**ATTACHMENT 2:**

**ARPA-E INTELLECTUAL PROPERTY PROVISIONS**

**FOR COOPERATIVE AGREEMENT WITH**

**DOMESTIC SMALL BUSINESSES**

**INCLUDING ENHANCED U.S. COMPETITIVENESS**

**AND A COMMERCIALIZATION PLAN**

1. 2 CFR Part 910, Subpart D, Appendix A, Patent Rights (Small Business Firms and Nonprofit Organizations) (OCT 2003)
2. 2 CFR Part 910, Subpart D, Appendix A, Rights in Data - Programs Covered Under Special Data Statutes (OCT 2003)
3. FAR 52.227-1 Authorization and Consent (DEC 2007) Alternate I (APR 1984)
4. FAR 52.227-2 Notice and Assistance Regarding Patent and Copyright   
   Infringement (DEC 2007)

*The above clause is not applicable if the award is for less than $100,000, in aggregate.*

1. Enhanced U.S. Competitiveness Clause
2. Subawards
3. Commercialization Plan

NOTE: In reading these provisions, any reference to “*Contractor*” shall mean “*Recipient*,” and any reference to “*contract*” or “*subcontract*” shall mean “*award*” or “*subaward*.”

NOTE: Please refer to Attachment 4 (ARPA-E Reporting Checklist and Instructions) for guidance on complying with the intellectual property reporting obligations referenced herein.

**1. 2 CFR Part 910, Subpart D, Appendix A, Patent Rights (Small Business Firms and Nonprofit Organizations) (April 2018)**

1. Definitions

*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. 2321et seq.).

*Subject invention* means any invention of the contractor 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.

*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.

*Made* when used in relation to any invention means the conception or first actual reduction to practice of such invention.

*Small Business Firm* means a small business concern as defined at section 2 of Pub. L. 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 standards 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.

*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 (25 U.S.C. 501(a)) or any nonprofit scientific or educational organization qualified under a state nonprofit organization statute.

*The term statutory period* means the one-year period before the effective filing date of a claimed invention during which exceptions to prior art exist per 35 U.S.C. 102(b) as amended by the Leahy-Smith America Invents Act, Public Law 112-29.

*The term contractor* means any person, small business firm or nonprofit organization, or, as set forth in section 1, paragraph (b)(4) of Executive Order 12591, as amended, any business firm regardless of size, which is a party to a funding agreement.

1. Allocation of Principal Rights

The Contractor may retain the entire right, title, and interest throughout the world to each subject invention subject to the provisions of this clause and 35 U.S.C. 203. With respect to any subject invention in which the Contractor retains title, the Federal government shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the subject invention throughout the world.

1. Invention Disclosure, Election of Title and Filing of Patent Application by Contractor
2. The contractor will disclose each subject invention to the Federal Agency within two months after the inventor discloses it in writing to contractor personnel responsible for patent matters. The disclosure to the agency shall be in the form of a written report and shall identify the contract under which the invention was made and the inventor(s). It shall be sufficiently complete in technical detail to convey a clear understanding to the extent known at the time of the disclosure, of the nature, purpose, operation, and the physical, chemical, biological or electrical characteristics of the invention. The disclosure shall also identify any publication, on sale or public use of the invention and whether a manuscript describing the invention has been submitted for publication and, if so, whether it has been accepted for publication at the time of disclosure. In addition, after disclosure to the agency, the Contractor will promptly notify the agency of the acceptance of any manuscript describing the invention for publication or of any on sale or public use planned by the contractor.
3. The contractor will elect in writing whether or not to retain title to any such invention by notifying the Federal agency within two years of disclosure to the Federal agency. However, in any case where a patent, a printed publication, public use, sale, or other availability to the public 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 agency to a date that is no more than 60 days prior to the end of the statutory period.
4. The contractor will file its initial patent application on a subject invention to which it elects to retain title within one year after election of title or, if earlier, prior to the end of any statutory period wherein valid patent protection can be obtained in the United States after a publication, on sale, or public use. If the contractor files a provisional application as its initial patent application, it shall file a non-provisional application within 10 months of the filing of the provisional application. The contractor will file patent applications in additional countries or international patent offices within either ten months of the first filed patent application or six months from the date permission is granted by the Commissioner of Patents to file foreign patent applications where such filing has been prohibited by a Secrecy Order.

