Session 2 :
Building & operating a TTO

Policies & guidelines- conversation on Indian status and global experiences
Exercise 1

Premnath V, Aravind Chinchure, Vidula Walimbe

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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

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Who's Speaking

Aravind Chinchure
PhD

Aravind Chinchure, PhD in Physics, has 30 years of expertise in R&D, technology transfer, innovation, IP, startups, and policy. He is a Visiting Faculty at IISER Pune, serves on Manipal University Jaipur's Board, and is Founder & CEO of QLeap Academy, which develops leaders in Industry 4.0 and innovation.

Affiliation

- Founder, QLeap Academy
- Ex-Assistant Vice President – Innovation, Reliance Innovation Leadership Center, Reliance Industries
- Ex-CEO, Deshpande Startups

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Who's Speaking

Vidula Walimbe

PhD, RTTP

Vidula has expertise in technology assessment, patent analytics, & innovation management. She has served as a single point of contact for several organizations, supporting IP strategy, technology transfer processes, & policy development. She has evaluated numerous technologies for their commercial readiness, market potential, innovation impact, & competitive landscape. She has played a key role in enabling spin-offs & strengthening institutional IP frameworks. With a PhD in Law, she brings a unique blend of legal and technical insight to advancing research commercialization and tech management.

Affiliation

- Associate Manager-Innovation Management, Venture Center

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Policies and guidelines – An overview

Premnath V, Aravind Chinchure

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TTO Scope

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Tech Transfer

Tech Transfer

- Technology transfer (TT) is the process of **moving** ***industrially useful knowledge created in academia and research institutions*** and **putting it to practical use in industry and start-ups** in order to produce products and services that can eventually deliver socio-economic impact for society.

- (***MIT TLO: Our mission is to move innovations and discoveries from the lab to the marketplace for the benefit of the public and to amplify MIT's global impact.)***

Knowledge Exchange

- TT is a key component of a larger umbrella of Knowledge Exchange (KE) mechanisms that allow academia and research universities (as creators and disseminators of knowledge) transmit and industry and start-ups (as entities that utilize and exploit knowledge to create socio-economic impact) exchange knowledge and knowhow. The other components include movement of knowledge workers, consulting, scientific services and R&D collaborations.

Source: "TTO Handbook", under preparation by TechEx.in as part of the UNIDO program

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Tech Transfer Office

Tech Transfer Office (TTO)

- An office of an academic organization or R&D lab that facilitates TT and champions the cause of TT.

Forms of TTOs

- Part of department (ex, part of Business Development Divisions at CSIR Labs; IRCC at IIT Bombay, IC&SR at IIT Madras; TTO in BITS Pilani; TT function embedded in Office of Sponsored Research in many smaller US univs)
- Stand-alone department (ex, TMG at CSIR-NCL; TLO at MIT)
- Separate entity (ex: FITT at IIT Delhi; NRDC in early days for CSIR labs; BCIL for DBT labs; WARF at UW-Madison; Oxford Innovations in UK; Cambridge Enterprise in UK; Mass General Brigham for MGH & BWH of HMS)

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Functions of a TTO

Roles a TTO may play:

- Awareness, training, enabling policies
- Identifying/ sourcing technology assets
- IP protection and management
- Patent analytics for decision support
- Technology translation and readiness; Innovation/POC funding
- Technology assessment
- Technology marketing
- Advancing a lead closer to deal making
- Technology transfer deal structures/ agreements
- Technology valuation
- Negotiations and closing a deal
- Post-deal contract life cycle management
- Tech venturing and spinouts; seed funding
- Other models of technology commercialization

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… may be organized differently!

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- Tech venturing and spinouts; seed funding
- Other models of technology commercialization

IP Protection & Portfolio Management:

- Awareness, training, enabling policies
- Identifying/ sourcing technology assets
- IP protection and management
- Patent analytics for decision support

Valorizing technology assets:

- Awareness, training, enabling policies
- Technology assessment
- Technology translation and readiness; Innovation/POC funding

Tech marketing and transactions:

- Technology assessment
- Technology marketing
- Advancing a lead closer to deal making
- Technology transfer deal structures/ agreements
- Technology valuation
- Negotiations and closing a deal
- Post-deal contract life cycle management

Venturing & other routes to market:

- Awareness, training, enabling policies, clubs
- Tech venturing and spinouts; seed funding
- Other models of technology commercialization

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Policies

The TTO's scope will decide what Policies & Procedures you need:

1. **Intellectual property policy**
2. **Technology transfer policy**
3. **Revenue sharing policy**
4. Startup/ spinout/ venture creation policy (esp. equity models)
5. Faculty entrepreneurship policy
6. **Conflict of interest & commitment policy**
7. Student entrepreneurship policy

