

THE UNIVERSITY OF MICHIGAN
REGENTS COMMUNICATION

ACTION REQUEST

Subject: Commercialization Agreements with the University of Michigan

Action Requested: Approval of Commercialization Agreements

Preamble:

Statutory conflicts of interest situations were identified by Innovation Partnerships while reviewing commercialization agreements that then triggered a review by the Medical School Conflict of Interest Board and/or the UMOR Conflict of Interest Review Committee. Plans for management of the possible risks associated with the conflicts of interest will be developed and approved by the Board and/or Committee and may require agreement by the parties involved.

These proposed commercialization agreements (“Agreements”) fall under the State of Michigan Conflict of Interest Statute because employees of the University of Michigan (“University”) have outside activities, relationships, or interests in the companies described in Attachment A. The law permits such Agreements provided they are disclosed to the Board of Regents (“Regents”) of the University and approved in advance by a 2/3 vote.

Background:

These companies were formed to commercialize University technologies and desire to option, license, or reassign the University’s rights associated with them. Innovation Partnerships selected these companies as University partners and negotiated the terms of the proposed agreements in accordance with University policy and its accepted licensing principles.

Agreement Terms Include:

The University will retain ownership of the optioned, licensed, or reassigned technologies and may continue to further develop and use them internally. No use of University services or facilities, nor any assignment of University employees, is obligated or contemplated under the Agreements. Standard disclaimers of warranties and indemnification apply, and the Agreements 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. Terms specific to each Agreement are described in Attachment A.

Net Effect:

Innovation Partnerships has negotiated and finalized the terms of the option, license, or reassignment agreements for patents, technology, or content related to University technologies for particular fields of use. The companies will obtain the right to evaluate, use, and/or commercialize the University technologies. The net effects specific to each Agreement are described in Attachment A.

Recommendations:

These matters have been reviewed and approved by the Medical School Conflict of Interest Board and/or the UMOR Conflict of Interest Review Committee. In light of this disclosure and our finding that the Agreements were negotiated in conformance with standard University practices, I recommend that the Board of Regents approve the Agreements between the University and the companies outlined in Attachment A.

Respectfully submitted,



Rebecca Cunningham
Vice President for Research

May 2023

Attachment A

Agreement #1

Reassignment Agreement between the University and Dr. Omer Berenfeld Reviewed by the Medical School Conflict of Interest Board		
<u>Innovation Partnerships Intellectual Property File Information</u>		
Number	Title	Inventors
2023-352	Identification of Stable Electrophysiological Regions	Omer Berenfeld, David Calvo
<p style="text-align: center;"><u>Background</u></p> <p>Dr. Omer Berenfeld and the University have agreed to have the University technology described above assigned to Dr. Berenfeld personally.</p>		
<p><u>Net Effects</u></p> <ul style="list-style-type: none">● Reassignment● Patents● All fields of use● Right to commercialize	<p><u>Agreement Terms</u></p> <p>Dr. Omer Berenfeld will:</p> <ul style="list-style-type: none">● Pay the University a percentage of any revenue that he is due from or receives in consideration for rights under or relating to the patents <p>The University will:</p> <ul style="list-style-type: none">● Assign ownership of the technology to Dr. Omer Berenfeld● Retain an irrevocable, non-exclusive, non-transferable, royalty-free license to practice and have practiced the technology and/or patents for any noncommercial research, academic, or teaching purpose	
<p style="text-align: center;"><u>University Employee; University Title</u></p> <ul style="list-style-type: none">● Omer Berenfeld; Professor, Internal Medicine-Cardiology		

Agreement #2

**Option Agreement between the University and Blue Arbor Technologies, Inc.
Reviewed by the Medical School Conflict of Interest Board**

Innovation Partnerships Intellectual Property File Information

Number	Title	Inventors
4889	A Living Biosynthetic Peripheral Nerve Interface	Paul Cederna, Melanie Urbanek, David Martin
6457	Method for Amplifying Signals from Individual Nerve Fascicles to Above 250 uVpp	Richard Gillespie, Cynthia Chestek, David Martin, Nicholas Langhals, Melanie Urbanek, Paul Cederna, Zachary Irwin, Daniel Ursu
2022-074	Wireless Prostheses Signal Interpreter	Paul Cederna, Cynthia Chestek, Alex Vaskov, Philip Vu

Background

Blue Arbor Technologies, Inc. was formed to commercialize the regenerative peripheral nerve interface system for advanced control of prosthetic devices and desires to option the University's rights associated with the technology listed above.

Net Effects

- Worldwide exclusive
- Patents
- All fields of use
- Evaluation only

Agreement Terms

Blue Arbor Technologies, Inc. will:

- Pay an upfront fee

University Employee; University Title; Relationship with Blue Arbor Technologies, Inc.

- Alex Vaskov; Research Fellow, Plastic Surgery; Partial Owner
- Paul Cederna; Professor, Plastic Surgery; Partial Owner
- Theodore Kung; Associate Professor, Surgery; Partial Owner

Agreement #3

**License Agreement between the University and JOINLU International Inc.
Reviewed by the UMOR Conflict of Interest Review Committee**

Innovation Partnerships Intellectual Property File Information

Number	Title	Inventors
2023-341	A Novel AI-Based Search Engine for Navigating Undergraduate STEM Major Selection and Career Planning	Yugo Ashida, Caleb Smith

Background

JOINLU International Inc. was formed to commercialize and develop a novel AI-based search engine platform that provides services to companies, research institutions, experts, and individuals facilitating efficient and effective collaboration for real world problem-solving and personal growth in technical areas, and desires to license the University’s rights associated with the technology listed above.

