

INTELLECTUAL PROPERTY

SPEAKER SERIES

IAP 2022 • JANUARY 5-27

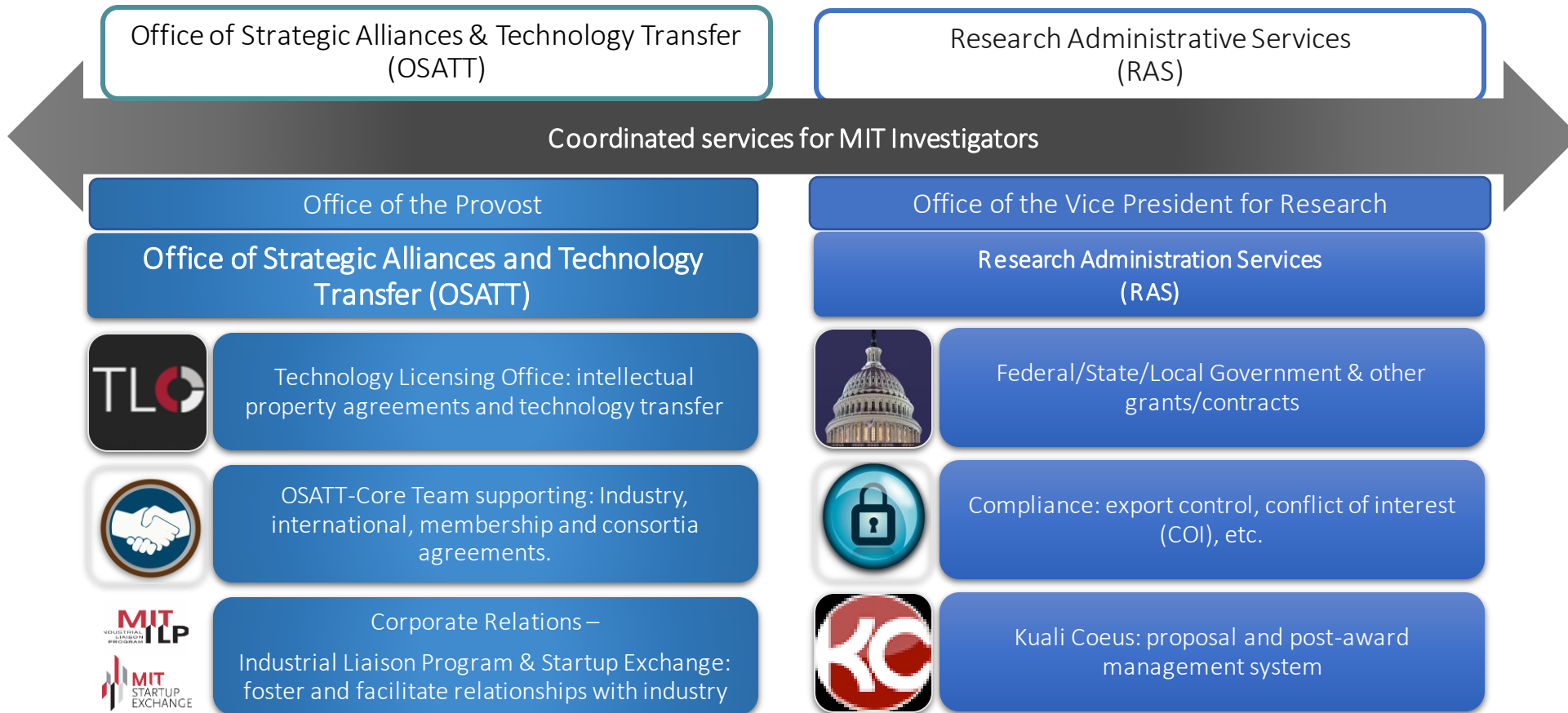
STARTUPS • INNOVATION • COPYRIGHT • TECHNOLOGY • INVENTIONS • PATENTS
...and more!



Office of Strategic Alliances and Technology Transfer (OSATT)

Developing Industry-Sponsored Research Agreements

OSATT & RAS: Working Together



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OSATT is a “one-stop shop” for industry research partners & IP licensees

