

APPENDIX D-8

INTELLECTUAL PROPERTY PROVISIONS

Supply And Services Contract Requiring Delivery of Data

Article

- I. Authorization and Consent
- II. Notice and Assistance Regarding Patent and Copyright Infringement
- III. Reporting of Royalties
- IV. Patent Indemnity - Supplies and Services
- V. Rights in Data - General (June 1987)
- VI. Additional Data Requirements

I. AUTHORIZATION AND CONSENT

The Government has given its authorization and consent for all use and manufacture of any invention described in and covered by a patent of the United States in the performance of this contract or any part hereof or any amendment hereto or any subcontract hereunder (including any lower-tier subcontract).

II. NOTICE AND ASSISTANCE REGARDING PATENT AND COPYRIGHT INFRINGEMENT.

The provisions of this clause shall be applicable only if the amount of this contract exceeds \$10,000.

- (a) The Contractor shall report to the Government through the Laboratory, promptly and in reasonable written detail, each notice or claim of patent or copyright infringement based on the performance of this contract of which the Contractor has knowledge.
- (b) In the event of any claim or suit against the Government on account of any alleged patent or copyright infringement arising out of the performance of this contract or out of the use of any supplies furnished or work or services performed hereunder, the Contractor shall furnish to the Government when requested by the Government or the Laboratory all evidence and information in possession of the Contractor pertaining to such suit or claim. Such evidence and information shall be furnished at the expense of the Government except where the Contractor has agreed to indemnify the Government or the Laboratory.
- (c) This clause shall be included in all subcontracts.

III. REPORTING OF ROYALTIES

If this contract is in an amount which exceeds \$10,000 and if any royalty payments are directly involved in the contract or are reflected in the contract price to the Laboratory, the Contractor agrees to report in writing to the Government through the Laboratory during the performance of this contract and prior to its completion or final settlement the amount of any royalties or other payments paid or to be paid by it directly to others in connection with the names and addresses of licensors to whom such payments are made and either the patent numbers involved or such other information as will permit identification of the patents or other basis on which the royalties are to be paid. The approval of DOE or the Laboratory of any individual payments or royalties shall not stop the Government at any time from contesting the enforceability, validity or scope of, or title to, any patent under which a royalty or payments are made.

IV. PATENT INDEMNITY - SUPPLIES AND SERVICES

If the amount of this contract is in excess of \$10,000, the Contractor shall indemnify the Laboratory, the Government, and their officers, agents, and employees against liability, including costs, for infringement of any United States letters patent (except U. S. letters patent issued upon an application which is now or may hereafter be kept secret or otherwise withheld from issue by order of the Government) arising out

of the manufacture or delivery of supplies or out of construction, alteration, modification, or repair of real property (hereinafter referred to as "construction work") under this contract, or out of the use or disposal by or for the account of the Government or the Laboratory of such supplies or construction work. The foregoing indemnity shall not apply unless the Contractor shall have been informed as soon as practicable by the Government via the Laboratory of the suit or action alleging such infringement, and shall have been given such opportunity as is afforded by applicable laws, rules, or regulations to participate in the defense thereof; and further, such indemnity shall not apply to:

- (i) an infringement resulting from compliance with specific written instructions of the Laboratory or the Government directing a change in the supplies to be delivered or in the materials or equipment to be used, or directing a manner of performance of the contract not normally used by the Contractor;
- (ii) an infringement resulting from addition to, or change in, such supplies or components furnished or construction work performed which addition or change was made subsequent to delivery or performance by the Contractor; or
- (iii) a claimed infringement which is settled without the consent of the Contractor, unless required by final decree of a court of competent jurisdiction.

V. RIGHTS IN DATA - GENERAL (JUNE 1987)

(a) Definitions.

"Computer software," as used in this clause, means computer programs, computer data bases, and documentation thereof.

"Data," as used in this clause, means recorded information, regardless of form or the media on which it may be recorded. The term includes technical data and computer software. The term does not include information incidental to contract administration, such as financial, administrative, cost or pricing, or management information.

"Form, fit, and function data," as used in this clause, means data relating to items, components, or processes that are sufficient to enable physical and functional interchangeability, as well as data identifying source, size, configuration, mating, and attachment characteristics, functional characteristics, and performance requirements; except that for computer software it means data identifying source, functional characteristics, and performance requirements but specifically excludes the source code, algorithm, process, formula, and flow charts of the software.

