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IP and STIP

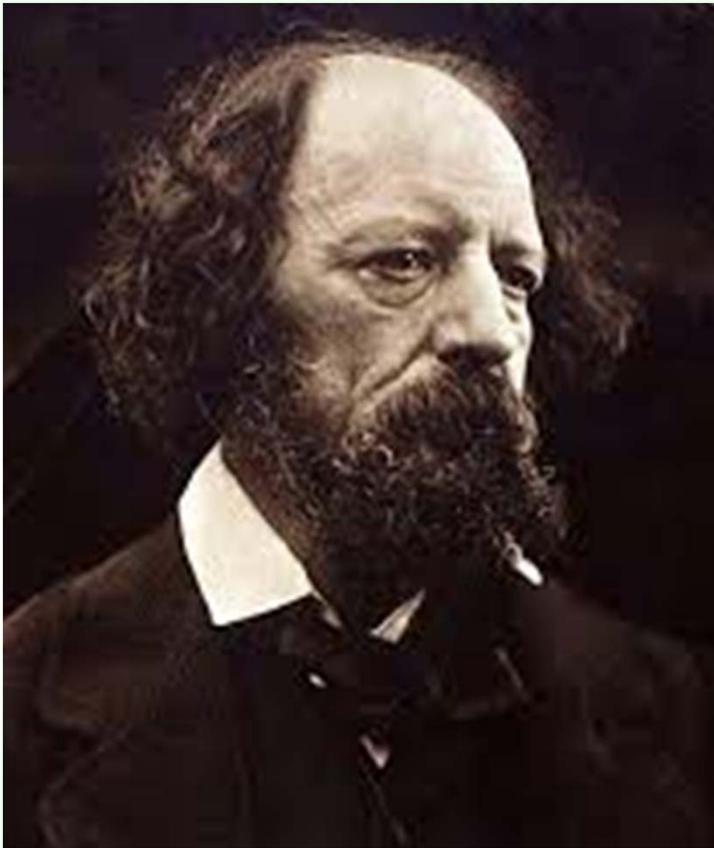
*DOE STIP Working Group Meeting
April 2, 2014*

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Overview

- Disclaimer
- An IP perspective on the STIP Program
- Statutory Authorities
- Copyright Law & Theory
- Copyright Infringement & Other Pitfalls
- Government Rights in Data
- Elsevier Case Study

A Challenge: Maximizing Taxpayers' ROI



*How dull it is to pause,
to make an end,
To rust unburnish'd,
not to shine in use!*

