GenomeWeb
biotechTrans

Tech Transfer White Paper Authors Hope to Spur Debate, Socially Responsible Licensing

[March 19, 2007]

By Ben Butkus

This article has been updated from a previous version, which incorrectly stated that the socially responsible licensing program began at Stanford, rather than UC Berkeley.

Earlier this month, a group of leading US research universities and members of the Association of American Medical Colleges released a set of guidelines for universities and non-profit research institutes to consider when licensing internally developed technologies to private parties.

The white paper, entitled "In the Public Interest: Nine Points to Consider in Licensing University Technology," is thought to be the first document from members of the tech-transfer community that suggests a set of good practices.

"We thought it was really a time to go back to fundamentals, and think about what the values are that really should drive university technology management," Arthur Bienenstock, special assistant to the president for federal research policy at Stanford University and primary organizer of the white paper authors, said last week.

The paper aims to trigger discourse that might strengthen the field, but also comes at a time when technology transfer and the Bayh-Dole legislation that enables it have come under especially heavy fire from critics – which is another major reason the collective felt compelled to draft the document, Bienenstock said.

The white paper grew out of a meeting on Stanford's campus last July, which brought together university research officers and technology-licensing directors from leading US research institutions. In addition to Stanford, the paper was signed by the California Institute of Technology; Cornell University; Harvard University; Massachusetts Institute of Technology;

In This Week's Issue

the University of California system; the University of Illinois, Chicago and UI-Urbana-Champaign; University of Washington; Wisconsin Alumni Research Foundation; and Yale University; as well as the AAMC.

The full paper can be seen here.

According to Bienenstock, who is a former vice provost and dean of research and graduate policy at Stanford, several sources of criticism spurred him and Kathy Ku, Stanford director of technology licensing, to organize the group that produced the paper.

One was criticism by freelance journalist Jennifer Washburn "that universities were coming too close to industry in inappropriate manners," Bienenstock said. Washburn has penned multiple critical articles of university tech transfer, and in 2005 authored the book *University, Inc.: The Corporate Corruption of Higher Education*.

Bayh-Dole Still Alive ar
Producing the Intende

North Carolina Biotech
Aldagen, BASF, Targac
Exeter Life Sciences, S
UTMB-Galveston, Genc
Planck, Miraculins, Mou
Product Development,
ImQuest, University of
Miriam Hospital/Brown
Pittsburgh, Hiberna, Cl

Tony Armstrong, Mark
Canada, Douglas Wooc

"On the other side, you had business people saying that universities were very difficult of intellectual property," Bienenstock added. "[Another reason] was that rumors were r leaders were pressuring university technology managers to maximize income without th other values involved."

Bienenstock also cited ongoing issues that arose around the Wisconsin Alumni Research that universities "take licenses to do research on certain aspects of human stem cells." some of those restrictions and clarified its policies on its stem cell IP (see *BTW*, 3/5/200 clear that this was a particular sticking point.

"As a senior research officer having real responsibility for research at [Stanford], I ente fundamental goals," he said. "First, I wanted to ensure that universities and other non- to do research and advance scientific … fields associated with university-held property. university should hinder another from doing research because of intellectual property."

The white paper is not meant to defend the practice of tech transfer, according to Biene aims is to spur discourse that might strengthen the field.

"Different people will take different items" from the guidelines, he said. "I find myself w the relevant literature about these points that other people feel strongly about. I'm hop Washburn will write and criticize [the white paper].

"In these cases, when you're getting down to fundamentals, it's important to have discu concerned parties," Bienenstock added. "So I'm hoping that people will take it up in the opportunity to think about the criticism we've received."

Carol Mimura, assistant vice chancellor for intellectual property and industry research a California, Berkeley, and one of the paper's co-authors, told *BTW* that Bienenstock and transparency in the way universities managed their IP – more understanding, in genera both public and private, manage their IP.

"There are manuals published by [the Association for University Technology Managers] practitioners, but from a manager's point of view, there are separate issues to discuss of transacting licenses and funded research agreements," Mimura added.

A Social Compact?

One of the most important of those issues, Mimura said, was to stress the role that univ science for the greater good.

Mimura authored the section of the guidelines that calls for tech-transfer officials to ens
profit research institutes honor their "social compact with society," help "advance knowl
"manage the deployment of resulting innovations for the public benefit."

The guidelines come at a time when technology transfer and the Bayh-Dole legislation that enables it is under especially heavy fire from critics – which is another major reason the collective felt compelled to draft the document.

For example, universities "should strive to cor
arrangements in ways that ensure that … und
low- or no-cost access to adequate quantities
innovations," Mimura wrote.

Such a philosophy, however, seems to be at c
mission of a university tech-transfer office: to
research investment by bringing in as much re

But these two goals do not have to be mutual
BTW. As an example, she offered what she ca
licensing program at UC-Berkeley that emerge
property management offices restructured ab

The resulting reorg combined the office that n
corporate-sponsored research agreements with the office that negotiates outgoing IP lic

The move "resulted in a different definition of tech-transfer success," Mimura said. "At I
'success in all aspects of the industry-university relationship,' including foundation supp
revenue that comes in from outlicensing IP, and then research obtained through the pri

Furthermore, the new structure allowed Berkeley to be part of a much-ballyhooed publi
in 2004 to develop a malaria cure, and which Mimura said has served as the poster chil
licensing.

As part of that deal, the Bill and Melinda Gates Foundation awarded $42.6 million to no
for OneWorld Health to collaborate with Berkeley and its spin-off, Amyris Biotechnologie
disease.

"It's clear that while we were sort of driving the transaction with the lure of a royalty-fr
the developing world, at the end of the day Berkeley was able to get [some] $8 million
basic research, which we wouldn't have had an opportunity to get from a federal fundin
explained. "When your tech-transfer program is open to new definitions of success, it ca
of measuring success, including revenue coming in from the sponsored research side.

"Since we have combined those two units, a given transaction that used to be at the ex
for instance, if it was a royalty-free license, is no longer detrimental because there is a
through the opposite office that brings in revenue, and it's all good for Berkeley," she a

Still, Mimura said it was important for those in tech transfer to realize that a possible fir
lines of the Berkeley-Gates partnership is not the main reason to have a socially respon

"A program where you use royalty-free license agreements or a commitment to maximi
developing world doesn't have to be set up to ensure you don't lose money," she said. '
imperative to do it. We really are trying to maximize our impact, not maximize the reve