U.S. DEPARTMENT OF ENERGY

琳达・菲尔德
Linda Field

能源部
Patent Counsel, USDOE
专利律师
linda.field@hq.doe.gov

中美清洁能源研究中心
Clean Energy Research Center

China-U.S. Joint IP Workshop:
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Transactions

With DOE

Contracts
Assistance Awards
- Grants
- Cooperative Agreements
- TIAs

With Labs

CRADA*s
"Work For Others" Agreements
User Facility Agreements
Licensing

事务

有关能源部

- 合同
- 资助奖
  - 奖金
  - 合作协议
  - TIAs

*CRADA- 合作研发协议

有关实验室

- 合作研发协议
- 非联邦机构工作协议
- 用户设施协议
- 许可证

拜杜法案（美国法典第35部分第200条）
Bayh- Dole Act (35 U.S.C. § 200 et seq.)
(政策&目标）
(Policy & Objective)

- 于1980年采用
- Adopted in 1980
- 使用专利系统以提高发明的使用，该等发明产生于联邦政府资助的研究或开发；
- To use the patent system to promote the utilization of inventions arising from federally supported research or development;
- 鼓励小型企业积极地参与由联邦政府资助的研究或开发；
- To encourage maximum participation of small business firms in federally supported research or development;
- 加强商业领域与非盈利性机构间的合作；
- To promote collaboration between commercial concerns and nonprofit organizations;
- 确保该等由非盈利性机构和小型企业创造的发明以一种能促进自由竞争的方式使用，同时企业不妨碍将来的开发和研究；
- To ensure that inventions made by nonprofit organizations and small bus. are used in a manner to promote free competition and enterprise without unduly encumbering future research and discovery;

拜杜（美国法典第35部分第200条）

Bayh-Dole (35 U.S.C. § 200 et seq.)

- 拜杜（美国法典第35部分第200条）
- Bayh-Dole (35 U.S.C. § 200 et seq.)
  - 适用于研发的“融资协定”，签约方为小型企业、非盈利性企业和大学
  - Applies to R&D “funding agreements” with small business, non-profit, and university contractors
  - 签约方有权选择“此发明”的称号，但受制于政府许可证、介入权以及美国优先权的规定
  - Contractor has the right to elect title to “subject inventions” subject to Government license, march-in rights, and U.S. preference
  - 特殊情况
  - Exceptional Circumstances

- 执行令12591号（1987）-法律允许范围内并遵循拜杜法案
- Executive Order 12591 (1987) – Follow Bayh-Dole to the extent permitted by law

Bayh-Dole

- Contracts with small businesses, non-profits and universities:
  - **Std FAR Clause 48 CFR 52.227-11**
  - Agencies have their own FAR supplements which may offer some slight modifications to the standard FAR patent rights provisions (e.g. DEAR, 48 C.F.R. Parts 927 and 952;)
- Financial Assistance:
  - "Intangible Property" cites to 37 C.F.R. Part 401
  - 10 CFR 600 Subpart D, Appendix A

拜杜

- 小型企业，非盈利企业以及大学的合约:
  - Std FAR 条款 48 CFR 52.227-11
  - 机构自身对FAR进行补充，这也对标准的FAR专利权提供了少量的修改（例如. DEAR, 48 C.F.R. 章节 927 和 952;）
- 财政支持:
  - "无形财产" 引自37 C.F.R. 章节 401
  - 10 CFR 600 子目录 D, 附录 A

Contracts, Grants, Cooperative Agreements
Patent Rights (48 CFR 52.227-11)
合同，奖金，合作协议
专利权(48 CFR 52.227-11)

- Subject Inventions
  - Small business, university or non-profit by law may elect to retain title to "subject inventions" (i.e. conceived or first actually reduced to practice under contract/award).
  - Large businesses must obtain patent waiver for DOE contracts/awards, typically require at least 20% cost share.
- Government reserves certain rights:
  - Government License
  - March-in rights
  - U.S. Manufacture Requirement

- 发明
  - 根据条例，小型企业，大学或者非盈利机构可以根据法律享有 "此发明" 的所有权（即按照合同/奖励，构想或者首次付诸实践）
  - 大型企业须放弃专利权，为获得能源部得合同/奖励，通常至少要求20%的成本分担。
- 政府保留一定的权利：
  - 政府许可证
  - 介入权
  - 美国生产要求

Contracts, Grants, Cooperative Agreements
Patent Rights
合同，奖金，合作协议
专利权

- ***Government License***: The Federal Government shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the subject invention throughout the world.

