TECHNOLOGY TRANSFER COMMUNITY NEWSLETTER

January 2019

ETT System – Update

ETT Team Eager to Begin Sprint to Finish Line

David Vismer, Sapient

Though the procurement process for the new Enterprise Technology Transfer (ETT) System has taken longer than originally expected, the procurement team is very excited to be close to making an award. The NIH has been lucky enough to receive proposals from several vendors, all of whom have well respected software packages, used by many universities and government organizations, that can meet the needs of the NIH technology transfer community.

As the procurement process moves forward, the ETT implementation team has been continuing to work with the NIH technology transfer community to document their processes, as well as their current systems and data, in order to prepare for the implementation of the new system and the migration of existing data into it. The complexity of working with so many different systems and organizations within the community provides exciting challenges that the ETT team is eager to take on!

If you have any questions about the project, or would like to volunteer your time to share your expertise with our implementation team, please ask your supervisor to reach out to the ETT Project Governance Group for more information.

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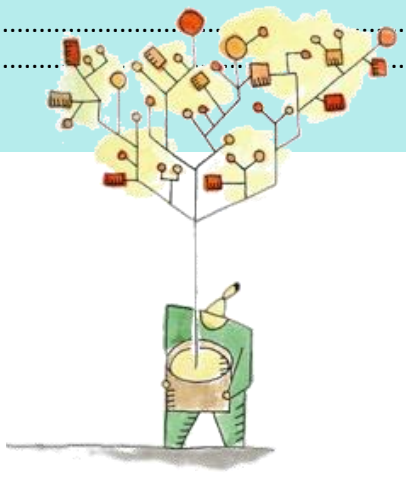

Please forward articles and newsletter suggestions to Ajoy Prabhu at ajoy.prabhu@nih.gov.

Why do some patents get licensed while others do not?

Steven Ferguson

A very simple question for NIH technology transfer but one that is very difficult to answer! Ideally, we would like to limit our patent filings to only those new inventions that companies or other organizations end up licensing. This is especially true for NIH since the purpose of obtaining these patents is strictly to transfer these rights to others to attract private sector investment and development of innovative medical products for public health. And of course, there is the unreimbursed cost issue. Other uses of patents such as to block product development by others or as a strategic asset valued in mergers and acquisitions really don't apply to us. While there are certainly always government use rights of patents (if ever needed), from a practical perspective at NIH it is really the licensing of these patents that is most critical.

Given this importance to the overall technology transfer program at NIH, what insights or key indicators for success in patent licensing can be found? Some of our Canadian university colleagues have published a very interesting empirical study (*Industrial and Corporate Change*, 2016, 1–22) that offers some important guidance for us on this topic. This biopharmaceutical-based patent study found that "patents owned by licensors with technological prestige, experience at licensing, and combined technological depth and breadth had a greater chance at being chosen by licensees". And interestingly also draws the conclusion, that "this would seem to suggest that a licensor's standing and organizational experience rather than the quality of its patent alone influence the success of patent success of outward licensing".

What does this all mean for NIH? Clearly the prestige and "brand" of the NIH is very important for our own patent licensing efforts. Technology transfer marketing efforts related to improving and extending this prestige and brand among our potential corporate partners will be key to future licensing success. The technological "breadth and depth" of NIH due to its size and 27 different institutes also clearly plays a positive role for us as well. After all, if it is a human disease or part of the human body, somebody here at NIH is researching it! Licensing and program experience at NIH is clearly a plus as well now with a formal technology transfer program dating back 30 years and staffed now with nearly 200 highly qualified individuals across all our offices.

With standing and experience assets like these 2019 should be our best year ever in terms of patent licensing!

Have your own licensing question or a discussion topic for an upcoming Licensing Forum session? Just as Steve!

Steven Ferguson, NIH OTT

Ask Steve – Q&A

NIH Joins National Academy of Inventions

NIH Chapter of NAI Off the Ground

Steven Ferguson and Ajoy Prabhu

A new intramural inventor recognition program is to be organized through a new NIH-wide membership in the National Academy of Inventors (NAI). The NAI was founded by scientists in 2010 to recognize and encourage inventors with patents issued from the U.S. Patent and Trademark Office, enhance the visibility of academic technology and innovation, encourage the disclosure of intellectual property, educate and mentor innovative students, and translate the inventions of its members to benefit society – all of which have also been goals of the NIH intramural research program for many years. Since 2010, the NAI has grown to boast a membership of over 200 research institutions in the U.S. and worldwide of all sizes, concentrations and innovative focuses, including several US federal laboratories. In 2017, Congress introduced HR 976, which would provide the NAI a federal charter like those held by other US National Academies. Further details regarding NAI, its fellows and awards can be found at http://academyofinventors.org.

