

ATERWYNNE LLP

ATTORNEYS AT LAW

**Research Institution/
Technology Transfer
Practice**

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OVERVIEW OF ATER WYNNE'S RESEARCH INSTITUTION & TECHNOLOGY TRANSFER GROUP

Ater Wynne LLP is one of only a few law firms in our region that has created a dedicated team of intellectual property and corporate attorneys that focuses on the legal needs of non-profit research institutions, including research universities, private research institutions, and research hospitals. Our firm also has a reputation as one of the region's leading technology-focused law firms.

The attorneys in our Research Institution and Technology Transfer Group represent these research institutions as well as private-sector technology companies that collaborate with, or were spun out of, these institutions.

Our firm represents these clients regarding intellectual property, licensing, technology transfer/commercialization, corporate, securities, tax, policy-formation, and general commercial law matters.

Our familiarity with representing both research institutions and private sector technology companies uniquely enables our attorneys to understand the cultural nuances involved with transactions between universities/research institutions and private sector companies. This experience allows our attorneys to more efficiently and effectively find the appropriate legal solutions and optimum alliances for our clients.

MORE DETAILS REGARDING ATER WYNNE'S LEGAL SERVICES IN THIS FIELD

• TECHNOLOGY TRANSFER & INTELLECTUAL PROPERTY LICENSING

Extensive experience representing universities/research institutions concerning license arrangements involving an array of technologies and regarding their overall technology transfer/technology commercialization strategies and arrangements. Also have significant experience representing private-sector companies that collaborate with, or are spun out of, these institutions. This background provides us with a unique perspective in knowing what make these transactions successful for all parties.

This experience includes:

- Assisting universities/research institutions with invention-disclosure policies, and overall technology commercialization strategies and procedures.
- Extensive experience preparing/negotiating agreements (both domestic and international)for licensing out of inventions/other technology between universities/research institutions and private-sector companies.
- Licensing experience related to a wide range of technologies:
 - A wide variety of patent-protected technologies, including hardware devices, semiconductor-related inventions, drug therapeutics, medical devices, and agricultural-based inventions.
 - A broad range of software applications and other copyright-protected works.
 - Databases and a wide variety of trade secrets/know-how.

- Counseling university/research institutions in technology transfer transactions in which clients receive mixture of royalties and equity in the licensee.
- Assisting university/research institution clients in developing reusable templates for their licensing/technology transfer program.

- **TECHNOLOGY / RESEARCH COLLABORATIONS AND ALLIANCES**

Ater Wynne LLP is uniquely positioned to address the special needs that universities and other research institutions encounter when they engage in complex technology or other research collaborations or alliances with other non-profit institutions or private sector technology companies.

We have represented universities/research institutions in the creation of: (i) inter-institutional arrangements with other non-profit institutions; (ii) research collaborations or other technology alliances between multiple institutions; (iii) sponsored research arrangements with private-sector technology companies; and (iv) other multi-party technology alliances.

One of our attorneys has a recognized reputation assisting universities/research institutions regarding these complex collaborations and alliances.

Our experience includes:

- Developing organizational structure of these collaborations/alliances.
- Negotiating contract terms or other policies governing ownership and cross-licensing of IP arising out of these collaborations/consortia;
- Domestic and international collaborations/consortia.
- Representing university/research institutions in alliances in which client is lead party responsible for grant funding or philanthropic funding.

- **OVERALL PROTECTION AND MAINTENANCE OF INTELLECTUAL PROPERTY RIGHTS**

Domestic and international protection and maintenance of patents, copyrights, trademarks, trade secrets and other IP rights. Our services include:

- **Patents:** US and foreign patent applications covering a wide variety of technology fields. Monitoring and enforcement.
- **Trademarks:** US and foreign registrations. Monitoring and enforcement.
- **Copyrights:** Registrations of copyright-protected work in US and evaluate scope of overseas copyright protection. Monitoring and enforcement.
- **Trade Secrets/Know How:** Development of proper steps to maximum worldwide trade secret protection.
- **Retention of IP Rights:** Procedures and documentation for retaining ownership of IP rights developed by employees and contractors (including visiting researchers).

- **OTHER RESEARCH AND DEVELOPMENT MATTERS**

Assist university/research institution clients regarding other issues which arise during research and development stages, including:

- Prepare/negotiate clinical trial agreements.
- Prepare/negotiate material transfer agreements.
- Prepare/negotiate material/specimen evaluation agreements or other types of beta test agreements.
- Counsel clients regarding proper use of open-source software or other freely-available technology in their research efforts.

