

•
•
•

What Got Tech Transfer Rolling?

- WWII led to the Bayh-Dole Act
 - (40 years later).
 - Passed by Congress and signed in to law by President Carter in 1980.
- Beforehand
- Federal agencies owned patent rights. Tended to retain them, and not license to the private sector.

– Based on speech by Howard W. Bremer November 11, 2001, http://www.autm.net/index_ie.html

•
•
•

The Academy's View

- A researcher that accepted corporate support was diverted from his basic research to serve corporate interests.
- Would no longer to seek new knowledge but would focus on solving current problems in the real world.

•
•
•

The Government's Problem

- Beginning with WWII, vast amounts of federally funded research began to be tied up in government agencies
- Indiana Jones syndrome.
- For example, by 1978, NASA had waived title to private contractor to less than 4% of the more than 30,000 inventions that had been reported to it by its contractors.

•
•
•

Policy Behind Bayh-Dole

- Technology is a national resource;
- The patent system is the vehicle to deliver that resource to the public;
- Designate universities as stewards of this resource; and
- Existing federal patent policy was not working, and in fact placing the nation in peril.

•
•
•

Most Significant Feature

- Bayh-Dole changed the presumption of title in and to any invention made in whole or in part with the use of government-supplied funds from the government to the universities.

•
•
•

Thomas Edison

- "The value of an idea lies in the using of it."
- Ergo: "It is the objective of the Congress to use the patent system to promote the utilization of inventions arising from federally supported research or development...." 35 U.S.C. 200.

•
•
•

How Bayh-Dole Works

- Title retained in University or Contractor
 - Each nonprofit organization or small business firm may, within a reasonable time after disclosure as required by paragraph (c)(1) of this section, elect to retain title to any subject invention....Branch and Subsidiary Filings.
35 U.S.C. 202.

-
-
-

How Bayh-Dole Works

- March-In Rights

- The Federal agency under whose funding agreement the subject invention was made shall have the right, ... to require the contractor, an assignee or exclusive licensee of a subject invention to grant a ... license in any field of use to a responsible applicant or applicants, upon terms *that are reasonable under the circumstances*

