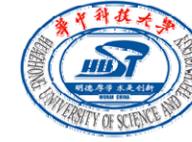




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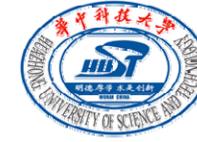
TMP & IP Protocol in the US-China CERC-ACTC Joint Research Project: *the Role, Difficulties and Strategies*

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摘要：余翔教授在发言中解析了中美清洁能源联合研究中心的《关于知识产权利用的技术管理计划》（TMP）的功能和作用，介绍了TMP的拟定与协商中遇到的困难。

Abstract: Prof. YU's explained the role of TMP regarding IP exploitation as well as the difficulties in TMP drafting and negotiation.



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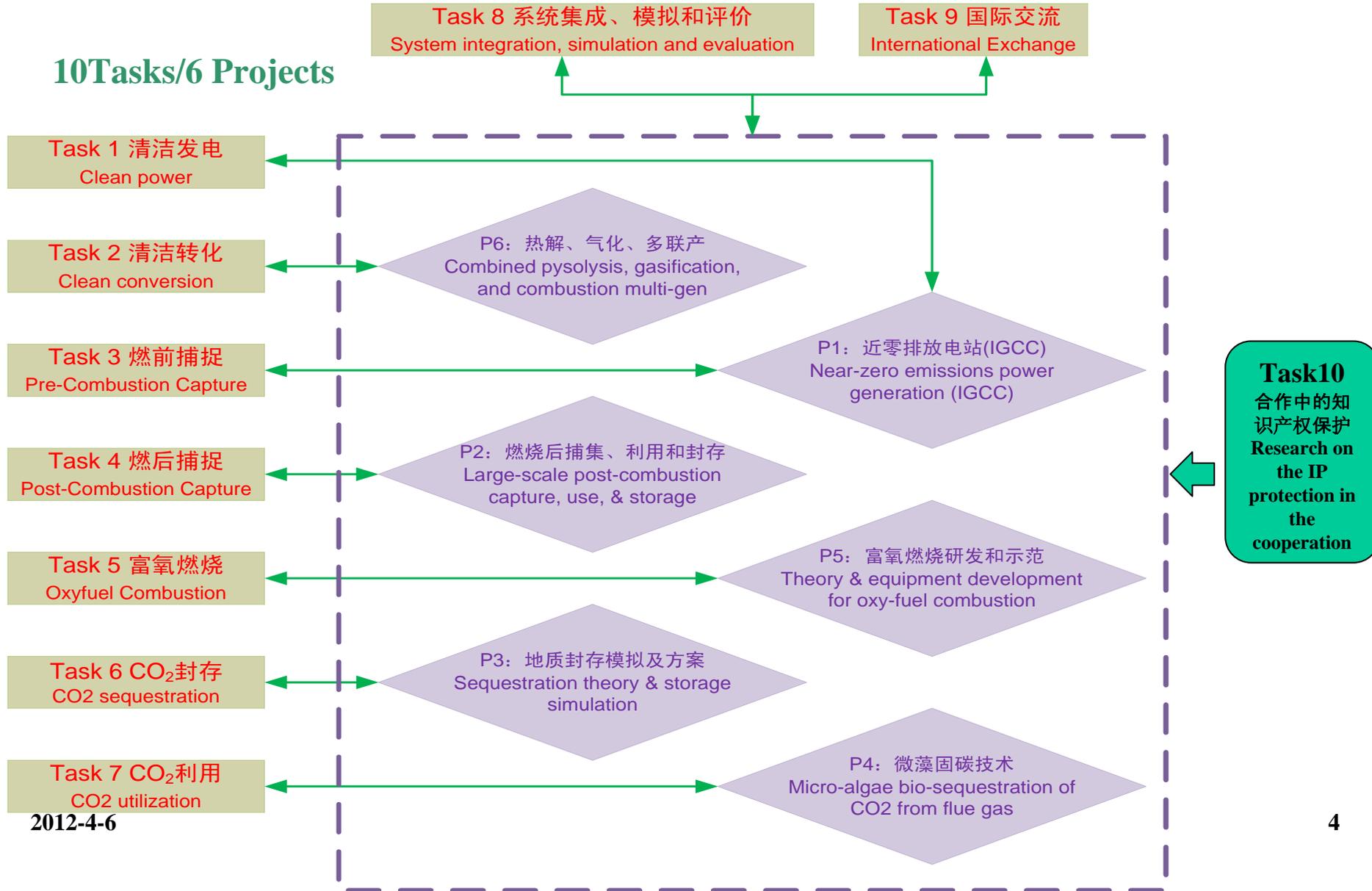


