

The Office of Technology Licensing Enjoys Another Successful Year

Over \$800K allocated to inventors

In FY07, the OTL experienced its most successful financial year since the office opened in 1995. Gross income for the year totaled \$2.8M, which was up from \$1.4M in FY06. Net income was \$2.2M, up from 1.1M, with approximately \$850,000 allocated to 59 different inventors. The change in these financial figures over the past four years is illustrated in Figure 1.

Figure 2 compares yearly patent activity over the past four fiscal years. Over this period, invention disclosures from the St. Jude staff have gradually increased, while new patent filings and granted patents have been fairly steady with some variability as expected for these activities. In FY07, eleven new U.S. patent applications were filed, seven U.S. patents and 3 foreign patents were issued. The U.S. and foreign issued patents are listed in Table 1 (see page 2).

Figure 3 compares the number of agreements completed each year by the OTL over the past four fiscal years. The agreements are separated into five standard categories; license, corporate research, interinstitutional, confidentiality and consulting. St. Jude is not a party to consulting agreements, but the OTL reviews and tracks these agreements and recommends changes to support compliance with St. Jude policy. For more infor-

mation, please see the related article addressing frequently asked questions about consulting agreements on page 2.

Figure 2. Patent Activity FY04–FY07

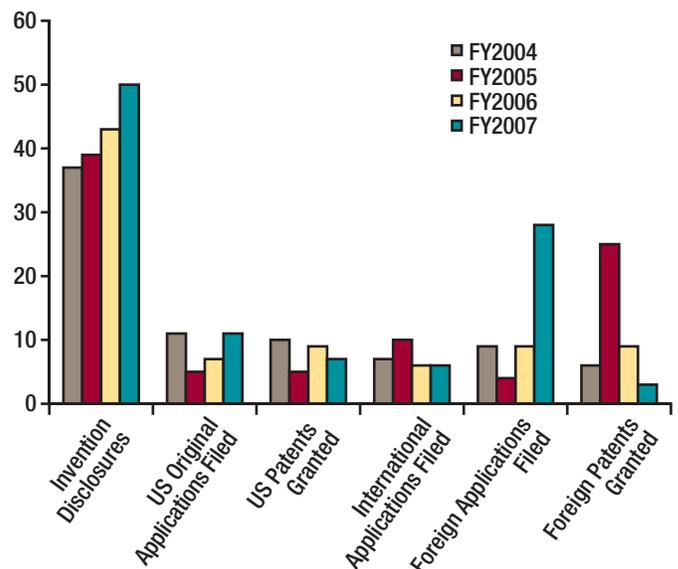


Figure 3. OTL Agreements FY04–FY07

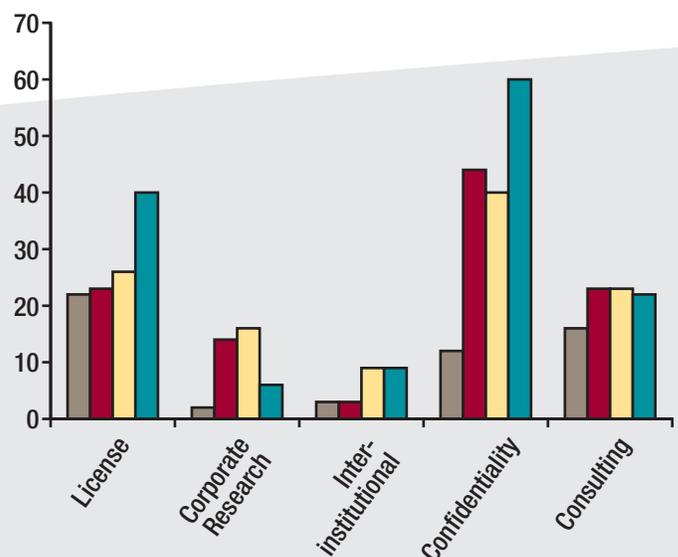


Figure 1. Income and Allocations FY04–FY07

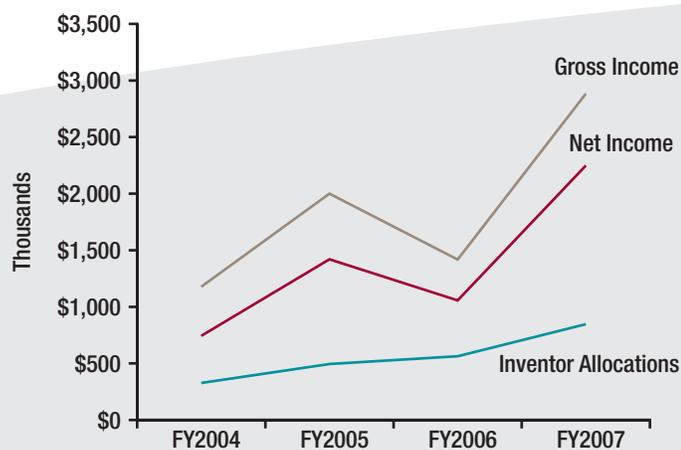


Table 1. Patents Issued to St. Jude in FY07

Issue Date	Country	Patent #	Subject Matter	Inventors
7/11/2006	US	7,074,908	Protein specific for cardiac and skeletal muscle	Bongiovanni, d'Azzo, Nastasi
9/4/2006	NO	322 261	Preparation and use of viral vectors for mixed envelope protein vaccines against human immunodeficiency viruses	Hurwitz, Owens, Slobod
9/19/2006	US	7,108,992	Critical phosphorylation site for activation of ATM kinase	Bakkenist, Kastan
10/19/2006	KR	638503	A polypeptide comprising the amino acid of an N-terminal choline binding protein A truncate, vaccine derived therefrom and uses thereof	Tuomanen, Masure
10/24/2006	US	7,125,673	CpG retrieval of DNA from formalin-fixed pathology specimen for methylation-specific PCT	Brent, Fan
