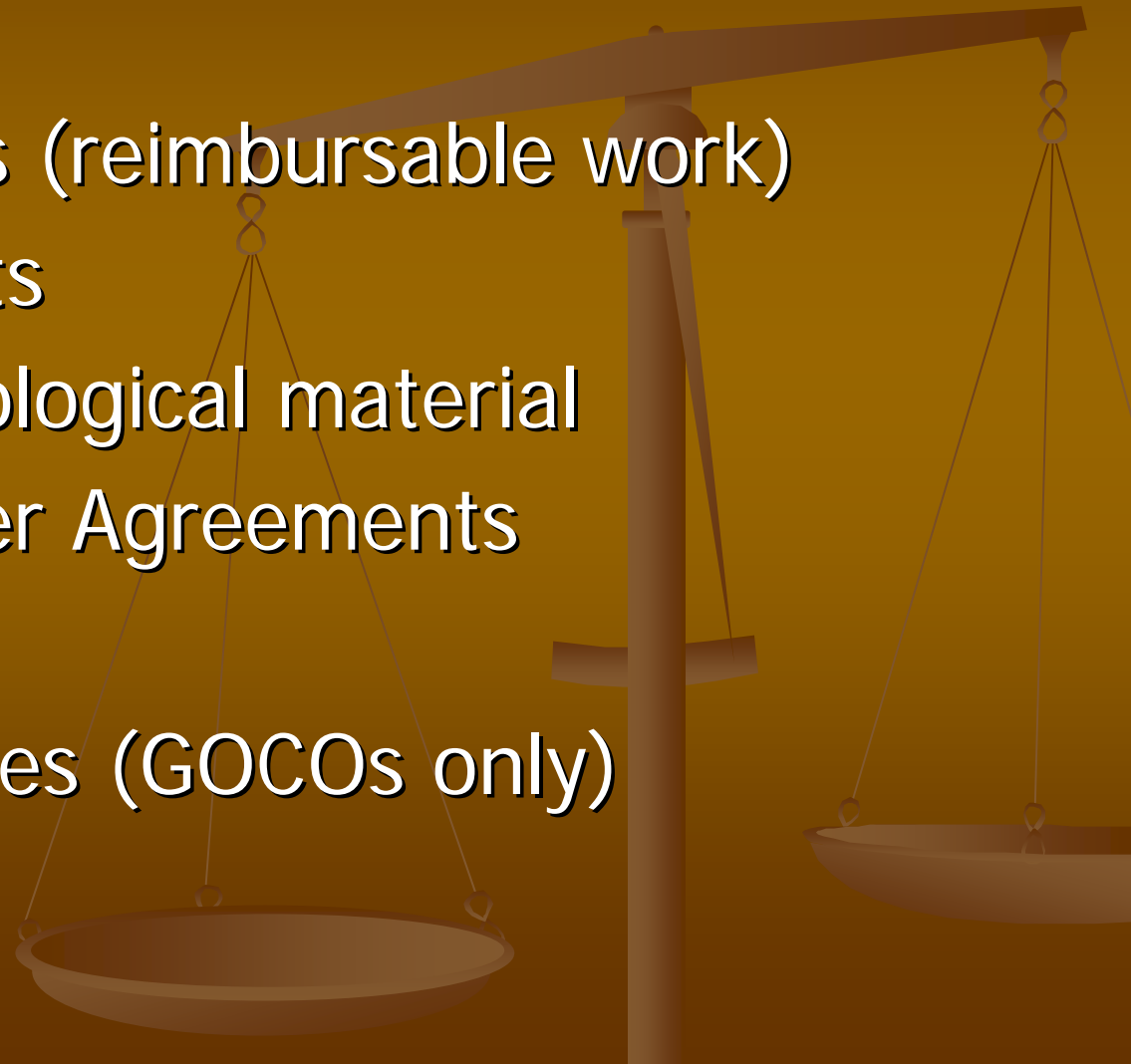


# International Technology Transfer at DOE National Laboratories: types of transactions and the rules that govern them

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# Type of Technology Transfer transactions at DOE labs

- CRADAs
- Work for Others (reimbursable work)
- User agreements
- Bailments of Biological material
- Material Transfer Agreements
- Patent Licenses
- Software Licenses (GOCOs only)



