

The Ohio State University: Commercializing Your Research at OSU

February 22, 2022

Jason “Jay” Dahlman, Ph.D., CLP (he/him),
Associate Director of Licensing (A&S/CFAES)
Technology Commercialization Office

oied.osu.edu | 614.292.7945 Office | Dahlman.3@osu.edu | [LinkedIn Profile](#)



THE OHIO STATE UNIVERSITY

COLLEGE OF FOOD, AGRICULTURAL,
AND ENVIRONMENTAL SCIENCES

Typical University Developed Intellectual Property

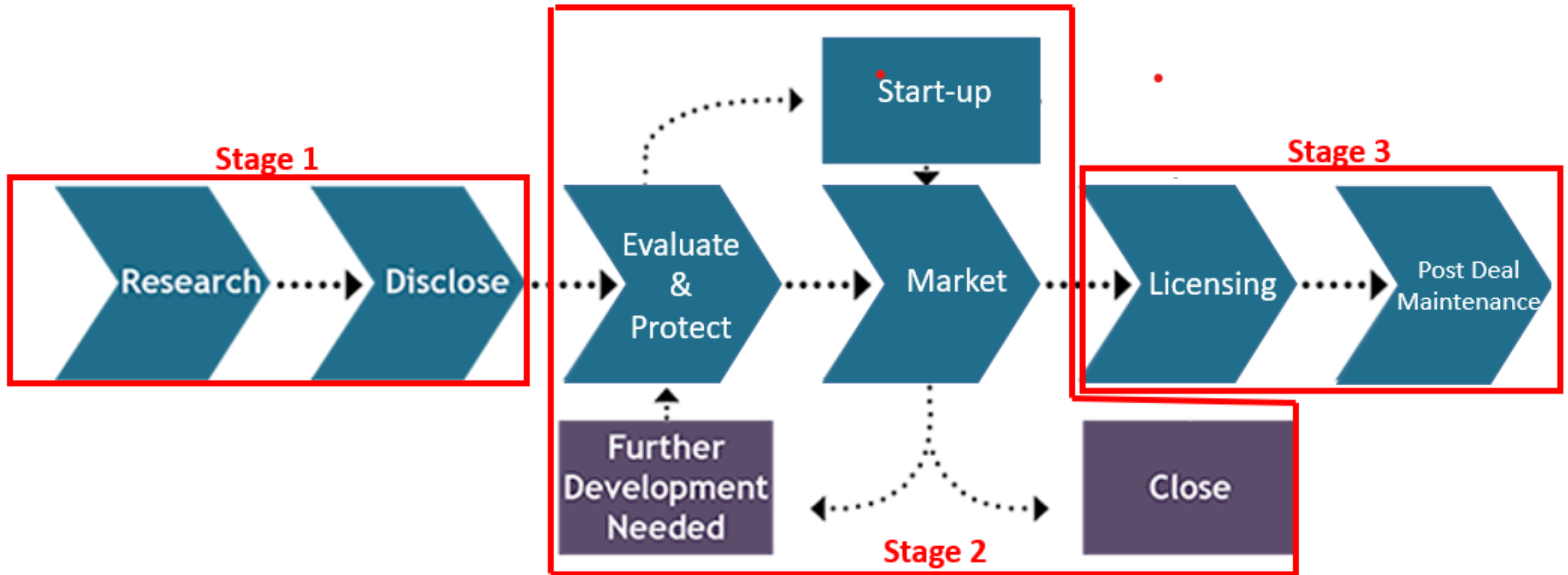
- **Patents** – protect ideas, exclude others from making, using, selling a composition of matter, a method/process of creating or using a composition, manufacturing process, Machines/Devices
- **Copyrights** – protect expression of an idea fixed in tangible medium. Software, Images, Videos
- **Tangible Property**– Research Tools
cell lines, tissue samples, animal models, materials
- **Technical Know how** – what’s in your head...
Unique expertise/knowledge required to maximize use of Patents, Copyrights or Tangible Property

What makes an Invention Patentable?

