

Office of TECHNOLOGY TRANSFER

BULLETIN

Volume 1, Number 1

National Institutes of Health

April 1992

Tech Transfer Seminar

Approximately 400 research scientists from NIH attended the introduction to tech transfer seminar March 11 at Masur Auditorium sponsored by the NIH Patent Policy Board.

The three-hour session featured presentations by *Dr. Philip S. Chen, Jr.*, Associate Director for Intramural Affairs; *Dr. John Gallin*, chair of the training subcommittee of the Patent Policy Board; and *MaryAnn Guerra*, Chief, Technology Transfer Branch, NIAID, along with *Reid Adler*, *Tom Wiseman* and *Marjorie Hunter* of OTT.

Each participant in the seminar was given the newly published notebook "NIH/ADAMHA/CDC Technology Transfer," the primary source of information about tech transfer within the PHHS.

Response to the seminar was enthusiastic, judging from the number of requests for additional notebooks being received by the OTT Technology Management Branch.

Advisory Committee Meets

Under the leadership of *Dr. Philip S. Chen, Jr.*, Associate Director, Office of Intramural Affairs, an ad hoc OTT Advisory Committee is providing input to OTT senior staff on a number of issues.

The committee includes *R. Eric Greene*, CDC; *Dr. Charles V. Grudzinskas*, NIDA; *MaryAnn Guerra*, NIAID; *Dr. Howard P. Jenerick*, Director, Extramural Inventions; *Dr. Thomas Mays*, NCI; *Edward H. McManus*, NEI; *Richard J. Riseberg*, Chief Counsel, Public Health Service; *Dr. Lana Skirboll*, ADAMHA; *James L. Tidmore*, Division of Contracts & Grants Management; and *Ellen Wormser*, Office of Assistant Secretary of Health.

At the first meeting March 4, the committee discussed OTT operations with *Tom Wiseman*, Acting Chief, Patent Branch; *Dr. Sandra Shotwell*, Chief, Licensing Branch; *Kim Hooven*, Administrative Officer; *Mike Miller*, Technology Management Branch; and *Reid Adler*, Director. Periodic followup meetings are planned.

Annual NIH/PMA Conference Scheduled

The Third Annual Technology Transfer Conference jointly sponsored by the Pharmaceutical Manufacturers' Association and NIH is scheduled June 3-4 in Washington, DC. Additional details will appear in the next Bulletin.

A number of NIH officials and industry representatives are scheduled to address the conference, which drew about 200 participants last year. The NIH planning committee includes *Dr. Jane Biddle*, NIAID; *Carolyn Craig*, OTT; *Dr. Bob Creveling*, NIDDK; *Lee Cummings*, NIDA; and *Diane Naughton*, Clinical Center.

This year's conference will focus on drug discovery, including sessions on access to new drug developments; sharing of information between academia, government and industry; conflict of interest guidelines; clinical evaluations; and frontiers in technology transfer.

Revised Employee Invention Reports

A new, improved Employee Invention Report (EIR) has just been implemented by OTT to facilitate the researcher's task in reporting inventions, and to make handling the report more efficient.

Re-designing the form is the result of weeks of input and deliberations involving a number of scientists, as well as Technology Development Coordinators (TDCs) from various Institutes, Centers and Divisions (ICDs).

The new form is available from the TDC in each ICD, or from OTT.

OTT Profiles

OTT has grown rapidly during the past two years in response to its increasing workload. As a way of getting to know more about newcomers — and some "old-timers" at OTT — profiles of OTT staff will be included in the Bulletin in coming months. This first issue profiles five new people — four in the Patent Branch and one in the Licensing Branch.

John Fahner-Vihtelic, a new licensing specialist in the Licensing Branch, has 15 years experience in medical electronics and disposable devices including design/product development, manufacturing and service. John comes to OTT from his former post as VP for Product Development at Physio-Technology Inc. in Topeka, KS. A former Army Green Beret, John is a serious advocate of physical fitness, participating in several endurance sports including running, swimming, cycling, triathlon and skiing. His wife Mary and two daughters Emily and Alexandra will be moving here after the school year ends.

One of the new faces in the Patent Branch is *Laverne Gilbert*, a Docketing Clerk. Prior to joining OTT she worked at the firm of Kendrick & Company in Washington, DC. Originally from Georgia, Laverne was employed with Robins Air Force Base in Warner Robins, GA, and has lived in the DC area for 4-1/2 years. In addition, Laverne is an ordained minister with the International Bread of Life Church Mission, Inc., and publishes a monthly Christian newsletter called "The Inheritance."