# Controlling references

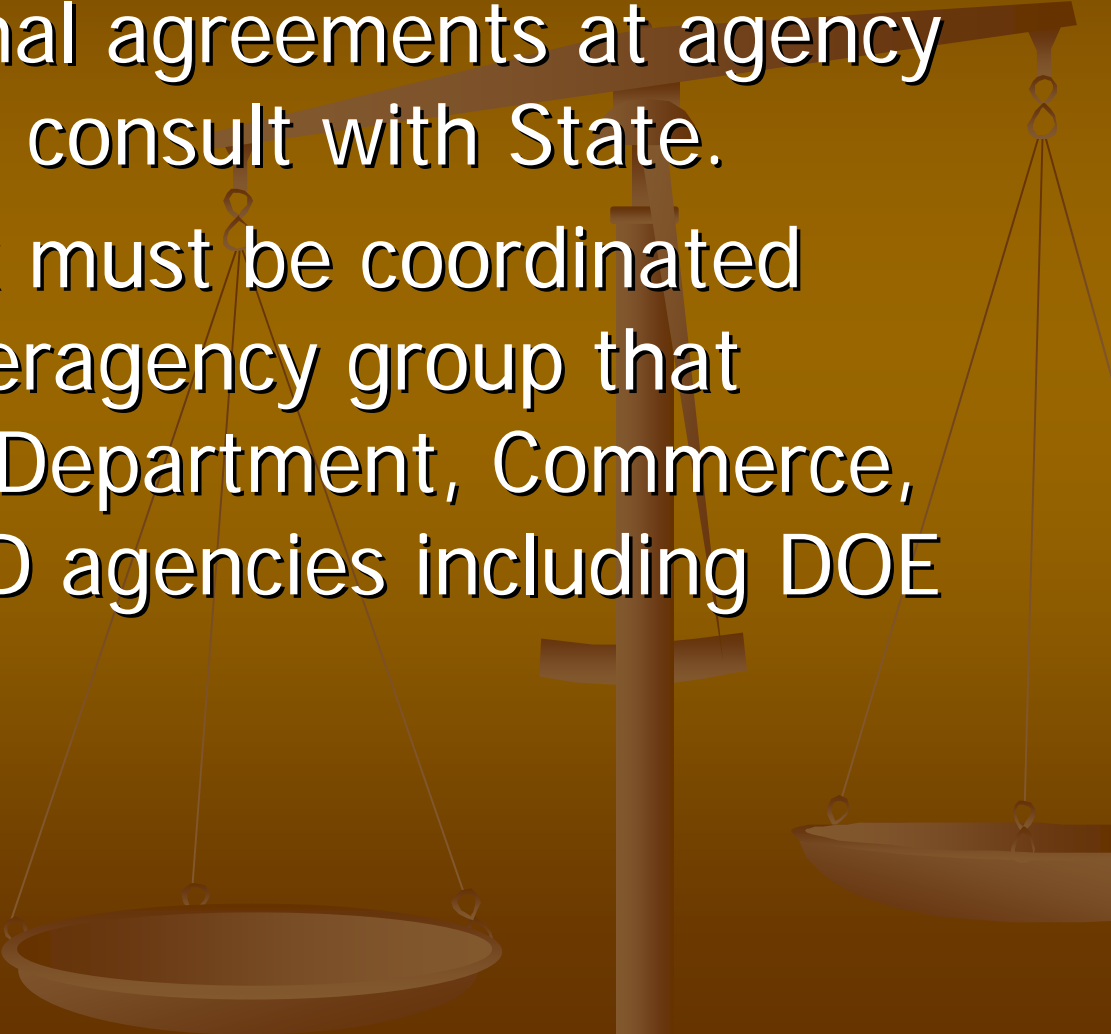


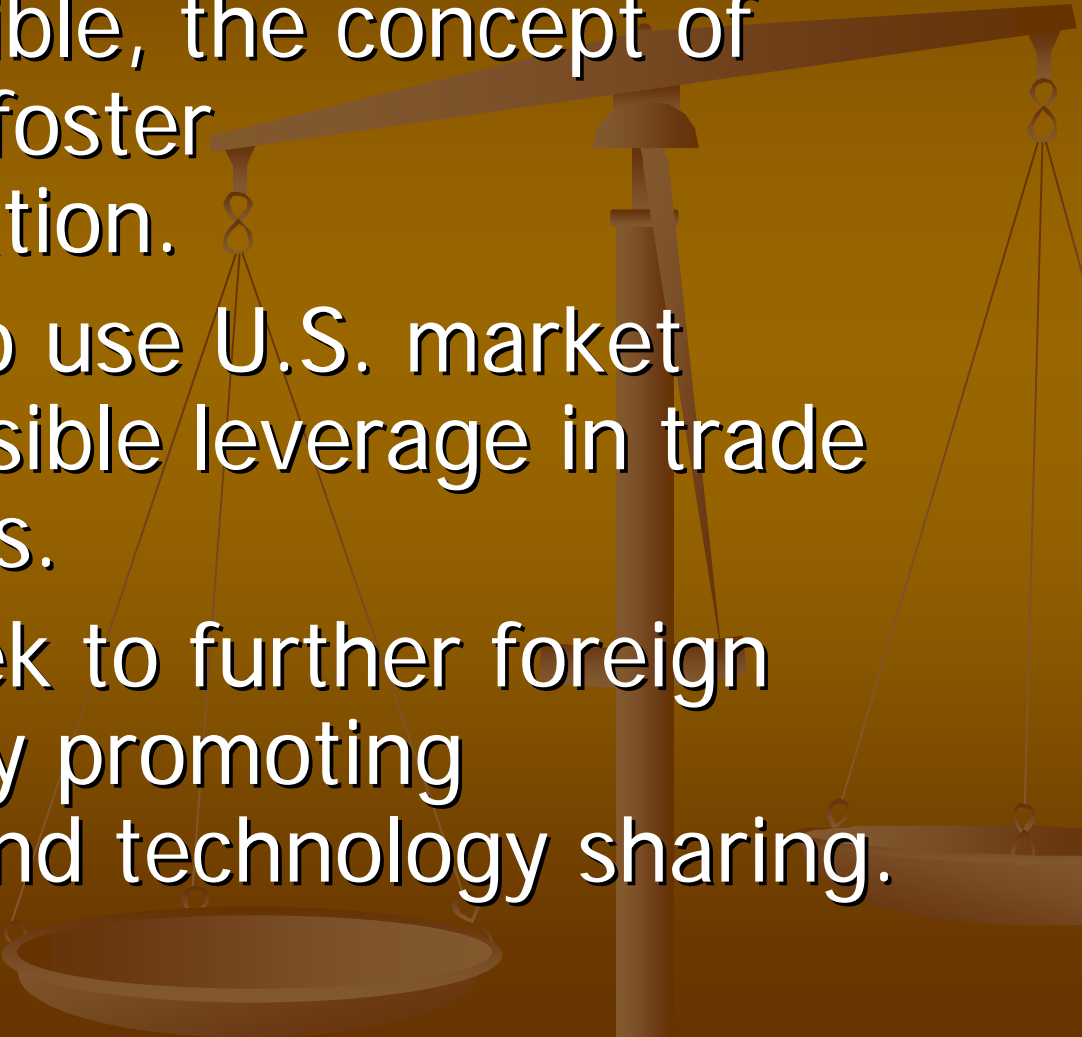
- An International Agreement which covers the scope of work of or governs the proposed transaction
- General Laws and regulations
  - Licensing of Government owned inventions
  - Export control
  - Security
- DOE laboratory operating contract clauses

An International Agreement which covers the scope of work of or governs the proposed transaction

- Government-to-Government agreements, providing for cooperation in science and technology, including joint research

