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Title: What is IP and why should you care?

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“What is “IP” and why should you care?”

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Los Alamos
NATIONAL LABORATORY
EST. 1943

Sig Hecker Conf. Rm.
9/18/2019

National Nuclear Security Administration
Managed by Triad National Security, LLC for the U.S. Department of Energy's NNSA

FCI Richard P. Feynman Center for Innovation at Los Alamos National Laboratory

Transitioning Los Alamos' **top innovations** to meet America's **national security challenges** and to grow the **U.S. economy** and **increase U.S. competiveness**.

"The **national labs** need to **respond** and **align** with **current market trends** and **industry investments** to encourage **a greater return** on **investment** from **research funding.**"

Paul Dabbar
Under Secretary of DOE

Main Types of Intellectual Property Protection

Patent

- Grant by the U.S. Government to provide individuals legal protection for their discoveries (inventions)
- Gives the patent owner the right to *prevent* others from making, using or selling the claimed invention within the United States or Country of Issue
- Types: Utility, Design, and Plant Patents

Copyright

- Protection of original works of authorship fixed in any tangible medium of expression but does not protect the idea itself
- Gives copyright owner the right to exclusively reproduce, adapt, publicly distribute, perform, and display
- Provides rights to prepare derivative works, restrict lawful copies, and ability to elect to license these rights to others

Trademark

- Protection of words, names, symbols, etc. which are used to identify and distinguish goods and services

Disclosure Policy

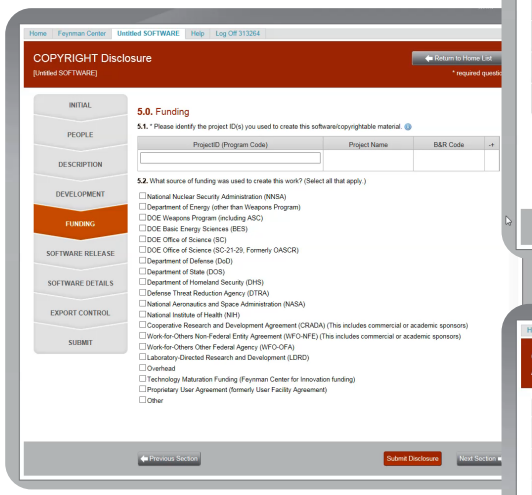
- **TRIAD employees agree to disclose innovations when they sign their employment agreements. Other workers are governed by their specific agreements with the Laboratory. Inventions and Software should be disclosed and considered for the appropriate protections.**

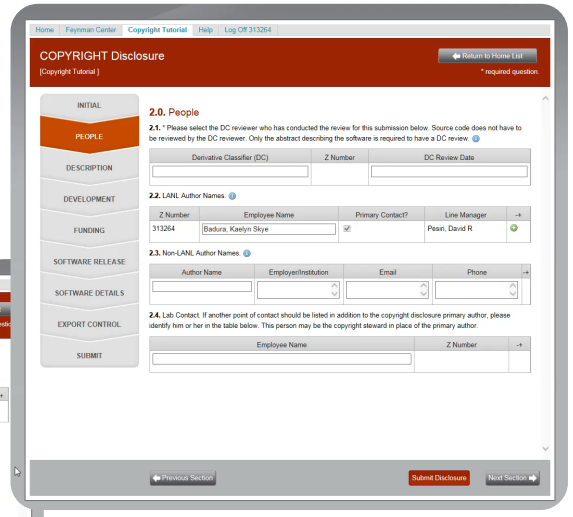
- **All scientific and technical information (STI) generated at the Laboratory and intended for public release must be reviewed and processed by Classification (SAFE-IP) before publication, submission for publication, or release.**
  - RASSTI is the system of Review & Approval System for Scientific and Technical Information.
  - Per policy PD0122, STI is defined as: information products intended to be published or disseminated, in any format or medium, which contain findings and technological innovations resulting from R&D efforts and scientific and technological work of scientists, researchers, and engineers. STI may be represented in many forms, including paper, electronic data….

