

# User and Work For Others (WFO) Agreements

# User Agreement Waiver

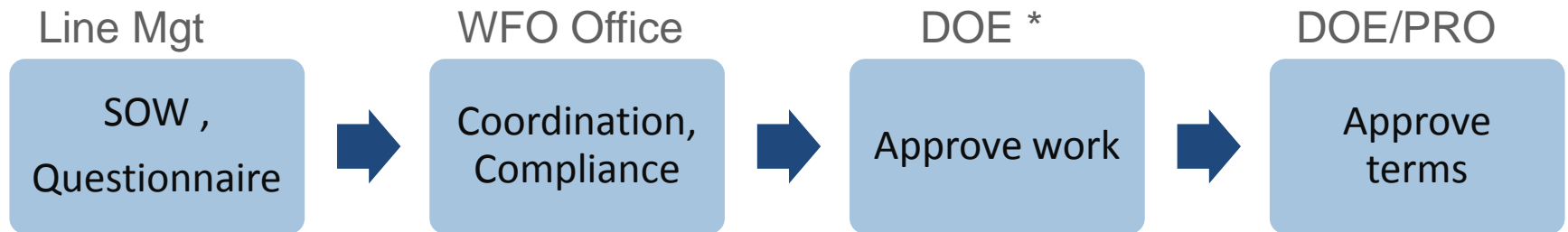
- Intellectual Property: Atomic Energy Act/Non-Nuclear Energy Act (42 USC 2182, **42 USC 5908**)

Whenever an **invention is “made”** (*conception or first actual reduction to practice*) in the course of or under any “contract” (*understanding or other **arrangement** which includes research, development or demonstration work*) of **[DOE]** ... or with a **contribution from the Government** (e.g., *facilities, equipment, material, funds or services*), ... **title shall vest** in the U.S. Government, ... **unless DOE waives** all or part of such rights in conformance with the provisions of this section. (42 USC 5908(a) & (m))

- User Agreement Waivers
  - Certain IP rights of Govt waived to Users
  - Use of Govt resources for non-Government purposes
    - ‘free-of-charge’, for qualified non-proprietary experiments
    - Cost recovery for proprietary experiments, but without WFO process
  - Selection/implementation of User Experiments delegated
- Agreements under new User Waivers intended to be consistent across DOE Labs and User Facilities to streamline/simplify access (fast, volume transactions)
  - Unique policies/procedures per User Facility



# WFO Process Overview (Case-by-Case)

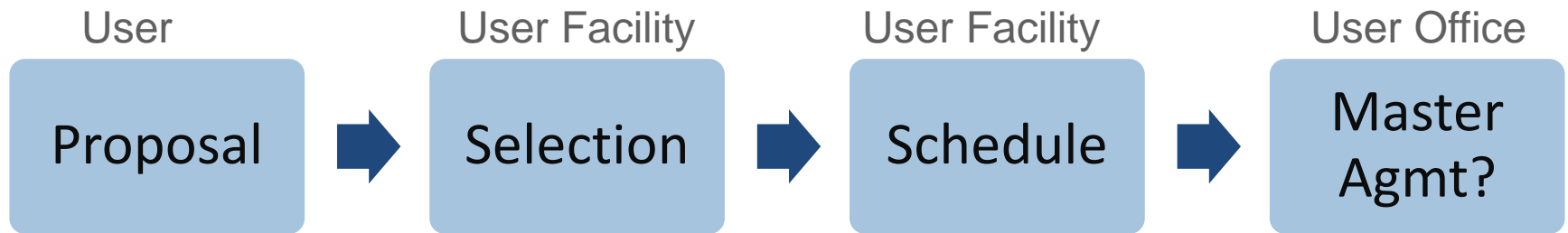


Takes Time

\* Foreign



# User Process Overview (Master Agreement)



Fast



# Nonproprietary and Proprietary Access to User Facility

## NONPROPRIETARY RESEARCH

- User may access User Facility **with or without collaboration** of Argonne researchers.
- User **not charged** for "machine time" or collaborative effort of Argonne researchers; user **may be charged** for ancillary materials, supplies, and services.
- User must **intend to publish** results.
- User may retain title to its inventions, Argonne retains title to its inventions; **Government retains a royalty-free license.**
- Experiment not directed towards producing specific commercial end result (marketable product).

