BCLP. Client Intelligent

HIGHER EDUCATION TECHNOLOGY DEVELOPMENT & COMMERCIALIZATION

OVERVIEW

University inventions in the pharmaceutical, medical device, biotech, agtech and software domains account nationally for a major share of successfully commercialized innovations. Many university inventions arise in the course of federally funded research generally requiring university ownership of those inventions, while other university inventions arise in the course of industry-academe negotiated sponsored research agreements.

University ownership of faculty inventions (as well as post-doctorate, graduate student inventions), usually under royalty-sharing agreements with inventor faculty), introduce special dynamics into the negotiation and terms of agreements ordinarily used to commercialize those inventions, and into the preparation and prosecution of patent applications. The interaction of University Intellectual Property Policies and the NDAs and IP assignment agreements that faculty are often required to sign in the course of their university-permitted consulting activities can create additional complications for full commercialization of university inventions.

BCLP patent attorneys and patent agents include inventors, scientists and engineers with hands-on experience in key fields of value to the cutting-edge research universities are conducting in the biomedical, agtech, computing and other engineering realms, and they use their technical backgrounds to better understand and protect such research with patents across the world, and to successfully resolve intellectual property disputes with alternative dispute resolution techniques and with litigation, as needed.

Our attorneys are also experienced in navigating the unique equity and non-dilutive financing, conflict of interest, confidentiality, indemnification, diligence and sublicensing control issues that arise in university licensing of both early stage and mature technologies, particularly to faculty startup ventures.

We also are skilled in drafting, revising and counseling on university intellectual property policies, and in conforming university technology transfer and licensing transactions to such policies of each specific university client. We know how to structure industry research support agreements to preserve optimal university discretion in licensing of resulting IP. And, we understand the critical importance to university inventors of preserving their rights and those of their academic colleagues to non-commercial, research use of the IP.

MEET THE TEAM

George C. Chen

Partner, Phoenix

george.chen@bclplaw.com
+1 602 364 7367

Kevin C. Hooper

Partner, New York

kevin.hooper@bclplaw.com
+1 212 541 1266

Lee Marshall

Global Department Leader – Litigation & Investigations, San Francisco

lee.marshall@bclplaw.com
+1 415 675 3444

EXPERIENCE

Our experience of importance in university technology R&D, entrepreneurship and related dispute management includes some of the following:

1. Negotiate and document sponsored research and collaborative research agreements for one of the nation's leading independent medical research institutes, including material transfer agreements, confidentiality agreements, inter-institutional agreements and joint development or commercialization ventures. Also provided strategic patent portfolio counseling and development focused on stem cell technology, therapeutic antibodies and DNA editing technologies, and developed patent portfolio around therapeutic antibodies targeting bone regulation pathways and assisted in the successful licensing of same.

2. Provided strategic patent portfolio counseling and development for Columbia University focused on small molecule and immunotherapeutics for neurodegenerative diseases and cancer. Other work includes pre-litigation assertion analyses related to the University's patent portfolio in the life sciences and out-licensing support for university-developed technology in the neurodegenerative disease and cancer spaces.

3. Out-licensing and in-licensing transactions to faculty startups, independent startups and mature companies, in fields ranging from cutting-edge immunotherapeutics and other biotech and data analytics.

4. Prepare FTO studies, patent infringement and invalidity opinions, prior art analyses to assess the competitive patent environment and value of the new inventions, and infringement allegation investigation.

5. Assist national research university in concluding major licensing and sublicensing transactions involving the commercialization of a novel antibody technology for Alzheimer's Disease.

6. Negotiate and document sponsored research and collaborative research agreements, material transfer agreements, confidentiality agreements, inter-institutional agreements and joint development or commercialization ventures.