

CDLB-1003
Intellectual Property Provisions (CDLB-1003)
Cooperative Agreement - Special Data Statute
Research, Development, or Demonstration
Large Businesses, State and Local Governments, and Foreign Entities

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NOTE: In reading these provisions, any reference to “contractor” shall mean “recipient,” and any reference to “contract” or “subcontract” shall mean “award” or “subaward.”

* If a waiver of patent rights is granted, then provisions approved by the DOE patent counsel, in accordance with 10 CFR 784, will be substituted for this Patent Rights provision.

01. FAR 52.227-1 Authorization and Consent (JUL 1995)-Alternate I (APR 1984)

(a) The Government authorizes and consents to all use and manufacture of any invention described in and covered by a United States patent in the performance of this contract or any subcontract at any tier.

(b) The Contractor agrees to include, and require inclusion of, this clause, suitably modified to identify the parties, in all subcontracts at any tier for research and development expected to exceed the simplified acquisition threshold; however, omission of this clause from any subcontract, including those at or below the simplified acquisition threshold, does not affect this authorization and consent.

(End of clause)

02. FAR 52.227-2 Notice and Assistance Regarding Patent and Copyright Infringement (AUG 1996)

(a) The Contractor shall report to the Contracting Officer, 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 under this contract, the Contractor shall furnish to the Government, when requested by the Contracting Officer, 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.

(c) The Contractor agrees to include, and require inclusion of, this clause in all subcontracts at any tier for supplies or services (including construction and architect-engineer subcontracts and those for material, supplies, models, samples, or design or testing services) expected to exceed the simplified acquisition threshold at FAR 2.101.

(End of clause)

03. FAR 227.71 Rights In Technical Data – Long Form (May 2005)

(a) Definitions.

(1) “Technical Data” means recorded information regardless of form or characteristic, of a scientific or technical nature. It may, for example, document research, experimental, developmental, or demonstration, or engineering work, or be usable or used to define a design or process, or to procure, produce, support, maintain, or operate material. The data may be graphic or pictorial delineations in media such as drawings or photographs, text in specifications or related performance or design type documents or computer software (including computer programs, computer software databases, and computer software documentation). Examples of technical data include research and engineering data, engineering drawings and associated lists, specifications, standards, process sheets, manuals, technical reports, catalog item identification, and related information. Technical data as used herein does not include financial reports, cost analyses, and other information incidental to contract administration.

(2) “Proprietary Data” means technical data which embody trade secrets developed at private expense, such as design procedures or techniques, chemical composition of materials, or manufacturing methods, processes, or treatments, including minor modifications thereof, provided that such data:

- (i) Are not generally known or available from other sources without obligation concerning confidentiality;
- (ii) Have not been made available by the owner to others without obligation concerning their confidentiality; and
- (iii) Are not already available to the Government without obligation concerning their confidentiality.

(3) "Contract Data" means technical data first produced in the performance of the agreement technical data which are specified to be delivered in the agreement, technical data that may be called for under the "Additional Technical Data Requirements" article of the agreement, if any, or technical data actually delivered in connection with the agreement.

(4) "Unlimited Right" means rights to use, duplicate, or disclose technical data, in whole or in part, in any manner and for any purpose whatsoever, and to permit others to do so.

(5) "Protected Information," means technical data or commercial or financial information first produced in the performance of this Agreement which, if it had been obtained from and first produced by a non-Federal party, would be a trade secret or commercial or financial information that is privileged or confidential under the meaning of 5 U.S.C. 552(b)(4), and which is marked as being Protected Information by a party to this agreement.

(b) Allocation of Rights.

(1) The Government shall have:

(i) Unlimited rights in Contract Data except as otherwise provided below with respect to Proprietary Data and Protected Information.

(ii) The right to remove, cancel, correct or ignore any markings not authorized by the terms of this agreement on any technical data furnished hereunder, if in response to a written inquiry by DOE concerning the propriety of the markings, the Contractor fails to respond thereto within 60 days or fails to substantiate the propriety of the markings. In either case DOE will notify the Contractor of the action taken.

