

Quick Start Inventor's Guide to Technology Transfer at Syracuse University

An excerpt for new Syracuse University faculty

The full [Inventor's Guide](#) is available on the [Office of Technology Transfer website](#).

What is the Office of Technology Transfer (OTT)?

The Office of Technology Transfer is a unit of the Office of Research, and reports to the Interim Vice President of the Office of Research. The OTT Director is a generalist skilled in managing intellectual property (IP) portfolios, from invention triage to facilitating patent drafting, filing and the patent 'prosecution' process with outside patent counsel. In addition, the office has expertise in transactional (contractual) matters regarding university IP including licensing, business formation, and related legal affairs. OTT has experience in transferring technologies from the physical sciences, life sciences, and information and computer sciences and more. The Office manages invention disclosures from all schools, colleges and administrative departments at Syracuse University. OTT interacts with all Syracuse University offices and departments relative to matters of intellectual property, technology transfer and industrial development - primarily - the Office of Sponsored Programs, Office of Corporation & Foundation Relations.

What is the primary policy governing Intellectual Property at Syracuse University?

See the [Excerpt of the Syracuse University Faculty Manual](#) on the Office of Technology Transfer website.

How do I work with the Syracuse University Office of Technology Transfer (OTT)?

We encourage inventors to contact the Office of Technology Transfer during their early research activities to be aware of the options that will best leverage the commercial potential of their research. OTT professionals are trained to assist you with questions related to applicable university policies & procedures, patent law, marketability, commercial partners, funding sources, new business start-up considerations, and much more.

What are the typical steps in the technology transfer process?

The technology transfer process is summarized in the following steps. Steps vary in duration, and may vary in sequence, and often occur simultaneously.

1 - Research Step:

How are innovations that may benefit from intellectual property protection created?

- Observations and experiments during research activities often lead to discoveries and inventions.
- An invention is any useful process, machine, composition of matter, or any new or useful improvement of the same.
- Often, multiple researchers may have contributed to the invention.

2 - Pre-Disclosure Step:

- New inventors are encouraged to speak with the Office of Technology Transfer (OTT) staff early, via a short meeting or e-mail exchange.
- This early contact will allow the inventor to share high-level facts about the technology and for OTT to provide feedback about next steps.

3 - Invention Disclosure Step:

- To officially inform Syracuse University of a new invention, complete the invention disclosure form available on the [Submit an Invention](#) page of the Technology Transfer website.

4 - Assessment Step:

- Completed invention disclosures are reviewed by OTT staff.
- The assessment period often consists of internal and external reviews of the technology.
- In assessing the technology disclosure, the following elements and more are considered: time bars; whether the technology was developed in the context of federal funding or other (i.e. corporate) sponsored research; status quo of the field as exemplified by past publications and other prior art; patentability; market niche; competitive advantage; existing competing technologies; and the invention's commercialization potential.

TIMING: PUBLISH, WHILE PRESERVING THE ABILITY TO PATENT. WHILE IT IS CERTAINLY POSSIBLE TO BOTH PUBLISH AND PURSUE PATENT PROTECTION, IT TAKES A LEVEL OF CARE AND AWARENESS BETWEEN THE RESEARCHER AND THE OTT. AS SUCH, WHENEVER POSSIBLE, PLEASE ALLOW 2 MONTHS BETWEEN COMPLETING AN INVENTION DISCLOSURE AND PRESENTATIONS OR PUBLISHING. IF YOUR PRESENTATION, PAPER OR GRANT APPLICATION IS DUE SOONER, WE WILL MAKE EVERY EFFORT TO EXPEDITE OUR PROCESS. PLEASE CALL 315-443-5196 IF YOU FIND YOURSELF IN THIS SITUATION.

UNIQUE APPROACHES: ALL UNIVERSITIES HAVE DIFFERENT APPROACHES TO HOW THEY HANDLE INVENTION DISCLOSURES AS RELATES TO WHICH TECHNOLOGIES ARE ULTIMATELY FILED AS PATENT APPLICATIONS AND WHEN.

