

TECHNOLOGY TRANSFER

IN A NUTSHELL FOR

ACCESSIBILITY VOTING TECHNOLOGY RESEARCHERS

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Technology Innovation Legislation

Major Technology Transfer Laws and Executive Orders

- Stevenson-Wydler Technology Innovation Act of 1980 (P.L. 96-480)
- Bayh-Dole Act of 1980 (P.L. 96-517)
- Small Business Innovation Development Act of 1982 (P.L. 97-219)
- Federal Technology Transfer Act of 1986 (P.L. 99-502)
- Executive Order 12591 (1987)
- Omnibus Trade and Competitiveness Act of 1988 (P.L. 100-418)
- National Competitiveness Technology Transfer Act of 1989 (P.L. 101-189)
- American Technology Preeminence Act of 1991 (P.L. 102-245)
- Small Business Research and Development Enhancement Act of 1992 (P.L. 102-564)
- National Department of Defense Authorization Act for 1994 (P.L. 103-160)
- National Technology Transfer and Advancement Act of 1995 (P.L. 104-113)
- Technology Transfer Commercialization Act of 2000 (P.L. 106-404)
- Energy Policy Act of 2005 (P.L. 109-58)
- America COMPETES Act of 2007 (P.L. 110-69)
- America COMPETES Reauthorization Act of 2010 (P.L. 111-358)

The Tools of Federal Technology Transfer

The Bayh-Dole Act

“Possibly the most inspired piece of legislation to be enacted in America over the past half-century was the Bayh-Dole act of 1980... More than anything, this single policy measure helped reverse America’s precipitous slide into industrial irrelevance.”

Economist Technology Quarterly, Dec. 14, 2002

Bayh-Dole Highlights

- A “contractor” (i.e., nonprofit organization (such as a university) or a small business) has the right **to elect** (within a reasonable time) **to retain title** to any “subject invention” made under federally funded R&D (e.g., grants, contracts, cooperative agreements)
- Under “exceptional circumstances when it is determined by the agency that restriction or elimination of the right to retain title to any subject invention will better promote the policy and objectives of this chapter” an agency may limit the presumption that ownership will vest in the contractor
- A contractor may assign or obtain rights in joint inventions made with federal employees
- An inventor may obtain ownership rights from the contractor or from a federal agency
- The contractor must commit to commercialization within a predetermined, agreed upon, time frame

Bayh-Dole Highlights

- The government retains “a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States any subject invention throughout the world”
- The government also retains “march-in rights,” which allow the federal agency to require the contractor (whether it owns the title or has an exclusive license) to “grant a nonexclusive, partially exclusive, or exclusive license in any field of use to a responsible applicant or applicants” (with compensation) or to grant such a license itself under certain circumstances
- To trigger march-in rights, the agency must determine that the contractor has not made efforts to commercialize within an agreed upon time frame, or that march-in “is necessary to alleviate health or safety needs which are not reasonably satisfied by the contractor”
- To date, no agency has ever exercised march-in rights

Bayh-Dole Highlights

- A contractor must report an invention to the funding agency within 2 months from the date it is reported to the contractor by the inventor (previous requirement was 6 months from conception or actual reduction to practice)
- A contractor must make an election of rights within 2 years from the date it is reported to the agency (may request additional time)
- A contractor must file a patent application within 1 year of making an election
- The patent application must include a government rights statement

Federal Tech Transfer Summed Up

- The Bayh-Dole Act underpins the ability of a non-profit (university) or small business to out-license inventions made with Federal funding
- Bayh-Dole creates a presumption of ownership by the contractor, and of a non-exclusive right of the government to practice
- A number of clocks start ticking for the contractor - including the obligation to disclose inventions, elect to retain title, file a patent application, and report on commercialization progress – failure to satisfy these can result in loss of rights
- The over-arching objective is to achieve practical application of government-funded research for the benefit of the public

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