

Session 17 : Understanding the activities of a TTO

**Building awareness, Effective communication, Relationship
with inventors, Effective IP protection and management**

John Fraser, Premnath V

Who's Speaking



John Fraser
CLP, RTTP

John is a global expert in technology transfer and knowledge exchange, with extensive experience in maximizing innovation impact. Having led four technology transfer offices across two countries, he understands the complexities of translating research into market-ready products. As a former AUTM President, he has advised global technology transfer professionals on country-specific challenges. Through Burnside Development, he consults for WIPO, Chilean institutions, Serbia's Innovation Foundation, and India's Department of Biotechnology.

Affiliation

- Past President Association of University Technology Managers, USA (AUTM)
- President, Burnside Development & Associates LLC
- Head of Tech Transfer for Florida State University & Simon Fraser University



@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Who's Speaking



Premnath Venugopalan PhD, RTTP, FSTEM

Dr. Premnath, Director of Venture Center and Head of NCL Innovations, is a leader in technology transfer, IP commercialization, and venture creation. He has shaped national policies and established award-winning innovation management initiatives, fostering technology commercialization, startups, and deep-tech incubation across India through CSIR-NCL and Venture Center.

Affiliation

- Director, Venture Center, Pune



@ Technology Transfer in Practice | Copyright, Venture Center, 2025

John Fraser slides

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Understanding the activities of a TTO

- ▶ Building awareness
 - Effective Communication
 - Relationships with Inventors
 - Building pipeline
 - Effective IP Protection and Management

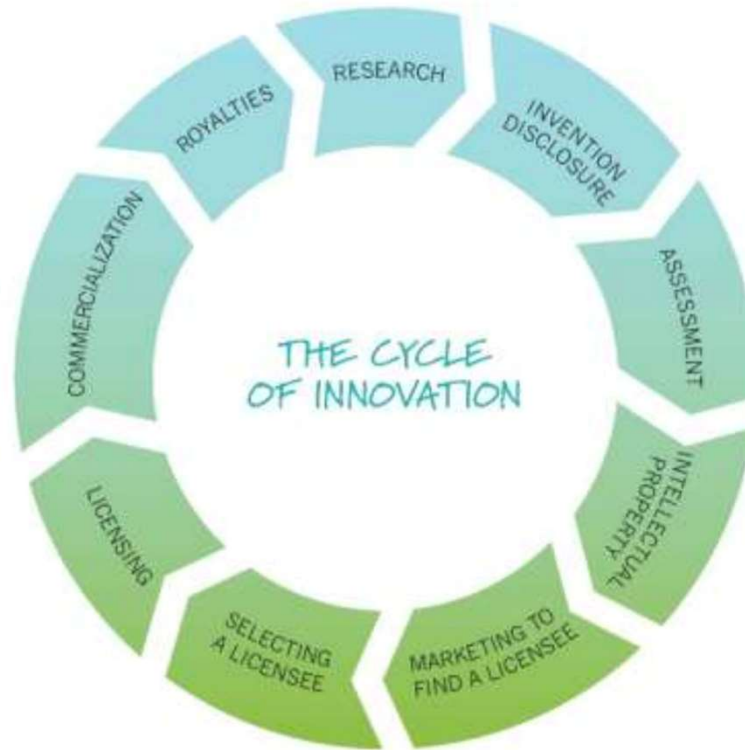
Building awareness

- › Create a program of regular OUTREACH activities – departmental visits, an on-campus showcase; Newsletter with project summaries, etc.;
- Showcase faculty TT achievements;
- Some large US U's pay a small retainer to faculty in large STEM Departments to serve as TT scouts (retainer paid with purchases of research consumables);
- Some large US U's set up office hours in STEM buildings on a monthly basis.
- TTOs are increasingly assisting faculty with SHAPE projects from non-STEM departments. The UK is a leader in this area.

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

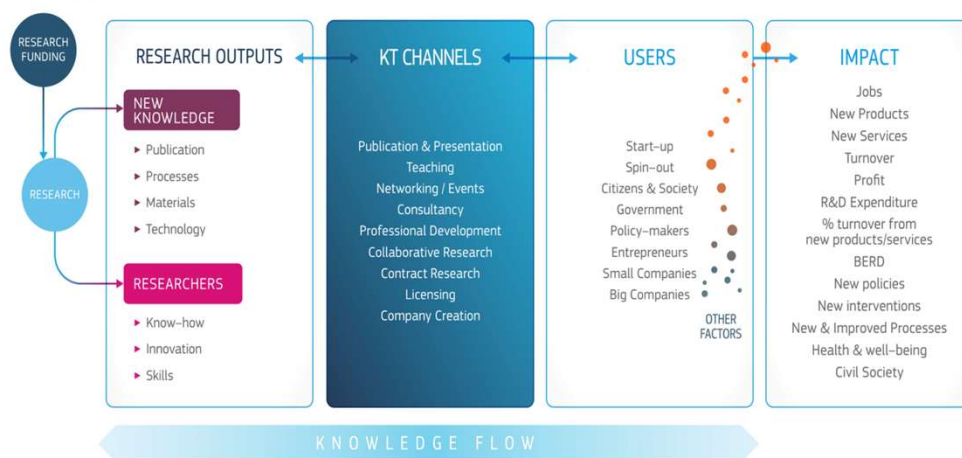
Effective Communication TOOLS

@ Technology Transfer in Practice | Copyright, Venture Center, 2025



“KNOWLEDGE TRANSFER METRICS” Towards a European-wide set of Harmonised indicators. Alison Campbell, Chair

Figure 1: Knowledge Transfer: from research to impact



- 1 There are several terms in use to describe the processes of knowledge valorisation. Knowledge Transfer (KT) and Knowledge & Technology Transfer (KTT) are often interchangeable. Technology Transfer (TT) tends to refer to research commercialisation and may be considered a subset of KT. This report will use the KT terminology.
- 2 Publicly Funded Research Organisations (PROs) includes universities, colleges and other governmentally research institutions. The term PRO is used in this report.
- 3 Available at: <http://www.innovationbycollaboration.se/wp-content/uploads/2015/09/Kevin-Cullen.pdf>

FUTURES CASHFLOW in Agreements

Faculty	Title	Licensee
Connor	Assessment 2 Instructions software	Rubicon Partners, LLC
Rodgers	software	LECO Corporation
Foorman	software	Lexia Learning, Inc.
Bhide	ADHD therepeutic	Avekshan, LLC
Megraw	CDK5RAP2 antibody	Millipore Corporation
Hurt and Rizkallah	Cell Stage Identifier Antibodies Assay and treatment technologies for	Millipore Corporation
Tang	Hepatitis C virus	BioFront Technologies
Roux	Various nut allergens	BioFront Technologies
Roux	Human IgE Protein	KeraFAST
Kumar, S.	Live Tissue Preservation Chamber	KeraFAST
Lee, C.	Circadian Rhythm antibodies	KeraFAST
Blaber, M.	HGF-1 Protein; Mouse KLK-1 Recombinant	KeraFAST
Blaber, M.	Human Growth Factor research	Trefoil, E&B
Lemmon	software	Nidus
Chatterjee, J	Analyte diagnostic device	G5 Engineering Solutions
Olcese	Preterm birth technologies	KynderMed, LLC
Zhang, J.	Chemotherapy regimen selection	Innomedicine, LLC
Zhang, J.	Data mining technology	Insilicom, LLC

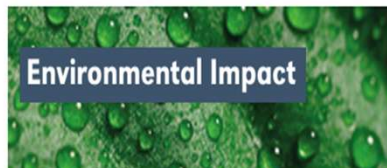
FY 2015		
15 Royalties	15 Grants	15 Other
25,000		
beta test license		253,934.44
not a license	345,344	
\$ 100.00		
\$ 200.00		
\$ 200.00		
\$ -		
\$ -		
\$ 200.00		
15,000		Option fee
not a license		
not a license		
not a license		
not a license		
not a license		

