



Partnership Intermediaries and Software Licensing

Advancing Commercialization from Federal Laboratories

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PRESENTATION OVERVIEW

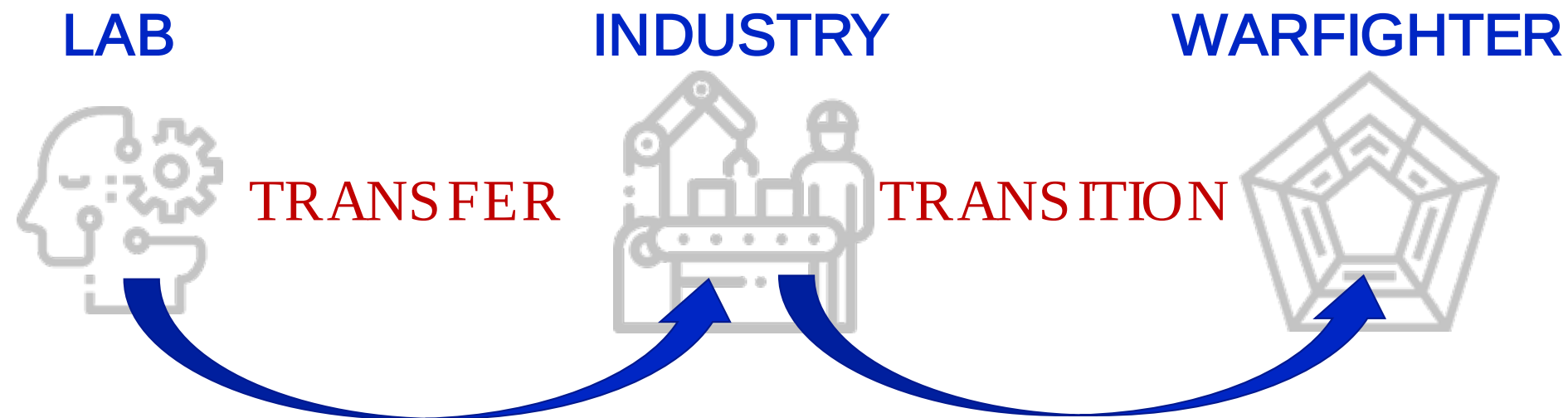
Key Topics

- TechLink and Partnership Intermediaries
- Software Licensing and DoD 801 Software Licensing Authority

PRESENTATION OVERVIEW

Considerations

- DOD Mission: T^2 v. T^3
- The unfunded mandate



TechLink and Partnership Intermediaries

OVERVIEW



TECHLINK OVERVIEW

What Is TechLink?

- 
- An aerial photograph of a university campus, likely the University of Colorado Boulder, showing various academic buildings, a large stadium, and surrounding green fields. In the background, a range of rugged mountains is visible under a blue sky with scattered white clouds.
- The original Partnership Intermediary
 - DoD and VA national technology transfer partner
 - Primary focus on patent licensing

TECHLINK OVERVIEW

What Does TechLink Do?



Select most commercially promising technologies and develop marketing materials for specific market segments / applications



Extensively market technology licensing opportunities to US industry, small businesses, and entrepreneurs



