

## § 780.53

shall proceed with a hearing and render its decision.

### § 780.53 Criteria for decisions for royalties, awards and compensation.

(a) In deciding a reasonable royalty fee for a patent licensed under section 158 or sections 153b or 153e of the Act, the Board shall consider:

(1) The economic value of the compulsory license and the Board shall strive to provide adequate remuneration for the circumstances of each case.

(2) Any defense, general or special, that a defendant could plead in an action for infringement;

(3) The extent to which such patent was developed through federally financed research or with other Federal support;

(4) The degree of utility, novelty, and importance of the invention or discovery; and

(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:

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(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

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AUTHORITY: 42 U.S.C. 2186, 42 U.S.C. 2201(g), and 35 U.S.C. 207–209.

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

### GENERAL PROVISIONS

#### § 781.1 Scope.

The regulations of this part supplement the U.S. Department of Commerce regulations, entitled LICENSING OF GOVERNMENT OWNED INVENTIONS, at 37 CFR Part 404.

[77 FR 4889, Feb. 1, 2012]

#### § 781.2 Policy.

(a) It is the policy of this regulation to use the patent system to promote the utilization of inventions arising from Department of Energy supported research and development.

(b) Decisions as to grants or denials of any license application will, in the discretion of the Secretary of Energy,

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be based on the Department of Energy'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 of Energy under these regulations may be made on the Secretary of Energy's behalf by the Assistant General Counsel for Technology Transfer and Intellectual Property, except where otherwise delegated.

[77 FR 4889, Feb. 1, 2012]

### § 781.3 [Reserved]

### § 781.4 Communications.

All communications concerning the regulations in this part, including applications for licenses, should be addressed or delivered to the General Counsel, Attention: Assistant General Counsel for Technology Transfer and Intellectual Property, U.S. Department of Energy, 1000 Independence Avenue SW., Washington, DC 20585.

[77 FR 4889, Feb. 1, 2012]

### TYPES OF LICENSES AND CONDITIONS FOR LICENSING

### §§ 781.51–781.52 [Reserved]

### § 781.53 Additional licenses.

Subject to any outstanding licenses, nothing in this part shall preclude the Department of Energy from granting additional nonexclusive, or exclusive, or partially exclusive licenses for inventions covered by this part when the Department of Energy determines that to do so would provide for an equitable exchange of patent rights. The following circumstances are examples in which such licenses may be granted:

(a) In consideration of the settlement of interferences or other administrative proceedings before the U.S. Patent and Trademark Office;

(b) In consideration of a release of any claims;

(c) In exchange for or as a part of the consideration for a license under adversely held patents;

(d) As necessary for meeting obligations of the U.S. under any treaty, international agreement arrangement or cooperation, memorandum of understanding or similar arrangement; or

(e) In consideration for the settlement or resolution of any proceeding under the Department of Energy Organization Act or other law.

[77 FR 4889, Feb. 1, 2012]

### PROCEDURES

### §§ 781.61–781.64 [Reserved]

### § 781.65 Appeals.

(a) Standing. The following parties have the right to appeal under this part:

(1) Pursuant to 37 CFR 404.11:

(i) A person whose application for a license has been denied;

(ii) A licensee whose license has been modified or terminated, in whole or in part;

(iii) A person who timely filed a written objection in response to the notice required by 37 CFR 404.7(a)(1)(i) or (b)(1)(i) and who can demonstrate to the satisfaction of the Federal agency that such person may be damaged by the agency action; or

(2) A management and operating contractor appealing an agency decision to grant a copyright license to a third party pursuant to the Rights in Data-Technology Transfer clause for DOE management and operating contracts per 48 CFR part 970.

(b) Notice of Appeal. Appeal under paragraph (a) of this section shall be initiated by filing a Notice of Appeal with the Secretary, ATTN: Deputy General Counsel for Technology Transfer and Procurement (“Deputy General Counsel”), within thirty (30) days from the date of receipt of a written notice by the Department of Energy of an action set forth in paragraph (a) of this section. The Notice of Appeal shall specify the portion of the decision from which the appeal is taken. A statement of fact and argument in the form of a brief in support of the appeal shall be submitted with the Notice of Appeal or within thirty (30) days thereafter.