(iii) No rights under this Agreement in any technical data which are not Contract Data.

(2) The Contractor shall have:

(i) The right to withhold Proprietary Data in accordance with the Provisions of this article, and

(ii) The right to use for its private purposes, subject to patent, security or other provisions of this Contract, Contract Data it first produces in the performance of this Agreement provided the data requirements of this Agreement have been met as of the date of the private use of such data. The Contractor agrees that to the extent it receives or is given access to Proprietary Data or other technical, business or financial data in the form of recorded information from DOE or DOE Contractor or Subcontractor, the Contractor shall treat such data in accordance with any restrictive legend contained thereon, unless use is specifically authorized by prior written approval of the Contracting Officer. Prior to disclosure, the DOE shall notify USABC of its intent to furnish or provide access to such proprietary data or other technical, business or financial data and permit USABC to refuse to receive or have access to the data if USABC does not wish to accept the data under the terms of the restrictive legend.

(3) Nothing contained in this "Rights in Technical Data" article shall imply a license to the Government under any patent or be construed as affecting the scope of any licenses or other rights otherwise granted to the Government under any patent.

(c) Copyrighted Material.

(1) The Contractor shall not, without prior written authorization of the Contracting Officer, establish a claim to statutory copyright in any contract data first produced in the performance of the Agreement. To the extent such authorization is granted, the Government reserves for itself and other acting on its behalf a royalty-free, nonexclusive, irrevocable, worldwide license for Governmental purposes to publish, distribute, translate, duplicate, exhibit and perform any such data copyrighted by the Contractor.

(2) The Contractor agrees not to include in the technical data delivered under the agreement any material copyrighted by the Contractor and not to knowingly include any material copyrighted by others without first granting or obtaining at no cost a license therein for the benefit of the Government of the same scope as set forth in paragraph (c)(1) above. If such royalty-free license is unavailable and the Contractor nevertheless determines that such copyrighted

material must be included in the technical data to be delivered, rather than merely incorporated therein by reference, the Contractor shall request the written authorization of the Contracting Officer to include such copyrighted material in the technical data without a license.

(d) Contracting Under this Agreement.

It is the responsibility of the Contractor to obtain from its contractors' hereunder technical data and rights therein, on behalf of the Government, necessary to fulfill the Contractors' obligations to the Government with respect to such data. In the event of refusal by a contractor hereunder to accept an article affording the Government such rights, the Contractor shall:

(1) Promptly submit written notice and a proposed contract to the Contracting Officer setting forth any modifications to the article and reasons for the modifications and other pertinent information which may expedite disposition of the matter; and

(2) Not proceed with said contract without the written authorization of the Contracting Officer.

(e) Withholding of Proprietary Data.

Notwithstanding the inclusion of the "Additional Technical Data Requirements" article in this Agreement or any provision of this Agreement specifying the delivery of technical data, the Contractor may withhold Proprietary Data from delivery, provided that the Contractor furnishes in lieu of any such Proprietary Data so withheld technical data disclosing the source, size, configuration, mating and attachment characteristics, functional characteristics and performance requirements ("Form, Fit and Function" data, e.g. specification control drawings, catalog sheets, envelope drawings, etc.) or a general description of such Proprietary Data where "Form, Fit and Function" data are not applicable. The Government shall acquire no rights to any Proprietary Data so withheld except that such data shall be subject to the "inspection rights" provisions of paragraph (f), and, if included, the "Limited rights in Proprietary Data" provisions of paragraph (g) and the "Contractor licensing" provisions or paragraph (h).

(f) Inspection rights.