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

FSU Product Pipeline 2005						
260 Invention Disclosed; 320 Provisional/Utility Patent Apps; 143 US Patents since FY 1995 75 CDA's completed; 22 Deal Opportunities*						
PRODUCT	LICENSEE	APPLICATION	PRE-LICENSE	LICENSED TO CORPORATIONS		
				Product Development	In Market	Terminated
EDUCATION						
Job Skills Education Program (JSE)	NCS Pearson Publishing	basic job skills army training				
WebPath	FSU	medical pathology				
FI Center Academic Advisory Serv	State of Florida	high school - university				
Partners for Healthy Baby Books	FSU	early child care				
Womens' Self Esteem Book	FSU	consumers				
Science Tobacco & You	TSI	grade 4 - 8 science education				
MagLab Alpha	Sempco Inc.	grade 4 - 8				
Ethics Course	LearnSomething.com	state government				
PHARMACEUTICAL						
synthetic-Human Growth Factor	GAP Funding	tissue growth				
Taxol analogs	Taxolog (S)	cancer				
Metronidazole	SDR Pharma	antibiotic - vs ulcers				
Metronidazole	SDR Pharma	Xray radiosensitizer				
Taxol production method	Bristol-Myers Squibb	cancer				
MEDICAL DEVICES						
Mad Cow Disease Diagnostic	GAP Funding	Food Industry				
magnetic separations of proteins	Nanomagnetics & Biotech Inc (S)	heart attack confirmation				
tree nut allergens	BioMay	allergy diagnostic				
Pacifier Activated Lullaby	GE Medical/Ohmeda	neonatal units-Hospitals				
INFORMATION TECHNOLOGIES						
Face Recognition Systems	GAP Funding	Security				
DQS queuing software	Genias/SUN	software				
Career Portfolio	UCSD; Georgia Tech; Goldwater	student career advice				
Superensemble Forecasting	WP Inc.	weather forecasting				
Florist Software	FSU	Security, Flowershop				
FSU Smart Card	Cybermark	Security, Identification				
OTHER						
Neural network	SUTI	data mining				
Seminole Fight Song Sheet Music	Arrangers Publishing	School Spirit				
StratoSequence Robot	Nanostrata (S)	Research Tool				
PAUP Software	Sinauer Publishing	Research Tool				
FT-CRT	FSU	Petroleum analysis				
T.E.S.T.	TTAN Inc.	Tabletop Exercise Simulation				
Disaster Housing Resource On-Lin	FEMA	Disaster housing dbase				
Electron resonance spin device	Kyo-Spin (S)	ERS device components				
Diagnostic Camera System	Software AG	webenabling CICS legacy dbases				
Cocktail Neck Ties	Integrated Design Tools (S)	Research Tool				
	Stonehenge	Clothing				
(S) = FSU start-up company Internal FSU Development External Development Product Development In Market Terminated - company started based on FSU technology, expertise - disclosure, IP protected, GAP Funding to define commercial collaboration in place - disclosure, IP protected, developed by industry/ Not GAP Funding - licensed, company working on product development - product in marketplace - no longer being sold in market						
* Includes status 3 (prospect identified) and status 4 (deal outstanding) from OIPDC Summary Sheets						
last updated - 1/23/2006						

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Types of Research Impact: UK Definition



The above categories/definitions cover all types of research: Social Sciences, Humanities, Arts Economics SHARE), and STEM and other non-STEM areas in the U.K.

@ Technology Transfer in Practice | Copyright, Venture Center, 2025



Expanding the Metrics System for University Technology Transfer and Licensing



A case study in analyzing a technology licensing portfolio measuring academic, societal, economic and financial impacts

✎ Impacts to date and estimated future impacts

✎ Rankings based on set criteria within distinct categories

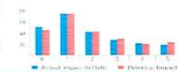
ACADEMIC IMPACT

Criteria

- Number of students trained during technology development
- Number of publications based on the technology, and impact rating of journals
- Level of R&D funding stimulated by the technology
- Ability to further assist future innovation and academic progress

Findings

- Is most commonly the highest potential impact
- Potential impact frequently realized at time of licensing
- Demonstrates that technology commercialization is not at expense of academic value



ECONOMIC IMPACT

Criteria

- Number of employees in spin-off and affiliated companies
- Total revenues of spin-off and affiliated companies
- Revenues generated from licensed technology in non spin-off or affiliated companies

Findings

- Half of the licensed technologies realize their potential impact after approximately five years
- Most licenses have a low economic impact, a small number have a very significant impact



FINANCIAL IMPACT

Criteria

- Level of annual royalties or other payments received from the licensing arrangement
- Value of equity holdings in the licensee company

Findings

- The majority of licensing revenue is derived from a small number of licenses
- Licensing of technologies is not chiefly motivated by potential financial returns



SOCIETAL IMPACT

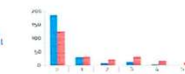
Several subcategories including human health, animal health, the environment, sustainability, lifestyle and business practices.

Criteria

- Seriousness of the issue being addressed – i.e. life-threatening, debilitating etc.
- Prevalence of the problem
- Role of the technology in lessening the threat or prevalence of the issue

Findings

- For licensed technologies whose greatest potential impact is societal, it takes 15-20 years for half of these licenses to reach their potential
- Therapeutics frequently offer the greatest potential impact in our portfolio



ENVIRONMENTAL BENCHMARKING

5 (outstanding)	Technology that is having a significant impact on reduction in air, water, or ground pollution on a global, continental, or national scale.
4 (excellent)	Technology that is having a significant impact on reduction in air, water, or ground pollution on a local or niche scale.
3 (good)	Incremental technology with a high impact in pollution reduction, likely a less polluting alternative.
2 (fair)	Technology that has a significant impact on reduction in air, water, or ground pollution on a local scale (e.g. site specific bioremediation, limited number of affected sites).
1 (minor)	Some level of impact in pollution reduction.
0 (negligible)	No environmental benefit.

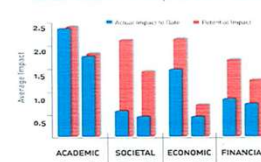
HUMAN HEALTH BENCHMARKING

5 (outstanding)	Product for cure or significant alleviation of a life-threatening or severely disabling condition with a prevalence in excess of 100 million people worldwide.
4 (excellent)	Product for the cure or significant alleviation of an orphan disease.
3 (good)	Product for the cure or significant alleviation of a life-threatening or severely disabling condition with a prevalence of less than 100 million people worldwide.
2 (fair)	Product for the cure or significant alleviation of a disease of typically moderate severity or societal impact (e.g. diabetes).
1 (minor)	Product for the alleviation of symptoms of non-fatal, low societal impact, medical conditions (e.g. male pattern baldness, acne).
0 (negligible)	No implications for human health either directly or indirectly.

SPIN-OFF COMPANY IMPACTS

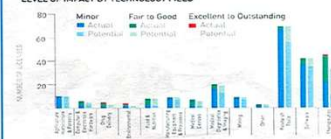
Findings

- Licensed technologies that form the basis of spin-off companies have greater actual and potential impacts across the board when compared to other licenses

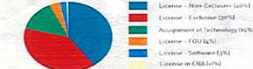


PORTFOLIO COMPOSITION

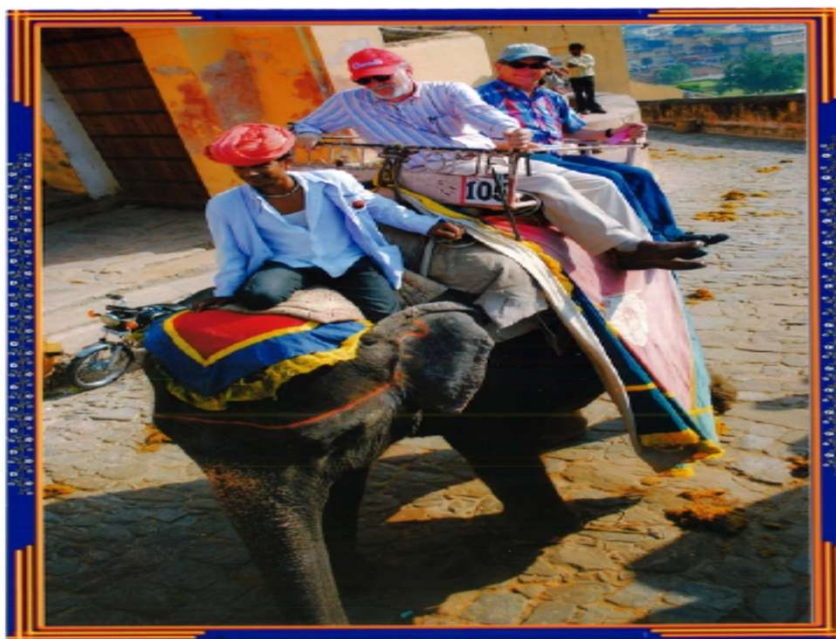
LEVEL OF IMPACT BY TECHNOLOGY FIELD



LICENSE TYPES



@ Technology Transfer in Practice | Copyright, Venture Center, 2025



@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Relationships with Inventors

- › At some point it is usually worthwhile creating an interactive database for all projects, accessible to all staff and for faculty to access their own projects. This allows busy Inventors to access the latest progress on their technology when they want, perhaps in the middle of the night.
- Touch base with each Inventor on a somewhat regular basis to determine how the relationship is working (or not working). Take Action !
- Satisfied Inventors will encourage other researchers to disclose.