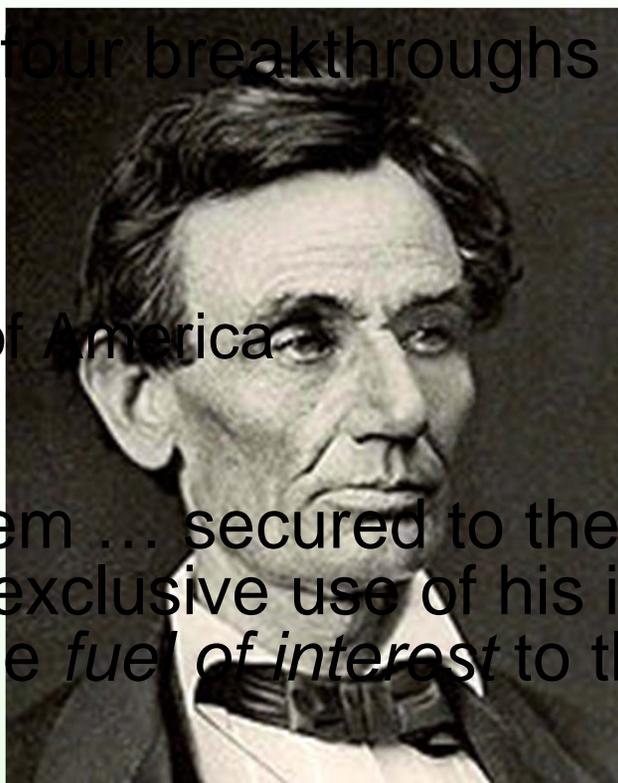
--Alfred, Lord Tennyson



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Patents: Ideas at Work

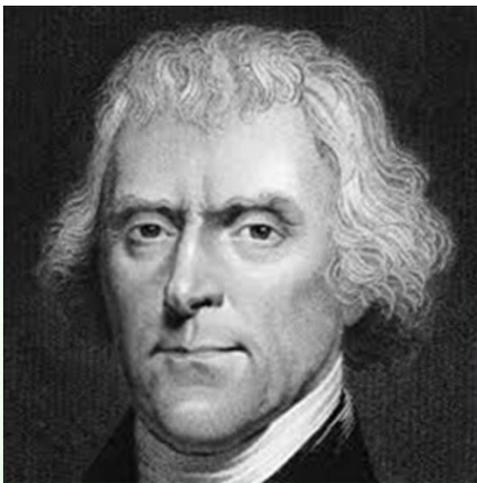
- Patents protect inventions for a limited time in exchange for public disclosure
- Only patent holder among U.S. Presidents?
- Lincoln's top four breakthroughs of all time:
 - Writing
 - Printing
 - Discovery of America
 - Patent law



“The patent system ... secured to the inventor, for a limited time, the exclusive use of his invention; and thereby added the *fuel of interest* to the *fire of genius*.”

The Inherent Value of Ideas

- But what about ideas that can't or shouldn't be patented?
 - “Technology transfer” is more than creating and licensing IP
 - DOE does science for science's sake
 - Most of the value of DOE's STI doesn't derive from IP
- OSTI/STIP's mission is to put DOE's information and ideas to work
- Jefferson on valuing ideas above and beyond property rights:



“He who receives an idea from me, receives instruction himself without lessening mine; as he who lights his taper at mine, receives light without darkening me. That ***ideas should freely spread from one to another over the globe, for the moral and mutual instruction of man, and improvement of his condition***, seems to have been peculiarly and benevolently designed by nature[.]”



Statutory Authority: AEC

- Atomic Energy Act of 1954
 - Transition from military to civilian R&D
 - Authority to enter arrangements with private and public institutions
 - But arrangements cannot prevent dissemination of STI unless prohibited by law
 - Dissemination of STI “should be permitted and encouraged so as to provide that free interchange of ideas and criticism which is essential to scientific and industrial progress[.]”
42 U.S.C. § 2161

Statutory Authority: ERDA

- Energy Reorganization Act of 1974
 - Transition from nuclear energy to all energy
 - Inherited AEC's authority
 - “[D]eveloping, collecting, distributing, and making available for distribution [STI]; ... creating and encouraging the development of general information to the public; disseminat[ing] such information through the *use of mass communications*[.]” 42 U.S.C. § 5813
 - Dissemination of STI to “**enlarge the fund of** such information[.]” 42 U.S.C. § 5817

Statutory Authority: DOE & Beyond

- DOE Organization Act of 1977
 - Inherited ERDA's (and AEC's) authority
 - Disseminate information from energy R&D; 42 U.S.C. § 7112
 - Establish “a central source of information ... made available to the public” 42 U.S.C. § 5916
- EPACT 2005
 - “[OSTI] shall maintain within the Department publicly available collections of [STI] resulting from research, development, demonstration, and commercial applications activities supported by the Department.” 42 U.S.C. § 16322
- Bottom line: words of encouragement are now a **mandate** to disseminate STI to the public



Basic Copyright Law

- Protects “original works of authorship fixed in any tangible medium of expression, now known or later developed[.]” 17 U.S.C. § 102
- Scope of Protection
 - Published and unpublished works
 - From the moment the work is created
 - Registration with copyright office is not required, but useful if you’re going to sue somebody
- *Doesn’t* protect mere ideas

What Works Can Be Protected?