INVENTION DISCLOSURES RECEIVED BY SYRACUSE UNIVERSITY ARE NOT AUTOMATICALLY FILED AS PATENT APPLICATIONS WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO). IN OTHER WORDS, FILING AN INVENTION DISCLOSURE WITH SYRACUSE UNIVERSITY OTT DOES NOT RESULT IN INSTANT OR AUTOMATIC PATENT PROTECTION.

5 - OTT Decision:

- In most cases, inventors will be informed no later than six weeks from the date of invention disclosure of the decision regarding patenting or other IP protection – this time lag is when technology assessments are conducted.
- This decision is most commonly communicated to the faculty innovators involved.

SYRACUSE UNIVERSITY, VIA THE OTT, CONTRACTS WITH OUTSIDE PATENT COUNSEL, FOR THE REVIEW OF INVENTION DISCLOSURES, DRAFTING, FILING, AND PATENT PROSECUTION OF PATENT APPLICATIONS. WHILE SYRACUSE UNIVERSITY INVENTORS ARE CLOSELY INVOLVED IN THIS PROCESS, IT IS SYRACUSE UNIVERSITY THAT IS THE CLIENT OF THE LAW FIRM HANDLING THE PATENT MATTERS.

6 - Protection Step:

- Various forms of IP protection are available under the law, and the protection step refers to the process (or in some cases, multiple processes) in which protection for an invention is pursued.

- Patent protection at Syracuse University often begins by filing a U.S. provisional patent application. This type of application is something of a “placeholder,” and it expires 1 year after filing.
- When Syracuse University decides to continue patent protection beyond a provisional application, a utility patent application is drafted and filed with the U.S. Patent and Trademark Office.
- A Patent Cooperation Treaty allows for future entry of a patent application into foreign patent offices.
- Once a utility patent application has been filed, it typically requires several years and tens of thousands of dollars to obtain an issued U.S. patent, and more time and money for foreign patents.
- Not all patent applications will result in a patent being issued.
- Other intellectual property protection methods (which may include copyright) may also be appropriate, as is true of software, for example.

7 - Marketing Step:

- With your active involvement, the Technology Transfer staff work to identify candidate companies that have the expertise, resources and business networks to bring the technology to market.
- This may involve partnering with an existing company or forming a start-up.

8 – Assessing the Commercialization Paths Available (Pre-Intellectual Property Licensing)

8(a) - Identifying a Potential Licensee (Existing Business) Step:

- If an appropriate and interested existing company, or companies, is selected as a potential licensee, OTT staff works with those potential licensees to develop the appropriate financial and diligence terms to fully commercialize the technology.

8(b) - Form a Start-up:

- If creation of a new business start-up is deemed the optimal commercialization path, then OTT staff will provide information on the start-up company resources (both internal and external) that are available.
- For additional information, please refer to the *Syracuse University [Inventor’s Guide to Technology Transfer](#)* section entitled "Considerations for a Start-Up Company"

9 – License Negotiation & Execution Step:

- A license agreement is a contract between the University and a third party in which Syracuse University's rights to a technology are licensed, without relinquishing ownership, for financial and other benefits.
- While a license will always address certain things, there is no one-size-fits-all license.
- Negotiating license terms requires a give and take between Syracuse University (via Technology Transfer staff) and the potential licensee.
- While the Technology Transfer staff will inform innovators that license negotiations are underway, it is important for innovators to treat the entire endeavor – who the potential licensee is; how the company would make use of the technology (i.e. what markets); and all the other details – in confidence.
- Learn more about this process by consulting the Syracuse University [Inventor's Guide to Technology Transfer](#).

10 - Commercialization Step:

- The corporate entity that has secured the intellectual property license from Syracuse University commercializes the technology.
- The licensee continues to advance and develop the technology and make other business investments to develop the product or service.
- The path to commercialization involves many pre-commercial steps, which could include prototyping, regulatory approvals, and more.

11 - Revenue Step:

- Revenues received by the University from licenses are distributed in accordance with Syracuse University policy to financially reward inventors and to encourage further participation in the technology transfer process.
- See [Section 3.23 of the Faculty Manual, Ownership and Management of Intellectual Property](#) under the heading "Distribution of Revenue from Technology."

12 - How long does the tech transfer process take?

- The process of protecting the technology takes years.
- Finding the right licensing partner often also takes years to complete.

For more information, contact:

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