Building pipeline

- › In the US, there is an obligation to disclose possible inventions arising from federal grants, but no consequence for nondisclosure.
- Researchers will be forthcoming with discussions about disclosures, if they believe that the TTO can advance their research careers in an effective manner and help achieve results.
- Most IP Policies pay \$500 to the Inventor group upon a US Patent filing, pay for commercialization activities, and share the Royalty compensation (if any) typically on a 1/3 (inventor); 1/3 (administrative unit); 1/3 (institution) share. FSU is 40%/60% for Patents and 50/50 for Copyright licenses.

Effective IP Protection and Management

- › This is a straightforward process, familiar to most in the audience, so I will not spend a lot of time on it.
- › At FSU, we had a Policy to:
 - Submit Provisional Patent applications 80% of the time.
 - Convert the provisional to a regular Patent application, 70% of the time , or 80% X 70% = 50% patent applications/disclosures.
 - Opportunities were marketed upon submitting Provisionals.
 - Lita Nelson of MIT and Kathy Ku of Stanford held the view that most disclosures were 5 years ahead of Industry's ability to use them.
 - Most US TTOs filed in the US and foreign PCT initial phase occasionally if a start-up company was being considered. Full foreign filings happened only if the Licensee paid.
 - Many TTOs continue to pay for the granted Patent until 7.5 years after the grant at which point there is a USPTO Maintenance fee to be paid. If no Licensee interest by that time, many TTOs do not pay the 7.5 year Fee.

THANK YOU for LISTENING !

John Fraser, President
Burnside Development & Assoc LLC

Moab , Utah, USA

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Premnath V slides

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Effective IP Protection & Management

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Proactively filing patents: Why?

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Proactively identifying inventions and filing patents -- The motivation:

- Credit of being the originator
- Creating property (ownership, ability to exclude others, transactable)
- Ability to guide/ control the future development of the invention
- Ability to attract resources/ talent for further development of invention
- Indicator of inventive potential
- Rankings, recognitions, etc

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Alert:

Most researchers who pursue technology commercialization pursue it to see their **ideas reach fruition, realize their own full potential and get satisfaction.**

Most institutions who promote technology commercialization do it to meet their **socio-economic mandate** of the organization and to demonstrate **significant diffusional impact.** Ex – Boston/SV area institutions

Direct financial returns to people or institutions is rarely the goal. It is an occasional happy by-product.

NIRF Innovation: Parameter 7



NIRF Innovation Ranking Framework: 7 Parameters & 22 Key Indicators		Weightage	%
Parameter 7: Intellectual Property (IP), Generation and Commercialization (Annual Calendar 2020 & 2021):		0.25	100
7.1	Number of Copyrights/Designs Obtained during the Annual Calendar Year 2020 & 2021		15
7.2	Number of Patents Filed during the Annual Calendar Year 2020 & 2021		15
7.3	Number of Patents Published during the Annual Calendar Year 2020 & 2021		20
7.4	Number of Patents Granted during the Annual Calendar Year:2020 & 2021		25
7.5	Number of Technologies (Patents/Non-Patents) Commercialized/Transferred during the Financial Year 2020-21 and 2021-22		25
Total		1.00	700.00

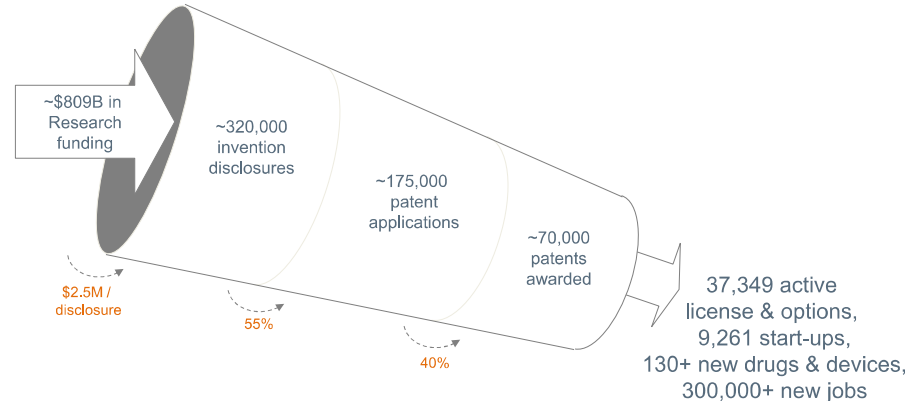
@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Lesson: Innovation is a portfolio activity. It is difficult to pick winners upfront!

- Example: Google
- Example: Tesla
- Example: Ather

Investment in innovation should not be treated as an investment in a production process. It is like an investment in a defense forces. It is done to create “options”.

Where Do Universities Play in This Space *Cumulative Inputs and Outputs, 1991 – 2014, US Universities*



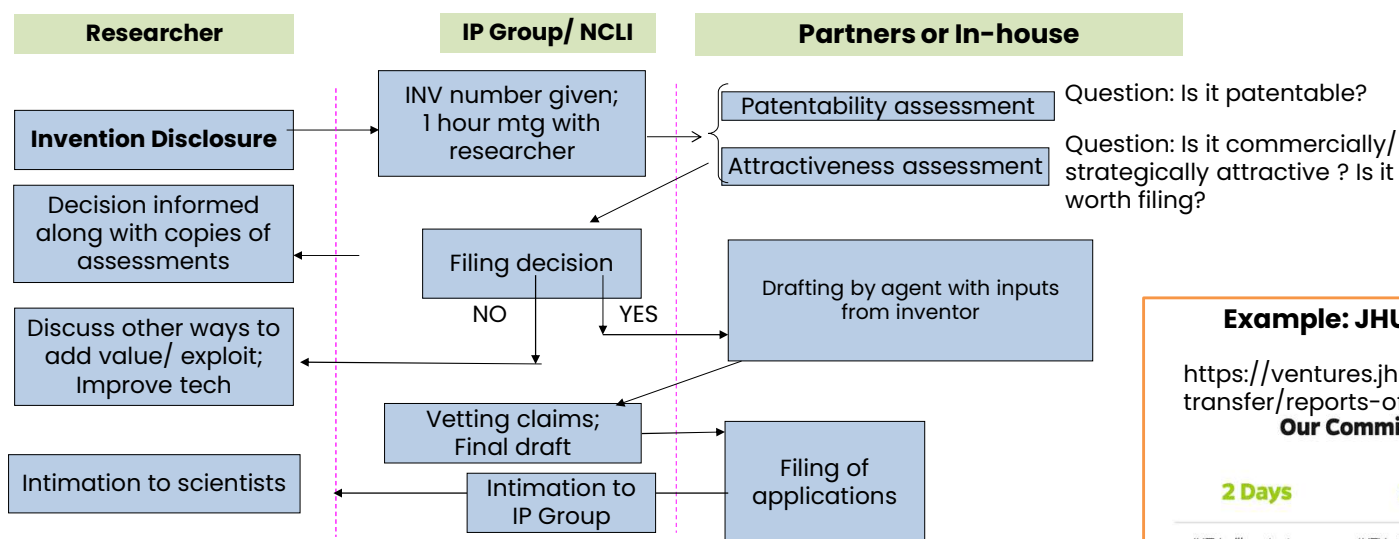
Source: AUTM Licensing Surveys (FY91- FY14)

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Invention disclosure process

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Example: NCL's patent document flow and decision points



© CSIR-NCL, 2023



Example: JHU Tech Ventures

<https://ventures.jhu.edu/technology-transfer/reports-of-invention/>
Our Commitment to Service: 2-2-2

2 Days

JHTV will contact you within **2 business days** of receiving your disclosure.

