



Mechanisms for Collaborating with UCSB

Sherylle Mills Englander

Director,

Office of Technology & Industry Alliances



University of California, Santa Barbara

Office of Technology & Industry Alliances

- Established *August 15, 2005*
- “Hybrid” model with two foci:
 - Management of UCSB intellectual property, including marketing and licensing activities
 - Negotiation of agreements related to industry support of research (including research agreements, MTAs, etc.)
- *Vision:* to promote productive and mutually-beneficial relationships with industry partners while effectively managing our intellectual property



University of California, Santa Barbara

- Mechanisms for Interacting with UCSB Research and Researchers
 - Licensing UCSB Technologies
 - Sponsored Research Agreements
 - Philanthropic Donation
 - Research Center Affiliations
 - Corporate Programs
 - Recharge Facilities
 - Faculty Consulting



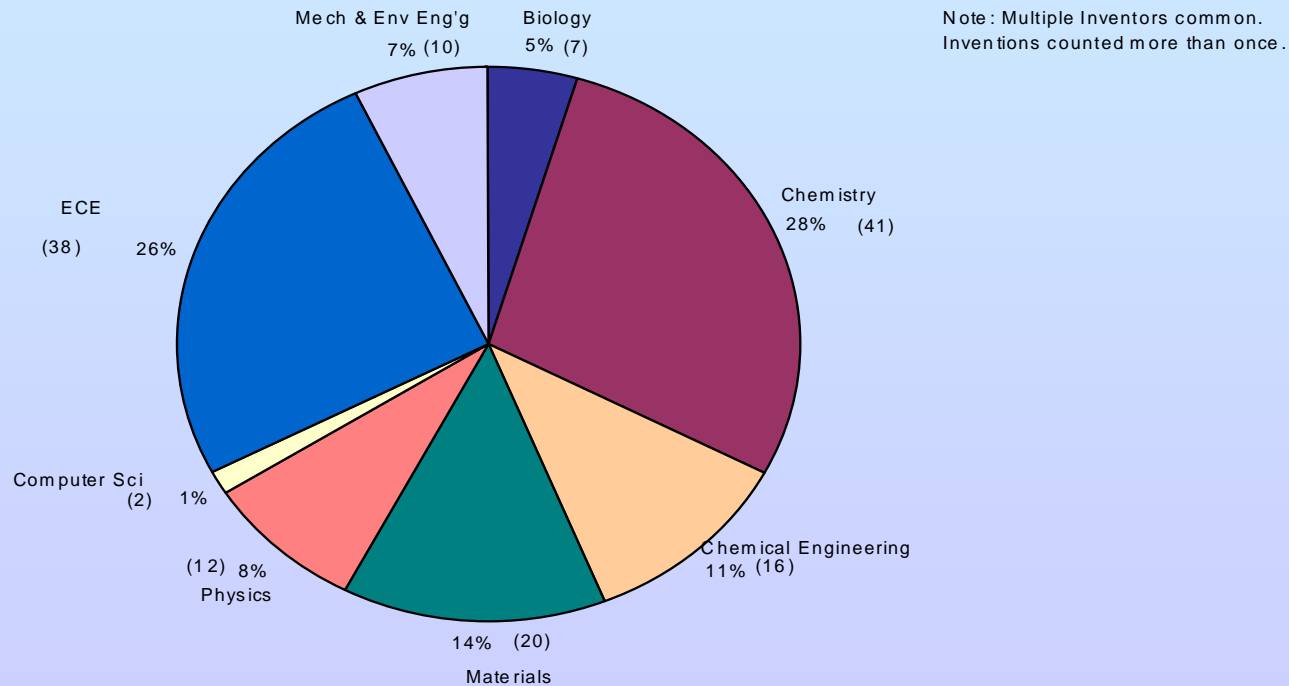
Mechanisms for Working with UCSB:

Licensing Technologies for Commercial
Development



University of California, Santa Barbara

Inventors by Dept: Active Inventions Disclosed FY02-FY04



UCSB patent portfolio is “engineering dominated,” includes over 500 inventions, more than 70% of which have engineering connection.