Except as may be otherwise specified in this grant for specific items of Proprietary Data which are not subject to this paragraph, the Contracting Officer's representatives, at all reasonable times up to three years after final payment under this Agreement may inspect at the Contractor's facility any Proprietary Data withheld under paragraph (e) and not furnished under paragraph (g), if included, or any Protected Information for the purposes of verifying that such data properly fell within the withholding provision of paragraph (e), or for evaluating work performance.

(g) Limited rights in Proprietary Data.

Contractor shall, upon written request from the Contracting Officer at any time prior to one (1) year after final payment by the DOE under this Cooperative Agreement, promptly make available to the Government at Contractor's or its Subcontractor's facilities any Proprietary Data withheld pursuant to paragraph (e) of the Rights in Technical Data clause of the Cooperative Agreement. The following legend is authorized to be affixed on any Proprietary Data delivered to or removed by DOE from such facilities pursuant to this provision, provided Proprietary Data meets the conditions for initial withholding under paragraph (e) of the Rights in Technical Data Clause. The Government will thereafter treat the Proprietary Data in accordance with such legend.

LIMITED RIGHTS LEGEND

This Proprietary Data, furnished under Cooperative Agreement DE-EE0006250 with the United States Department of Energy, may be used by DOE with the express limitations that the Proprietary Data be retained in confidence and may not be disclosed outside the Government except to support service contractors and National Laboratory contractors who are not reasonably expected to be present or potential competitors of Contractors for evaluation of the electrochemical energy storage units forming the subject matter of the above identified agreement and under the restriction that the Proprietary Data be retained in confidence and not be further disclosed. Thereafter all such Proprietary Data must be returned to the Participant or, with written certification by the Contracting Officer to Participant, destroyed.

(h) Contractor Licensing.

Except as may be otherwise specified in this contract as technical data not subject to this paragraph and provided the electrochemical energy storage unit for Vehicle Technologies applications is developed to the point of practical application under this contract and is not available for sale in the United States, DOE shall have the right, in accordance with procedures similar to those in 37 CFR 401.6 and any supplemental regulations of DOE, and upon written application by DOE, to require Contractor to grant to the Government and responsible third parties for purposes of making, using and selling such a nonexclusive license in any Protected Information and Contract Data owned or controlled by Contractor and specifically used in performing this contract and which are proprietary data, on terms and conditions reasonable under the circumstances including appropriate provisions for confidentiality, provided, however, the contractor shall not be obligated to license any such data if the contractor provides a reasonable basis that:

- (1) such data are not essential to the manufacture of such unit;
- (2) such data, in the form of results obtained by their use, have a commercially competitive alternative available or readily introducible from one or more other sources;
- (3) such data, in the form of results obtained by their use, are being supplied by the contractor or its licensees in sufficient quantity and at reasonable prices to satisfy market needs, or the contractor or its licensees have taken effective steps or within a reasonable time are expected to take effective steps to so supply such data in the form of results obtained by its use;
- (4) such data, in the form of results obtained by their use, can be furnished by another firm skilled in the art of manufacturing such units of the same general type and character necessary to achieve the contract results; or
- (5) such data are available for licensing to responsible third parties on reasonable terms and conditions by the Contractor.

This paragraph (h) shall be included in all subcontracts, however, subcontracts with a small business, university, or nonprofit organization will only require licensing of Protected Information (i.e., such organizations are not required to license their Proprietary Information).

(i) Information Available to the Public

(1) The parties agree that the following types of technical data and commercial or financial information are not considered to be proprietary and shall be provided to the Government when requested without any claim that the information is to be protected as Protected Information. The parties also agree that it is necessary for this type of information to be publicly available.

1. Battery Performance Standards versus USABC Technical Targets.
2. Significant Accomplishments for presentation at a public conference (annual merit review, etc.) or publication in peer reviewed journal including subrecipient cell and or other deliverable performance data
3. Descriptions of subcontract work and technology progress for inclusion in DOE's annual progress report.
4. Cost analysis results

(2) The parties agree, however, that notwithstanding the foregoing lists of the types of information to be publicly available, nothing precludes the Government from seeking delivery of additional technical data and information in accordance with this agreement or from making publicly available additional non-proprietary or non-protected technical data and information, nor does the foregoing list constitute any admission by the Government that technical data or information not on the list is proprietary.

