



Department of Energy
Washington, DC 20585

DOE IPI-II-03-22

INTERNAL PATENT INSTRUCTIONS (IPI)
FOR USER AGREEMENTS

TO ALL DOE PATENT COUNSEL:

INTRODUCTION

Waivers

- 1) Class Waiver for Non-Proprietary User Facilities: DOE WAIVER NO. W(C)2008-003
- 2) Class Waiver for Proprietary User Facilities: DOE Waiver No. W(C)2008-005

In 2008, DOE granted the above two Class Waivers for designated User Facilities at all DOE Laboratories. DOE's Assistant General Counsel for Technology Transfer and Intellectual Property, in coordination with the Office of Laboratory Policy, maintains a list of designated User Facilities and approves the addition of new facilities. Each Class Waiver included a respective User Agreement attached: Non-Proprietary User Agreement (NPUA) or a Proprietary User Agreement (PUA). Each Class Waiver stated that "the form of NPUA [PUA] may be updated periodically at the discretion of the DOE Assistant General Counsel for Technology Transfer and Intellectual Property after consultation with DOE program organizations."

On October 23, 2018, DOE issued a memo titled "Decision on Recommended Technology Transition Reforms Related to Indemnity Requirement in Laboratory Partnering Agreements with Domestic Entities." (hereinafter Indemnity Memo) In the Background of the Indemnity Memo, User Facility Agreements were included as being affected by the changes in indemnity provisions. The changes recommended in the Indemnity Memo are explained in further detail in the AGREEMENTS section below and inserted in the attached model NPUA and PUA.

This IPI is being issued to update the User Agreements attached to each Class Waiver to incorporate changing DOE policy, make other minor changes, add optional language and updates deemed necessary to clarify provisions. Each Laboratory must work with its DOE site office in determining whether current agreements should be allowed to continue until expiration or amend them accordingly. However, the Laboratories should seek approval for Laboratory Model User Agreements to implement changes as soon as practical for new users.

THE AGREEMENTS

A. Non-Proprietary User Agreements:

The Indemnity Memo allows reserving General Indemnity and Intellectual Property Indemnity in User Facility Agreements for state and local government and public universities and “Federally-funded sponsors” (i.e. sponsors that fund the transaction through previously acquired Federal funds) who are funding work that advances a United States (U.S.) Government mission. Since allocation of time at a User Facility is funded by DOE and not a Federally-funded Sponsor, this office has determined that the reservation of the General and Intellectual Property Indemnity should apply only to NPUAs with U.S. state and local governments and public universities and not Federally-funded Users. Many Laboratories enter into a single User Agreement with an entity that will cover multiple allocations of time for projects at the user facility. These User Agreements may be active over a standard period of time such as five years and it would be difficult to monitor whether a sponsor is Federally-funded for all projects. To implement the Indemnity Memo, the Laboratories may reserve the General Indemnity and Intellectual Property Indemnity for state and local governments and public universities.

Foreign entities will continue to require indemnity provisions in their agreements.

Exhibit A is attached with the revised NPUA and guidance to comply with DOE policy.

B. Proprietary User Agreements:

A User under a Proprietary User Agreement fully funds its own experiments with no federal funds per the PUA Class Waiver. Therefore, Federally funded entities needing an allocation of facility time can enter into a different agreement, e.g. under a Strategic Partnership Projects (SPP), where indemnity provisions may be reserved. However, as discussed above for the NPUA, the Indemnity Memo does provide for reserving these clauses for “state and local governments and public universities” based on their status and not whether Federal funds are used for their work.

Exhibit B is attached with the revised PUA and guidance to comply with DOE policy.

C. The Laboratory models:

The laboratories are encouraged to create User Agreements models for the entire lab or tailored to specific user facilities within the lab. These models shall be approved by site office DOE contracting officers with concurrence from DOE patent counsel.

CONCLUSION

The changes to the Model agreements are under the purview of Assistant General Counsel for Technology Transfer as stated in the Class Waivers.

A handwritten signature in black ink, appearing to read 'BJL', is centered on the page.

Brian J. Lally
Assistant General Counsel for
Technology Transfer and Intellectual Property

Date: July 14, 2022

Exhibit A Non-Proprietary User Agreement

The Department of Energy (DOE) has opted to utilize the following standard agreement for non-proprietary work at Designated User Facilities. Because these activities are widespread across Departmental facilities, uniformity in agreement terms is desirable. Many of these Articles have been pre-approved by DOE in this Laboratory model and may require DOE approval for any modifications. In instances where DOE Contracting Officer approval for substantive changes cannot be obtained, Strategic Partnership Projects (SPP) or Cooperative Research and Development Agreements (CRADAs) may be more appropriate due to the increased flexibility such agreements afford. Where this agreement is to be used as an umbrella agreement for multiple transactions, it may be modified to reflect such usage.

Non-Proprietary User Agreement

No.

BETWEEN

(" CONTRACTOR")

Operator of [name of Laboratory] (hereinafter "Laboratory")
under United States (U.S.) Department of Energy (DOE) Contract No.

AND

("USER")

(Collectively, "the Parties")

The obligations of the above-identified DOE Contractor may be transferred to and shall apply to any successor in interest to said Contractor continuing the operation of the DOE Non-Proprietary User Facility involved in this User Agreement.

ARTICLE I. FACILITIES AND SCOPE OF WORK

CONTRACTOR will make available to employees, consultants and representatives of USER (hereinafter called "Participants") certain Laboratory User Facilities for non-proprietary user, which may include equipment, services, information and other material, with or without Laboratory scientist collaboration, for purposes as described in the Appendix which is attached to and made a part of this Agreement. Additional future Appendices referencing this Agreement may be submitted by USER for identifying facilities and purposes during the term of this Agreement (see Article II). Such additional Appendices will be considered to be part of this Agreement upon acceptance by CONTRACTOR. Each Appendix shall set forth the Technical Scope of Work of a specific project, including deliverables, to be performed pursuant to this Agreement. The scope of work shall not be considered proprietary information and shall be publicly releasable. The Parties agree that an initial publicly-releasable abstract of the work to be performed shall be a deliverable under this Agreement.

