



Essentials of Academic Technology Transfer September 8-11, 2019

Technology Operations and Organization Licensing Skills (TOOLS) September 9-11, 2019





Welcome to Oak Brook!

Get ready to connect with colleagues, exchange ideas, ask questions, get answers and gain valuable contacts. AUTM's 2019 TOOLS and Essentials Courses offer diverse programs for technology transfer newcomers.

AUTM TOOLS and Essentials Courses are Paperless

As a courtesy to the environment, we have dispensed with handouts. Attendees have online access to materials before, during and after the courses.

About AUTM

AUTM is the nonprofit leader in efforts to educate, promote and inspire professionals, throughout their careers, to support the development of academic research that changes the world. AUTM's community is comprised of more than 3,000 members who work in more than 800 universities, research centers, hospitals, businesses and government organizations around the globe.

Essentials of Academic Technology Transfer course leadership:

Program Chair

Marie Kerbeshian, PhD,
University of Iowa Research Foundation

Program Committee

Dirk Benedict, *Louisiana State University AgCenter*
Alexander P. Ducruet, *University of Pittsburgh*
Joseph Janda, MA, MBA, RTTP, *Portland State University*
Andrew Maas, RTTP,
Louisiana State University and A&M College
Arundee Pradhan, RTTP, *Apio Innovation Transfer*
Ellen Purpus, PhD, *University of Nevada Reno*
Brian Shedd, *University of Houston*
Paul Tumarkin, *The University of Arizona*
Julie Watson, JD, *Marshall, Gerstein & Borun LLP*
Ray Wheatley, MS, CLP,
University of Texas Southwestern Medical Center (retired)

Technology Operations and Organization Licensing Skills (TOOLS) course leadership:

Program Co-chairs

Stephen Auvil, *TEDCO*
Khera Douglass, *KLD Enterprises, LLC*

Program Committee

George Chellapa, PhD, *University of Chicago*
Sarah Conrod, *Cape Breton University*
Sabrina Darnell, *University of Kentucky*
Jacqueline Havens, BS, MEd,
Children's Hospital of Philadelphia
Julie Kelley, *Augusta University*
Lisa Nolan, *Skysong Innovations*
Michelle O'Shea, *Borman & Company*
Caroline Page, JD, *University of South Carolina*
Alex Sanders, *Augusta University*



Congratulations to all the RTTP-certified speakers and moderators presenting at this week's TOOLS and Essentials courses. Want to showcase your expertise? Visit www.attp.info and become a Registered Technology Transfer Professional candidate.



Meeting Agenda

Sunday, September 8

3:30 – 5:30 pm

Registration

Location: First Floor Foyer

4 – 6 pm

Introduction to the Course

Location: Rooms 134 & 136

Moderator: Marie Kerbeshian,
*University of Iowa
Research Foundation*

Instructors: Essentials Committee

This session provides the opportunity to meet your fellow students and the course faculty through a series of team building exercises and games. We will also introduce the technology transfer cases that you'll be studying over the next few days.

Monday, September 9

7 – 5 pm

Registration

Location: First Floor Foyer

7 – 7:45 am

Breakfast

Location: Second Floor Foyer

7:45 – 8:20 am

Welcome to Technology Transfer

Location: Rooms 134 & 136

Program Chair: Marie Kerbeshian,
*University of Iowa Research
Foundation*

Attendees will get a brief overview of AUTM, its membership benefits and its role in the technology transfer profession. Learn about RTTP, CLP, and AUTM's strategic plan associated with professional development. An overview of the Essentials course will be discussed.

8:20 – 10:15 am

Innovation Assessment

Location:

Rooms 134 & 136

Instructors:

Joseph Janda,
Portland State University
Arundee Pradhan,
Apio Innovation Transfer

With an ever-increasing pool of innovations to assess, time management and focusing on critical elements is essential. This session covers the major business, legal, and technical considerations used in assessing an invention disclosure. We will also look at the disclosure decision-making process itself and the broader strategic considerations around those decisions. Students can experience walking through an actual disclosure and sitting down with the inventors themselves to ask questions and test their analytical skills.

10:15 – 10:30 am

Break

Location:

First Floor Foyer

10:30 am – Noon

Market Research

Location:

Rooms 134 & 136

Instructors:

Dirk Benedict,
Louisiana State University AgCenter
Paul Tumarkin,
The University of Arizona

Participants will learn the basic tools and methods needed to conduct market research. This class will describe various types of market research, provide practical resources for performing research, and illuminate methods for discovering unmet market needs. Participants will have the opportunity to step into the shoes of a market researcher through role-play and examples. Our session will conclude with hints and tips, offering "tools you can use" to find, qualify, and manage licensing deals.