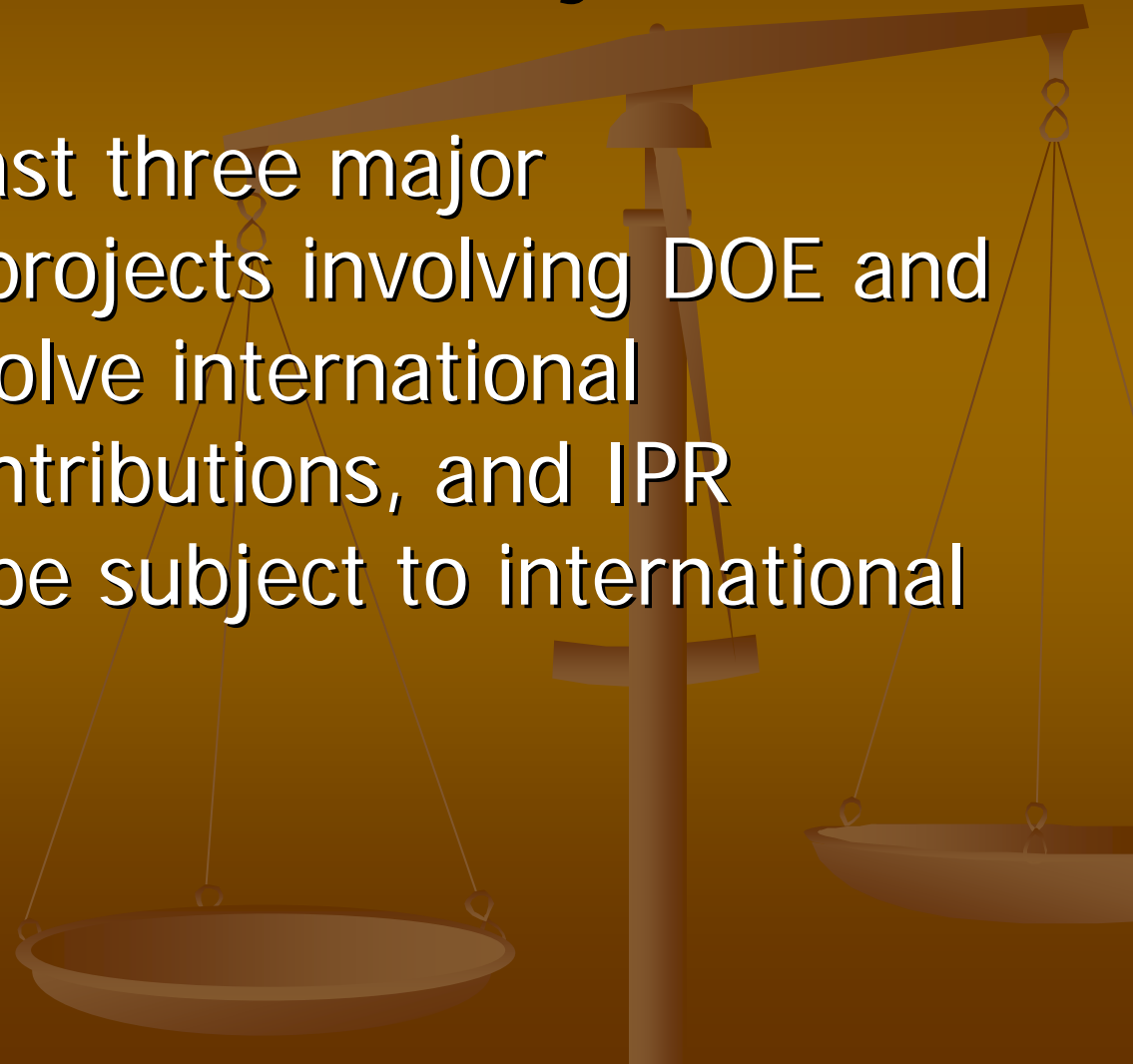


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- DOE has statutory authority to enter into international agreements at agency level, but must consult with State.
  - The IPR Annex must be coordinated through an interagency group that includes State Department, Commerce, USTR, and R&D agencies including DOE

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- Commerce seeks to preserve, as much as possible, the concept of exclusivity to foster commercialization.
  - USTR seeks to use U.S. market access as possible leverage in trade and IP matters.
  - State may seek to further foreign policy goals by promoting cooperation and technology sharing.

