



## Bayh-Dole Compliance for Tech Transfer: Q&A Part Two

Although it's been more than a year since the new Bayh-Dole reporting requirements were announced, we continue to see clients challenged with the best process and tactics to implement the changes going forward. Here are several questions we have received in recent months that are relevant under the new and old Bayh-Dole regulations:

### **1) What is the best action to take when finding an issued patent that has government support clause that has not been reported?**

It is always best to report inventions to the Government at any stage that you become aware of federal funding. In the case of iEdison, you can enter a note indicating the date that you became aware of the funding.

### **2) What happens if we are late in providing utilization reports? Can we lose title?**

Utilization reports are due upon request from the federal agencies. At this time, NIH and DOE require utilization reports. You should assume that iEdison agencies expect utilization reports from grantees. More recently, in July 2019, Edison updated the utilization module in iEdison to include additional utilization data that DOE is now requiring. While there is no data available to indicate that grantees will lose title for not submitting utilization reports, it is possible that some agencies (such as NIH) could stop grant funding on certain awards until utilization reports are submitted.

### **3) How and when do you need to request a one-year extension to convert a provisional patent application pursuant to the associated Bayh Dole 2 reporting requirement?**

If the federal funding is from NIH, you need to email at [edison@nih.gov](mailto:edison@nih.gov) with the EIR Number and funding periods of the NIH grant(s). The extension request is required for inventions funded under grants with an award date on or after October 1, 2018.

For all other grants the extension request needs to be emailed to the particular agency contact. The extension request is required for inventions funded under grants with an award date on or after May 14, 2018.

As we are all aware, the accuracy of Bayh-Dole compliance is critical to avoiding IP disputes downstream and we strive to keep our clients informed through articles, on-site training and individual guidance to tech transfer offices. You can find additional questions answered about the new [Bayh-Dole Reporting Regulations](#) here or drop us a line at [Borman & Company](#) anytime.

