MEMORANDUM OF UNDERSTANDING
BETWEEN

THE NATIONAL INSTITUTE OF STANDARDS AND TECHNOLOGY
AND
THE UNITED STATES PATENT AND TRADEMARK OFFICE

I. PARTIES

This Memorandum of Understanding (MOU) constitutes an agreement between the National Institute of Standards and Technology (NIST) with specific emphasis for the involvement of the Manufacturing Extension Partnership (MEP) program, and the United States Patent and Trademark Office (USPTO). Both are bureaus of the United States Department of Commerce.

II. AUTHORITIES

To implement this MOU, authority for cooperation in areas of mutual interests and responsibilities is provided for USPTO and for NIST under the following:

National Institute of Standards and Technology - Section 3 of the National Institute of Standards and Technology Act (15 U.S.C. 271 et. seq.) Regional Centers for the Transfer of Manufacturing Technology (15 U.S.C. §§ 272(b) (1), 273, 278k);

United States Patent and Trademark Office - USPTO Efficiency Act (35 USC § 2(b)(5)) allows the USPTO to use, with their consent, services, equipment, personnel, and facilities of other departments, agencies, and instrumentalities of the Federal Government, on a reimbursable basis, and cooperate with such other departments, agencies, and instrumentalities in the establishment and use of services, equipment, and facilities of the Office; and 35 U.S.C. § 2(b)(11) authorizes the Agency to conduct programs, studies, or exchanges of items or services regarding domestic and international intellectual property law and the effectiveness of intellectual property protection domestically and throughout the world.

III. PURPOSE AND INTENT

This document formalizes the agreement between the Parties and is intended to provide an enabling mechanism for coordination and cooperation to enhance outreach of Intellectual Property (IP) information to United States manufacturers whenever appropriate and mutually beneficial. Cooperation may include, but is not limited to, the specific areas identified below:

- Broadly exploring multiple opportunities to leverage USPTO's educational resources on IP with NIST's reach to industry;

- Informational webinars, briefings, meetings and conferences for NIST and MEP field personnel regarding the value of IP to include Intellectual Property Awareness Campaign (IPAC) Event Opportunities and the methods for acquiring, managing and enforcing IP rights;

- Utilizing USPTO's Federal resources from the Office of Innovation Development and the Global Intellectual Property Academy to work with the Program Development division of NIST MEP, to develop a prototype and training materials for an awareness assessment tool that can be used for outreach, training, and guidance for small and medium enterprises (SMEs) and inventors;

- USPTO and NIST MEP exploring the possibilities of patent mining to support NIST MEP SME client technology scouting for the purposes of developing an innovation pipeline;

- Sharing of program contacts to leverage reach and enhance dissemination of IP information through the network of business assistance programs through the Interagency Network of Enterprise Assistance Providers; and

- USPTO participation in training workshops and briefing sessions at the MEP National Conference and at several MEP Centers during the year.

The awareness assessment tool development-focused effort mentioned above provides Federal resources that will be appropriately defined in corresponding statements of work (SOWs) with detailed specific programmatically focused aspects of this collaboration. The existing Federal programs that are impacted under the USPTO and NIST are also stated above. The intent of this MOU is to help coordinate and integrate the resources and capabilities of the USPTO and NIST to optimize benefits and results.

IV. IMPLEMENTATION AND RESPONSIBILITIES

1. To enable close and effective collaboration within the design of this MOU, it is agreed that both the NIST and USPTO will identify coordinators to implement and manage this MOU. The coordinators shall meet on a regular basis to discuss activities conducted under the MOU, review all aspects of implementation, and plan future directions of programmatic interaction and cooperation.

2. The coordinators will report progress to their respective management on a quarterly basis, or more often as appropriate.

3. The coordinators shall obtain appropriate agreement by each agency in writing on each significant activity to be undertaken pursuant to the MOU, including agreement on the scope of work; tasks, deliverables (if any) and delivery dates; anticipated products and outcomes; periods of performance; levels of funding and resources to be provided for each activity by the two agencies; and any other appropriate and necessary aspects of mutual activities.

4. NIST and USPTO will provide meeting space with internet connectivity as needed. NIST and USPTO will provide clearance onto campus and enable security badge(s) for access as deemed appropriate to offices and departments on NIST campus and at the USPTO.

5. Any disputes that may arise under this Memorandum of Agreement which cannot be resolved by the signatories to this MOU will be submitted to the next higher level of management for final resolution.