- Books, brochures, newspapers, periodicals
- Music and/or lyrics
- Dramatic works
- Pantomimes and choreographic works
- Paintings, architecture, sculptures, photos
- Sound recordings
- Audiovisual works (film, TV, YouTube...)
- Computer programs

What What Are Copyright Rights?

- Reproduce (copy) the copyrighted work
- Prepare derivative works
- Distribute copies to the public
 - Sale/transfer, rental, lease, lending...
- Perform the copyrighted work publicly
- Display the copyrighted work publicly



The unauthorized reproduction or distribution of this copyrighted work is illegal. Criminal copyright infringement is investigated by federal law enforcement agencies and is punishable by up to 5 years in prison and a fine of \$250,000.



Three Theories of Copyright - 1

➤ “It’s All About the Benjamins!”

→ Copyright terms through the ages

- Privilege (UK 1518): 2 years
- Statute of Anne (UK 1709): 14 years (+ 14 years)
 - Copied almost word for word by U.S. in 1790
- Copyright Act of 1831: 28 years (+ 14 years)
- Copyright Act of 1909: 28 years (+ 28 years)
- Copyright Act of 1976: life + 50 years
- Copyright Term Extension Act of 1998: life + 70 years
 - aka: “Mickey Mouse Copyright Term Extension Act”
 - Now Mickey “expires” in 2023



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Three Theories of Copyright - 2

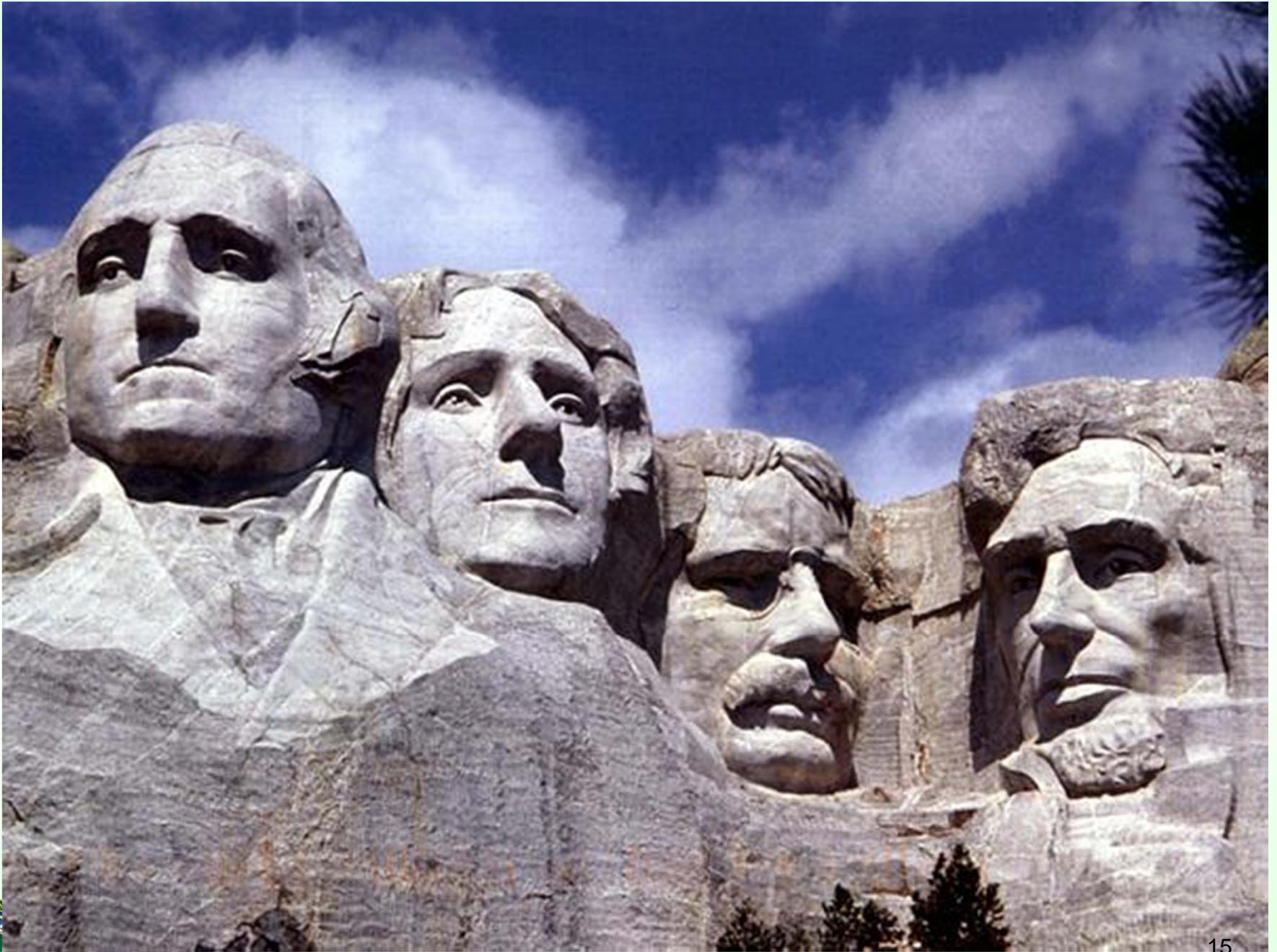
- “Help, help! I’m being repressed!”
 - ➔ The (church/government/secret cabal) wields copyright to curb free flow of information
 - E.g.: Gutenberg c. 1450, papal bull issued in 1501: no unlicensed copying of books!
 - ➔ Copyrights are a (privilege/monopoly) that inherently favors pro-government speech
 - ➔ The free internet is our best weapon against the police state
 - ➔ (and strengthening anti-piracy laws will destroy