# DOE International Demonstration Projects

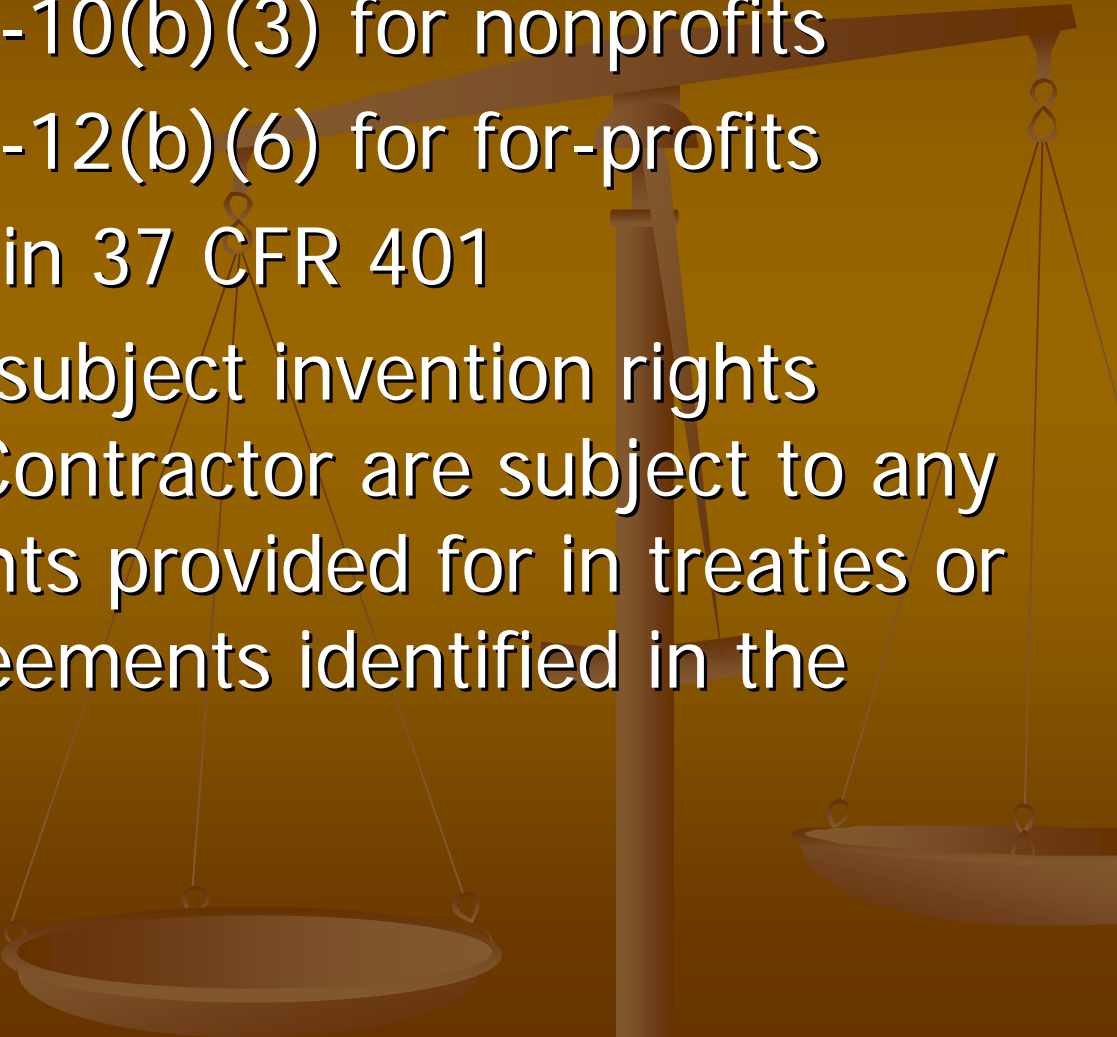
- Currently, at least three major demonstration projects involving DOE and its labs may involve international Government contributions, and IPR disposition will be subject to international agreements.



