

Roadmap Workshop on Manufacturing R&D for the Hydrogen Economy

Paul Gottlieb

Assistant General Counsel

for Tech. Transfer & IP

202-586-3439 (fax 2805)

Paul.Gottlieb@HQ.DOE.GOV

www.GC.DOE.GOV/GCMAIN.html

Types of Government/Industry R&D Interactions

- **“Advisory” role, peer review:**
 - Credibility for the Government R&D program
 - Access to technical knowledge in Industry to avoid wasting resources on R&D that industry doesn’t think will work
 - Examples
 - FreedomCar
 - Solid State Lighting MOU DOE/Alliance
- **R&D Funding**
 - Direct Contract, Grant cooperative agreement and in the future other transaction
 - Partnership with DOE laboratory through subcontract, CRADA, WFO, license
 - Examples
 - USABC
 - SECA

Types of Government/Industry R&D Interactions: “Advisory” Role IP issues

- Antitrust
 - 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

Types of Government/Industry R&D Interactions: Direct Agreements

- New inventions owned by Technology Developer
- How does industry get access to new inventions
 - New approach: Solid State Energy Conversion Alliance, Solid State Lighting
 - Industry players have 1 year to take Nonexclusive license

Types of Government/Industry R&D Interactions: Direct Agreements

- Partner with a company which subcontracts or with consortium which subcontracts
 - Impact of Bayh-Dole: Party that creates owns regardless of who funds
 - Who controls IP?
 - Impact of DOE Waiver statute: Title waived to prime except for those subs subject to Bayh-Dole

Types of Government/Industry R&D Interactions: Direct Agreements

- Qualification requirements
 - EPACT: 10 CFR 600.500
 - Manufacture in the US
 - IP reciprocity of home country
 - Cost Sharing
 - What does the cost sharing party get for their cost sharing?

Types of Government/Industry R&D Interactions:

Direct Agreements-Terms and conditions issues

- Public Release of scientific data first produced under agreement with government vs. public dissemination of scientific data first produced
 - Quid pro quo for cost sharing
 - Induce follow-on private investment
 - Public release needed to stimulate further research
 - If no release looks like corporate welfare
 - Statutory authority with negotiation to satisfy both party's needs

Types of Government/Industry R&D Interactions: Direct Agreements-Terms and conditions issues

- U.S. Manufacture, benefit to the US economy
- Recoupment
- March-in rights to assure commercialization
- Government march-in rights to Background IP to assure commercialization

Types of Government/Industry R&D Interactions:

- Other Transactions Authority: IP flexibility
- DOE now has authority
 - Must issue regulations before authority used
 - Each transaction must be approved by Presidential appointee