

MICHIGAN STATE UNIVERSITY

July 25, 2018

Via email: roi@nist.gov

RE: RFI Response: Federal Technology Transfer Authorities and Processes
Docket Number: 180220199-819-01

Michigan State University Office of Technology Transfer to NIST Request for Information: Federal Technology Transfer Authorities and Processes

Michigan State University (MSU) is the nation's pioneer land-grant university. Founded in 1855 as the Agricultural College of the State of Michigan and opening its doors to students in 1857, this university triggered a revolution that five years later would culminate in the Morrill Act, founding land grant universities across the United States. Since 1857, Michigan State University has been leading the nation in the growth and development of research, teaching, and outreach founded in the land grant ideals. In 2018, MSU and our commitment to technology transfer for the public good is the 21st century embodiment of that ideal.



MSU Innovation Center

MSU Technologies

City Center Building
325 E. Grand River, Ste 350
East Lansing, MI 48823

517-355-2186
Fax: 517-432-3880
technologies.msu.edu

The office of technology transfer at Michigan State University, MSU Technologies (MSUT), appreciates the opportunity to respond to the Request for Information ("RFI") issued by the National Institute of Standards and Technology (NIST) regarding federal technology transfer authorities and processes.

MSU Technologies reviewed responses to the RFI submitted by other organizations:

- A joint response from the Association of American Universities (AAU), Association of Public and Land Grant Universities (APLU), Council on Governmental Relations (COGR), and the Association of American Medical Colleges (AAMC);
- A response from AUTM, a non-profit organization representing more than 3000 technology transfer professionals, mainly in the United States, along with 50+ additional countries worldwide.

MSUT believes the detailed recommendations presented in these responses merit serious consideration by NIST; MSUT wishes to highlight what we believe are among the most important recommendations.

We strongly recommend Bayh-Dole remain unchanged as the statutory framework for promoting the transfer of federally funded research to the public.

Bayh-Dole establishes several fundamental principles for commercialization of federally-funded research:

- Decentralization of technology ownership and management from the federal bureaucracy to the local creating organization;
- Establishment of clear rules that are uniformly implemented across all government agencies;
- Creation of strong incentives for university-industry partnerships for successful technology transfer; and
- Clarification of patent ownership and related benefits in the federal research and development system.

Universities greatly benefit from the local control provided in the Bayh-Dole framework. Tech transfer professionals working in conjunction with researchers at universities and federal research labs alike are best equipped to move technology from the laboratory to the market due to their expertise on the technology invented, as well as the often narrow areas of research involved. To this end, MSUT recommends that the government, through NIST, reassert technology transfer as a priority of federal research, empowering the tech transfer professionals in federal labs to enable a variety of industrial partnership opportunities through delegated authority and clear guidelines.

Emphasize the Societal Benefits of Technology Transfer.

Too much weight has been assigned to metrics such as the number of patents, licenses, and licensing revenue in defining the success of university tech transfer. These metrics provide a certain indication of the important contributions of technology transfer, but that can never tell the whole story. Metrics leave out the positive impact tech transfer has on people's lives, from life-saving pharmaceuticals, to clean energy advances, to hardier crop varieties transferred to the developing world. MSUT recommends that the federal government, in consultation with the universities and their associations, broaden the understanding of return on investment to focus on societal impact and emphasize the underlying social and public mission inherent in the development of federal research into products that benefit the American public.

Fine Tune the Patent System to Provide Greater Clarity and Certainty Regarding the Patent Process.

Universities, federal labs, and medical schools depend on a robust, reliable patent system for their technology transfer activities to achieve societal benefits. Patents lower the perceived risk of investing in early stage technology and help attract private investment dollars to developing this technology. To that end, research institutions and their licensees and startups would benefit substantially from greater clarity on what constitutes patentable subject matter, greater certainty that patents on their inventions will not be subject to misapplications of the Bayh-Dole Act march-in rights and greater assurances that those patents will be enforceable in fair proceedings, whether in the courts or at the Patent Trial and Appeal Board (PTAB). Without this clarity, research institutions cannot attract investors and licensees. Fewer technologies will be licensed and fewer technologies developed under federal funding will be transferred into products that benefit the American Public.

Streamline Technology Transfer Reporting Requirements.

In order to advance the technology transfer efforts of federal contractors, it is critical that current reporting requirements and systems are simplified and improved. Most, but not all, federal agencies use the iEdison system for reporting federally funded inventions. iEdison is a legacy system that has

never been properly resourced. Use of iEdison is not mandatory across government agencies and several agencies have their own alternative and burdensome reporting requirements and systems. A uniform, simplified invention reporting system utilizing current IT standards across all federal agencies should be implemented in place of the current system. Furthermore, use of this system should be mandatory for all federal funding agencies and all federal labs.

MSUT thanks NIST for soliciting viewpoints and conducting public forums on this important issue.

Sincerely,

A handwritten signature in blue ink, reading "Richard W. Chylla". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Richard W. Chylla, PhD, CLP, RTTP
Executive Director, MSU Technologies