NOTE: *The laboratory may insert the specific User Facility name in the first sentence or add a block at the end of the paragraph:*

FACILITY: _____

NOTE: *The USER may be part of a large collaboration where it is impractical to attach all of the experimental documentation to each agreement or the User's proposal accepted by the laboratory granting user facility allocation of time does not need to be attached to this agreement because it is documented elsewhere. However, there needs to be a link between the User's proposed research activities and the current User Agreement. Therefore, the existing User Agreement number may be referenced in the proposal, the Laboratory's approval letter for allocation of time, or other process approved by the DOE Site Office that documents the link. The Laboratory should maintain the documentation of these proposals and collaboration agreement for an adequate period of time after the projects are completed. This optional language removes the Appendix from the model type agreement:*

CONTRACTOR will make available to employees, consultants, and representatives of USER (hereinafter called "Participants") certain Laboratory User Facilities for non-proprietary use, which may include equipment, services, information, and other material, with or without Laboratory scientist collaboration, for purposes as described in the USER's proposal accepted and conducted at the designated User Facility. Additional future experiments referencing this Agreement may be submitted by USER for identified User Facilities and purposes during the term of this Agreement (see Article II). Such additional proposals will be considered part of this Agreement upon acceptance by CONTRACTOR. Each accepted and approved proposal shall set forth the Technical Scope of Work of a specific project, including deliverables, to be performed pursuant to this Agreement. The scope of work shall not be considered proprietary information and shall be publicly releasable.

ARTICLE II. TERM OF THE AGREEMENT

This Agreement shall have a term of ____ months/years from the effective date. The term of this Agreement shall be effective as of the date on which it is signed by the last of the Parties.

NOTE: *The Laboratories may allow extending the agreement by automatic renewal or amend the user agreement to extend. If an automatic renewal is used, then the Termination clause will need to be used to end the agreement appropriately. The following suggested sentences may be added:*

Option 1:

Unless terminated in accordance with the terms herein, this Agreement shall automatically renew on a year-to-year basis after the initial five year term.

Option 2:

The agreement can be renewed without any changes for additional terms upon written consent of the parties.

ARTICLE III: COST

Each Party will bear its own costs and expenses associated with this Agreement. No money will be transferred to or from either Party as consideration, in whole or in part, for this Agreement.

ARTICLE IV: GENERAL DISCLAIMER

THE U.S. GOVERNMENT AND CONTRACTOR MAKE NO EXPRESS OR IMPLIED WARRANTY AS TO THE CONDITIONS OF THE USER FACILITY FURNISHED HEREUNDER. IN ADDITION, THE U.S. GOVERNMENT, CONTRACTOR AND USER MAKE NO EXPRESS OR IMPLIED WARRANTY AS TO THE RESEARCH OR ANY INTELLECTUAL PROPERTY, GENERATED INFORMATION, OR PRODUCT MADE OR DEVELOPED UNDER THIS AGREEMENT, OR THE OWNERSHIP, MERCHANTABILITY, OR FITNESS FOR A PARTICULAR PURPOSE OF THE RESEARCH OR RESULTING PRODUCT; THAT THE GOODS, SERVICES, MATERIALS, PRODUCTS, PROCESSES, INFORMATION, OR DATA TO BE FURNISHED HEREUNDER WILL ACCOMPLISH INTENDED RESULTS OR ARE SAFE FOR ANY PURPOSE INCLUDING THE INTENDED PURPOSE; OR THAT ANY OF THE ABOVE WILL NOT INTERFERE WITH PRIVATELY OWNED RIGHTS OF OTHERS. THE U.S. GOVERNMENT, CONTRACTOR AND/OR USER SHALL NOT BE LIABLE FOR SPECIAL, CONSEQUENTIAL, OR INCIDENTAL DAMAGES ATTRIBUTED TO USE OF SUCH FACILITIES, RESEARCH OR RESULTING PRODUCT, INTELLECTUAL PROPERTY, GENERATED INFORMATION, OR PRODUCT MADE OR DELIVERED UNDER THIS AGREEMENT.

ARTICLE V: PROPERTY AND MATERIALS

USER may be permitted by Contractor to furnish equipment, tooling, test apparatus, or materials necessary to assist in the performance of its experiment(s) at the User Facility. Such items shall remain the property of USER. Unless the Parties otherwise agree, all such property furnished by USER or equipment and test apparatus provided by USER will be removed by USER within sixty (60) days of termination or expiration of this Agreement or will be disposed of as directed by USER at USER's expense. Any equipment that becomes integrated into the User Facility shall be the property of the U.S. Government. USER acknowledges that any material supplied by USER may be damaged, consumed or lost. Materials (including residues and/or other contaminated material) remaining after performance of the work or analysis will be removed in their then condition by USER at USER's expense.

USER will return facilities and equipment utilized in their original condition except for normal wear and tear.

CONTRACTOR shall have no responsibility for USER's property in CONTRACTOR's possession other than loss or damage caused by willful misconduct or gross negligence of CONTRACTOR or its employees.

Personal property produced or acquired during the course of this Agreement shall be disposed of as directed by the owner at the owner's expense.

ARTICLE VI: SCHEDULING

USER understands that CONTRACTOR will have sole responsibility and discretion for allocating and scheduling usage of the User Facilities and equipment needed for or involved under this Agreement.

