

Cos. Should Prepare For Gov't Grantee IP Reporting Update

By **Cara Wulf** (July 28, 2022, 6:07 PM EDT)

For years, recipients of government funding have been forced to meet their intellectual property reporting requirements using the antiquated and user-unfriendly Interagency Edison, or iEdison, system.

Changes to iEdison have been underway since December 2019, with responsibility for iEdison soon transferring from the National Institutes of Health to the U.S. Department of Commerce's National Institute of Standards and Technology.[1]



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At long last, the revamped iEdison is almost ready to go live. While the possibility of a more manageable iEdison is exciting, contractors and grantees should prepare now for the inevitable hiccups that will accompany the transition and implement internal controls necessary to protect valuable IP rights.

After more than two and a half years of development, on Aug. 9, NIST will launch the new, and hopefully improved, iEdison. While the new iEdison boasts an updated interface and many new features, it preserves some features of the old iEdison that worked well for users.

In particular, the flow of reporting in iEdison will remain the same in that funding recipients will be required to report inventions first, then connect patent and utilization reports as applicable to the invention report.

The new iEdison also preserves the dual notification system whereby both users and agencies receive notifications of reporting activity and upcoming — or missed — reporting deadlines.

The Bayh-Dole Act requires recipients of government funding to timely provide a host of critical information to funding agencies or risk losing title to valuable IP funded in whole or in part by government contracts or grants. In particular, recipients are expected to:

- Report subject inventions;
- Elect title to such inventions;

- Provide confirmatory licenses to the government;
- Demonstrate the inclusion of the government support clause in any resultant patents; and
- File utilization reports.

Electronic reporting is mandatory under the regulations implementing the Bayh-Dole Act.[2] However, the existing iEdison system has many frustration-inducing flaws and quirks.

These frustrations have made it difficult for contractor and grantee users to meet reporting obligations, a source of justifiable anxiety for those organizations eager to protect their critical IP rights.

The new iEdison has multiple new features that seem poised to greatly improve the user experience, including:

- The ability to indicate whether old pre-2018 or newer 2018 Bayh-Dole regulations apply to a particular invention or patent family;
- Integration with the U.S. Patent and Trademark Office filing system, as well as login.gov;
- The ability for a child patent to claim priority to two or more parent patents;
- The ability to communicate back and forth within the iEdison system with the granting agency and to archive such communications for the record;
- Increased capabilities to make requests within iEdison and to include requests for extensions to file nonprovisional patents, requests to void a record and requests for domestic manufacturing waivers; and
- A broad range of new notifications — to include notifications when invention disclosures, government support clauses and confirmatory licenses are accepted by the agency — and the ability to customize the type and frequency of notifications delivered to administrators and users via email.

These changes, of course, will be accompanied by a period in which wrinkles will need to be ironed out. Therefore, in the coming months, funding recipients should remain cognizant of their reporting deadlines and proactive about making the required disclosures so that their IP rights are not compromised or effected during the transition.

In particular, contractors and grantees should note the following factors.

The old iEdison will go offline Aug. 2, and the new iEdison will go live Aug. 9. During the transition period from Aug. 2 through Aug. 8, iEdison will not be available and therefore contractors will be unable to complete their required reporting in iEdison.

Contractors and grantees with reporting deadlines during or shortly after this transition period should move quickly to make sure that all reporting deadlines are met prior to the transition.

Users should ensure that the email address associated with their iEdison account is the same email address used for their login.gov account.

Existing iEdison accounts will be migrated over to the new system; however, if a user's iEdison account does not use the same email address as a user's login.gov account, the user will be unable to access iEdison and complete the required reporting.

Organizations should make a copy and ensure that they have an internal record of their existing iEdison reports. While all records from the old iEdison will migrate to the new system in theory, glitches are always possible.

Organizations will want to ensure they have a record demonstrating that they have completed the required reports in the event entries are corrupted or lost in the transition.

Finally, and perhaps most critically, contractors and grantees should take this opportunity to create and/or update their internal formal invention reporting procedures to ensure that reporting deadlines are met.

The updated iEdison interface will now include a field in invention reports that will indicate to agencies whether a report is overdue, giving agencies the ability at a glance to determine whether an organization has failed to comply with its reporting obligations and thus jeopardized its title to valuable IP rights.

While we expect that users will spend the next several months, if not years, working out bugs in the new iEdison and acclimating to the new interface, the new iEdison appears to address many of the issues that plagued the old system.

It is expected that contractors and grantees will find the updated interface much more user-friendly; however, we caution that as iEdison becomes easier to navigate for contractors and grantees, it will also be easier for agencies to identify tardy and deficient reports.

Both Title 37 of the Code of Federal Regulations, Section 401.14, and Federal Acquisition Regulation 52.227-11 are explicit that the government may request title to a subject invention where the contractor fails to meet the reporting obligations in the applicable clause.

The iEdison transition is an excellent opportunity for contractors and grantees to avoid this and protect crucial IP rights by making improvements to their own internal reporting systems.

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[1] <https://www.governmentcontractslaw.com/2020/01/iedisons-2020-new-years-resolution-improvement-time-to-submit-your-comments/>.

[2] 37 CFR 401.16.