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 & Answer
Technology Transfer

• The commercialization of inventions and discoveries made by Government and academic researchers
• Most often it involves licensing a patent to a company which will develop the invention 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)
• The mission of the VA Technology Transfer Program (TTP) is to facilitate the commercialization of VA inventions to benefit Veterans and the American public
  • Manage Inventions of VA employees
  • Review CRADAs
  • Consultations
  • Collaborate with partners

• Bringing Research Advancements for Veterans to Everyone (BRAVE)
• 1 - Director, Dr. John Kaplan PhD, JD, MBA, PE
• 5 - Technology Transfer Specialists (PhD, JD, MBA, MPP)
• 3 - Staff Assistants (JD, MBA)

• Experience - Government, Private Industry, Consulting
Snapshots

- Intramural Research Program ($600M/ $1.8B)
- 500 new CRADAs/ yr.
- Over 100 partnerships with academia
- 589 Invention Disclosures in FY17
- 88 Patents Issued in FY17
- 15 active license agreements (VA only)
  - Est. 100 plus VA & Affiliate license agreements
- $490,000 annual license revenue in FY17
  - Est. $2.5M annual VA & Affiliate license revenue
Aspirational Goals

• FTEs
  • Goal 22
• Disclosures
  • Goal 700 plus
• Patent Applications
  • Goal 400 plus
• Licenses
  • Goal 150 plus
Our Process

- VA Affiliate Inventor Disclosure
- Affiliate TTO VA TTP
- VA Lead
- Deal
- Assessment
- Protection
- Market
- D.O.R
- Affiliate Lead
Disclosure

- 38 CFR 1.656
- Accept academic disclosure
- VA Certification Form
- 1 per each VA affiliated inventor
  - Full-Time
  - Part-Time
  - WOC
  - IPA
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, Govt. use license

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

**What happens next?**

Machelle Pardue
Atlanta VAMC
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 TTS
  • Active marketing during first year informs decision on conversion to a utility patent application

• **Utility Patent Application**
  • In the absence of a license or strong licensing prospect, only U.S. patent is sought
Marketing

• Passive
  • Posted to Web site
• Marketing Briefs
• Active Marketing
• Media Outlets
• Inventor Suggestions
## Active Marketing

<table>
<thead>
<tr>
<th>Company</th>
<th>Contact</th>
<th>Action</th>
<th>Response After Review</th>
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</thead>
<tbody>
<tr>
<td>Adroit Medical Systems</td>
<td>Gene Gammons</td>
<td>2/27/13 — Called and spoke with G. Gammons. He is interested and would like to see the NCD. Introductory e-mail and NCD were sent.</td>
<td>3/14/13 – Called and spoke with Gene. He is interested in speaking with the inventors and would be happy to sign an NDA. Will arrange the call and coordinate any necessary paperwork.</td>
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<td>3/13/13 – Sent follow up e-mail to G. Gammons. Received reply, “Yes, I would be interested in reviewing your device. As you may or may not know, this technology is what my life has been dedicated to manage Hypo/Hyperthermia, The art of heating and Cooling patients.” Replied asking if the information had been received on the 27th. Also explained that the technology was intended to be used for the management of hypo/hyperthermia.</td>
<td>3/18/13 – E-mailed G. Gammons requesting contact information at Adroit in order to move forward with the NDA.</td>
</tr>
<tr>
<td></td>
<td></td>
<td>Received second e-mail reply to my original message, “Yes I would be very interested in discussing your device”</td>
<td>4/9/13 – Resent NCD to G. Gammons.</td>
</tr>
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<td></td>
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<td></td>
<td>4/23/13 – Followed up with G. Gammons regarding interest.</td>
</tr>
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Licensing

• To Further Commercialize
• Application Process is Codified (37 CFR 404)
  • Commercial Development Plan
• Negotiate an exclusive, partially exclusive, or nonexclusive license agreement
  • Fees
  • Royalties
  • Reimbursement of Costs

No Inventor Involvement During Financial Negotiations
Royalty Distribution

• First $2,000 to inventor(s), then:
  • 50% to inventor(s)
  • 50% to VAMC where invention was made
How you can assist

So what do I do as a PI?

Alexandra Howell
White River Junction VAMC

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

• Submit through your ACOS R&D

• 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
Contact

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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”