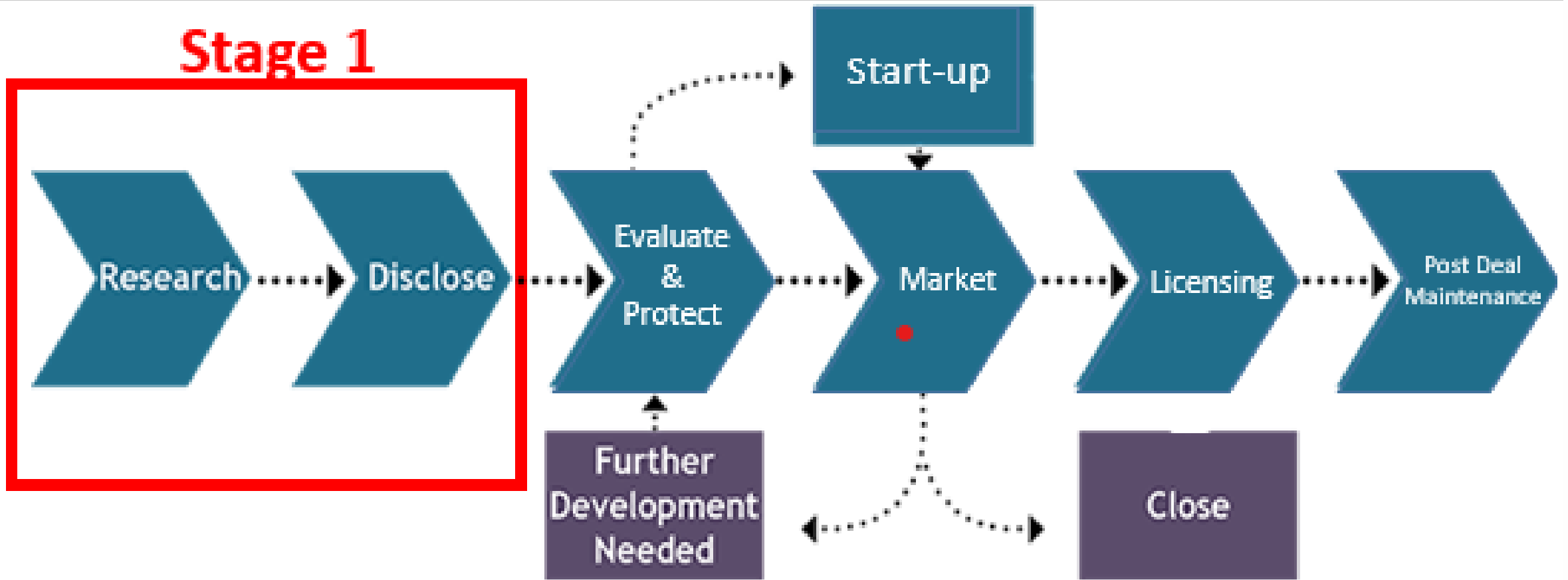
- The invention must be:
- Novel – must be novel in light of the prior art, including the inventor’s own past publications
- Useful – must have some real-world utility
- Non-obvious - must be non-obvious to a person knowledgeable in the field at the time the invention was made
- Also – the invention must be “Enabled” by the written description in the patent application. The invention (including the best mode) must be adequately described to permit one skilled in that field to practice the invention.

Technology Commercialization Services

The Licensing Process



The Licensing Process: Stage One



The Licensing Process: Stage One

Pre-Disclosure conversations (Prior to submitting an Invention Disclosure)

