

APPENDIX 4

CLASS DEVIATION § 910.362 INTELLECTUAL PROPERTY

§ 910.362 Intellectual property.

(a) Scope. This section sets forth the policies with regard to disposition of rights to data and to [inventions](#) conceived or first actually reduced to practice in the course of, or under, a grant or cooperative agreement made to a For-Profit entity by DOE.

(b) Patents right - small business concerns. In accordance with [35 U.S.C. 202](#), if the recipient is a small business concern and receives a grant, cooperative agreement, subaward, or contract for [research](#), developmental, or [demonstration](#) activities, then, unless there are “exceptional circumstances” as described in [35 U.S.C. 202\(e\)](#), the award must contain the standard clause in 37 CFR.401.14 [~~appendix A to this subpart, entitled “Patents Rights (Small Business Firms and Nonprofit Organizations)”~~] which provides to the recipient the right to elect ownership of [inventions](#) made under the award. DOE patent counsel shall provide appropriate intellectual property provisions incorporating 37 C.F.R. 401.14 suitably modified, for example incorporating DOE’s title taking authorities (e.g., 42 U.S.C. 5908) in (g) subcontracts.

(c) Patent rights - other than small business concerns, e.g., large businesses -

(1) No Patent Waiver. Except as provided by [paragraph \(c\)\(2\)](#) of this section, if the recipient is a for-profit organization other than a small business concern, as defined in [35 U.S.C. 201\(h\)](#) and receives an award or a subaward for [research](#), development, and [demonstration](#) activities, then, pursuant to statute, the award must contain the standard clause in appendix A to this subpart, entitled “Patent Rights (Large Business Firms) - No Waiver” which provides that DOE owns the patent rights to [inventions](#) made under the award. DOE patent counsel shall provide the standard clause in appendix A to this subpart, entitled “Patent Rights (Large Business Firms) - No Waiver” with any modifications as necessary, for example including enhanced U.S. Manufacturing requirements.

(2) Patent Waiver Granted. [Paragraph \(c\)\(1\)](#) of this section does not apply if:

(i) DOE grants a class waiver for a particular program under [10 CFR part 784](#);

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(ii) The applicant requests and receives an advance patent waiver under [10 CFR part 784](#); or

(iii) A subaward is covered by a waiver granted under the prime award.

(3) *Special Provision.* Normally, an award will not include a background patent and data provision. However, under special circumstances, in order to provide heightened assurance of commercialization, a provision providing for a right to require licensing of third parties to background inventions, limited rights data and/or restricted computer software, may be included. Inclusion of a background patent and/or a data provision to assure commercialization will be done only with the written concurrence of the DOE program official setting forth the need for such assurance. An award may include the right to license the Government and third party contractors for special Government purposes when future availability of the technology would also benefit the government, *e.g.*, clean-up of DOE facilities. The scope of any such background patent and/or data licensing provision is subject to negotiation.

(d) *Rights in data - general rule.*

(1) Subject to paragraphs (d)(2) and (3) of this section, and except as otherwise provided by paragraphs (e) and (f) of this section or other law, any award under this subpart must contain the standard clause in appendix A to this subpart, entitled “Rights in Data - General”.

(2) Normally, an award will not require the delivery of limited rights data or restricted computer software. However, if the contracting officer, in consultation with DOE patent counsel and the DOE program official, determines that delivery of limited rights data or restricted computer software is necessary, the contracting officer, after negotiation with the applicant, may insert in the award the standard clause as modified by Alternates I and/or II set forth in appendix A to this subpart.

(3) If software is specified for delivery to DOE, or if other special circumstances exist, *e.g.*, DOE specifying “open-source” treatment of software, then the contracting officer, after negotiation with the recipient, may include in the award special provisions requiring the recipient to obtain written approval of the contracting officer prior to asserting copyright in the software, modifying the retained Government license, and/or otherwise altering the copyright provisions.

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(e) *Rights in data - programs covered under special protected data statutes.*

(1) If a statute, other than those providing for the Small Business Innovation [Research](#) (SBIR) and Small Business Technology Transfer [Research](#) (STTR) programs, provides for a period of time, typically up to five years, during which data produced under an award for [research](#), development, and [demonstration](#) may be protected from public disclosure, then the contracting officer must insert in the award the standard clause in appendix A to this subpart entitled “Rights in Data - Programs Covered Under Special Protected Data Statutes” or, as determined in consultation with DOE patent counsel and the DOE program official, a modified version of such clause which may identify data or categories of data that the recipient must make available to the public.

(2) An award under [paragraph \(e\)\(1\)](#) of this section is subject to the provisions of paragraphs (d)(2) and (3) of this section.

(f) *Rights in data - SBIR/STTR programs.* If an applicant receives an award under the SBIR or STTR program, then the contracting officer must insert in the award the standard data clause in the General Terms and Conditions for SBIR Grants, entitled “Rights in Data - SBIR Program”.

(g) *Authorization and consent.*

(1) Work performed by a recipient under a grant is not subject to authorization and consent to the use of a patented [invention](#), and the Government assumes no liability for patent infringement by the recipient under [28 U.S.C. 1498](#).

(2) Work performed by a recipient under a cooperative agreement is subject to authorization and consent to the use of a patented [invention](#) consistent with the principles set forth in [48 CFR 27.201-1](#).

(3) The contracting officer, in consultation with patent counsel, may also include clauses in the cooperative agreement addressing other patent matters related to authorization and consent, such as patent indemnification of the Government by recipient and notice and assistance regarding patent and copyright infringement. The policies and clauses for these other patent matters will be the same or consistent with those in [48 CFR part 927](#). DOE Patent Counsel shall provide appropriate

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intellectual property provisions incorporating other patent matters related to authorization and consent, such as patent indemnification of the Government by recipient and notice and assistance regarding patent and copyright infringement.