Academic Technology Licensing & the America Invents Act

Eric Gosink, Ph.D.
Senior Licensing Officer
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University of California San Diego

- **Expertise and Resources**
  Scripps Inst. Oceanography, Medical and Pharmacy Schools, Medical Center, Engineering School, CalIT2

- **Health System, best in nation**
  Pulmonology, Psychiatry, Diabetes/Endocrinology, Orthopedics, Geriatrics

- **Faculty Honors**
  Nobel Prize, National Academy of Sciences, Fields Medal, National Medal of Science
University of California San Diego

News Center

August 15, 2012 | By Christine Clark

UC San Diego Named 15th Best Among World Universities

Academic programs in engineering, life sciences, chemistry and economics earn accolades

The University of California, San Diego is ranked the 15th best university in the world and its life sciences program is ranked 9th, according to the 2012 Academic Ranking of World Universities (ARWU) that was released Aug. 15, 2012 by the Center for World-Class Universities at Shanghai Jiao Tong University.

"It's an honor for UC San Diego to be recognized as a global model of academic excellence," said UC San Diego Chancellor Pradeep K. Khosla. "This ranking is a testament to the extraordinary achievements of our outstanding faculty, dedicated staff, high-caliber students and successful alumni."

The Academic Ranking of World Universities also recognizes subject fields. In the life and agriculture sciences category, UC San Diego is ranked 9th in the world.

"These rankings provide unequivocal validation of the commitment we have made to faculty quality and top research programs," said Steve Kay, dean of the Division of Biological Sciences at UC San Diego. "They are a clear example of our standing as a world-class Division of Biological Sciences and complement the number one ranking from the National Research Council that we received last year for our graduate program."

Other UC San Diego ARWU subject field rankings include natural sciences and mathematics (20), engineering (12), clinical medicine and pharmacy (21), social science (25), mathematics (23), chemistry (13), computer science (14) and economics (17).

http://ucsdnews.ucsd.edu/pressrelease/uc_san_diego_named_15th_best_among_world_universities
Research funding for 2012 at the University of California, San Diego has surpassed $1 billion for the second time in the last three years, the Office of Research Affairs has announced.

Total UC San Diego research funding for the fiscal year which ended on June 30 was more than $1,010,000,000, an increase of about $50 million over the funding for 2011.

UC San Diego competed for and received more than $960 million dollars for research in fiscal year 2011, at that time the university’s second-best year.

http://ucsdnews.ucsd.edu/pressrelease/research_funding_at_uc_san_diego_again_surpasses_1_billion_milestone
The Role of the University

Public Knowledge

Economic Driver

University

Technology Transfer Office
Promote and facilitate the transfer of UC San Diego innovations for the benefit of the University community and the public.
IP Reported to the UCSD TTO

Technology Transfer Office

INVENTIONS
COPYRIGHTS/TRADEMARKS

FY03  294  28
FY04  288  26
FY05  290  44
FY06  310  35
FY07  333  40
FY08  330  34
FY09  396  32
FY10  367  37
FY11  388  28
FY12  433  48

UCSanDiego
U.S Patent Activity

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Revenue Based Licenses

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UCSD TTO Licenses (FY2012)

405 Active Global Licenses by Country

405 Total Worldwide Licenses
ASIA: China (4), South Korea (1), Japan (8), Thailand (2), Taiwan (1)
AUSTRALIA: Australia (1)
EUROPE: Austria (2), Belgium (4), Denmark (2), France (2), Germany (1), Ireland (1), Italy (2), Netherlands (3), Switzerland (2), United Kingdom (9)
MIDDLE EAST: Israel (3)
NORTH AMERICA: Bermuda (1), United States (356)
Gross IP Revenue (in millions)
Agreements Under the ORA

Current Rights*

Future Rights*

Compensation**

OCG

TTO

Publicly Useful Results

** Funding or Collaboration

* Material or IP Rights

Technology Transfer Office
... in other words:

The University does not create companies...

...it provides the opportunity to others.
Key License Terms

**Financial**
- License issue fee
- Annual maintenance
- Milestone payments
- Earned royalties
  - % of Net Sales
  - $ /product sold
- Reimbursement of patent costs
- Equity in start-up companies

**Non-financial**
- Definitions
- Grant (XL/NXL)/field of use/territory/term
- Diligence milestones
  - Prototype
  - Clinical trials
  - First Commercial Sale
- Warranties and indemnification
- Patent matters
Key License Terms (warranty detail)

- ...provided “AS IS” and without WARRANTY OF MERCHANTABILITY or WARRANTY OF FITNESS FOR A PARTICULAR PURPOSE

- UNIVERSITY makes no representation or warranty that the Licensed Product, Licensed Method or the use of Patent Rights or Technology will not infringe any other patent or other proprietary rights

- Nothing in this Agreement shall be construed as a warranty or representation by UNIVERSITY as to the validity or scope of any Patent Rights
Concerns about IP - licensed or otherwise

- Early filing date
- Comprehensive and enabling
- Minimal challenges or limitations
- Minimal amount of time and cost
Patents are only given to novel ideas...but inventors have some grace periods.

- Publication: 0 time (Europe, China), 6 months (Japan, Taiwan), 12 months (USA, Canada)
- Loss of all IP: 1 year
Patent filing after disclosure...is more limited and expensive.

- **Review Time:**
  - 0 time: Europe, China
  - 6 months: Japan, Taiwan
  - 12 months: USA, Canada

- **Publication:**
  - 1

- **Loss of all IP:**
  - 1
Before the AIA, inventors could “swear behind.”
Patenting around other inventions;

After the AIA, only if “essentially identical”
Patenting around other inventions;

After the AIA, only if “essentially identical”
Patenting around other inventions:

After the AIA, 1 must show 2 derived from 1.
Concerns about IP - licensed or otherwise

- Early filing date
- Comprehensive and enabling
- Minimal challenges or limitations
- Minimal amount of time and cost
Concerns about IP - licensed or otherwise

Concern:
- Adequate time to review disclosures
- Balance of earliest filing date and most complete invention
- Minimal prior art challenges and USPTO limitations
- Minimize time and cost

University’s Response:
- Educate inventors and interact to get “best” disclosure
- File prior to publication and keep lab notebooks
- Limited budget, but:
  - Some prior art (not FTO)
  - More complete filings
- Collaborate with licensees on accelerated review, prior art and FTO searches
Thank you!

http://invent.ucsd.edu

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