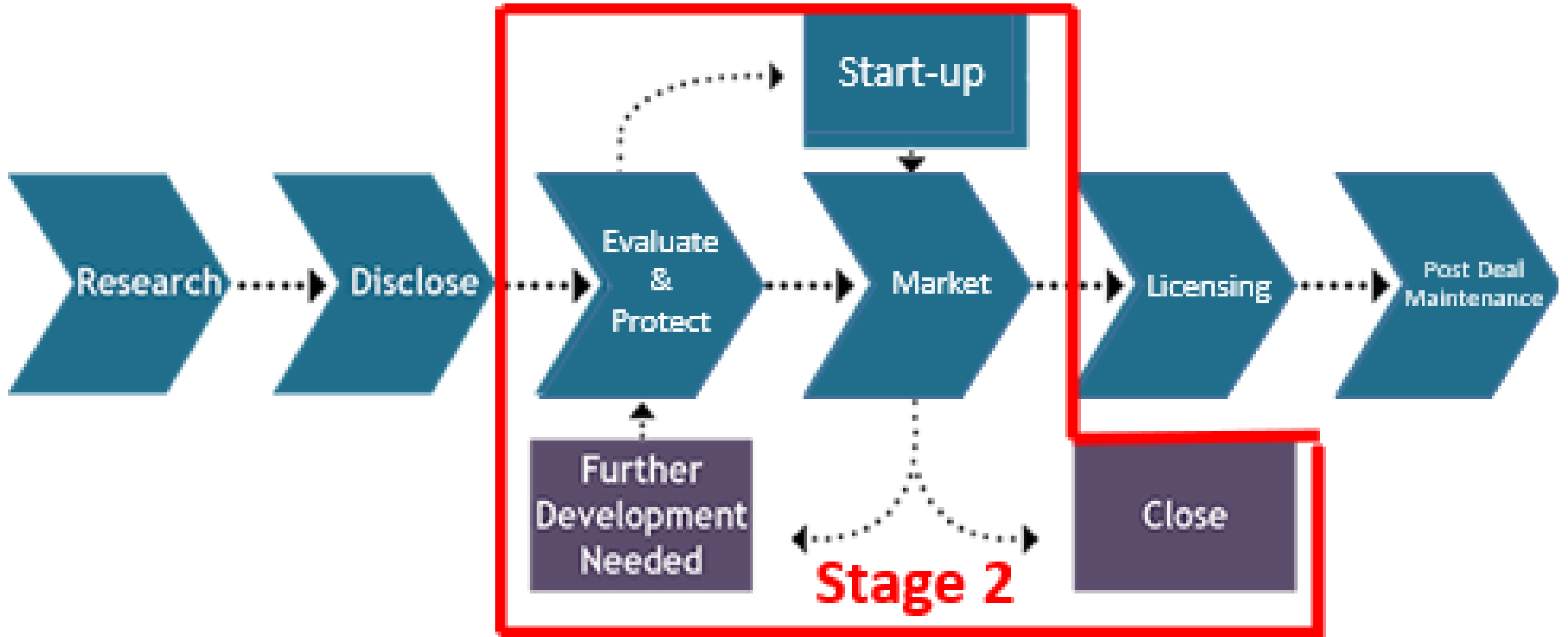
- I think I have an idea that...
 - Reach out to your TCO contact
 - If you don't have a contact reach out to a Licensing Officer (LO)
 - <https://oied.osu.edu/technology-commercialization>
 - You and your Licensing Officer will discuss your idea and develop defined next steps

Submitting an Invention Disclosure Form (IDF)

- I have an idea that...
 - Submit an IDF using the following portal
 - https://innovate.osu.edu/new_form/
 - Once submitted you will be assigned a LO and move to Stage 2



The Licensing Process: Stage Two



The Licensing Process: Stage Two – Evaluate & Protect

You and your LO will review the IDF and discuss commercial applications for the technology

- If a Patent would be needed in order to commercialize your technology
 - LO will perform a prior art search and review findings with you
 - File Provisional application if appropriate
- You and your LO will discuss the Marketing Strategy
 - Reach out to existing companies
 - Create a Start-up



TCO – The Licensing Process: Stage Two – Start-Up

- Keenan Center for Entrepreneurship (KCE) (<https://keenan.osu.edu/>)
 - Provide start-up guidance
 - How does OSU spin out companies?
 - Provide assistance with building the Start-up team
 - Keenan has access to a large network of talent that it can coalesce around a technology
 - Provide the start-up with access to capital (<https://keenan.osu.edu/capital>)
 - SBIR/STTR, TVSF Phase II, Contract Funding, Catalyst Funding, Ohio Innovation Fund
- KCE & TCO will work together with the start-up to move forward to Stage 3

