MTAs, NDAs, DUAs, IP and Federal Reporting Requirements

What they mean to Research!

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Questions I get

Why do non-funding agreements matter to my Research?

Why does the Federal Government have rights to University technology(ies)?

Office of Technology Commercialization
OTC

ou.edu/otc

Intellectual Property Forms

Disclose an Invention

OU Intellectual Property Policy

Types of IP

Forms

NDAs

MTAs

DUAs

Non-Disclosure Agreements

Confidentiality

Ability to Publish

Protect Ideas

Future Research

Material Transfer Agreements

Incoming

Outgoing

UBMTA

SLA

Addgene

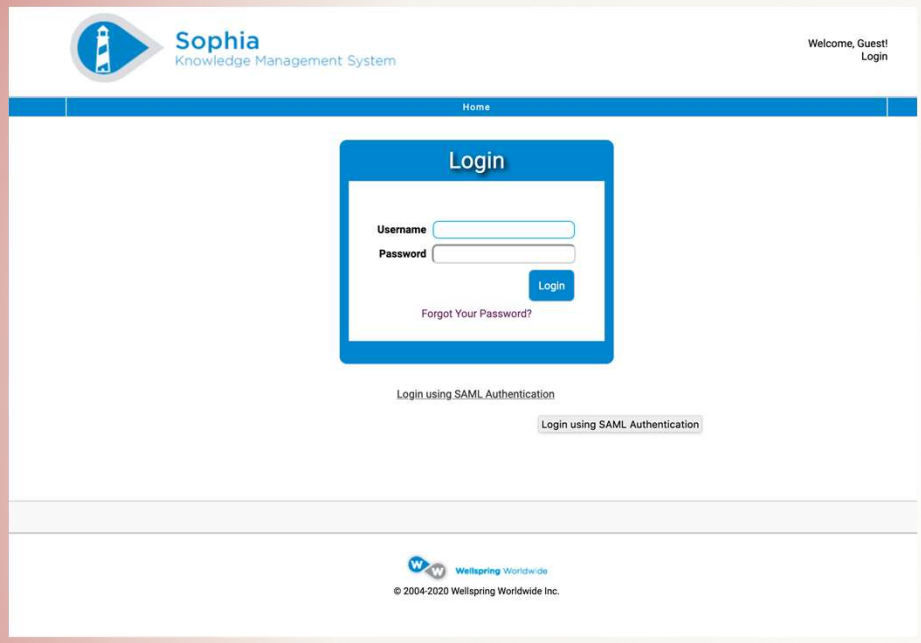
Data Use Agreements

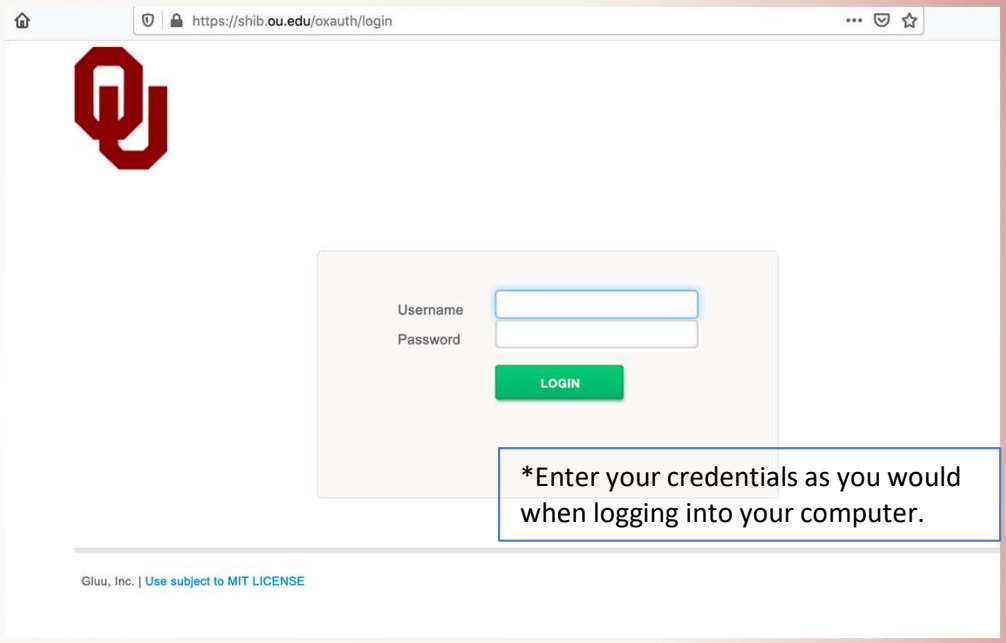
Incoming

Outgoing

How to Disclose

– Disclose technologies through OTC's online database portal.