10/26/2006	AU	2001125921	DNA transfection system for the generation of infectious influenza virus	Hoffmann
10/31/2006	US	7,128,919	Group B streptococcus polypeptides nucleic acids and therapeutics compositions and vaccines thereof	Adderson
1/9/2007	US	7,160,692	Critical phosphorylation site for activation of ATM kinase	Bakkenist, Kastan
4/17/2007	US	7,206,789	System and method for defining and collecting data in an information management system having a shared database	Hunsberger, Hurmiz, Kothapalli, Zhao
6/19/2007	US	7,232,670	Targeting proteins to macrophages via expression in insect cells	d'Azzo

Faculty and Staff Private Consulting Agreements

Frequently Asked Questions

- Does St. Jude allow faculty and staff members to consult with other nonprofit and for-profit entities?

Yes, subject to case by case review and consideration. St. Jude recognizes that faculty and staff possess unique knowledge and skills that may offer consulting opportunities beneficial to the faculty or staff member and St. Jude. However, such activities also can create conflict of commitment and conflict of interest concerns that must be managed. St. Jude has adopted policies to address these concerns and provide meaningful guidance, which can be found in Faculty Handbook Sections 300.3 and 300.6, and in Corporate Compliance Policy 70.003.
- What type of consulting is generally allowed?
 - consulting with a nonprofit
 - participation on a scientific advisory board
 - general consulting on for-profit company research projects, as long as any research you do is not funded by or associated with that company
 - scientific journal editing
- What type of consulting is generally NOT allowed?
 - consulting with a company that is funding your research
 - acting as an expert witness
 - participating in a corporate or industry speakers bureau
 - holding an office in a company (e.g., chief scientific officer, CEO)
 - any activity that could compromise St. Jude's reputation or a faculty or staff member's ability to carry out his or her obligations to St. Jude

cont., p. 3

4. Does the consulting agreement need to be in writing?

Consulting agreements for recurring activities need to be in writing. Agreements for one-time nonrecurring activities may not need to be in writing. However, even for these activities a written agreement is recommended, especially if the activity involved is significant, the amount of compensation is greater than \$1,000, or the agreement is with a for-profit entity.

