



Working with PNNL

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MISSION: To transfer technology to commercial markets to improve U.S. industrial competitiveness

- ▶ Help identify, evaluate, and protect intellectual assets that may evolve into intellectual property (IP) such as patents and copyrights
- ▶ Work with staff to prevent premature public disclosure of IP
- ▶ Market and leverage IP to attract business (licenses AND contract R&D)
- ▶ Generate IP licensing revenues to reward inventors and re-invest in the Lab as Technology Maturation funds

...and enhance the Lab's reputation and impact to our sponsor's missions.



Doing Business with PNNL



Direct Licensing of Existing IP

- Patents and technologies available for licensing

CRADA

- Cost share with DOE
- Option to exclusive rights to foreground IP

SPP (WFO)

- Fund research
- Keep the IP
- Mostly non-negotiable terms

ACT

- Fund research
- Negotiate IP
- More flexible in some terms



Licensing Options

- ▶ Patents and/or copyrights (software)
- ▶ Non-exclusive or exclusive
- ▶ Option agreement
- ▶ Research license
- ▶ Exploratory license
- ▶ Software: site license, marketer license, temporary use agreement
- ▶ Government use acknowledgement letter



Licensing Terms

- ▶ Negotiable vs. (essentially) non-negotiable terms
- ▶ License grant (make, have made, use, sell)
- ▶ Field of use
- ▶ Up-front fee
- ▶ On-going royalties
- ▶ Technical diligence terms
- ▶ Minimum royalties (earned and unearned)
- ▶ US manufacturing clause
- ▶ Patent cost reimbursement
- ▶ Sub-licensing, assignment
- ▶ Others?



Licensing Process

- ▶ Identify IP to license
- ▶ Contact commercialization manager
- ▶ Determine type of license
- ▶ Business plan information
- ▶ Term sheet
- ▶ Full license (commercial terms and boilerplate in parallel)
- ▶ Execution



Licensing FAQs

- ▶ How long does the licensing process usually take?
- ▶ Can I get a license outside the US?
- ▶ I need to manufacture overseas – is the US manufacturing clause waivable?
- ▶ Can Battelle/PNNL take equity rather than cash?
- ▶ How do I access PNNL know-how?
- ▶ What if more than one company wants an exclusive license for the same IP?
- ▶ What if I miss a diligence or royalty milestone?
- ▶ Do you provide a freedom to operate guarantee?
- ▶ Can I include IP from other Battelle labs in this license?
- ▶ Can I get a right to improvements or first right of refusal?



Questions/Comments?

