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Conveyance Type

☐ Assignment ☐ Security Agreement

☐ License ☐ Change of Name

☐ Merger ☒ Other Confirmatory License

U.S. Government
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☒ Departmental File ☐ Secret File

Conveying Party(ies)

☐ Mark if additional names of conveying parties attached

Execution Date
Month Day Year
9/23/98

Name (line 1) California, University of

Name (line 2)

Second Party

Name (line 1)

Name (line 2)

Execution Date
Month Day Year

Receiving Party

☐ Mark if additional names of receiving parties attached

Name (line 1) U. S. Department of Energy

Name (line 2)

Address (line 1) P. O. Box 808 (L-376)

Address (line 2)

Address (line 3) Livermore

CA

94550

City

State/Country

Zip Code

☐ 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.)

Domestic Representative Name and Address

Enter for the first Receiving Party only.

Name

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PATENT

REEL: 010546 FRAME: 0137

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)

08/680395

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

Signature

Date

UC Case #: 96-185-1

CONFIRMATORY LICENSE

Title: Gene From 20qu13 Amplicon and Their Uses

Inventor: Joe W. Gray, Colin Collins, Tony Godfrey, David Kawbel, Johanna Rommens

Serial No.: 08/680,395

Filing Date (U.S.): 2/9/96

Contractor: The Regents of The University of California

DOE Contract No.: De AC03-76SF00098

DOE Case No.: S-91,119 - No RL #

Foreign Applications filed in or intended to be filed at

Contractor's expense in (countries): No

The invention identified above is a "subject invention" under the Patent Rights clause included in the above-identified contract with the Department of Energy. Contractor, having the right to retain title to "subject inventions" as a result of Public Law 96-517, has reported the invention to the Department of Energy with its election to retain title thereto.

Accordingly, this document is confirmatory of the paid-up license granted to the Government under this contract in this invention, patent application, and any resulting patent, and of all other rights acquired by the Government by the referenced clause, a copy of which is attached hereto and incorporated by reference herein.

The Government is hereby granted an irrevocable power to inspect and make copies of the above-identified patent application.

Signed this 23rd day of Sept, 1998

On behalf of the

Regents of the University of California

(Contractor's Name)

By Howard B. Scheckman

(Contractor's Official's Signature)

Howard B. Scheckman

Manager, DOE Liaison

(Official's Name and Title)

The Regents of The University of California,

1320 Harbor Bay Parkway

Alameda, CA 94502

(Contractor's Business Address)

Attachment Patent Rights Clause

Modification No. M145
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Contract No. DE-AC03-76SF00098

(b) Employee Assistance Program Records of DOE Employees (DOE-34)

(i) Physical Fitness Test Records — Includes only LANL Security and Safeguards Department records on security inspectors and guards certification for DOE physical fitness standards. (DOE-77)

ARTICLE XI, CL. 5 - SPECIAL AGREEMENT ON THE DISPOSITION OF RECORDS (SPECIAL)

The following agreement is entered into pursuant to Article VII, Clause 4 (d), "Accounts, Records and Inspection — Disposition of Records," of this contract:

(a) Government records. Records that are owned by the government pursuant to the provisions of this contract shall be disposed of by the University in accordance with the direction of the Contracting Officer. Such disposition instructions will in no way limit the right of the University to make copies of such records it deems necessary.

(b) University records. Records that are owned by the University in accordance with Article VI, Clause 10, "Contract Records," of this contract, shall be disposed of in accordance with the University's records retention policies.

(c) Costs of storage and retention. The cost of storage and disposition of all records and copies shall be borne by the government and compensated through the method of payment described in Article VII, Clause 3, "Payments and Advances," of this contract, both before and after termination until the time specified in paragraph (d) of this clause.

(d) Applicable schedules for disposal. Notwithstanding any other provision of this contract, all records and copies in the possession of the University relating to this contract shall be preserved by the University until the later of (i) the University institutional records disposal schedule (for University records), (ii) the DOE disposal schedule (for government records), or (iii) October 1, 2002, except as may be agreed upon by the Government and the University.

(e) Claims requiring access to records which have been disposed. The University reserves the right to assert a defense against any claim by the Government the defense of which is premised upon any record properly disposed of in accordance with this clause.

