

ASSEMBLY, No. 2507

STATE OF NEW JERSEY 219th LEGISLATURE

INTRODUCED FEBRUARY 3, 2020

Sponsored by:

Assemblywoman NANCY F. MUNOZ

District 21 (Morris, Somerset and Union)

SYNOPSIS

Establishes technology transfer assistance program in EDA.

CURRENT VERSION OF TEXT

As introduced.



1 AN ACT establishing a technology transfer assistance program in
2 the New Jersey Economic Development Authority and
3 supplementing P.L.1974, c.80 (C.34:1B-1 et seq.).
4

5 **BE IT ENACTED** by the Senate and General Assembly of the State
6 of New Jersey:
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8 1. As used in P.L. , c. (C.) (pending before the
9 Legislature as this bill):

10 "Authority" shall have the same meaning as provided in section 3
11 of P.L.1974, c.80 (C.34:1B-3).

12 "County college" means an educational institution established or
13 to be established by one or more counties, offering programs of
14 instruction, extending not more than two years beyond high school,
15 which may include, but not be limited to, specialized or
16 comprehensive curriculums, including college credit transfer
17 courses, terminal courses in the liberal arts and sciences, and
18 technical institute type programs.

19 "Institution of higher education" shall include a public institution
20 of higher education and a private institution of higher education.

21 "Private institution of higher education" means an independent
22 college, university, or institute incorporated and located in New
23 Jersey, which by virtue of law, character, or license is a nonprofit
24 educational institution authorized to grant academic degrees and
25 provide a level of education which is equivalent to the education
26 provided by the State's public institutions of higher education as
27 attested by the receipt of and continuation of regional accreditation
28 by the Middle States Association of Colleges and Schools, and
29 which is eligible to receive State aid under the provisions of the
30 Constitution of the United States and the Constitution of the State
31 of New Jersey, but does not include any educational institution
32 dedicated primarily to the education or training of ministers, priests,
33 rabbis, or other professional persons in the field of religion.

34 "Public institution of higher education" means Rutgers, The State
35 University of New Jersey, the New Jersey Institute of Technology,
36 Rowan University, a State college, a county college, and any other
37 New Jersey public university or college established or authorized by
38 law.

39 "State college" means any of the State colleges or universities
40 established pursuant to chapter 64 of Title 18A of the New Jersey
41 Statutes including any State college designated as a teaching
42 university.

43 "Technology business" means a corporation, partnership, limited
44 liability company, or sole proprietorship that is engaged in the
45 design, development, and introduction of new technology,
46 including, but not limited to, biotechnology, information
47 technology, re-manufacturing, advanced materials, processing
48 engineering or electronic technology products, or innovative
49 manufacturing processes.

1 2. The New Jersey Economic Development Authority, in
2 consultation with the Business Action Center created in the
3 Department of State and an institution of higher education, shall
4 establish, pursuant to the provisions of P.L. , c. (C.)
5 (pending before the Legislature as this bill), a technology transfer
6 assistance program to:

7 a. facilitate the dissemination of technology developed through
8 State-funded academic programs and State-subsidized technology
9 businesses;

10 b. provide assistance to private technology businesses in
11 transferring technology to commercial applications; and

12 c. conduct a patentability assessment and evaluation of existing
13 products to determine the marketability of the technology or
14 intellectual property.

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16 3. a. A person or business may apply to the authority for
17 assistance with the transfer of technology from the development
18 stage to licensing for practical application, including licensing for
19 patentable inventions, software, and other forms of intellectual
20 property. The authority may elect to contract with an institution of
21 higher education or with another qualified entity having an existing
22 technology transfer program to perform a portion or all of the duties
23 provided for in subsection b. of this section. If the authority so
24 elects, it may designate an institution of higher education to act on
25 behalf of the authority, and that designation shall be made on the
26 basis of competitive proposals and shall be based on the institution
27 of higher education's comparative experience, effectiveness, and
28 efficiency with respect to its existing technology transfer
29 operations.