ARTICLE VII: INDEMNITY AND LIABILITY

- A. Personnel Relationships** - USER shall be responsible for the acts or omissions of Participants.
- B. General Indemnity** - To the extent permitted by U.S. law and U.S. State law, USER hereby agrees to indemnify and hold harmless CONTRACTOR and the U.S. Government, their officers, agents and employees from any and all liability, claims, damages, costs and expenses, including attorney fees, for injury to or death of persons, or damage to or destruction of property, to the extent such liability, claims, or damages is caused by or contributed to the negligence or intentional misconduct of USER or its employees or representatives during the performance of the work under this Agreement.
- C. Patent and Copyright Indemnity—Limited** - To the extent permitted by U.S. law and U.S. State law, USER shall fully indemnify the U.S. Government and CONTRACTOR and their officers, agents, and employees for infringement of any United States patent or copyright arising out of any acts required or directed or performed by USER under this Agreement to the extent such acts are not normally performed at the facility.
- D. Product Liability** - To the extent permitted by U.S. law and U.S. State law, if USER utilizes the work derived from this Agreement in the making, using, or selling of a product, process or service, then USER hereby agrees to hold harmless and indemnify CONTRACTOR and the U.S. Government, their officers, agents and employees from any and all liability, claims, damages, costs and expenses, including attorney fees, for injury to or death of persons, or damage to or destruction of property, as a result of or arising out of such utilization of the work by or on behalf of USER, its assignees or licensees.
- E.** The liability and indemnity provisions in paragraphs B, C and D above shall not apply unless USER shall have been informed as soon as practicable by CONTRACTOR or the U.S. Government of the suit or action alleging such infringement, and such indemnity shall not apply to a claimed infringement that is settled without the consent of USER unless required by a court of competent jurisdiction.
- F. Notice and Assistance Regarding Patent and Copyright Infringement**
 - a. USER shall report to the U.S. Government, promptly and in reasonable written detail, each notice or claim of patent or copyright infringement based on the performance of this Agreement of which USER has knowledge.
 - b. In the event of any claim or suit against the U.S. Government on account of any alleged patent or copyright infringement arising out of the performance of this Agreement or out of the use of any supplies furnished or work or services performed hereunder, USER shall furnish to the U.S. Government when requested by the U.S. Government,

all evidence and information in possession of USER pertaining to such suit or claim. Such evidence and information shall be furnished at the expense of the U.S. Government except where USER has agreed to indemnify the U.S. Government.

NOTE: For U.S. State and Local Governments and Public Universities, the following provision may be used to replace the above indemnity and liability clauses of paragraphs B-D:

- B. General Indemnity—Reserved**
- C. Patent and Copyright Indemnity—Limited - Reserved**
- D. Product Liability** Any licenses granted or assignments made by USER to any third party in technology derived from the work performed under this Agreement, such license or assignment shall include the requirement that the licensee/assignee shall agree to hold harmless and indemnify CONTRACTOR and the U.S. Government, their officers, agents and employees from any and all liability, claims, damages, costs and expenses, including attorney fees, for injury to or death of persons, or damage to or destruction of property, as a result of or arising out of such utilization of the work by or on behalf of USER's assignees or licensees.

NOTE: The Product Liability clause above for licensing to third parties by the USER may be used with Private Universities, but those agreements would still require General and Intellectual Property Indemnity clauses.

ARTICLE VIII: PATENT RIGHTS

A. Definitions

1. "Subject Invention" means any invention or discovery conceived or first actually reduced to practice in the course of or under this Agreement.
2. "USER Invention" means any Subject Invention of USER.
3. "CONTRACTOR Invention" means any Subject Invention of CONTRACTOR.
4. "Patent Counsel" means the DOE Counsel for Intellectual Property assisting the DOE Contracting activity.

B. Subject Inventions

CONTRACTOR and USER agree to disclose their Subject Inventions, which includes any inventions of their Participants, to each other, concurrent with reporting such Subject Inventions to DOE. USER shall provide through the iEdison reporting system, unless otherwise directed by Patent Counsel, the disclosure within six months of conception or first actual reduction to practice, whichever occurs first.

C. CONTRACTOR's Rights

Except as provided below in the case of joint inventions, CONTRACTOR Inventions will be governed by the provisions of CONTRACTOR'S Prime Contract for operation of the User Facility.

D. USER's Rights

Subject to the provisions herein, USER may elect title to any USER Invention through iEdison reporting system and in any resulting patent secured by USER within one year of reporting the subject invention to DOE. The USER shall file a US patent application within a reasonable period of time. Where appropriate, the filing of patent applications by USER is subject to DOE security regulations and requirements.

E. Joint Inventions

For Subject Inventions conceived or first actually reduced to practice under this Agreement that are joint Subject Inventions made by CONTRACTOR and USER, each Party shall have the option to elect and retain title to its undivided rights in such joint Subject Inventions.

F. Rights of the U.S. Government

1. USER agrees to timely assign to the U.S. Government, if requested, the entire right, title, and interest in any country to each USER Invention where USER:
 - a. Does not elect to retain such rights; or
 - b. Fails to timely have a patent application filed in that country on the USER Invention or decides not to continue prosecution or not to pay the maintenance fees covering the Invention; or
 - c. At any time, no longer desires to retain title.
2. USER shall provide through the iEdison reporting system, unless otherwise directed by Patent Counsel, a copy of any application filed by USER promptly after such application is filed, including its serial number and filing date.
3. USER hereby grants to the U.S. Government a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the USER Invention made under said project throughout the world.
4. USER acknowledges that the DOE has certain March-in Rights to any USER Inventions elected by the USER in accordance with 48 C.F.R. 27.304-1(g) and that the USER is subject to the requirements with respect to preference for U.S. industry pursuant to 35 U.S.C. § 204 to any USER Inventions elected by the USER.
5. The USER agrees to include, within the specification of any U.S. patent applications and any patent issuing thereon covering a USER Invention, the following statement: "The United States Government has rights in this invention pursuant to a USER Agreement (specify number) between (USER name) and (CONTRACTOR Name), which manages and operates (name of Laboratory) for the U.S. Department of Energy."
6. USER agrees to submit through the iEdison reporting system, unless otherwise directed by

Patent Counsel, periodic reports to DOE no more frequently than annually on the utilization of USER Inventions or on efforts to obtain such utilization that are being made by USER or its licensees or assignees.

