

REGENTS COMMUNICATION

ACTION REQUEST

Subject: Reassignment of International Patent Rights to
Drs. James Geiger and Shorya Awtar

Action Requested: Approval of Reassignment Rights

Preamble:

A statutory conflict of interest situation was identified by the Office of Technology Transfer while reviewing the technology transfer agreement. This then triggered a review by the Medical School Conflict of Interest Review Board and the OVPR Conflict of Interest Review Committee. A plan for management of the possible risks associated with the conflict of interest was developed and approved by the Board and the Committee and agreed to by the parties involved in these plans.

This proposed reassignment agreement ("Agreement") falls under the State of Michigan Conflict of Interest Statute because Professors Shorya Awtar and James Geiger are both employees of the University of Michigan ("University"). The law permits such an Agreement provided it is disclosed to the executive officers and approved in advance by a 2/3 vote of the Regents of the University of Michigan.

Background:

Dr. Shorya Awtar, Professor in Mechanical Engineering, and Dr. James Geiger, Professor of Surgery, have worked together to invent a unique laparoscopic surgical device for which the University of Michigan Office of Technology Transfer (OTT) has applied for US patent protection. Drs. Geiger and Awtar are requesting that the University of Michigan reassign the international rights for the following countries: Japan, Canada, Europe, and Australia (hereafter referred to as "International Patent Rights"). Drs. Awtar and Geiger will pay the costs of these applications and will agree to the University of Michigan's standard reassignment policy.

UM OTT File No. 3864, entitled, "Minimally Invasive Surgical Tool with Enhanced Dexterity" (James Geiger, Shorya Awtar, Patrick Quigley, Andrew Mansfield)

Parties to the Agreement:

The Regents of the University of Michigan and Drs. James Geiger and Shorya Awtar.

Agreement Terms:

Terms include granting to Drs. Geiger and Awtar the University's entire right, title and interest to International Patent Rights. All patent costs for International Patent Rights will be paid for personally by Drs. Awtar and Geiger, and the University will receive 15% of any payments received by Drs. Awtar and Geiger in conjunction for licensing of

the International Patent Rights. No use of University services or facilities, nor any assignment of University employees, is obligated or contemplated under the agreement. Standard disclaimers of warranties and indemnification apply, and the contract may be amended by consent of the parties. University procedures for approval of these changes will be followed and additional conflict of interest review will be done as appropriate.

Pecuniary Interest:

The pecuniary interests of Drs. Awtar and Geiger arise from their ownership interest in the International Patent Rights.

Net Effect:

The Office of Technology Transfer has negotiated and finalized the terms of a reassignment agreement for International Patent Rights patents related to UM OTT File Number 3864.

Recommendations:

This matter has been reviewed and approved by the Medical School Conflict of Interest Board and by the OVPR Conflict of Interest Review Committee. In light of this disclosure and our finding that the Agreement was negotiated in conformance with standard University practices, I recommend that the Board of Regents approve the Reassignment Agreement between the University and Drs. Shorya Awtar and James Geiger.

Respectfully Submitted,



Stephen R. Forrest
Vice President for Research

November 2010