

TTA Webinar
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Developing the ideal TTO for external counsel

By:



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Topic: **Developing the ideal TTO for external counsel**

Introduction to **Ortiz & Lopez**

1. Your overall experience/history working with TTO (5 min)

- Good overall experience with TTOs (government R&D Labs, Universities).
- Great research.
- Great knowledgeable inventors.

Career began as patent attorney with the US Dept of Energy to provide oversight of Sandia and Los Alamos TTOs which were established under the Stevenson-Wylder Technology Innovation Act of 1980.

The **Stevenson-Wylder Technology Innovation Act of 1980** (Pub.L. 96–480) (94 Stat. 2311) was the first major U.S. [technology transfer law](#). It required [federal](#) laboratories to actively participate in and budget for technology transfer activities.

The Act made it easier for federal laboratories to transfer technology to nonfederal entities and provided outside organizations with a means for accessing federal laboratory technologies.

The primary focus of the Stevenson-Wylder Act was to disseminate information from the federal government to the public and to require federal laboratories to actively engage in the technology transfer process. The law requires laboratories to set apart a percentage of the laboratory budget specifically for technology transfer activities.

Also worked directly with many inventors from these federal laboratories to prepare and file patents..

Members of my firm and I continue working with federal laboratory and university TTOs today.

2. Story of a bad experience with a TTO (5 min)

Inventorship is uncertain: Inventorship and ownership should be figured out at the beginning of the invention disclosure process.

Inventor(s) are inexperienced: Inexperienced inventors need more help understanding the patent process at the beginning compared to seasoned inventors – tutorials, training would be helpful (e.g., outside counsel)

Unreasonable filing deadlines: Short fuse filing deadlines can be avoided with periodic docket updates. Change in decision to file/not file provisional to non[provisional patent application conversions or the filing of PCTs at last minute creates time pressure for OC.

Unreasonable licensing Terms: Terms if unreasonable can poison the ability for

licensee to be successful (especially start ups).

Better understanding of strategies for cases filed by TTOs – sometimes it seems that TTOs are not clear on ultimate goals other than just getting a patent allowed.

3. Story of a great experience with a TTO (5 min)

Seasoned inventors. Often filed and received numerous patents. Understand how the system works. Can maintain focus on application preparation.

TTO-OC bonds: Once a great working relationship is developed between OC and TTOs, it becomes easier to understand goals and objectives and work through issues.

Site visits are encouraged: OC is able to see great research in the works. OC should be invited to and engage in onsite visits for other than just patent/IP counseling or prosecution matters. Get to know the client.

4. Top 5 things a TTO should do/consider/develop when working with outside counsel (15 min)

- Have clear, accessible policies for employees of the R&D facilities.
- Set up tutorial for novice inventors (inventors that are new to the process).
- Try to figure out inventorship well before handing disclosure off to OC.
- Establish clear disclosure guidelines. Provide enough information to OC at the outset of a matter. More information (including key background tech or patents) is useful in preparing a case.
- Try to avoid last minute patent filing decisions. Be careful of bar dates and give OC enough time.
- Also manage expectations of inventors and help them understand the process.
- Utilize seasoned inventors as patent champions/mentors for the organization.

5. Q&A over chat (30 min)