"Limited rights data," as used in this clause, means data (other than computer software) developed at private expense that embody trade secrets or are commercial or financial and confidential or privileged.

"Technical data," as used in this clause, means data (other than computer software) which are of a scientific or technical nature.

"Restricted computer software," as used in this clause, means computer software developed at private expense and that is a trade secret; is commercial or financial and is confidential or privileged; or is published copyrighted computer software; including minor modifications of such computer software.

"Unlimited rights," as used in this clause, means the right of the Government and the Laboratory to use, disclose, reproduce, prepare derivative works, distribute copies to the public, and perform publicly and display publicly, in any manner and for any purpose, and to have or permit others to do so.

"Limited rights," as used in this clause, means the rights of the Government and the Laboratory in limited rights data as set forth in the Limited Rights Notice of subparagraph (g)(2) if included in this clause.

"Restricted rights," as used In this clause, means the rights of the Government and the Laboratory in restricted computer software, as set forth In a Restricted Rights Notice of subparagraph (g)(3) if included In this clause, or as otherwise may be provided in a collateral agreement incorporated in and made part of this contract, including minor modifications of such computer software.

(b) Allocations of rights.

- (1) Except as provided in paragraph (c) below regarding copyright, the Government and the Laboratory shall have unlimited rights in-
 - (i) Data first produced in the performance of this contract;
 - (ii) Form, fit, and function data delivered under this contract;
 - (iii) Data delivered under this contract (except for restricted computer software) that constitute manuals or instructional and training material for installation, operation, or routine maintenance and repair items, components, or processes delivered or furnished for use under this contract; and
 - (iv) All other data delivered under this contract unless provided otherwise for limited rights data or restricted computer software in accordance with paragraph (g) below.
- (2) The Contractor shall have the right to-
 - (i) Use, release to others, reproduce, distribute, or publish any data first produced or specifically used by the Contractor in the performance of the contract, unless provided otherwise in paragraph (d) below;

- (ii) Protect from unauthorized disclosure and use those data which are limited rights data or restricted computer software to the extent provided in paragraph (g) below;
- (iii) Substantiate use of, add or correct limited rights, restricted rights, or copyright notices and to take other appropriate action, in accordance with paragraphs (e) and (f) below; and
- (iv) Establish claim to copyright subsisting In data first produced In the performance of this contract to the extent provided in subparagraph (c)(1) below.

(c) Copyright.

- (1) Data first produced in the performance of this contract. Unless provided otherwise in subparagraph (d) below, the Contractor may establish, without prior approval of the DOE, claim to copyright subsisting in scientific and technical articles based on or containing data first produced in the performance of this contract and published in academic, technical or professional journals, symposia proceedings or similar works. The prior, express written permission of the DOE (with notice to the Laboratory) is required to establish claim to copyright subsisting in all other data first produced in the performance of this contract. When claim to copyright is made, the Contractor shall affix the applicable copyright notices of 17 USC 401 or 402 and acknowledgment of Government sponsorship (including contract number) to the data when such data are delivered to the Laboratory and the Government, as well as when the data are published or deposited for registration as a published work in the U.S. Copyright Office. For data other than computer software the Contractor grants to the Government, and others acting on its behalf, a paid-up, nonexclusive, irrevocable worldwide license in such copyrighted data to reproduce, prepare derivative works, distribute copies to the public, and perform publicly and display publicly, by or on behalf of the Government. For computer software, the Contractor grants to the Government and others acting on its behalf, a paid-up nonexclusive, irrevocable worldwide license in such copyrighted computer software to reproduce, prepare derivative works, and perform publicly and display publicly by or on behalf of the Government.
- (2) Data not first produced in the performance of this contract. The Contractor shall not, without prior written permission of the DOE via the Laboratory, incorporate in data delivered under this contract any data not first produced in the performance of this contract and which contains the copyright notice of 17 USC 401 and 402, unless the Contractor identifies such data and grants to the Government, or acquires on its behalf, a license of the same scope as set forth in subparagraph (1) above; provided, however, that if such data are computer software the Government shall acquire a copyright license as set forth in subparagraph (g)(3) below if included in this contract or as otherwise may be provided in a collateral agreement incorporated in or made part of this contract.

