



Agreements for Commercializing Technology as a Technology Transfer Tool

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PNNL is operated by Battelle for the U.S. Department of Energy



ACT agreements

- Authorized under Atomic Energy Act authority for performing work for others (42 USC 2011 et. seq)
- Allows Lab Contractors to bridge the Gap between obligations and requirements that DOE mandates while contracting with other parties for access to DOE laboratory resources and personnel on a non-interference basis.
- FFRDC requirements still in play (cannot compete with the private sector)
- Lab Contractor responsible and liable for all obligations and damages to DOE, but can make arrangements to address (fee, insurance, other agreements)
- IP allocated by specific class waiver
- No obligations can be placed on Government

Advantages

- Labs can take on risk and negotiate with third parties
- Can use third party's paper as a starting point and negotiate terms (only two clauses must be added (disclaimer and reference to IP class waiver))
- Reduced cycle times
- Helps persons who are unfamiliar with national labs by allowing the lab contractor to serve as an intermediary and helper in the process
- Allows for lab contractors to find easy solutions to issues like
 - indemnification,
 - advance payment,
 - Performance guarantees (fixed price)
 - IP reporting obligations

Technology Transfer Mechanisms at DOE Facilities



Agreement	Use	Funding	Subject Inventions	Generated Data	U.S. Competitiveness	Cost	Highlights
Cooperative Research and Development Agreement (CRADA)	Collaborative research between DOE Labs and public and/or private entities for the mutual benefit of the parties	Non-Federal and/or Federal funds	Lab and Participant may elect their own inventions and Participant has right to negotiate exclusive license to Lab inventions	Protected for up to 5 years	Products embodying IP resulting from CRADA shall be manufactured substantially in the U.S.	Lab and Participant may share costs or Participant pays 100% funds-in	<ul style="list-style-type: none"> ✓ Collaborative research ✓ 5 year data protection ✓ Designed for multi-party collaborative research
Strategic Partnership Projects (SPP)	Work for businesses and other non-federal entities using highly specialized or unique DOE facilities, services or technical expertise	Non-Federal funds	Sponsor may elect title to Subject Inventions ²	Protected as Sponsor's proprietary data w/limited exceptions ^{1,2,3}	U.S. Preference: Sponsor agrees not to grant any party exclusive right to use or sell products embodying Subject Inventions in the U.S. unless products are manufactured substantially in the U.S.	Sponsor pays full cost recovery	<ul style="list-style-type: none"> ✓ Sponsor typically retains right to elect title to subject inventions ✓ Generated data treated as proprietary ✓ Option for limited Gov. R&D license²
		Federal funds	Lab may elect title to Subject Inventions of the Lab	Unlimited Gov. rights	U.S. Preference (see above)	Sponsor pays full cost recovery	<ul style="list-style-type: none"> ✓ Access to unique facilities and expertise using federal funds
Agreements for Commercializing Technology (ACT)	Work for businesses and other non-federal entities using highly specialized or unique DOE facilities, services or technical expertise	Non-Federal funds	Initial title to the designated IP Lead. (ACT Participant or Lab Contractor)	Protected as proprietary data w/limited exceptions ^{1,2,3}	U.S. Preference (see above)	Participant pays full cost recovery plus additional negotiated compensation to the Contractor	<ul style="list-style-type: none"> ✓ Flexibility for addressing indemnity & adv. payment ✓ Negotiable IP terms ✓ Optional performance guarantee ✓ Option for limited Gov. R&D license³
		Federal funds	Lab may elect title to Subject Inventions of the Lab	Unlimited Gov. rights	U.S. Preference (see above)		
Proprietary User Agreement ⁴	User may access designated facilities to conduct its own proprietary research	Non-Federal funds	User may elect title to its Subject Inventions	User may protect as proprietary	n/a	User pays approved user rate	<ul style="list-style-type: none"> ✓ Generated data treated as proprietary ✓ Merit based access to unique facilities
Non-Proprietary User Agreement ⁴	Non-proprietary research at designated facilities	n/a	Lab and User may elect their own Subject Inventions	Unlimited Gov. Rights	U.S. Preference (see above)	Each party covers own cost	<ul style="list-style-type: none"> ✓ Merit based access to unique facilities

Certification: The Lab provided this DOE technology transfer matrix and explained all the options available including the availability of SPP agreements and CRADAs. The Lab is also disclosing the relative cost differential of +1% in performing the proposed scope of work under ACT, versus a non-federal/SPP agreement or a CRADA (not including any fee the Contractor is authorized to include under ACT).

By: _____ (Sponsor/Participant/User Name)

Signature: _____ Date: _____

Hurdles

- Lab Contractors must be able to assess and be willing to take on risk including risk of non-compliance with DOE
- Lab Contractors must learn to think more like business persons and keep multiple parts of the transaction/ interaction in mind
- Lab Contractors and DOE site offices must become familiar with procedures and metes and bounds
- Not a solution to all problems but rather another tool in the tool kit for working with third parties