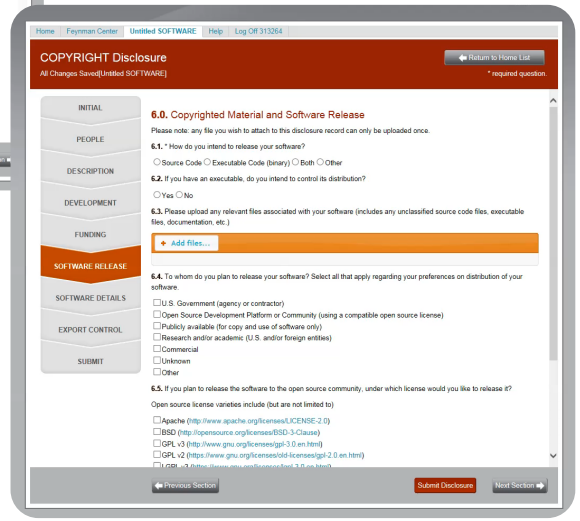
eIDR: Streamlined disclosing

1. Visit eidr.lanl.gov.

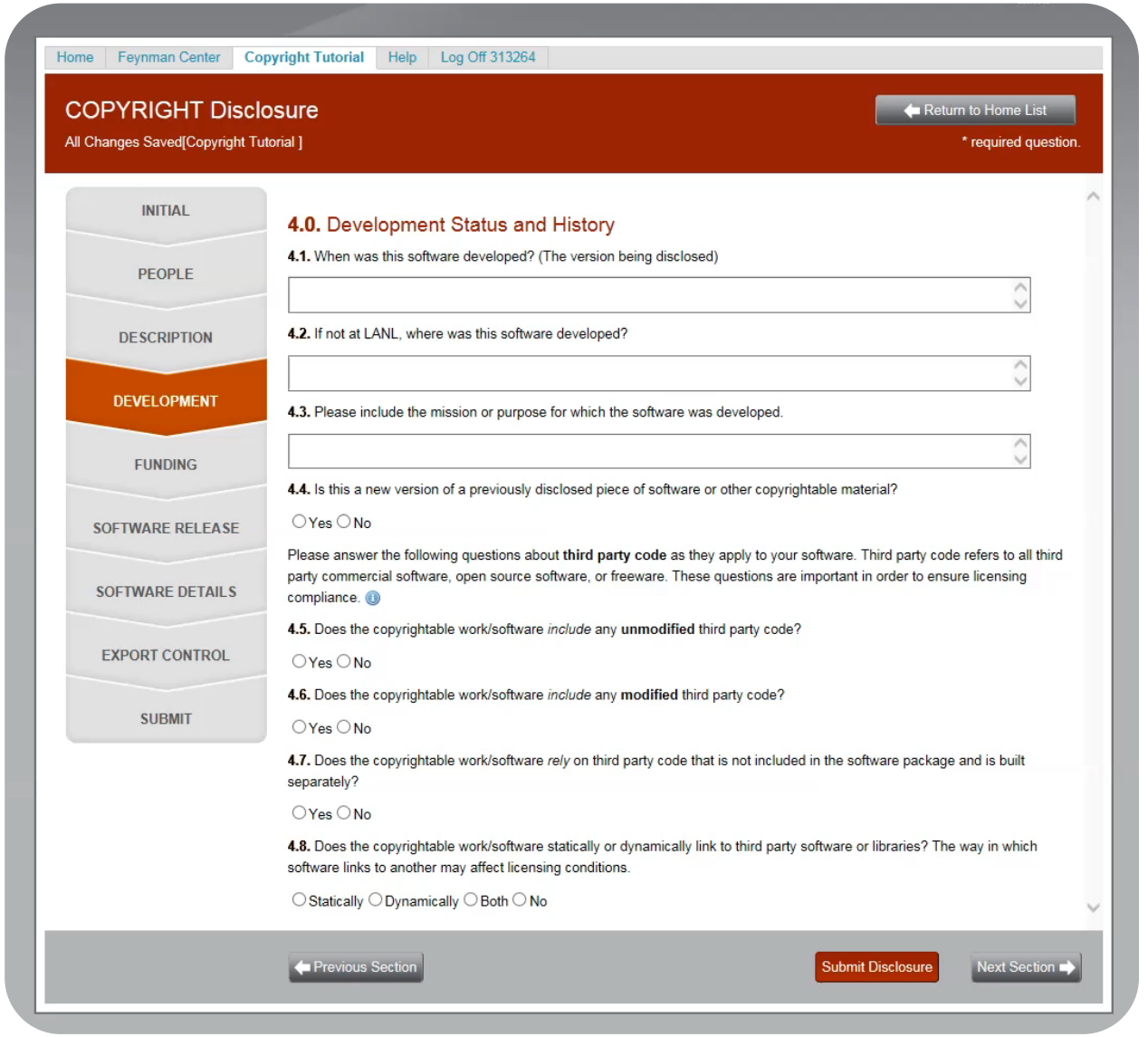
2. Sign into eIDR using your Z# and your cryptocard.







Please note that after the disclosure is submitted, you will no longer be able to view your disclosure.



To report errors or system issues, please contact the eIDR system administrator at eidr@lanl.gov.

Disclosure Tips and Guidelines

Be as thorough as possible. Once your disclosure is submitted, it will be routed to your line manager for approval. If you have any questions please reach out to the Feynman Center for Innovation's IP team at fci-ip@lanl.gov.

Below are some additional tips to help expedite the review process:

- Start the disclosure process early ← *If it's time to think about publishing, it's definitely time to consider disclosing!*
- Use the authors' full legal names
- Designate additional Laboratory contacts
- Include support documentation
- Include proof of concept if available for invention disclosures
- Know who uses or intends to use your software
- Know what **3rd party software** your code includes, links, or imports

