

# Working with University Tech Transfer Offices

---

**Michael Chambers, J.D., Ph.D.**  
**Associate Vice President for Research**  
**Director & PI, NSF I-Corps Site**  
**Site Director & PI, CARFS (NSF IUCRC)**

**Former:**

**Co-Founder & CEO: InnoRx Pharmaceuticals**

**Co-Founder & CEO: Swift Biotech**

**Chairman of the Board: ProUroCare (NASDAQ)**



UNIVERSITY OF  
SOUTH ALABAMA

# Challenges: Change & Speed

---

Aviation & Aerospace

Life Span

Medicine

Computing

# Consequences....

---

**Work Faster**

**Work Smarter**

**Know the Market**

**Deliver What Customers Want**

# Tech Transfer

🏠 OCIC Home

Office of Research and Economic  
Development Home

About Us

Available Technologies

Core Research Competencies

Resources

Office of Commercialization and Industry  
Collaboration  
775 University Blvd. N.  
Bldg. II, Ste. 150  
Mobile, AL 36608-0002  
📞 Ph: (251) 460-7932  
📠 Fax: (251) 461-1774  
[ott@southalabama.edu](mailto:ott@southalabama.edu)

## Office of Commercialization and Industry Collaboration (OCIC)

The OCIC is responsible for managing the intellectual property assets of the University of South Alabama, while also serving as the point of contact for industry collaboration partners. We orchestrate the cooperation between university, industry and government stakeholders to develop faculty inventions into products on the market. Although patentable inventions constitute the majority of OCIC's licensing activities, we also handle copyright, Tangible Research Property, Material Transfer Agreements, and Confidential Disclosure Agreements.



### Submit Invention Disclosure

Disclosing your invention is just the beginning of the path to commercialization.



### Commercialization Roadmap

Use our commercialization roadmap to track the progress of your invention



### Search Technologies

Explore our technology portfolio and contact us for additional information.

# Tech Transfer: One Stop Shop

---

- Available Seminars
- Frequently Asked Questions
- For Entrepreneurs
- Material Transfer Agreements
- Student Research Agreement
- Policies
- Commercialization Roadmap

