

**WHAT DO I NEED TO KNOW
ABOUT INVENTIONS**

from

**GOVERNMENT OWNED
GOVERNMENT OPERATED**

[GOGO]

LABORATORIES?

Major Federal Legislation Impacting Technology Transfer from Federal Laboratories

- Bayh-Dole Act
- Stevenson-Wydler Technology Innovation Act of 1980
- Federal Technology Transfer Act of 1986

1) Bayh-Dole Act

Provided authority to grant exclusive or partially exclusive licenses on a royalty-bearing basis for patented inventions.

2) Stevenson-Wydler Technology Innovation Act

Vested federal government with
the responsibility for promoting
the use of federally funded R&D

3) Technology Transfer Act of 1986

- authorizes **Cooperative Research And Development Agreements (CRADAs)**
- provides for right of first refusal to cooperator
- mandates that inventors receive the first \$2,000 plus at least 15% of royalties received (USDA gives 25%; each agency is different)

Four Mechanisms for Retaining Confidentiality:

1. Authorized to withhold information until a patent is filed
 - 35 USC 205
2. Marketing and development plans/utilization reports may be held as confidential information.
 - 35 USC 209 (a)
 - (referenced in 37 CFR 404.14)

Mechanisms continued:

3. A. No confidential or commercial information from a non-federal party shall be disclosed;

B. Information may be held confidential for up to 5 years.
 - 15 USC 3710a(c)(7)

4. FOIA – exemption b (4):
business and confidential information
 - 5 USC 552

Three Common Concerns of Industrial Partners:

1. March in Rights allow Government to terminate or grant a license to a third party if:
 - b) steps to practical application not taken;
 - c) action necessary for health/safety reasons or public use;
 - d) substantial manufacture requirement.
- 35 USC 203

Concerns continued:

1. Government is granted an irrevocable, paid-up, royalty-free license to practice and have practiced the invention.
 - 35 USC 202 (c)(4) & 209 (b)
(referenced in 37 CFR 404.7(a)(2)(i))

Concerns continued:

3. Preference for U.S. industry: invention must be substantially manufactured in the United States
 - 35 USC 204 (referenced in 37 CFR 404.5(b)(8))

Relevant Websites

- Federal Laboratory Consortium

www.federallabs.org

- EPA

www.epatechmatch.com

- NIH

www.ott.nih.gov

- ARS – OTT

www.ars.usda.gov/Business/Business.htm

- DOD

www.defenselink.mil/policy/sections/policy_offices/hd/offices/techTrans/index.html