



OSPIP Contracts Officer Guidance

Non-Federal Work for Others Process for DOE Review And TTIPM Review of WFO and CRADAs

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Instructions to Use

Exhibits A-O with Non-Federal Sponsors

There are 6 versions of the WFO contract that can be used at LBNL

1. [Exhibit A.](#)
This contract will apply to private or non-profit sponsors which are offered the WFO patent class waiver. With DOE concurrence it can be offered to foreign entities. No Generated Information can be marked proprietary and the sponsor has unlimited rights to Generated Information except computer software.
2. [Exhibit B.](#)
This contract is similar to A, except that the *class waiver does not apply*. Both parties keep rights to their inventions and the sponsor is granted a license in Contractor's inventions. This contract can be used for private industry, foreign entities and private universities (i.e. Stanford).
3. [Exhibit C.](#)
This contract is for standard laboratory analysis or characterization, technical assistance, training or other work not involving protectable intellectual property, e.g. the SOW does not contemplate any patents or copyrights as a result of this project, or the transfer of LBNL technology. The patent and product liability articles are reserved.

Exhibit C is also used for User Facility Participating Research Team (PRT) Agreements.
4. [Exhibit D.](#)
This contract is to be used for state and local governments or public domestic universities when the class waiver does not apply.
4. [Exhibit E. and Exhibit E.\(ref.\)](#)
This Memorandum Agreement (Exhibit E) and the document, "Work for UC Campuses by UC National Laboratories General Provisions" [Exhibit E (ref.)] which is incorporated by reference in Exhibit E, are for use by UC campuses when contracting with UC managed and operated National Laboratories for research or services.
6. [Exhibit O.](#)
This is a short form, non-negotiable contract for non R&D work, technical assistance, training or other work not involving protectable intellectual property or the transfer of LBNL technology. It can only be used for work not to exceed \$250,000. The general indemnity article is not included so it cannot be used for work scope that would require such indemnity.

[Review Process](#)
[Approval Process](#)

Non-Federal Proposal Review Process

1. **Sponsored Project Proposal Form (SPPF) / PI'S Role.**

The Laboratory Divisions provide the Office of Sponsored Projects & Industry Partnerships (OSPIP) with the Sponsored Project Proposal Form (SPPF). The SPPF contains the budget, scope of work, intellectual property information review factors, and the NEPA/CEQA review form. The PI's signature on the SPPF indicates approval of the allocation of patent rights as represented in the intellectual property review factors.

2. **Sponsored Project Proposal Form (SPPF) / CO's Role**

The OSPIP Contracts Officer will review the SPPF, and determine which contract exhibit to use. They will sign the Allocation of Patent Rights form (Exhibit F). If the Intellectual Property Review Factor is incomplete or is changed, the PI will need either to complete it or make the change and approve the form.

The form will be submitted to DOE as part of its [approval process](#). In addition, the form Rep/Cert will be completed (Exhibit G) to determine if a sponsor is a foreign entity (or a small business, or non profit). If the sponsor is a foreign entity, follow the [Foreign WFO process](#).

3. Contracts Officers will decide the proper contract based on the following:

a. [Exhibit A](#) is the standard contract and will be used unless other fact patterns exist.

When the Sponsor is a foreign entity it may take title to inventions with DOE HQ Program's approval and DOE Berkeley Site Office approval. DOE generally prefers to have foreign entities obtain title.

b. [Exhibit B](#) will be used when

- (1) the sponsor declines the patent rights (with DOE approval), or
- (2) the sponsor is a foreign entity (with DOE approval) or
- (3) the work to be performed may develop inventions that could be a "fundamental research tool." Since the federal Government may have an interest in retaining title to such inventions for the public interest, DOE Patent Counsel must concur in the determination that the Contractor retains title (with DOE approval), or
- (4) a domestic sponsor's interests/abilities to appropriately commercialize are in a fewer fields of use. In this case, the Contracts Officers should use the alternate Article XIV provision for paragraph B (2) (with DOE Approval), or
- (5) other exceptions to the class waiver may be approved by DOE on a case by case basis because of special facts where it is in the best interest of the United States (with DOE approval), or
- (6) the sponsor is either a domestic private industry entity, domestic nonprofit organization, or private University, which is subcontracting Federal Govt. funds to LBNL under their prime federal grant or contract. (Ex. SBIR, NIH Grant)

