



BULLETIN

> UNIVERSITY EMPOWERMENT FOR TECHNOLOGY TRANSFER

Contact Us:

CU-Boulder and CU-Colorado
Springs inventors:

Kate Tallman
kate.tallman@cu.edu
phone: 303-492-5732
fax: 303-492-2128

UC Denver inventors:

Rick Silva
rick.silva@uchsc.edu
phone: 303-724-0222
fax: 303-724-0816

Information about licensing to
start-up companies:

Tom Smerdon
tom.smerdon@cu.edu
phone: 303-735-0621
fax: 303-735-3831

General information and CU
System office:

David Allen
david.allen@cu.edu
phone: 303-735-3711
fax: 303-735-3831

General address for
correspondence:

CU System Technology
Transfer Office
4740 Walnut St., Suite 100
588 SYS
Boulder, CO 80309-0588

Web site:

www.cu.edu/techtransfer

The Bayh-Dole Act: Reason and Rules for University Technology Transfer

The Bayh-Dole Act (37 CFR Part 401) in 1980 gave rise to US university technology transfer operations by defining the rights to inventions derived from federally funded research. By guaranteeing universities the rights to protect and license such inventions, the law promotes transfer and application of government-sponsored research for the benefit of inventors, the University and the general public.

Essentially, the presumption of IP ownership lies with the University, as dictated by the Bayh-Dole Act of 1980. Covered IP includes any inventive idea (compound, device or process) or its reduction to practice, including know-how, and copyrightable works pertaining to the invention. The IP policy on Discoveries and Patents does not apply to ownership and copyright of scholarly and artistic works, which are governed by the Intellectual Property Policy on Educational Materials; in such educational works, the presumption of ownership lies with the creator or author.

Prior to the implementation of Bayh-Dole in 1980, the government could claim rights to intellectual property (IP) derived from federal funding, but very little IP was commercialized. Ambiguity over ownership and the conditions the federal government placed on licensing created barriers to private investment in technology development, delaying public access to federally sponsored innovations. In adopting the Bayh-Dole model for technology transfer and fulfilling the mandated reporting requirements, the University acknowledges the federal government's enormous role in supporting academic research. This is critically important at CU given the University's top 10 ranking in federal research funding among all public and private universities.

Incorporation of Bayh-Dole into CU's Policies and Practices

In compliance with the federal law, and consistent with academic IP principles and good business practice, the Bayh-Dole rules are incorporated into the Regents Intellectual Property Policy on Discoveries and Patents and are applied in the Administrative Policy Statement on same. (<http://www.cusys.edu/techtransfer/policies>)

CU's Obligations Under Bayh-Dole

Bayh-Dole rules form the foundation for best practice in research universities' technology transfer programs, by requiring the University to:

- ♦ Clarify ownership of intellectual property
- ♦ Meet statutory deadlines for patenting
- ♦ Exercise diligence in the development and commercialization of new technologies
- ♦ Bring innovations into practical application for public use and benefit
- ♦ Return license revenues to University inventors and the University in support of its education and research endeavors.



Bayh-Dole Compliance and the Invention Management Timeline

Bayh-Dole compliance dovetails with proactive intellectual property management, resulting in timely patent and license management actions. The following illustrates elements of Bayh-Dole requirements and mandates, and the timeframe in which decisions are made:

- Government rights to discoveries → per CU acceptance of grant
- Disclose each invention to agency sponsor → within 60 days
- Resolve election or waiver of ownership → within 2 years
- File patent → within 1 year of election
- Provide confirmatory license to the government → upon title election
- Indicate government support on patent → with patent application
- Share royalties with inventor → upon licensing & development
- License small businesses → where feasible based on effort to do so
- Product manufacturing in U.S. → waivers are allowable

Release of Invention and Patent Rights

When the TTO determines that it is not in the University's interest to pursue patent protection any further, the University will waive title to the sponsoring agency. Most federal agencies welcome inventors' applications to take title to inventions not chosen by their university, as long as they certify their commitment to fulfill the remaining IP protection, technology development, and reporting mandates of Bayh-Dole. When the University waives its title, the TTO will cooperate with inventor groups in the process of requesting title from a sponsoring agency.

The Government's "March-In Rights"

If the University fails to comply with Bayh-Dole reporting obligations or to take effective, timely steps to implement practical application of an invention, or if the government determines that intervention is necessary to alleviate a health or safety need, the federal government may exercise "march-in rights" and reclaim title to the invention.

The Role of Bayh-Dole in the Academic Community

- ♦ Provides the framework for dissemination of federally-funded research results in proactive and publicly available ways
- ♦ Enables universities to interact with industry so as to assure proper management of federally supported IP
- ♦ Enables the continued openness of academic research while providing for the commercialization of results through university-industry partnerships
- ♦ Creates technology transfer training opportunities and experience for students, university inventors, and university technology transfer personnel who facilitate the spectrum of university-industry relationships.
- ♦ Fosters a culture of competitiveness that motivates innovations resulting in job creation and economic growth.

To learn more about TTO processes: <http://www.cu.edu/techtransfer/about/bulletins.html>

To download disclosure forms: <http://www.cu.edu/techtransfer/disclose/>

For more info or to submit a disclosure, email ttocontact@cu.edu