LA-CC numbers have been replaced by C#'s as the number of record

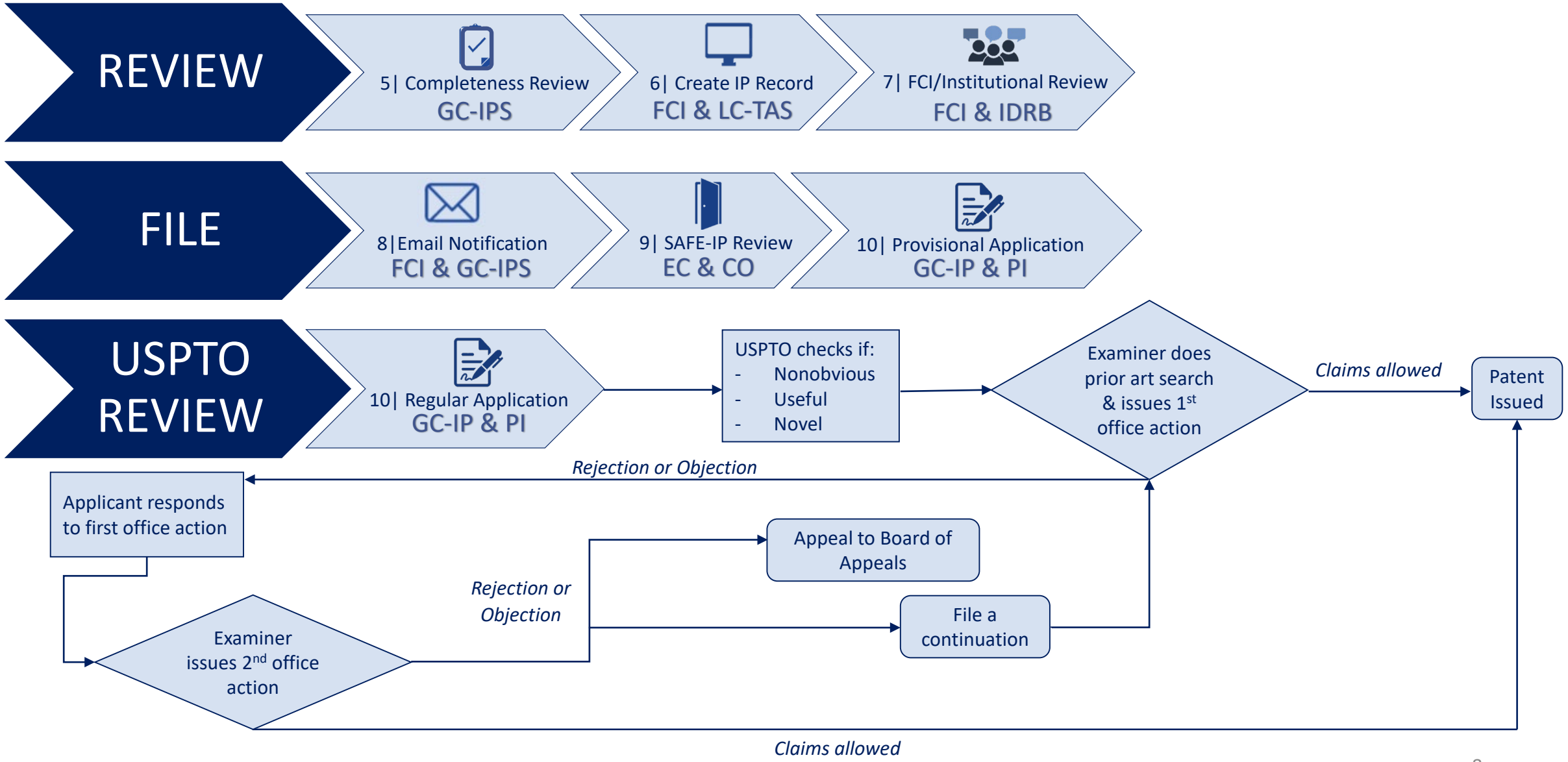
A new disclosure and C# are needed if:

- Significant scope/functional change
- New funding/sponsor

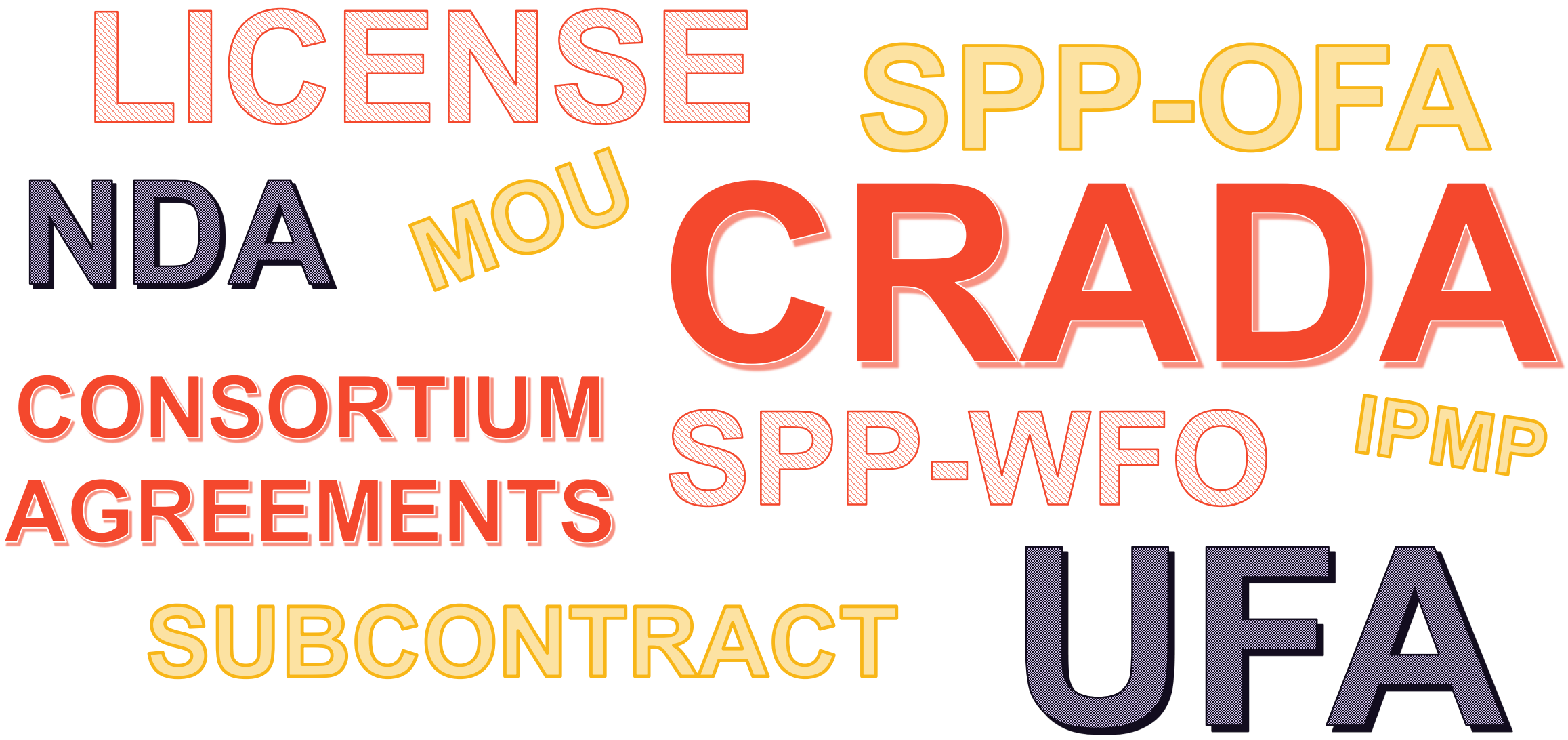
Recommended if:

- It has been more than 2-3 years and development is ongoing

Generalized Patent Process



Agreements & Contracts



NDA – Nondisclosure Agreement
- Protects proprietary information exchanged related to a predefined scope
- Often covers initial interaction between the Laboratory and a potential industry partner
- Quickly put in place and normally covers a disclosure term of one year, but can be renewed

CRADA – Cooperative Research and Development Agreement
- Enables non-federal entities to *collaborate* with the Laboratory on joint R&D activities
- Lab cannot pay out funds to the industry partner but can leverage a variety of other resources
- DOE must approve Joint Work Statement and terms of CRADA before work is started, usually completed in 180 days.
- Reserve government right in all intellectual property developed in performance of agreement

SPP - Strategic Partnership Projects (formerly WFO)
- Enables a non-federal partner to ask the Laboratory to perform a defined scope of work
- Must use unique Lab capability and not place the Lab in direct competition with industry
- These are full-cost recovery and can usually be put in place within 45 days

Subcontract – Procurement
- A procurement contract managed by ASM with defined scope of work and deliverables
- IP rights need to be carefully evaluated, work is not inherently treated as a work-for-hire

What is a Non-Disclosure Agreement (NDA) ?

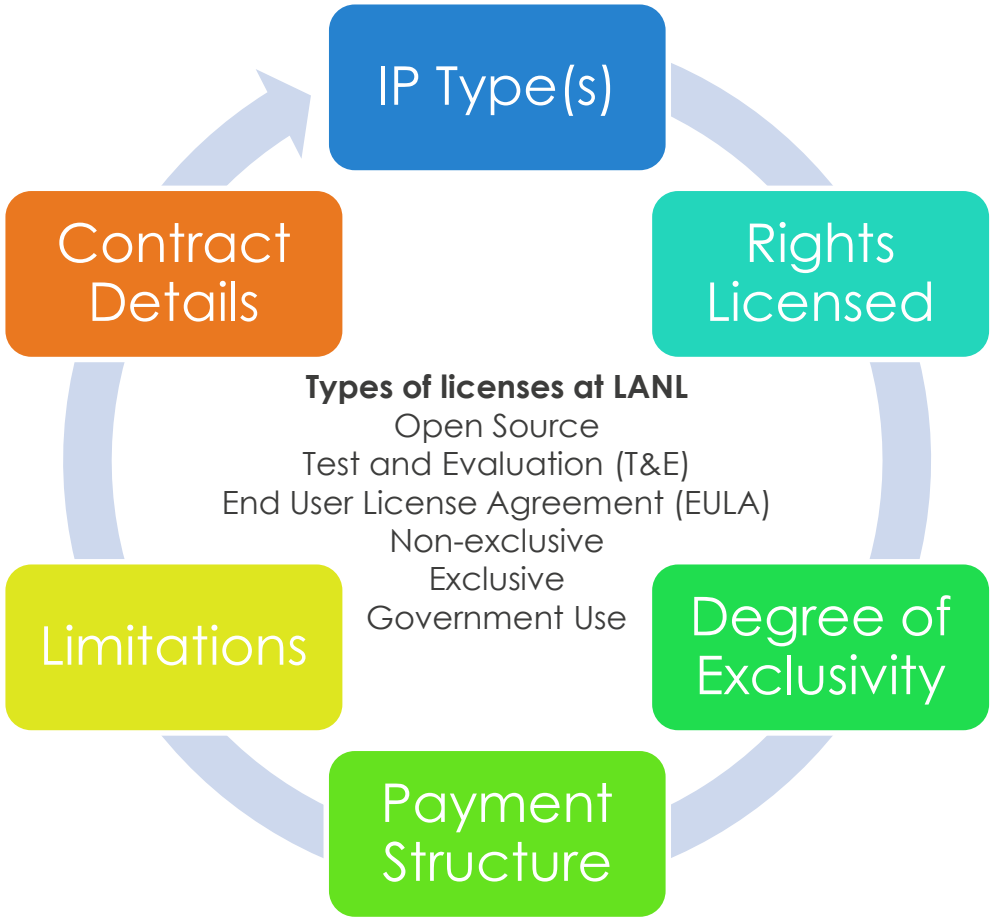
- **A legal document that is used when an exchange of Proprietary Information is <u>REQUIRED</u> between TRIAD and one or more companies**
- **Not a <u>work</u> authorization agreement or purchase agreement**
- **FCI typically processes 60% of the NDAs at LANL and the remaining 40% of NDAs involve purchase agreements processed by ASM or Line Mgmt. or Program.**
- **Types of Agreements:**
  - Bilateral – Two Parties
  - Multi-Party – Many Parties
  - Unilateral-In – Only Receiving Info
  - Unilateral-Out – Only Providing Info

How Do I Set-up A NDA?