7. Facilities License: USER agrees to and does hereby grant to the U.S. Government a nonexclusive, nontransferable, irrevocable, paid-up license in and to any inventions or discoveries, regardless of when conceived or actually reduced to practice or acquired by USER, which are incorporated in the User Facility as a result of this Agreement to such an extent that the facility is not restored to the condition existing prior to this Agreement (1) to practice or to have practiced by or for the U.S. Government at the User Facility, and (2) to transfer such licenses with the transfer of that User Facility. The acceptance or exercise by the U.S. Government of the aforesaid rights and license shall not prevent the U.S. Government at any time from contesting the enforceability, validity or scope of, or title to, any rights or patents herein licensed.

NOTE: Before paragraph A in this clause and the following Article for Rights in Technical Data, a preamble referencing a USER's funding for their research might be added. The following suggestions are used by various laboratories:

Option 1:

Unless the USER is performing work under a Federal Contract, Grant or Cooperative Agreement, the following shall apply:

Option 2:

If research subject to this Agreement is performed by the USER under a Federal agency grant, cooperative agreement or contract, then, to the extent that the patent rights provisions in the USER's grant, cooperative agreement or contract with a federal agency are inconsistent with the terms and conditions contained in this Article, the terms and conditions of the grant, cooperative agreement or contract shall apply.

Option 3:

The provisions, in Articles VIII (Patent Rights) and IX (Rights in Technical Data) below, are applicable to any privately or non-federally funded work. Notwithstanding the foregoing, if research subject to this Agreement is performed by the USER under a federal agency grant, cooperative agreement, or contract, or the work is subject to an international agreement then, to the extent that the Intellectual Property Provisions in the USER's grant, cooperative agreement, or contract with a federal agency or in the international agreement are inconsistent with the terms and conditions contained in Articles VIII and IX below, the Intellectual Property terms and conditions of the grant, cooperative agreement, or contract, or international agreement that are inconsistent with Articles VIII and IX below, shall apply to the work performed by the USER under this Agreement

ARTICLE IX: RIGHTS IN TECHNICAL DATA

A. Definitions:

1. "Technical Data" means recorded information regardless of form or characteristic, of a scientific or technical nature. Technical Data as used herein does not include financial reports, costs analyses, and other information incidental to administration of this Agreement.
2. "Proprietary Data" means Technical Data which embody trade secrets developed at private expense, outside of this agreement, such as design procedures or techniques, chemical composition of materials, or manufacturing methods, processes, or treatments, including minor modifications thereof, provided that such data:
 - a. Are not generally known or available from other sources without obligation concerning their confidentiality.
 - b. Have not been made available by the owner to others without obligation concerning their confidentiality, and
 - c. Are not already available to the CONTRACTOR or the U.S. Government without obligation concerning their confidentiality.
 - d. Are marked as "Proprietary Data."
3. "Unlimited Rights" means right 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.

B. Allocation of Rights

1. USER, CONTRACTOR, and the U.S. Government shall have Unlimited Rights in all data generated under this Agreement, except for information which is disclosed in a Subject Invention disclosure being considered for patent protection.
2. USER 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 the CONTRACTOR, DOE or subcontractor, USER shall treat such data in accordance with any restrictive legend contained thereon, unless use is specifically authorized by prior written approval of the CONTRACTOR or DOE Contracting Officer.

C. Deliverables

1. USER agrees to furnish to DOE or CONTRACTOR those data, if any, which are (a) specified to be delivered in Appendices, (b) essential to the performance of work by CONTRACTOR personnel or (c) necessary for the health and safety of such personnel in the performance of the work. Any data furnished to DOE or CONTRACTOR shall be deemed to have been delivered with unlimited rights unless marked as "Proprietary Data" of USER.
2. Upon completion or termination of the project, USER agrees to deliver to DOE and CONTRACTOR a nonproprietary report describing the work performed under this Agreement.

D. Legal Notice

The following legal notice shall be affixed to each report or publication resulting from this Agreement which may be distributed by USER:

DISCLAIMER NOTICE

This document was prepared by ___ as a result of the use of facilities of the U.S. Department of Energy (DOE), which are managed by [CONTRACTOR name_____], acting under Contract No._____. Neither [CONTRACTOR name], DOE, the U.S. Government, nor any person acting on their behalf: (a) make any warranty or representation, express or implied, with respect to the information contained in this document; or (b) assume any liabilities with respect to the use of, or damages resulting from the use of any information contained in the document.

E. Copyrighted Material

1. USER agrees to, and does hereby grant to the U.S. Government, its officers, agents, servants and employees acting within the scope of their duties:
 - a. A royalty-free, nonexclusive, irrevocable license to reproduce, translate, publish, use, and dispose of and to authorize others so to do, all copyrightable material first produced or composed in the performance of this Agreement by USER, its employees or any individual or concern specifically employed or assigned to originate and prepare such material; and
 - b. A license as aforesaid under any and all copyrighted or copyrightable works not first produced or composed by USER in the performance of this Agreement but which are incorporated in the material furnished or delivered under this Agreement, provided that such license shall be only to the extent USER now has, or prior to completion or final settlement of this Agreement may acquire, the right to grant such license without becoming liable to pay compensation to others solely because of such grant.
2. USER agrees that it will not knowingly include any copyrightable material furnished or delivered under this Agreement without a license as provided for in subparagraph 1(b) hereof, or without the consent of the copyright owner, unless it obtains specific written approval of the DOE Contracting Officer for the inclusion of such copyrighted materials.

