

**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

September 2022

Attachment A

Agreement #1

Option Agreement between the University and Electric Thrust Applications, Inc. Reviewed by the UMOR Conflict of Interest Review Committee		
<u>Innovation Partnerships Intellectual Property File Information</u>		
Number	Title	Inventors
2020-004	In-space Electric Propulsion System Enabled by Multitone Radiofrequency Waves	Ben Jorns, Ben Wachs
2022-412	Coaxial Electron Cyclotron Resonance Magnetic Nozzle Thruster	Ben Jorns, Ben Wachs
<u>Background</u>		
Electric Thrust Applications, Inc. was formed to commercialize plasma thruster technologies for small satellites and desires to option the University's rights associated with the technology listed above.		
<u>Net Effects</u>	<u>Agreement Terms</u>	
<ul style="list-style-type: none">● Internal use only exclusive for option period● Patents● All fields of use● Right to use internally for development and testing	Electric Thrust Applications, Inc. will: <ul style="list-style-type: none">● Have the right to negotiate an exclusive license	
<u>University Employee; University Title; Relationship with Electric Thrust Applications, Inc.</u>		
<ul style="list-style-type: none">● Benjamin Jorns; Associate Professor, Aerospace Engineering; Partial Owner● Benjamin Wachs; Postdoctoral Research Fellow, Aerospace Engineering; Partial Owner		

Agreement #2

**Option Agreement between the University and FreehillFerlic Corporation
Reviewed by the UMOR Conflict of Interest Review Committee**

Innovation Partnerships Intellectual Property File Information

Number	Title	Inventors
2019-315	An Instrumented Baseball for Measuring Grip Forces	Michael Freehill, Stephen Cain, Mason Ferlic, Jacob Casciano

Background

FreehillFerlic Corporation was formed to commercialize ball grip sensing technology and desires to option the University's rights associated with the technology listed above.

Net Effects

- Worldwide exclusive
- Patents
- All fields of use
- Right to evaluate

Agreement Terms

FreehillFerlic Corporation will:

- Reimburse patent costs

University Employee; University Title; Relationship with FreehillFerlic Corporation

- Mason Ferlic; Graduate Student Research Assistant, Statistics; Partial Owner

Agreement #3

License Agreement between the University and Fundamentals of Vaginal Surgery, LLC (a subsidiary of MakeMedical, LLC)

Reviewed by the Medical School Conflict of Interest Board

Innovation Partnerships Intellectual Property File Information

Number	Title	Inventors
2019-038	FVS Trainer	Deborah Rooney, Payton Schmidt, Tyler Bylsma, Chase Barlow, Trevor Alberts

Background

Fundamentals of Vaginal Surgery, LLC was formed to commercialize surgical simulators for advanced skills training of medical providers and desires to license the University's rights associated with the technology listed above.

Net Effects

- Worldwide exclusive
- Prototype documentation
- All fields of use
- Right to commercialize

Agreement Terms

Fundamentals of Vaginal Surgery, LLC will:

- Pay a royalty on sales

University Employee; University Title; Relationship with Fundamentals of Vaginal Surgery, LLC

- Deborah Rooney; Associate Professor, Learning Health Sciences; Partial Owner
- Payton Schmidt; Assistant Professor, Obstetrics and Gynecology; Partial Owner

Agreement #4

**License Agreement between the University and Low Carbon Fuel Systems, LLC
Reviewed by the UMOR Conflict of Interest Review Committee**

Innovation Partnerships Intellectual Property File Information

Number	Title	Inventors
2023-062	Improvements Relating to Multi-Plunger Pumps	Philip John Gregory Dingle, Andre Boehman
2023-063	Improvements to Fuel Injectors	Philip John Gregory Dingle, Andre Boehman

Background

Low Carbon Fuel Systems, LLC was formed to build and commercialize a dedicated Dimethyl ether fuel injection system for Cummins to Fiat Powertrain Technologies (FPT) engines and FPT-CNH (Case-New Holland) engines and desires to license the University's rights associated with the technology listed above.

Net Effects

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

Agreement Terms

Low Carbon Fuel Systems, LLC will:

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

The University will:

- Receive equity in Low Carbon Fuel Systems, LLC
- Retain the right to acquire/purchase more equity in Low Carbon Fuel Systems, LLC

University Employee; University Title; Relationship with Low Carbon Fuel Systems, LLC

- Andre Boehman; Professor, Mechanical Engineering; Partial Owner

Agreement #5

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

Innovation Partnerships Intellectual Property File Information

Number	Title	Inventors
2021-403	Delivery of Therapeutic NIR	Thomas Sanderson, Samuel Tuck

Background

Mitovation, Inc. was formed to commercialize medical device technology for the treatment of brain reperfusion injuries and desires to option the University's rights associated with the technology listed above.

Net Effects

- Worldwide exclusive
- Patents
- Field specific (medical devices for therapeutic intervention in reperfusion and inflammatory injury in humans)
- Right to evaluate

Agreement Terms

Mitovation, Inc. will:

- Pay an upfront fee
- Reimburse patent costs

University Employee; University Title; Relationship with Mitovation, Inc.

- Thomas Sanderson; Associate Professor, Emergency Medicine; Partial Owner