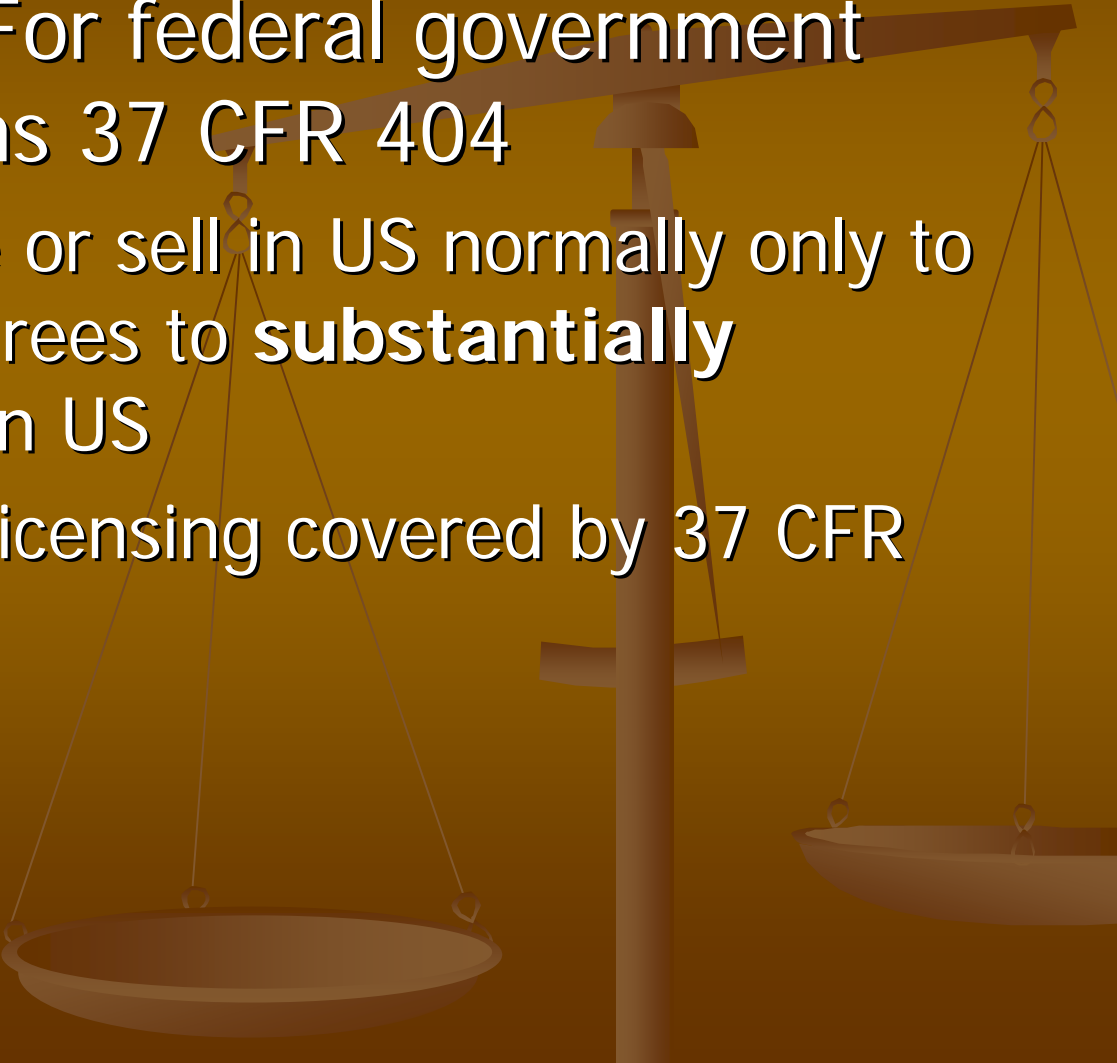
# ITER

- IPR Annex currently being negotiated. International partners, which have been proceeding without U.S. for last six years, favor explicit guarantee of nonexclusive commercial license rights, at least in its home territory, regardless of ownership of IP. Also favor some guaranteed access to background IP of other parties (and their contractors).
- ITER project likely to involve DOE labs at Princeton, Oak Ridge and Sandia, and perhaps others

# Contract Implementation

- 48 CFR 970.5227-10(b)(3) for nonprofits
  - 48 CFR 970.5227-12(b)(6) for for-profits
  - Similar language in 37 CFR 401
  - Provide that any subject invention rights acquired by the Contractor are subject to any disposition of rights provided for in treaties or international agreements identified in the contract
- 

# General Laws and regulations

- Licensing regs. For federal government owned inventions 37 CFR 404
    - Any right to use or sell in US normally only to licensee who agrees to **substantially manufacture** in US
    - Foreign patent licensing covered by 37 CFR 404.7 (b)
- 