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Guiding Principles

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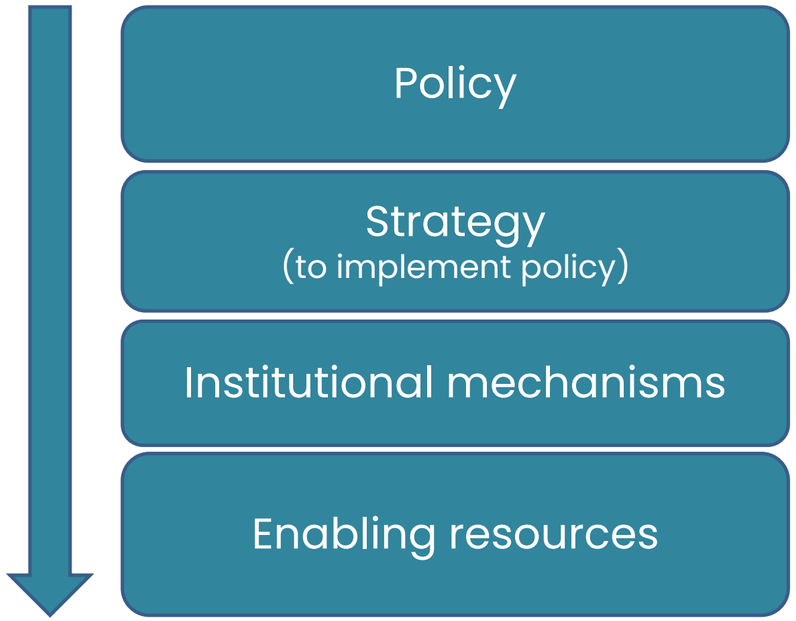
Building lasting organizations and systems: Policies are the keystones



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Policies need to be aligned to organizational goals

	Academia Ex: IISERs, IITs	Govt R&D Labs Ex: NCL, CCMB, TIFR	Production focused R&D Labs Ex: DRDO, ISRO
Priority 1	Teaching; Dissemination of knowledge	New knowledge generation; Research training	"Production" R&D; Assemble, test, optimize, deploy
Priority 2	New knowledge generation; Research training	Create new knowhow/ inventions; technology options; Impact via tech	Manage resource centers, collections; Capabilities bank
Priority 3	Create new knowhow/ inventions; technology options; impact via tech	Manage resource centers, collections; Capabilities bank	Support industry by offering services
Priority 4	Manage resource centers, collections; Capabilities bank	Support industry by offering services	Create new knowhow/ inventions; technology options; Impact via tech
Priority 5	Support industry by offering services	"Production" R&D; Assemble, test, optimize, deploy	New knowledge generation; Research training
Priority 6	"Production" R&D; Assemble, test, optimize, deploy	Teaching; Dissemination of knowledge	Teaching; Dissemination of knowledge
	X Income	X Income	X Income

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Example: MIT's Policy Statement

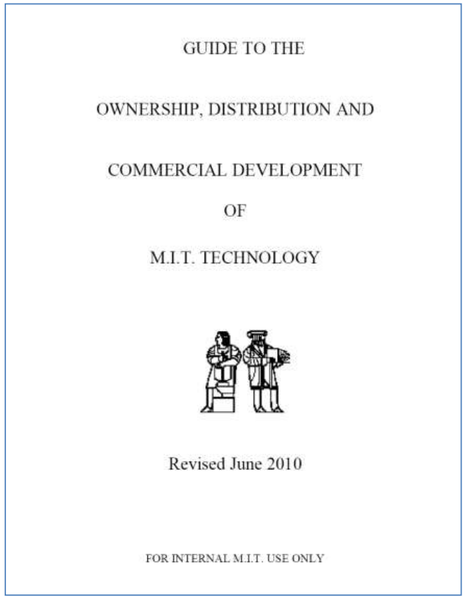
PART 2. M.I.T. POLICY STATEMENTS

2.0 GENERAL POLICY STATEMENT

The prompt and open dissemination of the results of M.I.T. research and the free exchange of information among scholars are essential to the fulfillment of M.I.T.'s obligations as an institution committed to excellence in education and research. Matters of ownership, distribution, and commercial development, nonetheless, arise in the context of technology transfer, which is an important aspect of M.I.T.'s commitment to public service. Technology transfer is, however, subordinate to education and research; the dissemination of information must, therefore, not be delayed beyond the minimal period necessary to define and protect the rights of the parties.

"Impact, not income": It's not about the money. Sure, we like it when our ships come in, but the primary focus is getting the deal done so that the technology gets developed.

