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Reporting Plant Variety Protection Information Into iEdison

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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
- How to enter PVP information into iEdison



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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



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Overview of Bayh-Dole Act Requirements

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 processes



Overview of Bayh-Dole Act Requirements

How does it do this?

- It allows the recipient of a 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 the 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.
- 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

If the recipient -

- Does not take advantage of its rights to an invention in a timely way *or*
- Waives its rights to an invention
- the ownership of the invention may go to the Federal government.

Therefore, an institution may not simply transfer their own rights to a third party (such as the inventor or a corporation);

- It may ask that the Federal government for permission to transfer its rights over to a named third party



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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

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

<i>Time</i>	<i>Patent Requirement</i>	<i>PVP Requirement</i>
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 <i>or</i> when reporting a PVP application	Confirmatory license	Confirmatory license
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



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How Bayh-Dole requirements are applied to PVP

The institution 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.”

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)
- 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



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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/>
 - Locate the 'Register Institution to use iEdison' link below the login information and select it
 - Provide all required information
 - Press Submit
 - Click on 'continue' to access registration form
 - User must have Adobe Acrobat installed
 - Print form
 - Sign and date as appropriate
 - Fax 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



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How to obtain an iEdison account

The registration request will be processed by the NIH staff in a timely manner. If you have any questions the NIH staff can be contacted via email at edison@nih.gov.



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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



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Walk-through of PVP data entry into iEdison



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For More Information

- NIFA Intellectual Property Web Page

<http://www.nifa.usda.gov/business/awards/intellprop.html>

- iEdison Web Page

www.iedison.gov

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