



Fact Sheet for Large Businesses:

Your Obligation to Report Subject Inventions, Election of Title, Publications, and Patent Filings

GENERAL INSTRUCTIONS

<p>What am I required to report to ARPA-E and DOE?</p>	<p>You are required to notify the Advanced Research Projects Agency – Energy (ARPA-E) and Department of Energy (DOE) of the following matters arising under your funding agreement:</p> <ol style="list-style-type: none"> 1. Any invention that you conceive or first actually reduce to practice in the course of or under your funding agreement (referred hereto as “subject inventions”), including anticipated public uses and sales of the subject invention. Following the initial notification, you are required to keep ARPA-E and DOE apprised of any further developments regarding the sale or public use of the subject invention. 2. Whether you elect to retain title to the subject invention. 3. Any publications disclosing a subject invention, manuscripts disclosing a subject invention submitted for publication, or other public disclosures of the subject invention. You are required to report manuscript submissions, regardless of whether a manuscript is accepted for publication. 4. Filing of domestic and foreign patent applications. 5. Requests for extension of time to elect title to subject inventions and file patent applications. 6. Decisions to discontinue prosecution of a patent application, maintenance of a patent, or defense in reexamination or opposition proceedings arising from work performed under your award or work authorization.
<p>How do I notify ARPA-E and DOE of these matters?</p>	<p>You must notify DOE of the above matters in writing by either:</p> <ul style="list-style-type: none"> • Submitting a completed ARPA-E Notice of Invention, Publication, Patent, and Title Election to both of the following email addresses: GC-62@hq.doe.gov and ARPA-E-Counsel@hq.doe.gov. This form may be used to report Items 1-6 above, and is available on the ARPA-E website at http://arpa-e.energy.gov/FundingAgreements/Overview/Award.aspx#Intellectual Property Reporting • Using the Interagency Edison (iEdison) system to report Items 1-4, above. You may access the iEdison system here: https://s-edison.info.nih.gov/iEdison/.
<p>Who should I contact if I have questions regarding IP reporting requirements?</p>	<p>Please direct all inquiries regarding IP reporting and disclosure requirements to both of the following email addresses: GC-62@hq.doe.gov and ARPA-E-Counsel@hq.doe.gov. For urgent matters, please contact the DOE IP Attorney assigned to your project.</p>

REPORTING SUBJECT INVENTIONS

<p>What is the timeframe for notifying DOE of my subject inventions?</p>	<p>You must notify DOE of each subject invention:</p> <ul style="list-style-type: none"> • <u>within six months</u> after conception or first actual reduction to practice and • <u>before</u> the planned sale, public use, or public disclosure of the invention.
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What should my notification consist of?	Your written notification should include the award under which the invention was made and the name(s) of the inventor(s). The report must be sufficiently complete in technical detail to convey a clear understanding, to the extent known at the time of the disclosure, of the nature, purpose, operation, and physical, chemical, biological, or electrical characteristics of the invention. The disclosure shall also identify any publication, sale or public use of the invention and whether a manuscript describing the invention has been submitted for publication and, if so, whether it has been accepted for publication at the time of disclosure.
What happens if I fail to disclose the subject invention?	The Federal Government may obtain title to the subject invention.

TITLE ELECTION

When do I have to decide whether I want to retain title to the invention?	You must notify DOE and ARPA-E in writing as to those countries (including the United States) whether or not you will retain title at the time of disclosure or <u>within 8 months</u> of disclosure. You must also elect in writing whether or not to retain title when filing a domestic continuation-in-part patent application. If publication, sale, or public use of the subject invention has initiated the one-year statutory period for filing a patent, DOE may require you to report your title election decision <u>at least 60 days</u> prior to the end of the statutory period.
What happens if I fail to elect title within the established timeframe?	The Federal Government may obtain title to the subject invention.

