

Office of Technology Licensing Intellectual property newsletter



2008 Issue 2

Tennessee Initiative to Promote Commercial Development

The state of Tennessee is trying to promote the commercial development of new technologies created in the state in ways which could benefit St. Jude researchers. These efforts are being channeled in large part through the Tennessee Technology Development Corporation (TTDC), a not-for-profit 501(c)(3) corporation created by the TN state legislature to implement an innovation-based economic development agenda throughout the state.

The TTDC is in the process of establishing a pilot commercialization grant program to provide funding for technology projects that are potentially commercializable, but need additional funding to get to a licensable stage. The program is intended to support research and discoveries from eligible research institutions that will likely lead to the development of new products, services, businesses and employment in the life sciences, engineering, material sciences, computer sciences

and other high technology fields. Eligible research institutions include Oak Ridge National Laboratory, the University of Tennessee, the University of Memphis, The Tennessee Board of Regents universities, St. Jude Children's Research Hospital and Vanderbilt University.

The TTDC is planning to allocate \$1M to this program for 2009. Grants of up to \$100,000 per project will be available to the technology transfer offices at the eligible research institutions.

On November 20 and 21 the TTDC hosted a Tennessee Innovation Conference in Nashville. The primary purpose of this event was to facilitate dialogue with capital investors about potential commercialization strategies for early stage innovations from Tennessee's leading research institutions. A secondary purpose was for venture capitalists to express their perceptions of Tennessee's business climate for venture-backed technology businesses, and provide input on state strategies for increasing the supply and accessibility of capital investment.

Two St. Jude investigators, Drs. Tom Webb and Charles Mullighan, presented inventions from their laboratories. Dr. Webb discussed two different compounds, an inhibitor to the anaplastic lymphoma kinase (ALK) and a novel spliceosome inhibitor. Dr. Mullighan explained a new diagnostic test for acute leukemia that involves detecting abnormalities in the IKAROS gene.

OTL Online Training Module

How long does it usually take to get a patent once an application is filed? What portion of St. Jude licensing income is shared with inventors? How does St. Jude regulate consulting activities? Can we still file a patent application if I have already publicly disclosed my invention?

Answers to these questions and many more can be found at the OTLs recently updated online training module. Anyone interested in learning more about technology licensing activities is encouraged to review this module, which is now a mandatory part of the annual CBL training for postdoctoral fellows. The module includes information about the patent process and agreements for licensing intellectual property, receiving corporate research funding, establishing a confidential relationship, consulting and exchanging research materials. You can access the module through the Learning Network on the intranet site by clicking on "Enroll in CBL". The course is titled *OFFICE OF TECHNOLOGY LICENSING*.

Did you know?

If you received the FluMist vaccine this year, you received a product made using technology developed at St. Jude. In 2001 St. Jude licensed patent rights covering a new way to make influenza vaccine, known as reverse genetics or the plasmid rescue system, to Aviron. MedImmune, the successor of Aviron, used this method for the first time to make its seasonal live, attenuated nasal spray influenza vaccine, FluMist, for the 2008–2009 season.

When Is a Confidentiality Agreement Needed?

A confidentiality agreement (CDA), sometimes called a non-disclosure agreement (NDA), is a formal agreement between two parties to keep certain information confidential. It can be a one-way agreement, under which only one party discloses confidential information, or it can be two-way, covering information disclosed by both parties.

Confidential information generally includes any information that has not been published or publicly disclosed. Examples of St. Jude confidential information include: unpublished materials, reagents, procedures, data, results, conclusions, know-how, experience or trade secrets. Financial information, patient information, and unfiled and unpublished patent applications are also examples of confidential information.

CDAs are used for a variety of interactions whenever there is a need or desire to share unpublished information and keep it confidential. Many licensing negotiations are conducted under a CDA to promote candid discussions between the parties. Discussions regarding a potential research collaboration with a company are usually covered by a CDA. Researchers who are invited to give a seminar outside of St. Jude and plan to disclose unpublished research results outside of St. Jude should consider whether a CDA is warranted. A CDA is also recommended for sharing unpublished clinical protocols with other institutions. Clinicians receiving protocols from pharmaceutical companies for review to determine whether St. Jude will participate in a clinical trial are usually asked to execute a CDA before a copy of the protocol is provided.

