

From: [Bogers, Karen \(NIH/OD\) \[E\]](#)
To: [NIH_TDC.Long_OO-OTT](#)
Cc: [Gottseman, Michael \(NIH/OD\) \[E\]](#); [Garcia-Peraz, Arlyn \(NIH/OD\) \[E\]](#)
Subject: Technology Transfer Community Newsletter - Issue #2
Date: Wednesday, November 18, 2015 10:45:52 AM
Attachments: [Annuity Drop Process.docx](#)

Dear Technology Transfer Community - For your reading pleasure the 2nd installment of the TT Community Newsletter. Please keep your suggestions for newsletter topics coming.

Creation of L#s and Processing New Licenses

Richard Rodriguez (NCI) is working to develop a "How To" document that will provide guidance on creating L#s. This information will also include a step-by-step guide on how to ensure that all of the necessary actions and data entry have been performed to correctly transmit a new license through TechTracS and SharePoint. In coordination, OTT is setting up training. The training will be recorded and saved for future reference. Because it is critical that the correct data is entered in TechTracS, the proper sequence is followed, and the SharePoint system used appropriately, the option for ICs to create their own L#s has been turned off in TechTracS. As IC staff are trained on this process, access will be granted to create L#s in TechTracS. In the meantime, please contact Richard Rodriguez if you have an urgent agreement that needs to be processed.

TechTracS and OTT SharePoint Support

We would like to remind you to go through the NIH Help Desk if you need assistance with TechTracS and OTT SharePoint set-up and support. Request that the ticket be forwarded to the OTT. If you don't hear back within 24-hours, please contact Tim Leahy by e-mail.

Annuity Reminders and Abandoning Technologies

Question: Once it's been determined that a technology should be abandoned, what is the process for abandoning a technology? In the past, when abandoning a country one year, another country would show up the following year for the same patent family. How can an entire technology be dropped at one time? Who do we notify? How do we notify them?

Answer: Excellent question. Please notify OTT once it's been decided to stop an annuity payment and to allow a patent to go abandoned. We ask that you use the drop report in TechTracS (*Scheduled to Drop Patents & Stop Annuity Payments*) and forward the signed report to OTT through the use of SharePoint.

Attached is a portion from the Program Specialist TechTracS Procedures Manual detailing the process, how to generate a drop report, and how to send the signed drop report to OTT.

However, please note that there is one caveat to the abandonment process. When receiving an annuity reminder for one member of a patent family and providing drop instructions for that one member of the family; doing so will *not* drop the *entire* patent family or technology, but rather only that one member.

When an entire technology consisting of multiple members of a patent family should be dropped, then all members of the patent family need to be addressed at the same time in order to avoid further reminders from generating, regardless of each patent's stage.

Every country has different conditions and schedules when annuities are due. Annuity fees and frequency are determined by many variables including the type of patent, the age, the stage or status, etc. Examples; Japanese annuities are due annually beginning in year 3, but only after issuance. Israeli annuities are due once every 7 years, after accumulated annuities have been paid at issuance. European annuities are due annually beginning in year 3, during pendency and from its PCT filing date.

The point being is that due to the differences in the annuity schedules, not all annuity reminders identify all of its corresponding patent family members. Annuity reminders identify only the patents that are coming due during a particular time period. When in receipt of an annuity reminder and deciding to "killing an EIR," we suggest that you use the record appearing on the annuity reminder as a prompt to examine the entire patent family and its members listed in TechTracS. Then when forwarding the drop report, indicate that *all* members of the patent family should be dropped and allowed to go abandoned.

Scanning Project

We're happy to report that the Docketing Group has finished prepping all of the patent records and completely cleared the file room. 6,671 patent files contained in 570 boxes were picked up on Thursday morning by the scanning contractor. The patent records will be scanned, converted into electronic files, and then attached to the corresponding patent record in TechTracS.

