

## Licensing INL Technology

**I**NL contractor-owned inventions are available for licensing for commercialization by U.S. and foreign companies and organizations. The INL licenses its intellectual property on much of the same terms as universities, other research organizations and industrial firms.

### **Grant of Rights**

Various licensing terms may be negotiated, including both exclusive and non-exclusive license grants. Exclusive licenses may be in certain fields of use, geographic areas, or according to other terms. Co-exclusive and partially exclusive licenses, where exclusive rights to commercialize a technology may be shared by several organizations or restricted by area of use, territory or other terms, may also be granted. For example, one company may obtain exclusive rights to use and invention for applications in the energy industry while another exclusively licenses the same invention for applications in the food industry.

### **Royalties and Payments**

INL licensing royalties comparable to those charged by universities, other research organizations and the private sector. Licenses usually require an up-front, nonrefundable payment, royalty payments based on sales, and a minimum annual royalty. The fees will vary depending on the number of patents licensed, the demand for the technology, and the



*INL has many technologies available for licensing to meet a variety of industry needs. INL's technology portfolios are organized by industrial area and are managed by account executives with experience in these industries.*

exclusivity of the license. Licensees obtaining foreign rights may be asked to pay the cost of preparing, filing, and prosecuting foreign patent applications, and the maintenance of all resulting foreign patents.

### **U.S. Government Retained License**

As with all technology developed with federal funds, the U.S. Government retains a worldwide, non-exclusive, nontransferable, irrevocable, paid-up license to practice or have practiced any licensed intellectual property for or on behalf of the U.S. Government.

### **U.S. Preference**

INL is required to preferentially license inventions to U.S.-based firms, particularly those that will develop and manufacture licensed products in the U.S. However, in appropriate circumstances, non-U.S. firms may receive licenses, including broad

exclusive licenses, for the countries in which they operate or even receive exclusive worldwide licenses.

### **Technical Assistance**

The Licensee is solely responsible for the commercialization of the licensed inventions. Under specific circumstances, INL may agree to provide technical assistance to the Licensee on a full cost recovery basis if the work is beneficial to the INL's mission objectives.

### **Limited Warranty and Indemnification**

Any license for INL technology will contain a disclaimer of warranties and require indemnification of BEA and the U.S. Government.

### **Non-Assignability**

The license may extend to subsidiaries of the licensee or other parties, if provided for in

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the license, but will be non-assignable unless approved by the INL, except to the successor of that part of the licensee's business to which the invention pertains.

### **Sublicensing**

An INL license may include the right to grant sublicenses under the license, subject to the approval of the INL. Each sublicense shall make reference to the license, including the rights retained by the Government, and a copy of such sublicense must be furnished to the INL.

### **DOE March-In Rights**

The DOE has certain march-in rights to intellectual property developed with federal funding. Although rarely exercised, this right is in accordance with the Code of Federal Regulations.

### **Export Control**

The license will contain a provision recognizing that the export of goods and/or technical data from the U.S. may require an export license from the U.S. Government. Failure to obtain an export license may result in criminal liability under U.S. law.

### **FY-06 Licensing Activities**

Twenty-eight new license agreements, four new license option agreements and three agreement modifications were executed in FY-06.

One new license in particular was signed with Proswat, Inc., a Boise, Idaho-based company, for the production and manufacturing of the Tactical Timed Firing Device (TTFD). Designed and developed by INL engineer, Stephen Frickey, the TTFD is a safe, low cost,

reliable, timed countdown, firing device capable of initiating either standard size shock tube or electric blasting cap.

It is intended for use in EOD operations, where once the device is armed, and the countdown begins, the operator departs from the immediate area. The device is designed for limited use and can be considered expendable; however it can be reused if it is kept out of range of the intended blast.

Also in 2006, a license was signed with NorthStar Nuclear Medicine, Inc. on a new technology to produce the extremely valuable medical



*The TTFD functions much like a countdown alarm clock, can be used day or night and is weather resistant.*

isotope, actinium-225, for use in cancer research and treatment. The agreements open the door to another source of a medical isotope that can be used in a cancer treatment regimen that offers many advantages over traditional treatment approaches.

The agreements between INL and NorthStar include a license for the company to use the MATT technology, and a cooperative research and development agreement (CRADA) supporting further development of the technology. The license authorizes NorthStar the exclusive right to use

the technology for the life of the patents in exchange for fees and annual royalty payments to the laboratory. The CRADA is an



*Separated organic phase (blue) collection.*

agreement under which NorthStar provides INL funding to develop MATT during the initial planning stage for designing and building a pilot plant to recover the medical isotope.

### **Partnering with INL**

The INL's goal is to find parties interested in commercializing lab-developed technologies. The INL invites interested parties to contact us regarding licensing opportunities.

### **For more information:**

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**A U.S. Department of Energy  
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