

# VCAT Subcommittee on Technology Transfer

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Subcommittee Chair

# Technology Transfer Subcommittee



## Objectives

- Review NIST technology transfer policies and practices, provide individual technical assessments for effectively engaging the business community and communicating with stakeholders
- Assess NIST's performance and recommend improvements -Specific areas
  - Development and use of intellectual property
  - Collaborative research

## VCAT Subcommittee Members

- Katharine Ku, Chair
- David Vasko
- Waguih Ishak
- Gail Wasserman
- Vinton Cerf

## Subject Matter Experts

- Leslie Millar-Nicholson
- Nancy Kamei
- Mike Paulus
- Tony Boccanfuso
- Terri Fiez
- Laurie Locascio
- Sethuraman "Panch" Panchanathan

# Subcommittee Action



- Conference Call August 14, 2019 to discuss various aspects of technology transfer
- The members were asked to share information on how their organization approaches or had approached the various items.
- Agenda:
  - NIST on A Chip Program Recap
  - Subcommittee Charge
  - Discussion and feedback on best practices
    - IP Strategy
    - Finding Licensees and Partners for Further Commercial Development
    - Portfolio management
- Additional opportunity for input after call

# Intellectual Property (IP) Strategy



Purpose: Establish a more conscious and comprehensive technology transfer strategy that will enhance the overall management of our scientific enterprise.

- The IP strategy has to follow the commercialization roadmap
- Create a culture of innovation - recognize the importance of reporting and assessing results, offer incentives and acknowledgement, use a variety of approaches to reach staff
- Primary decision factors for what to patent are commercial potential, market opportunity, ROI on patent investment, and patentability
- Differences in managing patent versus copyright protections – recognize differences, keeping track of copyright portfolio may be challenging
- Copyright software when needed for commercialization
- Exclusive versus non-exclusive licensing approaches based on each case, generally allow exclusive licensing to encourage investment in development
- Consider foreign filings if appropriate ROI

- Communication!!
- Make it known widely that NIST would like to partner
- Multiple methods, tools, and processes – focus on differing needs for different audiences
- Conduct and use market research
- Internet and social media tools are required but need in person communication
- Due diligence needed before executing agreement with prospective partner – use tools to know the partner and capabilities
- Consider a variety of spin out pathways

- IP strategy needs to consider the business case for research products
- Look 3-7 years ahead, monitor and predict trends and needs in the form of problems
- Data driven decision making – understand market for the product
- Balance expected purpose and return with the investment of time and effort
- Foreign national stage only with licensee

Meet October 30 after VCAT adjournment

- NIST Technology Maturation
- Discussion of best practices for partner identification
- University marketing for technology development opportunities
- Industry mechanisms to identify technologies that you may want to license
- Plans for a potential site visit
- Assessment of NIST's technology transfer processes and practices





# Discussion