

09-13-2000

FORM  
Expires 06/  
OMB 0651-

101455765

U.S. Department of Commerce  
Patent and Trademark Office  
PATENT

8-28-00

RECORDATION FORM COVER SHEET  
PATENTS ONLY

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  Confirmatory License
- 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)  Reliance Electric Company
- Name (line 2)
- Execution Date  
Month Day Year  
08/01/2000

## Second Party

- Name (line 1)
- Name (line 2)
- Execution Date  
Month Day Year  
09-408-614

## Receiving Party

- ☐ Mark if additional names of receiving parties attached
- Name (line 1)  United States Department of Energy
- Name (line 2)
- Address (line 1)  1000 Independence Avenue
- Address (line 2)
- Address (line 3)  Washington  D.C. USA  20585
- 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
- Address (line 1)
- Address (line 2)
- Address (line 3)
- Address (line 4)

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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: 011051 FRAME: 0852

**Correspondent Name and Address**

Area Code and Telephone Number

630-252-2393

Name Robert J. Fisher

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

Address (line 2) Office of Intellectual Property Law

Address (line 3) 9800 S. Cass Ave

Address (line 4) Argonne, IL 60439

**Pages**

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

# 31

**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)

09/408,614

If this document is being filed together with a new Patent Application, enter the date the patent application was

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.

#

**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

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.

Mark P. Dvorscak

Name of Person Signing

MPDvorscak  
Signature

8/23/00  
Date

# CONFIRMATORY LICENSE

(Large Business - Advance Waiver)

Superconducting Electromechanical Rotating Device Having a Liquid-Cooled, Potted,  
Title One Layer : ~~Water Cooled Potted One Layer Stator Winding Design for~~ Stator Winding  
~~Superconducting Motors.~~

Inventor(s) : *Viatcheslav V. Dombrovski, David I. Driscoll and Boris A. Shoykhet*

Serial No : 09/408614 Filing Date: September 30, 1999

Contractor : *Reliance Electric Company*

DOE Contract No. : *DE-FC36-93CH10580*

DOE Case No. : *S-94,335*

Waiver No. : *W(A)-93-028 - CH-0786*

Foreign Applications filed in or intended to be filed at Contractor's expense in (countries):

None

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An advance waiver of Government rights having been granted by DOE to the Contractor, and the above-identified invention having been reported as a subject invention to DOE by the subcontractor with his election to file a domestic patent application thereon, and foreign applications in the countries noted above, the effective date of said waiver for the above invention is

*September 22, 1999*.

Accordingly, this document is confirmatory of the paid-up worldwide, license required to be granted to the Government under 10 CFR Part 784 and 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 undersigned certifies the attached copy to be a true copy of said clause. It is understood and agreed that this license does not preclude the Government from asserting rights under the provisions of said contract or of any other agreement between the Government and the Contractor, or any other rights of the Government with respect to the above-identified invention.

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

Signed this 1st day of August, 19 2000

(SEAL)

*Reliance Electric Co.*

(Contractor)

By *Robert K. Beck*

(Contractor's Official and Title)

Robert K. Beck, Vice President

*1 Allen-Bradley Drive*

(Business Address)

*Mayfield Heights, OH 44124*

ARTICLE 4. PATENT RIGHTS

(a) Definitions.

- (1) "Subject Invention" means any invention or discovery of the Grantee conceived or first actually reduced to practice in the course of or under this subcontract and includes any art, method, process, machine, manufacture, design, or composition of matter, or any new and useful improvement thereof, or any variety of plants, whether patented or unpatented under the Patent Laws of the United States of America or any foreign country.
- (2) "Subcontract" means any subcontract, grant, agreement, understanding, or other arrangement, which includes research, development, or demonstration work, and includes any assignment or substitution of parties.
- (3) "Government agency" includes an executive department, independent commission, board, office, agency, administration, authority, Government corporation, or other Government establishment of the Executive Branch of the Government of the United States of America.
- (4) "To the point of practical application" means to manufacture in the case of a composition or product, to practice in the case of a process, or to operate in the case of a machine and under such conditions as to establish that the invention is being worked and that its benefits are reasonably accessible to the public.
- (5) "Patent Counsel" means the DOE Patent Counsel assisting the procuring activity.

