

# Technology Transfer Procedure

## 1. Purpose

### *Background*

In June 2022, the ATU Governing Body approved the ATU IP Policy which clarifies the role of Intellectual Property in the activities of the University. It takes account of the requirements of the National IP Protocol and draws on guidelines from various research funding agencies in relation to the treatment of Intellectual Property and similar policies from a selection of Irish and international Higher Education Institutions. This Policy sets out the principles and rules that govern the creation, ownership and commercialisation of Intellectual Property which is created by University personnel during the course of any Funded Research and/or while making more than incidental use of the University resources.

### *Purpose of document*

The purpose of this document is to outline in more detail the process steps that are involved in bringing new inventions through the Technology Transfer process. The intent is to enable researchers, inventors and innovators to have a better understanding of Technology Transfer and the various stages, associated forms, evaluations and approvals processes involved.

## 2. Scope

There are many potential avenues that researchers/inventors/innovators may explore in the process of disseminating their idea/technology etc to another person or organisation, in order to transform inventions and scientific outcomes into new products and services that benefit society. This document does not cover every possible avenue but endeavours to cover the most common potential stages that a researcher/inventor/innovator may encounter from Invention disclosure through to routes to market.

The following is included:

- The most frequently used types of agreements/documents that are typically associated with Technology Transfer and Intellectual Property.
- Approval authority required for such documents/agreements as well as in seeking/retaining IP protection
- The process of seeking and retaining IP protection

## 3. Procedure Description

### *3.1 Invention disclosure*

3.1.1 It is important that if a researcher/inventor/innovator believes there is any potential Intellectual Property in something that they are working on, that they disclose this as early as possible to the Technology Transfer Office to avoid the unintentional loss of available protection.

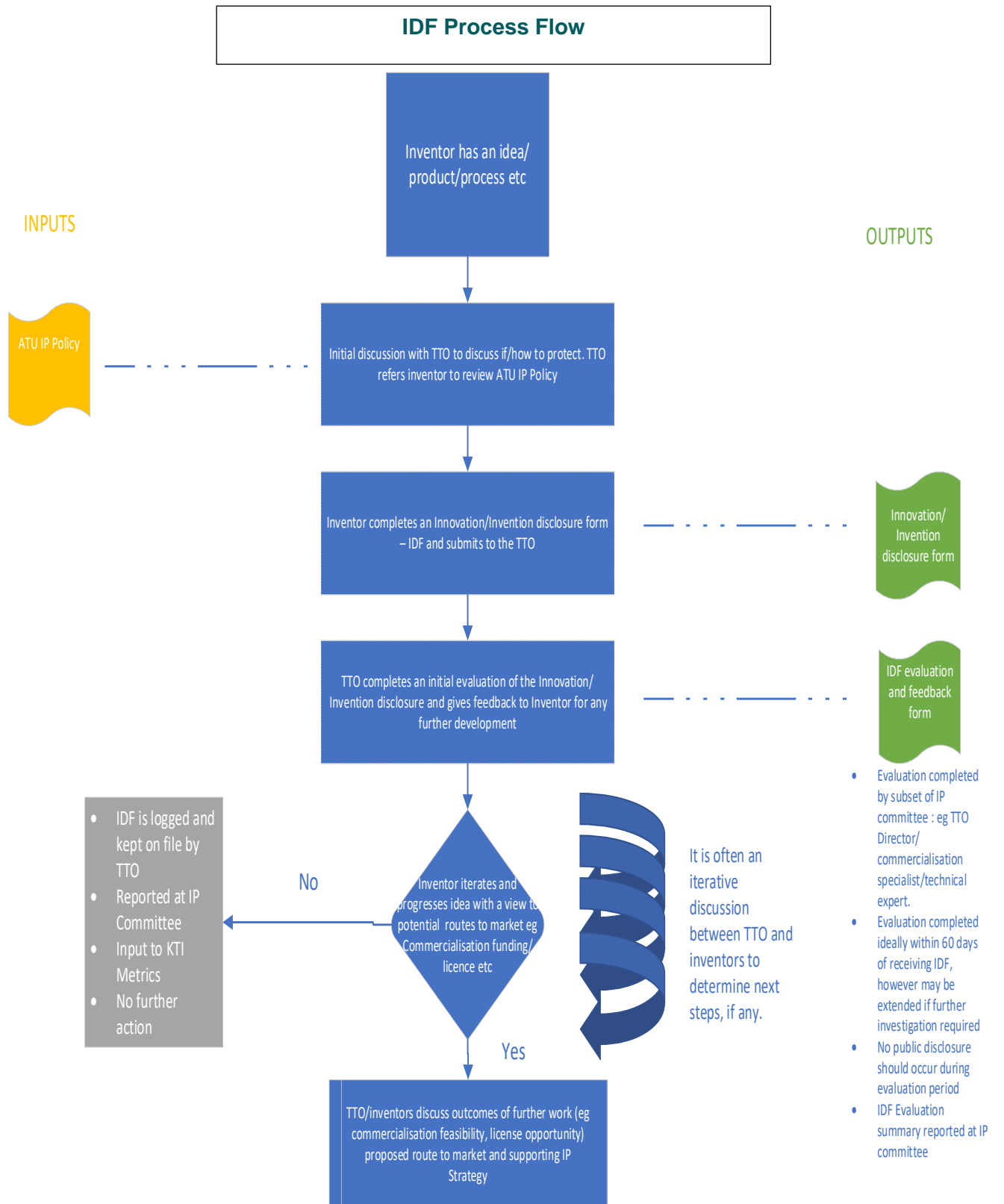
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- 3.1.2 Once the TTO is engaged they will request the inventor to prepare and submit an Invention Disclosure Form (IDF). (See appendices)
- 3.1.3 The TTO will discuss and assess the IDF within 60 days of receipt, (calling on other expertise as required) and will provide feedback to the inventor which may include:
- a. Indication of novelty through initial patent search outputs relevant to the topic
  - b. Suggestions on commercialisation/routes to market
  - c. Suggestions on licensing
  - d. Further information required and/or next steps