– Important information to include:
  - All inventors and possible contributors in creation of technology
  - Sources of funding used in the creation
  - A description of the discovery
  - Current state of the art and/or others working in the field
  - Future plans for development and commercial intentions
  - Details of any publications, presentations or external conversations (public disclosures)

Disclosure Process

- Please list ALL external funding RELATED TO THE TECHNOLOGY (if it supported the creation and/or reduction to practice of the IP) on the Disclosure Form
- Remember, funding for the grad student(s) working on the technology(ies) should be listed
- Be sure to list all prior publications and presentations on the Disclosure Form including Dates
- If you are unsure, please call or e-mail me and we will work through the issue

Federal Reporting

Agencies have Obligations

- Are the Federal Agencies funding research projects wisely?
- What are the Results of that funding?
- Are Technologies being created to the betterment of Society?
- Is there a Return on the Agency's Investment?

Universities have Obligations

- Are the funded research projects using the funds wisely?
- What are the Results of that funding?
- Are Technologies being created to the betterment of Society?
- Is there a Return on the University's Investment?

Bayh-Dole Act

- December 12, 1980
- P.L. 96-517 (as amended P.L. 98-620)
- 37 CFR 401
- Objectives:
  - Stimulate innovation and application of Federally-funded research
  - Stimulate tech transfer in U.S.

Bayh-Dole Accomplished

- Created a uniform patent policy among the many federal agencies that fund research
- Enabled small businesses and nonprofit orgs (universities) to retain title to materials & products invented under federal funding
- Gave universities control of their inventions

Bayh-Dole Act

- Requirements
  - University IP Policy
  - Notices: Disclosure; Title Election/Waiver; Patents
  - Federal support clause
  - Government-Use License
- Expectations
  - Commercialize technology thru licensing
  - File patents on inventions
- Obligations
  - Licensing preference to small businesses
  - US Manufacturing
  - Utilization reporting (annually)
- Government Rights
  - March-In Rights – non-action, health/safety needs, public use
  - Government Use License – NERF license throughout the world for government purposes only

Bayh-Dole Requirements

- 37 CFR 401.14
  - Invention Disclosure – 60 days
  - Title Election/Waiver – 2 years
  - Patent Filing – 1 year of Title Election
  - Utility Reporting – Annually from Title Election
  - License to the Government – at Title Election
  - Government Support Clause in Patent
  - Share royalties with Inventor
  - Preferences for Small Businesses
  - U.S. Manufacturing Requirement

What is Needed of our Inventors/Researchers/PIs?

Annual Reports

Grant Close-Out Reports

Patent and Tech Reports

New Funding Reported

Report Disclosures (IP/Techs) to OTC

Annual Reports

- Annual Financial Reports – Work with Research Mgmt.
- Annual Technical Reports – NOTE: this is separate from OTC reporting in iEdison. OTC does not submit Technical Reports.
- Should Results indicate a technology, please file a Disclosure with our office as soon as possible
- Annual Reports can create a patentability bar if we are not aware of the technology – They are not always Confidential.

Grant Close-Out Reports

- Final Financial Report – Work with Research Mgmt.
- Final Technical Report – Work with Research Mgmt and OTC - NOTE: this is separate from OTC reporting in iEdison. OTC does not submit Technical Reports.
- Should Results indicate a technology, please file a Disclosure with our office as soon as possible
- Final Reports can create a patentability bar if we are not aware of the technology – They are not always Confidential.

Patent and Tech Reports

- There are different types of this Report
  - HHS 568; DD882 are examples.
  - NOTE: this is separate from OTC reporting in iEdison.
  - OTC can only sign on original documents wherein there is a positive report
  - OTC CANNOT submit the documents in Commons or Grants.gov. That must be done by the PI and/or Research Mgmt.

General Funding Notes

- Federal
  - Bayh-Dole Act
  - Other clauses – Data Rights, etc.
- State
  - OCAST
- Other Funding
  - Foundations (i.e. AHA)
- OTC will always refer to the funding agreement (grant or contract) as to requirements

OTC Reporting Process

- Report to Agency per Regulations
- Notify Inventor of Reporting
- Track deadlines
- Annual Utility Reports
- Notify Inventor Annually on Reporting

- NOTE: Federal Reporting of Technologies is Confidential.

Join us for the next Lunch & Learn:

Patents 101: First Do No Harm

How to Write and Speak about Your Invention Without Losing U.S. or Foreign Patent Rights



About this Event

Learn critical information about how to protect your invention and your patent rights.

This month's speaker is Dr. Chris Corbett, Director of Intellectual Property for OTC.

Topics

- **What is a patent and what does a patent protect?**
- **Patenting in a university.**
- **Requirements for patentability.**
- **What is "prior art"?**
- **What is a public disclosure?**
- **How to publish without hurting your patent rights.**
- **Key milestones of the patenting process.**

Questions?

Thank you!

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