30 b. (1) The authority or the institution of higher education
31 designated pursuant to subsection a. of this section, shall conduct a
32 patentability assessment and evaluation of existing products to
33 determine the marketability of the technology or intellectual
34 property. If the authority determines that the technology can be
35 protected by patent, the authority shall conduct, or contract with
36 another entity to conduct, a market assessment, including an
37 estimate of market size and an assessment of potential licensees, as
38 well as collecting other pertinent market and industry data. The
39 authority shall gather detailed information on potential licensees
40 and an assessment of the potential licensees' product lines,
41 production, marketing capabilities, if applicable, and financial
42 status.

43 (2) Upon the completion of the assessment authorized pursuant
44 to paragraph (1) of this subsection, a patent strategy shall be
45 developed, which may include designating a technology business or
46 other entity which the authority will assist in seeking patent
47 protection. An agreement may be made for outside legal counsel to
48 obtain patent protection, including the filing of the necessary forms,

1 applications, and documents.

2 (3) Upon obtaining a patent, the authority may provide
3 assistance in conducting a marketing campaign, including the
4 development of a strategy for obtaining patent protection and the
5 production of patent marketing materials. A technology business
6 interested in obtaining a license agreement shall sign a
7 confidentiality agreement before confidential information regarding
8 the patent is submitted for evaluation by the technology business.
9 The authority may provide assistance in negotiating a license
10 agreement that provides details on how the technology or other
11 subject of the patent will ultimately reach the marketplace. A
12 license agreement shall include terms relating to initial licensing
13 and other fees, patent costs, royalties, license maintenance, and a
14 definition of the property rights conferred in the agreement.

15 (4) The authority may provide a referral to the applicant for an
16 agent to continue to manage the relationship between the applicant
17 and a licensee after a license agreement is executed; this may
18 include monitoring the license, collecting fees, royalties and
19 reimbursable expenses, and the maintenance of records of patent
20 expenses and revenues.

21 (5) The authority or the institution of higher education
22 designated pursuant to subsection b. of this section, may assess the
23 applicant for the actual cost of the patenting, licensing, or license
24 management process, or upon agreement by both the applicant and
25 the authority, may assume partial ownership of the license in lieu of
26 the fee assessment. In the case of technology or intellectual
27 property funded by grants or by persons who are employees of the
28 State or any public entities and who developed the technology in the
29 course of their employment, the authority may elect to take a
30 percentage ownership in the technology or other subject of the
31 patent, the income from which shall accrue to the authority.

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33 4. This act shall take effect immediately.

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STATEMENT

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38 This bill requires the New Jersey Economic Development
39 Authority (authority) to establish a technology transfer assistance
40 program to facilitate the dissemination of technology developed
41 through State-funded academic programs and State-subsidized
42 technology businesses, and provide assistance to private technology
43 businesses in transferring technology to commercial applications.

44 The bill allows the authority to elect to contract with a New
45 Jersey institution of higher education or with another qualified
46 entity having an existing technology transfer program to perform a
47 portion or all of the duties in administering the program. The
48 authority may designate the institution of higher education to act on

1 behalf of the authority, and that designation shall be made on the
2 basis of competitive proposals and shall be based on the institution
3 of higher education's comparative experience, effectiveness, and
4 efficiency with respect to its existing technology transfer
5 operations.

6 The bill requires the authority or the institution of higher
7 education, as part of the technology transfer assistance program, to
8 conduct a patentability assessment and evaluation of existing
9 products to determine the marketability of the technology or
10 intellectual property. If the authority or institution of higher
11 education determines that the technology can be protected by
12 patent, the authority is to conduct, or contract with another entity to
13 conduct, a market assessment, including an estimate of market size
14 and an assessment of potential licensees, as well as collecting other
15 pertinent market and industry data. The authority is to gather
16 detailed information on potential licensees and an assessment of the
17 potential licensees' product lines, production, marketing
18 capabilities, if applicable, and financial status. Upon the
19 completion of the assessment, a patent strategy is to be developed,
20 which may include designating technology businesses or other
21 entities in which the authority is to assist in seeking patent
22 protection.