ARTICLE XII INTELLECTUAL PROPERTY

ARTICLE XII, CL. 1 - PATENTS RIGHTS - 37 CFR 401.14

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The following applies except for inventions made by the University arising under University Research and Supporting Efforts for the Laboratory, provided pursuant to Article VIII, Clause 2, and under complementary and beneficial program activities at non-Laboratory facilities, in which case rights in such inventions shall be governed by the provisions of subparagraph (g) of this clause.

(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, or any novel variety of plant which is or may be protected under the Plant Variety Protection Act (7 U.S.C. § 2321 et seq.).

(2) "Subject Invention" means any invention of the University conceived or first actually reduced to practice in the performance of work under this contract, provided that in the case of a variety of plant, the date of determination (as defined in Section 41(d) of the Plant Variety Protection Act (7 U.S.C. § 2401(d))) must also occur during the period of contract performance.

(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 being 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 U.S.C. § 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 and subcontracting at 13 C.F.R. 121.3-8, and in 13 C.F.R. 121.3-12, respectively, 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 1986 (26 U.S.C. § 501(c)) and exempt from taxation under Section 501(a) of the Internal Revenue Code (26 U.S.C. § 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) Counsel for Intellectual Property assisting the DOE contracting activity.

(8) "Exceptional Circumstance Subject Invention" means any Subject Invention for which DOE provides the exceptional circumstances finding and analysis in writing under 35 U.S.C. § 202(a)(ii) and the Procedures of 37 C.F.R. Part 401.3(e).

(9) "Secretary" means the Secretary of Energy.

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(b) Allocation of Principal Rights.

(1) The University may retain the entire right, title and interest throughout the world to each Subject Invention subject to the provisions of this clause and 35 U.S.C. § 203. With respect to any Subject Invention in which the University retains title, the Federal government shall have 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.

(2) The University shall not elect to retain title to any Exceptional Circumstance Subject Invention until DOE procedural requirements have been met to DOE's sole satisfaction.

(3) The DOE reserves the right to unilaterally amend this contract to identify specific treaties or international agreements entered into by the government after the effective date of this contract and effectuate those license or other rights which are necessary for the government to meet its obligations to foreign governments, their nationals and international organizations under such treaties or international agreements with respect to subject inventions made after the date of the amendment.

(4) The right of the University to elect title to Subject Inventions is subject to the invention rights disposition in treaties or international agreements identified at Appendix C and existing or future class waivers to third parties by DOE, such as Work for Others, User Facility and Cooperative Research and Development Agreement (CRADA) waivers.

(5) The DOE has declared the following to be Exceptional Circumstance inventions:

- (i) Subject Inventions relating to uranium enrichment, including isotope separation;
- (ii) Subject Inventions relating to storage and disposal of civilian high level nuclear waste or spent nuclear fuel;
- (iii) Subject Inventions related to subject matter that is sensitive under Section 148 of the Atomic Energy Act of 1954, as amended (42 U.S.C. § 2168 (1982)); and
- (iv) Subject Inventions arising under the US Advanced Battery Consortium research and development.

DOE reserves the right to unilaterally amend this contract to add or delete Exceptional Circumstance Subject Inventions that may, in the national interest, be designated by the Secretary.

(6) The University, pursuant to applicable laws and regulations, may petition for waiver of the Government's rights with respect to Subject Inventions not electable by the University under the terms of this paragraph (b).

(c) Invention Disclosures, Election of Title and Filing of Patent Applications by the University.

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(1) The University shall establish and maintain active and effective procedures by which the University will use its best efforts to assure that Subject Inventions are promptly identified and disclosed to University personnel responsible for patent matters within six months of conception and/or first actual reduction to practice, whichever occurs first in the performance of work under this contract. This reporting requirement also applies to Subject Inventions of Participants in any CRADA in which the University is a party. 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 University shall furnish the Contracting Officer a description of such procedures for evaluation and for determination as to their effectiveness.

(2) The University shall disclose each Subject Invention to the Contracting Officer within two months after the inventor discloses it in writing to University personnel responsible for patent matters or, if earlier, within six months after the University 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 University. The disclosure to DOE shall be in the form of a written report and shall identify the contract under which the invention was made, the inventors, all sources of funding by B&R code for the invention. 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 University shall promptly notify the DOE of the acceptance of any manuscript describing the invention for publication or of any on sale or public use planned by the University.

(3) The University will elect in writing whether or not to retain title to any such invention by notifying the DOE within two years of disclosure to DOE. However, 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 title may be shortened by the DOE to a date that is no more than 60 days prior to the end of the statutory period.