(b) Allocation of principal rights.

- (1) Assignment to the Government. The Grantee 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 waived to and retained by the Grantee under paragraphs (b)(2) and (c) of this clause.
- (2) Greater rights determinations. The Grantee or the employee-inventor with authorization of the Grantee may request greater rights than the domestic and foreign patent rights provided in paragraph (c) of this clause on identified inventions in accordance with 41 CFR 9-9.109-6. Such requests must be submitted to Patent Counsel (with notification by Patent Counsel to the Contracting Officer) at the time of the first disclosure pursuant to paragraph (e)(2) of this clause, or not later than nine (9) months after conception or first actual

- (A) Does not elect pursuant to paragraph (c)(2)(i) of this clause to retain such rights;
  - (B) Fails to have a United States patent application filed on the invention in accordance with paragraph (d)(1) of this clause, or decides not to continue prosecution of such application; or
  - (C) At any time, no longer desires to retain title.
- (ii) Subject to the rights granted in paragraph (c)(1) of this clause, the subcontractor agrees to convey to the Government, upon request, the entire right, title, and interest in any Subject Invention in any foreign country if the Grantee:
- (A) Does not elect pursuant to paragraph (c)(2)(ii) of this clause to retain such rights in the country; or
  - (B) Fails to have a patent application filed in the country on the Subject Invention in accordance with paragraph (d)(3) of this clause, or decides not to continue prosecution or to pay any maintenance fees covering the invention. To avoid forfeiture of the patent application or patent, the Grantee shall notify the Patent Counsel not less than sixty (60) days before the expiration period for any action required by the foreign Patent Office.
- (iii) Conveyance requested pursuant to paragraphs (c)(3)(i) and (c)(3)(ii) of this clause shall be made by delivering to the Patent Counsel duly executed instruments and such other papers as are deemed necessary to vest in the Government the entire right, title, and interest in the invention to enable the Government to apply for and prosecute patent applications covering the invention in this or the foreign country, respectively, or otherwise establish its ownership of the invention.
- (iv) For each invention in which the Grantee initially elects pursuant to (c)(2)(i) or (c)(2)(ii) of this clause not to retain the rights waived, the Grantee shall inform the Patent Counsel promptly in writing of the date and identity of any on sale, public use, or public disclosure of the invention which may constitute a statutory bar under 35 USC 102, which was authorized by or known to the Grantee or any contemplated action of this nature.

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 licensees; or
- (4) Such action is necessary because the agreement required by paragraph (c)(3)(vii) 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.

(ix) U.S. COMPETITIVENESS

The Contractor (waiver recipient) agrees that any products sold by Contractor and embodying any waived invention or produced through the use of any waived invention will be manufactured substantially (1) in the U.S. if such product is rated at 5000 horsepower or less; or (2) in the U.S. or Canada if such product is rated greater than 5000 horsepower; unless the Contractor (waiver recipient) can show to the reasonable satisfaction of the Contracting Officer that it is not commercially feasible to do so. Contractor further agrees that any increase in production capacity (defined as an increase in both square feet of production space and employment at a facility) attributable to the commercialization of superconducting motors will be made in the United States unless the Contractor (waiver recipient) can show to the reasonable satisfaction of the Contracting Officer that it is not commercially feasible to do so. In the event the Contracting Officer agrees to forego the requirements set forth in the preceding sentence, there will be a requirement that the Government's support of the technology be recognized in some appropriate manner (e.g., through a reasonable royalty payable on

(5) Effective Date of Waivers.

The waiver of rights in a Subject Invention shall be effective on the following dates:

- (i) For advance waivers of identified inventions, i.e., inventions conceived prior to the effective date of the subcontract, on the effective date of the subcontract even though the advance waiver may have been requested after that date;
- (ii) For identified inventions under advance waivers, i.e., inventions conceived or first actually reduced to practice after the effective date of the subcontract, on the date the invention is reported with the election to retain the waived rights in that invention; and
- (iii) For waivers of identified inventions (other than under an advance waiver), on the date of the letter notifying the requestor that the waiver has been granted.

