



# Revisions to Intellectual Property DEAR Clauses

**Briefing for Fall 2017 TTWG Meeting**

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# Overview

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- **RevCom Process (2015-2016)**
  - Rights In Data (DEAR 970.5227-2)
  - Technology Transfer Mission (DEAR 970.5227-3)
  - Made it through comment phase but didn't get finalized
- **RWG—Revolutionary Working Group for LBNL M&O Contract**
  - Rights In Data (DEAR 970.5227-2)
  - Technology Transfer Mission (DEAR 970.5227-3)
  - Patent Rights (DEAR 970.5227-10)
  - Authorization and Consent (DEAR 970.5227-4)
  - Notice & Assistance Regarding Patent & Copyright Infringement (DEAR 970.5227-5)

**RWG clauses will be used at Office of Science M&O**



# Rights In Data

## \*(new portions)

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- **Definitions added in RevCom**
- **\*Paragraph (b)(2)(iii)– “works produced by Contractor under DEAR 952.204-75 (Public Affairs) or otherwise made available to the public”**
  - Lab may to assert copyright in works such as reports, media, presentations, communication pieces, videos and other scientific and educational materials where the lab may want control of the content but not planning on commercially licensing.
- **Paragraph (b)(4)—Scientific and technical Information reported to OSTI**
- **Paragraph (c)(3)—Government can have Contractor assert copyright and transfer to the Government (similar to FAR 52.227-17).**
- **\*Paragraph (d)(1)-- Broaden from scientific and technical “articles” to “works” to include “contributions to chapters of book compilation”, reports, non-architectural drawings ,videos, website, workshops, or social media. “Purpose of scientific research, knowledge and education” added to distinguish from paragraph (e) where © assertion is for “control distribution to advance the goals of TT mission.”**



# Rights In Data (continued)

## \*(new portions)

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- **\*Paragraph (e)(1)(iv)—removed appendix for treaties and reference DOE’s Office of International Affairs for latest list.**
- **Paragraph (e)(3)(iv)—reworded language from RevCom to change renewing exclusive copyright every five years to a standard when lab abandons commercializing.**
  - **Extends to “subsequent minor versions (e.g., minor revisions, patches and bug fixes) having same funding source, same name and substantially the same functionality**
  - **May extend to subsequent major versions with approval of Patent Counsel**
  - **Grandfather clause for previously approved copyright will follow the abandon commercializing standard**



# Rights In Data (continued)

## \*(new portions)

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- **Paragraph (f)—Adding a section on Open Source Software. Modified a bit from Acquisition Letter of 2006 that is in most M&O Contracts now, but similar except:**
  - DOE Program has 10 days after notice to object to assertion of copyright
  - Industry standard disclaimer can be used
  - Removed Export Control and Trademark sections since covered elsewhere
- **\*Paragraph (g)—Patent Counsel can approve the replacement of FAR 52.227-14 with FAR 52.227-17 Special Work without CO approval. However, the provision to direct copyright and transfer of FAR will still require DOE CO.**



# Technology Transfer Mission

## \*(new portions)

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- Paragraph (a)(3)—added a paragraph on Trademark and Servicemark.
- Paragraph (b)—two definitions added
- \*Paragraph (c)(1)—deleted the requirement of getting CO approval for raising the budget of Licensing Activity above 0.5 percent of operating funds.
- \*Paragraph (d)(1) and (n)(5)—Conflict of Interest in (d)(1) has been changed from “preparing, negotiating, and approving” to “negotiating, approving and performing”—preparation by staff is not included, but the PI performing is now.
- \*Paragraph (d)(9)—removed notice to Users of User facilities of possible Lab BIP. There are thousands of users mostly using equipment without the need of Lab BIP in the future and burdensome for lab to do analysis. Requirement remains for SPP because SPP are more individually developed and deal with actual lab research.
- Paragraph (f)—U.S. Trade Rep review from Acquisition Letter 2006



# TT Mission (continued)

## \*(new portions)

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- **\*Paragraph (g) Product Liability Indemnity—modified last sentence to not include CRADA and SPP because the Orders have guidance in addressing this issue. So only licenses or assignments would apply here.**
- **\*Paragraph (h)(1)—matches the statute 35 USC 202(c)(7) to drop the net amount of royalty collected above 5% of Lab budget from 75% to 15% paid to treasury.**
- **\*Paragraph (i)—transfer of title to successor Contractor from “one package” to “one or several packages if necessary”**
- **\*Paragraph (l)—The Report to Congress for technology transfer plan is modified to allow to be included as part of the Annual Laboratory Plan. This should eliminate a duplicate report.**
- **Paragraph (n)—lab licensing to consider U.S. Trade Representative information from Acquisition Letter 2006**
- **Paragraph (p)—moved the Ombudsman paragraph from Alternate I to the clause.**



# Patent Rights

- Paragraph (b)(2)—moved Treaty section up to have Exceptional Circumstance paragraphs together. Also, removed the appendix list of treaties and referenced the url instead.
- Paragraph (c)(1)—Contractor shall notify DOE of “accepted” manuscript 60 days prior to end of statutory bar.
- Paragraph (c)(4)—Add a paragraph to allow reporting through NIH-iEdison portal to report, elect and file inventions.
- Paragraph (c)(6) —publication “approval” to “review” and reference to lab procedures in (f)(5) (Contractor’s Invention Identification Procedures) is enough protection for DOE for rare publication affecting rights in invention DOE might protect
- Paragraph (h)—instead of reporting commercializing for the thousands of active patents, the lab responds to the yearly data call for the Department of Commerce that shows the technology transfer activity.
- Paragraph (q)—Classified Inventions. Since several Science Labs do not generate Classified Inventions, we have moved that paragraph as an Alternate 2 to be included when Labs do generate Classified Inventions.





# Authorization & Consent Notice & Assistance Regarding Patent & Copyright Infringement

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- **Both clauses changed the \$100,000 threshold to “the simplified acquisition threshold” so that clause sets don’t have to be changed when the dollar level changes.**