F. Disclosure of Proprietary Data

1. The U.S. Government and Contractor agree not to disclose properly marked Proprietary Information without written approval of the USER, except to U.S. Government employees who are subject to the statutory provisions against disclosure of confidential information set forth in the Trade Secrets Act (18 U.S.C. 1905).
2. The USER is solely responsible for the removal of all of its Proprietary Information from the facility by or before termination of this Agreement at its own expense. USER may request the Contractor to return or destroy all of the USER's Proprietary Information subject to paragraph (1) above. The U.S. Government and Contractor shall have Unlimited Rights in any information which is not removed from the facility by termination of this Agreement. The U.S. Government and Contractor shall have Unlimited Rights in any Proprietary Information which is incorporated into the facility or equipment under this Agreement to such extent that the facility or equipment is not restored to the condition existing prior to such incorporation.

NOTE: A Laboratory CONTRACTOR may delete the clauses pertaining to Proprietary Data if the CONTRACTOR prohibits the USER from bringing Proprietary Data into the User Facility. In such cases, the CONTRACTOR may substitute the following for Section F:

The USER shall not bring Proprietary Data into the User Facility except at USER's own risk. Any such data, regardless of how it is marked, shall be deemed Technical Data and shall be treated according to this article of this Agreement.

ARTICLE X. LABORATORY SITE ACCESS, SAFETY AND HEALTH

As a precondition to using the User Facility, Participants must complete all CONTRACTOR site access documents and requirements. USER and participant shall take all reasonable precautions in activities carried out under this Agreement to protect the safety and health of others and to protect the environment. Participants must comply with all applicable safety, operating and health procedures, access to information, security, cyber-security, hours of work, conduct and environmental regulations and the requirements of the DOE and CONTRACTOR, including the specific requirements of the User Facility covered by this Agreement. In the event that USER or its Participant fails to comply with said regulations and requirements, CONTRACTOR may, without prejudice to any other legal or contractual rights, issue and order stopping all or any part of USER's activities at the User Facility.

ARTICLE XI. PERSONNEL RELATIONSHIPS

Participants will remain employees or representatives of the USER at all times during their participation in the work under this Agreement, and shall not be considered employees of CONTRACTOR or DOE for any purpose. Participants shall be subject to the administrative and technical supervision and control of CONTRACTOR during and in connection with the Participant's activities under this Agreement.

ARTICLE XII: EXPORT CONTROLS

USER acknowledges that the export of goods or Technical Data may require some form of export control license from the U.S. Government and that failure to obtain such export control license may result in criminal liability under the laws of the United States.

NOTE: The DOE Site Office may approve a Laboratory version or use the more robust Export Control language similar to the CRADA Order as follows:

THE PARTIES UNDERSTAND THAT MATERIALS AND INFORMATION RESULTING FROM THE PERFORMANCE OF THIS AGREEMENT MAY BE SUBJECT TO U.S. GOVERNMENT EXPORT CONTROL LAWS AND REGULATIONS AND THAT EACH PARTY IS RESPONSIBLE FOR ITS OWN COMPLIANCE WITH SUCH LAWS AND REGULATIONS. EXPORT LICENSES OR OTHER AUTHORIZATIONS FROM THE U.S. GOVERNMENT MAY BE REQUIRED FOR THE EXPORT OF GOODS, TECHNICAL DATA OR SERVICES UNDER THIS AGREEMENT. THE PARTIES ACKNOWLEDGE THAT EXPORT CONTROL REQUIREMENTS MAY CHANGE AND THAT THE EXPORT OF GOODS, TECHNICAL DATA OR SERVICES FROM THE U.S. WITHOUT AN EXPORT LICENSE OR OTHER APPROPRIATE GOVERNMENTAL AUTHORIZATION MAY RESULT IN CIVIL AND CRIMINAL LIABILITY.

ARTICLE XIII: PUBLICATIONS

- A. USER and CONTRACTOR will provide each other copies of articles of any publication of information generated pursuant to this Agreement for review and comment 14 days prior to publication.
- B. USER will not use the name of CONTRACTOR or the U.S. Government or their employees in any promotional activity, such as advertisements, with reference to any product or service resulting from this Agreement, without prior written approval of the U.S. Government and CONTRACTOR.

ARTICLE XIV: DISPUTES

The parties will attempt to jointly resolve all disputes arising under this agreement. If the parties are unable to jointly resolve a dispute within a reasonable period of time, either party may contact the CONTRACTOR's Technology Transfer Ombudsman (TTO) to provide assistance. The TTO may work directly to resolve the dispute or, upon mutual agreement of the parties, contact a third-party neutral mediator to assist the parties in coming to a resolution. The costs of the mediator's services will be shared equally by the parties. In the event that an agreement is not reached with the aid of the ombudsman or mediator, the parties may agree to have the dispute addressed by neutral evaluation. The decision rendered by the neutral evaluator shall be nonbinding on the parties, and any costs incurred there from shall be divided equally between the parties. Upon mutual agreement, the parties may request a decision by the DOE Contracting Officer. Absent resolution, either party may seek relief in a court of competent jurisdiction.

ARTICLE XV. CONFLICT OF TERMS

This Agreement constitutes the primary document which governs the work described in the attached Appendices or in references cited. In the event of any conflict between the terms of this document and any other document issued by either Party, the terms of this document shall prevail, unless USER is performing work with Federal funding or an international agreement. In such situations, the terms of the Federal funding agreement or international agreement will prevail.

NOTE: The following alternate clause could be used:

This Agreement constitutes the primary document which governs the work conducted under approved proposals at CONTRACTOR's User Facilities. In the event of any conflict between the terms of this Agreement and any other document issued by either Party, the terms of this Agreement shall prevail.

ARTICLE XVI: TERMINATION

Either Party may terminate this Agreement for any reason at any time by giving not less than thirty (30) days prior written notice to the other Party. Notice will be deemed made as of the day of receipt. The obligations of any clause of this Agreement, which by their nature extend beyond its termination, shall remain in full force and effect until fulfilled.