Noon – 1:30 pm

Lunch

Location:

Grand Oaks Pavilion

Registered Technology Transfer Professional (RTTP)

Demonstrate your expertise in the academic technology transfer profession by becoming a Registered Technology Transfer Professional (RTTP). All AUTM professional development courses and designated educational offerings and meetings are eligible for continuing education (CE) credits, which support your registration application. For more information about the registration process and requirements, visit the Alliance of Technology Transfer Professionals (ATTP) website at www.attp.info.

Certified Licensing Professionals (CLP) Continuing Education

Certified Licensing Professionals (CLP) are required to demonstrate continued competence in their field to maintain their certification status. Individuals who hold the CLP designation can renew their credential by earning at least 40 continuing education (CE) credits. All AUTM professional development courses and designated educational offerings on the topics of licensing, technology transfer and technology commercialization at AUTM conferences or meetings are eligible for CLP continuing education credits for certification renewal. Visit www.licensingcertification.org for more information on the recertification requirements.

*The AUTM TOOLS course will provide **16 hours** of CE credits for those who attend the entire course.*

*The AUTM Essentials course will provide **18 hours** of CE credits for those who attend the entire course.*



Meeting Agenda

Monday, September 9 (continued)

1:30 – 3:15 pm **Reaching Potential Partners**
Location: Rooms 134 & 136
Instructors: Dirk Benedict,
 Louisiana State University AgCenter
 Brian Shedd, *University of Houston*
 Paul Tumarkin,
 The University of Arizona

In this session, we'll synthesize the outcomes of your assessment, valuation, and market research to start marketing the technology. How do you develop and deliver a message that captures the attention of potential partners? How do you identify targets, generate leads and effectively manage them? What untapped resources are available to you? And how can you pull it all together to create an effective, scalable marketing plan? We will explore tools and methods to keep you organized, productive, and focused on results.

3:15 – 3:30 pm **Break**
Location: First Floor Foyer

3:30 – 5 pm **Reaching Potential Partners (continued)**
Location: Rooms 134 & 136
Instructors: Dirk Benedict,
 Louisiana State University AgCenter
 Brian Shedd, *University of Houston*
 Paul Tumarkin,
 The University of Arizona

5:30 – 7 pm **Welcome Reception**
Location: Grand Oaks Pavilion
Meet your colleagues and make new friends at the welcome reception.

Tuesday, September 10

7 am – 5 pm **Registration**
Location: First Floor Foyer

7 – 8 am **Breakfast**
Location: Second Floor Foyer

8 – 10:15 am **Introduction to Valuation**
Location: Rooms 134 & 136
Instructors: Joseph Janda,
 Portland State University
 Andrew Maas,
 Louisiana State University and
 A&M College
 Arundee Pradhan,
 Apio Innovation Transfer

It's time to start working with your partner on the financial deal terms. How do you take the information you learned during your assessment of the innovation and turn it into a term sheet that works for both you and your partner? This session will introduce valuation models and how to use them in a negotiation.

10:15 – 10:30 am **Break**
Location: First Floor Foyer

10:30 am – Noon **Functional Framework of a License**
Location: Rooms 134 & 136
Instructors: Ellen Purpus,
 University of Nevada Reno
 Julie Watson,
 Marshall, Gerstein & Borun LLP

The license is the apex of all our hard work to find a commercialization partner and negotiate a deal. We'll show you how to see the forest for the trees in these sometimes-complex agreements by focusing on the underlying functional framework. We'll close with drafting exercises to hone your skills in crafting clear and enforceable license provisions.

Noon – 1:30 pm **Lunch**
Location: Grand Oaks Pavilion



Tuesday, September 10 (continued)

1:30 – 3:15 pm

Basics of Negotiation

Location:

Rooms 134 & 136

Instructors:

Alexander P. Ducruet,
University of Pittsburgh
Ray Wheatley,
*University of Texas Southwestern
Medical Center (retired)*

You know what you want and what you need. So does your partner. It's time to learn the basics of negotiation to arrive at a deal that works for both of you.

3:15 – 3:30 pm

Break

Location:

First Floor Foyer

3:30 – 5 pm

Basics of Negotiation (continued)

Location:

Rooms 134 & 136

Instructors:

Alexander P. Ducruet,
University of Pittsburgh
Ray Wheatley,
*University of Texas Southwestern
Medical Center (retired)*

Wednesday, September 10

7 – 11 am

Location:

Registration

First Floor Foyer

7 – 8 am

Location:

Breakfast

Second Floor Foyer

8 – 9 am

Location:

Other Agreements: The Tools for Transferring Innovations

Rooms 134 & 136

Instructors:

Andrew Maas, *Louisiana State
University and A&M College*
Ellen Purpus,
University of Nevada Reno

How are your institution's innovations transferred into the hands of potential partners and collaborators? Throughout the process, you will rely on a number of agreements that let you share information, materials, experience, research activities, and intellectual property rights. This session will review the basics of CDAs/NDAs, MTAs, sponsored and collaborative research agreements, inter-institutional agreements, and others.