(4) For any subject invention with Federal agency and contractor co-inventors, where the Federal agency employing such co-inventor determines that it would be in the interest of the government, pursuant to 35 U.S.C. 207(a)(3), to file an initial patent application on the subject invention, the Federal agency employing such co-inventor, at its discretion and in consultation with the contractor, may file such application at its own expense, provided that the contractor retains the ability to elect title pursuant to 35 U.S.C. 202(a).

1. Requests for extension of the time for disclosure, election, and filing under paragraphs (1), (2), and (3) of this clause may, at the discretion of the Federal agency, be granted. When a contractor has requested an extension for filing a non-provisional application after filing a provisional application, a one- year extension will be granted unless the Federal agency notifies the contractor within 60 days of receiving the request.
2. Conditions When the Government May Obtain Title

The contractor will convey to the Federal agency, upon written request, title to any subject invention:

1. If the contractor fails to disclose or elect title to the subject invention within the times specified in paragraph (c) of this clause, or elects not to retain title.
2. In those countries in which the contractor fails to file patent applications within the times specified in paragraph (c) of this clause; provided, however, that if the contractor has filed a patent application in a country after the times specified in paragraph (c) of this clause, but prior to its receipt of the written request of the Federal agency, the contractor shall continue to retain title in that country.
3. In any country in which the contractor decides not to continue the prosecution of any non- provisional patent application for, to pay a maintenance, annuity or renewal fee on, or to defend in a reexamination or opposition proceeding on, a patent on a subject invention.
4. Minimum Rights to Contractor and Protection of the Contractor Right to File
5. The contractor will retain a nonexclusive royalty-free license throughout the world in each subject invention to which the Government obtains title, except if the contractor fails to disclose the invention within the times specified in (c), above. The contractor's license extends to its domestic subsidiary and affiliates, if any, within the corporate structure of which the contractor is a party and includes the right to grant sublicenses of the same scope to the extent the contractor was legally obligated to do so at the time the contract was awarded. The license is transferable only with the approval of the Federal agency except when transferred to the successor of that party of the contractor's business to which the invention pertains.
6. The contractor's domestic license may be revoked or modified by the funding Federal agency 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 part 404 and agency licensing regulations (if any). This license will not be revoked in that field of use or the geographical areas in which the contractor 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 funding Federal agency to the extent the contractor, its licensees, or the domestic subsidiaries or affiliates have failed to achieve practical application in that foreign country.
7. Before revocation or modification of the license, the funding Federal agency will furnish the contractor a written notice of its intention to revoke or modify the license, and the contractor will be allowed thirty days (or such other time as may be authorized by the funding Federal agency for good cause shown by the contractor) after the notice to show cause why the license should not be revoked or modified. The contractor has the right to appeal, in accordance with applicable regulations in 37 CFR part 404 and agency regulations (if any) concerning the licensing of Government-owned inventions, any decision concerning the revocation or modification of the license.
8. Contractor Action to Protect the Government's Interest
9. The contractor agrees to execute or to have executed and promptly deliver to the Federal agency all instruments necessary to (i) establish or confirm the rights the Government has throughout the world in those subject inventions to which the contractor elects to retain title, and (ii) convey title to the Federal agency when requested under paragraph (d) above and to enable the government to obtain patent protection throughout the world in that subject invention.
10. The contractor agrees to require, by written agreement, its employees, other than clerical and nontechnical employees, to disclose promptly in writing to personnel identified as responsible for the administration of patent matters and in a format suggested by the contractor each subject invention made under contract in order that the contractor can comply with the disclosure provisions of paragraph (c) of this clause, to assign to the contractor the entire right, title and interest in and to each subject invention made under contract, and to execute all papers necessary to file patent applications on subject inventions and to establish the government's rights in the subject inventions. This disclosure format should require, as a minimum, the information required by paragraph (c)(1) of this clause. The contractor 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.
11. For each subject invention, the contractor will, no less than 60 days prior to the expiration of the statutory deadline, notify the Federal agency of any decision: Not to continue the prosecution of a non- provisional patent application; not to pay a maintenance, annuity or renewal fee; not to defend in a reexamination or opposition proceeding on a patent, in any country; to request, be a party to, or take action in a trial proceeding before the Patent Trial and Appeals Board of the U.S. Patent and Trademark Office, including but not limited to post-grant review, review of a business method patent, inter partes review, and derivation proceeding; or to request, be a party to, or take action in a non-trial submission of art or information at the U.S. Patent and Trademark Office, including but not limited to a pre-issuance submission, a post-issuance submission, and supplemental examination.
12. The contractor agrees to include, within the specification of any United States patent applications and any patent issuing thereon covering a subject invention, the following statement, “This invention was made with government support under (identify the contract) awarded by (identify the Federal agency). The government has certain rights in the invention.”
13. Subcontracts
14. The contractor will include this clause, suitably modified to identify the parties, in all subcontracts, regardless of tier, for experimental, developmental or research work to be performed by a small business firm or nonprofit organization. The subcontractor will retain all rights provided for the contractor in this clause, and the contractor will not, as part of the consideration for awarding the subcontract, obtain rights in the subcontractor's subject inventions.
15. The contractor will include in all other subcontracts, regardless of tier, for experimental developmental or research work the patent rights clause required by 2 CFR 910.362(c).
16. In the case of subcontracts, at any tier, when the prime award with the Federal agency was a contract (but not a grant or cooperative agreement), the agency, subcontractor, and the contractor agree that the mutual obligations of the parties created by this clause constitute a contract between the subcontractor and the Federal agency with respect to the matters covered by the clause; provided, however, that nothing in this paragraph is intended to confer any jurisdiction under the Contract Disputes Act in connection with proceedings under paragraph (j) of this clause.
17. Reporting on Utilization of Subject Inventions