Lita Nelson, then Head of MIT-TLO



GUIDE TO THE

OWNERSHIP, DISTRIBUTION AND

COMMERCIAL DEVELOPMENT

OF

M.I.T. TECHNOLOGY

Revised June 2010

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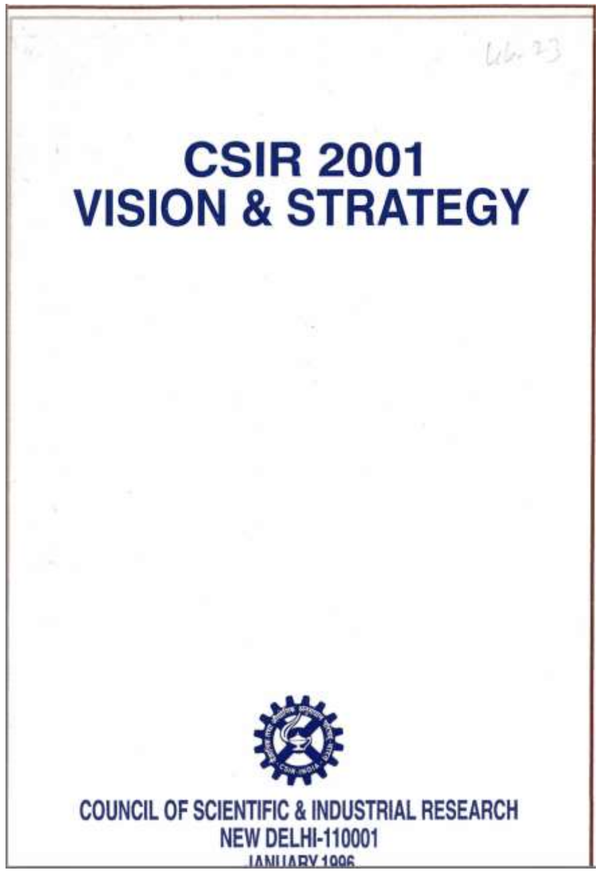
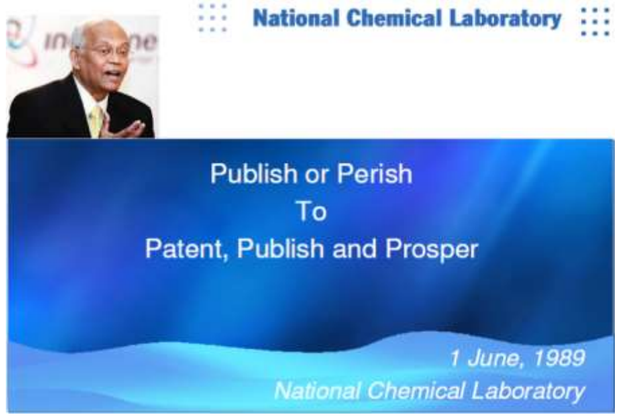
Example: CSIR



IP policy. CSIR's IP policy is:

To maximise the benefits to CSIR from its intellectual capital by stimulating higher levels of innovation through a judicious system of rewards, ensuring timely and effective legal protection for its IP and forging strategic alliances for enhancing the value of its IP.

http://missioncsir.nclinnovations.org/wp-content/uploads/2014/10/2001_CSIR_Vision-Strategy.pdf



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Policies and Procedures

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Document of P&P: Ex – MIT (circa 2010)

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MIT Technology – Policies and Procedures June 2010

Recent policy: https://policies.mit.edu/policies-procedures/130-information-policies/131-intellectual-property

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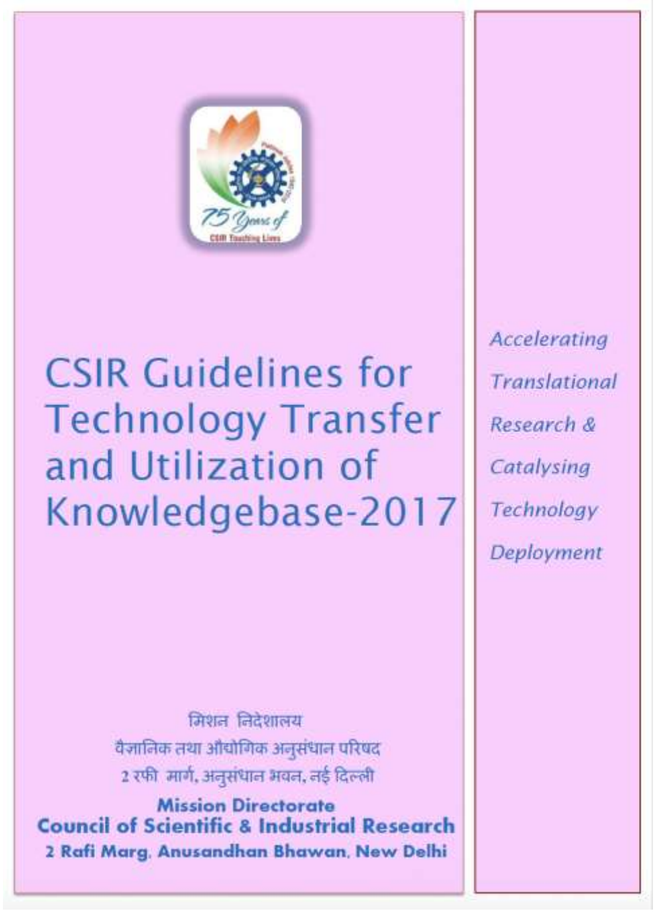
Document of P&P: Ex – CSIR (circa 2017)



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Elements of IP and TT Policy

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Design policies to enable results and not control

- Designed for intended outcomes; incentivize participation
- Create legitimacy
- Clarity, minimize ambiguity
- Easily implementable
- Predictability, reduced uncertainty, reduced risk
- Reduce potential disputes

