Department of Veterans Affairs
Technology Transfer

Bringing Research Advancements for Veterans to Everyone!
Agenda

• Technology Transfer
• Business at the VA
• Scope of VA Portfolio
• Our business process
  • Invention Disclosure
  • Determination of Rights
  • Assessment of Technology
  • Marketing
  • Licensing
  • Royalty Distribution
• Questions & Answers

Andrew Schally
Miami VAMC
Technology Transfer

• The commercialization of inventions and discoveries made by Government and affiliated researchers
  • Most often the commercialization involves licensing intellectual property to a company which will develop the intellectual property into a product that benefits the public
  • Could involve a collaboration with the inventor(s) through a license or a Cooperative Research And Development Agreement (CRADA)
At the VA...

• The mission of the VA Technology Transfer Program (TTP) is to facilitate the commercialization of VA inventions to benefit Veterans and the American Public
  • Review and evaluate VA employee invention disclosures
  • Manage collaborations with Universities
  • Review CRADAs, Material Transfer Agreements (MTAs) and other Intellectual Property (IP) related agreements
  • Provide IP consulting services to VA employees
  • Seek development and commercialization partners

• Bringing Research Advancements for Veterans to Everyone (BRAVE)
TTP Organization

• 14 Full Time Employees (FTE) authorized
• Current Staff: 10 FTEs
  • 1 - Director, Dr. John Kaplan PhD, JD, MBA, PE
  • 6 - Technology Transfer Specialists (PhD, JD, MBA)
  • 3 - Program Analysts/Specialists

• Experience - Government, Private Industry, University TTO, Consulting
• Intramural Research Program ($700M)
• 500 new CRADAs/yr.
• Over 100 partnerships with academia
• 497 New Invention Disclosures in FY18
• 255 (65) Patents Filed in FY18
• 72 (20) Patents Issued in FY18
• 18 active license agreements in FY18 (VA only)
  • Est. 100 plus VA & Affiliate license agreements
• $680,000 annual license revenue in FY18 (VA only)
  • Est. $2.5MM annual VA & Affiliate license revenue
Our Process

1. VA Affiliate Inventor Disclosure
2. Affiliate TTO VA TTP
3. Determination of Rights
4. VA or Affiliate Lead
5. Protection
6. Assessment
7. Marketing
8. Make a Deal

Bringing Research Advancements for Veterans to Everyone!

4/3/2019
Disclosure

• All VA employees
• Accept the VA or Affiliate Invention Disclosure Form
• VA Certification Form
  • 1 per each VA affiliated inventor
    • Full-Time
    • Part-Time
    • Without Compensation Employee (WOC)
    • Interpersonnel Agreement (IPA)

Source: VHA Directive 1200.18 & 38 CFR 1.656
In the Determination of Rights process, TTP reviews the VA Certification form and all other available information to determine if the VA has a legal basis to assert rights in the invention.
Determination of Rights

• Assessment of Government Rights
  • Assert Government ownership of the invention
  • Leave ownership of the invention with the inventor
  • Leave ownership of the invention with the inventor subject to the VA retaining a non-exclusive, government use license

• Employee Has Right to Appeal

• VA Asserts Rights
  • Managed by VA; or
  • Obligations through CTAA/IMA/IIA if jointly owned

Source: 37 CFR 501
Assessment

• Brief Technical Description
• Brief Market Analysis
• Competitive Position
• Barriers to Entry
• Recommendations
Patent Protection

• **Provisional Patent Application**
  • VA contracted patent firm
  • Collaborative process between attorney and inventor(s)
  • Managed by VA Technology Transfer Specialist (TTS)
  • Active marketing during first year informs decision on conversion to a utility patent application

• **U.S. Utility Patent Application**
  • In the absence of a license or strong licensing prospect, only U.S. patent protection is sought
  • Lengthy prosecution process
  • Grant provides 20 year exclusionary right

• **Foreign Patent Rights**
  • Patent Cooperation Treaty Filing
  • Regional/National Filings
Marketing

• Marketing Briefs
• Passive
• Targeted Marketing
• Media Outlets
• Inventor Suggestions
• Inventor’s Publications
Marketing