9 – 10:15 am

Location:

Beyond the Deal

Rooms 134 & 136

Moderator:

Marie Kerbeshian, *University of
Iowa Research Foundation*

Instructors:

Essentials Committee

You may think you are done when you sign on the dotted line, but every successful technology transfer agreement starts a long, and hopefully successful, relationship. What role can you play to support the success of this relationship, and how does that impact your office and your own career development?

10:15 – 10:30 am

Location:

Break

First Floor Foyer

10:30 – Noon

Location:

Beyond the Deal (continued)

Rooms 134 & 136

Moderator:

Marie Kerbeshian,
*University of Iowa Research
Foundation*

Instructors:

Essentials Committee

Noon

Course Adjourns



Meeting Agenda

Monday, September 9

7 – 5 pm

Registration

Location: First Floor Foyer

7 – 8 am

Breakfast

Location: Second Floor Foyer

8 – 8:30 am

TOOLS Welcome

Location: Room 226

Speakers: Stephen Auvil,
Maryland Tech Dev Corp
Khera Douglass,
KLD Enterprises, LLC

Attendees will get a brief overview of AUTM, membership benefits and their role in the technology transfer profession. An overview of what will be covered in the AUTM Technology Operations and Organization Licensing Skills (TOOLS) course and the other courses that are offered in the Administrative and Operations space and why those courses would be of interest to TOOLS course attendees.

8:30 – 10 am

Pre-disclosure

Location: Room 226

Moderator: Sabrina Darnell,
University of Kentucky

Instructors: Christina Hietala,
*The Translational Genomics
Research Institute*
Julie Kelley, *Augusta University*

In this session, we will discuss many of the agreements used in tech transfer and why it's important to know whether or not there are any obligations around the disclosed invention.

10 – 10:30 am

Networking Break

Location: Second Floor Foyer

10:30 am – Noon

Invention Disclosures

Location: Room 226

Moderator: Khera Douglass,
KLD Enterprises, LLC

Instructors: Brittany Butler,
University of Chicago
Michele O'Shea,
Borman and Company LLC
Adrienne Padgett,
University of Florida

The invention disclosure is the foundation of the technology transfer process. In this session, we will dissect the invention disclosure form and explain why it is so important to ask the right questions of your potential inventors. We will look at the various ways technology

transfer offices gather the information. The session will cover best practices for capturing all of the data that is gathered by the team, whether it's by way of the invention disclosure form, an inventor meeting or through any other research tools available to your office, grant information, another database that captures data at your institution or just reading between the lines of any supporting documents.

Noon – 1:30 pm

Lunch

Location: Grand Oaks Pavilion

1:30 – 3 pm

Intellectual Property Primer

Location: Room 226

Moderator: Brittany Butler,
University of Chicago

Instructors: Tamara Alcaraz,
University of California, Los Angeles
Jessica Mandl, *Skysong Innovations*

In this session, attendees will learn about the basic types of intellectual property including patents, copyrights, trademarks, trade secrets, and know-how. Tangible property will also be described.

3 – 3:30 pm

Networking Break

Location: Second Floor Foyer

3:30 – 5 pm

**Managing Data for
Pre-disclosure, Invention
Disclosures, Provisional and
PCT Filings**

Location: Room 226

Moderator: Khera Douglass,
KLD Enterprises, LLC

Instructors: Jessica Mandl,
Skysong Innovations
Michele O'Shea,
Borman and Company LLC
Alex Sanders, *Augusta University*

We will discuss how the different offices capture the data, communicate with outside parties and how that data is added to the informational tools used by the different institutions represented by the moderator and panelists.

5:30 – 7 pm

Welcome Reception

Location: Grand Oaks Pavilion

Meet your colleagues and make new friends at the welcome reception.



Tuesday, September 10

7 am – 5 pm

Registration

Location: First Floor Foyer

7 – 8 am

Breakfast

Location: Second Floor Foyer

8 – 10 am

US and Foreign Patent Applications

Location: Room 226

Moderator: Brittany Butler,
The University of Chicago

Instructors: Tamara Alcaraz,
University of California, Los Angeles
Khera Douglass, *KLD Enterprises, LLC*
Jessica Mandl, *Skysong Innovations*

This session will take a closer look prosecution. Time will be spent on patent types, parts, terminology, patenting process including office actions, restrictions, notices of missing parts (declarations), advisory actions and requests for continued examinations. Tracing relationships between patents within a patent family will also be covered.

