



FEDERAL LABORATORY CONSORTIUM
FLC
FOR TECHNOLOGY TRANSFER

*The Only Government-wide
Forum for Technology
Transfer*

How to Establish and Manage a Technology Transfer Office

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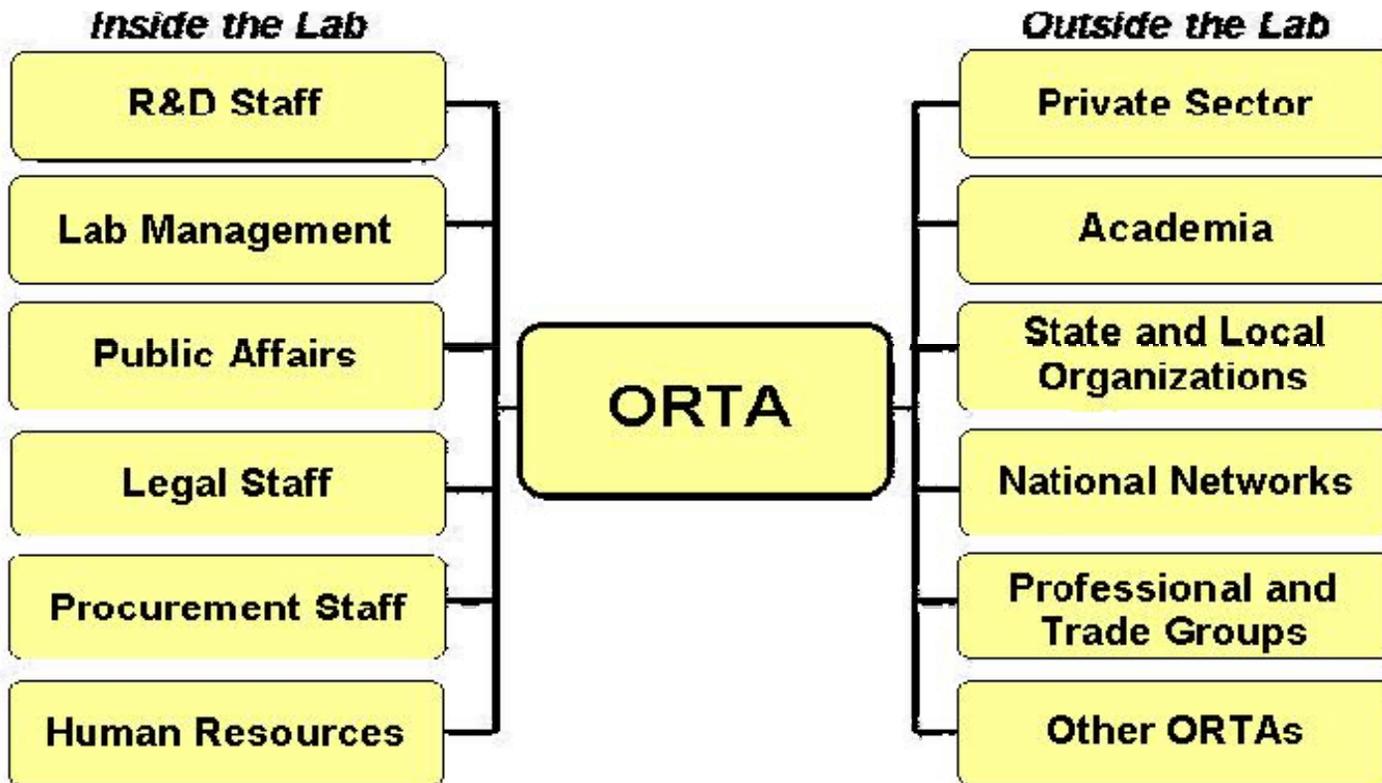


DR. J. SCOTT DIETER

- Director of Technology Transfer Office, Naval Surface Warfare Center (NSWC), Indian Head Division for 12 years
- Technology transfer responsibilities include:
 - Marketing and licensing Navy intellectual property
 - Negotiating CRADAs among labs, industry, state and local governments, and academia
 - Outreach activities to develop partnering opportunities
 - Interaction with partnership intermediaries
- ORTA Representative for NSWC, Indian Head Division
- Regional Coordinator, FLC Mid-Atlantic Region
- Research Chemist at NSWC for 22 years



