

Patent - University Research and Technology Transfer

Helping you bring groundbreaking research from the lab to the market

Capabilities at a glance

- **We counsel clients at every stage of the life cycle of a patent**, from disclosure through issuance, maintenance and licensing or enforcement.
- **Decades of representation of research institutions** engaged in technology transfer, dating to before the passage of Bayh-Dole.
- **A specially crafted legal strategy for each invention**, built on deep industry knowledge of the key players conducting substantive academic research in your area and an understanding that the goals of universities in obtaining patents are unique and do not always follow the same goals as private companies.

Deep experience supporting those at the forefront of innovation

Since before the passage of the Bayh-Dole Act, Quarles has been representing research institutions engaged in technology transfer. We remain at the forefront of innovative solutions for institutions engaged in cutting-edge research. Our attorneys understand all aspects of tech transfer, from technology evaluation and patent prosecution to licensing and patent enforcement. We represent clients in the formation of patent strategies, patent prosecution, license negotiation, intellectual property and patent licensing, business startups, intellectual property enforcement and patent litigation, providing comprehensive legal services that successfully move technology from the lab to the marketplace and fully protect it. Informed by extensive industry experience and technological backgrounds, our lawyers have helped organizations generate millions in returns from their portfolios. Given this breadth and depth of experience, our patent team obtains patents with an eye toward universities' commercialization goals: We know the applications we prepare may need to simultaneously protect a licensee from competition while also ensuring a royalty to the university.

Dynamic legal support for research institutions and businesses of all kinds

Our technology transfer attorneys have helped research institutions bring groundbreaking research to market, such as human stem cell technologies and medical imaging advancements. We have experience in all types of patent law, with clients of many different shapes and sizes in a range of fields. Over the years, universities, foundations,

Practice Contact

Stephen Gardner
(608) 283-2476
stephen.gardner@quarles.com

People

Daniel Ark
Sangik Bae
Alex Ballwanz
Mason Baranczyk
Tracey Baxter
Lauren Bolcar
Melanie Brunow
Heather Buchta
Robert Chisholm, Ph.D.
Jack Cook
Victoria Cook
Remy Cooper, Ph.D.
Amanda Eckermann, Ph.D.
Jamie England
Seth Essendrop
Christopher Fernandez
Therese Finan
Trevor Foster
Stephen Gardner
Darla Graff, Ph.D.
Tolga Gulmen, Ph.D.
Amber Holiday
John Jansky
Thomas Keating, Ph.D.
Rosemary Kellogg, Ph.D.
Jason Krueger
Thomas Krumenacher
Theodore Lester
John Linzer



research hospitals, health care organizations, museums and clinical research organizations have all brought a wide array of products and services to market with our assistance. For new and young technology companies, where IP assets are of paramount importance, we focus on supporting our clients in acquiring and structuring investments of that vital early capital, offering guidance from creation to sale. We help our clients make critical decisions on when and how to file for patent protection on their inventions. This includes not only invention disclosure review, but innovative strategies for positioning early-stage or cross-disciplinary innovations for the best outcome at the patent office and the license negotiation table.

Experience

- **Efficient and practical invention disclosure review**
- **Patent strategy**
- **Patent preparation prosecution, both domestic and foreign**
- **License drafting and negotiation**
- **Intellectual property enforcement**

Successes

- Assisted a large research university in developing an IP portfolio relating to a foundational biotech technology, which was then licensed to a startup that was subsequently acquired in a large exit. We effectively assisted the client in demonstrating early value by overcoming patent eligibility questions and quickly getting claims issued, while preserving claim scope in subsequent child applications.
- Navigated a dispute between a university and an exclusive licensee regarding filing of international applications and validations in key countries, preserving rights for our client and positioning for future royalties or infringement, while limiting out of pocket costs for the client.
- Negotiated a favorable hybrid (materials and patents) exclusive license, involving a Bayh-Dole waiver, from a university to a large international company.
- Assisted a university foundation in navigating a market lockup dispute with a licensee and its underwriter, when the foundation owned a small equity stake in the company pre-IPO.
- Drafted license and other agreement templates for over a dozen major research institutions.

Lu Liu, Ph.D.
 Katherine Lobel-Rice, Ph.D.
 Kay Madison, Ph.D.
 Amber Majnik, Ph.D.
 Lauren McComis
 Christopher McWhinney
 Sierra Messenger
 Jessica Nault, Ph.D.
 Michael Neary
 Kristin Graham Noel
 Scott Nolan
 Elizabeth O'Connell, Ph.D.
 Carly Paveglio
 Jere Polmatier
 Harrison Powell
 Kevin Rizzuto
 Margaret Robinson, Ph.D.
 Richard Roche
 Michael Santonocito
 Paul Saveriede, Ph.D.
 Jeff Sazama
 Katharine Schulz, Ph.D.
 Yakov Sidorin, Ph.D.
 Jonathan Stone
 Jean Tibbetts
 Christine Tiskevich, Ph.D.
 Joel Tragesser
 Christopher Unterberger, Ph.D.
 Tambryn VanHeyningen, Ph.D.
 Stephanie Vavra
 Peter Volberding, Ph.D.
 Weiwei Wang, Ph.D.
 Michele Washington, Ph.D.
 Amanda White
 Elizabeth White, Ph.D.
 Sara Wright





Service Areas

Wei Yan, Ph.D.

Emerging Growth Companies and Venture Capital

We understand how to guide a full range of participants through the complexities of rapidly changing and competitive industries. We represent entrepreneurs and emerging startup or growth companies from formation to exit, in a variety of corporate matters, including equity, convertible instruments and debt financings, commercial contract drafting and negotiations, employment and onboarding matters and mergers, sales and other liquidity events.

Research Institutions & Higher Education

Our attorneys are thought leaders, meeting regularly to share the cross-disciplinary news and legal issues that affect you, such as changes in research compliance regulations, nonprofit tax treatment, student issues, labor and employment, patentability and best practices in startup formation. While never compromising on quality of service, we are also committed to providing you with the highest quality legal advice at transparent and predictable rates.