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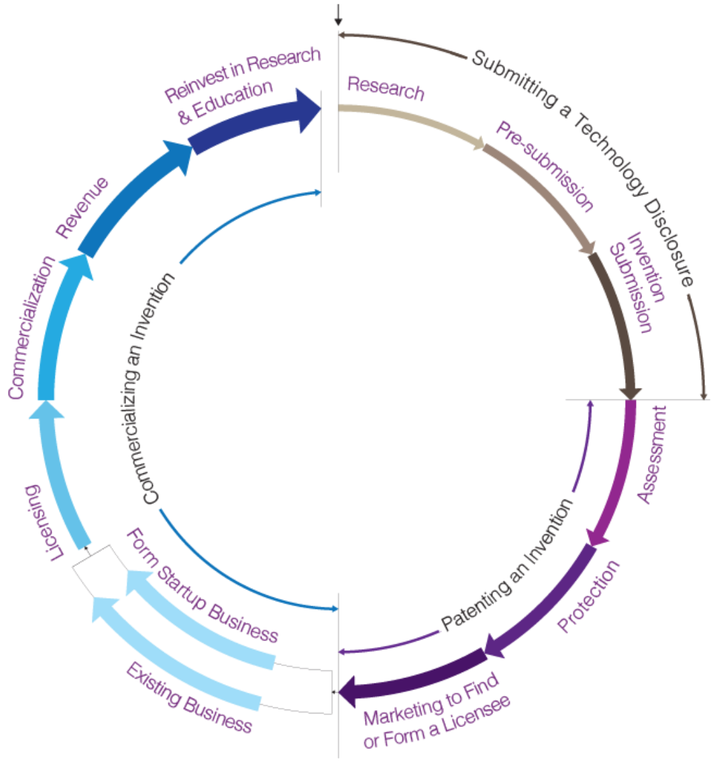
- Policies provide the essential rules, guidelines, and framework
- They bring clarity, predictability, and legitimacy to TT activities
- Well-defined policies incentivize participation and manage expectations
- Critical for both internal stakeholders (researchers, staff) and external partners (industry, investors)
- A strong policy environment minimizes ambiguity and potential disputes



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Intellectual Property (IP) Policy

- **Core Function:** Defines ownership, protection, and management of IP created at the institution.
- **Key elements**
  - Clear IP Ownership Rules (Institution vs. Creator).
    - Example: University IP Policy states inventions using significant university resources are owned by the university.
  - Obligation and Process for Invention Disclosure
  - Procedures for IP Protection (Patents, Copyright, etc.)
  - Inventor Rights, Responsibilities, and Recognition.
  - Handling IP in Collaborations and Sponsored Research.
- **Why it Matters:** Provides legal certainty and incentivizes creators to disclose valuable innovations.

Policy provides a clear path for evaluation, potential of patenting by the university, and defines rights in the commercialization process (e.g., revenue sharing).

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Source: Aravind Chinchure

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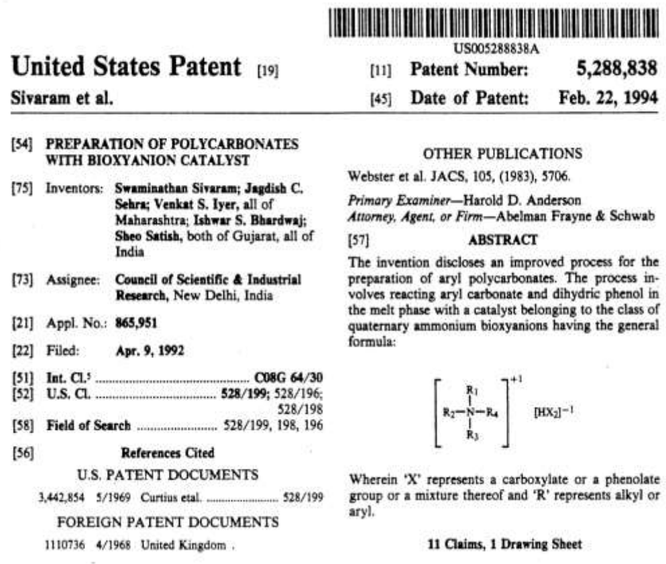
Example: IP Portfolios

Dr Sivaram & the Patent Portfolio on Polycarbonates

Dr S Sivaram



US005288838A

United States Patent [19]
Sivaram et al.

[11] **Patent Number: 5,288,838**
[45] **Date of Patent: Feb. 22, 1994**

[54] **PREPARATION OF POLYCARBONATES WITH BIOXYANION CATALYST**

[75] Inventors: **Swaminathan Sivaram; Jagdish C. Sehra; Venkat S. Iyer,** all of Maharashtra; **Ishwar S. Bhardwaj; Sheo Satish,** both of Gujarat, all of India

[73] Assignee: **Council of Scientific & Industrial Research,** New Delhi, India

[21] Appl. No.: **865,951**

[22] Filed: **Apr. 9, 1992**

[51] **Int. Cl.**[5] **C08G 64/30**
[52] **U.S. Cl.** **528/199;** 528/196; 528/198
[58] **Field of Search** 528/199, 198, 196

[56] **References Cited**

U.S. PATENT DOCUMENTS

3,442,854 5/1969 Curtius etal. 528/199

FOREIGN PATENT DOCUMENTS

1110736 4/1968 United Kingdom .

