



12-11-2000



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U.S. Department of Commerce  
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**RECORDATION FORM COVER SHEET  
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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)	Execution Date		
	Month	Day	Year
HYDRO QUEBEC	09	21	2000

Name (line 2)

**Second Party**

Name (line 1)	Execution Date		
	Month	Day	Year
MINNESOTA MINING & MANUFACTURING COMPANY	10	09	2000

Name (line 2)

**Receiving Party**

☐ Mark if additional names of receiving parties attached

Name (line 1)	Name (line 2)	Address (line 1)	Address (line 2)	Address (line 3)	Execution Date				
					Month	Day	Year		
UNITED STATES DEPARTMENT OF ENERGY		1000 INDEPENDENCE AVENUE, S.W.		WASHINGTON	D. C. USA	20585			

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.)

City State/Country Zip Code

**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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**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 SOUTH CASS AVENUE**

Address (line 4) **ARGONNE, ILLINOIS 60439**

**Pages**

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

# **015**

**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)

09/544,134

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.

# **01**

**Fee Amount**

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

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

*Mark P. Dvorscak*

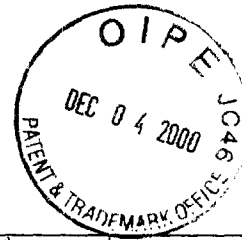
Signature

NOV 29 2000

Date

# CONFIRMATORY LICENSE

(CRADA PARTICIPANT)



Title : Composite treatment with LiPO3  
Inventor(s) : Michel Gauthier, Simon Besner, Michel Armand,  
Serial No. : 09/544,134 Filing Date: (U.S.) 04/06/2000  
Participant (s) : Hydro Quebec & Minnesota Mining & Manufacturing Company  
CRADA NO. : ANL-C-9203901 with Hydro Quebec & Minnesota Mining & Mfg.  
DOE Case No. : S-94,967 Waiver No. W(C) -90-013

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

The Contractor, having the right to retain title to certain Subject Inventions as a result of the above identified U. S. Department of Energy (DOE) Class Patent Waiver, has reported the above identified invention as a Subject Invention to DOE with an election to retain title thereto.

Accordingly, this document is confirmatory of the nonexclusive, nontransferable, irrevocable, paid-up license to practice or to have practices for or on behalf of the United States in this subject invention, patent application and any resulting patent, as well as continuation, divisional, reissue, supplemental or continuation-in-part thereof, throughout the world and of all other rights acquired by the Government, including the march-in rights in accordance with 48 CFR 27.304-1(g), by the above identified CRADA. It is understood and agreed that this license does not preclude the Government from asserting rights under the provisions of said CRADA, or from asserting 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.

(SEAL)

Signed this 21<sup>st</sup> day of September, 20 000.

HYDRO QUEBEC

(Contractor)

By: \_\_\_\_\_

(Contractor's Official and Title)

Jean-René Marcoux  
General Manager

75 boul. René Lévesque Ouest Montréal, Québec  
H2Z 1A4 (Business Address)

(SEAL)

Signed, this 9<sup>TH</sup> day of OCTOBER, 20 00.

MINNESOTA MINING & MANUFACTURING COMPANY

(Contractor)

By Wayne W. Brown

(Contractor's officer and title)

Wayne W. Brown

Vice President Automotive

P.O. Box 33427, St. Paul, MN 55133-3427

(Business Address)

## SECTION 7 SUPERSEDITION OF 3M/HYDRO-QUEBEC LETTER SUBCONTRACT NO. G1-00210-KMT BY THIS CRADA

Upon the effective date of this CRADA, letter subcontract No. G1-00210-KMT dated August 6, 1993 issued by 3M to Hydro-Quebec is hereby cancelled and superseded by this CRADA and all work performed under such letter subcontract is hereby merged into and made a part of the work performed under this CRADA. All work performed under such letter subcontract shall be subject to the terms and conditions of this CRADA and the "Flowdown Agreement by and between 3M and Hydro-Quebec in connection with LPBs." All costs incurred by Hydro-Quebec under such letter subcontract shall be deemed to be costs incurred by Hydro-Quebec under this CRADA.

