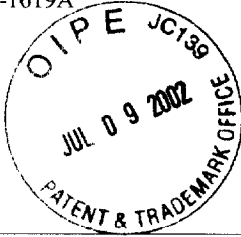


07-16-2002



102157876

RECORDATION FORM COVER SHEET
PATENTS ONLY

5-96, 132

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

Submission Type

New 7-9-02

Resubmission (Non-Recordation)
Document ID#

Correction of PTO Error
Reel # Frame #

Corrective Document
Reel # Frame #

Conveyance Type

Assignment Security Agreement

License Change of Name

Merger Other

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

Departmental File Secret File

Conveying Party(ies)

Mark if additional names of conveying parties attached

Name (line 1) Execution Date Month Day Year

Second Party

Name (line 1) Execution Date Month Day Year

Name (line 2)

Receiving Party

Mark if additional names of receiving parties attached

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

Name (line 2)

Address (line 1) Execution Date Month Day Year

Address (line 2)

Address (line 3)
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)

FOR OFFICE USE ONLY

Correspondent Name and Address

Area Code and Telephone Number

202-586-2802

Name Brenda K. Banks

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

Address (line 2) 1000 Independence Avenue, S.W.

Address (line 3) Washington, D. C. 20585-0162

Address (line 4)

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

5

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)

			6,268,198		

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.

1

Fee Amount

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

0.00

Method of Payment:

Enclosed Deposit Account

Deposit Account

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

Deposit Account Number:

#

Authorization to charge additional fees:

Yes

No

Statement and Signature

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

Brenda K. Banks

Brenda K. Banks

6/18/2002

Name of Person Signing

Signature

Date

09/687,147
New Pat. 6,268,198



CONFIRMATORY LICENSE
(Nonprofit Organizations or Small Business Firms)

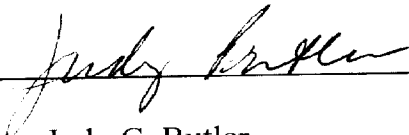
Title: Cellulases and Coding Sequences
UGA Inventor(s): Xin-Liang Li, Lars Ljungdahl, Huizhong Chen
Serial No.: 09/687,147 Filing Date (U.S.): 10/12/2000
Contractor: University of Georgia Research Foundation, Inc.
DOE Contract No.: DE-FG05-93ER20127
DOE Case No.: S-96,132
Patent Rights Clause No.: 17
Continuing Data if any:
Foreign Applications filed in or intended to be filed at Contractor's expense in (countries):

The Contractor, having the right to retain title to Subject Inventions as a result of Public Law 96-517, has reported the above-identified invention as a Subject Invention to DOE with its election to retain title thereto.

Accordingly, this document is confirmatory of the nonexclusive, non-transferable, irrevocable, paid-up license required by the Public Law and this contract in this invention, patent application and any resulting patent as well as any continuation, divisional, reissue, or supplemental thereof, and of all other rights acquired by the Government by the above-identified clause, a copy of which is attached hereto and incorporated by reference herein. The undersigned certified 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 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.

Signed this 29th day of November, 2000.



By: Judy C. Butler
Corporate Secretary and Legal Advisor
University of Georgia Research Foundation, Inc.
Boyd Graduate Studies Research Center
Athens, Georgia 30602-7411

12. RENEWAL AND SUPPLEMENT APPLICATIONS.

The signed original and 7 duplicate originals of applications are to be submitted to the DOE Project Officer, as identified in Block 11 of the NFAA. Applications are to be separate documents and are not to be commingled with or bound together as part of any other required submission (technical information forms, financial status reports, etc.). Grantee applications are to be submitted in accordance with the General Terms and Conditions, 10 CFR Part 605, DOE's published Application and Guide, and the following guidance:

a. DOE F 4650.2, Face Page, and ERF 4620.1, Grant Application Budget Period Summary, are to be submitted with applications. If applications cover multiyear support, the ERF 4620.1 should be submitted for each proposed budget period.

b. Renewal Application – An application for a renewal award must be submitted no later than six months prior to the scheduled expiration of the project period.

13. EXTENSIONS WITHOUT ADDITIONAL FUNDS.

When the grantee extends the expiration date (project period end) in accordance with Article 12 of the General Terms and Conditions, DOE will issue a formal amendment to the grant. This procedure will ensure that the Financial Status Report is submitted for the extended budget period identified in the NFAA, Block 6, and continuity of the project period is maintained in the NFAA, Block 7.