OTHER PUBLICATIONS

Webster et al. JACS, 105, (1983), 5706.

Primary Examiner—Harold D. Anderson
Attorney, Agent, or Firm—Abelman Frayne & Schwab

[57] **ABSTRACT**

The invention discloses an improved process for the preparation of aryl polycarbonates. The process involves reacting aryl carbonate and dihydric phenol in the melt phase with a catalyst belonging to the class of quaternary ammonium bioxyanions having the general formula:

$$\left[\begin{array}{c} R_1 \\ | \\ R_2-N-R_4 \\ | \\ R_3 \end{array}\right]^{+1} [HX_2]^{-1}$$

Wherein 'X' represents a carboxylate or a phenolate group or a mixture thereof and 'R' represents alkyl or aryl.

11 Claims, 1 Drawing Sheet

Over twenty five US patents in the broad area of polycondensation chemistry

Over 15 million dollars of income through patent licensing fee, royalties, research and consulting fee to NCL between 1994 to 2002

This patent led to over ten years of very productive and exciting research in the area of polycarbonates, resulting in several PhD thesis, publications and industrial partnership with GE plastics. This also established the principle of "organic catalysis" for polymer synthesis

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Technology Transfer Policy: Key Elements

- **Core Function:** Translates the value of intellectual property into tangible financial returns and impact.
- **Key Elements:**
  - Guidelines for Negotiating Licensing Terms (Fees, Milestones, Royalties).
    - *Inventor Priority:* Policy may give inventors the first option or priority in licensing the technology if they intend to form a startup around it with *flexible licensing terms by a*voiding overly restrictive clauses (e.g., "only non-exclusive allowed" or "assignment not allowed etc.).
  - Policy on University Equity in Spinout Companies.
  - Clear Formula for Calculating and Distributing Net Revenue.
  - Requirements for Licensee Reporting and Compliance Monitoring.
- **Why it Matters:** The policy ensures that the university receives a fair financial return and facilitates pathways to market by allowing flexibility needed for commercial development.

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Example: Tech Transfer
Prof Gregory Winter, MRC, Cambridge

Sir Greg Winter

Nobel Prize in Chemistry 2018
for the phage display of peptides
and antibodies,
former Master of Trinity College,
founder of CAT, Domantis and
Bicycle Therapeutics

Prof. Gregory Winter is a Nobel Laureate and highly successful serial entrepreneur. He has **400+ patents** to his name and **founded two unicorn companies.** His IP has generated more than **£1bn in royalties.**

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Revenue Sharing Policy

- **Core Function:** Determines how income from IP commercialization is distributed.
- **Key Elements:**
  - Clear Formula for Revenue Distribution (Inventors, Department, Institution).
    - The revenue sharing policy dictates the distribution. After deducting pre-defined expenses, a significant percentage (e.g., 40-60%) of the first tier of revenue goes to the inventors
  - Definition of "Net Revenue" (What Expenses are Deducted).
  - Process for Allocating Inventor Shares (for multiple inventors).
  - Principles for Reinvestment of Institutional Share (e.g., back into research/TT).
- **Why it Matters:** Incentivizes inventors and provides resources for future innovation.

The inventors receive a substantial financial reward, motivating them and others to engage in TT. The remaining funds are allocated to their department and the university, often reinvested in research infrastructure or TT office operations as per policy.

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Policy for Spinout Companies

- **Core Function:** Provides a framework for creating new ventures based on university IP.
- **Key Elements:**
  - Process for Spinout Formation and University Approval.
  - Terms for Licensing University IP to the Spinout (Equity, Royalties).
  - Guidelines on University Equity Stake (often flexible/negotiable).
  - Permissible Faculty/Staff Involvement in Spinout Management (with COI management).
  - Potential University Support Mechanisms (Incubation, Mentorship).
- **Why it Matters:** Enables a key pathway for commercialization and economic impact.

The university licenses the IP to the student-led startup, taking an agreed-upon equity stake as per the policy. The policy allows the professor to serve as a technical advisor while managing their university commitments.

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Example: Spinouts
Prof Bob Langer, MIT

Robert Langer receives Dr. Paul Janssen Award

Award honors "scientists who have made a transformational contribution toward the improvement of human health."

