

UC Berkeley Press Release

EBI named tech-transfer "Deal of Distinction"

By Robert Sanders, Media Relations | 22 October 2008

BERKELEY — The University of California, Berkeley's landmark \$500 million biofuels research partnership with energy giant BP, signed nearly a year ago, has been named a "Deal of Distinction" by the Licensing Executives Society, an organization of U.S. and Canadian technology transfer professionals.

The annual Deal of Distinction awards, announced today (Oct. 22) at the society's meeting in Orlando, Fla., honor the "complex art" of technology licensing. According to the society, the awards recognize agreements that are clearly written and "permit intellectual property transfer at fair value," thereby speeding the flow of research from the laboratory to the marketplace, where it can benefit society.

The Energy Biosciences Institute (EBI), a research partnership between UC Berkeley, Lawrence Berkeley National Laboratory, the University of Illinois at Urbana-Champaign (UIUC) and BP, draws upon many scientific disciplines to find clean, renewable energy sources and lessen the impact of fossil fuels on global warming.

According to a statement from co-chairs Bob Gruetzmacher and Nathan Golden and chair-elect Elaine White, all from the Industry/University and Government Laboratory (IUGI) Transactions sector of the organization, the EBI contract is "unique in scope and represents an innovative model for collaboration between academia, government labs and industry."

Intellectual property (IP) includes patents, copyrights, trademarks and trade secrets, which "are the fundamental drivers of innovation in our knowledge-based economy," the society noted.

"This deal enables the partners to leverage complementary skills, expertise and resources in a way that has the potential to result in the development of novel energy sources and solutions that could significantly benefit the global community," said White. "The IUGI sector is extremely pleased to congratulate this year's winners for this important collaboration."

Awards also were given by four other sectors of the organization, representing consumer products; chemicals, energy and materials; health care; and high technology.

"This deal exemplifies the synergies that arise when universities, industry and government work together to accelerate innovation," said Carol Mimura, assistant vice chancellor for UC Berkeley's Intellectual Property and Industry Research Alliances (IPIRA), who will accept the award for the campus.

"Translational research gaps are both wide and expensive to traverse," she said. "We applaud BP for having the foresight and commitment to invest in the Energy Biosciences Institute at

Berkeley and UIUC to address the urgent problem of finding sustainable energy solutions. We have piloted several new approaches at the industry-university interface over the last several years with the goal of maximizing the social impact of UC Berkeley research. We are honored and so pleased to be recognized by LES and to contribute to the society's ongoing efforts."

Mimura oversaw negotiations between BP and the three academic partners to insure that UC Berkeley's values of academic freedom were a part of the 10-year EBI contract. At the same time, she sought to structure the agreement so that laboratory inventions, so-called intellectual property, would be vigorously developed by BP or others. The key to this was a provision giving BP not only a non-exclusive, royalty-free license to an invention, but a 90-day option for an exclusive, royalty-bearing license in the energy field.

"An exclusive license to a patent right provides a company with the protection and incentive it needs to invest in a long, expensive and risky research-and-development process," said Mimura. "A company would have no incentive to make such large investments if its competitors could obtain the same license to the same IP rights."

In either situation, BP is required to diligently commercialize the invention. If BP does not opt for an exclusive license in the energy field, UC Berkeley can approach other companies, including BP's competitors, to license the technology. Even with an exclusive license, UC Berkeley can license an invention to other companies outside the field of energy.

Noting that the EBI's goal is to find improved biofuels to lessen the release of greenhouse gases and slow global warming, Mimura said, "We want BP to deploy the technology for public benefit. The university's goal should be to chase the social impacts and not the money."

UC Berkeley's IPIRA office was created in 2004 to provide a one-stop shop for industry research partners to interact with the campus. IPIRA's mission is to establish and maintain multifaceted relationships with private companies, and thereby enhance the research enterprise of the Berkeley campus. These relationships include sponsored research collaborations and intellectual property commercialization.

For more information on the EBI contract, link to an [FAQ](http://berkeley.edu/news/media/releases/2007/11/14_ebi-faq.shtml):
(http://berkeley.edu/news/media/releases/2007/11/14_ebi-faq.shtml)