14. KEY PERSONNEL

The project director/co-project directors (principal investigator/co-principal investigators) are identified in Block 8 of the NFAA and are designated as key personnel in addition to the following:

(If left blank, there are no other key personnel.)

15. FEDERALLY OWNED EQUIPMENT.

a. During the period of DOE support, the grantee shall (a) submit annually in accordance with DOE written instructions an inventory which lists Federally owned equipment acquired with DOE grant funds which is in the custody of the grantee or any subgrantee under the grant and (b) notify DOE as soon as practicable whenever Federally owned equipment is no longer needed for the project.

b. For extended or terminated grants, the grantee shall report any Federally owned equipment upon request DOE as part of closeout.

16. CLOSEOUT.

The grantee shall provide (a) technical and financial reports in accordance with DOE F EIA-459A, Federal Assistance Reporting Checklist, (b) a report of nonexempt equipment in accordance with Article 14 of the General Terms and Conditions, (c) a report of Federally owned equipment in accordance with Article 15 of these special terms and conditions, and (d) DOE F 2050.11, Patent Certification.

17. PATENT RIGHTS - SMALL BUSINESS FIRMS AND NONPROFIT ORGANIZATIONS (OTHER THAN M&O [DEAR 952.227-71 (APR 1987)]).

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 (U.S.C.) or any novel variety of plants 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 conceived by the grantee or first actually reduced to practice in the performance of work under this grant, provided that in the case of a variety of plants the date of determination [as defined in Section 44(d) of the Plant Variety Protection Act, 7 U.S.C. 2401(d)] must also occur during the period of grant 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 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 (11 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 CFR 121.3-8 and 13 CFR 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 1954 [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) Patent Counsel assisting the DOE awarding activity.

b. Allocation of Principal Rights.

(1) The grantee may retain the entire right, title and interest throughout the world to each subject invention subject to the provisions of this clause and 35 U.S.C. 203. With respect to any subject invention in which the grantee 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 Grantee.

(1) The grantee will disclose each subject invention to the Patent Counsel within two months after the inventor discloses it in writing to grantee's personnel responsible for patent matters. The disclosure to the Patent Counsel shall be in the form of a written report and shall identify the grant 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 grantee 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 grantee.

(2) The grantee 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 grantee 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 grantee will file patent application 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 sub paragraphs (1), (2), and (3) may, at the discretion of the Patent Counsel, be granted.

d. Conditions When the Government May Obtain Title

The grantee will convey to the DOE, upon written request, title to any subject invention:

(1) If the grantee 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 within 60 days after learning of the failure of the grantee to disclose or elect within the specified times;

(2) In those countries in which the grantee fails to file patent applications within the times specified in c. above; provided, however, that if the grantee has filed a patent application in a country after the time specified in c. above prior to its receipt of the written request of the Patent Counsel, the grantee shall continue to retain title in that country; or

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

e. Minimum Rights to Grantee and Protection of The Grantee's Right to File.

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

(2) The grantee's domestic license may be revoked or modified by DOE to the extent necessary to achieve expeditious practical application of the subject invention pursuant to an application for an exclusive license submitted in accordance with applicable provisions at 37 CFR 404 and 10 CFR 781. This license will not be revoked in that field of use or the geographical areas in which the grantee has achieved practical application and continues to make the benefits of the invention reasonably accessible to the public. The license in any foreign country may be revoked or modified at the discretion of DOE to the extent the grantee, its licensees, or its domestic subsidiaries or affiliates have failed to achieve practical application in that foreign country.

(3) Before revocation or modification of the license, DOE will furnish the grantee a written notice of its intention to revoke or modify the license, and the grantee will be allowed thirty days (or such other time as may be authorized by DOE for good cause shown by the grantee) after the notice to show cause why the license should not be revoked or modified. The grantee has the right to appeal, in accordance with 37 CFR 404 and 10 CFR Part 781, any decision concerning the revocation or modification of its license.

f. Grantee Action to Protect The Government's Interest.

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

(a) Establish or confirm the rights the Government has throughout the world in those subject inventions to which the grantee elects to retain title, and

(b) Convey title to DOE when requested under d. above and to enable the Government to obtain patent protection throughout the world in that subject invention.

(2) The grantee agrees to require, by written agreement, its employees, other than clerical and nontechnical employees, to disclose promptly in writing to personnel identified as responsible for the administration of patent matters and in a format suggested by the grantee each subject invention made under this grant in order that the grantee can comply with the disclosure provisions of c. above and to execute all papers necessary to file patent applications on subject inventions 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 grantee 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 grantee will notify the Patent Counsel 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, at least thirty days before the expiration of the response period required by the relevant patent office.