Larry Hyman, the newest adviser in the Patent Branch, was most recently a litigator enforcing regulations for the Department of Energy. Larry began his government career at EPA, after earning his law degree at Boston University School of Law. Three years ago, he decided to get back into science, entered Georgetown University as a part-time candidate for an M.S. in biology (while remaining a full-time lawyer), and hopes to finish his thesis in the next few months. He was recently admitted to the patent bar.

Amy McMurry, also a Docketing Clerk in the Patent Branch, comes to OTT from the Farmers Home Administration at USDA, where she was a County Office Assistant. A native of Brunswick, MD, she enjoys biking, swimming and "just relaxing" in her spare time.

Nelson Phelps just started in the Patent Branch staff as a Legal Technician. He earned his law degree in 1991 from California Western School of Law in San Diego, and passed the Maryland bar exam last year. A 1988 graduate of the University of Maryland, Nelson worked his way through school by providing a tennis racquet stringing service. His clients included the Maryland tennis team and professional players such as Lori McNeil and Zina Garrison. (Tennis is still a favorite sport of his.)

Pats On The Back To:

* *Margaret Griffin-Young*, veteran Patent Branch legal technician, for her countless hours overseeing the initiation and growth of the computerized docketing system. Beginning in September, 1990, Margaret has been responsible for entering information on every case from the paper files, entering data on every new Employee Invention Report (EIR), tracking the status of each of the more than 2,000 patent applications, and producing status reports. An indication of the magnitude of this task is the fact that OTT has just hired two docket clerks to help do what Margaret did alone for a year and a half.

* *Bob Benson*, Senior Patent Advisor, for his commendable work in filing a patent application for a new antitumor compound developed by Dr. Michael R. Boyd, NCI, who sent a letter to OTT praising Bob for his work. "The result was both rewarding and educational; and an excellent patent application was produced and filed in behalf of NCI in an exceptionally efficient and timely manner," wrote Dr. Boyd. "It was also clear that Dr. Benson actively sought and achieved a remarkable grasp of the science involved, asked many insightful questions and contributed very substantially to the accuracy and clarity of the scientific issues encompassed in the application."

SWAT Team Success

Preparing and filing the 1,000 page patent application covering nearly 2,000 gene sequences required a special effort at OTT. To handle the situation, a SWAT Team (Special Work

Assignment & Tasks) was formed under the direction of *Jim Haight*, Senior Patent Attorney, OTT Patent Branch.

Working day and night, weekends and holidays, this group was able to prepare the filing in less than two weeks — a monumental accomplishment. Pursuing patent protection on these sequences is an interim DIHIS policy. We hope that several public meetings in May will permit the gathering of enough data from industry and the research community to decide whether patenting and licensing will be in the overall public interest.

In addition to *Drs. Craig J. Venter, Mark Adams, and Chris Fields*, NINDS, and *Carole Kirby*, TDC at NINDS, the SWAT Team included *Reid Adler*, Director, OTT; *Bob Benson*, Senior Patent Advisor, OTT; *Kelly Cummings*, Chief Legal Assistant, OTT; *Ericka Harris*, Legal Assistant, OTT; *Angela Saah*, Legal Assistant, OTT; and *Elaine Ray*, Secretary, OTT. Special thanks to Kelly, who worked extra long hours.

Outside attorneys involved in the application were Lead Attorney *Ned Israelsen* of Knobbe, Marten, Olson & Bear in San Diego; *Steven Bent* of Foley & Lardner in Alexandria; and *Al Tanenholtz* of Birch, Stewart, Kolasch & Birch in Falls Church.

Issued Patents

Since 1986, a total of 227 patents have been issued based on PHS research inventions, reflecting the increasing participation of researchers in the patent application process. The following new patents have been issued to PHS researchers since the start of the 1992 fiscal year:

CC	5,100,646; Choyke, P., Frank, J., and Austin, H.; NMR Glomerular Filtration Test and Kit
CDC	5,055,267; Burroughs, G. and Huebener, D.; Thin Film Environmental Monitor
CDC	5,078,553; Dutkiewicz, J., Kwapiszewski, C., Olenchock, S., and Lewis, D.; Compact Drill Sampler for Quantitation of Microorganisms in Wood
CDC	5,081,871; Glaser, R.; Breath Sampler
FDA	5,052,934; Carey, R., Herman, B., Robinson, R., Stewart, H., Hoops, R., and Douglas, G.; Phantom for Evaluation of Prosthetic Valves and Cardiac Ultrasound Procedures
FDA	5,052,997; Ruggera, P.; Diathermy Coil
NCI	5,081,226; Berzofsky, J., Cease, K., Delisi, C., and Margalit, H.; Synthetic Peptides Which Induce Cellular Immunity to the AIDS Virus and AIDS Viral Proteins
NCI	5,096,808; Harris, C.; Method and Kit for Detecting Human Exposure to Genotoxic Agents
NCI	5,091,430; Moschel, R., Dolan, M., and Pegg, A.; 06-Substituted Guanine Compounds and Methods for Depleting 06-Alkylguanine-DNA Alkyltransferase Levels
NCI	5,082,927; Pastan, I., Fitzgerald, D., and Ogata, M.; Selectively Cytotoxic IL-4-PE40 Fusion Protein
NCI	5,093,115; Stevenson, H.; Activated Killer Monocytes: Tumoricidal Activity and Method of Monitoring Same
NCI	5,096,707; Wiltrout, R. and Hornung, R.; Flavone 8-Acetic Acid and Interleukin-2 for Cancer Therapy
NCI	5,061,488; Wiltrout, R. and Hornung, R.; Cancer Therapy Using Interleukin-2 and Flavone Compounds