## SECTION 8 - PATENT RIGHTS

### A. Definitions

(1) "Subject Invention" means any invention or discovery of Hydro-Quebec conceived or first actually reduced to practice in the course of or under this CRADA, 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) "Contract" means any contract, 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) Whereas USABC has entered into a Cooperative Agreement No. DE-FC02-91CE50336, with the Department of Energy (DOE) for conducting work in the DOE's Advanced Battery Program, and whereas prior to entering into the Cooperative Agreement, USABC did receive from the DOE an advance waiver of certain rights with respect to intellectual property generated as a consequence of said Cooperative Agreement, said advanced waiver being executed on August 21, 1991, and whereas concurrent with said waiver DOE declared an exceptional circumstance under 35 USC 202 (a) (ii) for funding agreements under said Cooperative Agreement; therefore, pursuant to said Cooperative Agreement and said advance waiver, USABC and 3M agreed that as to any Subject Invention of employees of 3M and/or employees of any Subcontractor and/or any Subcontractor who is an individual, USABC thereby granted to 3M and to such Subcontractors under the Research and Development Agreement the right to elect title thereto pursuant to the terms of said Cooperative Agreement and thereby conveyed the entire right, title and interest to such Subject Invention to 3M and/or such Subcontractors, including Hydro-Quebec, which conveyance may be confirmed by an appropriate assignment. Under the terms of the Research and Development Agreement, the election by 3M and its Subcontractors shall be concomitant with the reporting of the Subject Invention to the DOE and USABC.

(2) Hydro-Quebec and/or 3M shall retain the entire right, title and interest throughout the world to each Subject Invention subject to the provisions of this clause.

(3) Hydro-Quebec 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 rights are waived to, and retained by Hydro-Quebec and/or 3M, or a Subcontractor under the terms of the Exceptional Circumstances Determination and the Statement of Considerations and pursuant to paragraph (c) of this Section 8.

C. Rights to Hydro-Quebec

(1) Minimum Hydro-Quebec license. Hydro-Quebec, 3M and USABC reserve an irrevocable, nonexclusive, paid-up license in each patent application filed in any country on a Subject Invention and any resulting patent in which the Government acquires title. The license shall extend to Hydro-Quebec's, 3M's and USABC's domestic subsidiaries and affiliates, if any, within the corporate structure of which Hydro-Quebec, 3M and USABC are a part and shall include the right to grant sublicenses of the same scope to the extent Hydro-Quebec, 3M and USABC were legally obligated to do so at the time the CRADA was awarded. The license shall be transferable only with approval of DOE except when transferred to the successor of that part of the business to which the invention pertains.

(2) Election to Retain Waived Rights.

(i) Subject to the provisions of paragraph C(3) and paragraph D of this clause, with respect only to a Subject Invention reported in accordance with paragraph E(2)(i) of this clause and with the written report of which is included an election by Hydro-Quebec identifying the party retaining title to the invention waived therein, rights in patent applications and patents will be reserved as follows: The election by Hydro-Quebec will specify that title will be retained by 3M and Hydro-Quebec jointly, or by 3M individually or by Hydro-Quebec individually. The party(ies) so specified will be referred to as the "Party retaining title" hereafter. The Party retaining title reserves the entire domestic right, title and interest in any United States patent application on the Subject Invention filed and any resulting United States patent secured by the Party retaining title.