ORTA—FOCAL POINT FOR TECHNOLOGY TRANSFER





KNOW YOUR TEAMMATES

- Contact your Lab Director, OC, PA
- Introduce yourself to your management
- Become aware of lab capabilities
- Seek competent **HELP!**
 - Administrative and legal assistance



OFFICIAL DESIGNATIONS/AUTHORITY

- Official letter of appointment as ORTA
 - Written confirmation of your position from the Director/Commander of the lab
- Authority to sign official correspondence related to ORTA
- Obtain copies of all delegations of authority for your lab
 - To enter into CRADAs, protecting agency inventions
 - Designation of tech transfer point of contact
 - SECNAVINST 5700.16A (for the Navy)



IMPORTANT REGISTRATIONS

- Become an FLC member
 - Register as Lab Representative or ORTA representative
 - Ensure lab voting rights
 - Attend meetings to make contacts and fill Rolodex
 - Mentors for guidance
- Register as Lab Representative and/or ORTA representative with your agency



KNOW DUTIES OF ORTA REP

- CRADAs
 - Writing, negotiation, safekeeping original document
 - Knowing when to use CRADA vs. some other legal vehicle
 - CANNOT release funding and SOW to third party
 - Identifying nonprofits available for helping private industry
- Patents
 - Writing, negotiating patent licenses
- Maintaining latest versions of legal instruments
- Develop an Invention Evaluation Board
- Training scientists and engineers (S&Es) on CRADA and patent processes (annually)



KNOW DUTIES OF ORTA REP (Cont.)

- T2 training (through FLC, LES, AUTM)
- Market lab intellectual property (IP), capabilities
 - FLC sponsors booth space at selected meetings
- Outreach (EDCs, state & local government, private businesses)



BUILD A TECHNOLOGY TRANSFER LIBRARY!!



ORTA HANDBOOK

- Legal foundation for the ORTA
- Functions of ORTA
- Technology transfer mechanisms
- Federal T2 organizations
- Nonfederal T2 organizations
- Describes IP rights
- T2 legislation and Executive Orders
- Model CRADAs for GOGO and GOCO laboratories



TECHNOLOGY TRANSFER DESK REFERENCE

- Tech Transfer Overview
- Role of FLC in T2
- CRADA legislative authority
- IP issues
- Overview of T2 Legislation and Executive Orders



TECHNOLOGY TRANSFER MECHANISMS DATA BASE

BOOK OF DEALS

- Model agreements on FLC website
 - 26 model T2 agreements, including:
 - MOU
 - Confidentiality
 - Work for Others
 - CRADA
 - PIA
 - Licensing
 - Educational Partnership
 - www.federallabs.org
- T2 Mechanisms Matrix
 - Identifies cross-section of T2 mechanisms
 - Identifies agencies utilizing each mechanism
 - Provides links to agency websites for more information and samples of mechanisms
 - Available in print and on FLC website



FEDERAL TECHNOLOGY TRANSFER LEGISLATION & POLICY ("GREEN BOOK")

- Technology innovation legislation highlights
- Legislation applicable to all federal agencies
- Special legislative provisions applicable to specific agencies
- Special provision language
- Executive Orders



TECHNOLOGY INNOVATION REFERENCE

- Chapter 63 United States Code, Title 15, Commerce and Trade, Sections 3701-3715, Highlights on Technology Transfer Legislation
- Contains Technology Innovation Legislation Highlights
 - Stevenson-Wydler Tech Innovation Act of 1980
 - Established the ORTA position and T2 as federal mission
 - Bayh-Dole Act of 1980 (Public Law 96-517)
 - Allowed labs to grant exclusive licenses to patents



LICENSING REFERENCES

- “Licensing - A Strategy for Profits”
 - Edward P. White, published by LES, 1997
- Licensing Executives Society
 - Negotiating techniques
 - IP valuation
 - Foreign licensing
 - Copyrights, trademarks, software
 - www.usa-canada.les.org



SECURING LAB INTELLECTUAL PROPERTY



ORTA IP RESPONSIBILITIES

- ORTA Rep has major responsibility for identifying and protecting lab IP
- Include ORTA signature line on route sheets for papers and presentations or copies of papers
- Read lab newspapers and agency highlights
- Attend technical briefings
- Brief management on need to protect IP
- Monitor funding for basic research
 - Remind scientists to contact you if invention made