(d) Filing of patent applications.

- (1) With respect to each Subject Invention in which the Grantee elects to retain domestic rights pursuant to paragraph (c)(2)(i) of this clause, the Grantee shall have a domestic patent application filed on the invention within six (6) months after submission of the invention disclosure pursuant to paragraph (e)(2)(i) of this clause, or such longer period of time as may be approved by the Patent Counsel for good cause shown in writing by the Grantee. For each identified invention, the rights in which are waived to the Grantee, the Grantee shall have a domestic patent application filed on the invention within six (6) months after the waiver has become effective. With respect to the invention, the Grantee shall promptly notify the Patent Counsel of any decision not to file an application.
- (2) For each Subject Invention on which a domestic patent application is filed by the Grantee, the Grantee shall:
  - (i) Within two (2) months after the filing or within two (2) months after submission of the invention disclosure if the patent application previously has been filed, deliver to Patent Counsel a copy of the application as filed including the filing date and serial number;
  - (ii) Within six (6) months after filing the application or within six (6) months after submitting the invention disclosure if the application has been filed previously, deliver to the Patent Counsel a duly executed and approved instrument fully confirmatory of all rights to which the Government is

(e) Invention identification, disclosures, and reports.

- (1) The Grantee shall establish and maintain active and effective procedures to ensure that Subject Inventions are promptly identified and timely disclosed. Those procedures shall include the maintenance of laboratory notebooks or equivalent records and any other records that are reasonably necessary to document the conception and/or the first actual reduction to practice of Subject Inventions, and records which show that the procedures for identifying and disclosing the inventions are followed. Upon request, the Grantee shall furnish the Contracting Officer a description of these procedures so that he may evaluate and determine their effectiveness.
- (2) The Grantee shall furnish the Patent Counsel (with notification by Patent Counsel to the Contracting Office) on a DOE-approved form:
  - (i) A written report containing full and complete technical information concerning each Subject Invention within six (6) months after conception or first actual reduction to practice whichever occurs first in the course of or under this subcontract, but in any event prior to any on sale, public use or public disclosure of such inventions known to the Grantee. The report shall identify the subcontract and inventor and shall be sufficiently complete in technical detail and appropriately illustrated by sketch or diagram to convey to one skilled in the art to which the invention pertains a clear understanding of the nature, purpose, operation, and to the extent known, the physical, chemical, biological, or electrical characteristics of the invention. The report should also include any election of foreign patent rights under paragraph (c)(2)(ii) of this clause and any election of rights under paragraph (c)(2)(i) of this clause. Any requests for greater rights shall be made within the period set forth in paragraph (b)(2) of this clause. When an invention is reported under this paragraph (e)(2)(i), it shall be presumed to have been made in the manner specified in Section (a)(1) and (2) of 42 USC 5908 unless the Grantee contends it was not so made in accordance with paragraph (g)(2)(ii) of this clause.
  - (ii) Upon request, but not more than annually, interim reports on a DOE-approved form listing Subject Inventions and subcontracts awarded containing a Patent Rights clause for that period and certifying that:
    - (A) The Grantee's procedures for identifying and disclosing Subject Inventions as required by this paragraph (e) have been followed throughout the reporting period;
    - (B) All Subject Inventions have been disclosed or that there are no such inventions;



- (i) Files or causes to be filed a United States or foreign patent application thereon; or
  - (ii) Submits the final report required by paragraph (e)(2)(iii) of this clause, whichever is later.
- (2) However, the Grantee shall not forfeit rights in a Subject Invention if, within the time specified in (1)(i) or (1)(ii) of this paragraph (g), the Grantee:
- (i) Prepared 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 subcontract and delivers the same to Patent Counsel (with notification by Patent Counsel to the Contracting Officer); or
  - (ii) Contending that the invention is not a Subject Invention the Grantee nevertheless discloses the invention and all facts pertinent to this contention to the Patent Counsel (with notification by Patent Counsel to the Contracting Officer); or
  - (iii) Establishes that the failure to disclose did not result from the Grantee's fault or negligence.
- (3) Pending written assignment of the patent applications and patents on a Subject Invention determined by the Secretary or his designee to be forfeited (such determination to be a final decision under the Disputes Clause of this contract), the Grantee 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 (g) shall be in addition to and shall not supersede other rights and remedies which the Government may have with respect to Subject Invention.