2 Weeks

JHTV will confer with you regarding your disclosure within **2 weeks** of receiving your disclosure.

2 Months

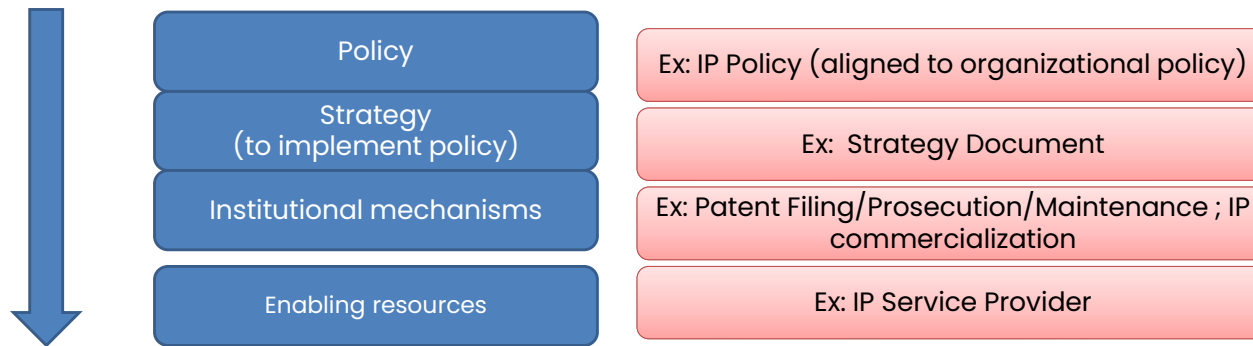
JHTV will provide a written determination within **2 months** about the commercialization plan.

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

For innovation managers: When researchers do not disclose inventions proactively, what can you do?

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Building lasting organizations and systems: Policies are the keystones



How to increase submissions of invention disclosures – basic needs:

- Do not ask inventors to find their own funds for patenting costs
- Reduce time spent by inventors on drafting, answering queries/ clarifications etc
- Reduce barriers/delays to publications/ presentations to minimum (**very important**)
- Reduce bureaucracy, paperwork, delays in decision making (committees and hierarchy), empowering inventors
- Awareness, remove fear of the unknown, remove myths
- High level support – commitment, carrot and stick
- Inventors should not have to deal with IP jargon and legal processes
- Sincere and authoritative efforts for licensing/ commercialization

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Two approaches

› **Basic:**

- Responding to interest from scientists to file patents: Awareness and efficient systems; ensuring funding
- Getting rid of myths (ex: patent filing is seen negatively by journal editors) and ideological barriers (ex: knowledge should be free).
- Visible technology licensing results – actual products/ services, awards/ recognitions, revenue

› **Proactive:**

- Level 1: Visits to various groups; talks/ seminars etc; scanning publications
- Level 2: IP landscaping and evolving integrated technology programs
- Level 3: Drive with research funding and other resource allocations; Facilitate collaborative funding proposals around themes and calls.

Myths to destroy:

- One cannot file a patent and publish an article on the same topic
- Journal editors look down on publications where previously a patent has been filed
- Patent filing can delay your publication
- Patents are not valued in CVs when research careers are involved
- One needs to show mechanistic data (and show how things work) in a patent

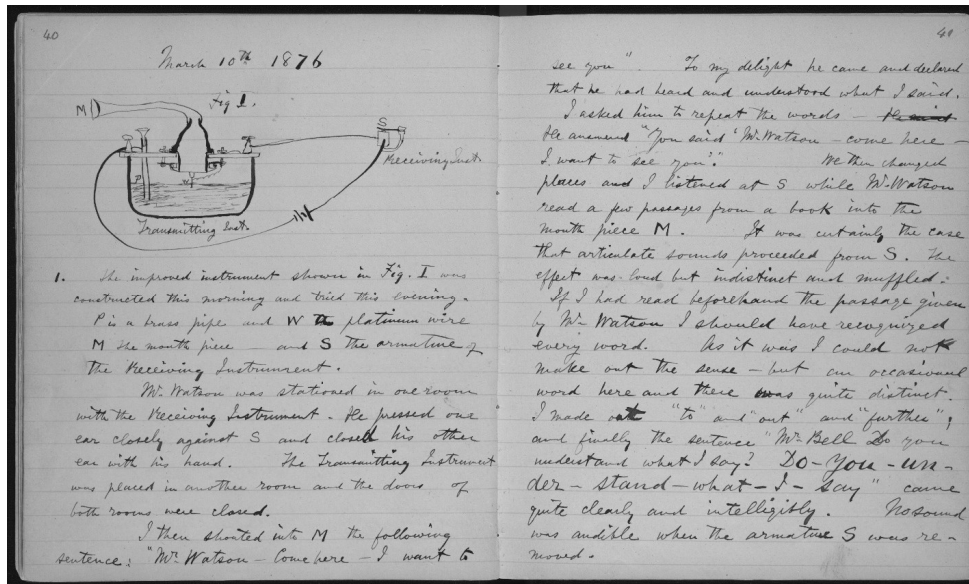
@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Ideas:

- IP Orientation Session when an employee joins the organization
- Making IP part of Orientation/ induction course for new PhD students
- Observership for students at IP/ Patent Group/Cell
- Sit in research seminars
- Scan all posters in Internal Poster Sessions
- Scan project proposals
- Scan your organization for research capabilities and knowhow. You might find patenting opportunities.
- Wall of Inventors; Most Prolific Inventor Badge
- Annual Inventors Day and honors
- Scan lab note books
- Scan conference presentations
- Scan publications

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Invention Spotting in Lab notebooks



Pages 40-1 of Alexander Graham Bell's unpublished laboratory notebook (1875-76), describing first successful experiment with the telephone.

https://en.wikipedia.org/wiki/Lab_notebook#/media/File:AGBell_Notebook.jpg

Carbon Nanotube Flow Sensors

Shankar Ghosh,¹ A. K. Sood,^{1*} N. Kumar²

We report that the flow of a liquid on single-walled carbon nanotube bundles induces a voltage in the sample along the direction of the flow. The voltage that was produced fit a logarithmic velocity dependence over nearly six decades of velocity. The magnitude of the voltage depended sensitively on the ionic conductivity and on the polar nature of the liquid. Our measurements suggest that the dominant mechanism responsible for this highly nonlinear response involves a direct forcing of the free charge carriers in the nanotubes by the fluctuating Coulombic field of the liquid flowing past the nanotubes. We propose an explanation based on pulsating asymmetric ratchets. Our work highlights the device potential for nanotubes as sensitive flow sensors and for energy conversion.