(4) The grantee agrees to include, within the specification of any United States patent applications and any patent issuing thereon covering a subject invention, the following statement "This invention was made with Government support under (identify the grant) awarded by the Department of Energy. The Government has certain right in this invention."

(5) The grantee agrees to:

(a) Upon request, provide a report prior to the closeout of the grant listing all subject inventions or stating that there were none;

(b) 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 grantee has applied for a patent; and

(c) Provide upon request, but not more than annually, listings of all subject inventions which were disclosed to DOE during the applicable reporting period.

g. Subgrants.

(1) The grantee will include this clause, suitable modified to identify the parties, in all subgrants, regardless of tier, for experimental, developmental or research work to be performed by a small business firm or a domestic nonprofit organization. The subgrantee will retain all rights provided for the grantee in this clause, and the grantee will not, as part of the consideration for awarding the subgrant, obtain rights in the subgrantee's subject inventions.

(2) The grantee will include in all other subgrants regardless of tier, for experimental, developmental, demonstration or research work the patent rights clause of 41 CFR 9-9.107-5(a) or 9-9.107-6 as appropriate, modified to identify the parties.

h. Reporting on Utilization of Subject Inventions.

The grantee agrees to submit on request periodic reports no more frequently than annually on the utilization of a subject invention or on efforts at obtaining such utilization that are being made by the grantee or its licensees or assignees. Such reports shall include information regarding the status of development, date of first commercial sale or use, gross royalties received by the grantee, and such other data and information as DOE may reasonably specify. The grantee also agrees to provide additional reports as may be requested by DOE in connection with any march-in proceeding undertaken by DOE in accordance with para-

graph j. of this clause. As required by U.S.C. 202(c)(5), DOE agrees it will not disclose such information to persons outside the Government without permission of the grantee.

i. Preference for United States Industry.

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

j. March-in-rights.

The grantee agrees that with respect to any subject invention in which it has acquired title, DOE has the right in accordance with the procedures in 37 CFR 401.6 and any supplemental regulations of DOE to require the grantee, an assignee or exclusive licensee of a subject invention to grant a nonexclusive, partially exclusive, or exclusive license in any field of use to a responsible applicant or applicants, upon terms that are reasonable under the circumstances, and if the grantee, assignee, or exclusive licensee refuses such a request, DOE has the right to grant such a license itself if DOE determines that:

(1) Such action is necessary because the grantee or assignee has not taken, or is not expected to take within a reasonable time, effective steps to achieve practical application of the subject invention in such field of use;

(2) Such action is necessary to alleviate health or safety needs which are not reasonably satisfied by the grantee, assignee, or their licensees;

(3) Such action is necessary to meet requirements for public use specified by Federal regulations and such requirements are not reasonably satisfied by the grantee, assignee, or 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 Grants with Nonprofit Organizations.

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

(1) Rights to a subject invention in the United States may not be assigned without the approval of DOE except where such assignment is made to an organization which has as one of its primary functions the management of inventions, provided that such assignee will be subject to the same provisions as the grantee;

(2) The grantee will share royalties collected on a subject invention with the inventor, including Federal employees 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 grant with respect to subject inventions, after payment of expenses (including payments to inventors) incidental to the administration of subject inventions, will be utilized for the support of scientific research or education and

(4) It will make efforts that are reasonable under the circumstances to attract licensees of subject inventions that are small business firms and that it will give a preference to a small business firm when licensing a subject invention if the grantee determines that the small business firm has a plan or proposal for marketing the invention which, if executed, is equally as likely to bring the invention to practical application as any plans or proposals from applicants that are not small business firms; provided that the grantee is also satisfied that the small business firm has the capability and resources to carry out its plan or proposal. The decision whether to give a preference in any specific case will be at the discretion of the grantee. However, the grantee agrees that the Secretary of Commerce may review the grantee's licensing program and decisions regarding small business applicants, and the grantee will negotiate changes to its licensing policies, procedures, or practices with the Secretary of Commerce when the Secretary of Commerce's review discloses that the grantee could take reasonable steps to implement more effectively the requirements of this paragraph k(4).

l. Communications.

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

18. RIGHTS IN TECHNICAL DATA (SHORT FORM)
[10 CFR PART 600.33].

This provision shall apply to all grants other than those having as a purpose the conduct of a conference, symposium, or training.

a. Definitions.

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