

02-16-2000

U.S. Department of Commerce
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OPR/FINANCE

TO: The Commissioner of Patents and Trademarks: Please record the attached original document(s) or copy(ies).

Submission Type

New

Resubmission (Non-Recordation)
Document ID#

Correction of PTO Error
Reel # Frame #

Corrective Document
Reel # Frame #

Conveyance Type

Assignment Security Agreement

License Change of Name

Merger Other

U.S. Government
(For Use ONLY by U.S. Government Agencies)

Departmental File Secret File

Conveying Party(ies)

Mark if additional names of conveying parties attached

Name (line 1) Execution Date Month Day Year

Name (line 2)

Second Party Name (line 1)

Name (line 2)

Receiving Party

Mark if additional names of receiving parties attached

Name (line 1) If document to be recorded is an assignment and the receiving party is not domiciled in the United States, an appointment of a domestic representative is attached. (Designation must be a separate document from Assignment.)

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Mail documents to be recorded with required cover sheet(s) information to:
Commissioner of Patents and Trademarks, Box Assignments, Washington, D.C. 20231

PATENT
REEL: 010546 FRAME: 0001

Correspondent Name and Address

Area Code and Telephone Number

(925) 422-4367

Name: William C. Daubenspeck

Address (line 1): U.S. Department of Energy

Address (line 2): Lawrence Livermore National Laboratory

Address (line 3): P.O. Box 808 (MS L-376)

Address (line 4): Livermore, CA 94550

Pages Enter the total number of pages of the attached conveyance document including any attachments.

1

Application Number(s) or Patent Number(s)

Mark if additional numbers attached

Enter either the Patent Application Number or the Patent Number (DO NOT ENTER BOTH numbers for the same property).

Patent Application Number(s)

Patent Number(s)

09/360416

If this document is being filed together with a new Patent Application, enter the date the patent application was signed by the first named executing inventor.

Month Day Year

Patent Cooperation Treaty (PCT)

Enter PCT application number only if a U.S. Application Number has not been assigned.

PCT PCT PCT PCT PCT PCT

Number of Properties

Enter the total number of properties involved.

1

Fee Amount

Fee Amount for Properties Listed (37 CFR 3.41): \$

0.00

Method of Payment:

Enclosed

Deposit Account

Deposit Account

(Enter for payment by deposit account or if additional fees can be charged to the account.)

Deposit Account Number:

#

Authorization to charge additional fees:

Yes

No

Statement and Signature

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document. Charges to deposit account are authorized, as indicated herein.

Janet L. Rego

Name of Person Signing

Janet L. Rego

Signature

1-25-2000

Date

Patent Application Filed in the Name of the Contractor
Electable (197)

CONFIRMATORY LICENSE

Title: Methods for Detection of Ataxia
Telangiectasia

Inventor: Richard a. Gatti
DOE Contract #: 87ER 60548
NIH Contract #NS35322

Contractor: The Regents of U/California
UC Case No.: 99-387-1
DOE Docket No.: S-93046
Application 09/360,416
Filing Date (U.S.): 7/23/99

Foreign Applications filed in or intended to be filed at Contractor's expense in (countries): None
The Contractor certifies that a true copy of the provisions which govern patent rights in "subject inventions" under the above-identified contract is herewith submitted or has been submitted to the U.S. Department of Energy by certification dated October 29, 1996.

WHEREAS, the above-identified contract provides the Contractor with the right to elect to retain title in certain inventions and the Contractor has reported the above-identified invention as a subject invention under the contract, has elected to retain title therein, and has agreed to file a domestic patent application thereon, if not previously filed.

ACCORDINGLY, the Contractor hereby confirms that under the provisions of the above-identified contract governing patent rights, it has granted to the Government a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the subject invention throughout the world. This license applies to the above-identified invention, the above-identified patent application (s), and any and all divisions or continuations thereof and any resulting patent or reissue patent which may be granted thereon.

The Government reserves for itself, and is hereby granted by the Contractor, the irrevocable power to inspect and make copies of the file wrapper(s) of the above-identified U.S. patent application and of any related or continuation patent application(s), whether domestic or foreign, for the above-identified invention.

It is understood and agreed that this instrument does not preclude the Government from asserting rights under the provisions of the above-identified contract or any other agreement between the Government and the Contractor, or any other rights of the Government with respect to the above-identified invention.

Signed this 17 day of August, 19 99 On behalf of the Regents of the University of California
(Contractor's Name)
By Linda S. Stevenson
(Contractor's Official's Signature)
Linda S. Stevenson, Chief Prosecution Analyst, OTT,
and Temporary DOE Liaison
(Official's Name and Title)
University of California,, 1111 Franklin, 5th Floor,
Oakland, California 94607
(Contractor's Business Address)

Attachment Patent Rights Clause

NOTICE OF FINANCIAL ASSISTANCE AWARD
(See Instructions on Reverse)

Public Law 95-91 Department of Energy Act of 1977 and Federal Grant and Cooperative Agreement Act of 1977.
on, regulations and policies applicable to (the legislative program title): Agreement Act of 1977.

PROJECT TITLE " Human Gene for Radiation Hypersensitivity"

2. INSTRUMENT TYPE
 GRANT COOPERATIVE AGREEMENT

4. INSTRUMENT NO. DE-FC03-87ER60548 **5. AMENDMENT NO.** A000

6. BUDGET PERIOD FROM 3-15-87 THRU 3-14-88 **7. PROJECT PERIOD** FROM 3-15-87 THRU 3-14-91

10. TYPE OF AWARD
 NEW CONTINUATION RENEWAL
 REVISION SUPPLEMENT

12. ADMINISTERED FOR DOE BY (Name, address, zip code, telephone No.)
 Resident Representative
 Office of Naval Research
 1030 E. Green Street
 Pasadena, CA 91106

3. RECIPIENT (Name, address, zip code, area code and telephone no.)
 The Regents of the University of California
 Office of Contract & Grant Administration
 405 Hilgard Ave. UCLA Los Angeles, CA 90024

8. RECIPIENT PROJECT DIRECTOR (Name and telephone No.)
 Professor Richard A. Gatti
 (213) 825-3905

9. RECIPIENT BUSINESS OFFICER (Name and telephone No.)
 Ann Wilks - Penrod
 (213) 825-3905

11. DOE PROJECT OFFICER (Name, address, zip code, telephone No.)
 Benjamin J. Barhardt, ER-72000, U.S. DOE
 Health Effects Research Division
 Germantown, MD 20545 (301) 353-3638

13. RECIPIENT TYPE

STATE GOVT INDIAN TRIBAL GOVT HOSPITAL FOR PROFIT ORGANIZATION INDIVIDUAL
 LOCAL GOVT INSTITUTION OF HIGHER EDUCATION OTHER NONPROFIT ORGANIZATION C P SP OTHER /Specify/

14. ACCOUNTING AND APPROPRIATIONS DATA

a. Appropriation Symbol 89X0224 91	b. B & R Number HA 0202020	c. FT/APF/OC SE-74-91	d. CFA Number
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15. EMPLOYER I.D. NUMBER/SSN
95-6006143-W

16. BUDGET AND FUNDING INFORMATION

a. CURRENT BUDGET PERIOD INFORMATION		b. CUMULATIVE DOE OBLIGATIONS	
(1) DOE Funds Obligated This Action	\$ 150,000	(1) This Budget Period (Total of lines a. (1) and a. (2))	\$ 150,000
(2) DOE Funds Authorized for Carry Over	\$ -0-	(2) Prior Budget Periods	\$ -0-
(3) DOE Funds Previously Obligated in this Budget Period	\$ -0-	(3) Project Period to Date (Total of lines b. (1) and b. (2))	\$ 150,000
(4) DOE Share of Total Approved Budget	\$ 150,000		
(5) Recipient Share of Total Approved Budget	\$ -0-		
(6) Total Approved Budget	\$ 150,000		

17. TOTAL ESTIMATED COST OF PROJECT \$ 474,000

(This is the current estimated cost of the project. It is not a promise to award nor an authorization to expend funds in this amount.)

18. AWARD/AGREEMENT TERMS AND CONDITIONS

This award/agreement consists of this form plus the following:

a. Special terms and conditions (if grant) or schedule, general provisions, special provisions (if cooperative agreement)

b. Applicable program regulations (specify) 10 CFR 605 as published in the Federal Register/Dated April 15, 1985

c. DOE Assistance Regulations, 10 CFR Part 600, as amended, Subparts A and B (Grants) or C (Cooperative Agreements).

d. Application/proposal dated 4-18-86 as submitted with changes as negotiated

19. REMARKS

The following Exhibits are a part of this award:
 Exhibit I - Budget Plan Exhibit III - Special Terms and Conditions
 Exhibit II - General Terms and Conditions Exhibit IV - Reporting Requirements

20. EVIDENCE OF RECIPIENT ACCEPTANCE

[Signature] 3-16-87
 (Signature of Authorized Recipient Official) (Date)

Ann W. Wilks-Penrod
 (Name)

Contract and Grant Officer
 (Title)

21. AWARDED BY

[Signature] 3/27/87
 (Signature) (Date)

[Name]
 (Name)

[Title]
 (Title)

12. Transfers of Funds Between Grants

Transfers of funds between DOE grants, and transfers of funds from a DOE grant to a project (or portion of a project) not supported by that grant require the prior approval of DOE. Transfer of funds into a DOE grant-supported project from a grant awarded by another Federal agency does not require DOE prior approval but may, of course, require the approval of the other Federal agency. Funds so transferred from the grant of another Federal agency may not be used to satisfy any cost sharing requirement on a DOE grant.

13. Property

Real and Tangible Personal Property

No real property may be acquired under this award.

Title to any equipment (an article of tangible personal property that has a useful life of more than 2 years and an acquisition cost of \$500 or more) or supplies acquired by a non-profit institution of higher education or a non-profit organization whose primary purpose is the conduct of scientific research shall vest in the grantee and such equipment shall be exempt from accountability except that DOE has the right to transfer ownership of any item of equipment having a unit acquisition cost of \$1,000 or more under the conditions specified in 10 CFR 600.117(d)(2). This exemption is derived from Public Law 95-224, The Federal Grant and Cooperative Agreement Act of 1977, as amended.

Title to equipment and supplies acquired by all other grantees shall vest in the grantee. However, such grantees shall be accountable for equipment with a unit acquisition cost of \$1,000 or more acquired under this grant as specified in 10 CFR 600.117(d)(2), (3) and (4). For such grantees, supplies need only be accounted for at closeout and then only if they are unused and exceed \$1,000 in total aggregate current fair market value. In this case accountability requires that DOE be compensated in an amount computed in accordance with Section 600.117(e) if the supplies are retained for use on non-Federal activities.

All grantees shall follow property management policies and procedures which provide for adequate control of the acquisition and use of assets acquired under the grant.

Intangible Property

Treatment, including reporting, of patent and data rights and copyrights shall be as specified in the Special Terms and Conditions of this grant.

SPECIAL TERMS AND CONDITIONS**SPECIAL RESEARCH GRANTS**

The requirements of this attachment take precedence over all other requirements of this grant found in regulations, the general terms and conditions, DOE orders, etc. except requirements of statutory law. Any apparent contradiction of statutory law stated herein should be presumed to be in error until grantee has sought and received clarification from the Contracting Officer, whose signature appears on the face page of this award.

1. Payments under this award will be made by:

Letter of Credit

Payment will be made by:

U.S. Department of Energy
San Francisco Operations Office
Financial Management Division
1333 Broadway
Oakland, CA 94612

In addition to the initial supply of forms made available with this award, appropriate payment forms and instructions will be provided by that office upon request.

The grantee shall request cash only as needed for immediate disbursements, shall report cash disbursements in a timely manner, and shall impose the same standards of timing and amount, including reporting requirements, on secondary recipients.

2. Except for technical data contained in pages N/A of the recipient's application, dated N/A, which are asserted by the grantee as being proprietary data, it is agreed that as a condition of this award, and notwithstanding the provisions of any notice appearing on the application, the Government shall have the right to use, duplicate, disclose and have others do so for any purpose whatsoever the technical data not identified in the above blanks contained in the application upon which this award is based.

(Paragraphs 3. and 4. apply if this is an Office of Energy Research Grant awarded in accordance with the provisions of 10 CFR Part 605.)

3. Article 17 of the General Terms and Conditions for Research Grants is hereby revoked. Grantee must receive prior approval from DOE before entering into any sole source contract or a contract where only one bid or proposal is received, when the value of the contract in the aggregate is expected to exceed \$25,000.

"A"

6. DOE PR 9-9.102-2 AUTHORIZATION AND CONSENT (JUN 1979)

The Government hereby gives 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 all lower-tier subcontracts).

7. DOE PR 9-9.104 NOTICE AND ASSISTANCE REGARDING PATENT AND COPYRIGHT INFRINGEMENT (JUN 1979)

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 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 in 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 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) This clause shall be included in all subcontracts.

8. DOE PR 9-9.110(c) REPORTING OF ROYALTIES (JUN 1979)

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 Government, the Contractor agrees to report in writing to the Patent Counsel (with notification by Patent Counsel to the Contracting Officer) 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 performance of this contract together 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 the identification of the patents or other basis on which the royalties are to be paid. The approval of DOE 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.

9. DEAR 952.227-77 RIGHTS IN TECHNICAL DATA - SHORT FORM (APR 1984)

(a) Definitions. The definitions of terms set forth in DEAR 927.401 apply to the extent these terms are used herein.

(b) Allocation of rights.

(1) The Government shall have:

- (i) Unlimited rights in technical data first produced or specifically used in the performance of this contract;
- (ii) The right of the Contracting Officer or his representation to inspect at all reasonable times up to three years after final payment under this Grant all technical data first produced or specifically used in the Grant (for which inspection the Grantee or its subcontractor shall afford proper facilities to DOE); and
- (iii) The right to have any technical data first produced or specifically used in the performance of this grant delivered to the Government as the Contracting Officer may from time to time direct during the progress of the work, or in any event as the Contracting Officer shall direct upon completion or termination of this grant.

(2) The Grantee shall have:

- (i) The right to use for its private purposes, subject to patent, security or other provisions of this contract, technical data it first produces in the performance of this Grant provided the data requirements of this Grant have been met as of the date of the private use of such data. The Grantee 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 a DOE contractor or subcontractor, the Grantee 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.

(c) Copyrighted material.

- (1) The Grantee agrees to, and does hereby grant to the Government, and to its officers, agents, servants and employees acting within the scope of their duties:

- (i) A royalty-free, nonexclusive, irrevocable license to reproduce, translate, publish, use, and dispose of and to authorize others to do so, all copyrightable material first produced or composed in the performance of this contract by the Grantee, its employees or any individual or concern specifically employed or assigned to originate and prepare such material; and
 - (ii) A license as aforesaid under any and all copyrighted or copyrightable works not first produced or composed by the Grantee in the performance of this Grant but which are incorporated in the material furnished under the Grant, provided that such license shall be only to the extent the Grantee now has, or prior to completion or final settlement of the Grant may acquire, the right to grant such license without becoming liable to pay compensation to others solely because of such grant.
- (2) The Grantee agrees that it will not knowingly include any material copyrighted by others in any written or copyrightable material furnished or delivered under this contract without a license as provided for in paragraph (c)(1)(ii) hereof, or without the consent of the copyright owner, unless it obtains specific written approval of the Contracting Officer for the inclusion of such copyrighted material.

10. OMB Cir. A-124, Trans. Memo No. 1 - PATENT RIGHTS (SMALL BUSINESS FIRMS OR NONPROFIT ORGANIZATIONS - APR 1984)

a. Definitions

- (1) "Invention" means any invention or discovery which is or may be patentable or otherwise protectable under Title 35 of the United States Code (USC).
- (2) "Subject Invention" means any invention of the Grantee conceived or first actually reduced to practice in the performance of work under this contract.
- (3) "Practical Application" means to manufacture in the case of a composition or product, to practice in the case of a process or method, or to operate in the case of a machine or system; and, in each case, under such conditions as to establish that the invention is utilized and that its benefits are, to the extent permitted by law or Government regulations, available to the public on reasonable terms.

- (4) "Made" when used in relation to any invention means the conception or first actual reduction to practice of such invention.
- (5) "Small Business Firm" means a small business concern as defined at Section 2 of Public Law 85-536 (15 USC 632) and implementing regulations of the Administrator of the Small Business Administration. For the purpose of this clause, the size standard for small business concerns involved in Government procurement, contained in 13 CFR 121.3-8, and in subcontracting, contained in 13 CFR 121.3-12, will be used.
- (6) "Nonprofit Organization" means a university or other institution of higher education or an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1954 (26 USC 501(c)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 USC 501(a)) or any nonprofit scientific or educational organization qualified under a state nonprofit organization statute.
- (7) "Patent Counsel" means the Department of Energy (DOE) patent counsel assisting the DOE contracting activity.

b. Allocation of Principal Rights

The Grantee may retain the entire right, title, and interest throughout the world to each subject invention subject to the provisions of this clause and 35 USC 203. With respect to any subject invention in which the Grantee retains title, the Federal Government shall have a nonexclusive, nontransferrable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the subject invention throughout the world.

c. Invention Disclosure, Election of Title and Filing of Patent Application by Contractor

- (1) The Grantee will disclose each subject invention to the Patent Counsel (with notification by the Patent Counsel to the Contracting Officer) within two months after the inventor discloses it in writing to Grantee personnel responsible for the Administration of patent matters. The disclosure to the Patent Counsel shall be in the form of a written report and shall identify the contract 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 the physical, chemical, biological or electrical characteristics of the invention. The disclosure shall also identify any publication, or

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 the Patent Counsel, the Grantee will promptly notify the Patent Counsel of the acceptance of any manuscript describing the invention or of any sale or public use planned by the Grantee.

- (2) The Grantee will elect in writing whether or not to retain title to any such invention by notifying the Patent Counsel within twelve months of disclosure to the Grantee; provided that in any case where publication, on sale or public use has initiated the one year statutory period wherein valid patent protection can still be obtained in the United States, the period for election of tital terminates sixty days prior to the end of the statutory period.
- (3) The Grantee will file its initial patent application on an elected invention within two years after election, or if earlier, prior to the end of any statutory period wherein valid patent protection can be obtained in the United States after a publication, on sale, or public use. The Grantee will file patent applications in additional countries within either ten months of the corresponding initial patent application or six months from the date permission is granted by the Commissioner of Patents and Trademarks to file foreign patent applications where such filing has been prohibited by a Secrecy Order.
- (4) Requests for extension of the time for disclosure to the Patent Counsel, election, and filing, may, at the discretion of the Patent Counsel be granted.

d. Conditions When the Government May Obtain Title

- (1) The Grantee will convey to DOE, upon written request, title to any subject invention:
 - (i) If the Grantee fails to disclose or elect the subject invention within the times specified in (c) above, or elects not to retain title.
 - (ii) In those countries in which the Grantee fails to file patent applications within the times specified in (c) above; provide, however, that if the Grantee has filed a patent application in a country after the times specified in (c) above but prior to its receipt of the written request of the Patent Counsel, the Grantee shall continue to retain title in that country; or

- (iii) In any country in which the Grantee decides not to continue the prosecution of any application for, to pay the maintenance fees on, or defend in a reexamination or opposition proceeding on, a patent on a subject invention.

e. Minimum Rights to Grantee

- (1) The Grantee will retain a nonexclusive, royalty-free license throughout the world in each subject invention to which the Government obtains title except if the Grantee fails to disclose the subject invention within the times specified in (c) above. The Grantee's license extends to its domestic subsidiaries the affiliates, if any, within the corporate structure of which the Grantee is a part and includes the right to grant sublicenses of the same scope to the extent the Grantee was legally obligated to do so at the time the Grant was awarded. The license is transferable only with the approval of DOE except when transferred to the successor of that part of the Grantee's business to which the invention pertains.
- (2) The Grantee's domestic license may be revoked or modified by DOE to the extent necessary to achieve expeditious practical application of the subject invention pursuant to an application for an exclusive license submitted in accordance with 10 CFR 781. This license will not be revoked in that field of use or the geographical areas in which the Grantee has achieved practical application and continues to make the benefits of the invention reasonably accessible to the public. The license in any foreign country may be revoked or modified at the discretion of DOE to the extent the Grantee, its licensees, or its domestic subsidiaries or affiliates have failed to achieve practical application in that foreign country.
- (3) Before revocation or modification of the license, DOE will furnish the Grantee a written notice of its intention to revoke or modify the license, and the Grantee will be allowed thirty days (or such other time as may be authorized by DOE for good cause shown by the Grantee) after the notice to show cause why the license should not be revoked or modified. The Grantee has the right to appeal, in accordance with 10 CFR 781, any decision concerning the revocation or modification of its license.

f. Grantee Action to Protect Government's Interest

- (1) The Grantee agrees to execute or to have executed and promptly deliver to the Patent Counsel all instruments necessary to:

- (i) Establish or confirm the rights the Government has throughout the world in those subject inventions for which the Grantee retains title, and
 - (ii) Convey title to DOE when requested under (d) above and to enable the Government to obtain patent protection throughout the world in that subject invention.
- (2) The Grantee 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 Grantee each subject invention made under this contract in order that the Grantee can comply with the disclosure provisions of (c) above and to execute all papers necessary to file patent applications on subject inventions. The disclosure format should require, as a minimum, the information requested by (c)(1) above. The Grantee shall instruct such employees through the employee agrees or suitable educational programs on the importance of reporting inventions in sufficient time to permit the filing of patent applications prior to United States or foreign statutory bars.
- (3) The Grantee will notify the Patent Counsel of any decision not to continue prosecution of a patent application, pay maintenance fees, or defend in a reexamination or opposition proceeding on a patent, in any country, not less than thirty days before the expiration of the response period required by the relevant patent office.
- (4) The Grantee agrees to include, within the specification of any United States patent application and any patent issuing thereon covering a subject invention, the following statement, "This invention was made with Government support under (identify the grant) awarded by the Department of Energy. The Government has certain rights in this invention".
- (5) The Grantee agrees to:
- (i) Provide a report prior to the close-out of the grant listing all subject inventions;
 - (ii) Provide notification of all subcontracts under this contract for experimental, development, demonstration, or research work, the identity of the patent rights clause therein, and copy of each subcontract upon request;

- (iii) Provide promptly a copy of the patent application, filing date, serial number, patent number and issue date for any subject invention in any country in which the Grantee has applied for a patent.

g. Subcontracts

- (1) The Grantee will include this clause, suitable modified to identify the parties, in all subcontracts, regardless of tier, for experimental, developmental or research work to be performed by a small business firm or a domestic nonprofit organization. The subcontractor will retain all rights provided for the Grantee in this clause, and the Grantee will not, as part of the consideration for awarding the subcontract, obtain rights in the subcontractor's subject inventions.
- (2) The Grantee will include in all other subcontracts, regardless of tier, for experimental, developmental, demonstration, or research work the patent rights clause required by 41 CFR 9-9.107-5(a) or 41 CFR Section 9-9.107-6 as appropriate, modified to identify the parties.
- (3) In the case of a subcontract at any tier, DOE the subcontractor, and the Grantee agree that mutual obligations of the parties created by this clause constitute a contract between the subcontractor and DOE with respect to those matters covered by this clause.

h. Reporting on Utilization of Subject Inventions

The Grantee agrees to submit on request periodic reports no more frequently than annually on the utilization of a subject invention or on efforts at obtaining such utilization that are being made by the Grantee or its licensees or assignees. Such reports shall include information regarding the status of development, date of first commercial sale or use, gross royalties received by the Grantee, and such other data and information as DOE may reasonably specify. The Grantee also agrees to provide additional reports as may be requested by DOE in connection with any march-in proceeding undertaken by DOE in accordance with paragraph (j) of this clause. To the extent data or information supplied under this section is considered by the Grantee, its licensee or assignee to be privileged and confidential and is so marked DOE agrees that, to the extent permitted by 35 USC 202(c)(5), it will not disclose such information to persons outside the Government.

i. Preference for United States Industry

Notwithstanding any other provision of this clause, the Grantee agrees that neither it nor any assignee will grant to any person the exclusive right to use or sell any subject invention in the United States unless such person agrees that any products embodying the subject invention or produced through the use of the subject invention will be manufactured substantially in the United States. However, in individual cases, the requirement for such an agreement may be waived by DOE upon a showing by the Grantee or its assignee that reasonable but unsuccessful efforts have been made to grant licenses on similar terms to potential licensees that would be likely to manufacture substantially in the United States or that under the circumstances domestic manufacture is not commercially feasible.

j. March-in Rights

The Grantee agrees that with respect to any subject invention in which it has acquired title, DOE has the right in accordance with the procedures in OMB Circular A-124 to require the Grantee, an assignee or exclusive licensee of a subject invention to grant a nonexclusive, partially exclusive, or exclusive license in any field of use to a responsible applicant or applicants, upon terms that are reasonable under the circumstances, and if the Grantee, assignee, or exclusive licensee refuses such a request, DOE has the right to grant such a license itself if DOE determines that:

- (1) Such action is necessary because the Grantee or assignee has not taken, or is not expected to take within a reasonable time, effective steps to achieve practical application of the subject invention in such field of use;
- (2) Such action is necessary to alleviate health or safety needs which are not reasonably satisfied by the Grantee, assignee, or their licensees;
- (3) Such action is necessary to meet requirements for public use specified by federal regulations and such requirements are not reasonably satisfied by the Grantee, assignee, or licensee; or
- (4) Such action is necessary because the agreement required by (i) of this clause has not been obtained or waived or because a licensee of the exclusive right to use or sell any subject invention in the United States is in breach of such agreement.

k. Special Provisions for Grants with Nonprofit Organizations

If the Grantee is a nonprofit organization, it agrees that:

- (1) Rights to a subject invention in the United States may not be assigned without the approval of DOE, except where such assignment is made to an organization which has as one of its primary functions the management of inventions and which is not, itself, engaged in or does not hold a substantial interest in other organizations engaged in the manufacture or sale of products or the use of processes that might utilize the invention or be in competition with embodiments of the invention (provided that such assignee will be subject to the same provisions as the Grantee);
- (2) The Grantee may not grant exclusive licenses under United States patents or patent applications in subject inventions to persons other than small business firms for a period in excess of the earlier of:
 - (i) Five years from first commercial sale or use of the invention; and
 - (ii) Eight years from the date of the exclusive license excepting that time before regulatory agencies necessary to obtain premarket clearance, unless on a case-by-case basis, DOE approves a longer exclusive license. If exclusive field of use licenses are granted, commercial sale or use in one field of use will not be deemed commercial sale or use with respect to a product of the invention will not be deemed to end the exclusive period to different subsequent products covered by the invention;
- (3) The Grantee will share royalties collected on a subject invention with the inventor; and
- (4) The balance of any royalties or income earned by the Grantee with respect to subject inventions, after payment of expenses including payments to inventors) incidental to the administration of subject inventions, will be utilized for the support of scientific research or education.

(1) Communications

The DOE central point of contact for communications or matters relating to this clause is the Patent Counsel.