

RECLAMATION

Managing Water in the West

Research & Development Office

License Agreement (LA) Guide

Technology Transfer



**U.S. Department of the Interior
Bureau of Reclamation**

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License Agreement (LA) Guide

This LA guide provides a brief description of License Agreement (LA), guidelines, steps to develop and execute, and approval checklist for entering into an LA.

For more information, please visit: https://www.usbr.gov/research/technology_transfer/partnerships.html.

Introduction to LA

An LA is an agreement between the owner of a patent or other intellectual property and another party interested in using the owned property or protected invention. Licenses may be granted to a non-federal partner for the right to practice, make, and/or sell a patented invention or other intellectual property owned by Reclamation. Only protected intellectual property (i.e., a patent application or issued patent) can be licensed. Licenses may be exclusive, co-exclusive, exclusive by field of use or territory, or non-exclusive.

The licensing of Reclamation's inventions must be carried out in accordance with 1) 35 U.S.C §209 (Licensing Federally Owned Inventions) and 2) 15 U.S.C §3710a (subject inventions made under a Cooperative Research and Development Agreement (CRADA)). The following guidelines for entering into LAs are obtained from the FTTA, 761 DM 1, and D&S RES 01-01:

- (a) If Reclamation develops a subject invention with a non-federal partner under a Technology Transfer Agreement, the non-federal partner must provide a royalty-free, non-exclusive, worldwide, irrevocable, non-transferrable license to Reclamation and the Government for any non-federal partner-owned subject invention. The purpose of this license shall be to practice the subject invention or have it practiced, by or on behalf of the Federal Government.
- (b) If Reclamation develops a subject invention with a non-federal partner under a Technology Transfer Agreement, the non-federal partner may be granted an option to negotiate an exclusive license in each subject invention owned by the Reclamation for one or more field(s) of use encompassed by the scope of the Technology Transfer Agreement in accordance with 15 U.S.C. §3710a(b). This license must be consistent with the requirements of 35 U.S.C. §209(a), §209(b) (manufactured substantially in the U.S.), and §209(f) and also 35 C.F.R. 404 and other such terms and conditions as may be reasonable under the circumstances, as agreed upon through good faith negotiations between Reclamation and the non-federal partner.
- (c) If Reclamation develops a subject invention with a non-federal partner under a Technology Transfer Agreement, Reclamation shall have the option to license, assign or waive its rights to the subject invention developed under the Agreement, as appropriate. However, Reclamation shall be provided a royalty-free, non-exclusive, worldwide, irrevocable, non-transferrable license to Reclamation and the Government to practice the subject invention or have it practiced, by or on behalf of the Federal Government.
- (d) If Reclamation assigns title or grants an exclusive license to a subject invention, Reclamation shall retain the march-in rights in accordance with 15 U.S.C. §3710a(b)(1)(B) and will only exercise those rights under exceptional circumstances, consistent with 15 U.S.C. §3710a(b)(1)(C).
- (e) Reclamation inventors will prevent conflict of interest issues and adhere to applicable ethics laws and regulations in accordance with 761 DM 1, 1.6 C and Reclamation Manual Policy, Ethics Program (ETH P01).

Develop and Execute an LA

Partners interested in licensing Reclamation's inventions can start by obtaining a license application from the Technology Transfer Coordinator (TTC) at the Research and Development Office. The TTC will negotiate the LA. To prevent conflict of interest issues, Reclamation's inventors will participate in license negotiations that involve technical matters and will not participate in negotiations that involve royalty rates or other business matters. Approval process takes about 2 to 4 weeks depending on the complexity of the LA and changes to the LA provisions.

LA Approval

The approval process is explained in the table below:

Description	Approval/Signatory
Technical Group	Researcher's Supervisor
	Researcher
Research & Development	Research Coordinator
	Technology Transfer Coordinator
Office (R&D)	Chief, R&D
	Science Advisor
DOI General Counsel	Intellectual Property Solicitor

More Information

For more information, please contact Samantha Zhang, Technology Transfer Coordinator, Research and Development Office at (303) 445-2126 or email szhang@usbr.gov.