**MODEL INTELLECTUAL PROPERTY MANAGEMENT PLAN**

*The following Model Plan was developed to facilitate the conclusion of Intellectual Property Management Plans. Such plans facilitate compliance with the terms and conditions of Department of Energy (DOE) financial assistance awards and work authorizations, and expedite commercialization and the dissemination of scientific data. Model clauses are provided below, along with explanatory text in italics.*

*DOE does not encourage or mandate the use of this Model Plan. Participants use this Model Plan at their own risk, and assume sole and exclusive liability arising from the use of this Model Plan. DOE encourage teams and consortia to consult with legal counsel regarding this Model Plan, as appropriate.*

1. **Preamble**

*Explanation:*

*The preamble:*

* + *Identifies the parties to the Plan (i.e., the Project Team) and the relevant financial assistance awards and/or work authorizations,*
  + *States the general purpose of the Plan, and*
  + *Sets forth objectives for the Plan.*

*Model Language:*

1. This Intellectual Property Management Plan (the Plan) is established by *[list Project Team Participants]* to address management of Intellectual Property that may be developed as a result of work performed under *[list applicable DOE financial assistance Award and/or work authorization]*.
2. The general purpose of the Plan is to address the protection and disposition of Intellectual Property developed under the DOE financial assistance award and/or work authorization, within the framework of Federal intellectual property laws, regulations, and policies.
3. The Plan objectives include:
   * 1. Promoting the patenting, licensing, and rapid commercialization of Subject Inventions developed under *[list applicable DOE financial assistance award and/or work authorization]*, and
     2. Promoting the rapid dissemination of scientific data for the public good.
4. **Definitions**

*Explanation:*

*The definitions section defines key terminology utilized in the Plan, including but not limited to the following terms:*

*Model Language:*

* 1. **“Award” and “DOE Award”** refers to a grant of financial assistance from DOE to an entity or entities by means of a grant, cooperative agreement, work authorization, Technology Investment Agreement, or other authorized financial assistance instrument.
  2. **“Award Work”** means any work or activity performed by a Participant pursuant to and funded by a DOE Award.
  3. **“Background Technical Data”** means information, in hard copy or in electronic form, including, without limitation, documents, drawings, models, designs, data memoranda, tapes, records, and databases developed before or independent of performance under the Award that is necessary for the performance of Award Work.
  4. **“Intellectual Property”** means technical information, Inventions, developments, discoveries, know-how, methods, techniques, formulae, algorithms, data, processes and other proprietary ideas (whether or not patentable or copyrightable). Intellectual Property also includes patent applications, patents, copyrights, trademarks, mask works, trade secrets, and any other legally protectable information, including computer software.
  5. **“Invention”** means any discovery or a new device, method, or process developed from study and experimentation that is or may be patentable or otherwise protectable under Title 35 of the United States Code, or any novel variety of plant which is or may be protected under the Plant Variety Protection Act (7 U.S.C. 2321 et seq.).
  6. **“Owner”** means a party, public or private, holding legal title to Intellectual Property, consistent with Federal laws and regulations.
  7. **“Participant”** means a Recipient who contributes to the execution of Award Work as part of a Project Team.
  8. **“Project Intellectual Property”** means and includes all Intellectual Property first conceived, discovered, developed, reduced to practice and/or generated in the performance of the Award.
  9. **“Project Team”** refers to a collective of Participants working in a collaborative manner to execute a DOE funded project.
  10. **“Project Technical Data”** means information (in hard copy or in electronic form) including, without limitation: documents, drawings, models, designs, data, memoranda, taps, records, and databases developed during the performance of Award Work.
  11. **“Recipient”** means an individual or entity who, directly or indirectly, receives money from DOE pursuant to the terms of a DOE Award for the purpose of performing Award Work.
  12. **“Subject Invention”** means any Invention of a Participant that is conceived or first actually reduced to practice in the performance of work under a DOE Award, provided that in the case of a variety of plant, the date of determination (the date a new plant is discovered/developed or the date a new plant is asexually reproduced, *see* the Plant Variety Protection Act, 7 U.S.C. 2401(a)(2)) must also occur during the period of award performance.

1. **Title to Subject Inventions and Other Project Intellectual Property**

*Explanation:*

*Title to Project Intellectual Property may be retained by one Participant or by multiple Participants. Project Teams may establish who will pay related ownership fees and may define the ownership interest that will be retained by Participant-Owners of jointly-owned Project Intellectual Property.*

*Model Language:*

* 1. Each Participant shall retain title to Subject Inventions and other Project Intellectual Property developed solely by its employees and agents.
  2. Unless agreed otherwise, the Participant filing a patent application shall pay all preparation and filing expenses, prosecution fees, issuance fees, post issuance fees, patent maintenance fees, annuities, interference expenses, and attorneys’ fees for that patent application and any resulting patent(s).
  3. Participants shall be joint Owners of Project Intellectual Property that is developed jointly by those Participants. Each Owner shall have an undivided interest in the jointly owned Project Intellectual Property. The jointly developed Project Intellectual Property shall be protected with joint patent applications in which the co-Owners are co-applicants.

1. **Intellectual Property Licensing**

*Explanation:*

*Participants who retain title to a Subject Invention may grant exclusive and non-exclusive licenses for Intellectual Property developed under the Award. Such licenses are subject to certain Government Intellectual Property rights and requirements, such as march-in rights and U.S. competitiveness.*

*Model Language:*

* 1. If a Participant does not retain title to a Subject Invention but is instead granted an exclusive license to use that Subject Invention, then Participant shall be responsible for all expenses and fees, past and future, in connection with the preparation, filing, prosecution, and maintenance of any patent applications and patents claiming exclusively-licensed Subject Inventions. If such Participant is granted a non-exclusive license, then the Participant shall be responsible for a pro-rated share, divided equally among all licensees, of expenses and fees for the non-exclusively licensed Subject Inventions.
  2. Participants who retain title to Project Intellectual Property may grant exclusive and non-exclusive licenses for use of technologies arising out of the Project Intellectual Property. Joint-Owners of Project Intellectual Property shall share equally in paying licensing expenses, and any benefits from licensing (i.e. royalties and equity) received shall be distributed equally between co-Owners. Any such license that an Owner may grant shall be subject to a reservation of certain rights to the Federal Government under the provisions of 35 U.S.C. § 201 et seq, which include march-in rights and U.S. Competitiveness.
  3. Any license that an Owner may grant will reserve the option to permit private or public educational institutions to use the Project Intellectual Property on a royalty-free basis for research and education, but not for commercial purposes, subject to confidentiality requirements.
  4. Any licensing of Project Intellectual Property shall be conducted pursuant to and in accordance with the terms of the Award under which the Project Intellectual Property was developed. Licensing of Project Intellectual Property shall not inhibit performance of Award Work.

1. **Ownership of Technical Data**

*Explanation:*

*To facilitate collaboration, Participants may wish to share Background Technical Data and Project Technical Data. Project Teams may establish parameters for the use of Participants’ Limited Rights Data and Protected Data, as defined in the Award.*

*Model Language:*

1. Each Participant shall have the right to use other Participants’ Project Technical Data and related Background Technical Data for the sole purpose of carrying out Award Work. Each Participant shall establish and implement specific measures and protocol to protect such data from disclosure.
2. **Dispute Resolution**

*Explanation:*

*Participants may wish to incorporate procedures for the resolution of disputes involving Intellectual Property rights.*

*Model Language:*

* 1. Any dispute between Participants relating to the management of Project Intellectual Property, as provided for in this Plan, or to the interpretation of this Plan, shall be referred to the Participants’ respective officers, as designated below. Through the designated officers, Participants’ agree to first attempt informal resolution of disputes, within a reasonable period of time and in a fair and equitable manner, taking into consideration the objectives of the Award and any laws, statutes, rules, regulations or guidelines to which the involved Participants are subject.

The designated officers are as follows:

**For Entity A:** \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**For Entity B:** \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**For Entity C:** \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**For Entity D:** \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

* 1. If the designated officers are unable to resolve the issues presented before them, and if the dispute cannot be settled through negotiation, the Participants agree first to try in good faith to settle the dispute by mediation administered by the American Arbitration Association under its Commercial Mediation Procedures before resorting to arbitration, litigation, or some other dispute resolution. If within 30 days after service of a written demand for mediation, the mediation does not result in settlement of the dispute, then any unresolved issues shall be settled by arbitration administered by the American Arbitration Association in accordance with its Commercial Arbitration Rules, and judgment on the award rendered by the arbitrator(s) may be entered in any court having jurisdiction thereof.

IN WITNESS THEREOF, the parties hereto have executed or approved this Intellectual Property Management Plan on the dates below their signatures.

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| --- | --- | --- | --- |
| Signature: |  | Signature: |  |
| Name: |  | Name: |  |
| Title: |  | Title: |  |
| Date: |  | Date |  |

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| Signature: |  | Signature: |  |
| Name: |  | Name: |  |
| Title: |  | Title: |  |
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