Supporting Inventors and Commercializing Innovations Across The Texas A&M University System

Pete O'Neill
Chief Innovation Officer

25 April 2024
TEXAS A&M INNOVATION | INVENTOR PROCESS

System-Wide Inventions

Council of Inventors

Invention Disclosure 3 days

Quick Assess 3 wks

Deep Assess 3 mths

Enhance (TIF, ADM, SBIR)

Address Commercialization Challenges

Close Innovation Project

Portfolio Evaluation and Management Committee

Market Advisory Groups

AI & Cyber Across Industries

Commercialization Plan

License

NewCo

Commercialization Pathway
IP Review of Sponsored Research Agreements

- Sponsored research very valuable contributor to IP creation.
  - Many sponsors are potential commercialization partners.
- Review agreements with non-standard IP terms.
  - With OGC, process for Vice Chancellor to approve.
  - Exception for “testing” agreements.
  - Working on other exceptions.
IP Review Considerations

- **IP language = fair:**
  - Does language provide appropriate IP rights to Texas A&M?
  - Does language provide reasonable opportunity for sponsor to obtain IP rights to support their commercialization needs?

- **SOW review**
  - Is the work described in the SOW likely to create IP with valuable commercial potential?
  - Is the SOW highly prescriptive such that Texas A&M’s role is simply to execute the SOW?
    - Vendor.
  - Does the SOW anticipate Texas A&M making intellectual contributions?
    - Development partner.
Fair Market Value

• As a not-for-profit, we are obligated to receive “Fair Market Value” in exchange for grant of IP rights.
• Most SOW budgets are based on personnel hours and equipment usage.
  – Do not include consideration for grant of IP rights.
• Conceptually difficult to define value of IP that will be created in the future.
  – Preferred approach, option to negotiate for future IP rights,
  – Option terms include significant preferences to the sponsor,
  – Partnership relationship should lead to additional preferences to the sponsor.
PI Guidance for IP

• PIs often have close, long-term relationships with their sponsors: exactly what we want.
• IP rights to sponsors can lead to restricting research beyond length of sponsored agreement.
• If SOW does not describe creation of IP, then IP that is created should not be included in sponsored work.
Questions?

• Pete ONeill: poneill@tamus.edu
• https://innovation.tamus.edu