



FEDERAL LABORATORY CONSORTIUM
FLC
FOR TECHNOLOGY TRANSFER

*The Only Government-wide
Forum for Technology
Transfer*

**Non-CRADA
Technology
Transfer
Mechanisms
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TERRY LYNCH

- Senior Licensing and CRADA Officer, National Institute of Standards and Technology (NIST)
- Negotiates licenses, CRADAs, and facility use agreements
- Previously, manager of NIST SBIR program
- Active participant in Interagency Working Group on T2 (IAWGTT)
- FLC Member-at-Large (2003-2007)
- NIST Laboratory Representative to the FLC (1996-present)



TT MECHANISMS

- Publication
- Open, relatively informal collaboration
- Formal collaboration agreements
- License agreements
- Agency-funded agreements
- Facility use agreements
- Material transfer agreements



TT MECHANISMS (Cont.)

- Personnel exchange agreements
- Work for others
- Nondisclosure agreements
- Partnership intermediary agreements



TT MECHANISMS (Cont.)

Agency/laboratory examples and information on each of these T2 mechanisms is available in the Federal Technology Transfer Mechanisms Database on the FLC website at:

<http://www.federallabs.org/education/t2-matrix>



PUBLICATION

- Peer reviewed publication
- Lab/agency PR activities
- Conference presentations, seminars, etc.
- Poster sessions



OPEN, INFORMAL COLLABORATION

- Informal collaboration
- Guest researcher agreements
- NRC post doctorate personnel – term employee?
- Other agency post doctorate personnel – IP rights?
- Professional Committees (formerly Standards Committees)



OPEN, INFORMAL COLLABORATION (Cont.)

“Guest” Type	Patent Rights
Domestic Guest Researcher – Research and Science, Contractor, Facility User	<ul style="list-style-type: none"> • If at NIST under a federal funding agreement, the inventor and/or his/her employer will have the option to elect to retain ownership to his/her sole inventions or to retain joint ownership rights in joint inventions. If a sole guest researcher (GR) invention, NIST may be precluded from using the subject matter of the invention until a patent application is filed or the two-year option period expires as the invention may be proprietary information. • If not at NIST under a funding agreement, the NIST Guest Research Agreement provides that the GR and or his/her employer retains ownership of GR inventions. NIST retains a government use right.
Domestic Guest Researcher- Technical (DGRTEC)	If at NIST under a federal funding agreement, the DGRTEC and/or his/her employer will have the option to elect to retain ownership to his/her inventions or to retain joint ownership rights in joint inventions. If a sole DGRRS invention, NIST may be precluded from using the subject matter of the invention until a patent application is filed or the two-year option period expires.



OPEN, INFORMAL COLLABORATION (Cont.)

<p>Domestic Guest Researcher – Special Programs (DGRSPL) Foreign Guest Researcher – Special Programs (FGRSPL) PREP, SURF</p>	<ul style="list-style-type: none"> • PREP and SURF participants are federal grant recipients and have the option to elect to retain ownership to his/her inventions or to retain joint ownership rights in joint inventions. If a sole PREP or SURF invention, NIST may be precluded from using the subject matter of the invention until a patent application is filed or the two-year option period expires. • If it is determined that PREP and/or SURF participants are at NIST primarily for educational purposes, NIST does not retain a government use right to their inventions.
<p>Foreign Guest Researcher – Research and Science (FGRRS) Foreign Guest Researcher-Technical</p>	<ul style="list-style-type: none"> • If at NIST under a federal funding agreement with a domestic institution, the FGR and/or his/her employer will have the option to elect ownership to his/her inventions or rights in joint inventions. (Note, subsistence allowances to FGRs are not considered “funding” for purposes of Bayh Dole) If a sole FGR invention, NIST may be precluded from using the subject matter of the invention until a patent application is filed or the two-year option period expires. • If not at NIST under a federal funding agreement, patent rights may be determined by treaty or other agreements.
<p>Research Associate (RA)</p>	<p>The patent rights of CRADA collaborators are determined by the language of a specific CRADA.</p>



OPEN, INFORMAL COLLABORATION (Cont.)

<p>Intergovernmental Agency Personnel Act</p>	<ul style="list-style-type: none"> • If the IPA is a federal government employee, the IPA will be required to assign their interest in the invention to their agency. • If at NIST under a federal funding agreement, the inventor and/or his/her employer will have the option to elect to retain ownership to his/her sole inventions or to retain joint ownership rights in joint inventions. If a sole IPA invention, NIST may be precluded from using the subject matter of the invention until a patent application is filed or the two-year option period expires as the invention may be proprietary information. • If not a federal government employee nor at NIST under a funding agreement, the NIST Guest Research Agreement provides that the IPA and or his/her employer retains ownership of IPA inventions. NIST retains a government use right.
<p>Student Volunteers</p>	<p>Student Volunteers do not sign the NIST Guest Researcher Agreement. Patent ownership rights, if any, retained by Student Volunteers must be determined on a case- by case basis by the Office of NIST Counsel.</p>



FORMAL COLLABORATION AGREEMENTS

- CRADAs and NASA Space Act Agreements
 - “Standard” Collaboration CRADAs
 - MTA CRADAs
 - Equipment Loan CRADAs
 - Calibration CRADAs
- Partnership Intermediary Agreements (PIAs)
- Interagency Agreements



PARTNERSHIP INTERMEDIARY AGREEMENT

- The statutory authority for use of partnership intermediaries is Title 15 USC, Section 3715.
- The PIA provides for the partnership intermediary to perform services for a federal lab that increase the likelihood of success in the conduct of cooperative or joint activities with small business firms, institutions of higher education, or educational institutions.