(4) The University will file its initial patent application on a Subject Invention to which it elects to retain title within one year after election of title 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 University will file patent applications in additional countries or international patent offices 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.

(5) Requests for extension of time for disclosure, election, and filing under subparagraphs (1), (2), (3) and (4) may, at the discretion of the DOE, be granted.

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(d) **Conditions When the Government May Obtain Title.** The University will convey to the DOE, upon written request, title to any subject invention:

(1) If the University fails to disclose or elect title to the subject invention within the times specified in (c), above, or elects not to retain title; provided that the DOE may only request title when election is prohibited by DOE pursuant to (b) above or within 60 days after learning of the failure of the University to disclose or elect within the specified times.

(2) In those countries in which the University fails to file patent applications within the times specified in (c) above; provided, however, that if the University 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 DOE, the University shall continue to retain title in that country.

(3) In any country in which the University decides not to continue the prosecution of any application for, to pay the maintenance fees on, or defend in reexamination or opposition proceeding on, a patent on a Subject Invention.

(e) **Minimum Rights to University and Protection of the University Right to File.**

(1) The University may request the right to reserve a revocable nonexclusive royalty-free license throughout the world in each Subject Invention to which the Government obtains title, except if the University fails to disclose the invention within the times specified in (c), above. The University's license extends to its domestic subsidiary and affiliates, if any, within the corporate structure of which the University is a party and includes the right to grant sublicenses of the same scope to the extent the University was legally obligated to do so at the time the contract was awarded. The license is transferable only with the approval of the DOE except when transferred to the successor of that part of the University's business to which the invention pertains.

(2) The University's domestic license may be revoked or modified by the 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 applicable provisions at 37 C.F.R. Part 404 and DOE licensing regulations (if any). This license will not be revoked in that field of use or the geographical areas in which the University 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 the DOE to the extent the University, its licensees, or the domestic subsidiaries or affiliates have failed to achieve practical application in that foreign country.

(3) Before revocation or modification of the license, the DOE will furnish the University a written notice of its intention to revoke or modify the license, and the University will be allowed thirty days (or such other time as may be authorized by the DOE for good cause shown by the University) after the notice to show cause why the license should not be revoked or modified. The University has the right to appeal, in accordance with the applicable regulations in 37 C.F.R. Part 404 and DOE regulations (if any) concerning the licensing of Government-owned inventions, any decision concerning the revocation or modification of the license.

(f) University Action to Protect the Government's Interest.

(1) The University agrees to execute or to have executed and promptly deliver to the DOE all instruments necessary to (i) establish or confirm the rights the Government has throughout the world in those Subject Inventions to which the University elects to retain title, and (ii) convey title to the DOE when requested under paragraph (d) above and to enable the government to obtain patent protection throughout the world in that subject invention.

(2) The University 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 University each Subject Invention made under the contract in order that the University can comply with the disclosure provisions of paragraph (c), above, and to execute all papers necessary to file patent applications on Subject Inventions and to establish the government's rights in the Subject Inventions. The disclosure format should require, as a minimum, the information required by (c)(1) and (2), above. The University shall instruct such employees through employee agreements or other suitable educational programs on the importance of reporting inventions in sufficient time to permit the filing of patent applications prior to U.S. or foreign statutory bars.

(3) The University will notify the DOE of any decisions not to continue the prosecution of a patent application, pay maintenance fees, or defend in 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 University agrees to include, with the specification of any United States patent applications and any patent issuing thereon covering a subject invention, the following statement, "This invention was made with government support under Contract No. DE-AC03-76SF00098 awarded by the U.S. Department of Energy. The government has certain rights in the invention."

(5) The University shall furnish the Contracting Officer the following:

(i) Interim reports every 12 months (or such longer period as may be specified by the Contracting Officer) from the date of the contract, listing Subject Inventions during that period, and certifying that all Subject Inventions have been disclosed (or that there are no such inventions) and that the procedures required by subparagraph (c)(1) above have followed, and listing all subcontracts containing a patent rights clause or certifying that there were no such subcontracts; and

(ii) A final report, within three months after completion of the contracted work, listing all Subject Inventions or certifying that there were no such inventions.

(6) The University agrees 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 provided, however, that any such disclosure of a Subject Invention in which the University has elected to retain title is subject to 35 U.S.C. § 205.

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(g) Subcontracts.