HELP! HELP!

I’m being repressed!



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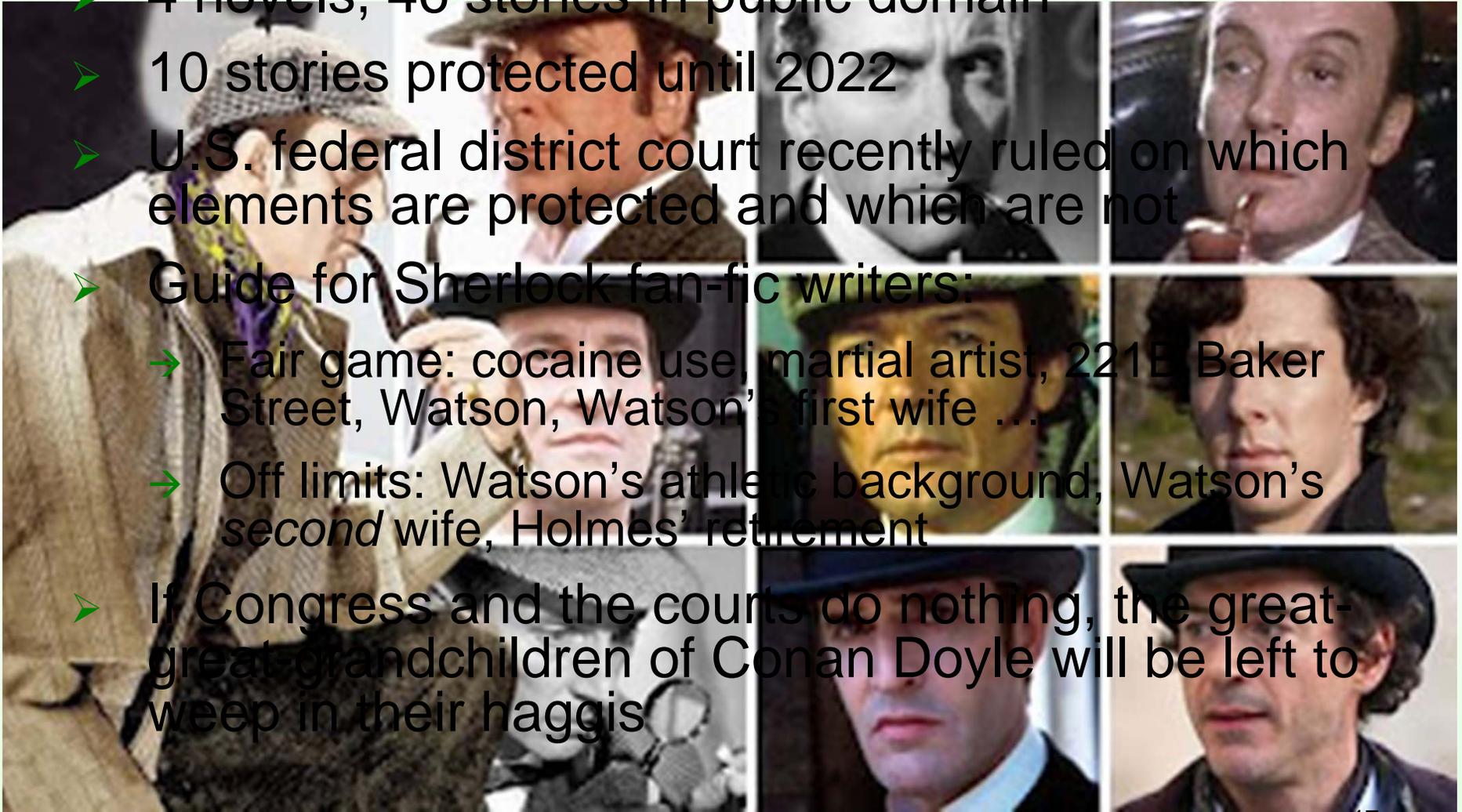
Why Should I Care About ©?

