

---

## *Technology, Software and Data Rights*

### Government Contracts

WilmerHale is particularly experienced in the unique intellectual property implications of government financial assistance and in-kind support. We advise clients on the government reporting and licensing requirements of the Bayh-Dole Act and agency-specific implementing regulations to maximize ownership of federally supported inventions and technical data, while developing long-term relationships with federal agencies that may be leading consumers of the resulting commercial products and technologies. In collaboration with our intellectual property and technology transaction and licensing colleagues, we craft agreements that not only reflect the unique requirements affecting federally sponsored research, but also fit seamlessly into our clients' broader intellectual property strategies.

Reflecting the government's leadership as a source of technological innovation, clients turn to WilmerHale for advice on government-to-industry technology transfer transactions, including identifying and licensing technologies that are owned by government agencies and available for commercial use.

Federal research and technology transactions provide opportunities for companies and institutions of all sizes. With a long history of advising early-stage and venture-backed companies, WilmerHale enables clients to leverage government programs to accelerate R&D and commercialization, without impeding their private-sector funding plans. For companies eligible for Small Business Innovation Research (SBIR) grants and contracts or Small Business Technology Transfer (STTR) collaborations among universities and government laboratories, we assist clients in negotiating favorable technology licensing terms and setting up required reporting and compliance procedures.

---

### *Experience*

Negotiated IP licensing arrangements between a provider of advanced sensor equipment and the US Department of Defense.

Secured an investment and technology development agreement between a telecommunications equipment provider and In-Q-Tel, the non-profit strategic

investment affiliate of the Central Intelligence Agency.

Advised a major international pharmaceutical company on the implications of federal financial support for technologies developed by and subsequently licensed from a US university.

Secured waivers of US manufacturing preferences applicable to exclusive US licensees of federally-funded inventions.

Negotiated Space Act Agreements to facilitate advanced research collaborations between an emerging technology company and two NASA space flight centers.

Challenged a federal agency's proposed exclusive licensing of a government-owned patent.

Counseled clients on strategies to protect pre-existing, privately developed technologies in federal grant applications and in resulting federally-funded research programs.

Obtained waivers of the US Department of Energy's (DOE) presumed ownership of DOE-funded inventions and negotiated US competitiveness conditions that provide paths for non-US manufacturing.