Inventions, Patents, Reports to NIH, and other Intellectual Property Considerations – Q & A

Presented By:

Scott Cooper, J.D., – Assistant Extramural Inventions Policy Officer
Mary Fran Deutsch, J.D, - Assistant Extramural Inventions Policy Officer

Division of Grants Compliance and Oversight, Office of Policy for Extramural Research Administration (OPERA)
Objectives

- Via a Q & A format, answer your questions regarding Intellectual Property, the Bayh-Dole Act, Inventions, Patents, Reporting Compliance and Timelines, and iEdison.
- Discuss where to get information to appropriately manage inventions, patents, reporting, publications, and other resources developed with NIH funds.
- Discuss why and how to safeguard intellectual property rights in discoveries and inventions made with NIH funds.
- Understand recipients’ rights and obligations and the government’s rights and obligations in inventions made with NIH funds.
- Learn when and how to report inventions to NIH.
Bayh-Dole Act

• The Bayh-Dole Act (1980) – few changes since 1980.
  • Codified at 35 U.S.C. § 200;
  • Implemented at 37 C.F.R. 401.
  • Revised April 13, 2018. NIH implementation for all subject inventions made with new NIH grant funding on or after October 1, 2018.
    • NIH Contracts – on the date of a new contract

• Applies to most federal funding agreements.

• Sets forth rights and responsibilities of grantee/contactor and Government for inventions and discoveries made in whole or in part with federal funding.
Bayh-Dole Act: Federal Funding Agreements


- Use the patent system to promote the utilization of inventions arising from federally supported research or development;
- Encourage participation of small businesses; Required preference in licensing by non-profit organizations
- Promote collaboration between commercial concerns and nonprofit organizations;
- Ensure inventions are used in a manner to promote free competition and enterprise without unduly encumbering future research and discovery;
- Promote the commercialization and public availability of inventions made with federal support; and
- Ensure that the Government obtains sufficient rights in federally supported inventions.
Resources....

- Where do I get information to appropriately manage data, inventions, publications, and other resources developed with NIH funding?
  - NIH Grants Policy Statement (GPS):
  - Notice of Award: terms and conditions of award
  - NIH Grants Information:
    - [https://grants.nih.gov/grants/grants_process.htm](https://grants.nih.gov/grants/grants_process.htm)
    - Questions to: grantsinfo@nih.gov
  - NIH Data Sharing Resources:
    - [https://grants.nih.gov/policy/sharing.htm](https://grants.nih.gov/policy/sharing.htm)
    - Questions to sharing@nih.gov
  - iEdison & Intellectual Property FAQs and Resources:
    [https://era.nih.gov/iedison/iedison_faqs.cfm](https://era.nih.gov/iedison/iedison_faqs.cfm)