

OUR PRACTICE

University Technology Transfer and Commercialization

University technology transfer and commercialization is laden with unique challenges, and the professionals in Baker Donelson's University Technology Transfer and Commercialization Team have the tools and experience to assist universities and their licensed startup companies alike to address these issues.

Our team has extensive experience assisting stakeholders throughout the technology transfer ecosystem with all aspects of the technology commercialization life cycle, including technology disclosure review, patent prosecution and patent portfolio management, intellectual property and business litigation, corporate structuring and corporate finance, license negotiations, and government contracting and regulations, among others.

- **Technology Disclosure Review**. The technology commercialization life cycle starts with the disclosure of research to a university technology transfer office by its faculty, students, and staff. We have professionals with first-hand experience in triaging technology disclosures and can help technology transfer offices map the most efficient route to market.
- **Patent Prosecution and Portfolio Management**. Patent applications and patents are the linchpin of university technology commercialization. Baker Donelson's bullpen of patent professionals, including former research scientists and industry professionals, has the knowledge to navigate the murky waters of patent offices both in the United States and abroad, assisting universities and companies alike in obtaining meaningful, enforceable patents in the fields of life sciences and biotechnology, medical devices, mechanical and electromechanical engineering, and chemical engineering, among others.
- **University IP Policy and Procedures**. In working with technology transfer offices with varying degrees of experience, our team is well-positioned to help emerging technology transfer offices lay the foundation for growth and success by assisting our clients establish and/or update their IP policy and procedures, including those governing patented inventions, trademarks, copyright, and works of art, among others.
- **Corporate Structuring and Finance**. University technologies are ideally suited for follow-on research and development by startup and emerging companies. We assist our clients with entity formation, vendor agreements, debt and equity financing, including convertible notes, venture capital, and angel investments. We provide clients with strategic guidance about the best options for each company's particular situation.
- **License Negotiations**. The heart of technology transfer is the licensing of intellectual property from a university to a company. With experience on both sides of the table, Baker Donelson's professionals can offer unique perspectives on license agreements and negotiations, assisting our clients in tailoring each license agreement to their specific goals.
- **Intellectual Property and Business Litigation**. When litigation cannot be avoided or resolved, Baker Donelson's intellectual property and business litigation attorneys are well-versed in litigation strategies. They have extensive knowledge and hands-on experience gained from handling cases

throughout the United States for a wide variety of clients, ranging from single inventors to Fortune 100 companies.

- **Government Contracting and Regulations**. Whether it be obtaining and managing a federal commercialization grant through the Small Business Association or seeking FDA approval, Baker Donelson's professionals regularly practice in the most dynamic areas of government contracting and regulations. Baker Donelson's team can advise clients in all aspects of government contracting at the federal, state, and local levels, while also helping to navigate the complexities of the regulatory environment created by the U.S. Food and Drug Administration (FDA).
- **Faculty and Staff Education**. With experience working with both large and small university technology transfer offices across the United States, our team is well-positioned to present educational and training sessions for faculty, students, and staff so as to make the university technology transfer process more efficient and productive.



Representative Matters

- Manages global patent portfolio directed towards antibodies and vaccines for infectious diseases and cancer for a world-renowned teaching hospital.
- Manages worldwide patent portfolio directed towards vaccine compositions for infectious viruses for a research institute.
- Manages a diverse patent portfolio for a public university health sciences center.
- Prosecutes patent applications before the United States Patent and Trademark Office (USPTO) for university clients in Europe and South Africa.
- Advised a student-run startup company during negotiations with a university technology transfer office for the license to a diagnostic imaging device and method.
- Advised a university spin-out company during negotiations with a university technology transfer office for the license of a surgical graft.
- Assisted a university client on intellectual property and technology transfer policy.