Why are CDAs important? Without one a party receiving information can use it for any purpose they want and disclose it to whomever they want with no restrictions. Furthermore, if you think you may want to pursue patent protection, disclosing information relevant to your invention before an application is filed without a CDA may constitute a prior public disclosure and result in lost patent rights.

The OTL can assist in getting the appropriate agreement in place. As you can see in the OTL Activities article, there were 64 CDAs executed in FY2008. The OTL will draft the agreement and contact the outside party's representative to negotiate the agreement. If an investigator at St. Jude receives a CDA from another party, that investigator should contact the OTL to review and negotiate the agreement and determine the appropriate St. Jude signatory.

OTL Activities

A summary of FY08 OTL activities is shown in Figures 1 and 2. Invention disclosures, patent applications and granted patents for FY08 are presented in Figure 1 as compared to the previous four fiscal years. These numbers are in line with expectations relative to previous years, although there was a decrease in invention disclosures over the previous three years. This decrease appears to correspond with a decrease in the number of tangible research materials submitted to the OTL for licensing last year. The increase in foreign applications filed and foreign patents granted was due to three of St. Jude's more mature patent portfolios, which have been successfully licensed.

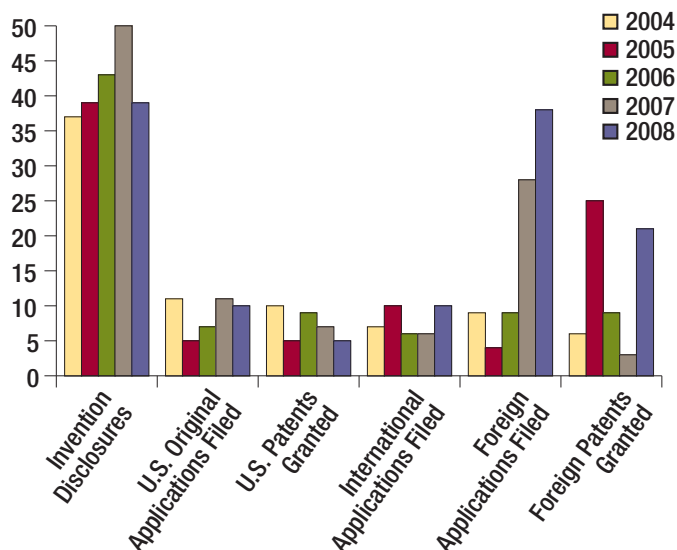


Figure 1. Patent activity (2004–2008)

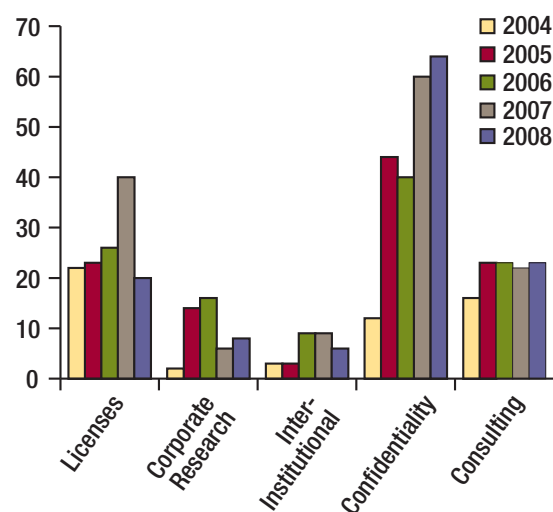


Figure 2. OTL Agreements (2004–2008)

OTL Staff • J. Scott Elmer, Director, x2756; Shawn A. Hawkins, Associate Director, x2751; Esther R. Allay, Licensing Associate, x4700; Regina D. McKinney, Executive Associate, x5354; Sheila R. Wilson, Administrative Assistant, x2342