(h) Examination of records relating to inventions.

- (1) The Contracting Officer or his authorized representative, until the expiration of three (3) years after final payment under this subcontract, shall have the right to examine any books (including laboratory notebooks), records, documents, and other supporting data of the Grantee which the Contracting Officer or his authorized representative reasonably deem pertinent to the discovery or identification of Subject Inventions or to determine compliance with the requirements of this clause.
- (2) The Contracting Officer or his authorized representative shall have the right to examine all books (including laboratory notebooks), records and documents of the Grantee relating to the conception or first actual reduction to practice of

- (4) The Contracting Officer may, in his direction, decrease or increase the sums withheld up to the maximum authorized above. If the Grantee is a nonprofit organization, the maximum amount that may be withheld under this paragraph shall not exceed \$50,000 or one percent of the amount of this subcontract, whichever is less. No amount shall be withheld under this paragraph while the amount specified by this paragraph is being withheld under other provisions of the subcontract. The withholding of any amount or subsequent payment thereof shall not be construed as a waiver of any rights accruing to the Government under this contract.

(j) Lower-tier Subcontracts.

- (1) For the purpose of this paragraph the term "Contractor" means the party awarding a subcontract and the term "Grantee" means the party being awarded a subcontract, regardless of tier.
- (2) The Contractor will include the Patent Rights clause of DEAR 952.227-71 (a copy of which is attached hereto as Attachment I) 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 or a domestic nonprofit organization. In all other subcontracts, regardless of tier, for experimental, developmental demonstration, or research work, the Contractor shall include the Patent Rights article of 41 CFR 9-9.107-5(a) or 41 CFR 9-9.107-6 as appropriate, modified to identify the parties. In the event of refusal by a subcontractor to accept this clause, or if in the opinion of the contractor this clause is inconsistent with patent policies, the contractor:
- (i) Shall promptly submit written notice to DOE setting forth reasons for the subcontractor's refusal and other pertinent information which may expedite disposition of the matter; and
  - (ii) Shall not proceed with the subcontract without the written authorization of DOE.
- (3) Except as may be otherwise provided in this clause, the Contractor shall not, in any subcontract or by using a subcontract as consideration therefor, acquire any rights in its subcontractor's Subject Invention for the Contractor's own use (as distinguished from such rights as may be required solely to fulfill the Contractor's contract obligations to the Government in the performance of this contract).
- (4) All invention disclosures, reports, instruments, and other information required to be furnished by the Subcontractor to DOE, under the provisions of a Patent Rights clause in any subcontract hereunder may, in the discretion of the Contracting Officer, be furnished to the Contractor for transmission to DOE.

(3) The Grantee also agrees that upon written application by DOE and only if considering the experimental and developmental nature of this Agreement, Grantee or assignee has not taken, or does not expect to take within a reasonable time, effective steps to achieve practical application of the subject matter of this Agreement, it will grant to responsible parties for purpose of practicing high temperature superconducting motors of 100 horsepower or greater nonexclusive licenses under any Background Patent on terms that are reasonable under the circumstances. If, however, the Grantee believes that exclusive or partially exclusive rights are necessary to achieve expeditious commercial development or utilization, then a request may be made to DOE for DOE approval of such licensing by the Grantee. Grantee will have no obligation to grant a license on any Background Patent to any person or entity if such entity is not organized under the laws of a U.S. state or territory, a U.S. citizen and U.S. controlled.