## PROPRIETARY RESEARCH

- User may access User Facility with or without **limited support (non-collaborative)** from Argonne personnel.
- User **charged** "machine time" and limited support services (non-collaborative) from Argonne personnel on cost recovery basis.
- User may keep research **results private.**
- User may retain title to its inventions; ***Government rights are extremely limited.***
- If **experiment is proprietary and collaborative with Argonne, use CRADA or WFO** instead of the User Agreement.



# User Invention Rights in User Agreements

	Non-Proprietary	Proprietary
User can elect User-researcher inventions	Yes *	Yes
Government-use License	Yes *	No
March-In Rights	Yes *	No
U.S. Industrial Preference (if <i>license exclusively</i> to others for use in U.S.)	Yes *	No
Notice of Govt involvement in patent application	Yes *	No
Period Report of utilization of invention on DOE request (no more than annually)	Yes *	No
License to invention if invention incorporated into Facility and not restored (removed)	Yes	Yes
Report Invention to DOE 6 months after made	Yes **	Yes

\* These provisions consistent with Federal Funding Agreement (grants, cooperative agreements) under Bayh-Dole Act.

\*\* Bayh-Dole typically report invention within 2 months of internal report, instead of 6 months from made.



# Sponsor Rights to Lab Inventions in *Privately-Funded* WFO Agreements (current WFO Waiver)

	WFO Waiver	Declined *
Sponsor can elect <u>Lab-researcher</u> invention	Yes	Govt-Owned
Government-use License	Yes	N/A
March-In Rights	No**	N/A
U.S. Industrial Preference (if <i>license exclusively</i> to others for use in U.S.)	Yes	N/A
Notice of Govt involvement in patent application	Yes	N/A
Period Report of utilization of invention on DOE request (no more than annually)	No	N/A
License to invention if invention incorporated into Facility and not restored (removed)	Yes	N/A
Report Invention to DOE 6 months after made	Yes	Yes

\* Govt-owns invention, but Sponsor has irrevocable, nonexclusive, paid-up license to invention.

\*\* New guidance

Note, important to get funding correct. Federal Funding requires different WFO model



# Summary

	<b>Non-Prop User</b>	<b>Proprietary User</b>	<b><u>Privately-funded</u> WFO Waiver</b>
Cycle Time	Fast	Fast	Case-by-case approval
Collaborative	Possible	No	Yes, if funded
Cost Recovery	No (yes, for ancillary items/services)	Yes	Yes
Scope of Access	Limited to User Facilities	Limited to User Facilities with costs/infrastructure	Any resources at Lab, subject to approvals
Data results	Public	Private	Private
Inventions	Each owns its inventions, subject to typical Govt Rights	User owns its inventions, very limited Govt Rights	Sponsor owns <i>Lab</i> inventions, subject to typical Govt rights





# Industry at User Facilities at Argonne

## Rep. list of Industry Users

- Abbott (P&N)
- Aerospace Corp. (N)
- AstraZeneca Pharm (P)
- Bechtel Marine Propulsion (N)
- BP Amoco Chemical (P&N)
- Bristol-Myers Squibb (P)
- Cabot Microelectronics (N)
- Caterpillar (N)
- E.I. Dupont de Nemours (P&N)
- GlaxoSmithKline (P&N)
- Hewlett-Packard (N)
- Johnson Matthey (P)
- Medtronics (P&N)
- Nalco (N)
- Packer Engineering (N)
- Pfizer (P&N)
- Philips Research North America (N)
- Raytheon Missile Systems (N)
- Schering Corp (P)
- Schlumberger Doll Research Ctr ( N)
- The DOW Chemical Comp (P&N)
- Toyota Motor Eng. & Mfg. N.A. (N)
- UOP (P&N)
- Western Digital Technologies (N)

(534 User Insts. as of 4/23/12)



Questions?