(j) Protected Information

(1) Except for items of information subject to paragraph (i) of this clause, Contractor may claim as Protected Information any information first produced in the performance of this Cooperative Agreement which meets the definition set forth in paragraph (a)(5) of this clause.

(2) Contractor shall mark any such Protected Information delivered to the Government with the following legend and such other legends, restrictions or limitations on use of disclosure as may be applicable or appropriate. Any such claimed Protected Information delivered to the Government with the proper marking will be treated as such, and except as otherwise provided herein, will not be published, disseminated, or disclosed to others outside the Government by the Government for a period of five (5) years after completion of the individual project without the prior written authorization of Contractor.

“PROTECTED INFORMATION”

“This Protected Information was produced under Cooperative Agreement No. DE-EE0006250 with the U.S. Department of Energy and may not be published, disseminated or disclosed to others by the Government unless otherwise authorized in the Cooperative Agreement until five (5) years after the completion of the individual project for which it was developed unless express written authorization is obtained from Contractor. Upon expiration of the period of protection set forth in this legend, the Government shall have unlimited rights to this data. This legend shall be marked on any reproduction of this data, in whole or in part.”

(3) Any such marked Protected Information may be disclosed by the Government under obligations of confidentiality for the following purpose:

(i) This Protected Information may be disclosed to for evaluation purposes under the restriction that such data be retained in confidence and not be further disclosed;

(ii) This Protected Information may be disclosed to other subcontractors performing work under the Government's program of which this Agreement is a part, for information or use in connection with the work performed under their agreements and under the restriction that the Protected Information be retained in confidence and not be further disclosed.

(4) Contractor shall have the right to license such Protected Information or include such Protected Information in a license with other technology developed under this agreement and, in accordance with paragraph (h) of this clause, agrees to license such Protected Information to responsible third parties. Such licenses shall include terms and conditions that are reasonable under the circumstances, including obligations of confidentiality.

(5) The obligations of confidentiality and restrictions on use, publication and dissemination shall end for any Protected Information:

(i) At the end of the protected period, as indicated in the legend unless otherwise protected by law;

(ii) If the information becomes publicly known or available from other sources without a breach of the obligations or confidentiality by the Government with respect to the Protected Information;

(iii) If the same information is independently developed by someone who does not have access to the Protected Information and such independently developed data is made available without obligations of confidentiality; or

(iv) If Contractor disseminates or authorizes another to disseminate such information without obligations of confidentiality.

PROTECTED INFORMATION (MAY 2005)

The following is a listing of data anticipated to be generated under this award that the Recipient expects will qualify as “Protected Information,” as that term is defined in the “Rights in Technical Data – Long Form” clause in this award.

Incorporating this listing of data into this agreement does not constitute a guarantee by the Government that the data will in fact qualify for this designation.

- Cell and system design, performance targets, program objectives and plans, and cost data
- Data disclosing and/or relating to Cell Materials and Fabrication Processes
- Data disclosing and/or relating to Cell Design
- Data disclosing and/or relating to Battery Module Design, Hardware, and Fabrication & Assembly Processes
- All Test Data
- Data disclosing and/or relating to Cost analyses
- Data disclosing and/or relating to Business and Marketing Plans

If a patent is issued by the United States Patent and Trademark Office or the patent office of any foreign country based on any information asserted to be Protected Information, the Government will no longer treat any data contained in such issued patent as Protected Information. In addition, if any information asserted to be Protected Information results in or becomes a Subject Invention, as that term is defined in the patent rights clause of this agreement, the Government will only treat such data as Protected Information until the Recipient has filed its initial patent application.