Department of Chemical Engineering
February 13, 2024

Dr. Langer has authored more than 1,600 research paper. **He also has over 1,495 issued and pending patents worldwide.** Dr. Langer's patents have been licensed or sublicensed to over **400** pharmaceutical, chemical, biotechnology and medical device **companies.**

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MIT Professor **Bob Langer**, a chemical engineer by training, is known among life-sciences entrepreneurs as "the Edison of Medicine." A scientist's h-index score measures how often other scientists cite his papers. For a scientist who has run a lab for 20 years, an h-score of 20 is good… 40 is great… 60 is remarkable. Bob Langer's h-score is 230 – the highest of any engineer ever. The Langer Lab's discoveries have translated into both clinical and commercial success. **His lab has given rise to 40 companies – 39 of them either acquired or still in existence, with a collective market value of over $50 billion.**

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Policy for Faculty & Student Entrepreneurship

- **Core Function:** Encourages and supports entrepreneurial activities beyond formal spinouts
- **Key Elements (Faculty):**
  - Recognition of Entrepreneurship in Career Progression
  - Guidelines on Time Commitment to External Ventures.
  - Management of Conflicts of Commitment and Interest.
- **Key Elements (Student):**
  - Clarification of IP Ownership for Student Projects (especially independent work).
  - Permissible Use of University Resources.
  - Academic Recognition or Flexibility for Entrepreneurial Pursuits.
- **Why it Matters:** Enables a key pathway for commercialization and economic impact.

These policies incentivize faculty to apply their knowledge commercially and empower students to pursue their entrepreneurial ideas, enriching the overall innovation ecosystem.

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Conflict of Interest (COI) Policy

- **Core Function:** Identifies, discloses, and manages potential conflicts arising from external activities.
- **Key Elements:**
  - Clear Definition of Reportable Interests (Financial, Roles in Companies)
  - Mandatory Disclosure Requirements for Faculty and Staff.
  - Process for Reviewing Disclosures and Identifying Conflicts.
  - Development and Implementation of Management Plans.
  - Guidelines on Conflicts in Research and Technology Transfer Contexts.
- **Why it Matters:** Maintains institutional integrity, objectivity in research, and public trust.

The plan might require an independent researcher to oversee any further university research related to the licensed technology, ensuring objectivity and preventing perceived bias, thus upholding the institution's integrity.

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Institutional Processes & Decision Points

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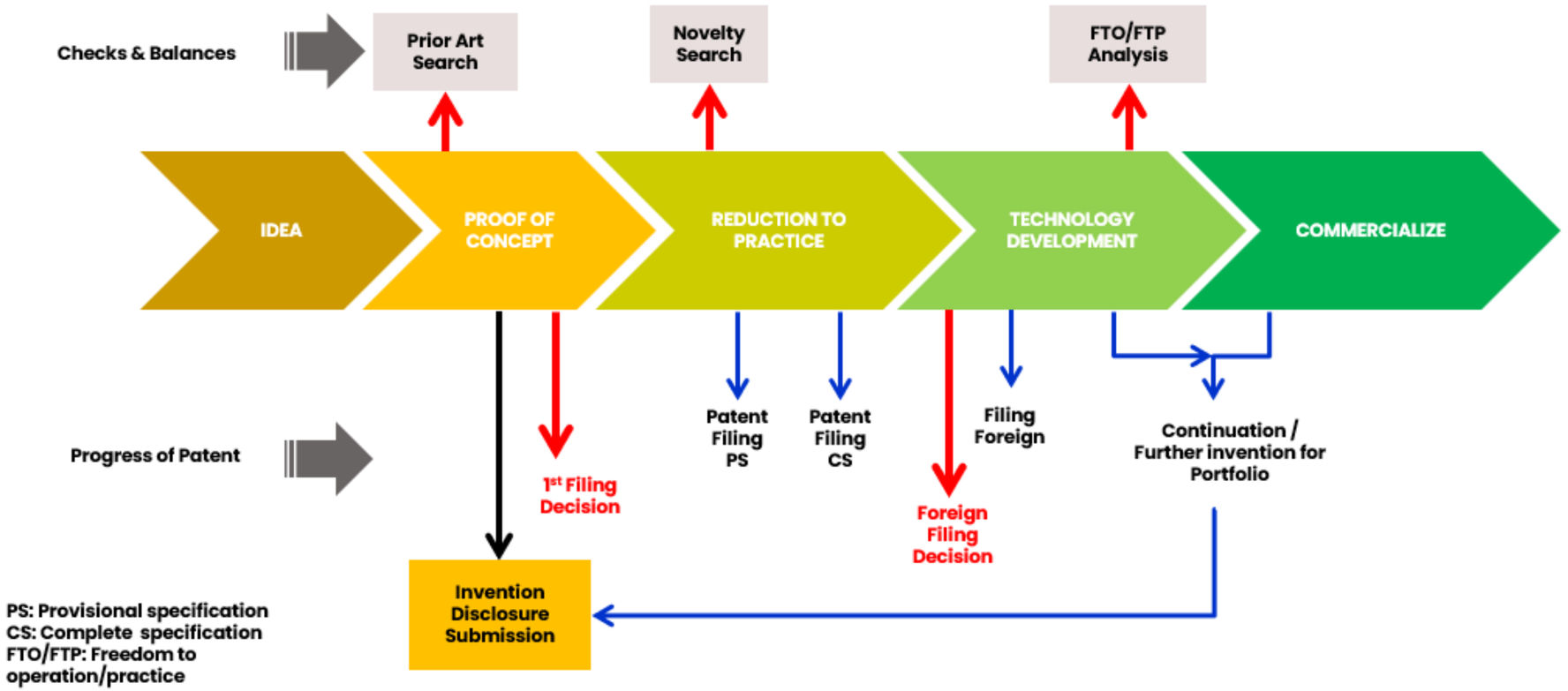
Idea to Market



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Stage 1: Creation & Identification (From Lab to Disclosure)

Invention Disclosure Process:

- Making it easy for researchers to submit new ideas/findings.
- Clear forms (online/offline) and accessible submission points.
  - User-friendly online invention disclosure portal.
- Training and awareness for researchers on what and when to disclose

Initial Assessment:

- Rapid review for completeness and initial potential.
  - A commitment to rapid initial review
- Quick decision on whether to proceed to detailed evaluation.
- Timely communication back to the inventors.