(ii) Subject to the provisions of paragraph C(3) and paragraph D of this clause, with respect only to a Subject Invention reported in accordance with paragraph E(2)(i) of this clause and with the written report of which is included an election by Hydro-Quebec as to whether an identified party will retain the rights in the invention waived herein and a statement specifying those foreign countries in which such rights will be retained, and subject to DOE security regulations and requirements, Hydro-Quebec and/or 3M jointly or individually will reserve the entire right, title and interest in any foreign patent application on the Subject Invention filed and any resulting foreign patent secured by Hydro-Quebec and/or 3M in those foreign countries specified. The party(ies) so specified will also be referred to as the "Party retaining title" hereafter.

(3) Terms and Conditions of Waived Rights

(i) Subject to the rights granted in paragraph C(1) of this clause, Hydro-Quebec and/or 3M agrees to reconvey to the USABC, and if the USABC declines, to convey to the Government, upon request, the entire domestic right, title, and interest in any Subject Invention when:

(a) Hydro-Quebec does not elect pursuant to paragraph C(2)(i) of this clause to retain such rights (DOE may only request title within 60 days after learning of Hydro-Quebec's and 3M's failure to elect within the specified time);

(b) Hydro-Quebec and/or 3M, as the case may be, 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) Hydro-Quebec and/or 3M, as the case may be, at any time, no longer desires to retain title except where transfer of title occurs pursuant to the Statement of Considerations.

(ii) Subject to the rights granted in paragraph C(1) of this clause, Hydro-Quebec and/or 3M, as the case may be, agrees to reconvey to the USABC and if the USABC declines, to convey to the Government, upon request, the entire right, title, and interest in any Subject Invention in any foreign country if:

(a) Hydro-Quebec does not elect pursuant to paragraph C(2)(ii) of this clause to retain such rights in the country (DOE may only request title within 60 days after learning of Hydro-Quebec's failure to elect within the specified time); or

(b) Hydro-Quebec and/or 3M, as the case may be, 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, Hydro-Quebec and/or 3M shall notify USABC and the Patent Counsel not less than 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, or to USABC when USABC takes title, duly executed instruments and such other papers as are deemed necessary to vest in the USABC or the Government the entire right, title, and interest in the invention to enable USABC or 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 Hydro-Quebec initially elects pursuant to C(2)(i) or C(2)(ii) of this clause not to retain the rights waived, Hydro-Quebec shall inform USABC and 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 Hydro-Quebec, or any contemplated action of this nature.

(v) Government License

With respect to any Subject Invention in which Hydro-Quebec and/or 3M, or USABC 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.

(vi) Reporting on Utilization of Subject Inventions

The Party retaining title 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 Party retaining title 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 Party retaining title, and such other data and information as DOE may reasonably specify. The Party retaining title also agrees to provide additional reports as may be requested by DOE in connection with any march-in proceedings undertaken by DOE in accordance with paragraph C(3)(viii) of this clause. To the extent data or information supplied under this paragraph is considered by the Party retaining title or USABC, or a 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.



(vii) Preference for United States Industry

The Party retaining title agrees that it will not 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 Party retaining title 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.

(viii) March-in Rights

The Party retaining title agrees that with respect to any Subject Invention in which it and/or 3M 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 Party retaining title, or an 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 Party retaining title, an 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 Party retaining title, or a licensee 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 Party retaining title, an assignee, or a licensee;
- [3] Such action is necessary to meet requirements for public use specified by federal regulations and such requirements are not reasonably satisfied by the Party retaining title, or its licensee; 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

[1] The Party retaining title to a Subject Invention shall, at the DOE's request, grant a sublicense under the Subject Invention, or any patent or patent application based thereon, to a U.S. owned or controlled company identified to the Party retaining title by DOE if the Party retaining title transfers title in the Subject Invention to a company or entity which is majority-owned or controlled, directly or indirectly, by a non-U.S. company or entity and the non-U.S. company or entity is other than 3M, Hydro-Quebec, Hydro-Quebec Related Corporations, or the Joint Venture.

[2] In the event the Party retaining title to a Subject Invention decides to grant licenses under a Subject Invention, or patent or patent application based thereon, to a party other than a 3M Related Corporation, Hydro-Quebec, a Hydro-Quebec Related Corporation or the Joint Venture, the Party retaining title will give preference to U.S. manufacturers who have demonstrated capability of providing high quality product and services.

