

# Government Practices in Purchasing R&D: Intellectual Property Provisions at the Department of Energy



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# Types of Government/Industry R&D Interactions: "Advisory" Role IP issues

## ⌘ Antitrust concerns

- ☑ Joint venture

- ☑ Individual companies

- ☑ Who is invited to participate Sharing of Proprietary Data

- ☑ Discouraged

- ☑ Non Disclosure Agreement: among companies, Government

## ⌘ Informal collaboration leading to an invention

## ⌘ Unocal dispute over invention arising from CARB advisory board

# Patent Rights



## ⌘ Bayh-Dole, 35 USC 201 *et seq*

- ⊗ Funding agreement with small businesses, universities, non-profits
- ⊗ Title to contractor subject to Government Purpose License, March-in, US Preference

## ⌘ Atomic Energy Commission Act, 42 USC 2182; Federal Nonnuclear Energy Act, 42 USC 5908

- ⊗ Covers R&D not subject to Bayh-Dole
- ⊗ Title to government unless waived, subject to Government Purpose License, March-in, US Preference and US Competitiveness

## ⌘ Other Transactions (TIAs): No statutory IP requirements; allows greater flexibility in negotiation

# Data Rights



- ⌘ Dissemination statutes promote widespread dissemination of scientific information
  - ☑ Technical Data including Databases
  - ☑ Software
  - ☑ Special data protection statutes (e.g., EPACT 1992) may allow for 5 year protection for first produced data, e.g. hydrogen fuel program, TIAs
  - ☑ Proprietary Data always protected

# Direct Transactions with DOE



## ⌘ Assistance: Grants and Cooperative Agreements, Technology Investment Agreements (TIA)

- ☑ DOE does many large R&D Cooperative Agreements for energy research, teaming arrangements

- ☑ 10 CFR 600

- ☑ Other Transactions (TIAs) 10 CFR 603  
(<http://professionals.pr.doe.gov/ma5/MA-5Web.nsf/FinancialAssistance/TechnologyInvestmentAgreements?OpenDocument>)

## ⌘ Acquisition

# Transactions with DOE Laboratories



- ⌘ Subcontracts: IP follows DOE acquisition rules, may be used for large R&D efforts
- ⌘ Work For others: access to unique capability, sponsor pays full cost and owns IP, DOE Order 481.1 & Manual
- ⌘ User Facility: access to unique scientific machine, sponsor owns IP

# Transactions with DOE Laboratories



- ⌘ CRADA: Collaborative Research of benefit to DOE mission DOE Order 483.1 & Manual, IP negotiable
- ⌘ Technical Assistance (guidance) for small business
- ⌘ IP license: Patent, copyrighted software, open source software, biological material bailments