UNIVERSITY OF MARYLAND
DIVISION OF RESEARCH

2133 Lee Building
College Park, Maryland 20742
301.405.4175 TEL

July 31, 2018

Re: RFI Response: Federal Technology Transfer Authorities and Processes
Docket No. 180220199-819-019

As one of the world's premier research institutions, the University of Maryland strives to transform lives by discovering new knowledge and putting it to work to benefit the state, our nation, and the world.

The breadth of research across our 12 schools and colleges is fueled by more than 4,600 faculty who are developing innovative, research-driven solutions to critically important national and international challenges.

To help accelerate our drive toward societal impact, we collaborate with fellow academic institutions in the U.S. and abroad. We are an active member of the Big Ten Academic Alliance, the Association of American Universities, and Universitas 21. The University of Maryland Strategic Partnership: MPowering the State initiative unites the complementary research strengths of the University of Maryland, College Park and the University of Maryland, Baltimore to achieve significant interdisciplinary collaborations and economic impact.

Our partnerships with federal agencies, national laboratories, and industry fortify our ability to conduct groundbreaking research in a multitude of fields, including: environmental adaptation and sustainability; national and global security; advanced computing, data analytics and visualization; quantum science; transportation analytics; and human health.

The University and its constituents have benefited from the passage of the Bayh-Dole Act in 1980 in our efforts to increase the impact from our ground-breaking research. The University of Maryland (UMD) created its first technology transfer office, the Office of Technology Commercialization (OTC), in 1986 following passage of Bayh-Dole. In its first 30 years of operations, OTC recorded more than 3,100 information, life, and physical sciences invention disclosures, secured more than 650 U.S. Patents, licensed more than 700 technologies to business and industry, generated more than $25M in technology transfer income, and facilitated the creation of 100 IP-based startup companies.

We appreciate efforts made on a national level to streamline and accelerate transfer of technology from Federal R&D investments in order to attract greater private-sector investment for innovative products, processes, and services, as well as new businesses and industries that will create jobs, grow the economy, and enhance national security. As a key collaborator, we look forward to working with NIST to support technology transfer's role in improving health, safety, and quality of life. We submit the following comments below:

1. What are the core Federal technology transfer principles and practices that should be protected, and those that should be adapted or changed?

   We echo our colleagues with the Association of University Technology Managers (AUTM) in supporting the preservation of the fundamental principles of the Bayh-Dole Act. We believe we need to continue to strengthen US intellectual property rights and systems. We also would like to see licensing terms and schemes applied consistently across Federal agencies.

2. What are the issues that pose systematic challenges to the effective transfer of technology, knowledge, and capabilities resulting from Federal R&D? Please consider those identified in the RFI as well as others that may have inhibited collaborations with Federal laboratories, access to other federally funded R&D, or commercialization of technologies resulting from Federal R&D.

One of the biggest problems we have encountered dealing with different federal labs in cooperative research is the inconsistencies among Federal agencies related to management of jointly owned inventions.

Approximately 15% of the University of Maryland's inventions disclosed in the last two years are jointly owned with the Government through collaborations with UMD and Government personnel. When the university receives such jointly owned inventions which may also be subject to Bayh-Dole, we are required to approach evaluation and decision-making differently depending on the agency involved. Having a different process to follow depending on the agency involved adds additional steps and time to the technology transfer process.

For example:
With UMD-NIH inventions, we are able to determine quickly which party will take the lead on patenting and commercialization and negotiate joint invention/inter-institutional agreements to address such roles and responsibilities accordingly. For the NIH to take the lead on such an invention, the university is not obligated to waive title.

With UMD-DOD inventions, DOD agencies will not take the lead on patenting unless the university waives title to the government. We understand that DOD in-house attorneys take the position that prosecuting a patent application on which there is a non-federal government employee constitutes representation of a non-federal government employee.

With UMD-NIST inventions, we have been through various processes over that past several years and would appreciate clearer guidance on NIST's current approach to inventions which are both jointly owned and subject to the provisions of Bayh-Dole.

With UMD-USDA inventions, the USDA takes a similar approach as the NIH, in that with communication we can make a decision on who will take the lead in patenting and commercialization.

Improved communication, collaboration, and consistency in how rules and processes are applied among federal agencies will increase the likelihood of technology transfer success.

3. What is the proposed solution for each issue that poses a systemic challenge to the effective transfer of technology, knowledge, and capabilities resulting from Federal R&D? Please consider the approaches identified in the RFI.

For the challenges described above involving jointly owned inventions, we propose adoption of HHS/NIH/USDA-type practices among all agencies when dealing with jointly owned inventions.

4. What are other ways to significantly improve the transfer of technology, knowledge, and capabilities resulting from Federal R&D to benefit U.S. innovation and the economy? What changes would these proposed improvements require to Federal technology transfer practices, policies, regulations, and legislation?

   We encourage investment in support of technology transfer offices and functions. In addition to support of core patenting and licensing functions, the government should also provide increased support for: appropriate staffing levels and training of technology transfer staff; proof-of-concept and translational funding; and startup creation/support programs like NSF's ICorps program.

We welcome the opportunity to further discuss these and look forward to the opportunity to continue to support this process. Please feel free to reach out to me directly with any questions – I can be reached via email at jlenzer@umd.edu or via my direct line at (301) 405-2960.

Sincerely,

Julie Lenzer
Associate Vice President, Innovation and Economic Development