

# Boston College

## Technology Transfer & Licensing

### Bayh-Dole Act FAQs

**1. What is the Bayh-Dole Act?**

Bayh-Dole created a uniform federal intellectual policy (IP) regarding inventions resulting from government-funded research and reversed the presumption of title of inventions from the government to a university.

**2. What effect did Bayh-Dole have on University IP?**

Prior to Bayh-Dole, the government licensed few of the patents that it owned and there seemed to be little incentive to develop a new technology with federal funding. Since Bayh-Dole implementation there has been a steady increase in U.S. academic patenting, licensing, and associated revenues. The act has also streamlined the bureaucratic process across all federal agencies.

**3. How do inventors comply with Bayh-Dole?**

Inventors must disclose an invention to the Office for Technology Transfer and Licensing (OTTL). OTTL then must disclose an invention to the sponsoring federal agency within 2 months of an invention disclosure.

**4. Does Bayh-Dole apply to training grants, fellowships, or scholarships?**

No, it does not apply to these or any other funding agreements that are primarily for educational purposes. Other exceptions to Bayh-Dole include when national security interests are involved or if the government determines that exceptional circumstances exist.

**5. What if I have non-federal funding in addition to my federal funding?**

Bayh-Dole applies to all inventions that are conceived or reduced to practice in whole or in part with federal funding. Individual non-federal organizations have their own specific requirements in regards to election of title of an invention. However, when negotiating non-federal agreements it is important that federal rights are not assigned or licensed to another organization.

**6. How does Bayh-Dole affect licensing practices?**

Bayh-Dole states that a University must make a reasonable effort to attract small businesses as licensees of an invention. For example, if there is a small business and a large business and both have a plan for marketing the invention that are both equally as likely to bring the invention to practical application, preference must be given to the small business.

**7. When can the government use march-in rights?**

If action is necessary:

- Because the assignee has not taken, or is not expected to take within a reasonable time, steps to achieve practical application of the invention.

- To alleviate health or safety needs that have not been reasonably satisfied.
- To meet requirements for public use specified by Federal regulations that have not been reasonably satisfied.
- If the preference for U.S. industry has not been obtained.

**8. How often has the government used their march-in rights?**

To date, a federal agency has never used their march-in rights, although there have been three petitions to the NIH which were denied.

**9. Do other countries have a policy similar to Bayh-Dole?**

Multiple countries including, China, Brazil, Malaysia, and South Africa have passed similar laws promoting the patenting of publicly funded research.