# How Can Tech Transfer Help?

---

**Patentability/ Copyrights/ Know-How**

**Barriers to Entry**

**Commercial Assessments**

**Market, Size and Competition**

**Industry Contacts**

**Specific Help Areas:**

**General Advice:  
L&Ls**

**Invention  
Disclosures**

**NDAs/CDAs**

**License Templates**

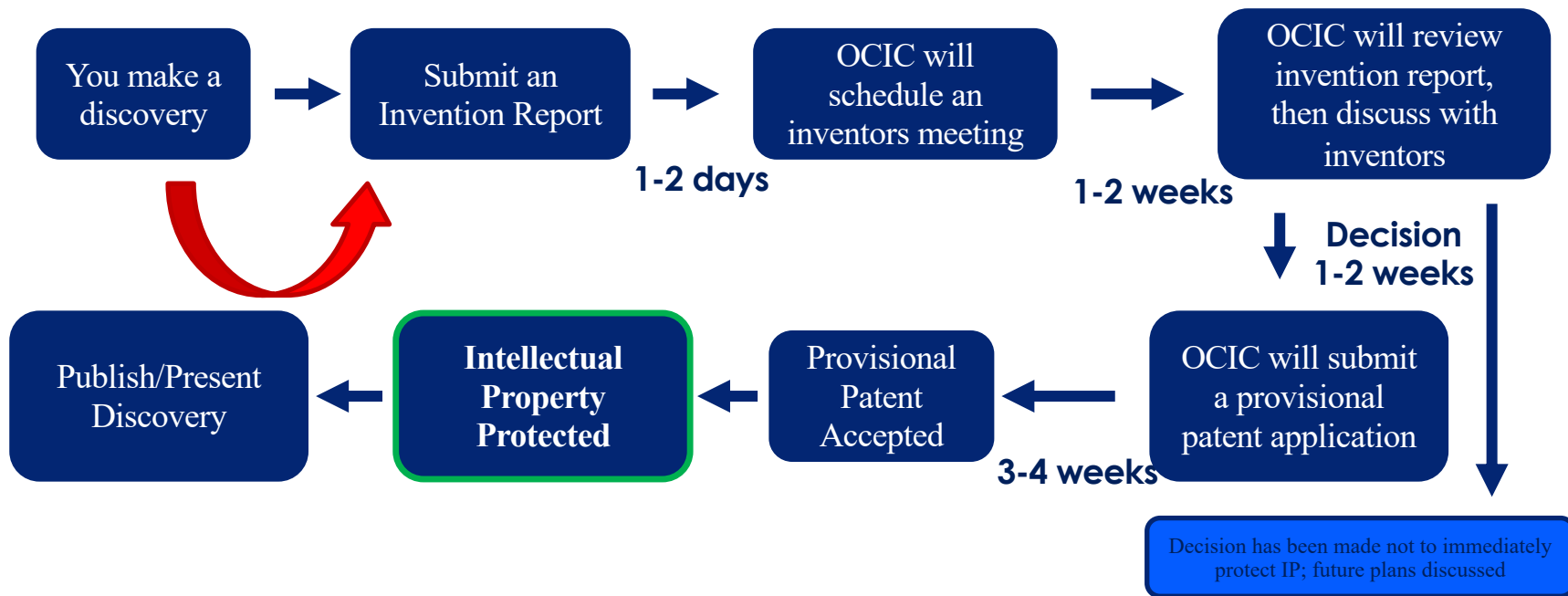
**Programming**

**Funding Sources**





# Invention Disclosure Process



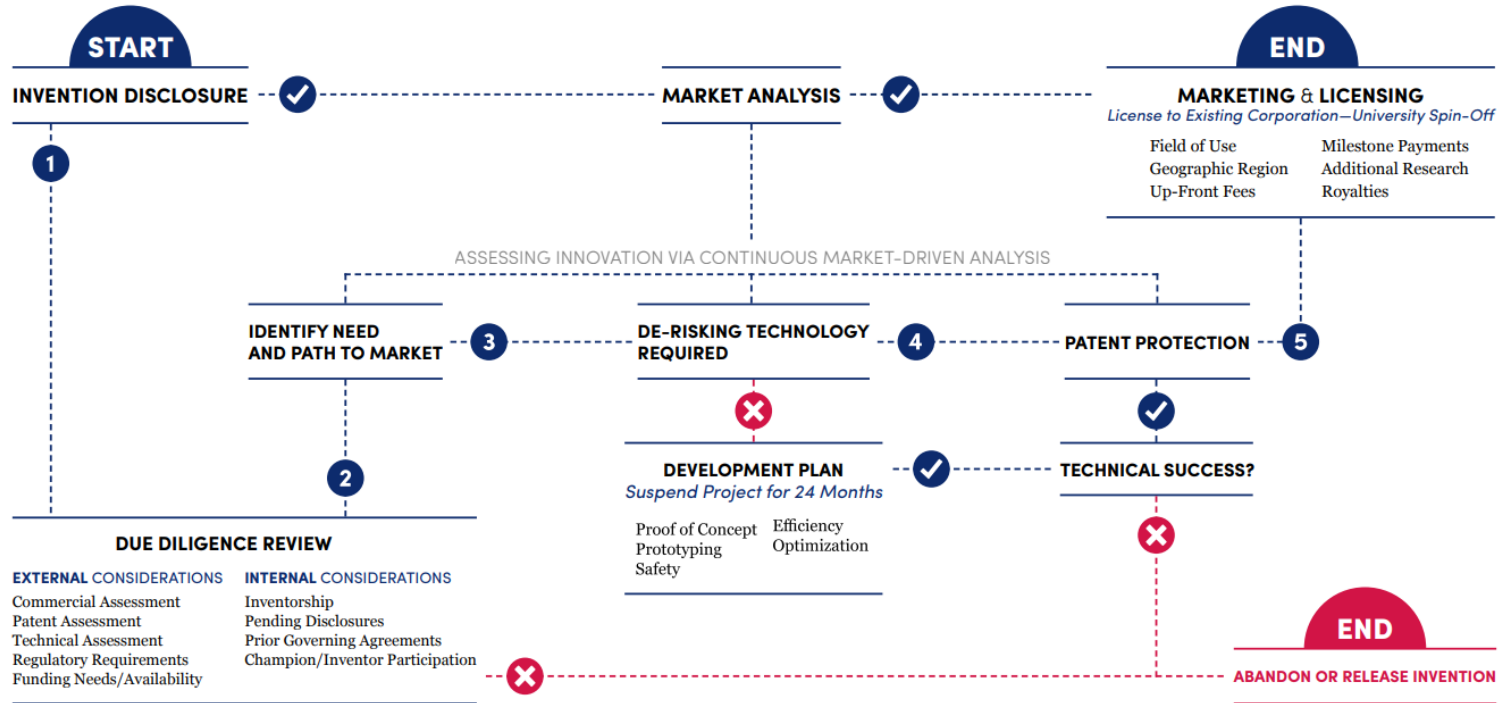
UNIVERSITY OF SOUTH ALABAMA  
COMMERCIALIZATION AND  
INDUSTRY COLLABORATION

Inventor Portal can be found at  
<https://southalabama.inteum.com/southalabama/inventorportal/login.aspx>