The Licensing Process: Stage Two – Market

- Collaboratively identify and connect with potential partners
- Initiate scientific discussions with inventors and interested partners
- LO works with inventors and partners to move into Stage 3

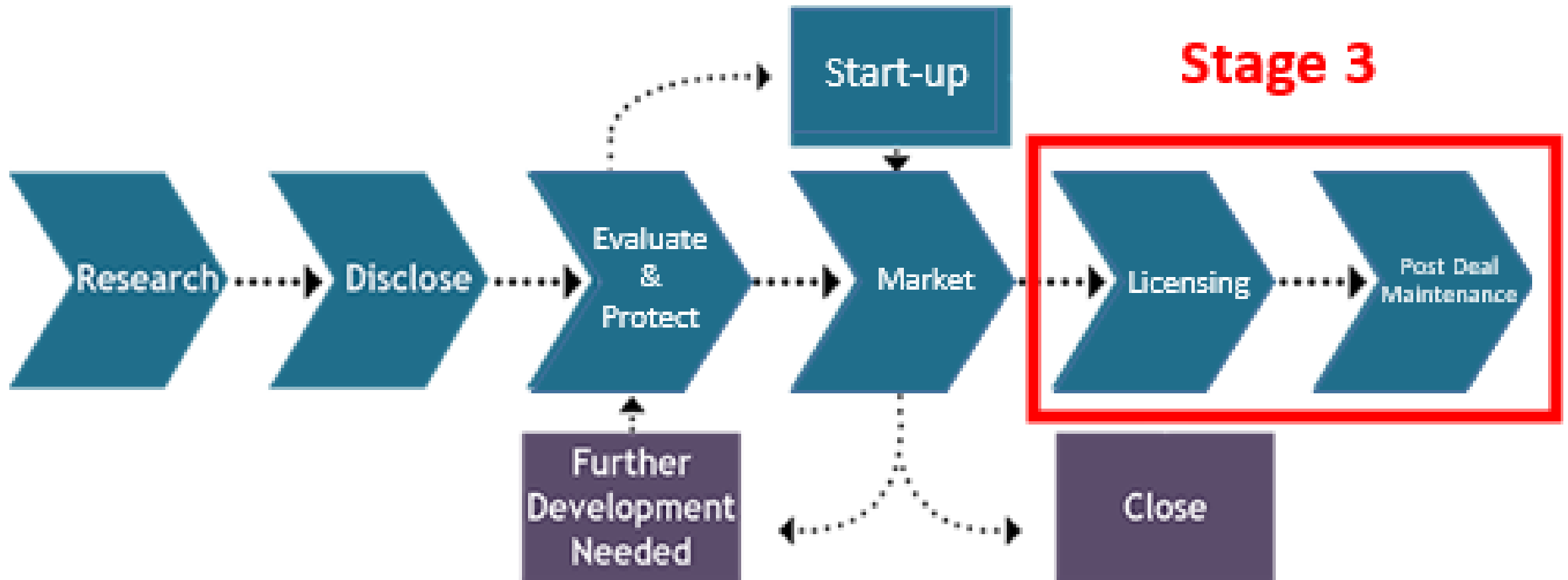
The Licensing Process: Stage Two – Further Development Needed

- Accelerator Awards (<https://keenanoosu.edu/accelerator-awards>)
 - Funding
 - Up to \$100,000 award for non biomedical technologies
 - Up to \$150,000 award for biomedical technologies
 - Eligible Sectors
 - Software/Information Technology
 - Biomedical/Life Sciences
 - Advanced Materials or Manufacturing
 - Sensors
 - Energy
 - Upcoming Deadlines
 - Spring 2022 cycle Pre-proposals due date March 1, 2022

