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If a specific question related to:

- **Commercialization**, please contact the [Poornima Upadhyia](#) at 631-344 -4711.
- **Intellectual Property**, please contact [Dorene Price](#) at 631-344-4153.
- **Sponsored Research**, please contact [Ivar Strand](#) at 631-344-7579

What is Technology Transfer?

Technology Transfer is the process of developing practical applications for the results of scientific research. For instance, a research result may be of scientific and commercial interest, but patents are commercially valuable when applied to practical processes, and so someone -- not necessarily the researchers -- must come up with a specific practical process. The process to commercially exploit research varies widely. It can involve licensing or setting up joint ventures and partnerships to share both the risks and rewards of bringing new technologies to market. Other corporate vehicles, like spin-outs, are used where the host organization does not have the necessary will, resources or skills to develop a new technology. Often these approaches are associated with raising venture capital (VC) as a means of funding the development process.

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What is a patent?

A patent is a form of intellectual property that essentially grants to an inventor the right to exclude others from making, using, or selling his or her invention. Patents are necessary for successful commercial developments of inventions. While there are several types of patents, generally the one of interest to you will be a utility patent. Utility patents are granted for machines, articles of manufacture, compositions of matter, and processes (or any useful improvement of these) that are novel, useful, and non-obvious. Patent protection is governed by the scope of the claims of the issued patent. Patent protection is only effective in the country (and its territories) where the patent has issued.

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What are the requirements for a patent?

The three basic requirements for a patentable invention are novelty, non-obviousness, and usefulness. Generally speaking, an invention is **useful** if it has a functional purpose, is operable, and is of some benefit to society. A **novel** invention is one that is not known to the public. In general, an invention will **NOT** meet the novelty requirement if:

- It was known to the public.
- It was described in a publication.
- It was used publicly, or offered for sale prior to the application filing date.

In addition, the invention must be **non-obvious**. This means that the invention must not be obvious to one of ordinary skill and creativity in the art and is a determination made by the U.S. Patent and Trademark Office by comparing the invention to the prior art (such as publications related to elements of the invention, including your own publications). To help meet this requirement, make sure the patent attorney or agent working on the application has a good understanding of the invention and provide him or her with any prior art you know. This will allow them to draft the patent application so that the invention is clearly distinguishable from prior art.

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What is a copyright?

A copyright is a form of intellectual property that grants its holder the sole legal right to copy their works of original expression; such as a literary work, movie, musical work or sound recording, painting, computer program, or industrial design. It is possible to protect software that you have developed by getting a copyright or releasing it under an Open Source Software License. Please consult with TCP or IPLG for assistance with copyrights.

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What is a public disclosure?

Disclosure of an invention is any public announcement or discussion, which includes written abstracts, talks, presentations, seminars, posters, publications (including electronic publications and postings), news releases, emails, and use of the invention in public. Disclosure will limit the right to obtain a patent. Until a patent application has been filed, you must be very careful what you say, send in an email, present in public, post on the Internet, or publish regarding the invention. There should be no public disclosure of an invention until a patent application is filed. Even if you have filed a Record of Invention, contact the IPLG or TCP prior to giving seminars, providing copies of papers, abstracts, overheads, or making any public disclosure.

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What is a Record of Invention?

A Record of Invention (ROI) is an important legal document that starts the patent process by identifying various aspects of the invention proposed to be patented. This document briefly describes the invention and its achieved advantages, date of conception, and novel features. A record of invention also includes (but is not limited to) design sketches, funding source, related or referenced publications or patents, laboratory notebook entries, information on the contributing collaborators, and public disclosure information. The ROI is very important because it officially starts the process of expert review of the invention to determine whether patent protection will be sought. Please let us know if we can assist you in the completing the ROI. The ROI helps to start the patent process, the sooner it is submitted, the better.

For ROI Form and Guidelines please visit the IPLG website or contact with TCP or IPLG for assistance.

Note: ROI is NOT a patent application and therefore should not be made public.

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Can I publish my work before the invention is patented?

The simple answer to this question is yes, you can publish your work before an invention is *patented*. But, the real question is what happens if you publish before a *patent application* is filed. In some instances, a *patent* in the United States may be obtained if the *patent application* is filed within one year of the date of publication which first disclosed the invention. A major distinction must be made between a patent and a patent application. These two distinct terms should not be used interchangeably because they convey separate meanings. A patent application does not carry the same protection provided by a patent because a patent excludes others from making, using, or selling an invention. In order to obtain a “patent” for an invention, a patent application must be filed. The patent application fully and publicly discloses the information of the invention (if there are questions about the meaning or examples of **public disclosure** please refer to question 5). When a patent application is filed, it does NOT mean that the invention is patented. Be aware that the patent process can take several years or more to finalize, However, once a patent application is filed then an inventor can publicly disclose the information of an invention in a publication.

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What are the policies for keeping a laboratory notebook?

From the moment you think you have an invention until the filing of the patent application, it is important to follow the proper procedures. A critical step in the patent process is maintaining accurate research records. Below is a short list of guidelines for maintaining research notes that must be followed:

- Notebooks must have sewn bindings and sequentially numbered pages.
- Make sure all entries are original, handwritten in ink, and do not skip any pages.
- Make corrections by drawing a line through the incorrect material so that it is still legible.
- Sign and date each page upon completion. Have a witness read, sign, and date each experiment upon completion.
- Record everything you do, as you do it, including small calculations, changes to procedure, and results.
- Record your hypotheses as they form the basis of the conception of an invention.
- Avoid disparaging commentary or other characterizations of the data in your notebooks.