- (3) Removal of copyright notices. The Laboratory and the Government agree not to remove any copyright notices placed on data pursuant to this paragraph (c), and to include such notices on all reproductions of the data.
- (d) Release, publication and use of data.
- (1) The Contractor shall have the right to use, release to others, reproduce, distribute, or publish any data first produced or specifically used by the Contractor in the performance of this contract, except to the extent such data may be subject to the federal export control or national security laws or regulations, or unless otherwise provided below in this paragraph or expressly set forth in this contract.
 - (2) The Contractor agrees that to the extent it receives or is given access to data necessary for the performance of this contract which contain restrictive markings, the Contractor shall treat the data in accordance with such markings unless otherwise specifically authorized in writing by the DOE (with notice to the Laboratory).
 - (3) The Contractor agrees not to establish claim to copyright in computer software first produced in the performance of this contract without prior written permission of the DOE (with notice to the Laboratory). When such permission is granted, the DOE shall specify appropriate terms to assure dissemination of the software. The Contractor shall promptly deliver to the DOE or to the Patent Counsel designated by the DOE a duly executed and approved instrument fully confirmatory of all rights to which the Government is entitled, and other terms pertaining to the computer software to which claim to copyright is made.
- (e) Unauthorized marking of data.
- (1) Notwithstanding any other provisions of this contract concerning inspection or acceptance, if any data delivered under this contract are marked with the notices specified in subparagraphs (g)(2) or (g)(3) below and use of such is not authorized by this clause, or if such data bears any other restrictive or limiting markings not authorized by this contract, the DOE or the Laboratory, with the approval of DOE, may at any time either return the data to the Contractor, or cancel or ignore the markings. However, the following procedures shall apply prior to canceling or ignoring the markings.
 - (i) The DOE or the Laboratory, with the approval of DOE, shall make written inquiry to the Contractor affording the Contractor 30 days from receipt of the inquiry to provide written justification to substantiate the propriety of the markings;
 - (ii) If the Contractor fails to respond or fails to provide written justification to substantiate the propriety of the markings within the 30-day period (or a longer time not exceeding 90 days approved in writing by the DOE for good cause shown), the Government shall have the right, and may direct the Laboratory, to cancel or to ignore the markings at any time after said period and the data will not longer be made subject to any disclosure prohibitions.

- (iii) If the Contractor provides written justification to substantiate the propriety of the markings within the period set in subdivision (i) above, the Government shall consider such written justification and determine, whether or not the markings are to be cancelled or ignored. If the Government determines that the markings are authorized, the Contractor shall be so notified in writing. If DOE determines that the markings are not authorized, the DOE shall furnish the Contractor a written determination, which determination shall become the final agency decision regarding the appropriateness of the markings unless the Contractor files suit in a court of competent jurisdiction within 90 days of receipt of the DOE's decision. The Government and the Laboratory shall continue to abide by the markings under this subdivision (iii) until final resolution of the matter either by the DOE's determination becoming final (in which instance the Government or the Laboratory with DOE approval shall thereafter have the right to cancel or ignore the markings at any time and the data will no longer be made subject to any disclosure prohibitions), or by final disposition of the matter by court decision if suit is filed.
 - (2) The time limits in the procedures set forth in subparagraph (1) above may be modified in accordance with agency regulations implementing the freedom of Information Act (5 USC 552) if necessary to respond to a request thereunder.
 - (3) This paragraph (e) does not apply if this contract is for a major system or for support of a major system by a civilian agency other than NASA and the U.S. Coast Guard subject to the provisions of Title III of the federal Property and Administrative Services Act of 1949.
 - (4) Except to the extent the Government's action occurs as the result of final disposition of the matter by a court of competent jurisdiction, the Contractor is not precluded by this paragraph (e) from bringing a claim under the Contract Disputes Act, including pursuant to the Disputes clause of this contract, if any, as applicable, that may arise as the result of the Government removing or ignoring authorized markings on data delivered under this contract.
- (f) Omitted or incorrect markings.
- (1) Data delivered to the Laboratory or the Government without either the limited rights or restricted rights notice as authorized by paragraph (g) below, or the copyright notice required by paragraph (c) above, shall be deemed to have been furnished with unlimited rights, and the Government and the Laboratory assume no liability for disclosure, use, or reproduction of such data. However, to the extent the delivered data has not been further disclosed without restriction outside the Government, the Contractor may request, within 6 months (or a longer time approved by the Government for good cause shown) after delivery of such data, permission to have notices placed on qualifying data at the Contractor's expense, and the Government or the Laboratory with DOE approval may agree to do so if the Contractor-

