

PI Worksheet on Determining Non-Federal Sponsor WFO Intellectual Property?

Non-Federal sponsors will receive title to LBNL inventions unless an exception applies. PI's need to answer the following questions when applying for non-federal funding so the SPO CO will know which contract documents to send to the sponsor and what kind of IP rights will exist on the contract. Most questions, once answered, require additional information. The answers are recorded in RAPID by divisional personnel.

Question / Statement	What Does it Mean? How Do I Answer?
<p>Sponsor Declines: The Sponsor declines its right to title in LBNL inventions. Provide reason and reference correspondence below.</p>	<p>Sponsor is not interested in obtaining title to inventions. For example, State agencies may have no interest in intellectual property ownership. LBNL can then propose to DOE that LBNL should retain title to the inventions under the project.</p>
<p>Research Tools: Likely inventions would be research tool(s), which should be available to many organizations. Indicate research tools and why below:</p>	<p>When the WFO Project involves the design, development, or production of a research tool and there is a DOE Program and public interest in having the tool available to many potential research and commercial organizations, LBNL can then propose to DOE that LBNL should retain title to the inventions under the project. Examples of research tools can include cell lines, monoclonal antibodies, reagents, animal models, growth factors, combinatorial chemistry libraries, drugs and drug targets, clones and cloning tools (such as PCR), methods, laboratory equipment and machines, databases and computer software.</p>
<p>Field of Use: A domestic Sponsor's interest to appropriately commercialize is in fewer fields of use than are realistically commercially feasible for the invention. Provide explanation below:</p>	<p>If a potential subject invention, for example, a new battery technology has more than one field of use, such as use in automobiles, cellular phones, laptops, etc. and the Sponsor is not interested in commercializing all of the potential fields of use, LBNL can propose to DOE that LBNL retain title to the subject invention and that the Sponsor would receive a royalty-free exclusive license in the field(s) of use they are interested in commercializing.</p>
<p>Federal Flow Thru: Sponsor's funding is from a Federal agency. Provide Agency below:</p>	<p>When the Sponsor is receiving funding from a contract, grant, or other agreement from a Federal Agency and is utilizing those funds to subcontract work to LBNL then LBNL by law has the right to retain title to inventions by LBNL employees.</p>
<p>University of California Sponsor is UC.</p>	<p>UC campuses and Office of the President have agreed that LBNL may retain title to inventions of its employees.</p>
<p>Special: There are special facts and it is not in the best interests of the United States. Provide explanation below:</p>	<p>This is a catch all if none of the above examples apply and LBNL still wants to propose to DOE that the transfer of technology to the U.S. domestic economy will benefit from LBNL retaining title to inventions by its employees.</p>
<p>Other Issues: Is there LBNL background intellectual property (IP) that may be used in the proposed project? Are there any other issues that need to be considered in allocating IP rights? Provide explanation below.</p>	<p>Background intellectual property includes existing LBNL patents, copyrights, or patent or copyright disclosures that have been submitted to the LBNL Technology Transfer and Intellectual Property Management that will be used in the WFO project. LBNL needs to identify such background intellectual property in the WFO Agreement so that the Sponsor understands that it may have to enter into a separate license agreement with LBNL, if such licenses are available, to have access to identified background intellectual property.</p>