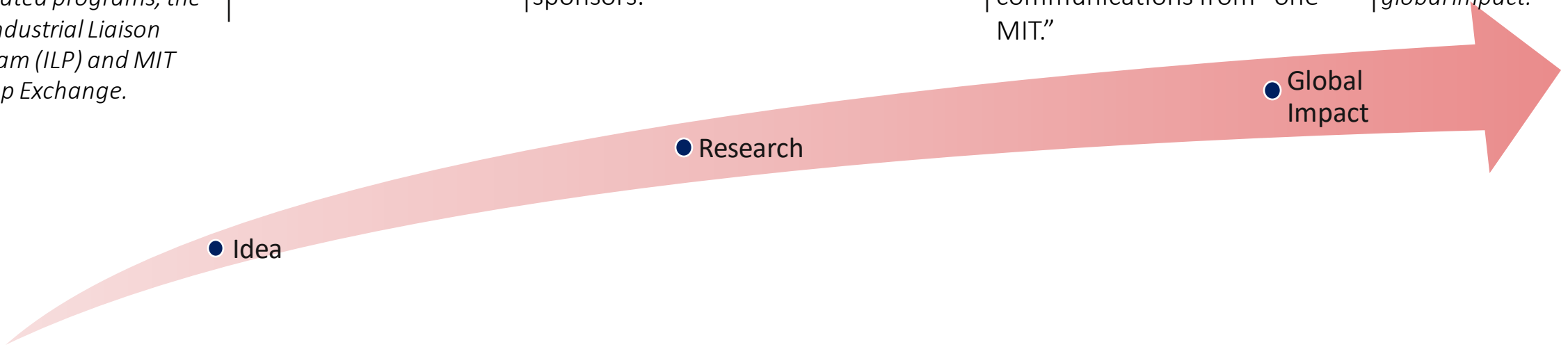
Corporate Relations
Aid and direct companies interested in multidisciplinary involvement with the Institute, and offer industry access to MIT through two integrated programs, the MIT Industrial Liaison Program (ILP) and MIT Startup Exchange.

Catalysts ●
Convert faculty-initiated ideas to campus investment through research agreements

Strategic Transactions Officers ▲
Develop and negotiate sponsored research and research-related agreements that manage risk and opportunity for faculty-led research teams, particularly with non-federal sponsors.

Alliance Managers ◆
Work with faculty, companies, and DLCs to ensure that MIT’s relationships are collaborative, forward looking, and built on strong, consistent communications from “one MIT.”

Technology Licensing Office
Move innovations and discoveries from the lab to the marketplace for the benefit of the public and to amplify MIT’s global impact.



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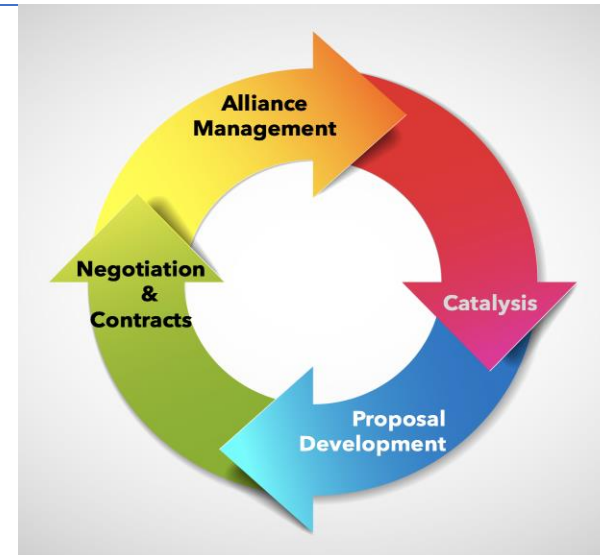


The OSATT CORE team drives the process to help secure industry funding to support a successful project



OSATT supports researchers across these phases, in collaboration with RAS, VPR & VPF. We provide:

- ✓ Researcher-centric communication
- ✓ High-touch, fast cadence engagements
- ✓ Focused on risk mitigation and deal making
- ✓ Guide strategic decisions about opportunities in constrained environment
- ✓ Connected with existing compliance and oversight mechanisms in RAS & VPR



OSATT Catalyst is your Navigator

- Engage in initial discussions with the **Company** and **Faculty** to ascertain the nature of the engagement
- Provide an early review and feedback on the Statement of Work to the Faculty
- Working closely with **TLO**, identify background IP with the Faculty member and to understand the IP portfolio and commercialization strategies
- Coordinate to bring onboard a **Strategic Transactions Officer (STO)** to begin agreement negotiations
- Coordinate with **RAS Contract Administrator (CA)** to ensure smooth and timely compliance checks, and later, setting up award account
- Coordinate with **lab administrator** and **DLC's Financial Officer (FO)** for a smooth set up of KC proposal and budget
- **Keep the Faculty and Company apprised of progress in negotiations**
- Participate with the **STO** in agreement negotiations with the company



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Catalysts support the development of a Statement of Work for an industry agreement

- MIT conducts basic and applied research with no restrictions on access, participation, or dissemination
 - ✓ Industry sponsors may only fund **basic and applied research** with the intent to advance science for the public good
 - ✓ MIT **does not allow** faculty or researchers to engage in **contract research** (aka, work-for-hire), where an individual is hired to complete a pre-determined scope of work, e.g. hiring a designer to build a website.
 - ✓ **Fundamental research**, though sometimes used interchangeably with basic research, is a **legal term of art** in the export control landscape with a specific meaning (more on this later in presentation)
- Research is PI-directed
 - ✓ Companies and faculty/research member discuss **research of mutual interest**
 - ✓ **PI directs the research project** and provides updates to industry sponsor
 - ✓ **Does not guarantee** particular results/outcomes
 - ✓ Describes the research as **an endeavor to complete the plan with unknown results**