The IDF will be assessed using the IDF Evaluation Form (See appendices) and feedback will be given on the IDF Evaluation Feedback Form (See appendices)

- 3.1.4 If the invention/innovation has been discovered through an existing research project, then a commercialisation path/route to market may already be planned. If, however, this is not the case, and there is currently no commercialisation path/route to market identified then potentially a recommendation will be made to seek funding to undertake commercial feasibility and develop a route to market plan.
- 3.1.5 If it is deemed that there is nothing novel or protectable or there is minimal commercial opportunity, then the IDF will be logged and submitted for KTI metrics, notification will be made to the IP Committee, and no further action will be taken by the TTO.

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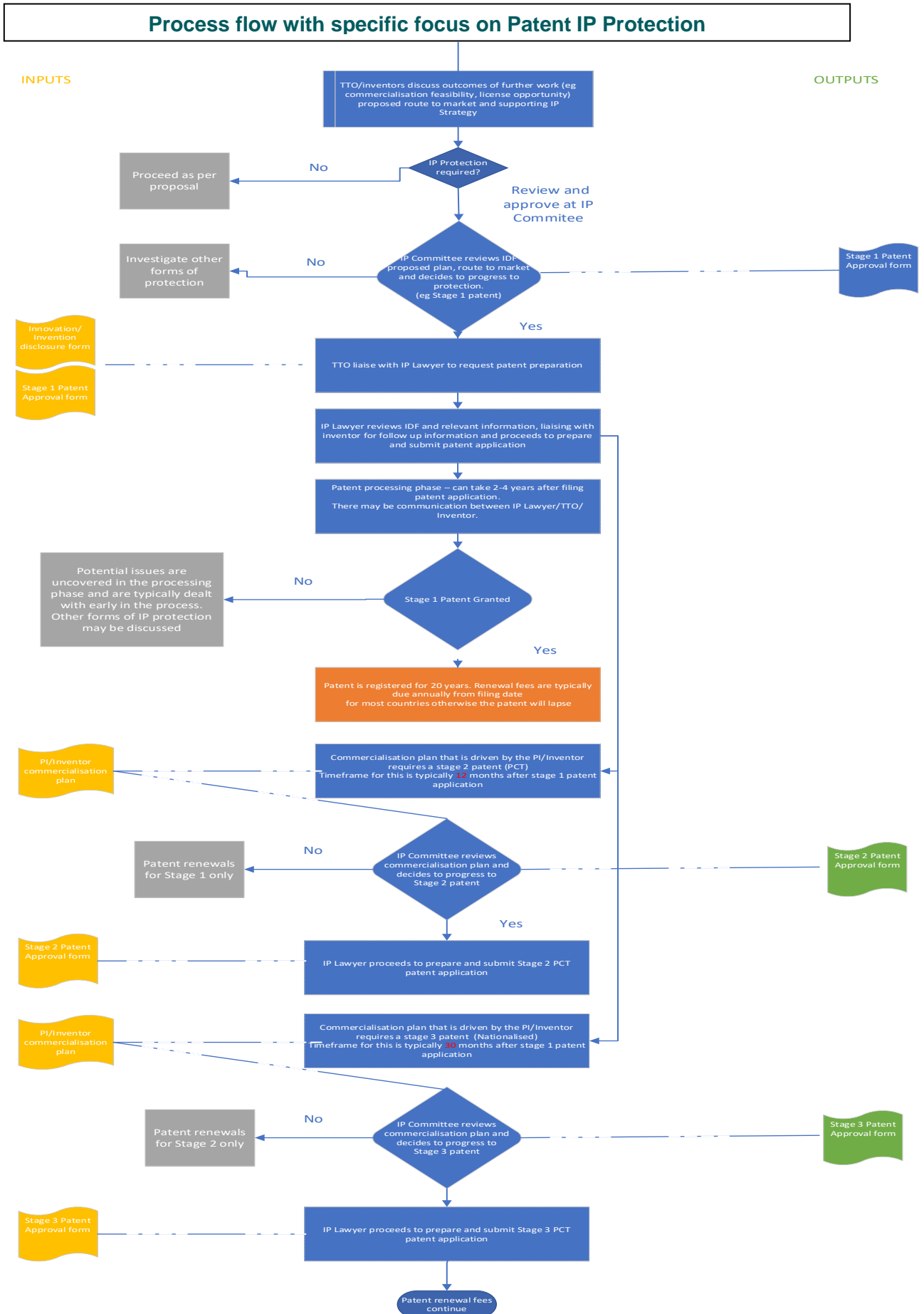
### 3.2 Commercialisation and route to market

- 3.2.1 If there is no current commercialisation/route to market identified and there is perceived merit in investigating further, the TTO may propose an initial discussion with Enterprise Ireland to investigate if Commercialisation Feasibility Funding or a full Commercialisation Project funding may be an option. The TTO will liaise with the EI Commercialisation Specialists and the Inventor team to progress and submit applications, as appropriate.
- 3.2.2 If the route to market is identified through the potential of a licensing agreement with a company, the TTO will identify and engage the external expertise required to progress licensing negotiations and agreements as appropriate.

### 3.3 IP Protection

- 3.3.1 Through the process of assessing the commercialisation/route to market options, an approach and strategy for IP should be developed as appropriate. The TTO will aid in this process and engage the relevant external expertise to investigate the most appropriate form of IP Protection.