(4) Notwithstanding the foregoing paragraph (k)(3), the Grantee shall not be obligated to license any Background Patent if the Grantee demonstrates to the reasonable satisfaction of the Secretary or his designee that:

- (i) a competitive alternative to the subject matter covered by said Background Patent is commercially available or readily introducible from one or more other sources; or
- (ii) the Grantee or its licensees are supplying the subject matter covered by said Background Patent in sufficient quantity and at reasonable prices to satisfy market needs, or have taken effective steps or within a reasonable time are expected to take effective steps to so supply the subject matter.

(l) Reserved.

(m) Limitation of rights.

Nothing contained in this Patent Rights clause shall be deemed to give the Government any rights with respect to any invention other than a Subject Invention except as set forth in the Patent Rights clause of this subcontract with respect to Background Patents and the Facilities License.

#### ARTICLE 5. ADDITIONAL TECHNICAL DATA REQUIREMENTS

- (a) In addition to the technical data specified elsewhere in this grant to be delivered, the Contracting Officer may at any time during the grant performance or within one year after final payment call for the Grantee to deliver any technical data first produced or specifically used in the performance of this grant except technical data pertaining to items of standard commercial design.

may be called for under the "Additional Technical Data Requirements" article of the grant, if any, or technical data actually delivered in connection with the grant.

- (4) "Unlimited Rights" 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 Data" means technical data or commercial or financial data 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 Data by a party to this Agreement.

(b) Allocation of rights.

(1) The Government shall have:

- (i) Unlimited rights in grant data except as otherwise provided below with respect to proprietary data.
- (ii) The right to remove, cancel, correct or ignore any markings not authorized by the terms of this grant on any technical data furnished hereunder, if in response to a written inquiry by DOE concerning the propriety of the markings, the Grantee fails to respond thereto within sixty (60) days or fails to substantiate the propriety of the markings. In either case DOE will notify the Grantee of the action taken.
- (iii) No rights under this grant in any technical data which are not grant data.

(2) The Grantee shall have:

- (i) The right to withhold proprietary data in accordance with the Provisions of this article,
- (ii) The right to use for its private purposes, subject to patent, security or other provisions of this grant, grant 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 grant, contract or subcontractor, the Grantee shall treat such data in accordance with any restrictive legend

Notwithstanding the inclusion of the "Additional Technical Data Requirements" article in this grant or any provision of this grant specifying the delivery of technical data, the Grantee may withhold proprietary data from delivery, provided that the Grantee 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 "Grantee licensing" provisions of 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 (3) years after final payment under this grant, may inspect at the Grantee's facility any proprietary data withheld under paragraph (a) and not furnished under paragraph (g), if included, 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 - (July, 1977)

Except as may be otherwise specified in this Contract as technical data which are not subject to this Paragraph, the Contractor shall, upon written request from the Contracting Officer at any time prior to three (3) years after final payment under this contract, promptly deliver to the Government any "proprietary data" withheld pursuant to paragraph (e) of the "Rights in Technical Data" clause of this contract. The following legend and no other is authorized to be affixed on any "proprietary data" delivered pursuant to this provision, provided the "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 Contract No. \_\_\_\_\_ with the United States Department of Energy (and purchase order No. \_\_\_\_\_ if applicable) may be duplicated and used by the Government with the express limitations that the "proprietary data" may not be disclosed outside the Government or be used for purposes of manufacture without prior permission of the Contractor, except that further disclosure or use may be made solely for the following purposes:

- (5) It is commercially feasible under the circumstances for DOE or third parties to reverse engineer such data from the deliverables produced by recipient under the Agreement.

Notwithstanding anything in this paragraph to the contrary, Recipient shall have no obligation to license the Protected Data to any person or entity if such entity is not organized under the laws of a U.S. state or territory, a U.S. citizen and U.S. controlled. For the purposes of this paragraph (h), Proprietary Data shall include only such data which are specifically necessary to the design, manufacture, or use of the superconducting portions of the motor or motors developed pursuant to this agreement.

(i) Information Available to the Public

- a. Contractor agrees 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 Data. DOE and Contractor agree that it is necessary for this type of information to be publicly available.