Can I request an extension of time for notifying ARPA-E and DOE of my title election decision?	Yes. You may request an extension of time if you have not previously publicly disclosed the subject invention by publication or other means. All requests for an extension of time should be submitted to both of the following email addresses: GC-62@hq.doe.gov and ARPA-E-Counsel@hq.doe.gov . DOE and ARPA-E will decide whether to grant an extension and notify you accordingly. Your request for extension will be considered in light of applicable statutory periods, such as the one-year statutory period for filing a patent.
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PUBLICATIONS, MANUSCRIPT SUBMISSIONS, AND OTHER PUBLIC DISCLOSURES

Can I publish the results of my work?	Yes, you may publish the results of your work and you are encouraged to do so. In so doing, you must include the Acknowledgment of Federal Support and Disclaimer included in Attachment 1 of your award agreement. You are required to report to DOE and ARPA-E the submission of a manuscript for publication, regardless of whether it is accepted for publication. If accepted for publication, you are required to report that fact to DOE and ARPA-E.
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<p>Am I allowed to publicly disclose a subject invention by other means?</p>	<p>Yes, you may publicly disclose subject inventions by other means, including public use. However, you remain obligated to report the subject invention to DOE and ARPA-E.</p>
<p>PATENT FILINGS</p>	
<p>When do I file a patent application in the U.S.?</p>	<p>You must file an initial patent application with the U.S. Patent & Trademark Office (PTO) <u>within one year</u> after electing to retain title, <u>but prior to</u> any statutory deadline.</p> <p>If publication, sale, or public use of the subject invention has initiated the one-year statutory period for filing a patent, you must file your initial patent application no later than <u>at least 60 days</u> prior to the statutory deadline.</p>
<p>What patent actions must I report to ARPA-E and DOE?</p>	<ul style="list-style-type: none"> • Filing of an initial, divisional, continuation, or continuation-in-part patent application with the PTO • Filing of one or more foreign patent applications.
<p>Once a patent application is filed, does the Government retain any rights in the subject invention?</p>	<p>Yes. The Government retains a nonexclusive, nontransferable, irrevocable, paid-up, worldwide license in the subject invention, patent application, and any resulting patent. In addition, the Government retains march-in rights and U.S. industry preferences.</p> <p>In reporting initial patent filings and continuation-in-part patent filings, you must submit to DOE and ARPA-E a signed Confirmatory License confirming these rights. The Confirmatory License is included in the ARPA-E Notice of Invention, Publication, Patent, and Title Election, available on ARPA-E’s website at http://arpa-e.energy.gov/FundingAgreements/Overview/Award.aspx#Intellectual_Property_Reporting.</p>
<p>Am I required to inform the patent office that the invention was funded (in whole or in part) by the Federal Govt.?</p>	<p>Yes. The patent application must include the following language: “This invention was made with Government support under Award No. _____, awarded by the Advanced Research Projects Agency – Energy (ARPA-E), U.S. Department of Energy. The Government has certain rights in this invention.”</p>
<p>When do I file patent applications in other countries?</p>	<p>The timelines for filing in foreign countries are varied and complex. If you wish to file patent applications in additional countries or international patent offices, you must file any patent applications:</p> <ul style="list-style-type: none"> • <u>within ten months</u> of the corresponding initial patent application; or • if the filing of the foreign patent application has been prohibited by a Secrecy Order, <u>six months from the date</u> when permission is granted by the Commissioner of Patents and Trademarks to file foreign patent applications. A Secrecy Order may be issued by the Commissioner of Patents and Trademarks if disclosure of the subject invention would threaten national security.



Can I request an extension of time for the filing of patents for a subject invention?	<p>Yes. You may request an extension of time if you have not previously publicly disclosed the subject invention by publication or other means. All extension requests should be submitted to both of the following email addresses: GC-62@hq.doe.gov and ARPA-E-Counsel@hq.doe.gov. For urgent matters, please contact the DOE IP Attorney assigned to your project.</p> <p>DOE and ARPA-E will decide whether to grant an extension and notify you accordingly. Your request for extension will be considered in light of applicable statutory periods, such as the one-year statutory period for filing a patent.</p>
What should I do if I decide to discontinue prosecution of a patent application, maintenance of a patent, or defense of a patent proceeding?	<p>You must notify DOE and ARPA-E <u>at least 30 days</u> before the expiration of the response period required by a relevant domestic or foreign patent office if you decide to discontinue: (1) prosecution of a patent application, (2) maintenance of an existing patent, or (3) defense of a patent in a reexamination or opposition proceeding,</p> <p>All discontinuation notices should be submitted to both of the following email addresses: GC-62@hq.doe.gov and ARPA-E-Counsel@hq.doe.gov.</p>