Researcher Consultation:

- Structured meetings to understand the invention in detail.
- Discussing potential applications and inventor aspirations.

Within a week, the TT office contacts the lead inventor to schedule a detailed discussion, keeping the process moving swiftly from initial idea to TT/IP office engagement.

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Stage 2: Protection (Securing Intellectual Assets)

- **Detailed Evaluation (Technical & Market):**
  - Engaging internal/external experts for thorough technical review.
  - Market research to understand commercial landscape and potential.
- **Prior Art Search & Patentability Analysis:**
  - Systematic searching of existing IP and literature
  - Expert analysis to determine if the invention meets patentability criteria (Novelty, obviousness, utility).
- **IP Strategy Development:**
  - Deciding on the best protection route (patent, copyright, trade secret).
  - Identifying key jurisdictions for protection based on market analysis.
- **Filing & Prosecution Management:**
  - Working with patent attorneys to draft and file applications.
  - Managing communication and responses to IP offices globally.
  - Tracking deadlines and ensuring compliance.

The TT/IP office efficiently manages the drafting and filing of the patent application through the external firm, ensuring the invention is protected according to the developed strategy.

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Stage 3: Commercialization (Bringing Technology to Market)

- **Technology Marketing & Outreach:**
  - Creating compelling marketing materials (summaries, presentations).
  - Identifying and contacting potential licensees/partners directly.
  - Utilizing online platforms and participating in industry events.
- **Confidentiality Management:**
  - Standardized process for quickly putting NDAs in place.
  - Secure sharing of confidential information.
- **Partner Evaluation & Due Diligence:**
  - Assessing the capabilities and resources of potential commercial partners.
  - Understanding their market position and interest.
- **Negotiation & Agreement Finalization:**
  - Structured process for negotiating license or spinout agreements.
  - Defining terms (royalties, milestones, equity).
  - Efficient internal approval workflows for agreements.
- **Spinout Support Process:**
  - Guidance on company formation, business planning, and funding pitches.
  - Connecting entrepreneurs with mentors and resources.

The efficient process for initial contact, confidentiality, and information sharing facilitates timely evaluation by the potential licensee, moving closer to a potential licensing agreement for implementation.

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Stage 4: Post-Closing & Impact (From Market to Impact)

Agreement Monitoring & Compliance:

- System for tracking license milestones, royalty payments, and reporting requirements.
- Regular communication with licensees/spinouts.

Revenue Collection & Distribution:

- Processes for receiving and verifying income.
- Transparent and timely distribution of revenue according to policy.

Impact Measurement & Reporting:

- Defining metrics for economic, social, and environmental impact.
- Collecting data from licensees, spinouts, and other sources.
- Reporting on TT outcomes to stakeholders (university leadership, government, public).

The collected data is used to report on the significant social impact of the technology transfer in the university's annual report, demonstrating the real-world benefits enabled by the TT processes.

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Processes as an Enabler: Key Takeaways

- Well-defined processes are essential for operational efficiency
- They ensure consistency and reduce delays in the TT pipeline.
- Transparency in processes builds trust with researchers and partners.
- Continuous improvement of processes is vital for adapting to change.
- Efficient processes free up TT staff time for strategic activities.
- Optimizing processes leads to greater success in translating research into impact.

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Policies and guidelines: Conversations on Indian status & global experiences

Aravind Chinchure

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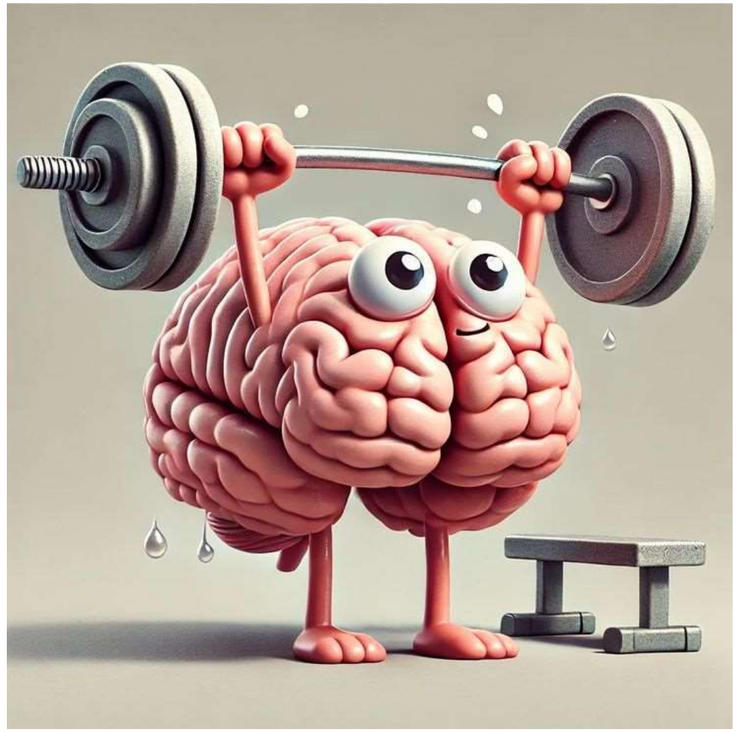
Exercise coming up next