1. Define a clear and concise purpose and specific scope of information to be shared
2. Determine how long you need to complete discussions with company
3. Gather company contact information (Name, email, phone #'s, etc.)
4. Identify how company information is to be marked, stored, and shared and who has a need to know
5. Identify and set-up computer and other resources necessary to electronically and non-electronically store company information
6. Communicate and discuss need of NDA with line and program managers and FCI Business Development Executives
7. Visit NDA.LANL.GOV and complete questionnaires

Licensing & Technology

- **Technology licensing occurs when parties own intellectual property and would like to provide consent for use* of the IP according to preset terms and conditions**
  - *Some licenses are developed to permit transfer of additional rights such as right to sublicense and distribute
- **Different ways to subdivide licenses for consideration**
  - Limited IP rights vs. all IP rights of any kind
  - Exclusive, Exclusive Field of Use, Nonexclusive
- **Licensing occurs in the context of business relationship where other agreements may be important**
  - Considerations of intersections of these agreements are important and can save time/money when managed effectively
- **License negotiation occurs between parties with different priorities which must coincide in some way**
  - Negotiators must understand the benefits available to both parties



Intellectual Property Licensing

- **Exclusive License**
  - Agree not to grant other licenses that have the same rights
  - Limited to specific field
  - Can be an option to a CRADA
  - Subject to DOE Rules & Regulations

- **Non-Exclusive License**
  - Can grant licensees the same rights
  - Can be an option to a CRADA

Licenses and terms associated with this software dictate how, and according to what terms, this software can be used, modified, incorporated, or *not* used.

More on software licensing:

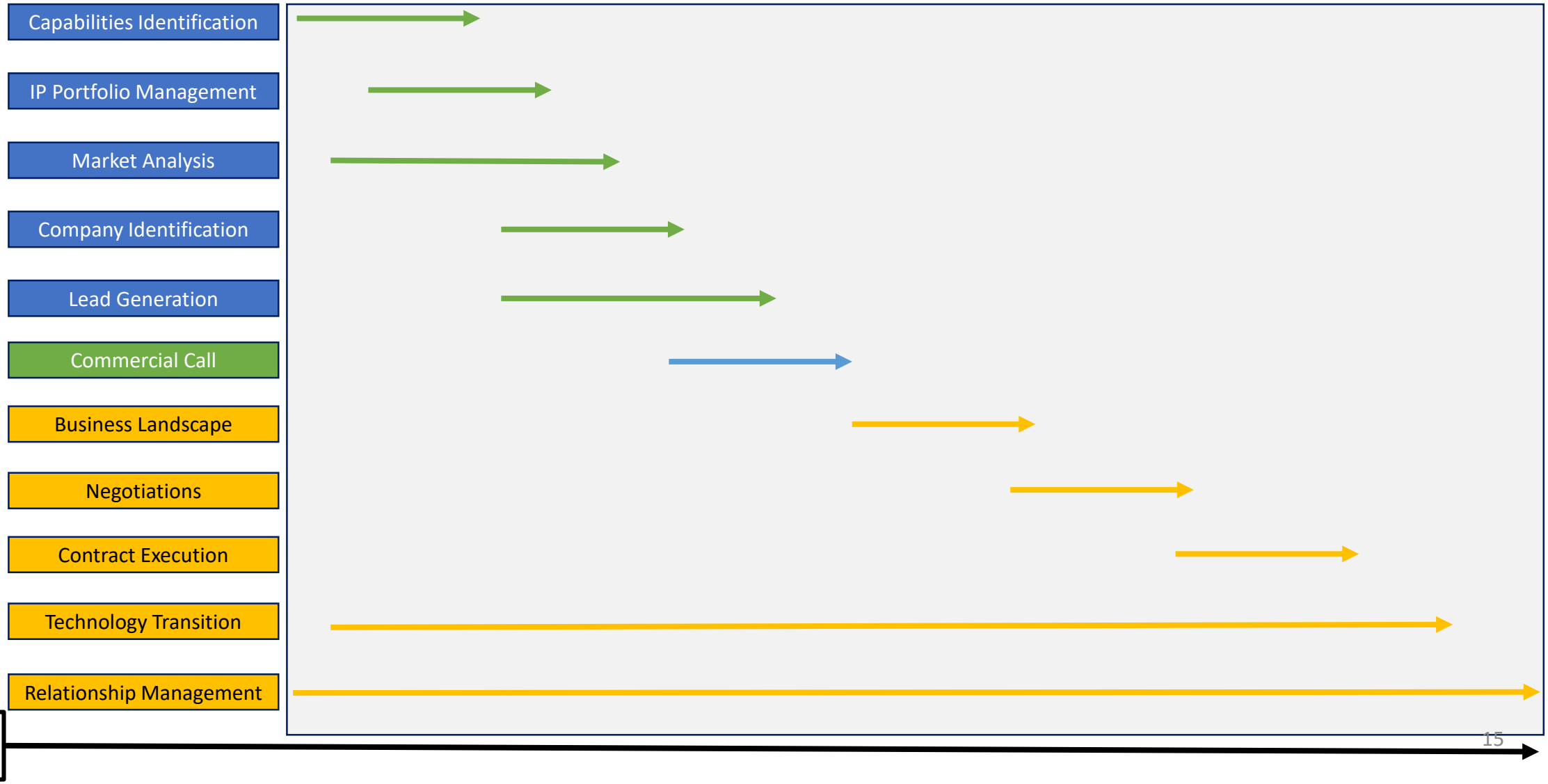
Typically they also require inclusion of the original copyright notice and attribution.