- Legal formula for © infringement:
 - P owns valid ©
 - D actually copied protected work
 - D has no valid defense (e.g. fair use)
- Real-world formula for © infringement:
 - P wants \$
 - D has \$
 - Legal blah blah details blah blah
 - P & D settle; “terms were not disclosed...”
- Pervasive copyrights mean pervasive infringement!



Sherlock Holmes and the Case of the Vanishing Copyright

- 4 novels, 46 stories in public domain
- 10 stories protected until 2022
- U.S. federal district court recently ruled on which elements are protected and which are not
- Guide for Sherlock fan-fic writers:
 - ➔ Fair game: cocaine use, martial artist, 221B Baker Street, Watson, Watson's first wife ...
 - ➔ Off limits: Watson's athletic background, Watson's *second* wife, Holmes' retirement
- If Congress and the courts do nothing, the great-great-grandchildren of Conan Doyle will be left to weep in their haggis



Music Rip-off Artists

(not even the tip of the iceberg...)

Beach Boys - *Surfin' USA*

Beatles - *All You Need is Love*

George Harrison - *My Sweet Lord*

Johnny Cash - *Folsom Prison Blues*

Rod Stewart - *Do Ya Think I'm Sexy*

Ray Parker, Jr. - *Ghostbusters*

Vanilla Ice - *Ice Ice Baby*

Men at Work - *Down Under*

Bee Gees - *How Deep is Your Love*

Robin Thicke - *Blurred Lines*

One Direction - (every single song ever)

John Fogerty (**sued by CCR!**)

Led Zeppelin – (nearly every song ever)

Madonna

The Rolling Stones

Andrew Lloyd Webber

Bob Dylan

Red Hot Chili Peppers

Timbaland

Beastie Boys

John Williams

Snoop ~~Dogg~~ ~~Dogg~~ Lion

Michael Bolton

Wyclef Jean

Lady Gaga

Beyoncé

Elton John

[Your Favorite Artist Here]

Suing the Big G!

- Not government, Google!
- How do I sue thee? Let me count the ways...
 - Google Search
 - Fair use, DMCA safe harbor ... dismissed
 - Google Books
 - Fair use ... dismissed
 - YouTube (vs. Viacom)
 - Filed in '07, settled in March '14 for $\$0 < X < \$1B$
 - Google Images (ongoing)
 - Android OS (vs. Oracle; on appeal)

Suing the *Other* Big G!