10 – 10:30 am

Networking Break

Location: Second Floor Foyer

10:30 am – Noon

Compliance with Funding Institutions (Federal & Non-Federal)

Location: Room 226

Moderator: George Chellapa,
The University of Chicago

Instructors: Michele O'Shea,
Borman and Company LLC
Alex Sanders, *Augusta University*

Learn about the Bayh-Dole Act including its history and all of its deadlines related to reporting federally funded inventions and how to develop administrative systems and procedures to ensure compliance with all of its requirements. We will also review invention reporting and iEdison and other reporting mechanisms will be covered.

Noon – 1:30 pm

Lunch

Location: Grand Oaks Pavilion

1:30 – 3 pm

Anatomy of a License

Location: Room 226

Instructors: Stephen Auvil, *TECDO*
George Chellapa,
The University of Chicago

Whether you are involved in license maintenance, finance or patent administration, you need to understand license agreements to do your job well. This session will include an introduction to license agreements and an explanation of the importance of each section. The session will include an interactive exercise. A comparison of license agreements for patent rights, copyright/software, and

trademark will be provided. We will also review some creative ways to capture data in order to produced focused metrics.

3 – 3:30 pm

Networking Break

Location: Second Floor Foyer

3:30 – 5 pm

Office Finance Payables, Receivables and Distributions

Location: Room 226

Moderator: Lisa Nolan, *Skysong Innovations*

Instructors: Alex Sanders, *Augusta University*
Khera Douglass, *KLD Enterprises, LLC*

Financial management is a critical function of any technology transfer office. This session will cover three major areas of financial management: budgeting for operations, tracking expenses, managing the receipt and distribution of licensing revenue, and general license agreement compliance. Attendees will review the complexities of royalty distributions and hear plenty of examples that are certain to inspire a lively dialog.

Wednesday, September 11

7 – 11 am

Registration

Location: First Floor Foyer

7 – 8 am

Breakfast

Location: Second Floor Foyer

8 – 9:30 am

Databases

Location: Room 226

Moderator: Khera Douglass, *KLD Enterprises, LLC*

Instructors: Sabrina Darnell,
University of Kentucky
Christina Hietala,
The Translational Genomics Research Institute
Julie Kelley, *Augusta University*

This session will feature breakout roundtable discussions for databases used by attendees, including home-grown. Each roundtable will be led by a power user. Attendees may attend the discussion for the software that they use or attend another discussion to learn about other systems.

9:30 – 10 am

Networking Break

Location: Second Floor Foyer

10 am – Noon

TOOLbox Tips and Tricks

Location: Room 226

Moderator: Khera Douglass, *KLD Enterprises, LLC*

Instructors: TOOLS Panel

This session will cover tips and tricks that help data managers in all aspects of their work. Both panelists and attendees will have an opportunity to share things that they find useful in their day-to-day work.

Noon

Course Adjourns



AUTM'S Antitrust Policy – What You Need to Know

AUTM has a policy of strict compliance with federal and state antitrust laws. The antitrust laws prohibit competitors from engaging in actions that could result in an unreasonable restraint of trade. Consequently, AUTM members must avoid discussing certain topics when they are together – both at formal association membership, Board, Cabinet, committee and other meetings and in informal contacts with other industry members. Please review AUTM's policy, www.autm.net/antitrust and adhere to the following:

- **DON'T** discuss prices or fees for service, costs, discounts, terms of sale or credit, warranties, profit margins, individual companies' marketing or bidding plans, pricing policies, controlling sales, allocating markets, complaints related to specific customers, or refusals to deal.
- **DON'T** joke about antitrust compliance.
- **DON'T** speak or act on behalf of AUTM or any committees unless specifically authorized to do so.
- **DON'T** participate if you think something is improper.
- **DO** alert the AUTM Chair, CEO, or legal counsel to any concerns about competitively sensitive information.

Save the Date

Annual Meetings

2020
March 8 – 11
Manchester Grand Hyatt
San Diego
San Diego, California

2021
March 14 – 17
Washington State
Convention Center
Seattle, Washington

Region Meetings

Western Region
September 19 – 20
Motif Seattle
Seattle, Washington

Eastern Region
October 3 – 4
Raleigh Marriott City
Center
Raleigh, North Carolina

Professional Development Courses

Agreement Course
October 28 – 30
Hyatt Regency Bethesda
Bethesda, Maryland

Compliance Course
October 28 – 30
Hyatt Regency Bethesda
Bethesda, Maryland

IP Portfolio Course
October 28 – 30
Hyatt Regency Bethesda
Bethesda, Maryland

**Corporate Engagement
Intensive Course**
December 9
The Jung Hotel
New Orleans, Louisiana