- 政府许可证： 联邦政府在全球范围内以美国发明的名义实施或已经实施非独占的、不可转让的、不可撤销的、有偿许可。

Contracts, Grants, Cooperative Agreements
Patent Rights
合同，奖金，合作协议
专利权

- ***March-in rights*** – Government can require the contractor, assignee, or exclusive licensee to grant license to responsible applicant where: (1) such action is necessary because the Contractor or assignee has not taken, or is not expected to take within a reasonable time, effective steps to achieve practical application of the subject invention in such field of use; (2) such action is necessary to alleviate health or safety needs which are not reasonably satisfied by the Contractor, assignee, or their licensees; (3) such action is necessary to meet requirements for public use specified by Federal regulations and such requirements are not reasonably satisfied by the Contractor, assignee, or licensees; or (4) Such action is necessary because of non-compliance with terms of U.S. Preference clause.

- *介入权* – 政府可以要求承包商，代理人，或者独占的被许可方将许可证授予可靠的申请人（1）这样的行为是非常有必要的，因为承包商或者代理人未在合理的期限内采取有效的措施在应用领域申请该发明；（2）承包商、代理人或者他们的被许可方并不能在健康或者安全的需求上获得合理满足，而这一行为则缓和了这种需求(3) 根据联邦法规规定，这一行为满足了公共使用的需求，但并不能满足承包商，代理人或者被许可方；或者(4) 因为与美国优先条款的不一致，所以这样的行为非常有必要。
- Has never been exercised by US Government.
- 美国政府还从未行使过

Contracts, Grants, Cooperative Agreements
Patent rights
合同，奖金，合作协议
专利权

- ***U.S. Manufacture***
  - *U.S. Preference* – for exclusive licenses to use or sell any subject invention in the United States, licensee must agree that any products embodying the subject invention or produced through the use of the subject invention will be manufactured substantially in the United States.
  - *U.S. Competitiveness* - Substantial manufacture also applies to contractor/ awardee and non-exclusive licensees, and may apply for sale worldwide (e.g. large businesses)
- *May be waived or modified under certain circumstances, but expect to agree to provide some benefit to U.S. economy*
- *美国制造*
  - *美国优先权* – 对于任何在美国使用或者销售的独占许可，被许可方应同意任何含有该发明的产品或者通过使用该发明而生产的产品将持续在美国生产。
  - *美国竞争性* – 持续生产也可以适用于承包商/受奖者以及非独占被许可方，也可以申请在全球范围内的销售（例如. 大型企业 ）
- *在特定情况可能免除或者进行修改，但是需利于美国经济的发展。*

Contracts, Grants, Cooperative Agreements
Data Rights
合同，奖金，合作协议
数据权利

- DOE data policy directed toward:
  - Making the benefits of the energy research, development and demonstration programs of DOE widely available to the public in the shortest practicable time
  - Promoting the commercial utilization of the technology developed under DOE programs
  - Encouraging participation by private persons in DOE energy research, development, and demonstration programs
  - Fostering competition and preventing undue market concentration or the creation or maintenance of other situations inconsistent with the antitrust laws
- Other civilian science agencies have similar policies
- 能源部数据政策有助于：
  - 使得能源部的能源研究，发展以及演示项目可以在最短的可实行时间内大范围向公众公布。
  - 促进能源部项目发展的技术商业化
  - 鼓励私人参与到能源部研究、发展以及演示项目中
  - 增强竞争性，并防止过度的市场集中或者其他违背反垄断法的方案的发生或者存在
- 其他的民间科学机构也有类似的政策

Contracts, Grants, Cooperative Agreements
Data Rights
合同，奖金，合作协议
数据权利

- For small bus. or large bus., the government gets:
  - *Unlimited rights* in generated data, which is right to use, disclose, reproduce, prepare derivative works, distribute copies to the public, and perform publicly and display publicly, in any manner and for any purpose, and to have or permit others to do so.

- For universities or non-profits, government gets rights to:

  - Obtain, reproduce, publish or otherwise use the data first produced under an award; and
  - Authorize others to receive, reproduce, publish, or otherwise use such data for Federal purposes.

- ***However***, under certain special authority (e.g. EPACT 2005), DOE may allow protection of generated data for up to 5 years.

- Always will have the right to protect subject invention information (e.g. disclosures) to allow for filing of patent applications

- 对于小型企业，或者大型企业，政府有权：
  - *对产生的数据有无限制的权利，也就是说以任何方式任何目的，有权使用，展示，再生产，准备衍生工作，将副本向大众公布，公开执行和展示，也可以授权他人进行这些操作。.*

- 对于大学或者非盈利机构，政府有权：
  - 以奖金的形式，再生产，出版或者使用首次产生的数据；
  - 以联邦目的授权他人接收，再生产，公布，或者使用这些数据。