SECURE LAB IP

- Obtain disclosures from inventors
- Convene Invention Evaluation Board (IEB) meeting
 - Make business decision to use federal funds to file for patent protection
- Lab Office of Counsel conducts prior art search
- Identify any commercial applications for inclusion in claims
- Obtain copy of patent application
- Obtain copy of filing with U.S. Patent and Trademark Office (USPTO)
- Determine if Patent Cooperation Treaty (PCT) coverage is necessary
- Federal government protects inventions with patents, but does **not** copyright any manuals, texts, etc. Navy **does** patent software



ESTABLISH AN INVENTION EVALUATION BOARD

- IEB
 - Includes ORTA Rep, PA, and knowledgeable scientist from each scientific department
 - Makes a business decision to spend lab funds (up to \$8K or more) to attempt to patent an invention
- ORTA
 - Announces IEB meeting to all personnel
 - Develops agenda, with presentations from each inventor
- IEB votes on invention based on rating factors, and PA announces decision to inventors
- If IEB rejects an invention, the scientist keeps IP rights, but government keeps royalty-free right to practice the invention



IEB RATING FACTORS

- **Navy Needs/Requirements** – Degree to which invention addresses need
- **Feasibility/Use**
 - The degree to which the invention could be expected to be used by the Navy
 - Is it currently in actual use by the Navy?
- **Mission Relevance** – The degree to which the invention enhances the core technical capabilities or status of the organization
- **Technological Advancement**
 - What is the relative significance of the invention?
 - Is it a pioneering invention?
 - Is this a significant or a marginal improvement in the art?



IEB RATING FACTORS (Cont.)

- **Degree of Development**
 - Has a working model been built?
 - Has comparative testing been done?
- **Dual Use** – Potential for commercialization, licensing (for income to the laboratory and the inventor(s)), attracting CRADA partners, etc.
- **Affordability Impact** – To what degree could the invention be expected to reduce acquisition or life-cycle costs?
- **Environmental Impact** – To what degree does the invention provide a positive impact on the environment?



IP MANAGEMENT

- Get access to IP MIS (or comparable)
 - Access to filing, issue, maintenance dates

- Obtain market search tool(s)
 - Dun & Bradstreet information
 - iMarket marketplace software



USE NOVEL RESOURCES FOR IP MARKET ASSESSMENTS

- BE CREATIVE!
- University of Baltimore “Lab to Market Program”
- Johns Hopkins University Business Opportunities
- Tech-Link
- PIA, such as Maryland TEDCO
- Novel venture capital groups
 - Genesis Technologies



DEVELOP MARKETING TOOLS

- Tech transfer brochures
 - Describe how to do business with your lab
 - Provide some success stories
- Technology one-pagers for technologies with commercial value
- Develop exhibition booth for technology transfer
 - IP with commercial value
 - Unique facilities
 - Unique expertise



FEDERAL REGISTER NOTICES

- NOTICES MUST BE EXACT!
- Get copies for:
 - Notices of availability
 - Notices of intent to license
 - Notice of correction
- Contact ORTA or Office of Counsel for copies



ETHICAL ISSUES IN LICENSING

- Who may become involved in developing a patent license?
 - Inventor having an interest in the deal
- How is royalty income used?
- What is publicly available when reporting a CRADA?
- Responsibility for protecting proprietary information (invention disclosures)
- Potential issues dealing with Invention Evaluation Board
- Safekeeping of files, such as invention disclosures and original CRADA documents



MAINTAIN DATABASES

- Keep table of yearly **metrics** on:
 - Number of CRADAs (annual and cumulative active)
 - Amount of CRADA funding
 - Number of patents
 - Patent royalty income
 - Number of patent licenses
 - Other legal instruments (PIAs, EPAs)



DTTIS DATABASE

- Defense Technology Transfer Information System (DTTIS) maintained by Defense Technology Information Center (DTIC) in cooperation with the military departments and defense agencies
 - Database contains project information on DOD T2 activities, including CRADAs and patent license agreements
- Report T2 agreements (CRADAs, patent licenses, etc.) to DOD through the DTTIS database
 - Navy version of DTTIS database is accessed at www.onr.navy.mil/dttis
- Within 30 days after agreement is signed, you must report the agreement through DTTIS