Primary License types include:

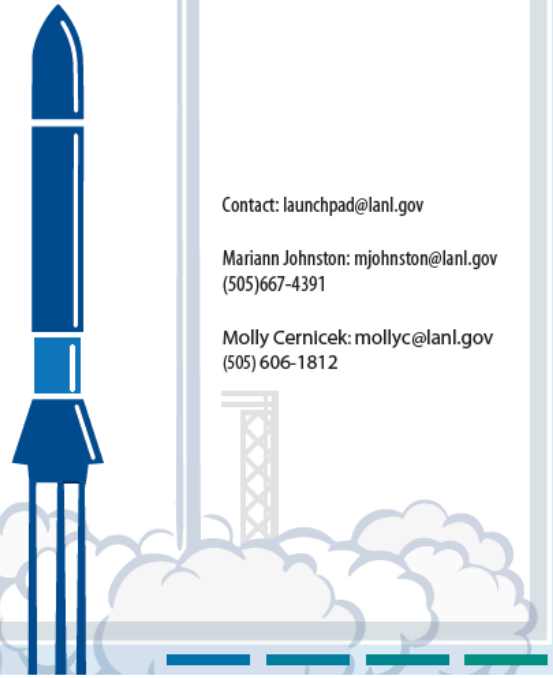
- **No license (i.e. certain numerical recipes, stack exchange snippets*)**
- **Designated Public Domain**
- **Open Source - Standard**
  - Open Source – Permissive (MIT, BSD, Apache 2.0)
  - Open Source - Weakly Protective (LGPL all versions, MPL)
  - Open Source - Strongly Protective (GPL all versions)
  - Open Source - Network Protective (Affero GPL)
- **Open source - Limited Use, Other**
- **Government Use**
- **Commercial Licenses**

FCI Business Development Process:

(TE&E + BDE + IP + Contracts + Tools = Business Development)



Los Alamos LaunchPad



Contact: launchpad@lanl.gov

Mariann Johnston: mjohnston@lanl.gov
(505)667-4391

Molly Cernicek: mollyc@lanl.gov
(505) 606-1812

DisrupTECH

DisrupTECH is a series of coaching activities by industry experts to provide targeted guidance for scientists and engineers to polish their presentation by refining their product definition, gaining investor perspective, and honing their pitch.

Lab Accelerator

Lab Accelerator is a collaborative laboratory effort to move technologies to market by helping scientists understand and interact with industry. Laboratory scientists and engineers learn the skills that help make their technologies more appealing and better positioned for market success and profitable for investors.

UC/Los Alamos Entrepreneurial Postdoctoral Fellowship

UC/Los Alamos Entrepreneurial Postdoctoral Fellowship is for postdoctoral researchers to gain skills in entrepreneurship and commercializing technology as part of their postdoctoral experience. This pilot will incorporate training and mentoring during an initial finalist period, culminating, for successful finalists, in a focused 6-month Fellowship aimed at creating a new business in Northern New Mexico.

Energy I-Corps

Energy I-Corps is a Department of Energy program that provides entrepreneurial education to national laboratory researchers and connects them to potential customers and industry partners. The goal is to accelerate the transfer of technologies from national laboratories into the commercial marketplace.

GET INVOLVED!

DisrupTECH

December	DisrupTECH Orientation
January	Application and Penta-chart Due
January	DisrupTECH Pitch
January	DisrupTECH Class selected
February – June	Participate in DisrupTECH coaching
July	DisrupTECH Forum

Lab Accelerator

January	Applications Accepted
March	Entrepreneurial Training

Postdoc Pilot

December	Start-up orientation and training session open to all postdocs
January	Application and Penta-chart Due.
January	UC/LANL Entrepreneurial Fellowship Pitch
January	Announce Entrepreneurial Postdoc Cohort (8-10 participants)
February – June	Participate in DisrupTECH and Lab Accelerator training and mentoring
July	DisrupTECH Showcase Phase1 cohort postdocs pitch to investment mentors for selction for phase2
October	UC/Los Alamos Entrepreneurial Fellows Phase 2 kicks off for 6 months to commercialize technology.
April	Final Presentation

Energy I-Corp

October	Call for Proposals
December	Selection of Cohort
April	Cohort begins
June	Graduation

Questions?