04. FAR 52.227-23 Rights to Proposal Data (Technical) (JUN 1987)

Except for data contained on pages 5-9, 11, 17, 23, and 28, it is agreed that as a condition of award of this contract, and notwithstanding the conditions of any notice appearing thereon, the Government shall have unlimited rights (as defined in the "Rights in Data--General" clause contained in this contract) in and to the technical data contained in the proposal dated January 21, 2013, upon which this contract is based.

05 10 CFR 600.325 Appendix A, Patent Rights - (Large Business Firms - No Waiver) (OCT 2003)

(a) Definitions

DOE patent waiver regulations, as used in this clause, means the Department of Energy patent waiver regulations in effect on the date of award. See 10 CFR part 784.

Invention, as used in this clause, means any invention or discovery which is or may be patentable or otherwise protectable under title 35 of the United States Code or any novel variety of plant that is or may be protectable under the Plant Variety Protection Act (7 U.S.C. 2321, et seq.).

Patent Counsel, as used in this clause, means the Department of Energy Patent Counsel assisting the awarding activity.

Subject invention, as used in this clause, means any invention of the Recipient conceived or first actually reduced to practice in the course of or under this agreement.

(b) Allocations of Principal Rights

(1) Assignment to the Government. The Recipient agrees to assign to the Government the entire right, title, and interest throughout the world in and to each subject invention, except to the extent that rights are retained by the Recipient under subparagraph (b)(2) and paragraph (d) of this clause.

(2) Greater rights determinations. The Recipient, or an employee-inventor after consultation with the Recipient, may request greater rights than the nonexclusive license and the foreign patent rights provided in paragraph (d) of this clause on identified inventions in accordance with the DOE patent waiver regulation. Each determination of greater rights under this agreement shall be subject to paragraph (c) of this clause, unless otherwise provided in the greater rights determination, and to the reservations and conditions deemed to be appropriate by the Secretary of Energy or designee.

(c) Minimum Rights Acquired by the Government

With respect to each subject invention to which the Department of Energy grants the Recipient principal or exclusive rights, the Recipient agrees to grant to the Government: A nonexclusive, nontransferable, irrevocable, paidup license to practice or have practiced each subject invention throughout the world by or on behalf of the Government of the United States (including any Government agency); "march-in rights" as set forth in 37 CFR 401.14(a)(J)); preference for U.S. industry as set forth in 37 CFR 401.14(a)(I)); periodic reports upon request, no more frequently than annually, on the

utilization or intent of utilization of a subject invention in a manner consistent with 35 U.S.C. 202(c)(5); and such Government rights in any instrument transferring rights in a subject invention.

(d) Minimum Rights to the Recipient

(1) The Recipient is hereby granted a revocable, nonexclusive, royalty-free license in each patent application filed in any country on a subject invention and any resulting patent in which the Government obtains title, unless the Recipient fails to disclose the subject invention within the times specified in subparagraph (e)(2) of this clause. The Recipient's license extends to its domestic subsidiaries and affiliates, if any, within the corporate structure of which the Recipient is a part and includes the right to grant sublicenses of the same scope to the extent the Recipient was legally obligated to do so at the time the agreement was awarded. The license is transferable only with the approval of DOE except when transferred to the successor of that part of the Recipient's business to which the invention pertains.

(2) The Recipient may request the right to acquire patent rights to a subject invention in any foreign country where the Government has elected not to secure such rights, subject to the minimum rights acquired by the Government similar to paragraph (c) of this clause. Such request must be made in writing to the Patent Counsel as part of the disclosure required by subparagraph (e)(2) of this clause, with a copy to the DOE Contracting Officer. DOE approval, if given, will be based on a determination that this would best serve the national interest.

(e) Invention Identification, Disclosures, and Reports

(1) The Recipient shall establish and maintain active and effective procedures to assure that subject inventions are promptly identified and disclosed to Recipient personnel responsible for patent matters within 6 months of conception and/or first actual reduction to practice, whichever occurs first in the performance of work under this agreement. These procedures shall include the maintenance of laboratory notebooks or equivalent records and other records as are reasonably necessary to document the conception and/or the first actual reduction to practice of subject inventions, and records that show that the procedures for identifying and disclosing the inventions are followed. Upon request, the Recipient shall furnish the Contracting Officer a description of such procedures for evaluation and for determination as to their effectiveness.