- c. [Exhibit C](#) will be used when:
 - (1) the work calls for standard laboratory work (e.g., sample analyses or characterization) not involving R&D that could result in protectable intellectual property, e.g. the SOW does not contemplate any patents or copyright as a result of the work, or
 - (2) the work calls for standard technical assistance or training, and no identifiable laboratory (background) technology is being transferred to the Sponsor.
 - d. [Exhibit D](#) will be used for either public universities or state and local governments only when either Bayh-Dole rights apply or patent rights are declined.
 - e. [Exhibit E and Exhibit E \(ref.\)](#) will be used by University of California campuses when they are sponsoring research or services provided by University of California managed and operated National Laboratories.
 - f. [Exhibit O](#) can be used in lieu of Exhibit C if (1) the proposed work is \$250,000 or less, (2) General Indemnity can be reserved per DOE O 481.1C and (3) is non negotiable. If the sponsor wants to negotiate, Exhibit C is to be used for starting negotiations.
4. The Contracts Officers would be able to modify the standard Exhibits except Exhibit O, only to the extent there are alternate provisions already included in those Exhibits (e.g., payment or licensing considerations).
5. All other modifications if they are in accordance with the guidance provided by the DOE Order 481.1c will require the OSPIP Manager's approval. All substantive changes to standard, pre-approved clauses will require DOE CO approval. The OSPIP Manager can approve use of alternate clauses or non-substantive changes to existing clauses. Examples include clarification language, changes to property or termination or other clauses so long as DOE's intent is met.

Awards involving substantive non-standard terms and conditions may not be accepted without BSO CO approval. The process for CO approval of substantive changes can be found [here](#).

[Non-Federal Proposal Approval Process](#)

Version Note: This replaces the April 11, 2011 update to reflect that Laboratory Counsel's Office is taking export control review responsibility from TTIPM.

Foreign WFO Proposal Pre-approval¹ for Exhibits A or B

For new foreign WFO, send Gary Drew an email with the SOW and suggest the exhibit to use (either A or B). Use the same rationale that we would use for U.S. companies. This is not required for Exhibits C or O.

Gary will email back approving / disapproving the suggested IP allocation. The official package will not be held up pending HQ approvals and we will have had his pre-approval for the IP.

For ALL Non Federal Proposals

1. DOE Review Packages

Send either Package A or Package B.

A. Proposal Review Package

Send the following to BSO (wfoproj@bso.science.doe.gov) (See Email Templates DOE Email [Templates-DOE 1 & 2](#))

- DOE Forms (from RAPID) including Waiver request if applicable.
- NEPA form
- SOW, Abstract or JWS
- Budget
- [Exhibit F](#) (Allocation of Patent Rights) form

B. Waiver Review (Only) Package

Send the following to BSO (wfoproj@bso.science.doe.gov) (See Email Templates DOE Email [Templates-DOE 1 & 2](#))

- Waiver Form (only)

2. TTIPM or Laboratory Counsel and FVA Proposal Review for WFO and CRADAs

Proposal review packages will also be copied to TTIPM or Laboratory Counsel and FVA under the following circumstances:

- TTIPM - Exhibit A (*DOE* package)
- Laboratory Counsel - Foreign Sponsor (*SPPF* package)
- Laboratory Counsel and FVA - Publication Restriction (*SPPF* package)

¹ Per 04/17/08 J. Weiner email.

A. TTIPM if Exhibit A (WFO).

(See attached Email [Template- Internal 1](#)).

If you are proposing to use Exhibit A, then also send a copy of the DOE proposal review package to TTIPM

The TTIPM reviewer will promptly notify the OSPIP Contracting Officer via email if they have concerns over the proposed Exhibit A Agreement.

The OSPIP CO and TTIPM reviewer will resolve the concern, and if necessary the OSPIP CO will send the Sponsor a revised proposed Agreement *after DOE concurrence* if needed.

B. Laboratory Counsel if Foreign Sponsor (WFO & CRADAs (Including Amendments with SOW Changes))²

(See attached Email [Template- Internal 2](#))

OSPIP will provide the WFO SPPF (with the SOW) or CRADA JWS for review by Laboratory Counsel if the Sponsor or Participant is a foreign entity. The OSPIP Contracting Officer will submit the proposal or JWS via email (Attached email template 2) to Laboratory Counsel reviewer in parallel with its submittal to DOE.

The DOE forms and Exhibit F should be excluded, and the SPPF included.

OSPIP will use a title format for the attached proposal or JWS and on the email 'Subject' line as follows:

Subject : Proposal #, LBNL DIV, PI Last Name, Company Name.

The WFO Agreement or CRADA will then be submitted to the Sponsor unless Laboratory Counsel reviewer raises objections.

Should the Laboratory Counsel reviewer identify possible export control issues with the submitted documents, the Laboratory Counsel reviewer will notify the OSPIP Contracting Officer that the Laboratory Counsel reviewer will work with the Principal Investigator to resolve the potential issue.

The OSPIP Contracting Officer **should not finalize and sign an Agreement with the Sponsor or Participant** for the project **until the Laboratory Counsel notifies the OSPIP Contracting Officer that the potential issue has been appropriately resolved.**

² The great preponderance of work done at Berkeley Lab falls within the fundamental research exemption for export control regulations. There are a few circumstances that may require further analysis, and therefore review by the Laboratory Counsel Reviewers who have some export control training is appropriate.