35 U.S.C. 203

-
-
-

The Result: A New Attitude

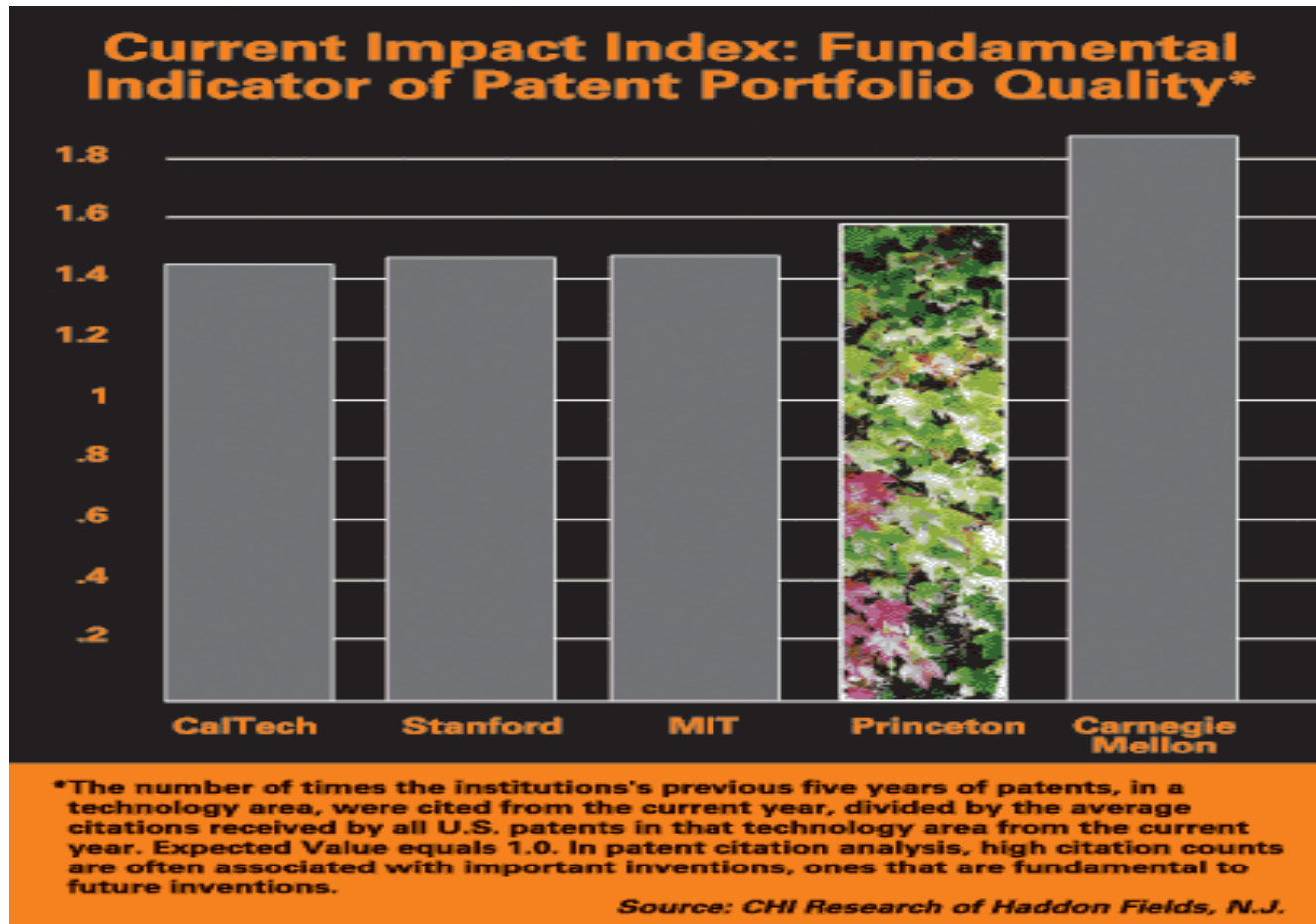


Illustration by Ann Haver-Alien

From S. Peters "The State of Technology Transfer at Princeton
Academia, industry perfect together, EQuad News: Winter '01-'02.

•
•
•

University Technology is Now Widely Available

- E.g.
- **Ceramics & Materials Science Technologies**
- **DOCKET NO. TECHNOLOGY TITLE**
- 97-1407-1 Formation of a Silicate Sponge (L3) Phase
- 98-1470-1 Method for the Preparation of Ceramic Articles
- 98-1474-1 Materials Design by Correlated Composition and Process Identification
- 98-1500-1 Controlled Microarchitecture Ceramic Composites by Stereolithography
- 00-1659-1 Electrohydrodynamic Patterning of Colloidal Crystals
- 00-1688-1 Segmented Arc Furnace Cathode
- 01-1818-1 Method for Prevention of Damage to Stone and Masonry from the Crystallization of Salt
- http://www.princeton.edu/patents/otl/ceramics_dockets.htm

•
•
•

Sample License Terms

- Swiggart & Agin, LLC Memo
 - MM dtd August 1, 2002 regarding Patents, Etc. Royalties, for a Major IP License.
 - Lesson Learned:
 - Don't agree to onerous royalty terms -- they will prevent your company from being financed in the future.



Swiggart & Agin, LLC

William F. Swiggart, Esq.

Corporate Law, Finance and M&A, Intellectual Property

617-742-0110 x234

wfs@swiggartagin.com

Warren E. Agin, Esq.

Insolvency, Internet Law, Commercial Law

617-742-0110 x233

wea@swiggartagin.com

Lawrence S. Delaney, Esq.

Litigation & Patent Litigation

617-742-0110 x232

lsd@swiggartagin.com

