

## Department of Energy

Washington, DC 20585

Date: April 5, 2007

Re: **TRADEMARK<sup>1</sup> APPLICATION AND LICENSING PROCEDURES, IPI**

Trademarks may be used by DOE or its contractors for identification of goods and services and serve as an intellectual property tool to enhance technology transfer. Registration in the PTO also helps to ensure that marks closely associated with DOE are not debased or devalued, and also helps to protect the public from those who may use marks closely associated with DOE to suggest "goods or services" are authorized by DOE. This IPI contains guidance on trademarks once the decision has been made to use a particular mark in commerce and obtain protection therefor. This IPI does not contain guidance as to when, in the first instance, a mark should be coined for association with a particular good/service, except at B.4 with respect to use of DOE as part of a mark.

### A. DOE OWNED TRADEMARKS

#### 1. When DOE has Ownership of Trademarks

- a. Proper names for DOE facilities, e.g., FERMILAB, NREL:  
DOE shall own the marks for the names of DOE facilities. DOE shall only license the marks to the Contractor responsible for managing and operating the facility for the duration of the contract
- b. Marks resulting from work by Government employees, such as GOGOs:  
The Government shall own marks coined by Government employees which are to be associated with DOE goods or services. DOE should only file a trademark application if the mark is being used in commerce by DOE or if DOE intends to use the mark in commerce, or intends to license the mark.
- c. Other marks as other circumstances dictate.

#### 2. Prosecution of the Application

- a. DOE attorneys will prosecute applications for DOE- owned marks. Prosecution may be handled by field counsel. Fees to the PTO for the trademark application may be statutorily waived under 15 U.S.C. §1113(b).
- b. The application will include all classes of potential use by DOE or its licensee or sublicensee.

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<sup>1</sup> "Trademarks" or "marks" as used herein will refer generally to all types of marks, including, e.g., service marks, collective marks, and other types of marks defined under 15 U.S.C. §1127, whether they are word marks or other types of marks.



3. Criteria for Licensing

See Appendix A for licensing considerations if it is desired to license a mark.

**B. CONTRACTOR OWNED MARKS**

1. When the Contractor has Ownership of Trademarks

- a. Marks for goods/services resulting from work at contractor operated labs:

Disposition of title to intellectual property, including trademarks is subject to the provisions of the prime contract. (See Technology Transfer Mission DEAR 970.5227.3) If the contractor retains ownership of a mark established in the performance of activities under the contract, the Government shall retain a license, and the contractor shall be required to assign the mark to its successor or to the Government as directed by the Contracting Officer. DOE Counsel should ensure that assignments of marks are executed by an appropriate laboratory official and are recorded in the U.S. Patent and Trademark Office.

The license retained by the Government shall contain the following language:

The Government shall have the right to indicate on any similar goods or services produced by or for the Government that such goods or services were derived from and are a DOE version of the goods or services protected by such mark, with the mark and the owner thereof being specifically identified. In addition, the Government shall have the right to use or have used on its behalf such mark in print or communication media.

- b. Marks created as a result of work performed under CRADAs:

The terms of a particular CRADA will control issues of ownership. The preferred provisions are found in the DOE CRADA Manual, DOE M 483.1 which specifically address trademarks that arise under CRADAs. As updated versions of the modular CRADA are implemented, however, those updated provisions will be applicable.

2. Prosecution of the Application

The Contractors shall be responsible for handling the prosecution of marks belonging to the Contractors. DOE Field Counsel will be responsible for approving the adequacy of the terms of the Government license.

3. Criteria for Licensing

See Appendix A

4. Special attention shall be given to any mark whether or not to be registered which suggests an association with DOE, such as by including the word DOE or the name of a laboratory in the mark. Headquarters should be consulted about any mark implying an association with DOE or a laboratory.

**C. ASSIGNMENT OF MARKS WHERE LAB IS NO LONGER UNDER A LONG TERM AGREEMENT WITH DOE**

Proper names for DOE facilities, e.g. Fermilab, NREL

The new owner of the facility shall not receive an assignment of the mark or name of the facility without DOE Headquarters approval.

**D. FOREIGN RIGHTS**

The foregoing rules regarding the ownership of marks and the prosecution of the application also apply to foreign rights in marks.

**E. USE OF TRADEMARK SYMBOL**

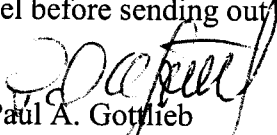
For all uses of any mark by the Government, contractor, licensee or sublicensee, the mark shall be accompanied with a superscript "TM" if not registered on the principal register in the PTO, or else a "®" if registered on the principal register.

**F. ENDORSEMENTS**

Per 5 CFR 2635.702 no DOE official shall acquiesce in the use of a name associated with DOE for any product, service or enterprise without the prior approval of the designated agency ethics official (i.e., the Assistant General Counsel for General Law).

**G ENFORCEMENT**

In the event it is discovered that another is found to be without authority using a DOE or Contractor-owned mark, whether or not that mark has been registered, the owner of the mark shall notify in writing the unauthorized user which activities are believed to be infringing, and request that the user cease those activities. For Contractor-owned marks, the Contractor shall obtain: approval from the appropriate Field Patent Counsel before sending out such notification.

  
Paul A. Gottlieb  
Assistant General Counsel

for Technology Transfer and Intellectual Property

## APPENDIX A

### I. Criteria for Licensing

- a. The product or service shall promote either the DOE mission in a particular area of research and development or the specific DOE program from which the mark developed.
- b. A disclaimer of DOE endorsement will be included in the license agreement.
- c. A definite termination date will be included in the license agreement. The termination of a prime contract is an appropriate termination date.
- d. Non-profit organizations may use the requested mark without charge when the proposed use contributes to public service and/or public education. DOE written permission is required for non-profit use.
- e. Royalty payments will be made if the licensee acquires income from use of the mark. A percentage of sales shall determine royalty payments.
- f. Licensee agrees to inform DOE of any improper use of the mark by others.
- g. Product liability remains with licensee.
- h. DOE retains the right to revoke the license if the licensee does not adhere to the agreement's terms and conditions.
- i. Assignment or transfer of the license is permitted by prior written approval by DOE.
- j. Sublicensing is permitted by prior written approval by DOE. -
- k. Where applicable, the licensee agrees to meet public demand for the product or service produced under the mark.

### II. Policing of licensed marks

- a. Licensees must comply with DOE directives, issued through the DOE Contracting Officer, in facilitating DOE's control of the nature and quality of goods or services sold or rendered by licensee and any of its sublicensees, to permit reasonable inspection of licensee's operations and to supply DOE with specimens of all uses of the marks upon request. Licensee shall comply with all applicable laws and regulations.
- b. Each program director controls the policing of the mark developed in that program. When an infringement occurs, the program director informs the Office of General Counsel.

### III. Additional criteria for licensing of Contractor marks are:

- a. The DOE Contracting Officer/field officer should review a specimen of the good/service to be associated with the mark by the licensee to ensure DOE's reputation will not be debased by the proposed use.

- b. A disclaimer of DOE endorsement will be part of the license agreement.
- c. Product liability shall remain with the licensee.