University of California, Santa Barbara

- UCSB Invention Portfolio
 - UCSB Researchers are efficient
 - In FY06,
 - the Santa Barbara campus produced one invention disclosure for every \$1.45M expended; per
 - Research institution average is only one for every \$2.4M expended.¹
 - Our Research Centers are even more efficient, with up to one invention per \$370K expended.
 - Better than the average of \$500K per invention disclosure reported by *The Economist* for technology companies.²

1. Average from 2001-2003 AUTM Licensing Surveys

2. *The Economist*, October 22, 2005



University of California, Santa Barbara

UCSB Invention Portfolio:

- Researchers are *highly collaborative*
 - Many disclosures involve researchers from multiple departments.
 - Strong, long term collaborations between the life and physical sciences and engineering form the basis for the many of our disclosures, allowing packaging, manufacturing and materials issues to be better anticipated at the early stage.



University of California, Santa Barbara

- Locating Available Technologies for Licensing:
 - *Website* listing of available technologies at:
 - http://research.ucsb.edu/tech_transfer/
 - *Contact* Technology & Industry Alliances to request customized portfolio search
 - *Identify Interesting Research Projects* (with help from TIA and Corporate Programs, if needed)
 - Inventions follow research activity
 - TIA is pleased to help facilitate an IP audit on interesting research and coordinate resulting disclosure/licensing activities.



University of California, Santa Barbara

- Licensing Options:
 - Letter of Intent: simple, two-page document to allow short term feasibility assessment (6 to 12 months).
 - Option Agreement: For longer term feasibility assessment (1 to 3 years). Provides right to use, make, have made (no right to sell or distribute).
 - License Agreement: All rights of patent holder, incl. right to sell. Term runs for life of the license patent(s)
- TIA seeks to establish customized license terms, based on sector, technology and circumstances, and to fit the type of licensing option to the anticipated development timeline.



University of California, Santa Barbara

Further Development *After* Licensing

- Inventor consultation during development may be available through sponsorship of campus research or private consulting
 - Research agreements can be negotiated simultaneously with license agreement
 - If technology early stage, option to initial patent can be set to run concurrently with research agreement to preserve rights while further R&D fleshes out technology applications and feasibility
 - Master license or option agreements, to allow improvements to be efficiently added, are embraced



Mechanisms for Working with UCSB:

Sponsoring Research Agreements



University of California, Santa Barbara

Sponsored Research Agreements

- Best choice for supporting research when intellectual property may be important . . .
 - Contractual right to receive first option to negotiate a license to any intellectual property developed during the research project.
 - Contractual right to receive reports of research results and to use data from the research
 - Indirect cost does apply.



University of California, Santa Barbara

Sponsored Research Agreements

Leveraging your Investment: Matching Funds

- UC Discovery Program (IUCRP) State matching funds. Matches \$1:\$1 private industry investment in project (provisions allow some in-kind to also receive matching).
 - Eligibility: For-profit companies with R&D operations in California
 - Level of Funding: Combined budgets (industry and state) of \$50,000 to \$2.0M
 - Same IP terms as stand-alone research agreements
 - **FAST turnaround** – proposal submission to research contract in 100 days.
- **MORE INFORMATION IN YOUR REGISTRATION PACKETS!**



University of California, Santa Barbara

Sponsored Research Agreements

Leveraging your Investment:

- **Corporate Programs Affiliate Program:**
 - Certain level of research agreement investment may make company automatic member of the new affiliate program
- **Institute for Collaborative Biotechnologies**
 - Members have ability to secure federal funding to fund certain research projects
 - At some membership levels, able to direct a portion of membership fee towards sponsored research agreements in addition to getting access to licenses for certain ICB-generated IP.



Mechanisms for Working with UCSB:

Philanthropic Donations



University of California, Santa Barbara

Philanthropic Donations

- Good choice to support early stage research if intellectual property rights are not critical
 - No contracts to negotiate
 - No indirect cost assessed
- Please be aware that:
 - No intellectual property rights can be given in exchange
 - Precise scope of work cannot be memorialized.
- Hybrid arrangements are possible where gift funds can support administrative and other costs, with a sponsored research agreement to fund the actual research projects where intellectual property rights are desired.



University of California, Santa Barbara

Questions?