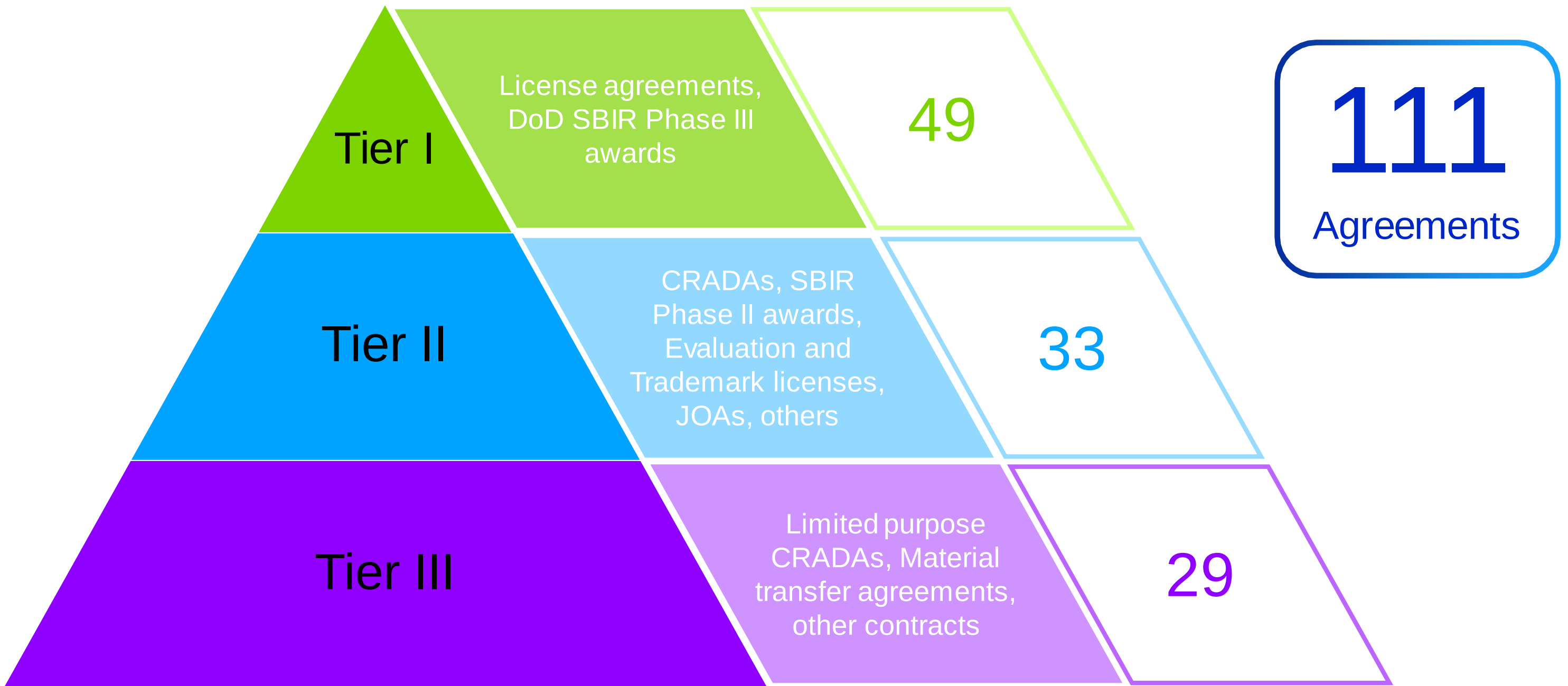
Deliver high quality licensing prospects to federal laboratories



Work hand-in-hand with labs and prospects to facilitate win-win agreements

TECHLINK OVERVIEW

Metrics



TECHLINK OVERVIEW

TechLink Is NOT...



COMPETITION

- TechLink DOES NOT speak for the laboratory
- TechLink DOES NOT have signature authority
- TechLink IS NOT in the lab management business



TECHLINK OVERVIEW

Statutory Authority

A FEDERAL TECHNOLOGY
TRANSFER PARTNERSHIP
INTERMEDIARY UNDER
15 USC § 3715



PARTNERSHIP INTERMEDIARIES

Statutory Requirements

FEDERAL LABORATORY

including

FFRDCs

[15 USC 3710a(d)(2)]

DoD Centers

[10 USC 2368(f)]

TECHNOLOGY
TRANSFER

PARTNERSHIP INTERMEDIARY

State or local government
agency

OR

Non-profit owned by or
directly affiliated with a
state or local government
agency

ECONOMIC
DEVELOPMENT

“enter into a contract
or memorandum of
understanding...”