• Partnership Intermediary
  • Portfolio Management
  • Marketing
  • Licensing Opportunities
  • Industry Contacts
  • Downstream Economic Impacts

Source: 15 USC 3715

TechLinkcenter.org
Licensing

• To Commercialize
• Application Process is Codified (37 CFR 404.8)
  • Commercial Development Plan
• Negotiate an exclusive, partially exclusive, or nonexclusive license agreement
  • Fees
  • Royalties
  • Reimbursement of Costs

*No Inventor Involvement During Financial Negotiations*

Source: 37 CFR 404
Royalty Distribution

- First $2,000 to inventor(s), then:
  - 50% to inventor(s)
  - 50% to VAMC where invention was made

*Annual cap of $150,000 per inventor*

Source: 15 USC 3710 c & VA Policy
VA Affiliated Nonprofits

- Facilitate Research at the VA Medical Centers
- Flexible Funding Mechanism
  - CRADAs
- Office of General Counsel negotiates
- TTP limited interaction

Source: 38 USC 7361, VHA 1200.17
How can you assist?

So what do I do as a PI?

• Complete the Invention Disclosure and VA Certification Form concurrent with your Academic disclosure (we accept academic disclosures)

• Submit completed forms through your ACOS R&D for review

• Be available for questions from TTP

• Assist the patent attorney in drafting the patent application

• Assist negotiations by explaining the scientific merit supporting the invention

• Do not publicly disclose

• Do not discuss with outside parties without an NDA

Alexandra Howell
White River Junction VAMC
Path Forward

• Political
  • Updates to the CFR and VA policy
  • New master agreements

• Economic
  • Increase in operations budget
  • Outreach
  • Staffing

• Technology
  • Modernization
  • IP database in Cloud, intake portal
Contact

• **Email Box:**
  VA Technology Transfer Invention Disclosures
  [vattid@va.gov](mailto:vattid@va.gov)
  202.443.5645

• **POC:**
  John Kaplan, PhD, JD, MBA
  Director, Technology Transfer Program
  [John.kaplan@va.gov](mailto:John.kaplan@va.gov)
  202.632.7271

  Benjamin Henry, MBA
  Technology Transfer Specialist
  [Benjamin.henry@va.gov](mailto:Benjamin.henry@va.gov)
  202.443.5736
Bringing Research Advancements for Veterans to Everyone!

Regional Contacts

<table>
<thead>
<tr>
<th>Region</th>
<th>TTS</th>
<th>Contact</th>
</tr>
</thead>
<tbody>
<tr>
<td>Northeast</td>
<td>202.443.5688</td>
<td><a href="mailto:christopher.drabik@va.gov">christopher.drabik@va.gov</a></td>
</tr>
<tr>
<td>Chris Drabik, JD</td>
<td></td>
<td></td>
</tr>
<tr>
<td>West</td>
<td>813.417.6327</td>
<td><a href="mailto:lee.sylvers@va.gov">lee.sylvers@va.gov</a></td>
</tr>
<tr>
<td>Lee Sylvers, PhD</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Southeast</td>
<td>202.443.5736</td>
<td><a href="mailto:benjamin.henry@va.gov">benjamin.henry@va.gov</a></td>
</tr>
<tr>
<td>Benjamin Henry, MBA</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Mid Southwest</td>
<td>202.443.5778</td>
<td><a href="mailto:kalpana.reddy3@va.gov">kalpana.reddy3@va.gov</a></td>
</tr>
<tr>
<td>Kalpana Reddy, JD</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Upper Midwest</td>
<td>202.632.7554</td>
<td><a href="mailto:ryan.davis7@va.gov">ryan.davis7@va.gov</a></td>
</tr>
<tr>
<td>Ryan Davis, JD</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Mid Atlantic</td>
<td>202.443.5609</td>
<td><a href="mailto:david.marks2@va.gov">david.marks2@va.gov</a></td>
</tr>
<tr>
<td>David Marks, JD</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>
Helpful Links

• Intranet:  
  http://vaww.research.va.gov/programs/tech_transfer/

• Internet:  
  http://www.research.va.gov/programs/tech_transfer/

• VHA Directive 1200.18

• TMS learning course “Technology Transfer Program”
Questions & Answers

Thank you!