PARTNERSHIP INTERMEDIARY AGREEMENT (Cont.)

- An intermediary must be a nonprofit entity owned in whole or in part by, chartered by, funded in whole or in part by, or operated in whole or in part by or on behalf of a State or local government.
- The intermediary's function must be to assist, counsel, advise, evaluate, or otherwise cooperate with small business firms/institutions of higher education.
- The lab may not receive funds under a PIA.



LICENSE AGREEMENTS

- Patent
- Plant variety
- Copyrighted software (limited circumstances)
- Other “inventions”?



LICENSE AGREEMENTS (Cont.)

- May be exclusive, non-exclusive, partially exclusive.
- May be research and/or commercialization licenses.
- May be royalty-free or income bearing.
- May divide the rights by field of use or geography.
- May involve laboratory support in further development/
commercialization, with or without additional compensation.



AGENCY-FUNDED AGREEMENTS

- Cooperative agreements (as distinct from a Cooperative Research and Development Agreement, or CRADA)
 - Federal guidelines for using a cooperative agreement (as distinct from a contract or grant) are basically the same as those for a grant, except that the funding agency expects to be substantially involved with the recipient of the research funds in carrying out the funded activities.

- SBIR/STTR



FACILITY USE AGREEMENTS

- Types – Proprietary, nonproprietary
- Typical policy considerations
 - Cost recovery
 - No equivalent private sector capability
 - Fairness of access
 - “Designated” facilities



MATERIAL TRANSFER AGREEMENTS

- Material Transfer Agreement (MTA) is a contract that governs the transfer of tangible research materials between two organizations, when the recipient intends to use it for his or her own research purposes.
 - MTA defines the rights of the provider and the recipient with respect to the materials and any derivatives.
 - Biological materials are the most frequently transferred materials, but MTAs may also be used for other types of materials, such as chemical compounds and even some types of software.



MATERIAL TRANSFER AGREEMENTS (Cont.)

Typical issues addressed in an MTA include:

- Who is providing what to whom and why
- Research restriction
- Relevant safety requirements
- IP language, which may require considerable negotiation
- Return/destruction of the transferred material



PERSONNEL EXCHANGE AGREEMENTS

- Guest researchers
- Industry/lab fellows
- Intergovernmental Personnel Act (IPA) program—Purpose is to facilitate cooperation through the temporary assignment of skilled personnel between the federal government, state and local governments, institutions of higher education, federally funded research and development centers maintained by the National Science Foundation, Indian tribal governments, and other nonprofit organizations for limited periods without loss of employee rights and benefits.



NONDISCLOSURE AGREEMENTS

- A nondisclosure agreement (NDA) is typically used when lab personnel are going to receive proprietary information from external organizations.
- Nondisclosure agreement defines the treatment of this proprietary information under terms that are acceptable to both parties' cooperative agreements



NONDISCLOSURE AGREEMENTS (Cont.)

- An NDA protecting incoming information creates an express obligation for federal employees under the Trade Secrets Act. This is a criminal statute.
- However, the Trade Secrets Act applies to a very broad definition of “proprietary information,” whether received informally or under a formal agreement such as an NDA or CRADA.



NONDISCLOSURE AGREEMENTS (Cont.)

Proprietary Information

A typical definition of proprietary information is “confidential scientific, business, or financial information,” with the exception of:

- Information that was already in the lab’s possession
- Becomes a matter of public knowledge through no fault of the lab
- Is received by the lab from another party without a duty of confidentiality
- Is disclosed by the provider to a third party without a duty of confidentiality on the third party, or
- Is independently developed by the lab.



NONDISCLOSURE AGREEMENTS (Cont.)

- There are relatively few circumstances under which a government-owned, government-operated (GOGO) lab would protect lab information under an NDA, because most lab information is subject to the Freedom of Information Act.
- One such case would be to protect information about an invention prior to the filing of a provisional or nonprovisional patent application to avoid premature “public disclosure” as defined in the patent statute.



COMMERCIAL TEST AGREEMENTS

- Agreement between government and nonfederal party
- Sell, rent, or lend government equipment or materials
- Testing of materials, equipment, models, computer software, and other items for a fee
- Not subject to procurement regulations
- Cannot compete with private sector