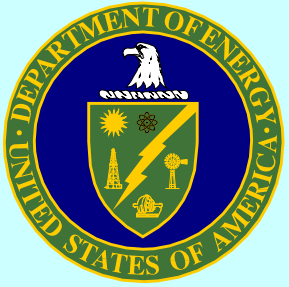


# **DEAR 970.5227-2 & -3 M&O Rights in Data-Facilities & Tech. Transfer Clause**

**Briefing for 2011 DOE Patent Counsel Meeting**

**Gary Drew**  
**U.S. Department of Energy**  
**Gary.drew@bso.science.doe.gov**



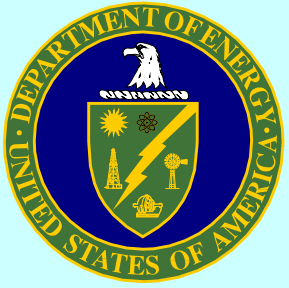
# “Commercializing Software”

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## Section (e) Copyrighted works

(e)(1)(i)(E) A statement that the Contractor plans to commercialize the data in compliance with the clause of this contract entitled, "Technology Transfer Mission," within five (5) years after obtaining permission to assert copyright or, on a case-by-case basis, a specified longer period where the Contractor can demonstrate that the ability to begin to commercialize effectively is dependent upon such longer period;

(e) (3)(iii) As long as the Contractor has begun to commercialize the copyrighted data within 5 years, the Contractor may continue its commercializing activity for as long as market demand is being met. ~~For a 5 year period or such other specified period as specifically approved by Patent counsel beginning on the date the Contractor is given permission to assert copyright in data,~~ During this period, the Contractor grants to the Government ... (narrow Government license)

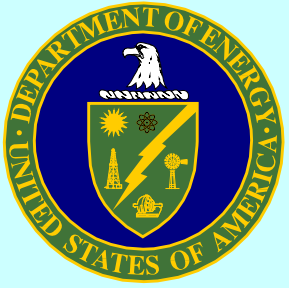


# “Commercializing Software”

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## Section (e) Copyrighted works

- (e)(3)(vi) With respect to any data to which the Contractor has received permission to assert copyright, the DOE has the right, during the ~~five (5) year or specified longer period~~ that Contractor is commercializing approved by Patent Counsel as provided for in paragraph (e)(3)(iv) of this clause, to request the Contractor to grant a nonexclusive, partially exclusive or exclusive license in any field of use to a responsible applicant(s) upon terms that are reasonable under the circumstances...



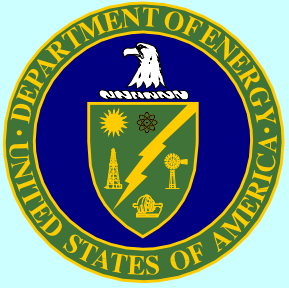
# Commercializing software

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## OSTI Requirements:

- (i) For computer software, the Contractor shall furnish to the DOE designated, centralized software distribution and control point, the Energy Science and Technology Software Center, at the time permission to assert copyright is given under paragraph (e)(2) of this clause --
- (A) An abstract describing the software suitable for publication; and  
(B) **Completed OSTI FORM**

**NOTE: Removed the source and object code requirements since OSTI doesn't usually want them if the lab is commercializing.**

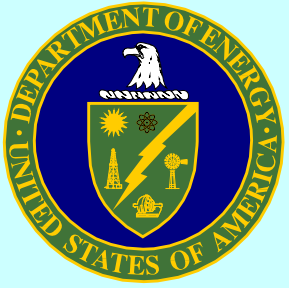


# Commercializing software

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- **WHEN LABORATORY ABANDONS SOFTWARE**

**(e)(3)(iv) After the period approved by Patent Counsel for application of the limited Government license describe in paragraph (e)(3)(iv) of this clause, or if, prior to the end of such period(s), the Contractor abandons commercialization activities pertaining to the data to which the Contractor has been given permission to assert copyright, the Contractor grants to the Government...(broad Government License)**

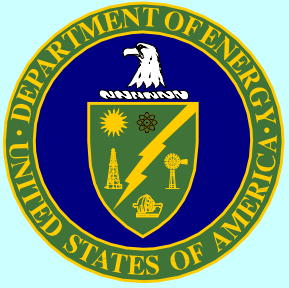


# Commercializing software

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- **WHEN LABORATORY ABANDONS SOFTWARE**

**(e)(3)(viii) At any time the Contractor abandons commercialization activities for data for which the Contractor has received permission to assert copyright in accordance with this clause, it shall advise OSTI and Patent Counsel and upon request assign the copyright to the Government so that the Government can distribute the data to the public. When the Contractor abandons commercialization activities, the Contractor will provide to the Energy Science and Technology Software Center the latest version of the copyrighted data (for example, source and object code for software, drawings or updated manuals). In addition, the Contractor will provide annually to local DOE Patent Counsel a list of all software that the Laboratory has abandoned commercial licensing activity during that year.**

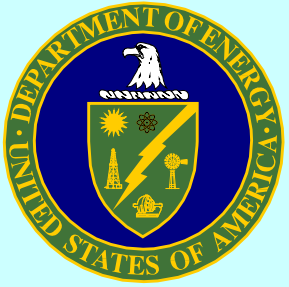


# IPI for Commercializing Software

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## Possible Internal Patent Instruction (IPI) issued for Lab's Commercial Software

- Patent Counsel has discretion on contacting DOE program for concurrence.
- Requirement that Laboratory assert there is no known issues with program funding or specify the issues such as DHS, OASCR/ASCI, specific project requirements.
- Patent Counsel approval applies to all versions funded by DOE (not DHS funded software)



# Open Source Software

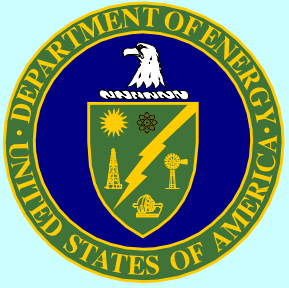
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## Section (f) Open software source.