NCI	5,063,053; Wong-Staal, F., Chanda, P., and Ghrayeb, J.; Isolation and Purification of the R18 Antigen of HTLV-III
NIA	5,096,893; Pitha, J. and Lindberg, B.; Regioselective Substitutions in Cyclodextrins
NIAAA	5,058,441; Whelan, J.; Safety Pipette and Adaptor Tip
NIAID	5,071,962; Morrison, R. and Caldwell, H.; Nucleotide Deduced Amino Acid Sequence, Isolation and Purification of Heat-Shock Chlamydial Protein
NIAID	5,075,228; Nano, F. and Caldwell, H.; Recombinant Clones of Chlamydia Trachomatis Lipopolysaccharide
NICHD	5,073,486; Leonard, W., Wolf, J. and Halden, N.; Novel Restriction Endonuclease
NIDDK	5,098,996; Jacobson, K., Kirk, K., Furlano, D., and Shai, Y.; Process for Introducing Fluorine into Biologically Active Materials
NIDR	5,066,716; Robey, F., Fields, R., and Linder, W.; Synthesis of Chloroacetyl and Bromoacetyl Modified Peptides for the Preparation of Synthetic Peptide Polymers...
NIMH	5,063,206; Bridge, P. and Goodwin, F.; Thymoleptic Peptides
NIMH	5,066,490; Neville, D. and Srinivasachar, K.; Protein Crosslinking Reagents Cleavable Within Acidified Intracellular Vesicles
NINDS	5,089,392; Miller, S. and Brady, R.; Fluorogenic Substrates for Measurement of Lysosomal Enzyme Activities within Intact Cells

OTT Gets New Contractors

Changes and additions in contract firms used by OTT to help file and prosecute patent applications, and to assist in licensing, have been implemented.

These changes will make the patent and licensing processes more efficient and responsive to PHS needs, and facilitate a smooth transition to handling more cases internally.

The new firms, and their areas of specialty, are:

- Allegretti & Witcoff: Specialized Patent Law Services
- Birch, Stewart, Kolasch & Birch: Chemistry
- Browdy & Witcoff: Specialized Patent Law Services
- Calpat Consulting: Licensing Consultation
- Cushman, Darby & Cushman: Chemistry
- Foley & Lardner: Biology, Licensing Consultation
- Knobbe, Marten, Olsen & Bear: Biology
- Leydig, Voit & Mayer: Chemistry
- Lowe, Price, Leblanc & Becker: Mechanical/Electrical
- Morgan & Finnegan: Biology, Chemistry, Mechanical/Electrical
- Needle & Rosenberg: Biology, Licensing Consultation
- Townsend & Townsend: Biology, Chemistry, Mechanical/Electrical

OTT Director's Column

The past year has been very challenging because of our heavy workload, yet it nonetheless has been very exciting for NIH and its sister PHS agencies. With special encouragement from Dr. Healy (and the approval of an increased staffing level for the patenting and licensing branches), OTT has almost acquired the critical mass to provide prompt and effective technology transfer services to the PHS research community. Important programs have been developed at most ICDs, several of which have also dedicated technology transfer offices.

Over the next twelve months, we will be phasing out our use of the licensing and foreign filing services at NTIS, working with a new advisory committee, developing new forms to expedite processing and review of invention reports, and continuing to build upon existing outreach programs such as the annual NIH/PMA conference, and the annual PHS Technology Transfer Conference.

We all need to be attentive to the details of invention reporting, to facilitate and yet assess critically the work product of the patent, CRADA and licensing staff at the ICD and central Agency levels and to restrain our expectations for perfection a bit longer until the staff capacity at all levels grows to handle the workload. This newsletter is intended to explain what we're doing at OTT, and to recognize the individual efforts of our staff. Please send me your comments!

POTPOURRI

Play Ball!