- 3.3.2 If the IP strategy determines that IP should be protected and it is deemed that the IP is protectable (by expert advice), then the decision to protect the IP would be made by the IP Committee.
- 3.3.3 The Researcher/inventor/innovator team along with the TTO prepares a recommendation to present to the IP Committee which may include, (but is not limited to) the following: what form of IP Protection is being sought, Commercialisation viability and route to market, potential costs of protection, funding, project plan.
- 3.3.4 If the form of IP Protection being sought is a patent, then there will be approvals required from the IP Committee at the stages when patent applications are being initiated (stage 1) and then move from Initial patent (Stage 1 approval) to PCT/International patent (Stage 2 approval) and are then nationalised (Stage 3 approval) (see appendices). At each of these stages, the IP committee will assess the project development including (but not limited to); technical progress, business plan, commercial viability, competitor landscape, costs etc. Patents are expensive and the University must ensure that such significant investments have a viable return.
- 3.3.5 Once a patent application has been submitted it can take up to 4 years to be granted, however patent renewal costs will start to accumulate from the date of application and are typically billed annually, otherwise the patent will lapse. Patents last for 20 years. It is at the discretion of the IP Committee to decide at any point whether it is in the interest of ATU to continue to pay patent renewal costs (ref ATU IP Policy)

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## *Note on Patent renewal costs:*