[3] Subject to Paragraph (ix)[4] below, the Party retaining title in a Subject Invention shall not grant or transfer to a company which is majority owned or controlled, directly or indirectly, by a non-U.S. company or entity the right to manufacture products embodying the Subject Invention or produced through the use of a Subject Invention in a foreign country without the express written approval of DOE.

[4] By reviewing and approving this CRADA, the DOE hereby approves any grant or transfer of the right to manufacture products embodying a Subject Invention or produced through the use of a Subject Invention in a foreign country by the Party retaining title to a Subject Invention to Hydro-Quebec, Related Corporations of 3M and/or Hydro-Quebec, or the Joint Venture, with the proviso that 3M Related Corporations, Hydro-Quebec, Hydro-Quebec Related Corporations, and the Joint Venture will not sell in the United States products embodying a Subject Invention or produced through the use of a Subject Invention unless they are manufactured substantially in the U.S. or Canada, without the express written approval of DOE.

[5] Hydro-Quebec shall include Subparagraphs (1), (2) and (4) of Section (c)(3)(ix), "U.S. Competitiveness," of Article 4, "Patent Rights," of Appendix B to the Cooperative Agreement in any Subcontract under which a Subcontractor may take title to a Subject Invention. Such Subparagraphs of Section (c)(3)(ix) shall be modified in each such Subcontract to (a) substitute the name of the Subcontractor for the name "USABC" each place it appears, and (b) provide that such paragraph shall not apply to, or restrict in any way, the assignment of the entire right, title and interest in a Subject Invention or the grant of a license, whether exclusive or otherwise, under a Subject Invention or any patent or patent application thereon, to 3M and/or Hydro-Quebec per this Subparagraph (c)(3)(ix), "U.S. Competitiveness," of this Section 8, "Patent Rights." Hydro-Quebec shall include this Section (c)(3)(ix) in any R&D Subcontract with a 3M Related Corporation or Hydro-Quebec Related Corporation.

[6] Subparagraphs (1), (2), (3) and (4) of this Section (c)(3)(ix) shall be included in any contract under which the Joint Venture is transferred title to a Subject Invention by the Party retaining title. Such Subparagraphs shall be modified in such contract to substitute the name of the Joint Venture for the "Party retaining title" each place it appears.

#### (4) Terminations

(i) Any waiver or retention of rights by Hydro-Quebec under paragraphs B(2), C(1), or C(2) of this clause may be terminated at the discretion of the Secretary or his designee, in whole or in part, if the request for waiver or retention of rights by USABC is found to contain false material statements or nondisclosure of material facts, and such were specifically relied upon in reaching the waiver determination or the agreement to the retention of rights by USABC or Hydro-Quebec.

(ii) Any waiver of the rights retained in accordance with paragraph C(2), as applied to particular inventions, may be terminated at the discretion of the Secretary or his designee, in whole or in part, if USABC, or Hydro-Quebec fails to comply with the provisions set forth in paragraph C(3) and paragraph D of this clause, and such failure is determined by the Secretary or his designee to be material and detrimental to the interests of the United States and the general public.

(iii) Prior to terminating any waiver of rights under paragraph C(4)(i) or C(4)(ii) of this clause, USABC and Hydro-Quebec will be given written notice of the intention to terminate the waiver of rights, the extent of such proposed termination and the reasons therefor, and a period of 30 days, or such longer period as the Secretary or his designee shall determine for good cause shown in writing, to show cause why the waiver of rights should not be so terminated.

(iv) All terminations of waivers of rights under paragraph C(4)(ii) shall be subject to the rights granted in paragraph C(1) of this clause, and termination shall normally be partial in nature, requiring Hydro-Quebec to grant nonexclusive or partially exclusive licenses to responsible applicants upon terms reasonable under the circumstances.