(1) The University will include the clause at 48 C.F.R. Part 952.227-71 dated April 1987 suitably 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 domestic non-profit organization and such clause as modified for subcontracts which are subject to Exceptional Circumstances. The subcontractor will retain all rights provided for the University in this clause, and the University will not, as part of the consideration for awarding the subcontract, obtain rights in the subcontractor's subject inventions.

(2) The University will include in all other subcontracts, regardless of tier, for experimental, developmental or research work the patent rights clause required by DEAR Subpart 970.27 and 41 C.F.R. Part 9-9.107-5(a) and such clause as modified for subcontracts which are subject to Exceptional Circumstances.

(3) In the case of subcontracts, at any tier, when the prime award with the DOE was a contract (but not a grant or cooperative agreement), the DOE, subcontractor, and the University agree that the mutual obligations of the parties created by this clause constitute a contract between the subcontractor and the DOE with respect to the matters covered by the clause; provided, however, that nothing in this paragraph is intended to confer any jurisdiction under the Contract Disputes Act in connection with proceedings under paragraph (j) of this clause.

(4) In the event of a refusal by a prospective subcontractor to accept such a clause, the University—

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

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

(5) The University shall promptly notify the Contracting Officer, in writing upon the award of any subcontract at any tier containing a patent rights clause, by identifying the subcontractor, the applicable patent rights clause, the work to be performed under the subcontract, and the dates of award and estimated completion. Upon request of the Contracting Officer, the University shall furnish a copy of such subcontract, and no more frequently than annually, a listing of the subcontracts that have been awarded.

(6) The University will not, as a part of the consideration for awarding the subcontract, obtain rights in any subcontractor's subject inventions.

(b) Reporting on Utilization of Subject Inventions. The University 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 University 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 University, and such other data and information as the DOE may reasonably specify. The University also agrees to provide additional reports as may be requested by the DOE in connection with any march-in proceeding undertaken by the DOE in accordance with paragraph (j) of this clause. As required by 35 U.S.C.

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§ 202(c)(5), the DOE agrees that it will not disclose such information to persons outside the government without permission of the University.

(i) **Publication Release.** It is recognized that during the course of the work under this contract, the University 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 contract. In order that public disclosure of such information will not adversely affect the patent interests of DOE or the University, patent approval for release or publication shall be secured from the University personnel responsible for patent matters prior to any such release or publication. Where publication releases are requested of DOE, DOE's response to such requests for approval shall not be withheld for more than 90 days except in circumstances in which a domestic application must be filed in order to protect foreign patent rights. In the latter case, the Department shall be granted an additional 180 days within which to respond to the request for approval. The period of 180 days may be extended by mutual agreement of the parties.

(j) **March-in Rights.** The University agrees that with respect to any Subject Invention in which it has acquired title, the DOE has the right in accordance with the procedures in 37 C.F.R. 401.6 and any supplemental regulations of the DOE to require the University, 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 University, assignee, or exclusive licensee refuses such a request the DOE has the right to grant such a license itself if the DOE determines that:

(1) Such action is necessary because the University 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 University, 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 University, assignee or licensees; or

(4) Such action is necessary because the agreement required by 35 U.S.C. § 204, Preference for U.S. Industry, 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 Contracts with Nonprofit Organizations.** Rights to a subject invention in the United States may not be assigned without the approval of the DOE, except where such assignment is made to an organization which has as one of its primary functions the management of inventions, provided that such assignee will be subject to the same provisions as the University.

(l) **Communication.** Communications to DOE with regard to this clause shall be directed to the Patent Counsel, San Francisco Field Office.

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(m) Examination of Records Relating to Inventions.

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

(i) Any such inventions are Subject Inventions;

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

(iii) The University and its inventors have complied with the procedures of subparagraphs (c)(1) and (4) of this clause.

(2) If the Contracting Officer learns of an unreported University invention which the Contracting Officer believes may be a Subject Invention, the University 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.

(n) Withholding of Payment.

(1) Any time before final payment under this contract, the Contracting Officer may, in the Government's interest, withhold payment until a reserve not exceeding \$50,000 or five percent of the amount of this contract, whichever is less, shall have been set aside if, in the Contracting Officer's opinion, the University fails to—

(i) Establish, maintain, and follow effective procedures for identifying and disclosing Subject Inventions pursuant to subparagraph (c)(1) above;

(ii) Disclose any Subject Invention pursuant to subparagraph (c)(2) above;

(iii) Deliver acceptable interim reports pursuant to subparagraph (f)(5)(i) above; or

(iv) Provide the information regarding subcontracts pursuant to subparagraph (g)(5) above.

