



December 13, 2012

MEMORANDUM FOR DISTRIBUTION

FROM: KARINA L. EDMONDS   
TECHNOLOGY TRANSFER COORDINATOR  
U.S. DEPARTMENT OF ENERGY

SUBJECT: GUIDANCE FOR TRACKING INQUIRIES RELATED TO THE LICENSING  
OF INVENTIONS DEVELOPED AT DOE FACILITIES

This memo provides guidance for tracking inquiries received from outside parties regarding licensable inventions developed at DOE Facilities (i.e. National Laboratories, single-purpose research facilities, and other Department facilities, hereafter referred to as "Facilities"). This guidance will help ensure that Facilities consistently track valid licensing inquiries<sup>1</sup> from industry while affording Facility operators flexibility to deploy technologies as expeditiously as possible.

The Department and its Facilities are committed to enhancing the impact of the Department's scientific and technological discoveries as well as promoting access to such discoveries by industry, including small businesses and entrepreneurs. The consistent tracking of licensing inquiries helps achieve these goals by ensuring that valid inquiries from entities both big and small are adequately considered for licensing, thereby helping maximize the potential deployment of DOE technologies.

Similarly, while Facilities have wide discretion in determining the most qualified entities to commercialize their technology, tracking and following-up on each valid licensing inquiry increases the likelihood that the most capable entities are both considered and ultimately selected.

The following guidelines will help Facilities consistently track valid licensing inquiries while ensuring that technology transfer activities at DOE facilities are conducted in a fair and transparent process. While the following guidelines are provided, it is recognized that the tracking of licensing inquiries may require site-specific adaptations. Therefore, these exemplary practices are meant as illustrative examples and not as limiting or definitive requirements.

### 1. Implementation of Guidance

Facilities are encouraged to develop written procedures (or update existing ones) for the tracking of licensing inquiries in accordance with the guidelines provided in this memo. These procedures

---

<sup>1</sup> A "licensing inquiry" is defined as a third-party request for information related to the licensing of a technology developed at a Facility which: (1) is made through the Facility's Technology Transfer Office or through the EERE Energy Innovation Portal, (2) identifies the technology by invention disclosure number, specific patent or family of patents, a specific inventor; or a specific area of expertise of the Facility that can be tracked to a particular inventor or invention disclosure and (3) is a technology currently available for licensing.

should establish a process for tracking valid licensing inquiries at the Facility and should ensure that reasonable efforts be made to follow-up on all valid inquiries.

## **2. Validation of Initial Inquiries**

While all licensing inquiries should be initially treated as though they are genuine, Facilities are encouraged to make reasonable efforts to collect the following information from outside entities in order to establish whether there is true interest in the technology from an outside party.

- Name(s) of the individual(s) making the request
- Name of Company/Organization
- Contact information (i.e. phone number, email address, physical address)
- Technology of interest
- Whether a foreign entity has a controlling interest in the company\*
- Type of licensed desired (i.e. exclusive, non-exclusive, R&D, etc.)\*
- Relevant experience (e.g. history of the company, technical areas of expertise, commercialization experience) if not readily apparent from the inquirer's website or other easily accessible public information.\*

Facilities have the flexibility to collect this information in a variety ways including the use of a licensing interest form (a sample form is provided in Appendix A), the EERE Energy Innovation Portal<sup>2</sup>, or other suitable means. It is recognized that a Facility may collect a smaller amount of input, e.g., answers to the first four (4) items only, as part of the initial inquiry in a staged inquiry process. Answers to the balance of the items should occur in follow-up communications.

If an interested party fails to provide such information (e.g. declines to complete a licensing interest form) the inquiry can be deemed unsubstantiated and will not be treated as a valid licensing inquiry for the purposes of tracking. However, if an interested party makes a good faith attempt to provide the identified information, the inquiry shall be deemed valid and the Facility should track the inquiry to final disposition.

## **3. Tracking of Valid Inquiries**

Once an inquiry has been determined to be valid, a record of the significant follow-up actions taken towards executing a licensing agreement should be tracked. Such actions may include:

- Date of initial inquiry
- Brief summary of the actions taken following the determination of validity (i.e. follow-up conference calls, meetings, etc.);

---

<sup>2</sup> The EERE Energy Innovation Portal can be used for as long as it remains fully operational

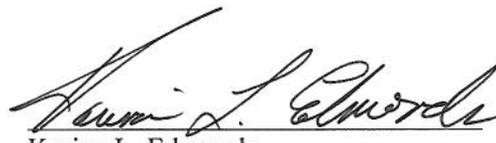
\* Optional for initial inquiry

- Date and reason the license inquiry was closed (i.e. date of an executed license agreement, decision not to license, etc.)

Facilities have the flexibility to track these actions using a spreadsheet, their technology transfer database, or other suitable means as long the information is appropriately tracked and can be easily provided to DOE upon request.

**Conclusion**

DOE is committed to improving its technology transfer policies and procedures and issues this guidance with the goal of ensuring that DOE's technology transfer activities are handled in accordance with best business practices and undertaken in a fair and transparent process. DOE will periodically reexamine and revise this guidance as appropriate to ensure these goals are being achieved.

 12/13/12  
Karina L. Edmonds  
Technology Transfer Coordinator  
U.S. Department of Energy

## Licensing Interest Form

If you are interested in licensing one of our technologies please complete the following form. The information requested provides the Lab with information about your capabilities and resources to commercialize the technology.

### Contact Information

Name:

Title:

Company/Organization:

Mail Address:

E-Mail:

Phone:

### Technology of Interest

What Lab technology are you interested in?

\*Does any foreign entity (company, person, foreign government, etc.) have a controlling interest in the company?  Yes  No

\*What type of license are you interested in?  Nonexclusive  Exclusive  R&D

\*How did you learn about the technology?

- Federal Business Opportunities notice
- EERE's Energy Innovation Portal
- America's Next Top Energy Innovator Program
- Our website
- Publication
- Trade Show/Conference
- Other

### Background Information including Commercialization & Technical Expertise

\*Brief description of your business/organization:

\*Summary of your organization's relevant technical expertise and experience in commercializing early stage technology (or a citation to a specific web page containing such information)

\*Other comments:

**Submit this form and any attachments to:**  
[INSERT LAB CONTACT INFORMATION]