http://repository.ias.ac.in/50270/1/83_out.pdf

Carbon Nanotube Flow Sensors

SHANKAR GHOSH, **A. K. SOOD**, AND N. KUMAR

SCIENCE

16 Jan 2003

Vol 299, Issue 5609

pp. 1042-1044

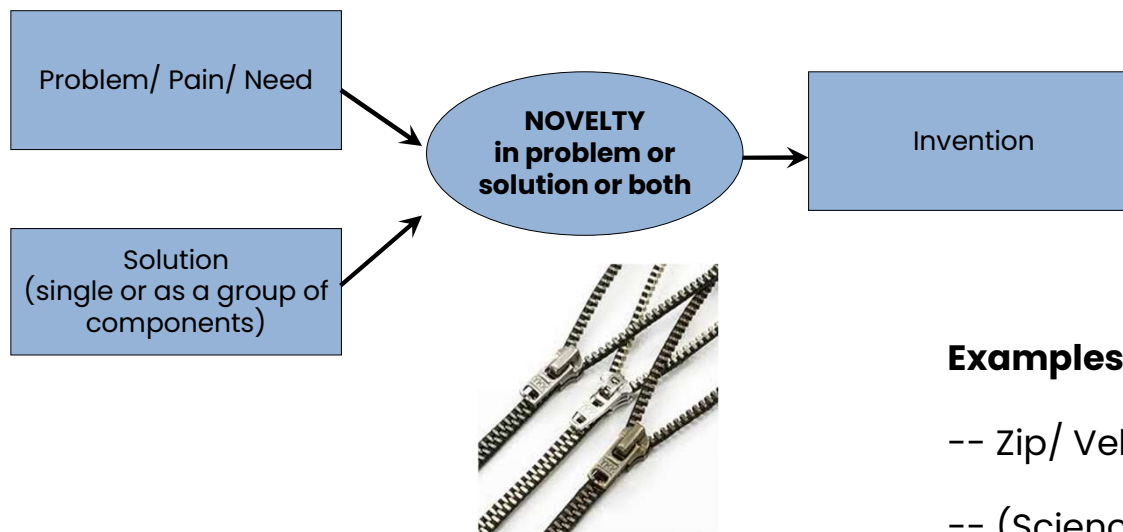
DOI: 10.1126/science.1079080

**For inventors:
You do not think you have an invention for patent
filing, what should you do?**

Typical questions/ doubts/ concerns of inventors:

- Is this an invention at all? I have just done an experiment and learnt something. What is the invention in this?
- Is this really novel?
- Is it worthy of a patent? Don't inventions have to be disruptive?
- Do I enough data to file a patent? Should I not file after getting all the data together?

Invention



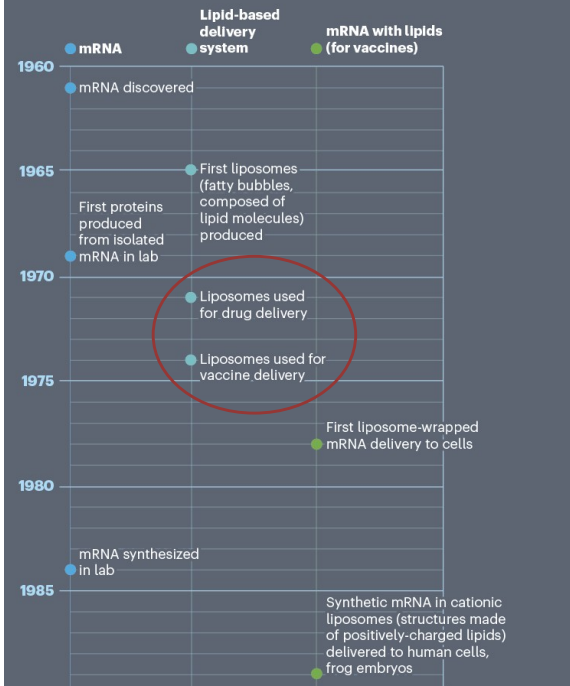
Examples:

- Zip/ Velcro/ Bundling tie
- (Science-led) Vaccines, drugs

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

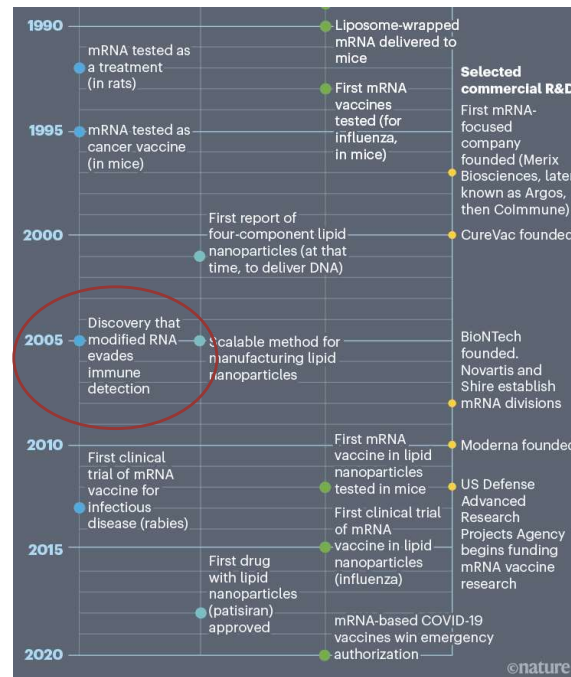
THE HISTORY OF MRNA VACCINES

A long chain of scientific advances led to the first messenger RNA (mRNA) vaccines, released last year to protect people against COVID-19. These vaccines, as well as mRNA drugs, make use of developments in the science of mRNA and in delivery systems, which are made of lipid molecules.

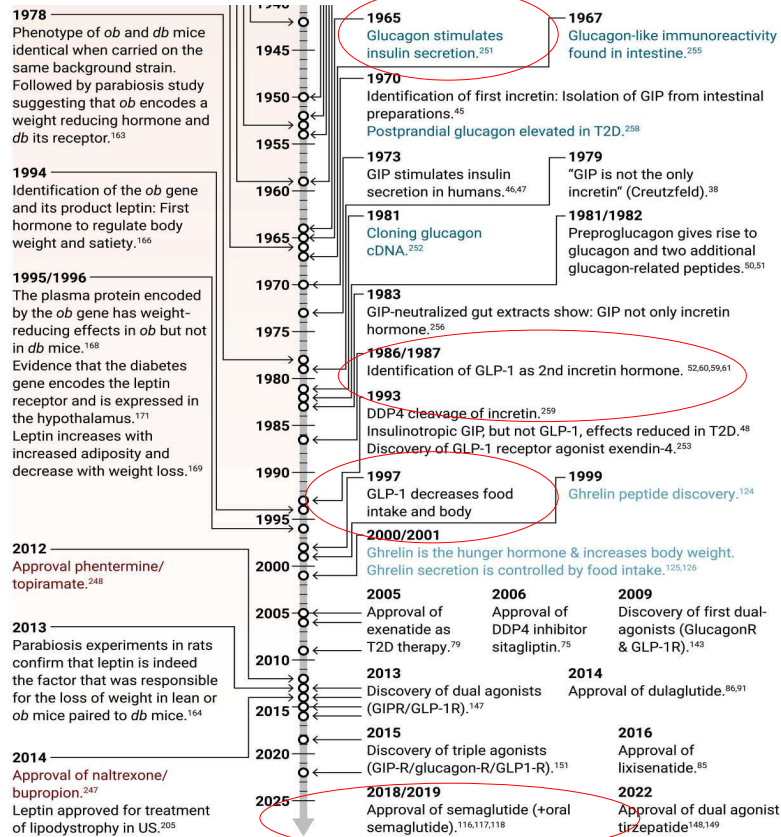


mRNA Vaccine

Source: <https://www.nature.com/articles/d41586-021-02483-w>



@ Technology Transfer in Practice | Copyright, Venture Center, 2025



Seeking satiety: From signals to solutions

Source: Tschöp and Friedman, Sci. Transl. Med. (2023)
<https://www.science.org/doi/10.1126/scitranslmed.adh4453>



Early insights into GLP-1's structure and function were generated by (from left to right) Svetlana Mojsov, Joel Habener, and Dan Drucker of Massachusetts General Hospital and Jens Juul Holst at the University of Copenhagen.
CHRISTINE KADOTAT

Fig. 1. Timeline of advances leading to the identification of short- and long-term satiety signals and their therapeutic applications. GI, gastrointestinal; IV, intravenous; RIA, radioimmunoassay; *ob*, obese; *db*, diabetic; R, receptor.

What can you protect?

