Technology Commercialization:
Licensing and Manufacturing Insights

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Licensing Tips – Why License

• Introduce intellectual property into company
  - Facilitates launch of product(s)
  - Avoid infringement/strengthen patent portfolio

• Expand use of your intellectual property
  - Value in a different industry
  - Foreign market penetration

• Universities can be a good resource for IP
Licensing Tips – Beyond Monetization

• Rights granted
  - Exclusive vs non-exclusive
  - Access to source code
  - Know-how

• Prohibition of use/fields of use
  - Product type
  - Regions

• Transfer or sublicense rights
Licensing Tips – Beyond Monetization

• Warranties
  - IP versus product

• Limitation on liabilities
  - Conditions licensor is reasonable

• Indemnification
  - Obligation of the parties to “cover cost”
  - IP infringement
  - Product ‘failure’
Licensing Tips – Things to Consider

• Monitoring compliance can be burdensome
  - Development
  - Sales/royalty payments

• Enforcement
  - Joinder
  - Can be difficult...and expensive
Licensing Tips – Things to Consider

• Control
  - Assignability
  - Quality control (on products)

• Use of counsel
  - IP attorney for IP
  - Contracts attorney for contracts
Manufacturing Tips

• Consider IP protection
  - Not only where you will sell, but where you will manufacture

• Export control compliance

• Ensure consistent with license terms
Manufacturing Tips

• Universities are usually not a manufacturer
  - Specialized equipment can be available but...

• Look for private/public partnerships
  - Global Center for Medical Innovation