(c) Procedure. Appeals under this section shall be conducted pursuant to rules of procedure provided by the Deputy General Counsel.

(d) Within sixty (60) days of receiving appellant's brief pursuant to paragraph (b) of this section or such other time

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period set by the Deputy General Counsel, the Office of the Assistant General Counsel for Technology Transfer and Intellectual Property shall submit to the Deputy General Counsel a response brief and shall timely serve a copy of the response brief to appellant.

(e) The Deputy General Counsel shall consider the facts and arguments submitted in appellant's brief submitted under paragraph (b) of this section, as well as those presented by the Assistant General Counsel for Technology Transfer and Intellectual Property. An appeal by a licensee under paragraph (a)(1)(ii) of this section may include a hearing, upon request of the licensee, to address a dispute over any relevant fact. Such request for a hearing must be received by the Deputy General Counsel within thirty (30) days of appellant's receipt of the response brief.

(f) The Deputy General Counsel shall issue a written decision, which shall constitute the final action of the Department on the matter.

(g) The parties may agree to Alternate Dispute Resolution in lieu of an appeal.

(h) Appeals Arising Under National Nuclear Security Administration (NNSA) Management and Operating Contracts. For appeals pursuant to paragraph (a)(2) of this section arising under management and operating contracts administered by NNSA for NNSA facilities, the NNSA Deputy General Counsel for Procurement shall be designated as the appeal authority (Deputy General Counsel) pursuant to paragraphs (b) through (f) of this section.

[77 FR 4890, Feb. 1, 2012]

**§ 781.66 [Reserved]**

SPECIAL PROVISIONS

**§ 781.71 [Reserved]**

**§ 781.81 [Reserved]**

**PART 782—CLAIMS FOR PATENT AND COPYRIGHT INFRINGEMENT**

**Subpart A—General**

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782.2 Objectives.

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782.3 Authority.

**Subpart B—Requirements and Procedures**

782.5 Contents of communication initiating claim.

782.6 Processing of administrative claims.

782.7 Incomplete notice of infringement.

782.8 Indirect notice of infringement.

AUTHORITY: Dept. of Energy Organization Act; sec. 651, 91 Stat. 601, 42 U.S.C. 7261; Atomic Energy Act of 1954; sec. 107(d), 88 Stat. 1241, 42 U.S.C. 5817(d); sec. 161(g), 80 Stat. 443, 42 U.S.C. 2201(g); sec. 172, 62 Stat. 933, 42 U.S.C. 2223; Foreign Assistance Act of 1961, sec. 2356, 75 Stat. 440, 22 U.S.C. 2356; Patents, Invention Secrecy Act; sec. 183, 66 Stat. 4, 35 U.S.C. 183; Judiciary and Judicial Procedure Act, sec. 1498, 62 Stat. 601, 28 U.S.C. 1498.

SOURCE: 45 FR 26950, Apr. 22, 1980, unless otherwise noted.

**Subpart A—General**

**§ 782.1 Purpose.**

The purpose of this regulation is to set forth policies and procedures for the filing and disposition of claims asserted against the Department of Energy of infringement of privately owned rights in patented inventions or copyrighted works.

**§ 782.2 Objectives.**

Whenever a claim of infringement of privately owned rights in patented inventions or copyrighted works is asserted against the Department of Energy, all necessary steps shall be taken to investigate and to settle administratively, to deny, or otherwise to dispose of such claim prior to suit against the United States.

**§ 782.3 Authority.**

The General Counsel or the General Counsel's delegate is authorized to investigate, settle, deny, or otherwise dispose of all claims of patent and copyright infringement pursuant to 42 U.S.C. 2201(g), 2223, 5817(d) and 7261; the Foreign Assistance Act of 1961, 22 U.S.C. 2356 (formerly the Mutual Security Acts of 1951 and 1954); the Invention Secrecy Act, 35 U.S.C. 183; and 28 U.S.C. 1498.