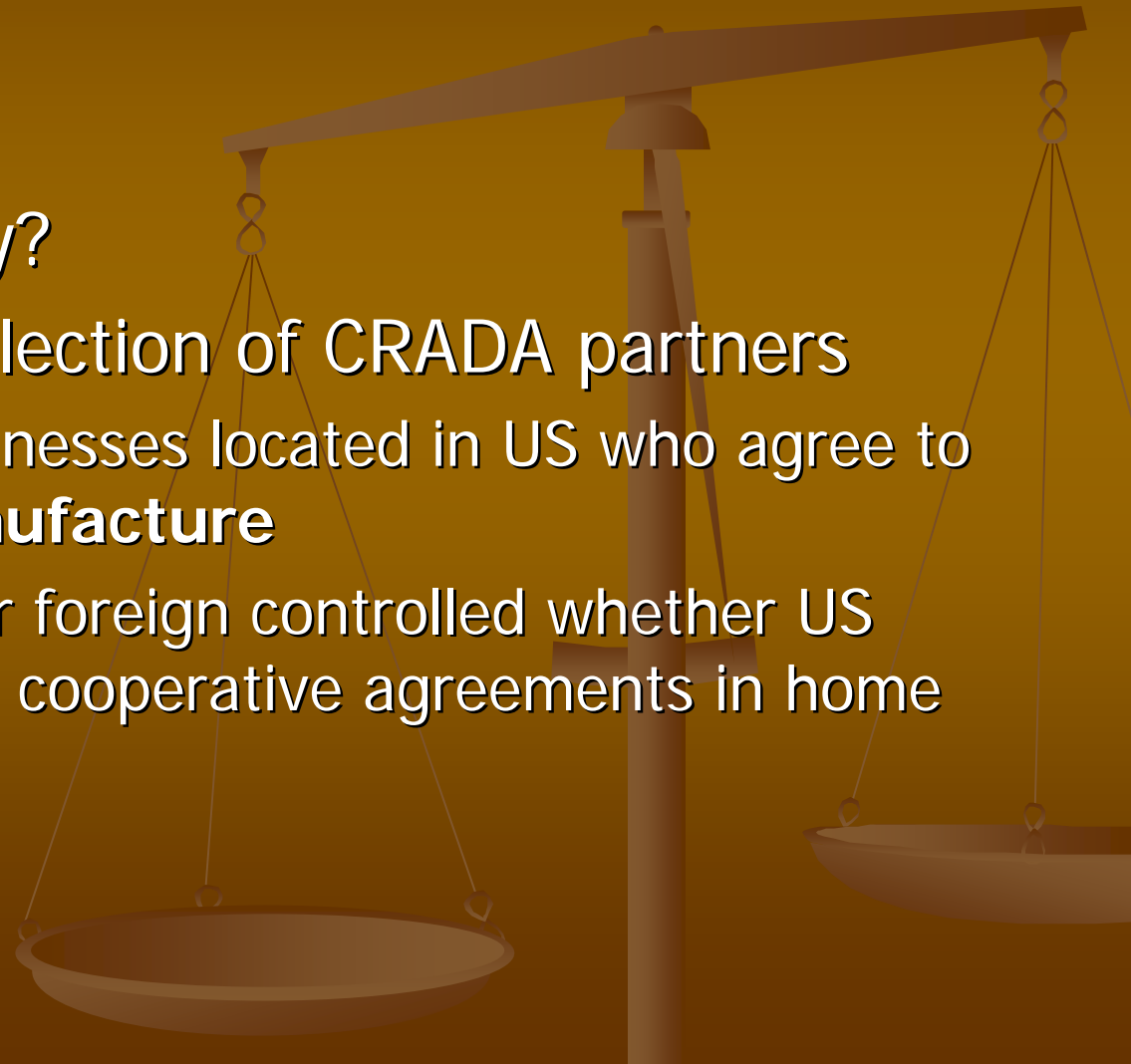
# General Laws and regulations



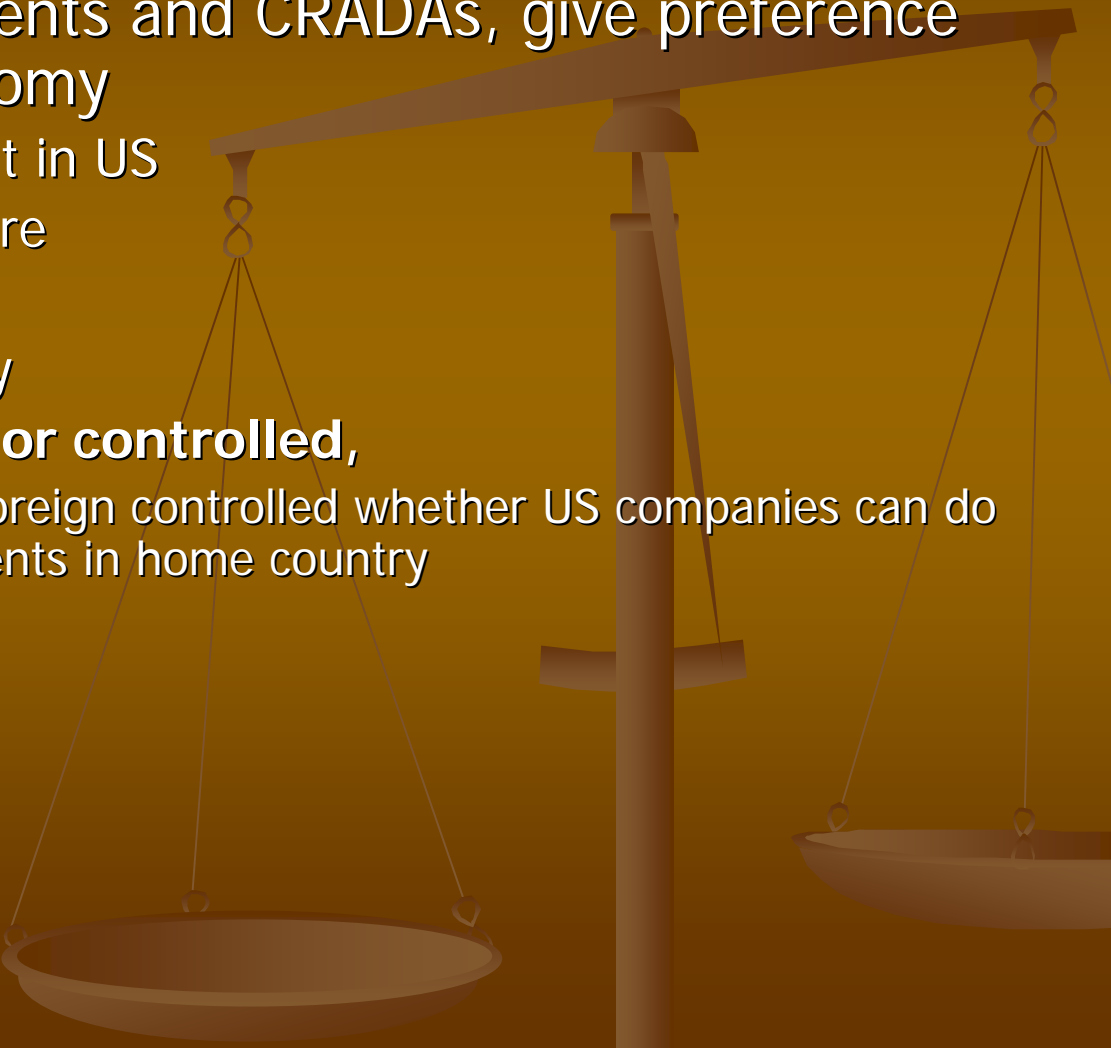
- Executive Order 12591, Section 4. International Science and Technology
  - CRADAs and Licenses
  - **With foreign persons or industrial organizations directly or indirectly controlled by foreign company or government**
  - Consultation with USTR
  - Consider
    - Whether US entities have equal access to foreign cooperative arrangements
    - Foreign country protects US IP
    - Foreign government protects export controlled technology

# General Laws and regulations

- Export control
- Security laws
- Homeland security?
- 15 USC 3710a, Selection of CRADA partners
  - Preference to businesses located in US who agree to **substantial manufacture**
  - Consider if partner foreign controlled whether US companies can do cooperative agreements in home country



# DOE Laboratory contractor contract clauses

- For licenses, assignments and CRADAs, give preference to benefit to US economy
    - Design or development in US
    - Substantial manufacture
    - Business unit in US
    - Benefit to US economy
    - And, **foreign owned or controlled**,
      - Consider if partner foreign controlled whether US companies can do cooperative agreements in home country
      - US IP protected
      - Consult with USTR
  - Export control
  - Security Laws
- 

# DOE CRADAs

- U.S. competitiveness provisions are negotiated upfront as part of the CRADA, DOE labs do not wait for the invention license to negotiate US competitiveness
    - Substantial manufacture
    - Net or alternate benefit: share technology, nature of market, other mission goals, etc.
  - EUV CRADA: Chip making machine
    - Net benefit market determined by chip user or chip maker?
    - vital national technology?
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