

Legal Considerations: Intellectual Property, Data, and Reporting

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Overview of Patent Rights in ARPA-E Awards

- The goals of DOE/ARPA-E patent provisions are:
 - Strengthen U.S. energy and economic security
 - Maintain or establish U.S. scientific and engineering leadership in key energy fields
 - Encourage development, manufacture, and deployment of new inventions in the U.S.
 - Establish new industries
 - Strengthen the U.S. manufacturing base
 - Create new sources of employment
 - Retention of limited government rights for use of inventions and data by the US government.
 - Maximize the retention of IP rights in awardees to facilitate commercialization
- Certain patent requirements and rights are mandated by law, regulation, or policy as the quid pro quo for the recipient receiving financial assistance.
- Under certain circumstances, there is some flexibility to vary from the standard patent requirements and rights

Patent Rights Clause

- CONSULT YOUR PATENT COUNSEL
- If you elect to retain title to an invention, you must file a patent application.
- Government Patent Rights:
 - Government license: Royalty-free right to practice invention by or on behalf of the Government
 - March-in Rights: Insurance Policy that you will commercialize the invention
 - Require substantial manufacture in the U.S. for any use or sale worldwide
 - U.S. Preference in licensing: Grant of exclusive right to use or sell invention in U.S. must be to party who agrees to substantially manufacture in the U.S

U.S. Competitiveness Provision

- Required by DOE-wide Determination of Exceptional Circumstances (DEC) under the Bayh-Dole Act to Further Promote Domestic Manufacture of DOE Science and Energy Technologies executed by DOE on June 7, 2021.
- All recipients' (prime and sub) awards contain a U.S. Competitiveness clause under which each recipient agrees that any products embodying any subject invention or produced through the use of any subject invention will be manufactured substantially in the United States.
- Such requirement may be modified upon a showing that domestic manufacturing is not feasible; however, other benefits to the U.S. economy must be demonstrated – review section VI.B.8 of the FOA.
- Recipients further agree not to license, assign or otherwise transfer any subject invention to any entity, at any tier, unless that entity agrees to the same requirements.
- Review Attachment 2 to your award in its entirety, including the Preference for United States Industry clause.

Technical Data Types

- **Limited Rights Data** is proprietary data that was developed at private expense before you received this award. The Federal Government does not have any rights to this data, unless the parties negotiate rights. To protect Limited Rights Data, you should not disclose it to ARPA-E, unless it is necessary for us to evaluate your work under the award. If you anticipate the need to deliver Limited Rights Data, you should notify DOE patent counsel.
- **Unlimited Rights Data** is data produced under the award that is suitable for immediate public release. Data produced under government sponsorship is generally classified as public information.
- **Protected Data** is data produced under the award that is protected from public release for a limited period of time. You may be eligible to designate data first produced under the conduct of this award as Protected Data; such data may be protected from public release for a period of 10 years from the time it is first produced. Automatically authorized for for-profit awardee. Others must request that right.
- **SBIR/STTR Data** is data first produced in an SBIR/STTR award that is protected from public release and includes certain limitations on Government use.

IP and Data Management Plans

- IP Management portion required when there is more than one team member. Data Management portion required for every award even if there is only one party.
- The IP and Data Management Plan is due 6 weeks after the award is made
- Starting point is that each team member performing R&D must have an appropriate IP attachment 2 included in their award (or the equivalent for an FFRDC) which each address IP issues between each team member and DOE/ARPA-E
- ARPA-E has posted a model template on the ARPA-E website
- Must include statement that award takes precedence over the IP and Data Management Plan
- Addresses IP issues between team members:
 - Data management/Sharing of technical data
 - Dealing with joint inventions
 - Licensing of technology
 - Dispute resolution

Reporting Requirements (overview)

- **IP and Data Management Plans** – within 6 weeks of award
 - Submitted in ARPA-E ePIC - <https://arpa-e-epic.energy.gov/>
- **Intellectual Property Reporting** – subject inventions, elections to retain title, patent filings (timelines vary)
 - Submitted in iEdison - <https://www.nist.gov/iedison>
- **Subject Invention Utilization** – annual reports throughout project and for 10 years after
 - Submitted in iEdison - <https://public.era.nih.gov/iedison/index.jsp>