(2) The Recipient shall disclose each subject invention to the DOE Patent Counsel with a copy to the Contracting Officer within 2 months after the inventor discloses it in writing to Recipient personnel responsible for patent matters or, if earlier, within 6 months after the Recipient becomes aware that a subject invention has been made, but in any event before any on sale, public use, or publication of such invention known to the Recipient. The disclosure to DOE shall be in the form of a written report and shall identify the agreement under which the invention was made and the inventor(s). It shall be sufficiently complete in technical detail to convey a clear understanding, to the extent known at the time of the disclosure, of the nature, purpose, operation, and physical, chemical, biological, or electrical characteristics of the invention. The disclosure shall also identify any publication, on sale, or public use of the invention and whether a manuscript describing the invention has been submitted for publication and, if so, whether it has been accepted for publication at the time of disclosure. In addition, after disclosure to DOE, the Recipient shall promptly notify Patent Counsel of the acceptance of any manuscript describing the invention for publication or of any on sale or public use planned by the Recipient. The report should also include any request for a greater rights determination in accordance with subparagraph (b)(2) of this clause.

When an invention is disclosed to DOE under this paragraph, it shall be deemed to have been made in the manner specified in Sections (a)(1) and (a)(2) of 42 U.S.C. 5908, unless the Recipient contends in writing at the time the invention is disclosed that it was not so made.

(3) The Recipient shall furnish the Contracting Officer a final report, within 3 months after completion of the work listing all subject inventions or containing a statement that there were no such inventions, and listing all subawards/contracts at any tier containing a patent rights clause or containing a statement that there were no such subawards/contracts.

(4) The Recipient agrees to require, by written agreement, its employees, other than clerical and nontechnical employees, to disclose promptly in writing to personnel identified as responsible for the administration of patent matters and in a format suggested by the Recipient each subject invention made under subaward/contract in order that the Recipient can comply with the disclosure provisions of paragraph (c) of this clause, and to execute all papers necessary to file patent applications on subject inventions and to establish the Government's rights in the subject inventions. This disclosure format should require, as a minimum, the information required by subparagraph (e)(2) of this clause.

(5) The Recipient agrees, subject to FAR 27.302(j), that the Government may duplicate and disclose subject invention disclosures and all other reports and papers furnished or required to be furnished pursuant to this clause.

(f) Examination of Records Relating to Inventions

(1) The Contracting Officer or any authorized representative shall, until 3 years after final payment under this agreement, have the right to examine any books (including laboratory notebooks), records, and documents of the Recipient relating to the conception or first actual reduction to practice of inventions in the same field of technology as the work under this agreement to determine whether--

(i) Any such inventions are subject inventions;

(ii) The Recipient has established and maintains the procedures required by subparagraphs (e)(1) and (4) of this clause;

(iii) The Recipient and its inventors have complied with the procedures.

(2) If the Contracting Officer learns of an unreported Recipient invention which the Contracting Officer believes may be a subject invention, the Recipient may be required to disclose the invention to DOE for a determination of ownership rights.

(3) Any examination of records under this paragraph will be subject to appropriate conditions to protect the confidentiality of the information involved.

(g) Subaward/Contract

(1) The recipient shall include the clause PATENT RIGHTS (SMALL BUSINESS FIRMS AND NONPROFIT ORGANIZATIONS) (suitably modified to identify the parties) in all subawards/contracts, regardless of tier, for experimental, developmental, demonstration, or research work to be performed by a small business firm or domestic nonprofit organization, except where the work of the subaward/contract is subject to an Exceptional Circumstances Determination by DOE. In all other subawards/contracts, regardless of tier, for experimental, developmental, demonstration, or research work, the Recipient shall include this clause (suitably modified to identify the parties), or an alternate clause as directed by the contracting officer. The Recipient shall not, as part of the consideration for awarding the subaward/contract, obtain rights in the subrecipient's/contractor's subject inventions.

(2) In the event of a refusal by a prospective subrecipient/contractor to accept such a clause the Recipient:

(i) Shall promptly submit a written notice to the Contracting Officer setting forth the subrecipient/contractor's reasons for such refusal and other pertinent information that may expedite disposition of the matter; and

(ii) Shall not proceed with such subaward/contract without the written authorization of the Contracting Officer.

(3) In the case of subawards/contracts at any tier, DOE, the subrecipient/contractor, and Recipient agree that the mutual obligations of the parties created by this clause constitute a contract between the subrecipient/contractor and DOE with respect to those matters covered by this clause.

(4) The Recipient shall promptly notify the Contracting Officer in writing upon the award of any subaward/contract at any tier containing a patent rights clause by identifying the subrecipient/contractor, the applicable patent rights clause, the work to be performed under the subaward/contract, and the dates of award and estimated completion.

Upon request of the Contracting Officer, the Recipient shall furnish a copy of such subaward/contract, and, no more frequently than annually, a listing of the subawards/contracts that have been awarded.

(5) The Recipient shall identify all subject inventions of a subrecipient/contractor of which it acquires knowledge in the performance of this agreement and shall notify the Patent Counsel, with a copy to the contracting officer, promptly upon identification of the inventions.

(h) Atomic Energy

(1) No claim for pecuniary award of compensation under the provisions of the Atomic Energy Act of 1954, as amended, shall be asserted with respect to any invention or discovery made or conceived in the course of or under this agreement.

(2) Except as otherwise authorized in writing by the Contracting Officer, the Recipient will obtain patent agreements to effectuate the provisions of subparagraph (h)(1) of this clause from all persons who perform any part of the work under this agreement, except nontechnical personnel, such as clerical employees and manual laborers.

(i) Publication

It is recognized that during the course of the work under this agreement, the Recipient or its employees may from time to time desire to release or publish information regarding scientific or technical developments conceived or first actually reduced to practice in the course of or under this agreement. In order that public disclosure of such information will not

adversely affect the patent interests of DOE or the Recipient, patent approval for release of publication shall be secured from Patent Counsel prior to any such release or publication.

(j) Forfeiture of Rights in Unreported Subject Inventions

(1) The Recipient shall forfeit and assign to the Government, at the request of the Secretary of Energy or designee, all rights in any subject invention which the Recipient fails to report to Patent Counsel within six months after the time the Recipient:

- (i) Files or causes to be filed a United States or foreign patent application thereon; or
- (ii) Submits the final report required by subparagraph (e)(3) of this clause, whichever is later.

(2) However, the Recipient shall not forfeit rights in a subject invention if, within the time specified in subparagraph (e)(2) of this clause, the Recipient:

(i) Prepares a written decision based upon a review of the record that the invention was neither conceived nor first actually reduced to practice in the course of or under the agreement and delivers the decision to Patent Counsel, with a copy to the Contracting Officer, or

(ii) Contending that the invention is not a subject invention, the Recipient nevertheless discloses the invention and all facts pertinent to this contention to the Patent Counsel, with a copy of the Contracting Officer; or

- (iii) Establishes that the failure to disclose did not result from the Recipient's fault or negligence.

(3) Pending written assignment of the patent application and patents on a subject invention determined by the Secretary of Energy or designee to be forfeited (such determination to be a final decision under the Disputes clause of this agreement), the Recipient shall be deemed to hold the invention and the patent applications and patents pertaining thereto in trust for the Government. The forfeiture provision of this paragraph (j) shall be in addition to and shall not supersede other rights and remedies which the Government may have with respect to subject inventions.

(End of clause)