# Commercialization Roadmap



UNIVERSITY OF SOUTH ALABAMA  
COMMERCIALIZATION AND  
INDUSTRY COLLABORATION

251.460.7932

techtransfer@southalabama.edu

775 University Blvd, Building 2 Suite 150; Mobile, AL 36608

<https://www.southalabama.edu/departments/research/ocic/>

# USA Revenue Distribution Summary



## Patented Assets

	50%	20%	30%	0%
\$10,000-\$50,000	50%	20%	30%	0%
\$50,000 and up	30%	20%	30%	20%

## Tangible Research Property

Inventor's Lab	90%
USA Innovation Investment Fund	10%



UNIVERSITY OF SOUTH ALABAMA  
COMMERCIALIZATION AND  
INDUSTRY COLLABORATION

251.460.7932

[techtransfer@southalabama.edu](mailto:techtransfer@southalabama.edu)

775 University Blvd, Building 2 Suite 150; Mobile, AL 36608

<https://www.southalabama.edu/departments/research/ocic/>



**Ownership of Intellectual  
Property**

**Employee Status**

**Inventorship vs. Ownership**

**Critical Documents**

**Faculty Handbook**

**Specific University Policy**

**Employment Contract**

**Promotion & Tenure Policy**

# What About Student Inventions?

---

## 4.9 Student Inventions

Inventions made by students, (a) *in the Course of Employment or Affiliation with the University*, or (b) in the conduct of research in University laboratories as part of a post-baccalaureate or postdoctoral degree or non-degree program, or (c) resulting from work directly related to the student's employment or research responsibilities at the University, or (d) from work performed under a grant or other sponsorship, or faculty-directed research or work shall be the property of the University and shall be subject to this policy.

# One Path: License to 3<sup>rd</sup> Party

---

## License Agreement:

- Scope
- Milestones
- Royalty Stream

## Involvement of Inventors

- Consultant?
- Conflict Issues?

# Another Path: Start-Up

---

**License Agreement:**

**Scope: Limited?**

**Milestones: Tighter?**

**Royalty Stream: Higher?**

**Patent Expenses?**

**Your Start-Up?**

**Your Involvement?**

**Conflict Issues?**



**Commercialize?**

**NSF Mission**

**Broader Impacts**

**Big Ideas**

**Promotion/Tenure**

**Money**





# Case Study Scenarios

---



## Scenario 1

---

**Professor Smith has learned that some business training might be available through a program on campus called I-Corps. Describe I-Corps and why it would be a good idea for him to participate.**

# I-Corps: Innovation Scholars



**National Science Foundation Program & Grant**

**8 Weeks: Credit or Non-Credit/ Based on Customer Discovery**

**Student Teams: Best with Faculty Mentor/ Industry Representative**

**\$5,000 Per Team: Travel, Materials & Supplies**

**Innovation Scholar Certificate**



**Business Model Canvas**

# **Business Model Canvas**

  
**Key Partners**

  
**Key Activities**

  
**Value Propositions**

  
**Customer Relationships**

  
**Customer Segments**

  
**Key Resources**

  
**Channels**

  
**Cost Structure**

  
**Revenue Streams**

<http://www.businessmodelgeneration.com>

## Scenario 2

---

**Professor Smith is working on an anti-malware software. Google would like to license the technology. He perfected the software at his current school, Hacker State University (HSU), but created the preliminary version at his former university, Red Team State. The critical breakthrough came from the work of his unpaid intern, an undergraduate student, who did the work at home on his personal computer. Smith's attorney thinks the work done by his undergraduate assistant may lend itself to a patent.**

## Scenario 3

---

**Professor Smith develops a suite of anti-malware tools. His attorney tells him that the collection might be able to secure a patent. Prior to talking to his attorney, he wrote and published an abstract that specifically described the key elements of the tech. He is not worried because he recalls that he has one year to file a patent application. Are there any issues related to patenting the technology?**

## Scenario 4

---

**Professor Smith wants to get rich fast. He has convinced two of his top students, Bubba and Buffy, to form a new start-up company and license the technology from him. He licensed the technology to the new company, negotiated a 10% royalty and secured 80% of the equity in the new company, non-dilutable.**

## Scenario 5

---

**Professor Smith is very proud of his graduate student, Hacker Hank. He decides to give him 50% of the stock of the start up company. Hank later decides to move and pursue a Ph.D. at a competing institution, working for the arch nemesis of Prof. Smith. In fact, Hank and his new doctoral advisor decide to take the core research and attempt to take it to the next level. Prof. Smith is furious and decides to cancel all of Hank's stock.**

# Biggest Mistakes

---

**Failure to Manage Invention**

**Disclosure**

**Commitments But No Authority**

**Not Working with Tech Transfer**





UNIVERSITY OF  
SOUTH ALABAMA



Thank You!

Michael Chambers, J.D., Ph.D.

[michaelchambers@southalabama.edu](mailto:michaelchambers@southalabama.edu)



For your next trip to the Gulf Coast....