

04-29-2002

U.S. Department of Commerce
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Conveyance Type

Assignment Security Agreement

License Change of Name

Merger Other

U.S. Government
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Departmental File Secret File

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Mark if additional names of conveying parties attached

Name (line 1) Execution Date Month Day Year

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

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)

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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 <input type="text"/>	PCT <input type="text"/>	PCT <input type="text"/>
PCT <input type="text"/>	PCT <input type="text"/>	PCT <input type="text"/>

Number of Properties Enter the total number of properties involved. #

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

Method of Payment: Enclosed Deposit Account

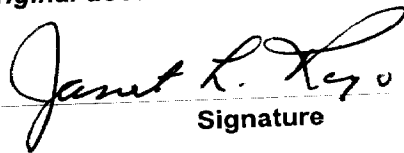
Deposit Account (Enter for payment by deposit account or if additional fees can be charged to the Deposit Account Number: #

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.

Janet L. Rego
Name of Person Signing


Signature

4-9-2002
Date

CONFIRMATORY LICENSE

Title: Optical Cavity for Darl Field Illumination

Inventor: Dan Pinkel, Donnal Albertson and Damir Sudar

Serial No.: 08/878,146

Filing Date (U.S.): 6/18/97

Contractor: The University of California

DOE Contract No.: DE-AC03-76SF00098

NIH Contract #: CA45919/HD17665

DOE Case No.: S-86712 (RL-13831)

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 9th day of Feb., 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)

University of California,
1320 Harbor Bay ParkwayAlameda, CA 94502

(Contractor's Business Address)

Attachment Patent Rights Clause

Modification No. M145
Supplemental Agreement to
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

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.

*Modification No. M145
Supplemental Agreement to
Contract No. DE-AC03-76SF00098*

(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.

(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.

* Modified for this contract

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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.