- Gov't is no Google, but still a huge bulls-eye
 - Whatever camp you're in, Big G is an adversary
 - Benjamins: Gov't won't miss a few million dollars!
 - Dennis the Repressed: © is evil, but Gov't is eviler!
 - Idealist: Gov't is undermining [ideas/business]!
 - Revisit the Infringement Formula
 - Publishers have a valid ©
 - DOE is copying the work
 - Does DOE have a defense?
 - **TRICK QUESTION! WHY?**

Authorization & Consent

- DEAR 970.5227-4
 - M&O contractors and their subcontractors are not directly liable for (most) *patent* infringement
 - Buck stops with the Government
 - Contractor must assist Government with its defense
 - M&O liability for *copyright* infringement is at the Contracting Officer's discretion
 - Major consideration: **programmatic necessity**
 - Hard sell
 - If denied, M&O's defense costs are likely not allowable
 - Subcontractors get no benefit of A&C for ©

Do You Have Any Good News?

- M&O contract won't get you off the hook for copyright infringement
- But, government contractors are generally protected by “government purpose” licenses, the same as the government
- Feds and contractors need to cooperate to ensure that we create and preserve the full benefits of government rights in inventions and data

Government's Rights in Data

- Ownership of technical data & software produced under the contract
- Unlimited rights in technical data & software specifically used in performance of the contract
 - ➔ (With certain exceptions not relevant here...)
- Contractor can assert, without approval, copyright in scientific and technical articles
- Contractor must request DOE permission to assert copyright in software and other technical data produced under M&O contract

Drilling Down on Journal Articles

- What version does the Gov't get rights in?
 - Submitted manuscript: yes
 - Accepted manuscript: yes
 - Peer review is valuable, but the accepted manuscript incorporating comments and suggested revisions is a work authored by the article's authors, hence ©
 - Published article: maybe
 - Final touches are by publisher, not author
 - But DEAR requires affixing notice that says: “worldwide license to publish or reproduce the published form of this manuscript” [e.g. 48 C.F.R. 970.5227-2]
- Which one should we freely use?
 - Accepted manuscript: safe, “fair”, science value is 100%

A Rock and a Hard Place

- Do publishers like the government license?
- Whose responsibility is it to ensure that the government and the publisher are on the same page?
 - Publisher?
 - Government?
 - Contractor?
 - [Hint: whose mistake results either in breach of contract or liability for copyright infringement?]
- Practically, DOE and M&Os cooperate here

Elsevier Case Study – part 1

- Elsevier to Sandia researcher, 9/20/12:

“As you may be aware, **the rights LBNL (*sic*) wishes to retain on behalf of the US Government have recently become problematic for Elsevier** and so we have been looking at alternative methods for handling these. Unfortunately, in the case of your article this has resulted in a delay in publishing. We are now very pleased to be able to offer a standard agreement, including the unmodified LBNL wording, *on the basis of an interim solution* and in order to proceed to publication.”

[emphases added on this and later slides]

Elsevier Case Study – part 2

- One interim solution became five interim solutions
- Sandia asked Elsevier, what about the rest of our articles pending publication?
- Elsevier to Sandia, 10/4/12:

“The five papers that were agreed under the previous wording were **approved as exceptions**, as the papers were urgently required for publication. We are in the process of having an alternative solution approved, which we will send for your review at the earliest possible time, for the remaining papers.”

Elsevier Case Study – part 3

- Sandia IP counsel informs DOE and NNSA IP counsel (John Lucas and Jim Durkis) that Elsevier has a problem with DOE labs reserving government rights in articles
- DOE HQ and field IP attorneys talk w/ OSTI:
“From hearing input from the STI/Librarian communities, **I think the sites would welcome a unified federal position** and to take a stand against such pressure from certain publishers” – Judy Gilmore

Elsevier Case Study – part 4

- Elsevier legal to Sandia legal, 11/1/12:
 - ➔ How about we grant the US Government the same re-use rights as we would a federal author? “These rights are generally sufficient for those authors.”
- Except they’re not sufficient for *the government!*
 - ➔ Authors are generally prohibited from “systematic distribution”, i.e. **OSTI**, PubMed, etc.

