

OFFICE OF RESEARCH &
CREATIVE ACTIVITIES (ORCA)



July 26, 2016

Bayh-Dole Act

35 U.S.C. Sect 200-212
37 CFR 401

Obligations of Institutions under Act:

1. Each Subject Invention must be disclosed to the Sponsoring Agency within a reasonable time after it becomes known to the Principal Investigator (PI) of the Institution (BYU). Two months has been used as a standard by the Federal Government. Most often disclosure is specified as to form such as DD Form 882; NASA Form 1679; or HHS 568 to name a few.
2. The Institution must make a *written* election within two years after the disclosure to the Federal Sponsor, whether the Institution will retain title to the Subject Invention. The Federal Government will receive title to any Subject Invention where the Institution does not elect to retain title or fails to elect rights within the time frame specified.
3. If the Institution elects to retain title per 1 & 2 above, the Institution agrees to file a patent application within one year after electing title. The Federal Government may receive title to any Subject Invention in the U.S. or other countries in which the Institution has not filed patent applications within the specified time.
4. If the Institution does not elect to retain title to a Subject Invention, if requested of the Sponsoring Agency, that Agency may allow the individual inventor to receive rights of ownership in the place of the Institution.
5. If the Institution, at some later date, decides not to maintain or defend the patented Subject Invention, the Institution must advise the original Sponsoring Agency.
6. The Institution must include statements in the patent application that the Subject Invention was financially supported by the Federal Government, and further, that the Government has a non-exclusive, nontransferable, irrevocable, world-wide paid-up license.

Pitfalls for Institution:

- A. The Sponsoring Agency may take title if the Institution or PI fails to timely fulfill any of the obligations above.
- B. Any infringer of a Subject Invention may allege that the Institution did not have title due to failure in one or more of the obligations above.
- C. Prospective business partners may discount payment of fees or royalties if failures are noted in compliance with obligations above.

Contact the Technology Transfer Office for disclosures: 3760 HBL; (801) 422-6266