

Coronavirus Innovators:

Tips & Tricks for working with OTTC to protect COVID-19 IP

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Office of Technology Transfer & Commercialization

What is OTTC:

- Part of University Research Services & Administration (URSA). Tasked with **identifying, reviewing, protecting, and commercializing intellectual property resulting from GSU research** as well as supporting faculty's innovation endeavors (website: <https://research.gsu.edu/georgia-state-technology-transfer/>)

Who is OTTC:

- 4 team members – Director, Licensing Associate (Nathanael McCurley), Legal Counsel (Gwen Spratt), and Operations/Administrative (Cheryl Hibbler)

When to contact OTTC:

- When you have made a **discovery, invention, or some other innovation** that may have commercial use
 - Examples: new drug, existing drug with a new use, diagnostic test, vaccine, biologic (mAb), software, research tool, survey instrument, device, process, etc.

Why contact OTTC:

- OTTC provides guidance to researchers and faculty regarding intellectual property protection, collaborating with industry partners, startup company support and formation, and the transfer of research materials to and from GSU (MTAs)

COVID-19 Research & Intellectual Property

The Challenge:

- Rapid dissemination of data/results is **in the public interest**; faculty are encouraged to disclose findings as soon as possible.
- Public disclosure of new inventions prior to filing of a patent application **limits the ability to protect an invention**
 - Generally it is preferable to file prior to publication.
- We **don't want to slow** sharing valuable findings but **do want to protect IP** – researchers are busy and may not have time to do it all.

OTTC's Approach to coronavirus IP

- Proactively contact COVID-19 researchers when approved for research or when a press release is to issue.
- Ask that faculty provide OTTC with a **draft manuscript/presentation at time of submission, prior to going public.**
 - OTTC will then initiate steps to file a provisional patent application
 - OTTC will follow-up with the faculty member to complete an invention disclosure form post-filing
- Acknowledge we may miss some things along the way due to these unique circumstances.

I've found something interesting, what do I do?

1. Feel free to call or email OTTC with questions.

- Cliff – cmichaels@gsu.edu or 404-413-6687
- Nathanael - nmccurley@gsu.edu or 404-413-3507
- Gwen – gspratt@gsu.edu or 404-413-0500

2. Send any OTTC team member the manuscript or presentation.

- Please copy intellectualproperty@gsu.edu
- Please indicate in the subject line it is related to potential COVID-19 IP
- Please include in the email:
 - A list of the potential contributors/inventors
 - What funding was used (federal grant with numbers, internal funding, contract, etc.)
 - Whether any 3rd party materials obtained under an MTA were used
 - When the expected publication date (estimates are ok).
 - A word version is preferable to a pdf if possible.

What will OTTC do?

- 1. Respond to questions by email and phone in a timely manner.**
- 2. Confirm receipt of manuscript, briefly review, and follow-up with any additional questions.**
- 3. Notify you once a provisional patent application has been filed and provide a reference (case) number to use in the future.**
- 4. Follow up to complete a formal invention disclosure.**
- 5. Over the next 12 months, perform a more thorough review of the invention disclosure.**
 - Provide additional feedback and analysis
 - Make recommendation regarding next steps, example pursue further or allow to expire
 - Not all COVID-19 related filings may continue past initial filing

Does it matter?

- 1. Helps OTTC meet its goal of maximizing the impact of GSU's research endeavors.**
- 2. IP protection can be an incentive for companies to develop and innovate.**
 - Help get a company interested in advancing a treatment, vaccine, diagnostic, etc.
- 3. IP on file helps ensure GSU has a potential role in how the discovery/invention is used or implemented commercially.**
- 4. Helps identify GSU as leader in the space and recognize our efforts underway.**
- 5. Licensing and commercialization strategies for COVID-19 align with public interests. GSU is committed to socially responsible licensing of COVID-19 IP.**
 - Low-No royalty approaches
 - Broad non-exclusive licensing strategies
 - Consortium approaches

What else does OTTC do?

- Educates researchers about IP, TT, & entrepreneurship
- Scout for research results with potential IP for disclosure
- Review & evaluate research disclosures for commercial viability
- Protect and manage IP (e.g., patent, trademark, copyright)
- Market IP
- **Facilitate relationships with industry & the development of start-up companies**
 - **If a company contacts you regarding a COVID-19-related research collaboration or contract – please reach out to OTTC or our colleagues in OSPA or OLA for assistance**
- Negotiate license arrangements for IP
- Monitor existing licenses for compliance both financial and non-financial
- Comply with Federal or research sponsor guidelines for IP
- Assist inventors to secure translational funding to demonstrate proof of concept

Common Links/Needs

- GSU COVID-19 Research FAQs - <https://www.gsu.edu/coronavirus/faculty-and-researchers/>
- OTTC Website - <https://research.gsu.edu/georgia-state-technology-transfer/>
- GSU Invention Disclosure Form - <https://research.gsu.edu/files/2020/04/IP-Disclosure-Form-April-2020-FINAL.docx>
- IP Policy - <https://gsu.policytech.com/?public=true&siteid=1>
- Instruction & forms for requesting MTAs - <https://universityattorney.gsu.edu/intellectual-property/material-agreements/>