- **For questions regarding disclosures, please contact the Intellectual Property team at fci-ip@lanl.gov.**

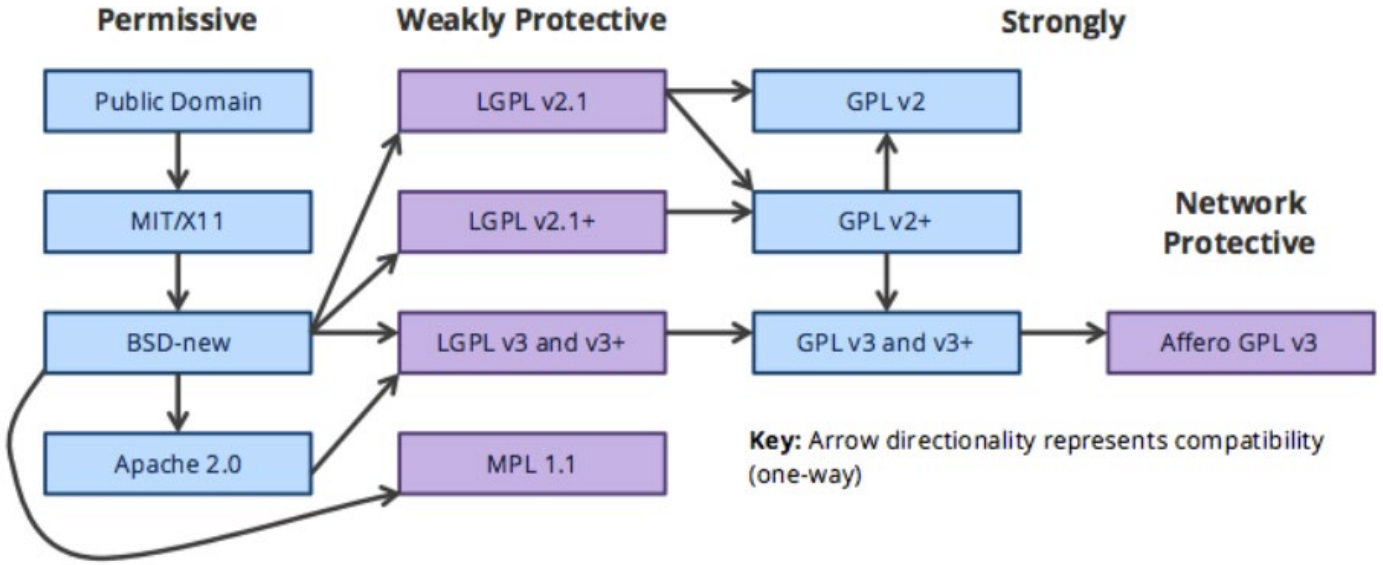
- **To report errors or system issues, please contact the eIDR system administrator at eidr@lanl.gov.**

- **Other Resources:**
  - LANL GitHub Host – github-register@lanl.gov
  - FCI Software Team — software@lanl.gov
  - General Inquiries – feynmancenter@lanl.gov
  - Export Control – export@lanl.gov
  - DC/SAFE Review – SAFE-IP | 667-5013 (or 667-5011)

Additional Slides

Open Source Software

- **Open source software is computer software and source code that is distributed under a license in which the user may use, copy, modify, prepare derivative works and distribute the software without needing to make royalty payments**
- **Types of Licenses:**
  - Open Source Initiative (OSI) is designated license steward
  - Common: MIT, BSD, Apache, LGPL, GPL
  - Permissive, Weakly Protective, Strongly Protective, Network Protective
- **Pay attention to the 3rd party tools**
  - Open source does not mean no obligations
- **Designating to the public domain**

