



# SPO Contracts Officer Guidance

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

Sponsored Projects Office  
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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, such as standard laboratory analysis or characterization, 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 Sponsored Projects Office (SPO) 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 SPO 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 SPO Manager's approval. All other deviations will require DOE approval.

## [Non-Federal Proposal Approval Process](#)

Version Note: This replaces the January 2008 update to reflect that DOE will not be sending the approved Exhibit F (Allocation of Patent rights form) back to the Contracts Officer.

DOE requires Berkeley Site Office approval of patent rights disposition. That function is no longer delegated to LBNL. TTIPM review of allocation of intellectual property rights is no longer required for proposals using, WFO Agreements other than Exhibit A (as of January 1, 2008).

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### [Foreign WFO Proposal Pre-approval<sup>1</sup> 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.

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### *For ALL Non Federal Proposals*

#### 1. DOE Review Packages

Send either Package A or Package B.

##### A. Proposal Review Package

Send the following to Jocelyn Byrd (Jacolyn-Byrd@bso.science.doe.gov) (See Email Templates DOE Email [Templates](#) 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

##### With copies to

1. Gary Drew (Gary.Drew@bso.science.doe.gov),
2. Chuck Marshall (Charles.Marshall@bso.science.doe.gov),
3. Yvette Dunmore (yvette.dunmore@bso.science.doe.gov)(Effective 05/07/09)

##### B. Waiver Review (Only) Package

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

- Waiver Form (only)

##### With copies to

1. Gary Drew (Gary.Drew@bso.science.doe.gov),
2. Chuck Marshall (Charles.Marshall@bso.science.doe.gov),
3. Yvette Dunmore (yvette.dunmore@bso.science.doe.gov)(Effective 05/07/09)

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<sup>1</sup> Per 04/17/08 J. Weiner email.

## 2. TTIPM Proposal Review for WFO and CRADAs

Proposal review packages will also be copied to TTIPM under the following circumstances:

- A. TTIPM - Exhibit A (*DOE* package)
- B. TTIPM - Foreign Sponsor (*SPPF* package)
- C. TTIPM and FVA - Publication Restriction (*SPPF* package)

\*\*\*\*\*

- A. TTIPM if Exhibit A (WFO).  
(See attached Email [Template 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 SPO Contracting Officer via email if they have concerns over the proposed Exhibit A Agreement.

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

- B. TTIPM if Foreign Sponsor (WFO & CRADAs (Including Amendments with SOW Changes))<sup>2</sup>

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

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

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

SPO 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 TTIPM raises objections.

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

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

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<sup>2</sup> 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 patent practitioners who have some export control training is appropriate.

**C. TTIPM and FVA if there is a Publication Restriction Requested (WFO & CRADA)<sup>3</sup>.**  
(See attached Email [Template 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 SPO 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 TTIPM 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 SPO Contracting Officer and TTIPM 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, SPO 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 SPO 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 SPO Contracting Officer will include the memo with the Laboratory Director's signature approving the acceptance of the restriction in the SPO 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.

Jocelyn 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.

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<sup>3</sup> Ibid.

**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 SPO 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**

LBNL 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: [Jacolyn.Byrd@bso.science.doe.gov](mailto:Jacolyn.Byrd@bso.science.doe.gov)  
Cc: [Charles.marshall@bso.science.doe.gov](mailto:Charles.marshall@bso.science.doe.gov)  
[Gary.drew@bso.science.doe.gov](mailto:Gary.drew@bso.science.doe.gov)  
[yvette.dunmore@bso.science.doe.gov](mailto:yvette.dunmore@bso.science.doe.gov) (Effective 05/09/2009)

**Subject:** WFO Proposal No. [00000XXXX]  
**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: [Jacolyn.Byrd@bso.science.doe.gov](mailto:Jacolyn.Byrd@bso.science.doe.gov)  
Cc: [Charles.marshall@bso.science.doe.gov](mailto:Charles.marshall@bso.science.doe.gov)  
[Gary.drew@bso.science.doe.gov](mailto:Gary.drew@bso.science.doe.gov)  
[yvette.dunmore@bso.science.doe.gov](mailto:yvette.dunmore@bso.science.doe.gov) (Effective 05/09/2009)

**Subject:** WFO Waiver for Proposal No.[ 00000XXXX]  
**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]

## TTIPM Email Templates

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

To: MLHart@lbl.gov

CC: SPO Contracting Officer

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

Attachment: DOE Approval Package

SPO 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:

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

To: Patent Practitioner (See list by [Division](#))

Cc: SPO 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.

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

Email Templates - TTIPM (continued)

For Publication Restriction Request

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

To: Patent Practitioner (See list by [Division](#))

Cc: FVA@lbl.gov

cc: SPO 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.

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



Sponsored Projects Office

## Director's Memo re Publication Restriction

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