The Licensing Process: Stage Two – Close

- If the technology is unable to progress to Stage 3
 - The technology can be marked as inactive until circumstances change which require the technology to be reactivated
 - New market opportunity emerges, new data is generated that addresses commercialization concerns raised by potential partners
 - Inventors can request assignment of the technology
 - TCO has a standard agreement
 - Your LO can walk you through this process
 - Federally funded technologies have additional requirements that your LO can walk you through

The Licensing Process: Stage Three



The Licensing Process: Stage Three – Licensing

- LO will connect with the inventors to develop an appropriate Licensing Strategy that supports their academic and commercialization goals
 - Exclusive vs. Non-Exclusive
 - Grant worldwide rights or territory specific (US only)
 - Create Field Limitations (limit applications the technology can be used for)
 - Retain rights to perform research, publish, collaborate with
- TCO will lead the licensing negotiations on behalf of OSU
- TCO will provide regular updates on the deal negotiation status



The Licensing Process: Stage Three – Post Deal Maintenance

- Once the License is executed
 - Continue to build relationship with our Licensing partner
 - Could result in...
 - SRA with Partner and Inventors
 - Service and Testing Agreement with Partner and Inventors
 - Consulting Agreement between Partner and Inventors
 - TCO provides guidance on these arrangements
 - Additional licensing opportunities to the Partner



Additional Contract Services from TCO

When to use a CDA

- Anytime you are disclosing detailed information about your invention to someone else, especially if you have not yet filed a patent application
- If you have a new product in development and you need to consult an expert for advice on how to proceed.
- You want to consult with another researcher about unpublished research or an unpatented invention.
- In the context of a collaboration agreement, a CDA should be in place so that both parties agree not to disclose or use information related to the other party's Intellectual Property.



When to use a MTA

- It is necessary to use MTAs whenever a provider wants to share research materials with a recipient (whether it be within the public sector or between the public and private sectors).
- MTAs are critical for protecting the rights of the provider.
- Restricted use provisions
- Ownership provisions
- Ownership of improvements/derivatives provisions



