

**THE UNIVERSITY OF MICHIGAN
REGENTS COMMUNICATION**

ACTION REQUEST

Subject: Technology Transfer Agreements with the University of Michigan

Action Requested: Approval of Technology Transfer Agreements

Preamble:

Statutory conflicts of interest situations were identified by the Office of Technology Transfer (“OTT”) while reviewing technology transfer 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 technology transfer 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. OTT 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:

OTT has negotiated and finalized the terms of the option, license, or reassignment agreements for patents, technology, or content related to University OTT files 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

July 2021

Attachment A

Agreement #1

License Agreement between the University and ChromX Health Co., Ltd. Reviewed by the UMOR Conflict of Interest Review Committee		
<u>Office of Technology Transfer Intellectual Property File Information</u>		
Number	Title	Inventors
7142	Miniaturized Discharge Photo-Ionization Detector	Xudong Fan, Hongbo Zhu, Katsuo Kurabayashi
7494	Integrated Micro-Photoionization Detector with an Ultrathin Ultraviolet Transmission Window	Xudong Fan, Hongbo Zhu, Katsuo Kurabayashi
2019-234	Film Thickness Gradient Column	Xudong Fan, Hongbo Zhu, Katsuo Kurabayashi, Jinyan She, Maxwell Weihao Li
2020-098	An Algorithm in Breath Analysis for Disease Detection and Monitoring	Xudong Fan, Kevin Ward, Menglian Zhou, Ruchi Sharma
2020-099	Volatile Inorganic Compounds in Breath Analysis	Xudong Fan, Kevin Ward, Menglian Zhou, Ruchi Sharma
<p style="text-align: center;"><u>Background</u></p> <p>ChromX Health Co., Ltd. was formed to commercialize gas chromatography technology designed to diagnose and monitor health conditions from compounds found in a patient's exhaled breath and desires to license the University's rights associated with the technology listed above.</p>		
<p><u>Net Effects</u></p> <ul style="list-style-type: none"> ● Exclusive in all countries in Africa, Asia, and the Middle East where there are Patent Rights, with the exception of Israel (where the company has no rights) ● Non-exclusive in Japan and India ● Patents and copyrights ● All fields of use for 2019-234, 2020-098, and 2020-099 ● For human and animal gas sampling in medical application use for 7142 and 7494 ● Right to commercialize 		<p><u>Agreement Terms</u></p> <p>ChromX Health Co., Ltd. will:</p> <ul style="list-style-type: none"> ● Obtain the right to grant sublicenses ● Pay a royalty on sales ● Pay an upfront fee ● Reimburse patent costs ● Pay a liquidation fee <p>The University will:</p> <ul style="list-style-type: none"> ● Have the right to acquire equity in ChromX Health Co., Ltd. ● Retain the right to purchase more equity in ChromX Health Co., Ltd.
<p style="text-align: center;"><u>University Employee; University Title; Relationship with ChromX Health Co., Ltd.</u></p> <ul style="list-style-type: none"> ● Xudong Fan; Professor, Biomedical Engineering; Partial Owner 		

Agreement #2

**License Agreement between the University and The TruEnamel Company, LLC
Reviewed by the UMOR Conflict of Interest Review Committee**

Office of Technology Transfer Intellectual Property File Information

Number	Title	Inventors
2826	Manufacture of Synthetic Dental Enamel	Brian Clarkson, Haifeng Chen

Background

The TruEnamel Company, LLC was formed to commercialize high-throughput screening tools for the discovery of drug polymorphs and desires to license the University's rights associated with the technology listed above.

Net Effects

- Worldwide non-exclusive
- Materials
- For research reagents use
- Right to commercialize

Agreement Terms

The TruEnamel Company, LLC will:

- Pay a royalty on sales

University Employee; University Title; Relationship with The TruEnamel Company, LLC

- Brian Clarkson; Professor Emeritus, Cariology, Restorative Sciences & Endodontics; Partial Owner
- Sywe-Ren Chang; Research Laboratory Specialist Intermediate, Cariology, Restorative Sciences & Endodontics; Partial Owner