6. The following persons are the points of contact for this Memorandum of Understanding:

- John Calvert, Senior Advisor, Office of Innovation Development (john.calvert@uspto.gov)
- Alex Folk, Director, Program Development Office (alex.folk@NIST.gov)

V. SPECIFIC PROJECTS

As indicated in Section I. of this MOU, a series of SOWs will be created for each Project that is to be worked in conjunction with this MOU. These Project SOWs will be jointly created by the Party POCs for each agency to ensure the appropriate address of the defined needs and issues in a timely manner. The Project SOWs will detail the Project resources to be provided by the collaborating entities, including the commitment of any direct funding, in-kind resources and other resources required during the Project. The Project SOWs will detail tasking for each Party, along with how Projects are to be managed. For those SOWs that involve NIST MEP, the roles of MEP Centers will also be detailed in Project SOWs. Such SOWs will be incorporated into this agreement by bilateral amendment, or will be memorialized in separate agreements.

VI. FINANCIAL RESPONSIBILITIES AND LIMITATIONS

Nothing in this MOU is to be construed as indicating a financial commitment by signatory agencies or any state agency for the expenditure of funds. Neither Party will have powers to enter into contracts, incur liabilities, own or create intellectual property, or otherwise make legally binding commitments of the funds or other assets of the other Party. Each Party will directly fund its own participation under this agreement. This agreement does not obligate either Party to spend funds for any particular project or purpose, even if funds are available.

As required by the Antideficiency Act, 31 U.S.C. §§ 1341-42, all commitments made by the Parties in this MOU are subject to the availability of appropriated funds and to budget priorities. Nothing in this MOU, in and of itself, obligates any Party to expend appropriations or to enter into any contract, assistance agreement, interagency agreement, or incur other financial obligations. Absent a formal amendment, no funds will transfer between the Parties to this MOU.

This MOU does not, and is not intended to impose any legally binding requirements on the Parties. Policy and procedures within this MOU are intended solely as guidance. If necessary, the Parties intend to jointly issue any formal guidance interpreting this MOU and background materials upon which it is based. This MOU does not constitute final agency action on any issue. Any actions contemplated by this MOU are to be carried out in an appropriate administrative process by the action agency in accordance with all applicable laws and regulations.

This MOU does not create any right or benefit, substantive or procedural, enforceable by law or equity, by persons who are not party to this agreement, against the Parties, their officers or employees, or any other person. This MOU does not direct or apply to any person outside of the Parties.

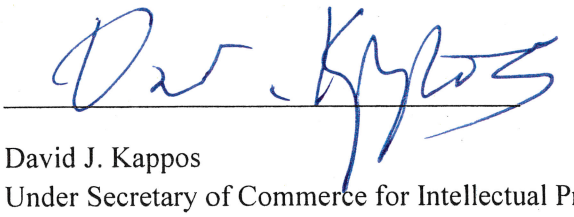
The parties agree that this MOU is non-exclusive and nothing contained herein prevents either party from entering into similar agreements with any third party. If any terms of this MOU are inconsistent with existing authorities or directives of either of the Agencies entering into this MOU, those portions of this MOU that are determined to be inconsistent shall be invalid; the remaining terms and conditions shall remain in full force and effect.

Nothing herein shall be construed to create any joint venture or similar relationship or to subject the parties to any implied duties or obligations respecting the conduct of their affairs that are not expressly stated herein. Neither party shall have any right or authority to assume or create any obligation or responsibility, either expressed or implied, on behalf of or in the name of the other party, or to bind the other party in any matter whatsoever. Neither party shall be deemed to be an agent or principal of the other.

VII. COMMENCEMENT/DURATION/MODIFICATION/TERMINATION

This MOU is to take effect upon the last signature date of the Parties, and shall remain in effect for a period of five years. This MOU may be extended or modified, at any time while it is in effect, per the mutual written agreement of the Parties. Additionally, a Party may terminate its participation in this MOU at any time by providing written notice to the other Parties, at least 60 days in advance of the desired termination date.

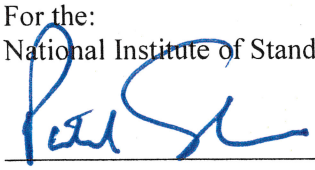
For the:
United States Patent and Trademark Office



David J. Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
david.kappos@uspto.gov

Date: 1/6/12

For the:
National Institute of Standards and Technology



Patrick Gallagher
Under Secretary of Commerce for Standards and Technology
and Director of the National Institute of Standards and Technology
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Date: 1/27/12