- Many countries charge a patent renewal fee 2 years from the original filing date even though the patent has not yet been granted, however some countries only charge renewals after the patent has been granted.
- Many patents are filed in Europe or UK first (stage1) and then followed up with filings in other countries within 12/18 months (stage 2 PCT). The PCT filing can keep options open for further worldwide filings for a further 18 months
- European PCT filing is one filing that covers 38 countries, however after a European patent is granted, the renewals are charged for each of those countries separately
- Patent application and renewal fees can vary widely based on jurisdictions however a guideline of costs is as follow
  - €2k for a preliminary application
  - €15k for PCT application and associated renewals per annum
  - €30k for nationalised patent associated costs per annum(depending on countries)

It is the intent that technologies developed in the University are 'transferred', to become available to wider society and therefore commercialised/brought to market through the most appropriate means eg. spin out or license/assignment. ATU will constantly base decisions to pay patent renewal costs on the commercial viability and the appropriate progression of commercialisation/route to market plans.

Further information on how ATU deals with Spin outs and Licensing is in the ATU IP Policy and all decisions to progress these will be made by the IP committee and ATU Executive/Governing Body as appropriate. The TTO will provide assistance as necessary.

## **3.4 Approval Authority**

- 3.4.1 The IP Committee has the authority to review and approve decisions regarding the pursual of IP Protection, eg Initial patent applications (stage 1) and at further stages where the patent may be broadened to other jurisdictions (stage 2 PCT and stage 3 nationalised). As per the ATU IP Policy, the IP committee also has the authority to decide to withdraw from any form of IP Protection.
- 3.4.2 Throughout the process of 'Technology Transfer' there are many different types of Agreements, Letters of Offer, Contracts etc that need to be signed in order to signify approval. The ATU President has designated authority to the campus VP's of Research Innovation and Engagement as the ONLY signatory authorities on ALL types of agreements, Letters of Offer, contracts etc.

Examples including (not an exhaustive list )

- Non Disclosure Agreement,
- Memorandum of Understanding,
- Joint Ownership Management Agreement
- Research agreement
- Innovation Vouchers
- Letters of Offer from funders
- Contracts (Funded project/other)

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- Licensing Agreement
- Spinout Agreement
- Shareholding Agreement

If in doubt of who has authority to sign any documentation related to research and technology transfer, please refer to the VP of Research Innovation and Engagement in the local ATU campus. Standard ATU templates for required documents/types of agreements can be found in the ATU Policies and Procedures portal.

### **4. Records generated by this Procedure.**

Records generated under this procedure will be held by the TTO in accordance with the provisions of the Data Protection Acts.


### **5. Measurement of Effectiveness of this Procedure.**

Not applicable at this time.

## Technology Transfer Procedure

### Revision History:

<b>Date:</b>		April 2023	Date of next review:	April 2024
<b>Version Number/ Revision Number</b>	<b>Revision Date</b>	<b>Summary of Changes</b>		<b>Changes marked</b>
1	April 2023	New Procedure		

<b>Date Approved:</b>  20 <sup>th</sup> April 2023	<b>Date Procedure to take effect:</b>  20 <sup>th</sup> April 2023	<b>Date Procedure to be Reviewed:</b>  20 <sup>th</sup> April 2024
Written by:	Head of Enterprise and Engagement	
Approved by:	University Planning Team	
Head of Function responsible:	VP for Research and Innovation and Engagement	
Reference Documents:	ATU IP Policy  <a href="#">ATU IP Policy</a>	

### Document Location:

Website – Policies and Procedures	X
Website – Staff Hub / Innovation SharePoint Site	X
Website – Student Hub	
Other: - Internal Use Only	

**It shall be reviewed and, as necessary, amended by the University annually. All amendments shall be recorded on the revision history section above.**



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## Appendices



ATU Invention Disclosure Form



ATU MOU Template



ATU Invention Disclosure Evaluation



ATU One Way NDA



ATU IDF Evaluation Feedback form



ATU One way NDA for staff\_collaborator



Approval of Stage 1 (Initial) patent filing



ATU Reseaarch programme plan



Approval of Stage 2 (PCT) patent filing



ATU Shareholder agreement



Approval of Stage 3 (nationalised) patent f



ATU wholly funded industry collaborative



ATU Consultancy Agreement



ATU two way non disclosure agreement



ATU COVID19 Non exclusive royalty free



ATU Part industry funded collaborative r



ATU EI Innovation Voucher contract



ATU Term sheet for company spiout\_com



ATU EI IPP Heads of Agreement



ATU IP licence for a spinout agreement



ATU Joint Ownership and Management Agr