The Division of Research Affairs (DRA) and the Technology Transfer Office (TTO) work together to serve SDSU for the management of new intellectual property developed by SDSU faculty and staff. Both play an active role in this management with several different responsibilities that work together to ensure compliance with all relevant laws as well to open doors for positively impacting the communities in which our researchers work.

DRA Responsibilities:

The DRA manages the University Copyright and Patent Committee (UCPC) which is the Senate committee responsible for the first review of appropriateness of disclosure and assignment to the university. The UCPC members are appointed by the DRA for annual terms; members commit to meeting at least once per month on the regularly scheduled UCPC review date. Traditionally, this is the first Tuesday of every month at 12:45. The committee is charged with reviewing new disclosures and recommending to the Vice President of Research whether or not to accept such disclosures, to review and propose policies impacting intellectual property (IP) management at SDSU and to review and recommend resolutions for issues concerning IP, including issues concerning amount of institutional support and exceptional circumstances that impact royalty sharing for a specific disclosure.

Beyond the UCPC, DRA reviews disclosures to accept or reject assignment of IP. As such, the VP of Research accepts the IP assignment on behalf of the university which is in turn assigned to the SDSU Research Foundation for management by the TTO. The assignment agreement will define the royalty sharing amount for the inventors/authors in order to ensure that the faculty understand the amounts and calculations prior to commercialization efforts.

Additionally, DRA is responsible for the management of Material Transfer Agreements (MTAs). MTAs are important documents for technology transfer; they can be both free as well as generate revenue, they allow important technologies (especially cell and mouse lines) to be used for further research at other institutions, and they manage how the sharing of these tools will impact further, downstream faculty build spin-out companies based on assigned IP development of IP. It is important to understand the purpose of using MTAs and that, for many reasons, these documents can be difficult to negotiate between different entities. Also, they have a long-term impact on IP creation at SDSU because of the strings that might be attached to using material from another researcher at a different institution in the development of new IP. Faculty should always keep a record of MTAs related to their research and make sure their disclosures describe how materials were used to develop the IP stemming from MTAs or if the materials had been shared through an MTA.

TTO Responsibilities:

The TTO is responsible for the protection and commercialization of assigned IP. In this respect, the TTO acts as the business development specialist for the faculty inventors/authors. The TTO is part of the SDSU Research Foundation, reporting to the Associate Executive Director of Research Advancement. The main activities of the TTO are to help faculty disclose new IP; hire and manage patent attorneys to
protect IP; develop cooperative research agreements with corporate collaborators/sponsors; source, negotiate and execute license transactions; negotiate and execute Confidentiality Agreements; distribute royalties to stakeholders; file notice of invention with sponsoring agencies; and provide guidance on other IP-related issues.

Additionally, the TTO assists faculty in establishing spin-out companies based on licensed IP.

Disclosure Process:

Disclosures are made through an online knowledge management system (Wellspring); in order to file the first disclosure, faculty must contact the TTO to have a username and password created for him/her. The online disclosure system is straightforward in its approach; it asks the inventor/author to answer standard questions about the new IP such as describing the technical attributes, if there are co-inventors/co-authors, federal grant support used to develop the creation, and if there was any institutional support used to develop the IP. Institutional support can be a difficult issue to some projects; we highly encourage inventors/authors to contact the TTO to provide assistance in understanding and reporting this correctly.

Once the disclosure is filed in the system, the TTO reviews the disclosure to ensure it is complete. Additionally, the TTO analyses the disclosure to provide feedback as to patentability, commercial viability, and market need. This review is used by the UCPC during its monthly review of disclosures. Because the committee only meets the first Tuesday of each month, the committee only reviews disclosures completed at least the Tuesday prior to the meeting in order to provide the members sufficient time to review the technology. One committee member is assigned to each disclosure as a technical lead to present the disclosure; providing the rest of the committee the ability to ask relevant questions about the technical feasibility of the invention as well as other aspects about commercialization and appropriateness of assignment to the university. The TTO provides additional resources to the committee, but is not a voting member. Committee members decide on a strategy and course of action for each disclosure which is recommended to the VP of Research for ultimate decision and acceptance of the assignment.

The acceptance of the assignment is sent to the TTO for further processing. The inventors/authors are asked to execute an assignment agreement that includes how royalties are shared amongst the pool of inventors/authors. All must execute the agreement with the same terms for the agreement to be executed by the TTO.