APPROPRIATE CONTACTS FOR NON-STANDARD AGREEMENTS

- U.S. Trade Rep
 - Todd Nissen [tnissen@ustr.gov]
202-395-4510
- Federal Register
 - Contact J. Scott Dieter for information about Federal Register points of contact
 - (301) 744-6111
 - john.deiter@navy.mil



TECH TRANSFER BUSINESS PLAN

- List CRADAs, patents, licenses
- Report metrics from databases
- Report success stories
- Present financial data
- Think about your future plans/add them
- Keeping track of this info throughout the year will prepare you for numerous data calls!



TECH TRANSFER VIA INTERNET

- Maintain tech transfer website
 - Use as marketing tool for patents, patent applications
 - Provide all forms and instructions
 - List patents and identify those with commercial potential
 - Identify unique facilities
 - Describe partnering success stories
- Acquire tech transfer button on laboratory/agency home page



PARTNERSHIP INTERMEDIARIES AND PARTNERSHIP INTERMEDIARY AGREEMENTS



PARTNERSHIP INTERMEDIARY

- Defined by organization’s “structure and function”
- Structure
 - An agency of a state or local government, or
 - A nonprofit entity owned, operated and funded in whole or in part by by state or local government
- Function
 - Assist, counsel, advise, evaluate, or cooperate with small business firms, institutions of higher education



PARTNERSHIP INTERMEDIARY AGREEMENT (PIA)

- Statutory authority: 15 USC 3715
- A contract or memorandum of understanding between a federal lab and an entity known as a partnership intermediary
- Provides for the partnership intermediary to perform services for the federal laboratory that increase the likelihood of success in the conduct of cooperative or joint activities with small business firms or educational institutions



EXAMPLES OF A PARTNERSHIP INTERMEDIARY

Tech Link:

- Contact: Dr. John Dennis, jdennis@montana.edu
- Free, very successful, will help writing FLC award nomination packages; other support available

Foresight Science & Technology

- Contact: Dr. Phyllis Speser, phyllis.speser@foresightst.com
- Cost, GSA contractor, very successful, numerous offices

Nonprofits

- TEDCO
- Franklin Partnerships
- Any local economic development center
- Universities with business marketing programs



EXAMPLE OF PARTNERSHIP INTERMEDIARY

- Maryland TEDCO
 - A nonprofit public corporation
 - Provides link between capabilities at federal lab and technology needs of businesses throughout Maryland
 - Serves as intermediary to locate and advise on R&D capabilities that may be made available to small businesses and universities
 - Develops technology marketing programs and **showcases** federal lab technologies
 - Sponsors activities and programs that showcase technology and capabilities of small businesses and educational institutions that may be of interest to federal labs



PIA BOILERPLATE

CALL ME!! I'll forward PIA boilerplate to you.

J. Scott Deiter, (301) 744-6111



CRADAS VS. WORK FOR OTHERS

- Statutory Authority: 10 USC 2539b, 2563
 - Routine work conducted
 - Work description submitted, proposal requested, cost estimate, time schedule, delivery package
 - Must be proprietary subject to customer's requirements
 - R&D not conducted under Work for Others



OUTREACH EFFORTS

- Educate public on value of technology transfer
 - Promote CRADAs
 - Create awareness of patents available for licensing
 - Promote awareness of capabilities, personnel, facilities
 - Collaborate for problem solving
 - Present at business, state and local government meetings



T2 MECHANISMS USED BY FEDERAL AGENCIES

- <http://www.gc.doe.gov/gcmain.html>
- <http://www.ars.usda.gov/Business/Business.htm>
- <http://www.ott.nih.gov/index.html>
- <http://www.nasa.gov>
- <http://www.onr.navy.mil/sci-tech/3t/transition/techtran/orta/t2/mechanisms>
- <http://www.afrl.af.mil/techtran-handbk-index.asp>
- <http://www.art.army.mil/main/Main/default.htm>
- <http://patapsco.nist.gov/ts/220/external/index.htm>
- <http://t2.dot.gov>
- <http://www.usgs.gov/tech-transfer>



FOR TECHNOLOGY TRANSFER HELP

- **Contact the Federal Laboratory Consortium for Technology Transfer**

www.federallabs.org

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