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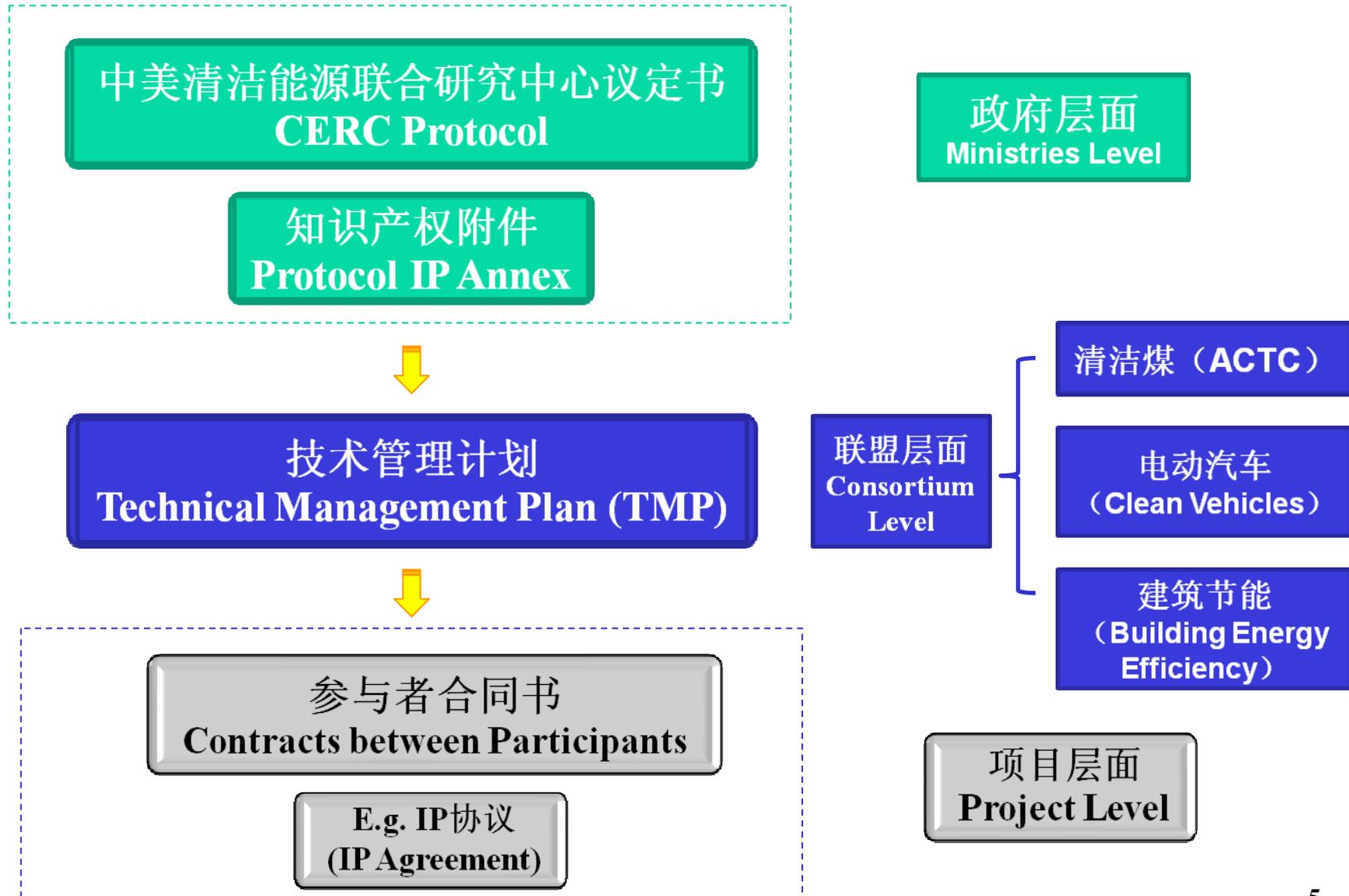
I. The Role and Function of TMP & IP Agreement



10Tasks/6 Projects



2012-4-6





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- **Protocol for Cooperation on a Clean Energy Research Center
Annex I - Intellectual Property**
- **Paragraph II.B.2.(d), (e)**
- **“The Parties or their participants shall jointly develop provisions of a Technology Management Plan regarding The Technology Management Plan shall consider the relative contributions of the Parties to the particular jointly-funded research project, the benefits of licensing by territory, or for fields of use, and other factors”**
- **“If the Parties cannot reach an agreement on a joint Technology Management Plan in the particular research project agreement, work on the particular research project shall not commence.”**



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II. Difficulties in TMP Drafting & Negotiation in CERC-ACTC Project



1. IP Allocation in Joint Research Project



Rights of Government

- Government License
- March-in rights
- U.S. Manufacture Requirement

Rights of Participants

- Bayh-Dole Act
- CRADAs
- WFO



Rights of Government

- Article 14 of Chinese Patent Law
- Designated License

Rights of Participants

- Article 8 of Chinese Patent Law



2. IP Exploitation in Joint Research Project

Difficulties / Focus	No.	Position/View		Final Text
		The U.S.	China	
Information Release	IV 2	Requires US-China ACTC Consortiums shall make regular publically available reports to respective governments generally describing research data produced, project progress and periodical achievement	Agree to release research reports, 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	Adopted China's View
IP Licensing	V 4.1 V 5.1	Requires non-exclusive IP licensing provisions shall naturally extend to licensee's subsidiaries or branches.	Sub-licensing shall be grant by Licensor independently, non-exclusive IP licensing provisions shall not naturally extended to licensee's subsidiaries or branches.	Adopted China's View



2. IP Exploitation in Joint Research Project (Cont.)

Difficulties / Focus	No.	Position/View		Final Text
		The U.S.	China	
IP Licensing of Co-invention	V 4.2	Encourage sharing; prevent a party which is IP owner refusing license to the other party in joint funded research on reasonable terms. In addition, unless otherwise required by law, an owner can license to third parties without accounting to the co-owner.	The US position is complying with Article 15 of Chinese Patent Law; however such licensing shall be restricted in non-exclusive Licensing.	Adopted China's View
IP Licensing of Invention for Research Purposes only	V 5.1	Deleted the word "free" in licensing, in the US, even licensing for scientific research only may charge.	According to Article 69 of Chinese Patent Law, Any person uses the relevant patent especially for the purpose of scientific research and experimentation shall not be deemed to be patent right infringement.	Adoption of the U.S. View



3. Confidential Information Management



Geological Data Management

➤ Public Available

Research Result

Publication and Sharing

➤ Research Results from State-funded Research



Geological Data Management

➤ State Secret

Research Result

Publication and Sharing

➤ Confidential Information & Novel Information Involving Patent Application cannot be published



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II. Strategy Conclusions of Negotiation Difficulties based on Different Legal Regulation in the US and China



1. TMP's Position in International Joint Research Agreements

➤ National Level

➤ Project Level

CERC-ACTC project

➤ Technology Alliance Level and Project Level



2. IP Allocation in International Joint Research Cooperation

• III. Ownership of Intellectual Property

2. 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. IP Exploitation and Licensing in Joint Research Cooperation

- **V. SHARING AND PROTECTION OF INTERESTS IN INTELLECTUAL PROPERTY RIGHTS**

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.



3. IP Exploitation and Licensing in Joint Research Cooperation

- V. 4.2 The China ACTC and U.S. ACTC hereby agree that any licenses to “Jointly-Funded Research Project” Project Intellectual Property granted to third-parties that are not Participants in the particular “Jointly-Funded Research Project”, shall be **non-exclusive** and based upon fairly negotiated arms-length commercial terms and compensation which contemplate the commercial benefits of the technology and the investment in the development of the technology, the benefits of licensing by territory, or for fields of use, and other factors deemed appropriate for the particular technology which is the subject of the “Jointly-Funded Research Project.” Unless otherwise required by law (or, consistent with applicable law, otherwise agreed by the owners of the particular Project Intellectual Property), an owner of “Jointly Funded Research Project” Project Intellectual Property shall **have no obligation of accounting to the co-owners** of such Project Intellectual Property or, unless otherwise required by law, to the Signatories of the CERC Protocol for any such arms-length licenses to third parties.



4. IP Licensing for Research Purpose Use Only

V. SHARING AND PROTECTION OF INTERESTS IN INTELLECTUAL PROPERTY RIGHTS

V. 5.1 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 ACTC Participants, for any invention made under such activities that is not a trade secret, **for research and development purposes only.**



5. The Effect of Non-Exclusive Licensing to Subsidiaries

- **V. SHARING AND PROTECTION OF INTERESTS IN INTELLECTUAL PROPERTY RIGHTS**

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.

5.1

Do not including subsidiary company.



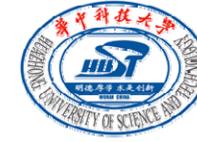
6. Release and Sharing of Information Involving Sensitivity and Patent Novelty

• IV. Management of Intellectual Property and Information Sharing

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 reports 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.



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Thanks for your attention!

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