- (i) Identifies the data to which the omitted notice is to be applied;
 - (ii) Demonstrates that the omission of the notice was inadvertent;
 - (iii) Establishes that the use of the proposed notice is authorized; and
 - (iv) Acknowledges that the Government and the Laboratory have no liability with respect to the disclosure, use, or reproduction of any such data made prior to the addition of the notice or resulting from the omission of the notice.
- (2) The Government (with notice to the Laboratory) may also (i) permit correction at the Contractor's expense of incorrect notices if the Contractor identifies the data on which correction of the notice is to be made, and demonstrates that the correct notice is authorized, or (ii) correct any incorrect notices.
- (g) Protection of limited rights data and restricted computer software.
- (1) When data other than that listed in subparagraphs (b)(1)(i), (ii), and (iii) above are specified to be delivered under this contract and qualify as either limited rights data or restricted computer software, if the Contractor desires to continue protection of such data, the Contractor shall withhold such data and not furnish them to the Laboratory or the Government under this Contract. As a condition to this withholding, the Contractor shall identify the data being withheld furnish form, fit, and function data in lieu thereof. Limited rights data are formatted as a computer data base for delivery to the Laboratory or the Government is to be treated as limited rights data and not restricted computer software.
 - (2) (Reserved.)
 - (3) (Reserved.)
- (h) Subcontracting. Contractor has the responsibility to obtain from its Subcontractors all data and rights therein necessary to fulfill the Contractor's obligations to the Government and the Laboratory under this contract. If a Subcontractor refuses to accept terms affording the Government such rights, the Contractor shall promptly bring such refusal to the attention of the Government via the Laboratory and not proceed with subcontract award without further authorization from DOE via the Laboratory.
- (i) Relationship to patents. Nothing contained in this clause shall imply a license to the Government or the Laboratory under any patent or be construed as affecting the scope of any license or other right otherwise granted to the Government or the Laboratory.
- (j) The Contractor agrees, except as may be otherwise specified in this contract for specific data items listed as not subject to this paragraph that the DOE and the Laboratory or an authorized representative may, up to three years after acceptance of all items to be delivered under this

contract, inspect at the Contractor's facility any data withheld pursuant to paragraph (g)(1) above, for purposes of verifying the Contractor's assertion pertaining to the rights or restricted rights status of the data or for evaluating work performance. Where the Contractor whose data are to be inspected demonstrates to the DOE or the Laboratory that there would be a possible conflict of interest if the inspection were made by a particular representative, the DOE or the Laboratory shall designate an alternate inspector.

VI. ADDITIONAL DATA REQUIREMENTS

Note: This clause does not apply to this contract if the contract is for the conduct of basic or applied research, as set out elsewhere in this contract, to be performed solely by a college or university, and the estimated cost is not in excess of \$500,000.

- (a) In addition to the data (as defined in the clause at 52.227-14, Rights in Data-General clause or other equivalent included in this contract) specified elsewhere in this contract to be delivered, the Laboratory or the DOE may, at any time during contract performance or within a period of 3 years after acceptance of all items to be delivered under this contract, order any data first produced or specifically used in the performance of this contract.
- (b) The Rights in Data-General clause or other equivalent included in this contract is applicable to all data ordered under this Additional Data Requirements clause. Nothing contained in this clause shall require the Contractor to deliver any data the withholding of which is authorized by the Rights in Data-General or other equivalent clause of this contract, or data which are specifically identified in this contract as not subject to this clause.
- (c) When data are to be delivered under this clause, the Contractor will be compensated for converting the data into the prescribed form, for reproduction, and for delivery.
- (d) The DOE via the Laboratory may release the Contractor from the requirements of this clause for specifically identified data items at any time during the 3-year period set forth in (a) of this clause.