Corporate Partnership Group

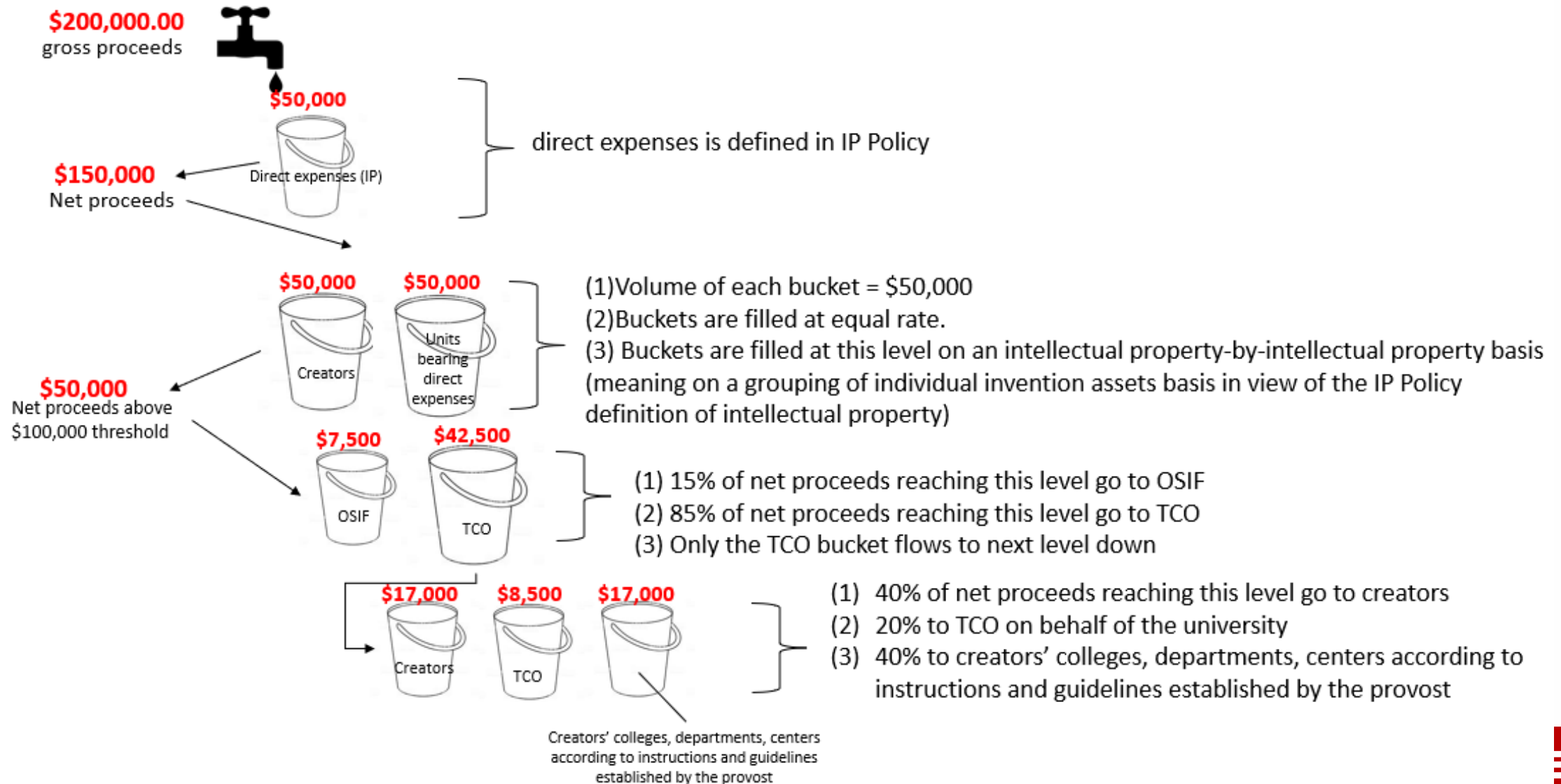
- Assistance with setting up Consortia Agreements
- Assistance with setting up Technology Access Fee Sponsored Research Agreements
- Assistance with setting up Master Research Agreements

OSU Revenue Distribution Policy

OSU Revenue Distribution Policy Breakdown

Net Proceeds	Distribution
Of first \$100,000 of net proceeds (where net proceeds is akin to licensing income under current policy)	50% to creators 50% to the units that have borne direct expenses of commercialization (currently this is TCO)
After first \$100,000 of net proceeds	15% to Ohio State Innovation Foundation (OSIF)
Following distribution to OSIF	Following distribution to OSIF

Distribution of gross proceeds received by OSIF



Distribution of gross proceeds received by OSIF – Tier One

- Gross Proceeds = \$200,000.00
- \$50,000.00 goes to direct expenses (IP) defined in the IP policy, leaving \$150,000.00 as net proceeds.
- Of the net proceeds, \$50,000.00 goes to creators and \$50,000.00 to units bearing the direct expenses.
- Volume of each bucket = \$50,000
- Buckets are filled at equal rate.
- Buckets are filled at this level on an intellectual property-by-intellectual property basis (meaning on a grouping of individual invention assets basis in view of the IP Policy definition of intellectual property)

Distribution of gross proceeds received by OSIF – Tier Two

- \$50,000.00 is left, net proceeds above the \$100,000.00 threshold so \$7,500.00 goes to OSIF and \$42,500.00 goes to TCO.
- 15% of net proceeds reaching this level go to OSIF
- 85% of net proceeds reaching this level go to TCO
- Only the TCO bucket flows to next level down

Distribution of gross proceeds received by OSIF – Tier Three

- Of the \$42,500.00, \$17,000.000 goes to creators, \$8,500.00 to TCO and \$17,000.00 to Creators' colleges, departments, centers according to instructions and guidelines established by the provost
- 40% of net proceeds reaching this level go to creators
- 20% to TCO on behalf of the university
- 40% to creators' colleges, departments, centers according to instructions and guidelines established by the provost