NAI membership is expected to benefit NIH and NIH inventors by:

- Honoring the inventors and innovators among our institution's investigators, staff, post-docs, students and further encourage the creative thinking and spirit of innovation across the intramural program.
- Supporting development and commercialization of NIH patents and inventions, and the disclosure of intellectual property.
- Enhancing "internal marketing" efforts at OTT and the IC offices to increase inventor engagement and participation in technology transfer efforts for the intramural research program.
- Coordinating with and further boosting existing NIH programs highlighting inventions and inventors, including the Patents & Technology Transfer Scientific Interest Group (SIG) and Annual Philip S. Chen Lecture on Innovation and Technology Transfer.

Interested in helping to get the new NIH Chapter of NAI off the ground in 2019? Please contact Steve Ferguson or Ajoy Prabhu!

To RDF or Not to RDF — That, is the Question

Karen Rogers

The OTT Royalties Administration frequently receives inquiries asking when a Royalty Distribution Form (RDF) should be generated. The easiest way to determine if an RDF is needed is to ask the following question:

Will the NIH receive any royalties or patent prosecution expense reimbursement from the licensee?

- If the answer is yes, please submit an RDF with the new license agreement.
- If the answer is no, an RDF is not needed.

Is an RDF Needed for License Amendments?

Yes, even if the amendment does not change royalties due or the licensed technologies.

How Many License Records Should be Generated for Multi-Party Agreements?

If the license agreement has multiple parties, the NIH has the lead in licensing, and will be sharing royalties with outside organizations, you will need to generate a separate license application and executed license record for each licensee. This is regardless if there is just one license that includes all parties. Why? If the NIH will be distributing royalties to other organizations we must have a way to associate the payout with each particular organization through the license number (L-XXX-XXXX-X). This is also the way that the NIH Office of Financial Management associates income and distributions.

Annotate on each copy of the multi-party license agreement an individual license number and forward through the NIH TechTracS and OTT SharePoint System as usual.

Still not sure? Contact Debbie Collins, Royalties Administrator, through phone 301.594.2366 or e-mail, for assistance.

NIH Patent & Licensing Activities Take Top Prizes in 2018

Jenish Patel, Peter Soukas and Steven Ferguson

Serum Institute of India and
The National Institute of Allergy and Infectious Diseases
IUGI Sector Leaders: Adrian Cyhan and Michele Gunness
Photo from left: Adrian Cyhan, LES; Steven Ferguson, NIH, Jenish Patel, NIH; Jagdish Zade, Serum Institute of India, Sameer Naik, Serum Institute of India; and Michele Gunness, LES IUGI Sector leader.

At award ceremonies separated by only a few weeks this past October & November, NIH technology transfer efforts received top national awards from both the Licensing Executives Society (LES) and the U.S. Patent and Trademark Office (USPTO). The development and patenting of a low-cost, temperature-tolerant vaccine from the laboratory of late Dr. Albert Kapikian of NIAID was recognized for both the "Deal of Distinction" (LES) and the "Patents for Humanity" (USPTO) awards. Licensed and manufactured by the Serum Institute of India, the vaccine has already been approved by the World Health Organization and the government of India.

The inspirational aspect of this project is to show the disease and the ability to cure it doesn't stop at any border. While the issue of rotavirus infection is an important one in the United States, in many other areas of the world it is considered life-threatening and a public health crisis. With this new vaccine the price of rotavirus treatment will drop to around $1, making it available now in many areas of the developing world. The Serum Institute of India had the underlying technology to make this possible and the NIH provided the new science discovery and patents. Joining the science, technology and patents together resulted in an international partnership that allowed the new vaccine to come forward.

From left to right in the USPTO picture – Dr. S.S. Pisal (SIIL), Dr. Rajendra Sabale (SIIL), Dr. Jagdish Zade (SIIL), Mrs. Catherine Kapikian, Mr. Gregory Kapikian, and Dr. Jenish Patel (TTIPO, NIAID).

NIH as a Business Partner

NCI TTC Leads NIH TT Panel at Bio+Tech 2018 Conference

Michele Newton

TTC's Invention Development & Marketing Unit (IDMU) hosted a panel at the **Bio+Tech 2018 Conference** in Baltimore on September 20 entitled, "***National Institute of Health as a Business Partner.***" Chaired by IDMU's Michael Salgaller, panelists included Joseph Conrad (IDMU); Ajoy Prabu (NIH, OTT); Haiqing Li (NIAID, TTIPO) and Michael Davis (NHLBI, OTTAD). Each panelist discussed the specifics of how stakeholders can work with their respective Institutes and obtain technologies to start or expand their businesses.