- Composition (ex: membrane, catalyst)
- Method or process (ex: method of manufacturing membrane, method of coating catalyst)
- Product (ex: MEA, fuel cell stack)
- System (ex: FC based electricity generation system)
- Method of use (ex: FC in a drone for long distance delivery; drug delivered as an aerosol for asthma treatment)

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Mini- Exercise

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

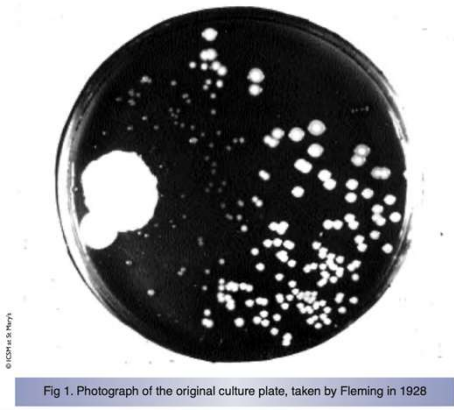
Mini exercise: Locate the invention

On 1 September 1928 Alexander Fleming became Professor of Bacteriology at St Mary's Hospital Medical School in London. He was an acknowledged expert on the staphylococcus and was following up a 1927 report by Bigger et al. describing changes in colour, texture and cohesion of *Staphylococcus aureus* colonies over time when left at room temperature. On 3 September 1928 he returned to London from his home in Suffolk, having been on holiday during August with his family. Before leaving for Suffolk, he had stacked all his *S. aureus* culture plates in one corner of his bench, out of the sun light, so that his new, young research scholar, Stuart Craddock, could work on his bench while he was away.

As Fleming started to examine his culture plates, his former assistant, Dr Merlin Pryce, walked into the laboratory and Fleming picked up the top plate, lifted the cover and said: "That's funny." Near the edge of the culture was a mould about 20 mm in diameter with a smaller satellite attached to it (Figure 1). Around it was a clear area in which organisms apparently had been lysed; further away were degenerate colonies, while still further away were normal colonies of *S. aureus*. Pryce looked and said: "That's how you discovered lysozyme."

Pryce left and thought nothing further of it. In February 1928 Pryce had decided to give up bacteriology and transferred to the Morbid Anatomy Department, leaving Fleming to continue the research by himself. Fortunately, this meant that he was the first person to see the penicillin effect and follow it up.

Mould contamination on culture plates had been seen by Fleming and many others before but he realised that here was something important. He subcultured the mould and kept it going in nutrient broth for further research. He found that the mould grew as a "thick, corrugated, felted mass and after a few days an intense yellow colour developed in the underlying clear fluid." He showed that after eight-days' growth at room temperature the culture fluid gave complete inhibition of staphylococci at a dilution of 1 in 500. For some months the culture fluid was known as 'mould juice' but on 7 March 1929 Fleming named the antibiotic 'penicillin'. On 10 May 1929 he submitted his first report on penicillin to the British Journal of Experimental Pathology.



<https://www.fleming.gr/impact/fleming-museum>

<https://www2.samford.edu/~djohnso2/44962w/london/PenicillinTrue.pdf>

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Mini exercise: Locate the invention

On 1 September 1928 Alexander Fleming became Professor of Bacteriology at St Mary's Hospital Medical School in London. He was an acknowledged expert on the staphylococcus and was following up a 1927 report by Bigger et al. describing changes in colour, texture and cohesion of *Staphylococcus aureus* colonies over time when left at room temperature. On 3 September 1928 he returned to London from his home in Suffolk, having been on holiday during August with his family. Before leaving for Suffolk, he had stacked all his *S. aureus* culture plates in one corner of his bench, out of the sun light, so that his new, young research scholar, Stuart Craddock, could work on his bench while he was away.

As Fleming started to examine his culture plates, his former assistant, Dr Merlin Pryce, walked into the laboratory and Fleming picked up the top plate, lifted the cover and said: "That's funny." Near the edge of the culture was a mould about 20 mm in diameter with a smaller satellite attached to it (Figure 1). Around it was a clear area in which organisms apparently had been lysed; further away were degenerate colonies, while still further away were normal colonies of *S. aureus*. Pryce looked and said: "That's how you discovered lysozyme."

Pryce left and thought nothing further of it. In February 1928 Pryce had decided to give up bacteriology and transferred to the Morbid Anatomy Department, leaving Fleming to continue the research by himself. Fortunately, this meant that he was the first person to see the penicillin effect and follow it up.

Mould contamination on culture plates had been seen by Fleming and many others before but he realised that here was something important. He subcultured the mould and kept it going in nutrient broth for further research. He found that the mould grew as a "thick, corrugated, felted mass and after a few days an intense yellow colour developed in the underlying clear fluid." He showed that after eight-days' growth at room temperature the culture fluid gave complete inhibition of staphylococci at a dilution of 1 in 500. For some months the culture fluid was known as 'mould juice' but on 7 March 1929 Fleming named the antibiotic 'penicillin'. On 10 May 1929 he submitted his first report on penicillin to the British Journal of Experimental Pathology.

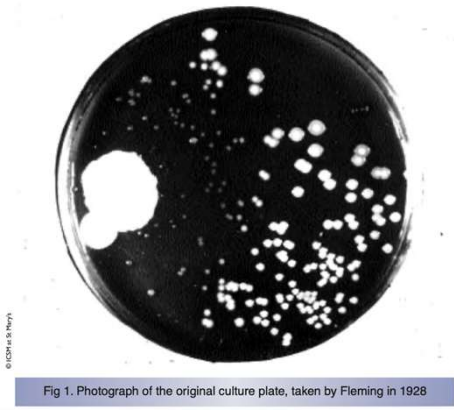


Fig 1. Photograph of the original culture plate, taken by Fleming in 1928

<https://www.fleming.gr/impact/fleming-museum>

<https://www2.samford.edu/~djohnso2/44962w/london/PenicillinTrue.pdf>

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Tech Assessment and Strategy

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Outline:

- C1. General information
- C2. Inventor's description of the invention/ technology and related inputs (based on interview with inventor)
- C3. Case manager's description of the invention/ technology in a problem-solution approach and comparison with alternative solutions
- C4. Translation to end-products and assessment of technology
- C5. Inputs from interviews with peer experts/ industry professionals/ potential customers/ licensees/ KOLs
- C6. Summary assessment and recommendations

Problem, Solution, Novelty

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Problem Definition

A way to do what?	
For whom	
To achieve what outcome	
Currently available ways/ approaches to deal with the problem	
Short comings of current alternative approaches	

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Potential Customer Segments and End-Products

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Customer Offering



Product visualization

Customer offering will consist of	
Features	
Price	

Value Proposition

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

What is Value Proposition?