FOR THE CONTRACTOR:
BY:
TITLE:
DATE:

FOR THE USER:
BY:
TITLE:
DATE:

Exhibit B Proprietary User Agreement

The Department of Energy has opted to utilize the following standard agreement for proprietary work at Designated User Facilities. Many of these Articles have been pre-approved by DOE in this Laboratory model and may require DOE approval for any modifications. In instances where DOE Contracting Officer approval for substantive changes cannot be obtained, Strategic Partnership Projects (SPP) or Cooperative Research and Development Agreements (CRADAs) may be more appropriate due to the increased flexibility such agreements afford.

Proprietary User Agreement

No.

BETWEEN

("CONTRACTOR")

Operator of [name of Laboratory] (hereinafter "Laboratory")
under United States (U.S.) Department of Energy Contract No.

AND ("USER")

(Collectively, "the Parties")

The obligations of the Contractor may be transferred and shall apply to any successor in interest to said Contractor continuing the operation of the DOE facility involved in this Proprietary User Agreement.

ARTICLE I. FACILITIES AND SCOPE OF WORK

Employee(s), consultant(s), and representative(s) of USER (hereinafter called "Participant(s)") shall be permitted to use Laboratory User Facilities for the purpose of performing the experiment(s) accepted and approved for performance at Laboratory. This Proprietary User Agreement shall be incorporated by reference and apply to all such experiments authorized for performance at Laboratory User Facilities which are totally funded by USER. CONTRACTOR will retain its employees assigned to this work on its payroll and will be reimbursed by USER for the account of DOE in accordance with DOE's pricing policy, which provides for full cost recovery.

Facility:

Scope of Work:

ARTICLE II. TERM OF THE AGREEMENT

This Agreement shall have a term of _____ months/years from the effective date. The term of this Agreement shall be effective as of the latter date of (1) the date on which it is signed by the last of the Parties, or (2) the receipt of any advance payment required under Article III.

ARTICLE III. BILLING AND PAYMENT OF EXPENSES

The estimated cost of the work, described in Article I above is \$ _____

NOTE: Please refer to the Strategic Partnership Projects Order 481.5 for updated advance payment clauses that should be used in this Agreement. DOE site office should approve a standard Laboratory Article to satisfy this requirement.

ARTICLE IV: GENERAL DISCLAIMER

THE U.S. GOVERNMENT AND CONTRACTOR MAKE NO EXPRESS OR IMPLIED WARRANTY AS TO THE CONDITIONS OF THE USER FACILITY FURNISHED HEREUNDER. IN ADDITION, THE U.S. GOVERNMENT, CONTRACTOR AND USER MAKE NO EXPRESS OR IMPLIED WARRANTY AS TO THE RESEARCH OR ANY INTELLECTUAL PROPERTY, GENERATED INFORMATION, OR PRODUCT MADE OR DEVELOPED UNDER THIS AGREEMENT, OR THE OWNERSHIP, MERCHANTABILITY, OR FITNESS FOR A PARTICULAR PURPOSE OF THE RESEARCH OR RESULTING PRODUCT; THAT THE GOODS, SERVICES, MATERIALS, PRODUCTS, PROCESSES, INFORMATION, OR DATA TO BE FURNISHED HEREUNDER WILL ACCOMPLISH INTENDED RESULTS OR ARE SAFE FOR ANY PURPOSE INCLUDING THE INTENDED PURPOSE; OR THAT ANY OF THE ABOVE WILL NOT INTERFERE WITH PRIVATELY OWNED RIGHTS OF OTHERS. THE U.S. GOVERNMENT, CONTRACTOR AND/OR USER SHALL NOT BE LIABLE FOR SPECIAL, CONSEQUENTIAL, OR INCIDENTAL DAMAGES ATTRIBUTED TO USE OF SUCH FACILITIES, RESEARCH OR RESULTING PRODUCT, INTELLECTUAL PROPERTY, GENERATED INFORMATION, OR PRODUCT MADE OR DELIVERED UNDER THIS AGREEMENT.

ARTICLE V. PROPERTY AND MATERIALS

USER may be permitted by the Contractor to furnish equipment, tooling, test apparatus, or materials necessary to assist in the performance of its experiment(s) at the User Facility. Such items shall remain the property of USER. Unless the Parties otherwise agree, all such property furnished by USER or equipment and test apparatus provided by USER will be removed by USER within sixty (60) days of termination or expiration of this Agreement or will be disposed of as directed by USER at USER's expense. Any equipment that becomes integrated into the User Facility shall be the property of the U.S. Government. USER acknowledges that any material supplied by USER may be damaged, consumed or lost. Materials (including residues and/or other contaminated material) remaining after performance of the work or analysis will be removed in their then condition by USER at USER's expense.

USER will return User Facilities and equipment utilized in their original condition except for normal wear and tear.

CONTRACTOR shall have no responsibility for USER's property at the User Facility other than loss or damage caused by willful misconduct or gross negligence of CONTRACTOR or its employees.

Personal property produced or acquired during the course of this Agreement shall be disposed of as directed by the owner at the owner's expense.

ARTICLE VI: SCHEDULING

USER understands that CONTRACTOR will have sole responsibility and discretion for allocating and scheduling usage of the User Facilities and equipment needed for or involved under this Agreement.

ARTICLE VII: INDEMNITY AND LIABILITY

- A. Personnel Relationships** - USER shall be responsible for the acts or omissions of Participants.
- B. General Indemnity** - To the extent permitted by U.S. and U.S. State law, USER hereby agrees to indemnify and hold harmless CONTRACTOR and the U.S. Government, their officers, agents and employees from any and all liability, claims, damages, costs and expenses, including attorney fees, for injury to or death of persons, or damage to or destruction of property, arising out of the performance of

this Agreement or arising out of the use of the services performed, materials supplied or information given hereunder by any persons including the USER, and not directly resulting from the fault or negligence of the Contractor or the United States Government, or persons acting on their behalf.

