

THE UNIVERSITY OF MICHIGAN
REGENTS COMMUNICATION

ACTION REQUEST

Subject: License Agreement between the University of Michigan and S3D Precision Dispensing, Inc.

Action Requested: Approval of License Agreement

Preamble:

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

This proposed license agreement (“Agreement”) falls under the state of Michigan Conflict of Interest Statute because Professor Kira Barton and Dr. Lai Yu Leo Tse are employees of the University of Michigan (“University”) and partial owners of S3D Precision Dispensing, Inc. The law permits such an Agreement provided it is disclosed to the Board of Regents (“Regents”) of the University of Michigan and approved in advance by a 2/3 vote.

Background:

Dr. Kira Barton, an Associate Professor in the Department of Mechanical Engineering, and Dr. Lai Yu Leo Tse, a Postdoctoral Research Fellow in the Department of Mechanical Engineering, are partial owners of a for-profit company called S3D Precision Dispensing, Inc. (the “Company”). The Company was formed recently to commercialize printhead technologies and desires to license from the University of Michigan the University’s rights associated with the following technologies:

UM OTT File No. 5572, entitled: “An Integrated Electrohydrodynamic Jet Printhead for Flexible Micro/Nano-Manufacturing” (Inventors: Kara Barton, Lai Yu Leo Tse)

UM OTT File No. 7816, entitled: “Rapidly Wetted Pin Style Electrohydrodynamic Jet Printhead” (Inventors: Kara Barton, Lai Yu Leo Tse)

The Office of Technology Transfer selected the Company as a University partner and negotiated the terms of the proposed Agreement in accordance with University policy and its accepted licensing principles.

Parties to the Agreement:

The Regents of the University of Michigan and S3D Precision Dispensing, Inc.

Agreement Terms Include:

Agreement terms include granting S3D Precision Dispensing, Inc. an exclusive license to the above technology from University.

The University will retain ownership of the licensed technology and may continue to further develop it and use it internally. 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 Agreement may be amended by consent of the parties, such as adding related technology. 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. Barton and Tse arise from their ownership interest in S3D Precision Dispensing, Inc.

Net Effect:

The Office of Technology Transfer has negotiated and finalized the terms of a worldwide option agreement for patent rights related to UM OTT File Nos. 5572 and 7816 for all fields of use. S3D Precision Dispensing, Inc. will obtain use and commercialization rights to the above listed University technologies.

Recommendations:

This matter has been reviewed and approved by the UMOR 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 Agreement between the University and S3D Precision Dispensing, Inc.

Respectfully submitted,



S. Jack Hu
Vice President for Research

February 2019