- ***然而***，在某些特定的权限下(例如. EPACT 2005)，能源部可以对所产生的数据保护高达5年之久。

- 考虑到专利申请，有权保护发明信息（例如，公开）

U.S. Position on CERC IP
美国在清洁能源研究中心的位置

- Protection of IPR is one of the most important steps to promote innovation.
- The U.S. works with China to ensure rules and regulations are enforced.
- Under CERC, the provisions of the IP Annex to the Protocol will guide our approaches.
- Disputes will be resolved in neutral settings under international rules.
- 知识产权的保护是促进创新最重要的步骤之一
- 美国与中国合作以保证规章制度得以执行
- 在中美清洁能源研究中心，协定的知识产权附件将指导我们的执行方法
- 争端将按照国际规则由中立机构解决

ANNEX I – INTELLECTUAL PROPERTY

The Parties shall ensure adequate and effective protection of intellectual property created or furnished under this Protocol and relevant implementing Project Annexes. Rights to such intellectual property shall be allocated as provided in this Annex. Subject to this Annex, the Parties shall support the widest dissemination of scientific information they generate in the execution of this Protocol.

I. SCOPE

A. This Annex is applicable to all cooperative activities undertaken pursuant to this Protocol, except as otherwise specifically agreed to by the Parties or their designees.

B. For purposes of this Protocol, "intellectual property" shall have the meaning found in Article 2 of the Convention Establishing the World Intellectual Property Organization, done at Stockholm, July 14, 1967, and may include other subject matter as agreed to by the Parties.

C. Each Party shall ensure, through contracts or other legal means with its own participants, if necessary, that the other Party can obtain the rights to intellectual property allocated in accordance with the Annex. This Annex does not otherwise alter or prejudice the allocation between a Party and the nationals of its country, which shall be determined by that Party's laws and practices.

D. Disputes concerning intellectual property arising under this Protocol shall be resolved through discussions between the concerned participating institutions or, if necessary, the Parties or their designees. Upon mutual agreement of the Parties, a dispute shall be submitted to an arbitral tribunal for binding arbitration in accordance with the applicable rules of international law. Unless the Parties or their designees agree otherwise in writing, the arbitration rules of the United Nations Commission on International Trade Law (UNCITRAL) shall govern.

E. Termination or expiration of this Protocol shall not affect rights or obligations under

http://www.us-chinacerc.org

Protocol's IP Annex
协定的知识产权附件

- Under CERC, the Protocol and its IP Annex (Gov-to-Gov) Take Priority:
  - Party that Makes or Creates the IP, Owns the IP
  - If IP is Jointly Made, then it is Jointly Owned
  - Regardless of Ownership, Each Party has (non-exclusive) Right in its Own Territory to Use or Sublicense
  - Rights outside its Territory are to be Determined via Negotiation under a Technology Management Plan (TMP)
  - TMP is to be Jointly Agreed Upon by the Parties (Respective Governments)
- The Protocol Does Not Otherwise Alter or Prejudice Allocation of IP between a Party and its Nationals, which are Determined by that Party's Laws
- The TMP further clarifies:
  - "Participants" (those entitled to preferential licensing)
  - "Cooperative Activities" and "Jointly Funded Research Projects"
- The TMP "Template" Provides Guidance; Additional Details May be Negotiated Providing a More Flexible International IP Regime than Other S&T Agreements
- 清洁能源研究中心，协定以及其知识产权附件（政府对政府）有优先权：
  - 创造知识产权的一方拥有知识产权
  - 如果知识产权是共同创造的，那么知识产权就双方共同所有
  - 除所有权外，一方有（非独占的）权在其自己的领土内使用或者转让
  - 其在领土外的权利按照《技术管理计划》（TMP)通过协商决定
  - TMP须获得各自政府的同意
- 协定并不改变或者歧视一方与其国民之间知识产权的归属，这是由该方国内法律决定
- TMP 更一步明确：
  - "参与者"（这些可以优先获得许可证）
  - "合作活动" 以及"共同资助研究项目"
- TMP "模板" 提供导引；可以通过商议额外的详情以提供比其他S&T协议更灵活的国际知识产权制度

TECHNOLOGY MANAGEMENT PLAN

(Regarding the exploitation of Intellectual Property Rights)
for the Clean Energy Research Center Advanced Coal Technology Consortium (ACTC)

中美清洁能源研究中心清洁煤技术联盟（ACTC）

关于知识产权利用的

技术管理计划

III. Ownership of Intellectual Property

三、知识产权的所有权

1. The owner(s) of Background Intellectual Property shall retain all right, title, and interest in their own Background Intellectual Property. The Signatories to the CERC Protocol have acknowledged that nothing herein shall be construed as requiring such an owner or owners to license, assign or otherwise transfer its Background Intellectual Property, and that any use of Background Intellectual Property authorized by its owner may require an appropriate license to such Background Intellectual Property.