5. Does St. Jude need to review my consulting agreement before it is signed?

Yes, if it is with a for-profit entity. You should submit any such proposed consulting agreement to the Office of Technology Licensing (OTL). The OTL reviews these agreements on behalf of St. Jude and adds standard language to help assure compliance with institutional policies. If a question about the propriety of a proposed consulting relationship is raised, the consulting agreement will be submitted to the St. Jude Corporate Compliance Officer for consideration by the Compliance Officer and the Conflict of Interest Committee.

6. Is there any company I absolutely cannot consult with?

You cannot consult for pay with any company that is funding your research. St. Jude does not allow such arrangements. St. Jude also has a policy of not allowing consulting arrangements that will, or are likely to, result in your being called to testify in court as an expert witness.

7. How many hours/days can I consult?

You can consult up to the equivalent of twenty four (24) days per year for for-profit entities. There is no strict limit on consulting time devoted to non-profit or government entities, but you must make sure that any consulting activities do not interfere with your primary commitment of your full professional time and effort to St. Jude.

8. Do I really need to read my consulting agreement?

Definitely. You are a party to the consulting agreement and are personally responsible for all of the obligations you accept. You should read the entire agreement and make sure you understand and can accept all of the provisions. The OTL can provide general guidance,

but it represents the interests of St. Jude and does NOT review consulting agreements on behalf of individual faculty or staff members. You need to seek your own private legal counsel if you want personal legal advice about your consulting agreement(s).

9. What should I look out for in these agreements?

You should pay particular attention to the following provisions:

- (i) **Payment:** The agreement should clearly state your rate of compensation and when you will be paid. Make sure the agreement provides for reimbursement of any out of pocket expenses you expect to incur while consulting.
- (ii) **Scope:** Make sure you are comfortable with all of the consulting activities you are being asked to undertake, and that they fall within your areas of expertise. You should not agree to disclose to anyone any St. Jude confidential information you have, the preliminary results of your own research, results of any other St. Jude research, or research results that you may be reviewing, for example as a member of a data and safety monitoring board.
- (iii) **Time:** The agreement should state the term of your consultancy and your maximum time commitment to assure compliance with institutional policy (see question 7). If the agreement does not state a maximum, you may be precluded from additional consulting activities due to time commitment concerns. The agreement should also give you the right to terminate your consulting services at any time after reasonable notice.
- (iv) **Confidentiality:** You need to be aware of obligations you are accepting with respect to keeping information you are given confidential and using it only to provide consulting services. Obligations requiring that you maintain confidentiality of information for a period longer than five years after disclosure to you should generally be avoided.
- (v) **Indemnification/Risk Allocation:** Companies may be willing to protect you from risks related to your consulting activities and/or they may require you to protect them from any risks associated with your violation of any agreement

New Conflict of Interest Policy

The new Conflict of Interest and Commitment policy is found in section 70.003 of the Institutional P&P and section 300.3 of the Faculty Handbook. The policy can be viewed online through the St. Jude intranet site under the P&P Manuals link found on the right hand side of the home page.

terms. Look for these provisions and read them carefully to make sure you are comfortable with the protection they provide and that you can accept any risks for which you are going to be responsible.

- (vi) Restrictions: Watch out for any restrictions, especially those prohibiting you from consulting with other companies in the same field, and make sure you can accept them and live by them.
- (vii) Intellectual Property. Provisions requiring you to assign rights to any inventions you make while consulting to the company are acceptable and do not conflict with your general assignment obligation to St. Jude for employment related activities. These provisions highlight the importance of keeping consulting activities separate from employment activities

10. Should I keep a copy of my consulting agreement?

Yes. You should give a copy of your completed agreement to the Office of Technology Licensing, but you should also keep a copy (or preferably an original) for yourself.

11. If I am a researcher, can I disclose my unpublished research results to a company under a consulting agreement?

No. Your unpublished research results, and those of other scientists or researchers, represent confidential information that belongs to St. Jude or to other institutions. Disclosure of such results should not be used as a bargaining chip to entice a company to retain you as a consultant.

12. Can I use St. Jude facilities, services or resources to conduct consulting activities?

No.

We're Moving

In January, the OTL offices will be moving to the east end of the 305 Building. More information about room numbers and the mail stop will be provided later.

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