Patent Licensing Responsibilities, Benefits and Guidelines for Laboratory Notebooks can be found at:

- <https://sbms.bnl.gov/SBMSearch/ld/ld12/ld12d331.htm>
- <https://sbms.bnl.gov/SBMSearch/ld/ld12/ld12d421.htm>

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What is a Material Transfer Agreement?

A Material Transfer Agreement (MTA) is a legally binding contract that provides the terms and conditions for a transfer of material (e.g., a sample or device) from BNL to another entity or vice versa. MTA terms may vary on a case-by-case basis. MTAs are important since they specify the rights, obligations, and restrictions of both the providing and receiving institutions with respect to issues such as ownership, publication, intellectual property, and permitted use and liability. All MTAs covering a specific transfer must be reviewed by IPLG to ensure that BNL may receive or provide such material.

Please note principal investigators are not authorized to sign a MTA. Please contact Dorene Price (Extension 4153; Email price@bnl.gov) in IPLG to discuss any specific questions regarding a MTA or to have a MTA reviewed.

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What is a Non-Disclosure Agreement?

A non-disclosure agreement (NDA) is a legally binding contract between at least two institutions (e.g., between BSA and on or more institutions), that governs the protection of information considered to be proprietary by at least one of the institutions. The terms and conditions of the NDA may specify (among other things) the information to be protected, and the circumstances under which it is protected. NDAs are to be forwarded to IPLG for review. During the review no disclosures between the institutions should occur.

Please see the SBMS NDA Policy: <https://sbms.bnl.gov/policies/NDA%20Policy.pdf>

Please note principal investigators are not authorized to sign a NDA. Please contact Dorene Price (Extension 4153; Email price@bnl.gov) in IPLG to discuss any specific questions regarding a NDA or to have a NDA reviewed.

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How do I release or use an open source software program?

All programs released, even those under an open source license, contain end user license agreements (EULAs). These EULAs typically require a user to accept or decline the license prior to activating the software in question. Under the Laboratory's prime contract with the Department of Energy, there may be provisions in the EULA which cannot be agreed to. Examples might be restrictions in a license, such as the ability to modify or distribute the source code, or the requirement to make the entire source code available in a program that incorporates the software under the EULA. As in other cases, this technology-related agreement is reviewed by IPLG prior to use.

Please consult TCP or IPLG for assistance.

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What does the Technology Commercialization Group do?

Part of the mission of the Department of Energy (DOE) is the transfer and commercialization of technology. TCP's role is to fulfill this DOE mission by finding industrial partners possessing the capability, interest, and resources to develop BNL technologies from infancy into maturity as useful products. This model is used at the university level and is now emulated by federal laboratories.

The technology commercialization group evaluates the Record of Inventions (ROI) submitted by inventors for commercial potential and makes recommendations on whether to retain title for the inventions. TCP markets BNL inventions to industry, and negotiates and administers license agreements. In addition, it records income and disbursements, and prepares yearly reports to the DOE. Other functions include assisting IPLG with material transfer agreements (MTAs) and non-disclosure agreements (NDAs). In addition, the technology commercialization group assists the sponsored research group with CRADA and Work for Others Agreements.

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What does Intellectual Property Legal Group do?

The Intellectual Property Legal Group (IPLG) of the Legal Department supports and protects BNL inventions at all stages of development and throughout the life of any patent protection that may be sought and obtained for it. IPLG receives and processes Records of Invention. IPLG works with TCP in its evaluation regarding any questions on patent protection, and IPLG oversees the preparation and prosecution of patent applications at the United States Patent and Trademark Office and other foreign jurisdictions if TCP determines to proceed. IPLG reviews and negotiates Nondisclosure Agreements and Material Transfer Agreements for researchers, if needed, as well as to support discussions that precede license agreements, research and collaborative agreements with industrial partners, and also reviews the license agreements or the research and collaborative agreements themselves (e.g., CRADAs, and WFOs), if needed.

Please contact IPLG early and often during the discovery process. Whether providing assistance to complete a Record of Invention or supporting commercialization of a BNL technology, we look forward to working with you.

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What does the Sponsored Research Group do?

The sponsored research group obtains the necessary authorizations and funding to perform research and development services for non-DOE federal agencies and non-federal entities which include Centers for Advanced Technology (CAT), or New York State Energy Research and Development Authority (NYSERDA). They draft and negotiate CRADAs and Work for Others Agreements with commercial entities. In addition, they authorize interagency agreements (proprietary or non-proprietary) or grants, which can be beneficial and appropriate in important research areas of other Federal agencies that simultaneously advance the goals of BNL.

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Location

The technology commercialization group and IPLG are co-located in Building 477 at Brookhaven National Laboratory. For detailed directions, please contact [Poornima Upadhy](#) at 631-344-4711 or [Dorene Price](#) at 631-344-4153.

The sponsored research group is located in Building 460 at Brookhaven National Laboratory. For detailed directions, please contact [Virginia Cocco](#) at 631-344-2506.

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