- **UNIVERSITY/RESEARCH INSTITUTION POLICIES**

Represent universities/research institutions in creating internal policies, including:

- Intellectual property ownership.
- Technology transfer, sponsored research arrangements, and other commercialization matters.
- Employee conflicts of interest.

Represent universities/research institutions in developing policies which allow them to take equity interest in start-up companies.

- **“SPIN-OUT” COMPANIES FROM UNIVERSITY/RESEARCH INSTITUTION**

Represent universities/research institutions in forming new “spin-out” start-up companies which are granted licenses to commercialize university/research institution’s inventions.

This experience includes:

- Corporate formation, securities and tax counseling.
- Structuring university/institution’s equity investment in spin-out companies.

- **ADDITIONAL CORPORATE AND TAX COUNSELING FOR NOT-FOR-PROFIT ENTITIES**

Our attorneys represent not-for-profit universities and research institutions, and their related entities (such as their foundations) concerning a broad range of corporate, tax and general business matters:

- Representing not-for-profits regarding corporate governance matters, including counseling the Boards of Directors.
- Counseling regarding a variety of tax issues, including unrelated business income tax issues.
- Representing universities and other not-for-profits regarding the formation of affiliated not-for-profit entities and other joint ventures.

- In particular, we have experience representing universities concerning tax and corporate issues regarding the formation of a separate not-for-profit affiliate organized to commercialize that university's intellectual property.

KEY ATTORNEYS PROVIDING LEGAL SERVICES IN THIS FIELD



FRANK X. CURCI (Primary Attorney) – Frank represents universities, other research institutions, high technology companies and bioscience companies concerning domestic and international intellectual property and technology matters. He assists these entities concerning patent/technology licensing, research/technology collaborations, other multi-party collaborations & consortia (in the life sciences and high tech industries), sponsored research, technology transfer, other technology commercialization matters, clinical trial agreements, and the overall commercialization and use of their intellectual property rights. He serves on the Board of Directors of the Cancer Research And

Biostatistics institute, a Seattle-based nonprofit bioscience institution. He is also an elected member of the Board of Directors of the Oregon Translational Research & Development Institute, a Portland-based non-profit bioscience research institute and bioscience incubator.



ERNIE BOOTSMA – Ernie represents start-up and growth stage businesses, as well as more mature companies, in broad range of corporate and intellectual property matters. He also has experience representing universities and other research entities. His practice encompasses the formation, financing, corporate governance, mergers and acquisition, intellectual property, and transactional fields. He has negotiated and closed complex merger and acquisition transactions, planned and counseled clients with regard to intellectual property protection and maintenance, structured and implemented licensing and distribution arrangements, and handled debt and equity financing transactions for clients in a wide variety of industries.



AKANA K.J. MA – Akana offers clients from around the world practical, creative solutions to business and legal issues involving different cultures, legal systems, and business. He chairs Ater Wynne's Global Trade Group. Akana works with companies and individuals conducting business in the global marketplace to help structure international joint ventures; comply with foreign laws and regulations; license and protect technology, trademarks, software and other intellectual property; negotiate contracts for the sale and distribution of products and services; establish foreign offices, license and finance exports; and comply with customs and import laws and regulations.



L. DAVID CONNELL – David focuses his practice on tax, business and nonprofit law. David works closely with many tax-exempt/not-for-profit organizations, including academic/research institutions, to provide practical solutions to complex issues, with a focus on achieving the client’s business and tax objectives. He counsels these tax-exempt organizations in all tax matters, including qualifying for and maintaining tax-exempt status, minimizing unrelated trade or business income, public charity/private foundation status, compensation issues, financing issues, limitations on lobbying, and transactions with other entities. He also regularly advises these organizations on governance and other day-to-day matters.



PAUL B. HEYNSSENS – Paul is a registered patent attorney and counsels clients regarding a wide variety of intellectual property and technology matters including patent prosecution (US, PCT, and foreign), and intellectual property portfolio management. He has drafted and prosecuted patent applications in the areas of electronics, computer systems, computers, software, semiconductors, lasers, mechanical devices, medical devices and diagnostic devices. His bioscience patent prosecution experience includes a blood collection medical device, a portable medical monitoring device, and an agrobiotech process for the extraction of botanical substances from plants.



THOMAS M. KARNES – Tom focuses his practice on tax, business and healthcare matters. He regularly represents tax-exempt/not-for-profit organizations regarding tax, corporate and healthcare matters.