

Technology Transfer

Counsel that helps you move new innovations from the lab to the market

Capabilities at a glance

- **Decades of experience** helping colleges, universities, foundations, hospitals and research institutions make the most of their groundbreaking work. Our team has grown with our practice, so our internal strengths match the needs of university clients.
- **A diverse legal team with a diverse set of technical specialties.** Our attorneys have the scientific and technical credentials to instill confidence in your researchers that their inventions are in the right hands.
- **Helping unleash the potential of historic scientific breakthroughs.** We have been trusted to help protect and license some of the most important, foundational and lucrative technologies arising from our clients' institutions.
- **We'll help you plan for the long term, beyond each individual case.** Our patent strategies are synchronized with business and licensing strategies from the outset.

Skilled attorneys covering all your technology transfer legal needs

Since before the passage of the Bayh-Dole Act in 1980, Quarles has focused on the intellectual property needs of colleges, universities, foundations, hospitals and other research institutions. We also have extensive experience in helping clients license and, when needed, enforce their rights. We represent clients in the formation of patent strategies, patent prosecution, license negotiation, due diligence navigation, startups, intellectual property enforcement and patent litigation, providing comprehensive legal services that successfully move technological innovations from the lab to the marketplace and fully protect them when they arrive. Working with Quarles, you can expect the best advice on technology transfer law, drawn from a large breadth of experience counseling top research institutions and delivered with a practical and sensible point of view. We will always deliver solutions with your long-term strategic objectives in mind, while seeking the best outcome and protection for each new innovation. When issues arise that your institution hasn't faced before, Quarles can provide advice based on our deep experience—more often than not, our team will have dealt with a similar issue before.

Helping you unleash the potential of your intellectual property

Practice Contact

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People

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Few law firms can boast our depth of knowledge and experience working with universities, foundations, research hospitals, health care organizations, clinical researchers, museums and other research-intensive organizations. We have helped patent human stem cell technologies, secured advances in medical imaging, patented practical uses of lucrative software and abstract methods, and played several roles in the establishment of major microbiological research facilities, to name just a few noteworthy projects. Our attorneys understand all aspects of tech transfer, from technology evaluation and patent prosecution to licensing and patent enforcement. We understand the goals, needs and methods of the specialists and experts working within universities and research institutions to develop groundbreaking new innovations because we work directly with them, day in and day out.

Experience

- Patent strategy
- Patent prosecution
- License template creation
- License drafting and negotiation
- Data use and compliance
- Bayh-Dole and grant compliance
- Startup company support
- Investment and equity ownership
- 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.

Amber Holiday
John Jansky
Thomas Keating, Ph.D.
Rosemary Kellogg, Ph.D.
Jason Krueger
Thomas Krumenacher
Theodore Lester
John Linzer
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Christopher Unterberger, Ph.D.
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Stephanie Vavra
Peter Volberding, Ph.D.





- 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.

Weiwei Wang, Ph.D.
Michele Washington, Ph.D.
Amanda White
Elizabeth White, Ph.D.
Catherine Witczak
Sara Wright
Wei Yan, Ph.D.