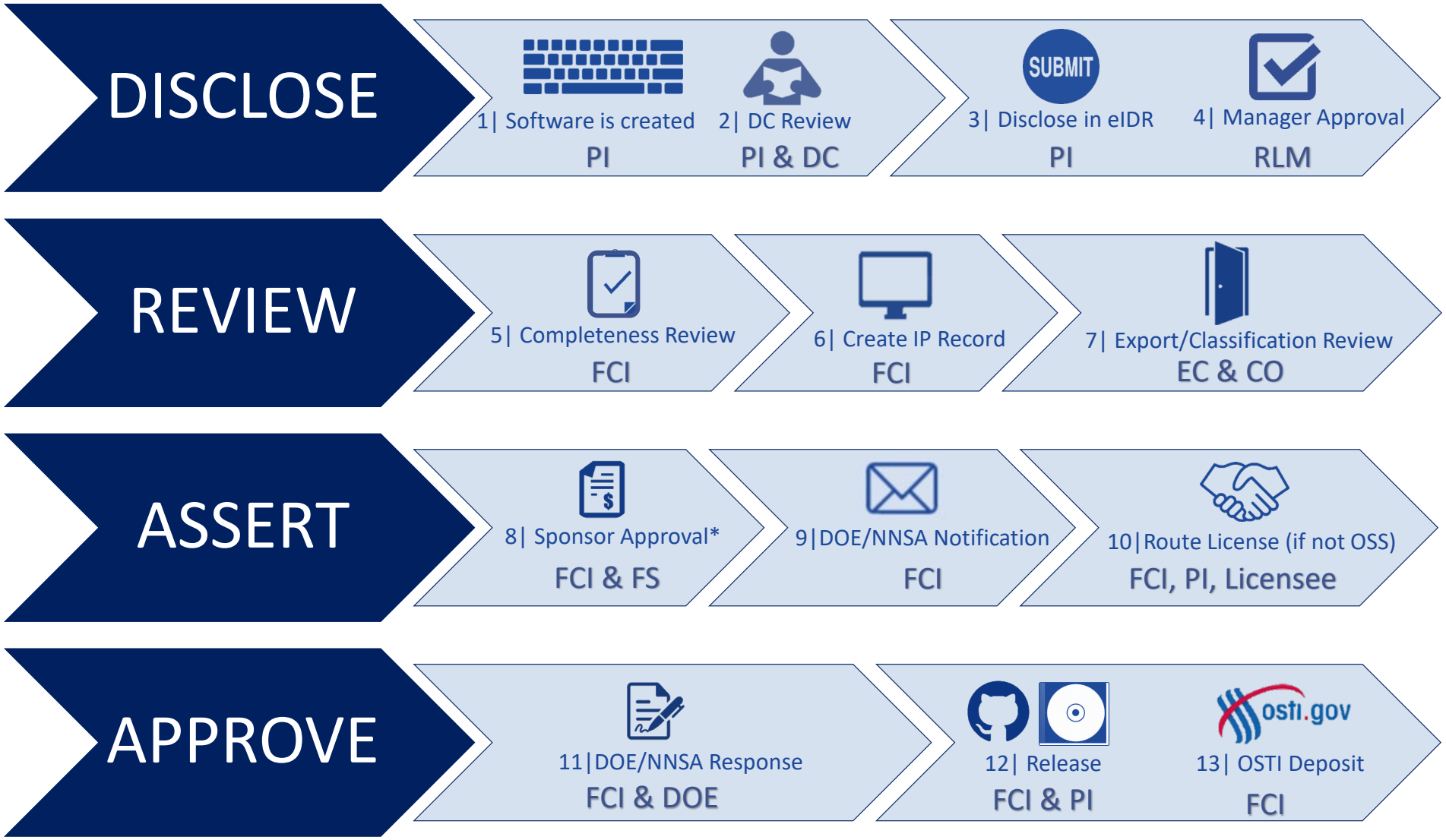


Funding Pathways @LANL

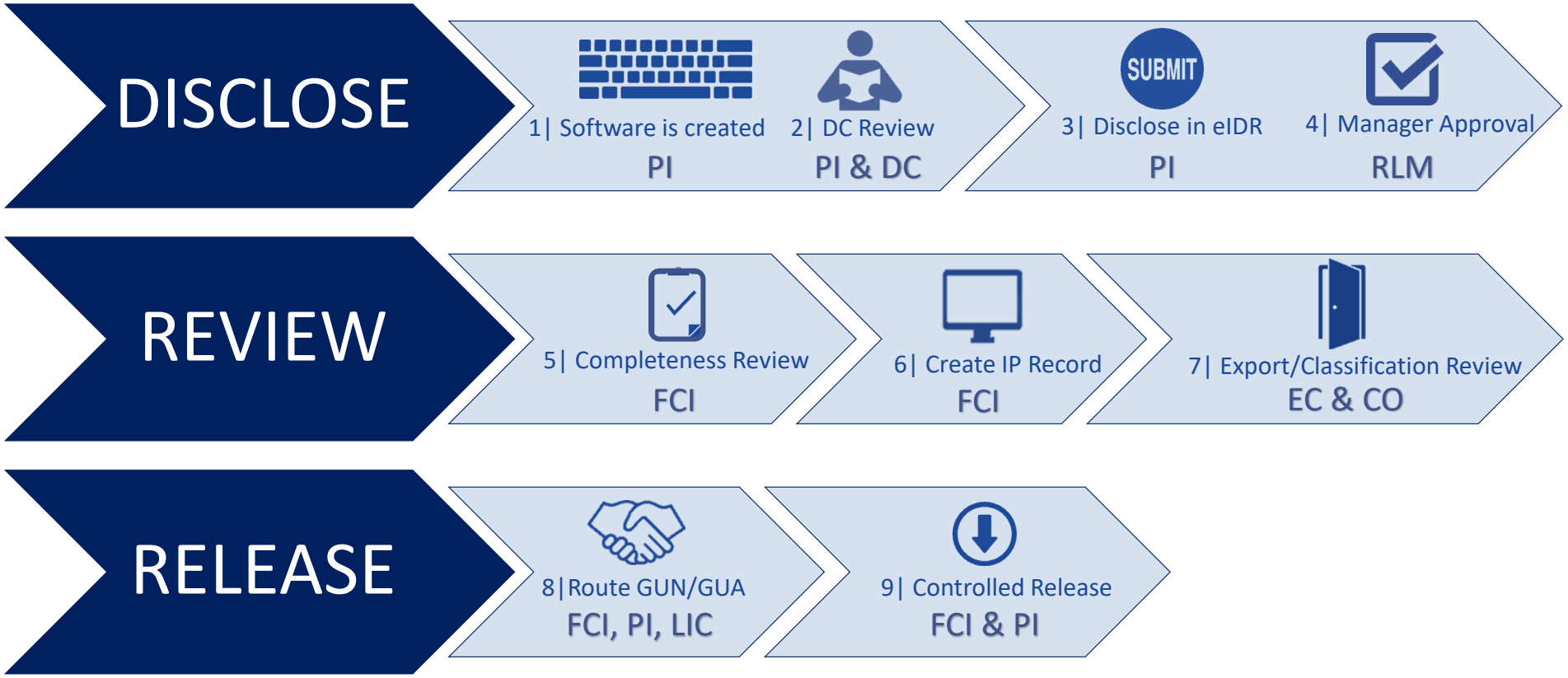
- **Programmatic Funding (e.g., DOE, DOD, DHS, DOS, IAEA etc.)**
- **LDRD (e.g., DR, ER, Early Career)**
- **Commercial**
  - –CRADA (e.g., Intellectual Property)
  - –NFE (e.g., No Intellectual Property)
  - –License (Exclusive vs. Non-Exclusive)
  - –FCI Tech Maturation Funds (e.g, up to $50K)

Make your first publication an invention disclosure!

Copyright Process



Government Use Software Process



*** Reminder:** *application is typically provisional. Each provisional application will be re-evaluated within 1 year to determine whether it will be converted to a full patent application.*

Disclosure/Patent Process