U.S. Competitiveness in Licensing

Brief

Policy Summary

Berkeley Lab's Technology Transfer and Intellectual Property Management (TTIPM) department must make intellectual-property licensing and assignment decisions that give preference to third parties providing economic and technological benefits to the U.S. domestic economy.

Who Should Read This Policy

Berkeley Lab researchers and TTIPM staff

To Read the Full Policy, Go To:

The POLICY tab on this wiki page

Contact Information

Licensing Manager
Technology Transfer and Intellectual Property Management
ttd@lbl.gov

Policy

Title: U.S. Competitiveness in Licensing
Publication date: 11/27/2012
Effective date: 3/12/2007

POLICY

A. Purpose

This policy describes intellectual property licensing requirements at Lawrence Berkeley National Laboratory (Berkeley Lab)

B. Persons Affected

Berkeley Lab researchers and Technology Transfer and Intellectual Property Management (TTIPM) staff

C. Exceptions

Berkeley Lab can request approval from the Department of Energy (DOE) Contracting Officer if the U.S. competitive requirement is not met.

D. Policy Statement

Berkeley Lab supports the U.S. domestic economy through its intellectual property licensing program.

1. Some of the factors TTIPM considers in its licensing program include:
   a. Whether related research & development will be performed in the U.S., and whether licensed products or components of

Lawrence Berkeley National Laboratory. The official or current version is located in the online LBNL Requirements and Policies Manual. Printed or exported versions are not official. Users are responsible for working with the latest approved revision.
1. licensed products will be substantially manufactured in the U.S.
   a. Whether a proposed licensee has a business located in the U.S.
   b. If the licensee is controlled by a foreign company or government, whether that foreign country’s government allows U.S. entities to enter into cooperative research agreements and whether it protects U.S. intellectual property rights

2. When a foreign company or government controls a potential licensee, TTIPM will research specified U.S. Trade Representative reports and other relevant information to reach conclusions regarding the foreign country’s intellectual property stance.

3. In the case of exclusive licenses, TTIPM will require that the licensees substantially manufacture in the U.S. licensed products for the U.S. market.

E. Roles and Responsibilities

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<tr>
<th>Role</th>
<th>Responsibility</th>
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<tr>
<td>TTIPM Licensing Staff</td>
<td>• Considers the U.S. industrial competitiveness factors</td>
</tr>
<tr>
<td></td>
<td>• Researches the U.S. Trade Representative reports as necessary</td>
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<tr>
<td></td>
<td>• Includes the required substantial U.S. manufacturing provision in exclusive licenses</td>
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<tr>
<td></td>
<td>• Keeps records of consideration of U.S. industrial competitiveness factors as well as copies of any required DOE approvals</td>
</tr>
<tr>
<td>Department of Energy</td>
<td>Responds to any requests for a waiver of the U.S. industrial competitiveness requirement within 30 days</td>
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F. Definitions/Acronyms

<table>
<thead>
<tr>
<th>Term</th>
<th>Definition</th>
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<tr>
<td>Exclusive License</td>
<td>An agreement between an owner and another party that permits the other party to make certain use of the property, with the understanding that the owner may not concurrently grant any other licenses that have the same rights within the scope or field covered by the exclusive license</td>
</tr>
<tr>
<td>Policy</td>
<td>Statements or directives from the federal, state, or local government; the University of California; or Berkeley Lab senior management that set a course of action, define acceptable conduct, or implement governing principlesExample: Berkeley Lab Site Access</td>
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<td>TTIPM</td>
<td>Technology Transfer and Intellectual Property Management</td>
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G. Recordkeeping Requirements

TTIPM Licensing keeps records of its consideration of U.S. industrial competitiveness factors as well as copies of any required DOE approvals.

H. Implementing Documents

None

I. Contact Information

Licensing Manager
Technology Transfer and Intellectual Property Management
ttd@lbl.gov

J. Revision History

<table>
<thead>
<tr>
<th>Date</th>
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<th>By whom</th>
<th>Revision Description</th>
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Document Information

DOCUMENT INFORMATION

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<th>Title:</th>
<th>U.S. Competitiveness in Licensing</th>
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Source Requirements Documents


Implementing Documents

None