“I see no justification to in any way narrow the rights we retain. [SC] is finding out the potential impact of **simply not publishing with Elsevier.**” – John Lucas

Elsevier Case Study – part 5

- Sandia legal to Elsevier legal, 11/5/12:

“We do not agree that the Retained Rights you have identified are equivalent to the rights held by the US Government. Sandia has granted rights to the US Government long before granting rights to Elsevier. As such, Sandia does not hold these rights and cannot grant rights to Elsevier [that] Sandia does not possess.”

- Elsevier legal to Sandia legal, 11/9/12:

“... discussed your request with the various stakeholders internally[.] [W]e believe **this is not an issue** and we will adjust the journal publishing agreement to reflect the clause as you suggested[.]”

Elsevier Case Study – part 6

- OSTI to DOE legal: even with reserved government rights, authors are still prohibited from systematic distribution. Can *labs* still give Elsevier-accepted manuscripts to OSTI?
- John Lucas to Elsevier legal, 11/21/12:
 - Please confirm *labs* can give articles to OSTI
- Elsevier legal to John Lucas, 11/26/12:

“There are no restrictions on the US Government's use whatsoever and the author has the right to use the published form of the manuscript for commercial use or systematic distribution.”

Elsevier Case Study – part 7

- DOE-Oak Ridge field counsel drafted guidance in Dec. 2012 in coordination with OSTI.
- John Lucas coordinated draft with Walt Warnick
- Final guidance to all DOE IP attorneys on 1/22/13:

“Sites that currently submit authors' manuscripts to OSTI should continue to follow this model. Sites that do not submit manuscripts to OSTI are encouraged to do so, to further the use of and access to DOE-sponsored research. I anticipate that OSTI will send appropriate guidance to STIP contacts, but for my part encourage each author/site to submit to OSTI a copy of the final pre-print version of the article (i.e. accepted for publication, post-peer review). ...

“Elsevier is only one of many major journal publishers, so DOE may encounter the same or similar issues in the future with other publishers. I would appreciate greatly if you and your staff would maintain awareness and bring these issues to our collective attention so as to encourage a timely, unified resolution.”

Elsevier Case Study – part 8

- Elsevier email to lab authors, 1/30/13:

“We would like to inform you once more that we are, and always have been, compliant with the US Government's retention of publishing rights (Gov. Use Rights) in manuscripts authored by all DOE Laboratories. ***Not only do we recognize the retention of publishing rights by US Government institutions, but the same principle applies for all independent contractors appointed by the US Government*** (including both DOE Laboratories owned by the US Government as well as independent contractors appointed by the US Government). ...

It may be of interest to you that we have recently started a new collaboration with the US Department of Energy to increase the visibility of DOE-sponsored research results by incorporating 300,000 full-text technical reports in Elsevier's free scientific search tools: SciVerse Hub and Scirus.”

Elsevier – Take Home Messages

- Labs can and should submit accepted manuscripts to OSTI in a timely manner
- Labs and authors should be wary of copyright assignment/transfer agreements:
 - ➔ Make sure the government has rights in *at least* the accepted manuscript
 - ➔ Make sure the rights include systematic distribution
- Beware of publishing agreements that sell you what you've already got
 - ➔ Don't pay a publisher to make an article "open-access." OSTI does that for free!

Islands in a Sea of Infringement

- Don't ignore © because you're a "DOE lab"
 - They think they can sue the government, but they're really suing an M&O: it's an unholy mess for everyone!
- Remind lab staff not to post unlicensed works
- If you have rights, publish the "right" version
- Limit unlicensed usage to "fair use"
 - Nonprofit, educational, short excerpts...
 - Consult your lab counsel's office for details
- Know your (government's) rights when dealing with journal publishers
- Raise yellow/red flags to IP counsel *and* OSTI
 - United we stand!



Thanks for Listening!

Questions?



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