- C. Patent and Copyright Indemnity-Limited** - To the extent permitted by U.S. and U.S. State law, USER shall fully indemnify the U.S. Government and CONTRACTOR and their officers, agents, and employees for infringement of any United States patent or copyright arising out of any acts required or directed or performed by USER under the Agreement to the extent such acts are not normally performed at the facility.
- D. Product Liability** - To the extent permitted by U.S. and U.S. State law, if USER utilizes the work derived from this Agreement in the making, using, or selling of a product, process or service, then USER hereby agrees to hold harmless and indemnify CONTRACTOR and the U.S. Government, their officers, agents and employees from any and all liability, claims, damages, costs and expenses, including attorney fees, for injury to or death of persons, or damage to or destruction of property, as a result of or arising out of such utilization of the work by or on behalf of USER, its assignees or licensees.
- E.** The liability and indemnity provisions in paragraphs B, C and D above shall not apply unless USER shall have been informed as soon as practicable by CONTRACTOR or the U.S. Government of the suit or action alleging such liability or infringement, and such indemnity shall not apply to a claimed liability or infringement that is settled without the consent of USER unless required by a court of competent jurisdiction.
- F. Notice and Assistance Regarding Patent and Copyright Infringement**
- a. USER shall report to the U.S. Government, promptly and in reasonable written detail, each notice or claim of patent or copyright infringement based on the performance of this Agreement of which USER has knowledge.
 - b. In the event of any claim or suit against the U.S. Government on account of any alleged patent or copyright infringement arising out of the performance of this Agreement or out of the use of any supplies furnished or work or services performed hereunder, USER shall furnish to the U.S. Government when requested by the U.S. Government, all evidence and information in possession of USER pertaining to such suit or claim. Such evidence and information shall be furnished at the expense of the U.S. Government except where USER has agreed to indemnify the U.S. Government.

NOTE: For U.S. State and Local Governments and public Universities, the following provision may be used to replace the above indemnity and liability clauses of paragraphs B-D:

- B. General Indemnity—Reserved**
- C. Patent and Copyright Indemnity—Limited - Reserved**
- D. Product Liability--** Any licenses granted or assignments made by USER to any third party in technology derived from the work performed under this Agreement, such license or assignment shall include the requirement that the licensee/assignee shall agree to hold harmless and indemnify CONTRACTOR and the U.S. Government, their officers, agents and employees from any and all liability, claims, damages, costs and expenses, including attorney fees, for injury to or death of persons, or damage to or destruction of property, as a result of or arising out of such utilization of the work by or on behalf of USER's assignees or licensees.

NOTE: The Product Liability clause above for licensing to third parties by the USER may be used with Private Universities, but those agreements would still require General and Intellectual Property Indemnity clauses.

ARTICLE VIII. PATENT RIGHTS

A. Definitions

1. "Subject Invention" means any invention or discovery of USER conceived or first actually reduced to practice in the course of or under this Agreement.
2. "Patent Counsel" means the DOE Patent Counsel assisting the Facility Operator.

B. Rights of USER - Election to Retain Rights

With respect to any USER Subject Invention, which includes inventions of any Participants, reported and elected in accordance with paragraph (C) of this clause, USER may elect to obtain the entire right, title and interest in any patent application filed in any country on a Subject Invention and in any resulting patent secured by USER. Where appropriate, the filing of patent application by USER is subject to DOE security regulations and requirements.

C. Invention Identification, Disclosures, and Reports

USER shall provide through the iEdison reporting system, unless otherwise directed by Patent Counsel, a written report concerning each USER Subject Invention, which includes inventions of any Participants, within six months after conception or first actual reduction to practice, whichever occurs first. If USER wishes to elect title to the

Subject Invention, a notice of election to the Subject Invention should be submitted with the report or within one year of such date of reporting of the Subject Invention.

D. Facilities License

USER agrees to and does hereby grant to the U.S. Government an irrevocable, nonexclusive paid-up license in and to any inventions or discoveries, regardless of when conceived or actually reduced to practice or acquired by USER, which at any time through completion of this Agreement are owned or controlled by USER and are incorporated in the User Facility as a result of this Agreement to such an extent that the User Facility is not restored to the condition existing prior to the Agreement (1) to practice or to have practiced by or for the U.S. Government at the user Facility, and (2) to transfer such licenses with the transfer of that User Facility. The acceptance or exercise by the U.S. Government of the aforesaid rights and license shall not prevent the U.S. Government at any time from contesting the enforceability, validity or scope of, or title to, any rights or patents herein licensed

ARTICLE IX. RIGHTS IN TECHNICAL DATA

A. Definitions

1. "Technical Data" means recorded information, regardless of form or characteristic, of a scientific or technical nature. Technical data as used herein does not include financial reports, cost analyses, and other information incidental to Agreement administration.
2. "Proprietary Data" means technical data which embody trade secrets, developed at private expense, such as design procedures or techniques, chemical composition of materials, or manufacturing methods, processes or treatments, including minor modifications thereof, provided that such data:
 - a. are not generally known or available from other sources without obligation concerning their confidentiality,
 - b. have not been made available by the owner to others without obligation concerning their confidentiality;
 - c. are not already available to the U.S. Government without obligation concerning their confidentiality, and
 - d. are marked as "Proprietary Data."
3. "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.

- B.** USER agrees to furnish to DOE or CONTRACTOR those data, if any, which are (1) essential to the performance of work by DOE or CONTRACTOR personnel or (2) necessary for the health and safety of such personnel in the performance of the work. Any data furnished to DOE or CONTRACTOR shall be deemed to have been delivered with unlimited rights unless marked as "Proprietary Data" of USER.