(2) Such reserve or balance shall be withheld until the Contracting Officer has determined that the University has rectified whatever deficiencies exist and has delivered all reports, disclosures, and other information required by this clause.

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(3) Final payment under this contract shall not be made before the University delivers to the Contracting Officer all disclosures of Subject Inventions required by subparagraph (c)(2) above, an acceptable final report pursuant to subparagraph (f)(5)(ii) above, and all past due confirmatory instruments.

(4) The Contracting Officer may decrease or increase the sums withheld up to the maximum authorized above. No amount shall be withheld under this paragraph while the amount specified by this paragraph is being withheld under other provisions of the contract. The withholding of any amount or the subsequent payment thereof shall not be construed as a waiver of any Government rights.

(o) Atomic Energy.

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

(2) Except as otherwise authorized in writing by the Contracting Officer, the University will obtain patent agreements to effectuate the provisions of subparagraph (o)(1) of this clause.

(p) Facilities License. In addition to the rights of the parties with respect to inventions or discoveries conceived or first actually reduced to practice in the course of or under this contract, the University agrees to and does hereby grant to the Government an irrevocable, nonexclusive, paid-up license in and to any inventions or discoveries regardless of when conceived or actually reduced to practice or acquired by the University, which are owned or controlled by the University, at any time through completion of this contract and which are incorporated or embodied in the construction of the facility or which are utilized in the operation of the facility or which cover articles, materials, or products manufactured at the facility: (1) to practice or to have practiced by or for the Government at the facility, and (2) to transfer such license with the transfer of that facility. The acceptance or exercise by the Government of the aforesaid rights and license shall not prevent the Government at any time from contesting the enforceability, validity or scope of, or title to, any rights or patents herein licensed.

(q) Rights Governed by Other Agreements. Rights to inventions made under agreements other than funding agreements with third parties shall be governed by the appropriate provisions incorporated, with DOE approval, in such agreements, notwithstanding any disposition of rights contained in this Prime Contract. Disposition of rights under any such agreement shall be in accordance with any DOE class waiver (including Work for Others, User Facility and CRADA class waivers) or individually negotiated waiver which applies to the agreement and shall take precedence over any disposition of rights in this Prime Contract. Where an invention is conceived in the course of work under this Prime Contract, but is later reduced to practice under a Work for Others or CRADA agreement, rights to such invention shall be governed by the provisions incorporated, with DOE approval, in the Work for Others or CRADA agreement. Nothing in this paragraph shall abrogate the rights of third parties under any agreement approved by DOE and entered into prior to any such DOE class waiver.

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(r) Educational Awards Subject to 35 U.S.C. § 212. The University shall notify the Contracting Officer prior to the placement of any person subject to 35 U.S.C. § 212 in an area of technology related to Exceptional Circumstances technology, or which is subject to treaties or international agreements as set forth in subparagraphs (b)(2), (b)(3), (b)(4) and (b)(5) of this clause or agreements other than funding agreements. The Contracting Officer shall have the right to disapprove such placement.

ARTICLE XII, CL. 2 - PATENT INDEMNITY (APR 1984) - FAR 27.203

Except as otherwise authorized by the Contracting Officer, the University shall obtain indemnification of the Government and its officers, agents, and employees against liability, including costs, for infringement of U.S. 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) from the University's subcontractors in accordance with 48 CFR 27.203.

ARTICLE XII, CL. 3 - AUTHORIZATION AND CONSENT - DEAR 970.2701(a) [41 CFR 9-9.102-2]

(a) 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 subcontracts hereunder (including all lower-tier subcontracts).

(b) In the case of suit or potential suit in copyright infringement, the University may request authorization and consent in copyright from DOE. Programmatic necessity shall be a major consideration in grant of authorization and consent.

ARTICLE XII, CL. 4 - REPORTING OF ROYALTIES - DEAR 970.2701(a) [41 CFR 9-9.110]

If any royalty payments are reflected in the contract cost to the Government, the University 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 shall 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. The provisions of this clause, appropriately modified as to parties, shall be included in all subcontracts that exceed \$25,000 unless otherwise approved by the Contracting Officer.

• Modified for this contract