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Statements of Work include: who, what, where, when, & how

- **Who** – PI and research team (new hires?), visiting scientists, other collaborators?
- **What** – describe the research to be performed by which members of the team; does it build on an existing IP portfolios?
- **Where** – is research only at MIT or at the company, or both? Domestic vs. international?
- **When** – set forth the anticipated duration & start and end dates
- **How** – consider what resources you will need to perform the work, e.g. any materials and data that the Company and MIT expect to exchange.

Catalyst & STO use additional information to draft a customized agreement

- Anticipated research outputs take various forms, for example:
 - ✓ Publications
 - ✓ Results
 - ✓ Patentable subject matter
 - ✓ Software (copyright)
 - ✓ AI model
 - ✓ Open research?

Catalyst & STO use additional information to draft a customized agreement...

- External confidential information/materials/data
- Other research tools, e.g. third party software?
- Scope overlap with other sponsored research/projects; and analysis of potential implications
- Is Background IP available for licensing? Consideration of its implications.

Agreement Overview

- Named **parties** to the agreement, includes all collaborators, identify a Principal Investigator, Sponsor fit with MIT
- Includes a **timeline** (term) & **budget** amount, approved by DLC Financial Officer; **Statements of work** are incorporated by attachment
- Research compliance, e.g. export control & COI; Protect researchers **right to publish results**
- Addresses intellectual property
- Addresses use of sponsor confidential information, materials, & data
- Use of MIT name (Companies cannot use MIT name to endorse & MIT needs to disclose sponsors of research)
- Risk management: limitation of liability, indemnification, disclaimers of warranties
- Assignment, governing law, dispute resolution



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Creating a customized agreement

- Strategic Transactions Officers use all of the collected information from conversations with Catalysts to create a customized agreement
- More efficient process because first draft is responsive to the parties needs and expectations
 - Collaborative? Data & materials exchanged? Use of CI? Limited Rights? Expanded Rights? Special terms?

Negotiating with the sponsor

- Catalyst & STO are the primary points of contact for negotiation
- Often company's legal team is connected with OSATT, where PI & researchers maintain scientific relationship
- Catalyst updates PI/others on an ongoing basis to keep informed on progress, may need input based on sponsor reaction/response
- OSATT keeps other MIT offices (RAS, VPR, compliance, etc.) informed and involved as necessary; no need for PI to manage those interactions

Catalyst & STO support you by connecting with research compliance resources

- Guided by Federal laws & MIT policies
- Export Control Restrictions ([MIT Export Control Team](#))
- Foreign Engagement/International Activity ([International Coordinating Committee](#))
- [Conflict of Interest](#) / Conflict of Commitment
- Environment, Health, and Safety Management
 - Human Subjects ([Committee on the Use of Humans as Experimental Subjects – COUHES](#))
 - Animal Usage ([Committee on Animal Care](#))
 - Committee on Radiation Protection ([EHS](#))
 - Radioactive Isotopes
 - Biohazard Materials & eSC (Committee on Assessment of Biohazards and Embryonic Stem Cell Research Oversight)
 - Recombinant DNA technologies & synthetic nucleic acids
 - Human, animal or plant pathogens including prions
 - Primary human cells, tissues or materials
 - Established human cell lines
 - Human embryonic stem (hES) cells and induced pluripotent (iPS) stem cells
 - use of biological agents at BL1 or greater including viral vectors
 - nanoparticle-based nucleic acid or drug delivery systems



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Alliance Management is a faculty-centric interface for the engagement

- Institution-Level Relationships
 - E.g., agreements across MIT, memberships, consortia
 - Comprehensive knowledge resource to OSATT, Lead PI, DLCs, others
 - Summaries & kickoff meetings, explain engagement(s), answer Qs
 - Comms conduit for DLCs, external parties, central offices
- Interim Program Manager Role
 - Not every engagement: The AM team helps, when it is helpful (faculty-centric)
 - Work with DLC and Lead PI to hire & onboard permanent PM
 - Perform PM duties until permanent hire onboarded
- Special Projects

Questions? Thank you!

Email: osatt@mit.edu

Today's panelists:

Grace Leung, PhD (Life Sciences), Catalyst

Subarna Basnet, PhD (Engineering), Catalyst

Leah Tenney Keating, JD, Senior Strategic Transactions Officer & RAS Liaison

Michael Leskiw, JD, Alliance Manager (moderator)

[TLO IAP Intellectual Property Speaker Series](#)



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