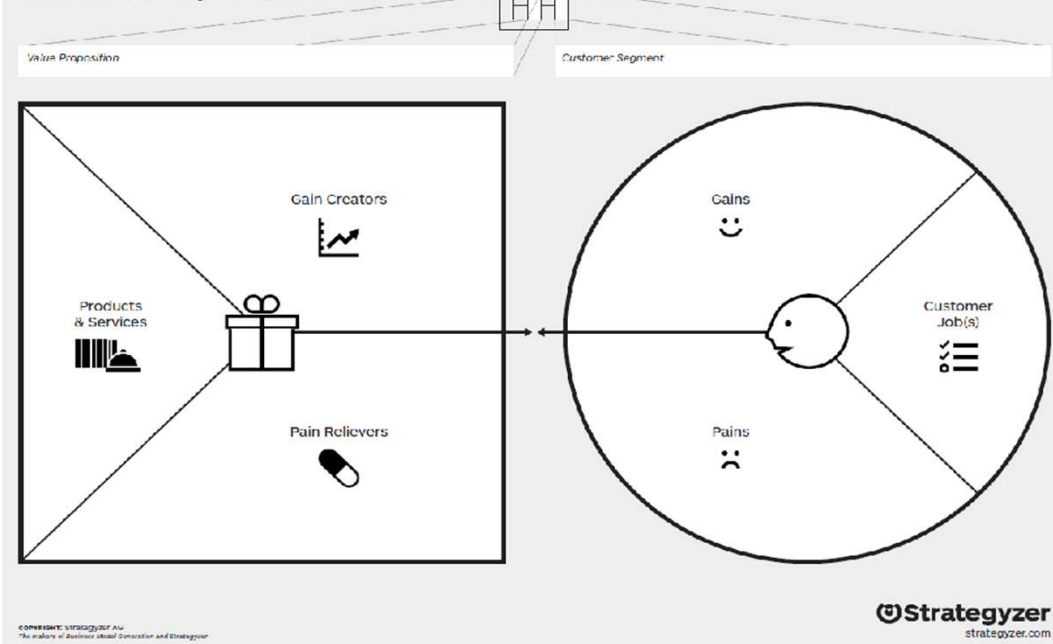


Source: Anonymous. Internet

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

A FRAMEWORK TO DESIGN VALUE PROPOSITION

The Value Proposition Canvas

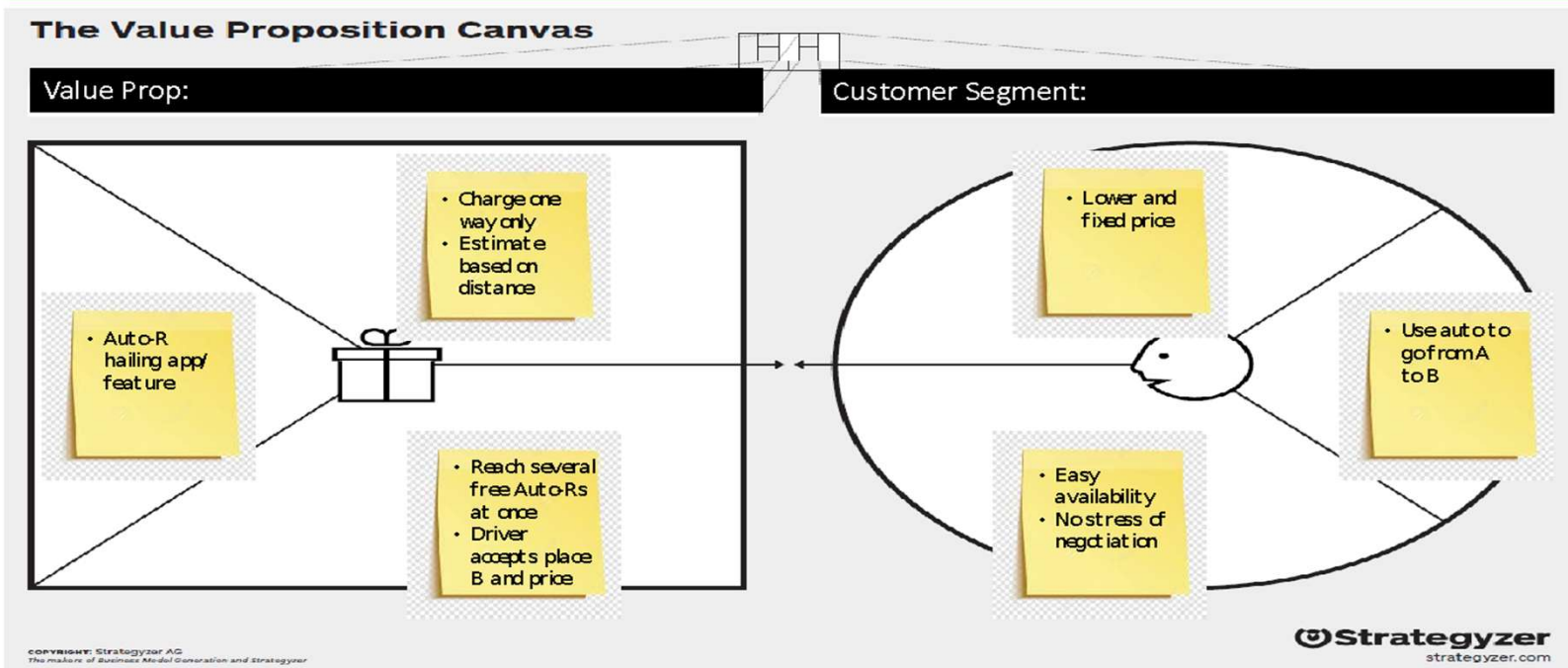


- You can start either side of the canvas; but starting with Customer Jobs (Customer Journeys) makes it easier
- Know the Customer's functional, emotional and social needs.
- Try to be as quantitative as possible
- Focus on one User Persona in each canvas-- (N = 1) approach
- User – Customer mapping is essential
- Don't confuse jobs (=activities, processes) and outcomes (=results)
- Keep unit economics in context

Courtesy: Sundara Nagarajan, IndusAge

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

AN EXAMPLE OF VALUE PROPOSITION MAP: AUTO-RICKSHAW HAILING APP



Courtesy: Sundara Nagarajan, IndusAge

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Strengthening Value Proposition

- Take one customer category at a time
- List benefits for that customer category from all product offerings in that category including yours; be careful in selecting the alternatives. They have to be the right ones, relevant and important ones that the customer segment can recognize as currently available.
- What does the product do? – Product vs. Technology, Key value vs. added values
- Compare the benefits (not “features” or “properties” but benefits; You can have a column of features that make the benefits possible)
- Where do you really stand out? Is it important for your customer?
- Where are you unsure? What are uncertain? What experiments do you need to do to illustrate superior benefits to customer? Features, data sheets, price points to demonstrate your claims (DE-RISKING STUDIES!)
- What will be acceptable to the customer as reliable evidence of superior benefits?

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Value Proposition

3. Customer offering/ product	7. Gain creators (Features)	8. Gains	1. Customer segment
4. Alternatives/ competing products	6. Pain reliever (Features)	5. Pains	2. Desired customer outcomes

Ref: Based on Value Proposition Canvas by Strategyzer.com

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Comparison

Alternatives -> Benefits (Gains/ Pains) V			

The opportunity

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

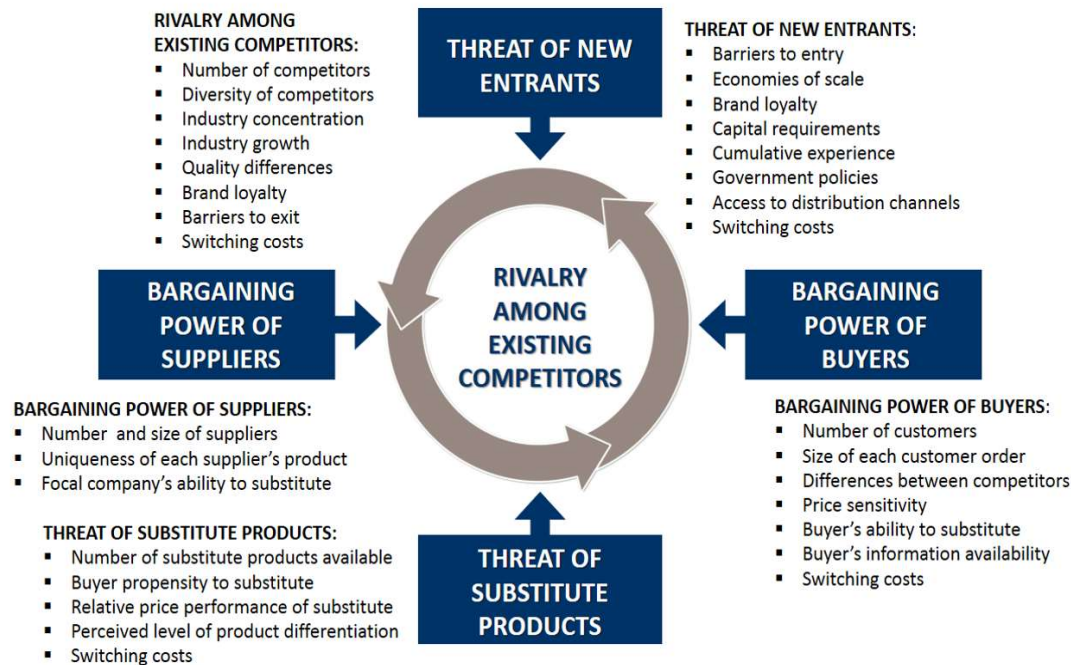
Opportunity analysis

- Existing market
 - Market Research (Secondary, Primary)
- Emerging market
 - Project a scenario of the future and project market opportunities; KOL opinions
- Strategic opportunities: Have options available (ex: Fuel cells R&D at NCL; vaccines during C19)
- Tactical opportunities: Place on the negotiation table, negotiate prices
- Funding/ investment opportunities: Ex – having multiple pieces of knowhow and IP in those spaces – say, mRNA modification, LNP; say, applications of CRISPR

Risks, uncertainties, competition

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Competition



<https://www.business-to-you.com/porters-five-forces/>

<https://hbr.org/2008/01/the-five-competitive-forces-that-shape-strategy>

<https://hbr.org/video/3590615226001/the-explainer-porters-five-forces>

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Selected Risks/ Uncertainties