C. Laboratory Counsel and FVA if there is a Publication Restriction Requested (WFO & CRADA)

(See attached Email [Template - Internal 3.](#))

If during the course of negotiations of a WFO Agreement or CRADA, the Sponsor or Participant insists on a publication restriction (e.g. more than the standard short delay for review for IP or proprietary information by the sponsor) the OSPIP Contracting Officer will forward the proposed publication restriction along with the originally proposed Agreement and the proposed Scope of Work via email (Attached email template 3) to the Laboratory Counsel's Office for review.

The DOE forms and Exhibit F should be excluded, and the SPPF (with SOW) included.

The Laboratory's **Foreign Visits and Assignments Office (FVA)** will also be copied on the above email to notify them that a project that potentially containing a publication restriction is under consideration.

The OSPIP Contracting Officer and Laboratory Counsel's staff will work together to appropriately resolve the proposed publication restriction, consistent with UC policy, and any related export control issues.

Director's Publication Restriction Approval.

If it is agreed that the publication restriction is still necessary in order to do the project, OSPIP will draft a [Memorandum](#) (sample attached) seeking the Laboratory Director's approval to accept the publication restriction.

Under University of California policy, only the Laboratory Director has the authority to approve an Agreement containing a publication restriction. If appropriate, the OSPIP Contracting Officer and the Principal Investigator may meet with the Laboratory Director in order to brief them on the proposed project and associated Agreement.

If the Laboratory Director approves acceptance of the publication restriction, the OSPIP Contracting Officer will include the memo with the Laboratory Director's signature approving the acceptance of the restriction in the OSPIP file for that Agreement.

3. DOE Approval

Await DOE Approval **BEFORE** sending WFO proposal/contract to Sponsor unless reasons B5, B6 or C on Exhibit F are chosen.

DOE will approve the proposal and update the RAPID DOE certification as usual.

This approval is also approval of the Allocation of Patent Rights form (Exhibit F). The form will **not** be returned.

Any issues will be resolved before we get the DOE proposal approval.

4. RUSH Proposals

If time is of the essence, you can send out a proposal/contract. However, you may have to change exhibits if DOE does not approve.

5. Review for Classified Work

Although there is an item on a review form referencing classified work, we believe this is an artifact from other Labs that conduct classified work. LBNL does not conduct classified work,

both by policy and practicality (i.e., it has no facilities to handle or protect classified information.) Nor do the OSPIP officers or the patent practitioners have clearances allowing them to deal with classified information. This item will be removed from the review list.

6. Invention Review

LBL employees are obligated to disclose their inventions to the patent group in TTIPM. The time and effort of the patent practitioners would be better spent educating and reminding the research staff of this obligation than reviewing the proposals for possible new inventions. In addition, only a minority of proposals are ever made public, and for those few that are made public, it is typically only a small portion (the abstract, which generally is non-enabling) and only after a many-months delay, when the award is made. Therefore the concern that public disclosure could impact foreign patent rights is a very limited and low-level risk. This item will be removed from the review list.

Email Templates - DOE

DOE 1 - Proposal

To: wfoproj@bso.science.doe.gov
Subject: WFO Proposal No. [0000XXXX] ['New' or 'Amendment Version _____']
Attachment: DOE Proposal Review Package

The subject proposal package is forwarded as a PDF attachment for review and approval. The proposal package includes:

- Review & Approval form,
- Waiver Form (if applicable)
- Statement of Work,
- Budget Estimate,
- NEPA/CEQA and EH&S Review, and
- Allocation of Patent Rights

If you have any questions regarding this submission, please contact [Contracts Officer]

DOE 2 - Waiver (only)

To: wfoproj@bso.science.doe.gov
Subject: WFO Waiver for Proposal No. [0000XXXX]
Attachment: Waiver Approval Request Form

The subject waiver approval request is forwarded as a PDF attachment for review and approval

If you have any questions regarding this submission, please contact [Contracts Officer]

Email Templates - Internal

[Template 1 - Allocation of Intellectual Property Rights](#)

To: HClark@lbl.gov

CC: OSPIP Contracting Officer

Subject: Exhibit A for Proposal [00000XXXX , LBNL DIV, PI Last Name, Sponsor Name]

Attachment: DOE Approval Package

OSPIP proposes using Exhibit A (Title to Sponsor for LBNL Subject Inventions) for the attached proposal.

No approval is required. Please notify me promptly if you disagree with the choice of Exhibit A for this proposed project.