Once again the mighty OTT softball team, the Tech Transfusions, will participate in the CoEd Softball League sponsored by the NIH R&W Association. As in the past, games will be played in the Bethesda/Rockville area on Wednesdays and Thursdays after working hours. As evidenced by last year's record, the team needs additional talented players, both men and women. If you are interested in joining the team, please see **Mark Hankins** ASAP. "Spring training" will begin on Wednesday, April 8 at 6 pm at a field near the NIH campus; the first game will be played on April 22. (Note: All players must be members of the NIH R&W Association. Joining the softball league itself costs between \$5-\$10. See Mark for more details.)

Welcome Back, Sandy!!

Sandy Shotwell, Chief, OTT Licensing Branch, returned to work March 23 after a three month maternity leave to take care of baby Jessica, born December 23, 1991. Both Jessica and father Dan are doing well.

THANKS to everyone who contributed to our first issue! The deadline for the May issue is April 24.

The OTT BULLETIN is an unofficial, internal publication of the Office of Technology Transfer, National Institutes of Health, Box OTT, Bethesda, MD 20892; Telephone 301/496-0750

OTT Calendar

OTT CALENDAR OF EVENTS 1992

APRIL

- 13 Grand Rounds I/Wilson Hall - 12:00 Invited speaker: Francine Kerner, J.D., Office of General Counsel, Department of Commerce: "Conflicts of Interest Problems Arising From Technology Transfer"
- 13 TDC Meeting I/Wilson Hall - 1:30-3:30
- 21 CRADA Subcommittee Meeting I/151 - 1:00-3:30
- 27 PPB Meeting I/151 - 1:00-3:00

MAY

- 11 Grand Rounds I/Wilson Hall - 12:00 Speaker: Joe Allen, Director of Planning & Development, National Technology Transfer Center (NTTC), Wheeling, WV
- 11 TDC Meeting I/Wilson Hall - 1:30-3:30
- 19 CRADA Subcommittee Meeting I/151 - 1:00-3:00
- 26 PPB Meeting I/151 - 1:00-3:00

JUNE

- 3-4 Joint NIH - Pharmaceutical Manufacturers Assoc. Conference Mayflower Hotel, Washington, D.C.
- 8 Grand Rounds I/Wilson Hall - 12:00
- 8 TDC Meeting I/Wilson Hall - 1:30-3:30

1992 TECHNOLOGY TRANSFER CONFERENCES AND COURSES

APRIL

- 7-8 Navy Domestic Technology Transfer Conference, Solomons Island, MD; sponsored by Naval Air Warfare Center. Contact: Joan Salemi, (703) 671-0552.
- 8-9 Western University/Industry Technology Transfer Conference, San Francisco, CA; sponsored by Technology Transfer Conferences, Inc. Contact: Lucy Malone, (615) 366-0679.

- 10 Information Technologies Network Meeting, "New Developments in Super-Computing-Two Perspectives," Supercomputing Research Center (SRC) in Bowie, MD. Contact: (301) 762-6325

- 16 Maryland Biotechnology Network Monthly Breakfast Meeting, "Marketing your Firm: Ingredients for Success," NIST, Gaithersburg, MD. Contact: (301) 762-6325

- 23 Technology Forum "Hybrid Communication Networks: The Road to Global Connectivity," University of Maryland, College Park, MD. Contact: (301) 762-6325

- 24 Pacific R&D Conference; sponsored by AAAS; Palo Alto, CA. Contact: (202) 326-6000

- 27-28 Capitalizing on CRADAs-II; sponsored by Cooperative Technology RD&D Report; Washington, DC. Contact: Grant Stockdale, (202) 966-9610

MAY

- 4-5 Executives Conference '92-Biotechnology & Life Sciences; sponsored by Pacific Northwest Laboratory, Oregon EDD, ASTI, et al; Portland, Oregon. Contact: Robert McQuate, (503) 346-3189
- 5-7 1992 FLC Spring Meeting "Technology Transfer in the Fast Lane" Indianapolis, IN. Contact: FLC Administrator's office (206) 683-1005 Larry Halbig, (317) 353-3838 or Tim Janis, (317) 262-5036

JUNE

- 24-26 17th Annual Conference of the Technology Transfer Society, Atlanta, GA. Contact: Dr. McGovern (404) 542-6283 or Maureen Swinney, Technology Transfer Society, (317) 262-5022

JULY

- 13-14 Eastern Regional Meeting, Association of University Technology Managers, Herndon, VA
- 15-16 Inaugural Meeting, Association of Government Technology Managers, Herndon, VA

NOVEMBER

- 2-5 FLC Technology Transfer Meeting - Fall 1992, Scottsdale, AZ. Meeting information coming out September 1