Time to put your neurons to work!

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Exercise 1:

How would you structure your TTO?
Which policies and guidelines will you put in place?

Vidula Walimbe, Premnath V

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Learning goals

This exercise is designed to understand the following:

- How your organization views the role of the TTO?
- Whether your organizational policies are adequate for your needs?
- If you have key institutional processes in place?
- How decisions are made in your organization?
- Understand funding and resourcing status in your organization
- Lay out a few action points for further discussion/ improvement

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Chatham House rules apply to this exercise

Chatham House Rule:

“When a meeting, or part thereof, is held under the Chatham House Rule, participants are free to use the information received, but neither the identity nor the affiliation of the speaker(s), nor that of any other participant, may be revealed.”

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You will need your phone or computer to do this exercise.

We will provide you a Google Form Link which you can use to provide answers.

We will show the aggregate results on the screen.

This will be followed by a discussion and listing of action points for your organization.

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Alignment with organizational mission

Question: How important is tech transfer to your organization's mission?

1. It is the number 1 goal
2. It is the number 2 goal
3. It is one among top 5 goals
4. It is desirable but not necessary

Example goals:

- Teaching, training
- New knowledge creation
- Impact from knowledge
- Services for industry
- Maintain and make available key resources centers/ collections/ facilities

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Positioning in Organization

- Question: Where in your organization is the TTO positioned?

1. Head, TTO reports to Dean, R&D/Sponsored research/ Innovation
2. Head, TTO reports to Director/ Vice Chancellor
3. Head, TTO reports to Head of Admin/ Registrar
4. We do not have a dedicated TTO
5. Other

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Policies

Question: Which of the following policies does your institution have in place?

1. Intellectual property policy
2. Technology transfer policy
3. Revenue sharing policy
4. Startup/ spinout/ venture creation policy (esp. equity models)
5. Faculty entrepreneurship policy
6. Conflict of interest & commitment policy
7. Student entrepreneurship policy

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Agreements

Question: Which of the following agreements have been implemented in your institutions?

1. Assignment of IP rights by employees to institution
2. Confidentiality agreements with employees
3. Agreements on confidentiality and IP with visiting/ transient researchers
4. Agreements on confidentiality and IP ownership with collaborators
5. Joint invention administration agreements (in case of collaborations)
6. NDA/CDA with interested industry partners/ collaborators
7. MTA for transfer/exchange of samples/ data

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Forms

Question: Which of the following formats are used in your institutions?

1. Invention disclosure form
2. Form informing about/ seeking permission for creation of a new venture
3. Disclosures of potential CoI/CoC

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Offices/ Functions

Question: Which of the following functions are adequately staffed in your institutions?

1. IP filing, prosecution, portfolio mgmt
2. IP investment decisions (and related decision support)
3. Technology marketing, lead generation
4. Deal structuring, negotiations and deal closure (and related decision support)
5. Post-TT contract life cycle management, royalty audits
6. Tracking infringements, litigations (and related decision support)

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Decisions

Question : Which of the following decisions are made efficiently and in a well-informed manner in your institutions?

1. Decision to file IP in India
2. Decision to file in foreign jurisdictions
3. Decisions to maintain/ renew IP
4. Decision on investments on IP costs
5. Decision on deal closure
6. Decisions on notices, litigations

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Decision bodies

Question: Who has the responsibility of taking investment/ deal closure decisions in your institution?

1. Head, IP Group/ Patent Cell
2. Head, TTO
3. Committees staffed by TTO staff
4. Committees staffed by Faculty
5. Dean, R&D/ Sponsored Research/ Innovation
6. Director/ Vice Chancellor

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Funds

Question: Do you have ear marked or dedicated funds for the following in your institution (or related organizations)?

1. IP filing, prosecution, maintenance statutory costs
2. Engaging firms for IP services
3. IP legal action
4. Engaging lawyers for drafting agreements
5. Engaging services for decision support (ex: deal structure, valuation etc)
6. Engaging technology marketing services
7. Third-party royalty audits

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7. Third-party royalty audits

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For the final question you will need to just write on the printout provided to you.

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Action points for your organization

Task: List a few action points for your organization in terms of additions to what you already do

Policies	
Agreements	
Forms	
Offices/ functions	

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Well done &
thanks for participating

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

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

https://www.techtransfer.online/

ttonline@venturecenter.co.in

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