For Export Control Review:

[Template 2 - Proposals or JWS with Foreign Sponsor or Participant](#)

To: ARDeISimone@lbl.gov

Cc: OSPIP Contracting Officer

Subject: Export Control Review for Proposal [00000XXXX , LBNL DIV, PI Last Name, Sponsor Name]

Attachment: SPPF Package

Please review the attached proposal with a foreign sponsor for potential export control issues. If potential export control issues are identified, please notify me via email that you are going to be working with the Principal Investigator to resolve the potential issues.

OSPIP will not sign an Agreement for the proposed project until we are notified by Laboratory Counsel reviewer via email that the potential issue has been appropriately resolved.

Email Templates - Internal (continued)

For Publication Restriction Request

[Template 3 - Agreements under Negotiation where the Sponsor or Participant is insisting on a Publication Restriction](#)

To: ARDeISimone@lbl.gov

Cc: FVA@lbl.gov

cc: OSPIP Contracting Officer

Subject: Publication Restriction Review for Proposal [00000XXXX, LBNL DIV, PI Last Name, Sponsor Name]

Attachment: SPPF Package

The Sponsor has requested contractual language to be included in the proposed Agreement that we believe results in a publication restriction. I have attached the originally proposed Agreement as well as the proposed changes by the Sponsor that we are concerned with. In addition, I have attached the proposed Scope of Work for the project.

Please let me know of any export control issues related to this project as well as your comments regarding the proposed publication restrictions.

Industry Partnerships

PROPOSAL _____ This is an amendment. No DOE approval is needed.

SPONSOR _____

PI _____

ALLOCATION OF PATENT RIGHTS UNDER NON-FEDERAL WORK FOR OTHERS

A. Class waiver applies Exhibit A -
DOE APPROVAL REQUIRED.

B. Class waiver does not apply because:

1. Sponsor declines rights (Attach documentation). Exhibit B or D.
DOE APPROVAL REQUIRED

2. Sponsor is a foreign entity. Exhibit B. See explanation below.
DOE APPROVAL REQUIRED

3. Likely invention(s) would be a research tool(s) which should be available to many organizations (Explain). Exhibit B.
DOE APPROVAL REQUIRED

4. A domestic Sponsor's interest to appropriately commercialize is in fewer fields of use (Explain). Exhibit B (Use alternate Paragraph 2, Article XIV, Patent Rights)
DOE APPROVAL REQUIRED

5. LBNL is entitled to Bayh-Dole rights (Sponsor's funding is from a federal agency. (Explain). Exhibit B or Exhibit D
NO DOE APPROVAL NEEDED

6. Sponsor is UC. Use Exhibit E and Exhibit E (REF.)
NO DOE APPROVAL NEEDED

7. There are special facts and it is not in the best interests of the United States. (Explain) Exhibit B
DOE APPROVAL REQUIRED

Explanation: DOE has programmatic interest in the technology completed by the SOW (foreign only)

C. Patent article is reserved because no R&D is contemplated (Standard laboratory analysis, technical assistance, training, etc. explain). Exhibit C/ Exhibit O
NO DOE APPROVAL NEEDED

D. Agreement type used, circle appropriate Exhibit:

A B C D E O Other: _____

Contracts Officer

Date

If using Exhibit A or Exhibit B (where B.1, 2, 3, 4 or 7 apply)

DOE APPROVAL REQUIRED

Concurred

By: _____

DOE Patent Counsel

Date



Office of Sponsored Projects & Industry Partnerships

Director's Memo re Publication Restriction ([Link to Word doc version](#))

Date:

To: Lab Director

From: [Division Head]
[Sponsored Projects Head]

Subject: Approval of Research Project Involving Publication Restrictions

The [Program and or Division] wishes to submit a proposal to [Sponsor Name]. The project, "[title]" would run for [period of performance] at a level of \$[amount]. Success could lead to renewed proposals. The statement of work is attached.

[Sponsor] requires that this contract contain terms and conditions that would allow its staff to review manuscripts and block publication of selected search results. Under LBNL policy, and consistent with University of California policy, your approval is required for any such contract. We request your approval to submit the proposal under the following conditions:

1. No students or postdoctoral fellows would participate in the research.
2. The group confirms that, in what they regard as the unlikely event that some or all of the results cannot be published, the increased knowledge of [subject matter] that would be gained as a result of doing this research would be of great benefit to the [Division or group] in its other efforts, which are funded by DOE and other agencies.
3. The staff scientists involved in this work initial this letter indicating that they realize that if some of their work cannot be published because of security requirements, it is possible that it would not be available for full consideration in the annual evaluation of their performance here at the Laboratory.
4. Continuations or expansions of this project beyond the limited period of performance described here, or other research activities with possible publication restrictions would have to be considered independently, and this approval would not be used as a precedent.

We appreciate your consideration of this matter.

Approved by: _____ Date: _____
Lab Director

Att: SOW