(v) The DOE recognizes that Hydro-Quebec did not participate in the USABC's request for waiver and that Hydro-Quebec may be unduly harmed by a termination of the USABC waiver. If the USABC waiver is terminated, the DOE will provide Hydro-Quebec an opportunity to submit a waiver in its own behalf and shall give full consideration on Hydro-Quebec's reliance on the USABC waiver together with participation in cost sharing in this Program. In no event will any termination of Hydro-Quebec's rights under this paragraph C(4) diminish or in any way adversely effect the rights obtained by USABC relative to Subject Inventions under the Cooperative Agreement No. DE-FC02-91CE50336.

(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 CRADA, on the effective date of the CRADA 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 CRADA, 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 Hydro-Quebec elects to retain domestic rights pursuant to paragraph C(2)(i) of this clause, the Party retaining title shall have a domestic patent application filed on the invention within 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 Party retaining title. With respect to the invention, the Party retaining title shall promptly notify USABC and 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 Party retaining title, the Party retaining title shall:

- (i) Within 2 months after the filing or within 2 months after submission of the invention disclosure if the patent application previously has been filed, deliver to USABC and Patent Counsel a copy of the application as filed including the filing date and serial number;
- (ii) Within 6 months after filing the application or within 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 entitled and provide DOE an irrevocable power to inspect and make copies of the patent application filed;
- (iii) Provide USABC and the Patent Counsel with a copy of the patent within 2 months after a patent is issued on the application;
- (iv) Not less than 30 days before the expiration of the response period for any action required by the Patent and Trademark Office, notify USABC and the Patent Counsel of any decision not to continue prosecution of the application and deliver to the Patent Counsel executed instruments granting the Government a power of attorney; and
- (v) Include the following statement in the second paragraph of the specification of the application and any patents issued on a Subject Invention, "The Government of the United States of America has rights in this invention pursuant to Cooperative Agreement No. DE-FC02-91CE50336 awarded by the U.S. Department of Energy".

(3) With respect to each Subject Invention in which Hydro-Quebec has elected pursuant to paragraph C(2)(ii) of this clause to retain the patent rights waived in specified foreign countries, or in which Hydro-Quebec has obtained a waiver of foreign rights on an identified invention:

(i) The Party retaining title shall file a patent application on the invention in each specified foreign country in accordance with applicable statutes and regulations and within one of the following periods:

(a) Eight months from the date of filing a corresponding United States application, or if such an application is not filed, six months from the date the invention is submitted in a disclosure pursuant to paragraph E(2)(i) of this clause;

(b) Six months from the date a license is granted by the Commissioner of Patents and Trademarks to file the foreign patent application where such filing has been prohibited by security reasons; or

(c) Such longer period as may be approved by the Patent Counsel for good cause shown in writing by the Party retaining title.

(ii) The Party retaining title shall notify USABC and the Patent Counsel promptly of each foreign application filed and upon written request shall furnish an English version of the application without additional compensation.

#### E. Invention Identification, Disclosures, and Reports

(1) Hydro-Quebec shall establish and maintain active and effective procedures to ensure that Subject Inventions of Hydro-Quebec employees 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 of Hydro-Quebec employees, and records which show that the procedures for identifying and disclosing the inventions are followed. Upon request, Hydro-Quebec shall furnish the Contracting Officer a description of these procedures so that he may evaluate and determine their effectiveness.

(2) Hydro-Quebec shall furnish USABC, 3M and the Patent Counsel (with notification by Patent Counsel to the Contracting Officer) on a DOE-approved form:

(i) A written report containing full and complete technical information concerning each Subject Invention of Hydro-Quebec employees within 6 months after conception or first actual reduction to practice whichever occurs first in the course of or under this CRADA, but in any event prior to any on sale, public use or public disclosure of such inventions known to Hydro-Quebec. The report shall identify the CRADA 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 Hydro-Quebec contends it was not so made in accordance with paragraph (G)(2)(ii) of this clause.