1. 背景知识产权拥有者保留对其拥有的背景知识产权所享有的所有权利、所有权及利益。CERC议定书缔约双方认为本文中的任何事项均不得解释为要求该权利拥有者许可、转让或以其他方式转移其所享有的背景知识产权，任何经权利享有者授权的背景知识产权的使用都可能要求获得合适的许可证 。

3. A Participant or Participants (and/or MOST, NEA or DOE, in accordance with the laws and practices of the territory of such ministry, agency or department) shall retain ownership, in all countries, of Project Intellectual Property created or invented by such Participant(s) (including the right to file a patent application).

3. 一个或多个参与者（和/或MOST、NEA、DOE，依据其所在地域法律和惯例的相应部委、机构或部门）应当在世界各国保留对其（参与者）所创造或发明的知识产权的所有权（包括专利申请权）。

IV. Management of Intellectual Property and Information Sharing
四、知识产权管理和信息共享

1. Participants in Cooperative Activities may list all relevant intellectual property that they assert as Background IP for the purpose of seeking to distinguish Background Intellectual Property from Project Intellectual Property. Participants in a particular Jointly-Funded Research Project or Cooperative Activity, and contributors of Background Intellectual Property to that Project or Activity, may agree in writing to the scope and nature of the Background Intellectual Property.

1.合作活动的参与者可列出其宣称为背景知识产权的所有相关知识产权，以便对背景知识产权和项目知识产权加以区分。专项共同资助研究项目或者合作活动的参与者及该项目或活动的背景知识产权提供者可以书面约定背景知识产权的范围和性质。

2. It is the intent of the China ACTC and U.S. ACTC to encourage sharing of data and other information related to the Project Work, both sides shall make regular publically available report s to the respective Signatories to the CERC Protocol (except for that which cannot be disclosed to the public in accordance with applicable national or other laws and regulations regarding secrecy, confidentiality or the need to preserve the novelty of an invention for purposes of patenting), generally describing research data produced, project progress and periodical achievement.

2. 中方ACTC和美方ACTC意在鼓励共享与项目工作有关的数据和其他信息，双方应定期向各自CERC议定书缔约方就项目所产生的研究数据、项目进度和阶段性成果进行概括性汇报并公开（依照各自国家法律法规及其他有关保密条例，以及为保护专利申请新颖性的需要不得公开的除外）。

IV. Management of Intellectual Property and Information Sharing
四、知识产权管理和信息共享

4. For "Jointly-Funded Research Projects," subject to the provisions of the IP Annex, each Signatory to the CERC Protocol, and its Participant(s) as may be necessary, shall have access to, and a free right to use such Intellectual Property created or invented during this cooperative activity, for purposes of execution of the project/work plan for the particular Jointly-Funded Research Project.

4. 就"共同资助研究项目"而言，在遵守IP附件规定的前提下，CERC议定书缔约双方及其参与者（如有必要）为执行专项共同资助研究项目/工作计划，应有权无偿使用此合作活动中创造或发明的知识产权。

V. SHARING AND PROTECTION OF INTERESTS IN INTELLECTUAL PROPERTY RIGHTS

五、知识产权权益的共享与保护

3. Project Intellectual Property created or invented jointly by employees of and/or those sponsored by Signatories to the CERC Protocol from BOTH territories, shall be jointly owned by the respective Signatories to the CERC Protocol (or their Participant(s) in accordance with the laws and practices of the signatory's territory) and subject to each such owner having an undivided interest in the same.

3. 由中美两国CERC议定书缔约双方雇员和/或被资助的人员共同发明或创造的项目知识产权，需由各自CERC议定书缔约方（或遵守所在国相应法律和惯例的参与者）共同享有所有权，且以每一所有方对该知识产权享有不可分割的权益为前提。

4. For "Jointly-Funded Research Projects," unless otherwise agreed by the China ACTC and the U.S. ACTC—

4. 就"共同资助研究项目"而言，除非中方ACTC及美方ACTC另有约定—

4.1. An owner or owners from one territory, of Project Intellectual Property arising from such a project (and where necessary, Signatories to the CERC Protocol with an interest in such intellectual property) shall agree to negotiate in good faith terms of a nonexclusive license , to the other territory's Participants in such particular "Jointly-Funded Research Project", to make, have made, use, sell or otherwise practice such intellectual property. Such licenses shall be subject to negotiation on favorable terms agreeable to the entities that have ownership of such Intellectual Property.

4.1 产生于"共同资助研究项目"的项目知识产权的一国所有权人（并在必要时，对该知识产权享有某种利益的CERC议定书缔约方）应同意基于诚信条款来谈判一项普通许可协议，许可另一国的参与者在该项"共同资助研究项目"中制作、委托制作、使用、出售或以其他方式实施该知识产权。此类许可应以对拥有该知识产权的主体有利和可接受的条款为前提。

谢谢！ Thank You

琳达·菲尔德 **Linda Field**

202-586-2802

linda.field@hq.doe.gov