### ***(1) Program notice or approval for copyright assertion for OSS.***

#### ***~~Obtaining funding source approval.~~***

(A) The Contractor **must give at least two week written notice to each** ~~shall ensure that the~~ DOE Program(s) that have provided funding (funding source(s)) to develop the software **that the Contractor intends to release the software as OSS unless the funding Program(s) has previously** provided blanket approval for all software developed with funding from that Program **or obligations under a specific DOE program overrides such release.** However, OSS release...the software, if any. **If DOE Program has neither objected nor responded to the Contractor's notification within two weeks, the Contractor may assert copyright in the software.** If notification of a funding DOE Program(s) is not practicable, the Patent Counsel may provide...



# Open Source Software

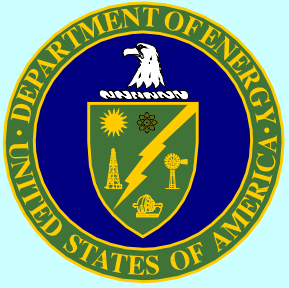
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Proposed deleting the following items:

- *(f)(9) Performance of periodic export control reviews by the Contractor.*
- *(f)(10) Determine if trademark protection for the OSS is appropriate.*

Laboratory abandons OSS

- ~~(12) Availability of original OSS~~ **Contractor Abandons OSS**. The object code and source code of the original OSS developed by the Contractor shall be available to any third party who request such from the Contractor for as long as such OSS is publicly available. If the Contractor ceases to make the software publicly available, then the Contractor shall submit to ESTSC the object code and source code of the latest version of the OSS...



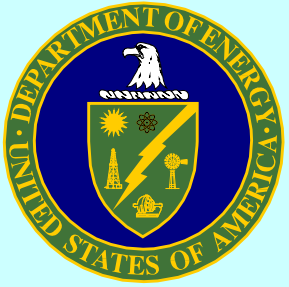
# DEAR 970.5227-3

## Tech. Transfer Mission

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### **(a) Authority.**

- **(3) Trademarks and service marks.** The Contractor is authorized to protect goods/services resulting from work at the Laboratory by Trademark and Service Marks. The Laboratory name and associated logos are owned by the Department of Energy and will be protected by DOE Patent Counsel. In furtherance of the technology transfer mission, should the Contractor want to assert trademark or service mark protection for any word, phrase, symbol, design, or combination thereof that includes or is associated with the Laboratory name, the Contractor must first notify the Department of Energy Patent Counsel. All marks, whether or not registered with the United States Patent and Trademark Office, are to be included in the “Intellectual property rights” in subparagraph (i), below, regarding transfer to successor contractor.



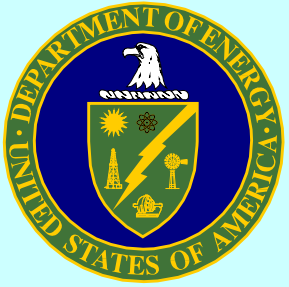
# DEAR 970.5227-3

## Tech. Transfer Mission

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### (n) *Technology transfer through CRADA. ...*

- (1) *Review and approval of CRADAs.* (i) Except as otherwise directed in writing by the Contracting Officer, each JWS shall be submitted to the Contracting Officer for approval. The Contractor's Laboratory Director... to assist the Contracting Officer in the approval determination. **With Contracting Officer approval, "review and approval" may be waived in lieu of performing periodic assessment of the Laboratory's CRADA process. Any such waiver should be based on pre-approved CRADA terms and conditions and may impose thresholds for "review and approval" based on dollar amounts, conflict of interest, high risk activities including human or animal subject testing, export controlled or classified information, environmental, health and safety concerns, etc.**



# DEAR 970.5227-3

## Tech. Transfer Mission

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### (n) *Technology transfer through CRADA. ...*

- (3) *Withholding of data.*
- (ii) Unless otherwise expressly approved by the Contracting Officer in advance for a specific CRADA, the Contractor agrees, at the request of the Contracting Officer, to transmit such data to other DOE facilities for use by DOE or its Contractors by or on behalf of the Government. When data protected pursuant to paragraph (n)(3)(i) of this clause is so transferred, the Contractor shall clearly mark the data with a legend setting out the restrictions against private use and further dissemination, along with the expiration date of such restrictions. **A final report, upon completion of a CRADA, shall be provided to DOE's Office of Scientific and Technical Information; reports marked as Protected CRADA Information will not be released to the public for a period up to five years, in accordance with the terms of the CRADA.**