



The Basics of Reporting NIFA Funded Intellectual Property

**National Institute of Food and Agriculture
Planning, Accountability, and Reporting Staff**

Topics

- Overview of Bayh-Dole Act and its Reporting Requirements
- How Bayh-Dole Requirements are applied to PVP
- Overview of iEdison
- How to obtain an iEdison account

Preparation

- Download the following from the NIFA Intellectual Property web page at <http://www.nifa.usda.gov/business/awards/intellprop.html>
 - Step by Step procedures for Entering PVP Information into iEdison
 - These slides
 - Along with other helpful documents

Overview of Bayh-Dole Act

- Purpose
 - To facilitate and accelerate the transfer of technologies and other such products resulting from Federally-funded research into public use, taking advantage of the market-based incentives of the patent and plant variety protection process

Overview of Bayh-Dole Act Requirements

- How does it do this?
 - It allows the recipient of the Federal research contract, grant, or cooperative agreement to retain the rights to any resulting inventions so long as the recipient complies with certain conditions and procedures.
 - *Note that formula funds are legally a type of grant and all laws and regulations that apply to grants in general, including Bayh-Dole Act, apply equally to formula funds.*

Overview of Bayh-Dole Act Requirements

- What is an invention?
 - Generally, an invention is anything which could receive patent and/or plant variety protection
 - The Bayh-Dole Act applies to what are termed “subject inventions”
 - These are inventions conceived or first actually reduced to practice in the performance of work under a funding agreement

Overview of Bayh-Dole Act Requirements

- What ownership rights are granted?
 - The Bayh-Dole Act grants to the recipient of Federal research funding the entire right, title, and interest throughout the world to inventions covered by the Act, subject to the conditions of the act.

Overview of Bayh-Dole Act Requirements

- What ownership rights are granted?
 - It also grants to the Federal government a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the invention throughout the world (35 USC 202(c)(4)).

Overview of Bayh-Dole Act Requirements

- The ownership of the invention may go to the Federal government, if the recipient...
 - Does not take advantage of its rights to an invention in a timely way *or*
 - Waives its rights to an invention
- Therefore, an institution may not simply transfer their own rights to a third party (such as the inventor or a corporation);
 - It may ask the Federal government for permission to transfer rights to a third party

Overview of Bayh-Dole Act Requirements

- As a condition of being able to retain rights to inventions, the Bayh-Dole Act requires institutions to report on the invention to the granting agency. These requirements apply regardless of whether a patent or PVP is actually sought for the invention.

How Bayh-Dole Requirements are Applied to PVP***

Time	Patent Requirement	PVP Requirement
2 months after the institution learns of an invention	Submit invention disclosure	Submit invention disclosure
2 years after the disclosure of an invention	Notify agency whether electing title	Notify agency whether electing title
Election of title or when reporting a PVP application	Confirmatory license	Confirmatory license

This is not a complete listing, consult 37 CFR Part 401

How Bayh-Dole Requirements are Applied to PVP***

Time	Patent Requirement	PVP Requirement
1 year after the election of title	File patent application, notify agency	File PVP application, notify agency
Issuance	Notify agency upon issuance of patent grant	Notify agency upon issuance of PVP certificate
If requested by agency	Utilization reports	Utilization reports

This is not a complete listing, consult 37 CFR Part 401

How Bayh-Dole requirements are applied to PVP

- The institute must include within the specification of any United States patent or PVP application and any resulting patent or PVP the following statement:

“This invention was made with government support under (identify the grant number) awarded by the National Institute of Food and Agriculture, USDA. The government has certain rights in the invention.”

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This statement must be inserted into Exhibit E, block 11 of the PVP application.

Overview of iEdison

- Secure, interactive web-based system for Bayh-Dole policy and reporting compliance
- Created and operated by National Institutes of Health (NIH)

Overview of iEdison

- Supports Bayh-Dole reporting to any of over 27 participating Federal Agencies, including USDA's three research agencies
 - National Institute of Food and Agriculture
 - Agricultural Research Service
 - Forest Service

Overview of iEdison

- NIFA has required the use of iEdison for all invention reporting since 1999
- Recently modified to accommodate Bayh-Dole reporting for PVPs

How to obtain an iEdison account

- Most institutions already have an iEdison account established by their office of technology transfer (OTT)
 - It is recommended that offices reporting PVPs contact their OTT for a login instead of creating a new organization within iEdison

How to obtain an iEdison account

- If your organization does not have an existing iEdison account, you will need to create one:
 - Go to <https://s-edison.info.nih.gov/iEdison/>
 - Select the ‘Register Institution to use iEdison’ link below the login information
 - Provide all required information
 - Press Submit

How to obtain an iEdison account

- Account Creation Steps Cont...
 - Click on 'continue' to access the registration form
 - Print form, fax the completed form to (301) 480-0272
 - The system will send an email to the email address provided
 - Click the embedded link to verify the email is correct

The registration request will be processed by the NIH staff in a timely manner. If you have any questions, the NIH staff may be emailed at edison@nih.gov.

Key iEdison Concepts

- The iEdison system was designed to support the reporting of patents for Bayh-Dole information. It has been minimally modified to accommodate reporting of PVP information.

Key iEdison Concepts

- iEdison uses the term “invention” to include intellectual property which could be protected either by a patent or a PVP.
- iEdison uses the terms “patent” to indicate intellectual property for which patent or PVP protection has been sought or received.
- There are separate modules for:
 - Invention
 - Patent

How to Contact...

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iEdison

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