With approximately 40 in attendance, the engaged and attentive audience asked several questions, during and after the session. Within TTC, the IDMU is focused on proactive outreach and engagement to increase awareness of the benefits of partnering with the NIH, with the ultimate goal of identifying potential technology collaboration partners and licensees.

Top right: Michael Salgaller, Ph.D.
Bottom right: Joseph Conrad, Ph.D.

New Director at NCI TTC

Long-Serving TTC Director Retires, New Director Named

Michele Newton

TTC has a new director after the retirement of Karen Maurey, who lead the TTC since 2003. Tom Stackhouse, Ph.D., a TTC veteran and associate director since 2009, was selected to lead TTC upon Maurey's departure in September.

"Over the years, Tom has demonstrated his passion for innovation in technology transfer and entrepreneurship," commented Patrick McGarey, associate director finance and legislation, to whom the TTC director reports. "His leadership resulted in notable accomplishments such as establishing a CRADA program within the Frederick National Laboratory, an invention development program to advance NCI's intramural discoveries, and the Startup Challenges, to stimulate creation of startup companies based on intramural inventions."

Thomas Stackhouse, Ph.D., new TTC director

Comings and Goings

Aditi Sengupta Banerjee, Ph.D. joined OTT as a volunteer Intern in August and is now working as a Fellow to support Technology Commercialization and Assessing Efficacy of Targeted Marketing of NIH Technologies. She received her Ph.D. in Molecular Virology and Cancer Cell Biology from Jadavpur University, India. She worked as a postdoctoral fellow at NCI and NIAID before joining OTT. Her research background includes viral oncology, cancer stem cells and malaria immunology.

Merissa Baxter, Ph.D. joined TTC in September and is working to support IC's within the TTC Service Center. She received her Ph.D. in Pharmaceutical Sciences from the University of South Carolina and worked as a biologist in a chemical biology lab at NCI Frederick before joining TTC. Her research background includes drug discovery/design, pharmacology, and peptide synthesis.

Douglas Cheung, Ph.D. joined NCI TTC as a targeted Presidential Management Fellow in October and is supporting technology transfer efforts for various NCI institutes and centers, including the Center for Cancer Research. He received his Ph.D. in Molecular, Cellular, and Developmental Biology from The Ohio State University, where he also spent time as an intern at the OSU Technology Commercialization Office. His research background includes cancer biology, cell cycle, DNA repair, CDK inhibitors, and microRNAs.

Charesse L. Evans, JD, MBA is the newest member of the Monitoring & Enforcement Unit. Prior to joining OTTMEU, Charesse held roles at: (1) USPTO as Patent Examiner; (2) the University of Chicago Office of Technology Transfer & Commercialization, as Technology Transfer Project Manager; (3) Science Applications International Corporation (SAIC), as Senior Technology Management Advisor; and (4) Thomson Reuters, as Director of Licensing and Business Development. Charesse earned her BS in Biology from Tuskegee University, her Juris Doctor (JD) from Hamline University School of Law (MN), a Master of Business Administration (MBA) from the University of St. Thomas Graduate School of Business (MN), and is registered to practice before the USPTO.

Rebecca Goodwin, JD is now the TDC for NLM. Rebecca is a Policy Analyst & Open Science Analyst in the Office of Strategic Initiatives and OD at NLM/NIH. She also serves as Chair of the NLM Copyright Working Group and Executive Secretary of the NIH Scientific Data Council's Common Data Elements Task Force. She had previously served as Project Manager and Special Assistant to the Director of NLM/LHNCBC, where she fostered numerous collaborative relationships with federal and state government agency partners, the public health community, academia, industry and standards development organizations. Before joining NLM, she was a Presidential Management Fellow at NCI, where she completed rotations with the Center for Cancer Research, the Office of Budget and Finance, the Technology Transfer Center and Deputy Director for Management, the Division of Cancer Control and Population Sciences and the NIH Office of the Ombudsman (Center for Cooperative Resolution). She earned her JD from the University of Florida Levin College of Law.

Daniel Lee, J.D. joined TTC in August and is supporting various labs in NIH CC. Lee received his J.D. from Emory University School of Law, LL.M. from Northwestern University School of Law and M.S. in Bioinformatics from Johns Hopkins University. He worked at law firms, a Private Equity firm and a technology business incubator. Lee supports the ICs served by TTC's Service Center.