Simplified schematics of project  
General information of project  
Project progress/status  
General economic analysis results  
Generic results of testing  
Results of final project status

- b. The parties agree, however, that notwithstanding the foregoing list 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 Data Information

- a. Except for items of information subject to paragraph (i) of this clause, Contractor may claim as Protected Data any information first produced in the performance of this Cooperative Agreement which meets the definition set forth in paragraph a(5) of this clause.
- b. With the agreement of the Contracting Officer Contractor shall mark any such Protected Data delivered to the Government with

- (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 Data Information;
- (iii) If the same information is independently developed by someone who does not have access to the Protected Data 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.

#### **ARTICLE 7. RIGHTS TO PROPOSAL DATA**

It is agreed that as a condition of the award of this grant or modification thereto, and notwithstanding the provisions of any notice appearing on the proposal(s), the Government shall have the right to use, duplicate, and disclose and have others to do so for any purpose whatsoever, the technical data contained in the proposal(s) upon which this grant or modification is based.

#### **ARTICLE 8. ASSIGNMENT**

Any intellectual property right accruing to Grantee in this Agreement (including but not limited to rights in Subject Inventions, Waived Inventions, Technical Data, Grant Data, and Protected Data) may be assigned, licensed, disclosed or otherwise transferred by Grantee subject to any restrictions on the exercise of such rights to the Grantee's domestic subsidiaries and affiliates within the corporate structure of which the Grantee is a part and shall include the right to grant sublicenses of the same scope to the extent the Grantee was legally obligated to do so at the time the subcontract was awarded.

(1) The contractor 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 contractor 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) (Reserved.)

(c) Invention disclosure, election of title and filing of patent application by contractor.

(1) The contractor will disclose each subject invention to the Patent Counsel within two months after the inventor discloses it in writing to contractor personnel responsible for 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, 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 the Patent Counsel, the Contractor will promptly notify the Patent Counsel of the acceptance of any manuscript describing the invention for publication or of any on sale or public use planned by the contractor.

(2) The contractor will elect in writing whether or not to retain title to any such invention by notifying the Patent Counsel within two years of disclosure to the Patent Counsel. 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 Patent Counsel to a date that is no more than sixty days prior to the end of the statutory period.

(3) The contractor 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 contractor 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.

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



shown by the contractor) after the notice to show cause why the license should not be revoked or modified. The contractor has the right to appeal, in accordance with 37 CFR 404 and 10 CFR Part 781, any decision concerning the revocation or modification of its license.

(f) Contractor action to protect the Government's interest.

(1) The contractor 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 to which the contractor elects to retain 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 contractor 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 contractor each subject invention made under this contract in order that the contractor can comply with the disclosure provisions of (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) above. The contractor shall instruct such employees through the 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 United States or foreign statutory bars.

(3) The contractor 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 contractor agrees to include, within 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 (identify the contract) awarded by the Department of Energy. The Government has certain rights in the invention."

(5) The contractor agrees to:

(i) Upon request, provide a report prior to the close-out of the contract listing all subject inventions or stating that there were none;

(ii) Provide, upon request, a copy of the patent application, filing date, serial number and title, patent number and issue date for any subject invention in any country in which the contractor has applied for a patent; and

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 contractor agrees that with respect to any subject invention in which it has acquired title, DOE has the right in accordance with the procedures in 37 CFR 401.6 and any supplemental regulations of DOE to require the contractor, 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 contractor, 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 contractor 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 contractor, 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 contractor, assignee, or licensees; or

(4) Such action is necessary because the agreement required by paragraph (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 contracts with nonprofit organizations.

If the contractor 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, provided that such assignee will be subject to the same provisions as the contractor;

(2) The contractor will share royalties collected on a subject invention with the inventor, including Federal employee co-inventors (when DOE deems it appropriate) when the subject invention is assigned in accordance with 35 U.S.C. 202(e) and 37 CFR 401.10;

(3) The balance of any royalties or income earned by the contractor with respect to subject inventions, after payment of expenses (including payments to inventors) incidental to