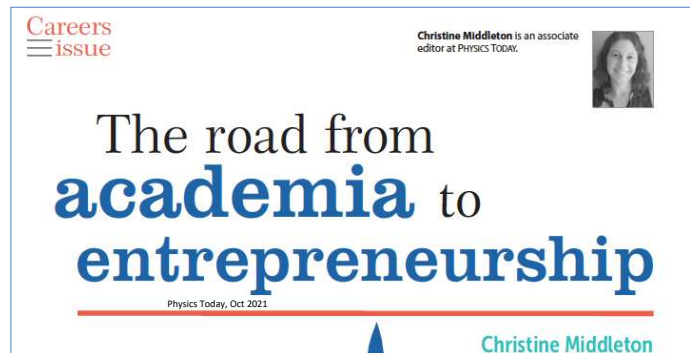
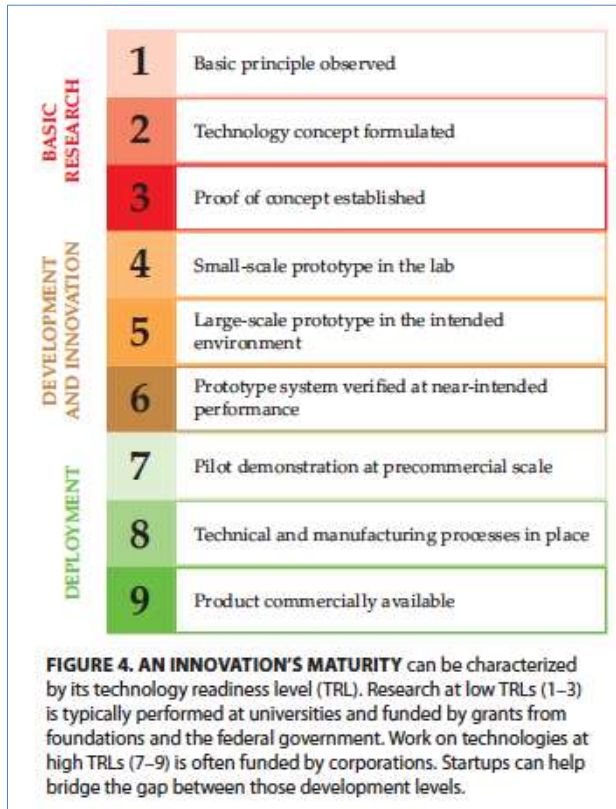
Key risks to usage/ commercialization

- Technical/ scale-up/ manufacturability risks
- Freedom to operate/ IP risks
- Regulatory/ standards/legal hurdles
- Market risks
- Industry/ competition risks
- Financial/ scale of investment barriers

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Status/strength of the technology and IP

@ Technology Transfer in Practice | Copyright, Venture Center, 2025



Physics Today, Oct 2021

BIRAC TRL Scale

- Website: https://www.birac.nic.in/desc_new.php?id=443
- Scales:
 - -- Drugs (including Drug Delivery)
 - -- Vaccines
 - -- Biosimilars
 - -- Regenerative Medicine
 - -- Medical Devices and Diagnosis
 - -- Artificial Intelligence, Big Data Analysis, IoT's,
Software Development & Bioinformatics
 - -- Industrial Biotechnology (including secondary agriculture)
 - -- Agriculture
 - -- Aqua Culture and Fisheries
 - -- Veterinary

Status of IP

- Provisional → Complete → Grant
- Age
- Strength of claims
 - Type of claim
 - Patentability; ISR
- Wide scope of claims
- Geographical coverage
- Oppositions
- Citations by others

What KOLs/experts have to say

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

KOL Opinion

- Some things that KOL can comment on:
 - Is the need/ problem being solved genuine and undisputed?
 - How big/ pressing is the need?
 - What are the alternative available today? What are the issues?
 - Will the proposed solution solve the problem?
 - What data would users/ buyers want to see to convince them?
 - What should be the price point?
 - How does the value chain work? What are the channels?
 - Who might be interested in licensing?
 - etc

Thinking through path ahead and strategy

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

Decision framework

- What is the potential benefit?
 - Keep doors open; hold some cards to influence tech journey (“create options” for yourself, organization, country)
 - Attract resources/ funders/ investors for further development
 - Attract licensors/ assignees (*sometimes this is overemphasized in academia!*)
 - Attract development/ co-development projects
 - Have a voice on the table
 - Exclude others
 - Credit/ recognition
 - Indicator of inventive potential
- What is the potential cost and risks?
 - Funds for patent protection
 - Funds for advancing the technology
 - Time
 - Law suits

@ Technology Transfer in Practice | Copyright, Venture Center, 2025

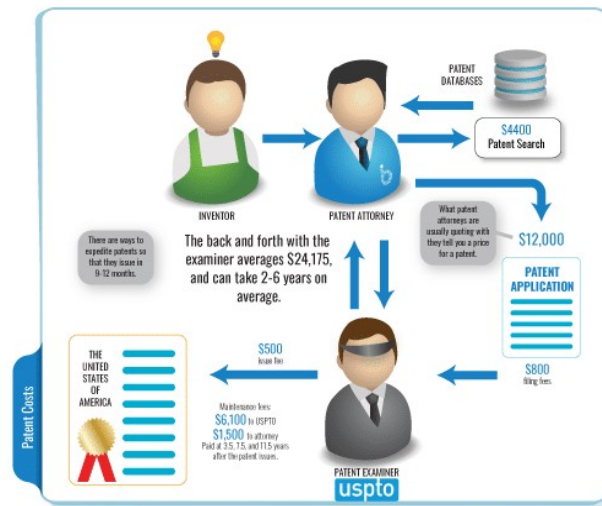
IP COSTS

- Drafting, filing, prosecution services/ IP attorney cost
 - Statutory fees for filing, examination etc
 - Others like translation costs
 - Maintenance fees
-
- Note: There is no such thing as an “international patent”. You have to protect individually in each region/ country
 - Note: Applicant can file directly on their own. But if they use the help of attorneys/ agents, they usually need attorneys/ agents from that region/ country.

WHAT PATENTS COST

US NATIONAL AVERAGE

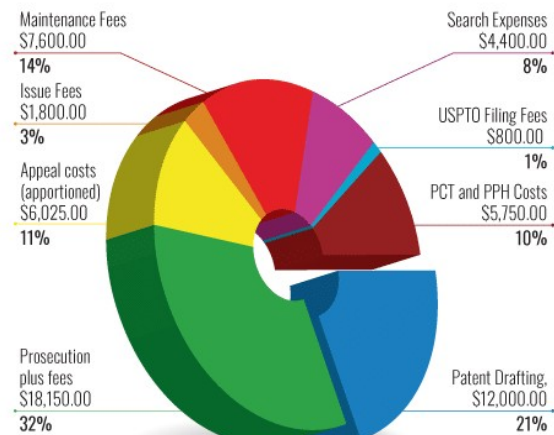
These costs are from the American Intellectual Property Lawyers Association bi-annual survey. For more details, see <https://blueironip.com/how-much-does-a-patent-cost>



(c) 2020 Blueiron, LLC All Rights Reserved

TOTAL COST: \$56,525

Fees paid to USPTO and WIPO \$12,100
Fees paid to Patent Attorney \$44,425



Notes:
1. All USPTO fees are based on Small Entity fees. Large entity fees are two times higher. These vary slightly from year to year.
2. All attorney's fees are average fees based on American Intellectual Property Lawyers Association bi-annual survey of 2020.
3. The total cost of \$56,525 is an average cost of a patent in the US with a PCT filing. It reflects the average 4.2 office actions, a 75% probability of a Pre-Appeal Conference, and a 25% probability of a Full Appeal.

@ Technology Transfer in Practice | Copyright, Venture Center, 2025



UNITED NATIONS
INDUSTRIAL DEVELOPMENT ORGANIZATION



Contact Us



<https://www.low-carbon-innovation.org/>



<https://www.venturecenter.co.in/>



<https://www.techtransfer.online/>



ttonline@venturecenter.co.in