

# Intellectual Property Policy

Purpose: It is the Established policy for governing the relationship between the University and the researcher

Applies to intellectual property sponsored or supported by the university

Establishes an ***Intellectual Property Committee (IPC)***

- Faculty
- Students
- Administration

IPC makes a recommendation regarding the research to the chancellor. The recommendation is prepared by IPC and the vice chancellor.



# Factors to be evaluated by the IPC

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1. The scientific, technical and economic merit of the intellectual property,
2. The likelihood and desirability of obtaining patent, trademark, copyright or trade secret protection,
3. An estimate of the commercial potential,
4. And general description of the university or resources used in the development of the intellectual property.

PMXBAA and SUBR OSP are currently establish the IPC for Southern University A&M campus.

Instructional Video Series coming near you!





# What we've accomplished at SUBR

- 2 applications filed with the U.S. Patent Office.
- 1 patent has been granted.
- 3 patents that we are currently seeking licensing partners.
- 1 patent is in active discussions with a protentional licensing partner.

# Car

# I

Let's watch



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Questions?





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