

# Non-Profit Technology Transfer

## Non-Profit Technology Transfer — Helping Institutions Protect and Commercialize Inventions

Many of the world's most important, innovations began as research discoveries in universities, hospitals, research institutes, and government agencies. The non-profit research sector continues to fuel the growth of scientific breakthroughs leading to life-enhancing products and services.

The experienced IP attorneys of Marshall, Gerstein & Borun evaluate, protect, and advise on the strategic transfers of research institutions around the world, while navigating contractual and statutory restraints and other issues related to IP in this highly complex environment.

### **Decades of experience**

Marshall Gerstein has been driving the dialogue on IP issues on behalf of non-profit clients all along. Early in our history, we represented the Board of Trustees of the University of Illinois before the U.S. Supreme Court in *Blonder Tongue Laboratories, Inc. v. University of Ill. Foundation*, 402 U.S. 313 (1971). Today, we provide ongoing counsel to more than 50 non-profit institutions across the full spectrum of IP matters.

### **In-house technology transfer experience**

Our team includes former technology transfer managers at non-profit institutions, who have first-hand knowledge of the issues and priorities of institutions, their corporate collaborators, and individual researchers and academics. We also understand the technologies and scientific principles that underlie new inventions and products, and are sensitive to the timelines and budgetary constraints that affect our clients' research activities.

### **Multidisciplinary approach to asset protection**

Our patent prosecution team is skilled in all key disciplines of science and engineering and regularly evaluates invention disclosures, prosecutes meaningful claims, and develops broad-based portfolio management strategies. Our trademark attorneys help non-profits protect their reputations and leverage IP assets, and we handle clearance, registration, licensing, monitoring, and enforcement of trademark rights. Our copyright practice is skilled in the strategic use of copyrights, including in the software arena and with regard to ownership and use issues. Trade secrets are no longer irrelevant to non-profit technology transfer. We are sensitive to the research mission and its balance with special circumstances.

### **Effective negotiators focused on the end game**

At Marshall Gerstein, we develop sophisticated licensing and transaction strategies, stay abreast of rapidly changing legal issues, and create enforceable agreements for each unique IP transaction. Having sat on all sides of the negotiating table, and given our deep experience representing non-profit organizations, we deliver creative yet practical solutions that help align and achieve our clients' long-term goals. We regularly negotiate funding, collaborations, IP acquisitions, and provide opinions on policy interpretations.

### **Strategically resolving disputes**

In pursuing a client's objectives, our litigators often recommend arbitration, mediation, or other forms of alternative dispute resolution (ADR) as the best way to address a dispute. We work with our clients to develop a course of action based on the importance of the matter, the economics of litigation versus using ADR, and the probability of the outcome. At times, disputes cannot be resolved through ADR. These matters are handled by litigators who possess significant courtroom experience and a strong record of success in intellectual property and contract litigation.

### **Committed to advances in the industry**

Our attorneys are thought leaders, authoring articles on technology transfer and IP issues in journals such as *Intellectual Property Magazine*, *Managing Intellectual Property*, and *InsideCounsel*. Frequently invited to teach around the world, Marshall Gerstein contributes at conferences by the Association of University Technology Managers (AUTM), Biotechnology Industry Organization (BIO), Licensing Executives Society International (LESI), American Intellectual Property Law Association (AIPLA), Global Healthcare Innovation Alliances Symposium (GHIA), and American Chemical Society (ACS).

### **Representative matters**

- **Unique Public and Private Partnership to Advance Stem Cell Research**

Marshall Gerstein structured and negotiated a highly unusual multi-year relationship between a private hospital and research institute and a state university medical system so a world-renowned expert in gene therapy, tissue engineering, and regenerative medicine could serve as a full-time tenured professor at the university and chief scientific officer of the private research institute. Many agreements, policies, and procedures had to be created to implement the vision of one lab in two locations that capitalizes on the university's infrastructure for basic research and the private hospital and the research institute's clinical research environment. With decades of experience in non-profit technology transfer organizational management, Marshall Gerstein's team was well positioned to advise on the legal constraints of state universities, Bayh-Dole requirements, and best practices to draft policies on IP and tangible material transfer, management committee governance documents, and the many other agreements to implement a joint technology transfer infrastructure.

- **Completed 75 Clinical Trial Agreements in Less than Two Months**

A major hospital medical center and research institution turned to Marshall Gerstein with its large backlog of clinical trial agreements. In less than two months, the IP Transactions team turned around 75 drug or medical device clinical trial agreements. Protecting the interests of the client without a protracted negotiation was balanced with the need to propose terms that the pharmaceutical or medical device company would be able to accept. Often characterized as "high-anxiety contracting," these types of negotiations are particularly challenging because there is so much at stake, including the significant financial investment in the trials, liability issues, and the need to navigate stringent regulatory requirements.