Net Effects

- Worldwide exclusive
- Copyrights
- All fields of use
- Right to commercialize

Agreement Terms

- JOINLU International Inc. will:
- Obtain the right to grant sublicenses
- The University will:
- Receive equity in JOINLU International Inc.

University Employee; University Title; Relationship with JOINLU International Inc.

- Yugo Ashida; Research Area Specialist Senior, Nuclear Engineering & Radiological Sciences; Partial Owner
- Gary Was; Professor Emeritus, Nuclear Engineering & Radiological Sciences; Partial Owner

Agreement #4

**License Agreement between the University and MScreen LLC
Reviewed by the UMOR Conflict of Interest Review Committee**

Innovation Partnerships Intellectual Property File Information

Number	Title	Inventors
3582	MScreen Application	Renju Jacob, Richard Neubig

Background

MScreen LLC was formed to commercialize a hosted services based offering (SaaS Application) of the M-Screen tool for drug discovery research and desires to license the University's rights associated with the technology listed above.

Net Effects

- Worldwide exclusive
- Copyrights
- All fields of use
- Right to commercialize

Agreement Terms

MScreen LLC will:

- Obtain the right to grant sublicenses

The University will:

- Receive equity in MScreen LLC
- Retain the right to purchase more equity in MScreen LLC

University Employee; University Title; Relationship with MScreen LLC

- Renju Jacob; Application Systems Analyst/Program Staff Specialist, Life Sciences Institute; Partial Owner

Agreement #5

**Option Agreement between the University and Naneco, LLC
Reviewed by the UMOR Conflict of Interest Review Committee**

Innovation Partnerships Intellectual Property File Information

Number	Title	Inventors
2023-162	Environmental-friendly decorative chrome color and method of making the same	Lingjie J Guo, Haozhu Wang, Taigao Ma

Background

Naneco, LLC was formed to commercialize and develop environmentally friendly coatings for the automotive, consumer electronics, medical, and consumer products industries, and desires to option the University's rights associated with the technology listed above.

Net Effects

- Worldwide option
- Patents
- All fields of use
- Evaluation only

Agreement Terms

Naneco, LLC will:

- Pay an upfront fee
- Reimburse patent costs

University Employee; University Title; Relationship with Naneco, LLC

- Lingjie Jay Guo; Professor, Electrical Engineering and Computer Science – Electrical and Computer Engineering (EECS-ECE Division); Partial Owner

Agreement #6

**License Agreement between the University and RACE Space, Inc.
Reviewed by the UMOR Conflict of Interest Review Committee**

Innovation Partnerships Intellectual Property File Information

Number	Title	Inventors
2023-345	Teen Talk	Riana Anderson, Farzana Saleem

Background

RACE Space, Inc. was formed to commercialize methods, tools, and a mobile application that will support young people of color and their caregivers as they learn about, navigate, and overcome racism, and desires to license the University's rights associated with the technology listed above.

Net Effects

- Worldwide exclusive
- Copyrights
- All fields of use
- Right to commercialize

Agreement Terms

RACE Space, Inc. will:

- Obtain the right to grant sublicenses

The University will:

- Receive equity in RACE Space, Inc.
- Retain the right to purchase more equity in RACE Space, Inc.

University Employee; University Title; Relationship with RACE Space, Inc.

- Riana Anderson; Assistant Professor, Health Behavior and Health Education; Partial Owner

Agreement #7

**License Agreement between the University and SVS-UMCHGN-1, Inc.
Reviewed by the UMOR Conflict of Interest Review Committee**

Innovation Partnerships Intellectual Property File Information

Number	Title	Inventors
7228	Viewpoint (f/k/a Policymaker)	Elisabeth Gerber
2023-201	Center for Academic Innovation - Learning Tools Interoperability Client	Michael Wheeler
2023-202	Center for Academic Innovation - Synchronized Data Models	Ben Hayward
2023-203	Center for Academic Innovation - Core Components Library	Ben Hayward
2023-204	Center for Academic Innovation - Event Tracking Module	Ben Hayward, Dennis O'Reilly

Background

SVS-UMCHGN-1, Inc. is being formed to commercialize the ViewPoint platform, a software solution for powering *engaged learning through role-based simulations* in online, hybrid and in-person educational settings, and simulation content and desires to license the University's rights associated with the technology listed above.

Net Effects

- Worldwide exclusive for 7228
- Worldwide non-exclusive for 2023-201, 2023-202, 2023-203, 2023-204
- Copyrights
- All fields of use
- Right to commercialize

Agreement Terms

SVS-UMCHGN-1, Inc. will:

- Obtain the right to grant sublicenses
- Pay a royalty on sales

The University will:

- Receive equity in SVS-UMCHGN-1, Inc.

The University may:

- Retain the right to purchase more equity in SVS-UMCHGN-1, Inc.

University Employee; University Title; Relationship with SVS-UMCHGN-1, Inc.

- Elisabeth Gerber; Professor, Public Policy; Partial Owner