BCLP. Client Intelligent

UNIVERSITY TECHNOLOGY DEVELOPMENT, IP PROTECTION AND 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 principal invention or other 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 (as well as into the preparation and prosecution of patent applications).

Bryan Cave's attorneys are 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. Bryan Cave's attorneys 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; they know how to structure industry research support agreements to preserve optimal university discretion in licensing of resulting IP; and they 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.

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

WITH RESPECT TO TECHNOLOGY TRANSFER:

- Out-licensing and in-licensing transactions, to faculty startups, independent startups and mature companies, ranging from biotech and data analytics to golf club technology
- Sponsored research and collaborative research agreements; material transfer agreements
- Clinical trial contracting
- Inter-institutional agreements and joint development or commercialization ventures
- Designing and negotiating SaaS agreements
- Creating innovative technology development programs and partnerships
- Assessing and managing export controls and other compliance risks attendant to the conduct of sponsored research and in-licensing transactions
- Counseling on the conflict of interest implications of technology transfer arrangements

WITH RESPECT TO PROTECTION OF NEW INVENTIONS:

- Developing and executing patent procurement or enforcement and trade secret strategies
- “FTO” studies, patent infringement and invalidity opinions, prior art analyses to assess the competitive patent environment and value of the new invention, and infringement allegation investigation
- Confidentiality, non-competition, consulting and other services contracts
- Counseling on patent infringement concerns and allegations
- Patent litigation

MEET THE TEAM

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