- C. USER agrees that it shall have the sole responsibility for identifying and marking all documents containing Proprietary Data which are furnished by USER or produced under this Agreement. USER further agrees to mark each such document by or before termination of the Agreement by placing on the cover page thereof a legend identifying the document as Proprietary Data of USER and identifying each page and portion thereof to which the marking applies. The U.S. Government and CONTRACTOR shall not disclose properly marked Proprietary Data of USER outside the U.S. Government and CONTRACTOR. The U.S. Government and CONTRACTOR reserve the right to challenge the proprietary nature of any markings on data.

NOTE: Per the Class Waiver, the Laboratory or DOE may choose to have an agreement that doesn't allow data first produced at the User Facility which does not embody the User's pre-existing proprietary data to be treated as Proprietary.

- D. USER is solely responsible for the removal of all of its Proprietary Data from the facility by or before termination of this Agreement. The U.S. Government shall have unlimited rights in any Technical Data (including Proprietary Data) which are not removed from the facility by or before termination of the Agreement. The U.S. Government shall have unlimited rights in any Technical Data (including Proprietary Data) which are incorporated into the User Facility under the Agreement to such extent that the User Facility or equipment is not restored to the condition existing prior to such incorporation.

- E. Upon completion or termination of the project, USER agrees to deliver to DOE and CONTRACTOR a non-proprietary report describing the work performed under the Agreement.

NOTE: A Laboratory may delete the provisions pertaining to the User furnishing Proprietary Data to the Laboratory if the Laboratory prohibits the User from bringing Proprietary data into the facility.

ARTICLE X. LABORATORY SITE ACCESS, SAFETY AND HEALTH

As a precondition to using CONTRACTOR User Facilities, Participants must complete all CONTRACTOR Site Access documents and requirements. USER and Participants shall take all reasonable precautions in activities carried out under this Agreement to protect the safety and health of others and to protect the environment. Participants must comply with all applicable safety, operating and health procedures, access to information, security, cyber-security, hours of work, conduct and environmental regulations and the requirements of the DOE and CONTRACTOR, including the specific requirements of the Proprietary User

Facility covered by this Agreement. In the event that USER or Participant fails to comply with said regulations and requirements, CONTRACTOR may, without prejudice to any other legal or contractual rights, issue and order stopping all or any part of USER's or Participant's activities at the Designated Proprietary User Facility.

ARTICLE XI. PERSONNEL RELATIONSHIPS

Participants will remain employees or representatives of USER at all times during their participation in the work under this Agreement, and shall not be considered employees of CONTRACTOR or DOE for any purpose. Participants shall be subject to the administrative and technical supervision and control of CONTRACTOR during and in connection with the Participants' activities under this Agreement.

ARTICLE XII: EXPORT CONTROLS

USER acknowledges that the export of goods or Technical Data may require some form of export control license from the U.S. Government and that failure to obtain such export control license may result in criminal liability under the laws of the United States.

NOTE: The DOE Site Office may approve a Laboratory version or use the more robust Export Control language similar to the CRADA Order as follows:

THE PARTIES UNDERSTAND THAT MATERIALS AND INFORMATION RESULTING FROM THE PERFORMANCE OF THIS AGREEMENT MAY BE SUBJECT TO U.S. GOVERNMENT EXPORT CONTROL LAWS AND REGULATIONS AND THAT EACH PARTY IS RESPONSIBLE FOR ITS OWN COMPLIANCE WITH SUCH LAWS AND REGULATIONS. EXPORT LICENSES OR OTHER AUTHORIZATIONS FROM THE U.S. GOVERNMENT MAY BE REQUIRED FOR THE EXPORT OF GOODS, TECHNICAL DATA OR SERVICES UNDER THIS AGREEMENT. THE PARTIES ACKNOWLEDGE THAT EXPORT CONTROL REQUIREMENTS MAY CHANGE AND THAT THE EXPORT OF GOODS, TECHNICAL DATA OR SERVICES FROM THE U.S. WITHOUT AN EXPORT LICENSE OR OTHER APPROPRIATE GOVERNMENTAL AUTHORIZATION MAY RESULT IN CIVIL AND CRIMINAL LIABILITY.

ARTICLE XIII. THIRD-PARTY CONTRACTS

Contracts between USER and third parties for work on CONTRACTOR premises including, but not limited to, construction, installation, maintenance, and repair, will be subject to prior approval by the Department and CONTRACTOR. The Department and CONTRACTOR may require the insertion of specific terms and conditions into such contracts.

ARTICLE XIV: DISPUTES

The parties will attempt to jointly resolve all disputes arising under this agreement. If the parties are unable to jointly resolve a dispute within a reasonable period of time, either party may contact the laboratory's Technology Transfer Ombudsman (TTO) to provide assistance. The TTO may work directly to resolve the dispute or, upon mutual agreement of the parties, contact a third party neutral mediator to assist the parties in coming to a resolution. The costs of the mediator's services will be shared equally by the parties. In the event that an agreement is not reached with the aid of the ombudsman or mediator, the parties may agree to have the dispute addressed by neutral evaluation. The decision rendered by the neutral evaluator shall be nonbinding on the parties, and any costs incurred there from shall be divided equally between the parties. Upon mutual agreement, the parties may request a decision by the DOE Contracting Officer. Absent resolution, either party may seek relief in a court of competent jurisdiction.

ARTICLE XV. CONFLICT OF TERMS

In the event of any conflict between the terms of this document and any other document issued by either Party, the terms of this document shall prevail.

ARTICLE XVI. TERMINATION

Either Party may terminate this Agreement for any reason at any time by giving not less than thirty (30) days prior written notice to the other Party, provided that CONTRACTOR shall recover payment for the costs incurred by CONTRACTOR on behalf of USER prior to termination and for termination costs.

In witness whereof, the Parties hereto have executed this Agreement.

FOR THE CONTRACTOR:

BY:
TITLE:
DATE:

FOR THE USER:

BY:
TITLE:
ADDRESS: