

Department of Energy

§ 781.2

(5) The cost to the owner of the patent of developing such invention or discovery or of acquiring such patent.

(b) In deciding whether or not to grant an award, under section 157 of the Act, for the making of an invention or discovery useful in the production or utilization of special nuclear material or atomic energy, the Board shall take into account the considerations set forth in § 780.53(a) of this part and the actual use of such invention or discovery.

(c) In deciding whether or not to provide compensation, pursuant to section 173 of the Act, to a person who owns a patent application that contains restricted data not belonging to the United States which the Department has communicated to a foreign nation, the Board shall take into account the considerations set forth in § 780.53(b) of this part and the damage to the applicant resulting from such communication.

(d) In the course of its review of an application to provide compensation, pursuant to 35 U.S.C. 183, to an applicant whose patent was withheld because of a secrecy order issued at the request of the Department, the Board shall take into account the considerations set forth in § 780.53(b) of this part and:

(1) The damage sustained by the applicant as a result of the secrecy order; and

(2) The use of the invention by the Government resulting from the disclosure of such invention to the Department.

[46 FR 39581, Aug. 4, 1981, as amended at 58 FR 68735, Dec. 29, 1993]

PART 781—DOE PATENT LICENSING REGULATIONS

GENERAL PROVISIONS

Sec.

781.1 Scope.

781.2 Policy.

781.3 Definitions.

781.4 Communications.

TYPES OF LICENSES AND CONDITIONS FOR LICENSING

781.51 Nonexclusive licenses.

781.52 Exclusive and partially exclusive licenses.

781.53 Additional licenses.

PROCEDURES

781.61 Publication of DOE inventions available for license.

781.62 Contents of a license application.

781.63 Published notices.

781.64 Termination.

781.65 Appeals.

781.66 Third-party termination proceedings.

SPECIAL PROVISIONS

781.71 Litigation.

781.81 Transfer of custody.

AUTHORITY: Dept. of Energy Organization Act, sec. 301, Pub. L. 95-91 (42 U.S.C. 7301); Federal Nonnuclear Energy Research and Development Act of 1974, sec. 9(g), Pub. L. 93-577 (42 U.S.C. 5908(g)); Atomic Energy Act of 1954, as amended, secs. 156, 161g, Pub. L. 83-703 (42 U.S.C. 2186, 2201g); Presidential Statement, 36 FR 16887, Aug. 26, 1971.

SOURCE: 45 FR 73447, Nov. 4, 1980, unless otherwise noted.

GENERAL PROVISIONS

§ 781.1 Scope.

The regulations of this part establish the procedures, terms, and conditions upon which licenses may be granted in inventions covered by patents or patent applications, both domestic and foreign, vested in the United States of America, as represented by or in the custody of the Department of Energy.

§ 781.2 Policy.

(a) The inventions covered by the patents and patent applications, both foreign and domestic, vested in the Government of the United States of America, as represented by or in the custody of the Department, normally will best serve the public interest when they are developed to the point of practical or commercial application and made available to the public in the shortest possible time. This may be accomplished by the granting of express nonexclusive, exclusive, or partially exclusive licenses for the practice of these inventions. However, it is recognized that there may be inventions as to which the Department deems dedication to the public by publication the preferable method of accomplishing these objectives.

(b) Although DOE encourages the nonexclusive licensing of its inventions to promote competition and to achieve

§ 781.3

10 CFR Ch. III (1–1–11 Edition)

their widest possible utilization, the commercial development of certain inventions may require a substantial capital investment that private manufacturers may be unwilling to risk under a nonexclusive license. Thus, DOE may grant exclusive or partially exclusive licenses where the granting of such exclusive or partially exclusive licenses is consistent with § 781.52.

(c) Decisions as to grants or denials of any license application will, in the discretion of the Secretary, be based on the Department's view of what is in the best interests of the United States and the general public under the provisions of these regulations. Decisions of the Department under these regulations may be made on the Secretary's behalf by the General Counsel or the General Counsel's delegate, except where otherwise delegated to the Invention Licensing Appeal Board. When the Department determines that it is appropriate to grant a license, the license will be negotiated on terms and conditions most favorable to the interests of the United States and the general public.

(d) No license shall be granted or implied under a DOE invention except as provided for in these regulations, in patent rights articles under Department procurement regulations (41 CFR part 9–9), in agreements between DOE and other Government bodies, or in any existing or future treaty or agreement between the United States and any foreign government or intergovernmental organization.

(e) No grant of a license under this part shall be construed to confer upon any licensee any immunity from the antitrust laws or from liability for patent misuse, and the acquisition and use of rights pursuant to this part shall not be immunized from the operation of State or Federal law by reason of the source of the grant.

§ 781.3 Definitions.

(a) *Board* means the Invention Licensing Appeal Board.

(b) *Department of Energy*, *Department*, or *DOE* mean the Department of Energy, established by the Department of Energy Organization Act (Pub. L. 95–91; 42 U.S.C. 7101).

(c) *DOE invention* means an invention covered by a U.S. or foreign patent or

patent application that is vested in the Government of the United States, as represented by or in the custody of the Department or any of its predecessors, and which is designated by the Department as appropriate for the grant of an express nonexclusive, exclusive, or partially exclusive license.

(d) *Exclusive license* means a license in which the licensee has the exclusive right under the patent for a part or the full term of the patent, subject only to the retention by the U.S. Government of a license and rights in the invention, as specified herein.

(e) *Partially exclusive license* means (1) an exclusive license where the exclusive right granted is limited to making or using or selling the invention, or is limited to specified fields of use or use in specified geographic locations; or (2) a license where the number of licenses under the particular invention is limited.

(f) *Person* means any individual, partnership, corporation, association, or institution, or other entity.

(g) *Predecessor* means the Energy Research and Development Administration, the Atomic Energy Commission, and any of the Government entities or parts thereof whose functions were transferred to the Department of Energy pursuant to title III of the Department of Energy Organization Act.

(h) *Responsible applicant* means an applicant who, in the discretion of the Department, has the intention, plans, and ability expeditiously to bring the invention to the point of practical or commercial application.

(i) *Secretary* means the Secretary of Energy or the delegate of the Secretary of Energy.

(j) *To the point of practical or commercial application* means to manufacture in the case of composition or product, to practice in the case of a process, or to operate in the case of a machine, under such conditions as to establish that the invention is being worked and that its benefits are reasonably accessible to the public.

(k) *United States and the general public* means the United States Government, United States citizens, and United States organizations.