Perform services to
facilitate partnerships
between federal lab and
small business &
educational entities

PRODUCTIVE
PARTNERSHIPS



PARTNERSHIP INTERMEDIARIES

Additional Examples

- AFRL local PIAs
- MilTech
- Naval Surface Warfare Center Crane Division PIAs
- USDA-ARS Agricultural Research Partnerships Network (ARP)



PARTNERSHIP INTERMEDIARIES

Benefits

- Focus
 - Economies of Scale
 - Best Practices
- Flexibility
 - Activities
 - Capabilities

Software Licensing

DOD “801” AUTHORITY





SOFTWARE LICENSING

Statutory Authority

- Technology Transfer Commercialization Act of 2000 **expanded federal licensing** from “patent applications, patents, or other forms of protection obtained” to “inventions”
- DOC interpretation and unknowns raised in 2006 update to 37 CFR 404
- The definition of “**invention**” hinges on “**...any invention or discovery which is or may be patentable...**” *35 USC 207(a)(2)*
- “Mixed” outcomes



SOFTWARE LICENSING

DoD 801 Authority

- National Defense Authorization Act for Fiscal Year 2014 (FY14 NDAA) / Public Law 113-66
- DoD labs may grant licenses to software and related documentation developed at a DOD lab
- Requirements:
 - Software would be a trade secret under 5 USC 552(b)(4)
 - Public notified of availability of the software
 - Licensing activities comply with 35 USC 209
 - Software originally developed to meet the military needs of the DoD
 - 5 year exemption from FOIA (5 USC 552) after development



CHALLENGES

Safeguarding Federal Software

- Software is especially vulnerable to improper release because it is often not disclosed and/or considered valuable
- GENERALIZATION: Patent orientation/bias in technology transfer
- Procurement benefits of establishing DOD software as a standard including potentially substantial savings for the US taxpayer
 - Reduced acquisition costs
 - Source of income to support continued improvement and support
- “Leakage” of DOD IP, including software, can have implications costing tens of millions of dollars in sole source procurement and/or litigation



SOFTWARE LICENSING

Best Practice Questions

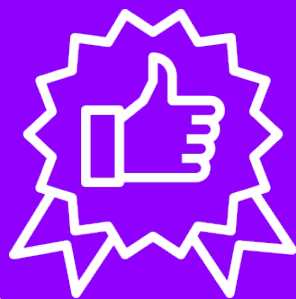
- Have you maintained control of the software?
- Who are the developers and coders?
- Are any of them contractors?
 - Who paid for the work?
 - Data rights?
- Is there use of open source code?
 - What are the obligations of the open source license?
 - Can you deliver software without open source components (have end user download libraries?)
 - Can you recode to avoid use of open source software?
- What are the DoD Program Protection Plan considerations?



CHALLENGES

Software Licensing Considerations

- Quality control
- Fixes and updates
- Trademarks
- Derivative works
- Use cases
 - Number of licensees and users
 - Training and technical support
 - Off-the-shelf shrink-wrap ready
 - Flexible API
 - GUI integration



SOFTWARE LICENSING

Marketing Best Practice

- Transfer demonstrations under a protective agreement (e.g. Material Transfer Agreement, Information Transfer Agreement, LP-CRADA, Non-Disclosure Agreement)
- Do not provide more than is necessary in marketing and demonstration activities
 - Screen shots and demonstration videos
 - Executable only instead of source code
 - Limited functionality version or kill switch
 - Host on interactive website
 - Demonstrations by lab personnel

Conclusion

TAKEAWAYS

TAKEAWAYS

Key Considerations

- Partnership intermediaries provide focused efficiencies and flexibility to federal lab technology transfer (and transition)
- Explicit letter of the law statutory authority
 - Who can do what and under what circumstances
 - Don't forget the accounting side: Where does the money go / come from?
- Software and Digital Product Licensing
 - Change from patent orientation
 - Professional development requirements to support effective software and digital product protection and licensing