(ii) Upon Patent Counsel's request, but not more than annually, interim reports on a DOE-approved form listing Subject Inventions of Hydro-Quebec employees and Subcontracts awarded containing a Patent Rights clause for that period and certifying that:

(a) Hydro-Quebec's procedures for identifying and disclosing Subject Inventions of Hydro-Quebec employees as required by this paragraph (E) have been followed throughout the reporting period;

(b) All Subject Inventions of Hydro-Quebec employees have been disclosed or that there are no such inventions;

(c) All Subcontracts containing a Patent Rights clause have been reported or that no such Subcontracts have been awarded; and

(iii) A final report on a DOE-approved form within 3 months after completion of the CRADA work listing all Subject Inventions of Hydro-Quebec employees and all Subcontracts awarded containing a Patent Rights clause and certifying that:

(a) All Subject Inventions of Hydro-Quebec employees have been disclosed or that there were no such inventions; and

(b) All Subcontracts containing a Patent Rights clause have been reported or that no such Subcontracts have been awarded.

(3) Hydro-Quebec shall obtain patent agreements to effectuate the provisions of this clause from all persons in its employ who perform any part of the work under this CRADA except nontechnical personnel, such as clerical employees and manual laborers.

(4) Hydro-Quebec 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. If the Party retaining title is to file a foreign patent application on a Subject Invention, the Government agrees, upon written request, to use its best efforts to withhold publication of such invention disclosures until the expiration of the time period specified in paragraph (D)(1) of this clause, or for up to the period specified on the restrictive legend authorized by the CRADA, but in no event shall the Government or its employees be liable for any publication thereof.

#### F. Publication

It is recognized that during the course of the work under this CRADA, Hydro-Quebec 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 CRADA. In order that public disclosure of such information will not adversely affect the patent interests of DOE or the Party retaining title, patent approval for release or publication shall be secured from Patent Counsel prior to any such release or publication.

#### G. Forfeiture of Rights in Unreported Subject Inventions

(1) Hydro-Quebec shall forfeit to the Government, at the request of the Secretary or his designee, all rights in any Subject Invention of its own and any Subject Inventions of any of its Subcontractors of which it is aware which Hydro-Quebec or its Subcontractor, as the case may be, fails to report to Patent Counsel (with notification by Patent Counsel to the Contracting Officer) within six months after the time Hydro-Quebec or its Subcontractor, as the case may be :

(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)(ii) of this clause, whichever is later.



(2) However, Hydro-Quebec shall not forfeit rights in a Subject Invention if, within the time specified in (1)(i) or (1)(ii) of this paragraph G, Hydro-Quebec or its Subcontractor:

(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 CRADA 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, Hydro-Quebec or its Subcontractor 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 Hydro-Quebec's or its Subcontractor 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 CRADA), Hydro-Quebec and/or the Party retaining title 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.

(4) A forfeiture by Hydro-Quebec under this paragraph G to rights in a Subject Invention shall not affect the rights of USABC to such Subject Invention as provided under the Cooperative Agreement No. DE-FC02-91CE50336.

#### H. Examination of Records Relating to Inventions

(1) The Contracting Officer or his authorized representative, until the expiration of 3 years after final payment under this CRADA, shall have the right to examine any books (including laboratory notebooks), records, documents, and other supporting data of Hydro-Quebec 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 Hydro-Quebec relating to the conception or first actual reduction to practice of inventions in

the same field of technology as the work under this CRADA to determine whether any such inventions are Subject Inventions, if Hydro-Quebec refuses or fails to:

- (i) Establish the procedures of paragraph E (1) of this clause; or
- (ii) Maintain and follow such procedures; or
- (iii) Correct or eliminate any material deficiency in the procedures within thirty (30) days after the Contracting Officer notifies Hydro-Quebec of such a deficiency.