

# Federal Funding leads to Federal Reporting Requirements

What it means to you!

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

# 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?

# 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.



# New Funding After Disclosure

- Should the new funding be used to support the creation and/or reduction to practice of the IP or improvements, please report the new funding via an email notice to [OTC@ou.edu](mailto:OTC@ou.edu).
- Be sure to list the OU Disclosure Number and the new funding grant/contract number.

# DISCLOSURE

<https://ou.edu/otc>

### Disclose an Invention

A disclosure is the first step in the process of determining appropriate protections and commercialization opportunities for your technology. This document provides a confidential overview of the invention to the Office of Technology Commercialization, and serves as the foundation for future discussions about the best path forward.

[BEGIN YOUR DISCLOSURE](#)

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### Transforming Ideas Into T

The Office of Technology Commercialization believes positive difference in the world. We help OU research betterment of society.

We provide the highest level of fiduciary expertise for OU intellectual property, and serve as a driving force for and efficiency.

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## Disclose an Invention

A disclosure is the first step in the process of determining appropriate protections and commercialization opportunities for your technology. This document provides a confidential overview of the invention to the Office of Technology Commercialization, and serves as the foundation for future discussions about the best path forward.

#### To begin the disclosure process:

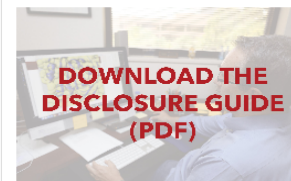
1. Download the [Disclosure Guide](#)
2. Access the online disclosure system [here](#)
3. Choose the link to "Login using SAML Authentication"
4. Enter your OU username and password



**SUBMIT A DISCLOSURE**

An invention disclosure should be completed when an invention is recognized by the inventor(s). You must first choose the link to log in using SAML Authentication, and then enter your OU username and password.

[BEGIN YOUR DISCLOSURE](#)



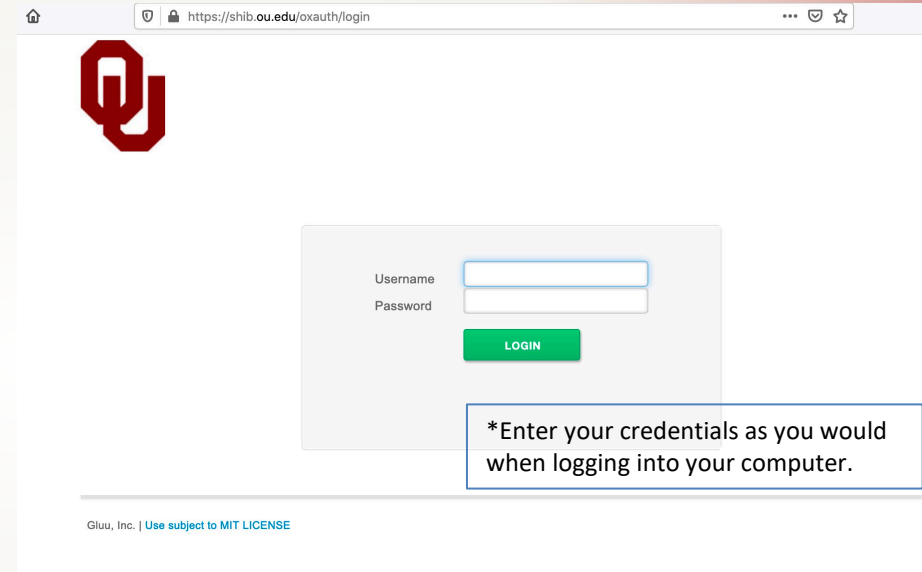
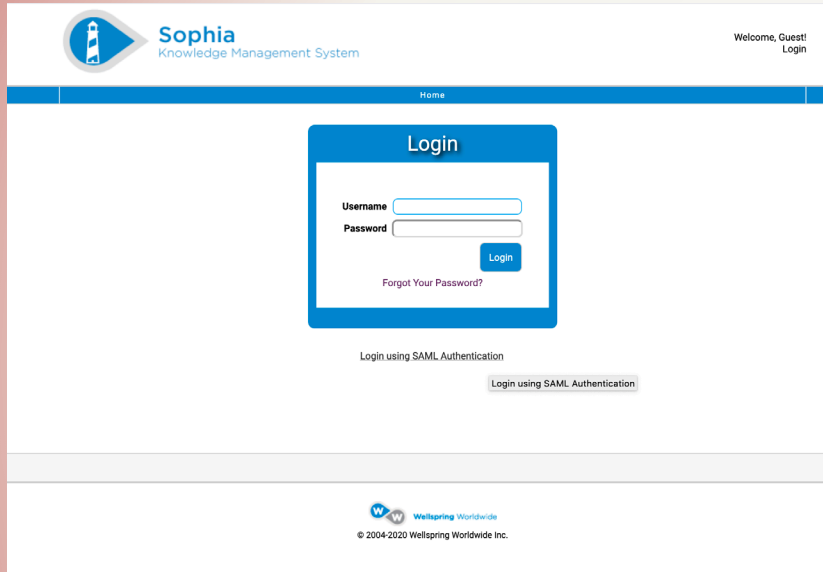
**DOWNLOAD THE DISCLOSURE GUIDE (PDF)**

Our Disclosure Guide is designed to walk you through each step of the online disclosure submission process. We encourage you to reference it often for helpful tips and references.

[DOWNLOAD THE GUIDE](#)

# 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

# OTC Process

- Review Disclosure
- Funding Review and Determination
- Priority – Federal Government always first
- Report – as required (i.e. iEdison; NASA)
- We track State and Foundation support, if required

# 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

# 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

# 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.

# Questions?

Thank you!

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