A big **"SHOUT OUT"** to -- Jill Roering (OTT), Bill Bigelow (OTT), Dominic LoPiano (OTT), Alexander Beraud (OTT) and Elizabeth Onstad (OTT), Kyle Doss (OTT), John Devany (NHLBI), Jean Eisenhour (NCI), Joseph Miles (NCI) and Marie Severin (NCI), for your tireless efforts to organize and package up thousands of documents related to this Technology Transfer Community effort.

When boxing up the patent records, the Docketing Group identified the patent families with active prosecution and labeled those records as the "Priority." The scanning contractor was provided with a detailed inventory list, specific instructions on how the records should be scanned, and which records are the priority records that need to be scanned first. Once scanning is underway, the contractor will begin providing batches of recently scanned records on a bi-weekly basis. As the newly scanned electronic records are received, they will be QC'ed and then uploaded into TechTracS.

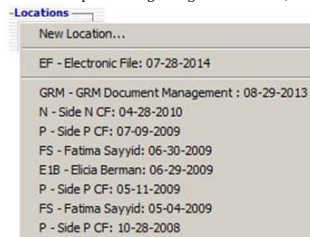
While the scanning process is underway, some may ask 'how will we be able to determine what patent records have been converted into electronic records?' We will be able to determine what has been scanned when pulling up an individual patent record and looking at the **Locations** field. If the Locations field has "GRM" then that record is with the scanning contractor and the electronic record hasn't been provided.



However, if the Locations field doesn't contain "GRM", but "EF" then that record has been scanned and is attached as an Electronic File to the patent record.



If there is a question regarding the **Locations**, click on the field and the acronym or initials will be identified.



We will provide progress updates throughout the project and upon its completion. We anticipate that scanning and attachment to TechTracS will be completed by the end of January 2016.



Why Aren't My Documents Attaching to SharePoint?

As a reminder, all new license documents must have a standard nomenclature to be processed through SharePoint. Please see list below and in the training document attached to SharePoint for reference <https://spweb.od.nih.gov/OTT/DTDT/DTDT%20Guide%20to%20SharePoint/Licenses.aspx>. **Please note that the document names all contain "dashes" and not "slashes".**

- Documents can have any name during the review process; however, before transmittal to RAU occurs, file names of documents to be sent **must** be edited to begin with "L-NNN-YYYY-A", where "L-NNN-YYYY-A" corresponds with the entry in the "L#" field. See "Editing Document Properties" at [Editing Documents and Document Properties](#) for instructions on editing the file name. The following nomenclature is preferred:
- **Licenses** – L-NNN-YYYY-A_Signed
- **License Memo** – L-NNN-YYYY-A_Summary
- **License Royalty Distribution Form** – L-NNN-YYYY-A_Royalty_Distribution_Form (initial RDF generated by DTDT)
- **License Royalty Distribution Form – Amended Versions** – L-NNN-YYYY-A_Royalty_Distribution_Form_MMDDYY
- **Green Sheet Documents that are only for OTT** – L-NNN-YYYY-A_Green_Sheet_MMDDYY (date represents the end of the expense period for which the costs are run)
- **Green Sheet Documents that should be sent by RAU to licensee along with invoice** – L-NNN-YYYY-A_Summary_PP_Costs_MMDDYY (this is the end of the expense period the costs are run)
- **Miscellaneous documents** only need to contain at least the first 12 digits and a descriptive name to be attached to the task. For example, L-NNN-YYYY-A_Other

Keeping Joint ICs in the Loop

The Technology Transfer Working Group would like to remind everyone to keep other ICs and Agencies in the loop when issues arise related to joint Patents and Licensing.

Regards, Karen

Karen L. Rogers
Acting Director, Office of Technology Transfer
Senior Royalties Administrator

Office of Technology Transfer
National Institutes of Health
6011 Executive Boulevard, Suite 325
Rockville, MD 20852
E-Mail: RogersK@nih.gov
Phone: 301-435-4359
Fax: 301-402-8678

SENSITIVE/CONFIDENTIAL INFORMATION

The attached information may be confidential. It is intended only for the addressee(s) identified above. If you are not the addressee(s), or an employee or agent of the addressee(s), please note that any dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this e-mail in error, please destroy the document and notify the sender of the error. Thank you.