



Intellectual Property Review Process

Memorial Sloan-Kettering Cancer Center (MSKCC) employees who have made an advance that might constitute an invention or who have developed other types of intellectual property (collectively “Invention”) should disclose such information to the Office of Industrial Affairs (OIA) via its website. Upon receipt of the disclosure a licensing professional is assigned to the case and will then contact the inventor within one week, provide to the investigator(s) a copy of the “MSKCC Intellectual Property Review Process” and work with other members of OIA’s management team to evaluate the disclosure. There are four main facets to the evaluation process.

1. Technology Summary

Based on the invention disclosure and conversations with the inventor, as well as with other OIA staff, the initial proposed uses and applications of the Invention are assessed, along with its strengths and potential benefits as related to those applications, its potential benefits to patient care, research and education, as well as to a particular program related to MSKCC’s missions. The technology summary serves to clearly define the Invention. It further serves as the starting point for the three remaining parts of the evaluation.

2. Patentability Analysis

The analysis of commercialization potential is a significant factor in deciding whether or not to move forward with intellectual property protection. Often seeking patent protection is the only way commercial value of an Invention can be attained. In certain cases, however, it may not be necessary to seek a patent for the Invention to retain commercial value, i.e., for a research material. In other cases, the public interest is best served simply through dissemination of knowledge by publication – i.e., new mechanism of action.

The strengths and weaknesses of the Invention are examined. Several factors are considered: i) determining if sufficient proof-of-principle exists to enable MSKCC to obtain a patent, ii) the types of patent claims that could be obtainable for this Invention (e.g., composition of matter claims are generally more commercially valuable than method claims, broader claims are generally more desirable than narrow claims), and iii) the ability to seek protection outside the U.S. The patentability analysis includes comparing the current technology to other patented, available or published technologies.

3. Market Analysis and Business Risk

The intention of this analysis is to determine the market strength of an Invention and whether patent protection would likely result in a license. A review of the relevant market for potential products and/or services that emerge from the Invention is conducted. This analysis estimates the size of the market, the potential market penetration of the product

and/or service, and its growth rate. Other determining factors are market margins, current market segmentation, and whether the market is ready for the entry of this particular type of technology, i.e., whether there is existing infrastructure, etc. For example, if a market is small there may be few or no companies interested in developing a product, making the prospects for licensing low, and patent protection may not be pursued.

Additionally, any pre-existing commitments or related patents that may limit the marketability or freedom to operate, such as an invention that arose under sponsored research or from the use of a material obtained under a material transfer agreement, are considered.

During this process, other uses and markets may be identified that are more commercially attractive than initially proposed, as well as gaps in the invention that must be filled to address these markets. Such new applications and gaps will be discussed with the inventor for his/her opinion, and to ascertain the possibility of his/her interest and ability to address the gaps. This analysis is also intended to initially identify new MSKCC spinout company opportunities which are then subjected to additional evaluation for feasibility.

4. Commercialization Analysis

OIA's analysis considers various commercialization issues affecting the value of the technology from the perspective of potential licensees. These issues include:

Development Needs and Costs: Time, effort and expense are required to mature the underlying technology into a commercial product. These are often considerable for MSKCC technologies.

Ease of Utilization: This is dependent upon the type and stage of development of the technology and refers to the amount of work that a potential licensee would need to undertake in order to further advance the technology to eventually make a commercial product/service. For example, some inventions require a delivery system, another proprietary compound, an assay, or a new procedure to be usable, any of which might need to be licensed from other companies. These factors can affect the commercialization pathway and the value of the MSKCC technology to a potential licensee.

OIA usually works with the inventor in conducting this evaluation. Once the evaluation has been completed, the OIA licensing professional discusses with the inventor(s) the results of the analyses described above and makes his/her recommendation about the disclosed Invention, and whether it would be advisable to file a patent application. In the event that there is not a consensus between OIA and the inventor(s), either may request that the disclosed Invention be evaluated by an outside Patent Review Advisory Committee.

Patent Review Advisory Committee

The Patent Review Advisory Committee shall comprise two members who are independent from OIA and shall be appointed by the Vice President, Research and Technology Management. One member shall be an experienced patent attorney who is well-versed in patent prosecution. The other member shall be an experienced businessperson who is well-versed in biotechnology investments and the evaluation of life science technology

Appeal Process

During the initial OIA review with the investigators, OIA will inform the investigators of the process for evaluation of the invention including, but not limited to, the opportunity to request an evaluation by the Patent Review Advisory Committee.

If upon completion of a good faith attempt by both OIA and the investigators to reach a consensus as to whether MSKCC should file a patent application, such as consensus can not be reached, either OIA or the Principal Investigator may request a review by the Patent Review Advisory Committee by making such request to the Vice President, Research and Technology Management.

Once an Invention is referred to the Patent Review Advisory Committee, a meeting will be scheduled with the investigator(s) and OIA. If such meeting can not be scheduled before a deadline to file a patent application, OIA will file a provisional patent application based upon detailed information about the invention provided by the investigator(s). At the meeting, both the inventor(s) and OIA shall have the opportunity to make a presentation and/or provide comments. If, after such a meeting there, still is no consensus, the Patent Review Advisory Committee shall provide a short evaluation and recommendation to the Vice President, Research and Technology Management as to how to proceed with the Invention.

The Vice President, Research and Technology will review the recommendation of the Patent Review Advisory Committee and decide whether the institution will file a patent application.