The Contractor 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 contractor 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 contractor, and such other data and information as the agency may reasonably specify. The contractor also agrees to provide additional reports as may be requested by the agency in connection with any march-in proceeding undertaken by the agency in accordance with paragraph (j) of this clause. As required by 35 U.S.C. 202(c)(5), the agency agrees it will not disclose such information to persons outside the government without permission of the contractor.

1. Preference for United States Industry

Notwithstanding any other provision of this clause, the contractor 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 the Federal agency upon a showing by the contractor 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.

1. March-in Rights

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

1. Such action is necessary because the contractor or assignee has not taken, or is not expected to take within a reasonable time, effective steps to achieve practical application of the subject invention in such field of use.
2. Such action is necessary to alleviate health or safety needs which are not reasonably satisfied by the contractor, assignee or their licensees;
3. Such action is necessary to meet requirements for public use specified by Federal regulations and such requirements are not reasonably satisfied by the contractor, assignee or licensees; or
4. Such action is necessary because the agreement required by paragraph (i) of this clause has not been obtained or waived or because a licensee of the exclusive right to use or sell any subject invention in the United States is in breach of such agreement.
5. Special Provisions for Contracts with Nonprofit Organizations

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

1. Rights to a subject invention in the United States may not be assigned without the approval of the Federal agency, except where such assignment is made to an organization which has as one of its primary functions the management of inventions, provided that such assignee will be subject to the same provisions as the contractor;
2. The contractor will share royalties collected on a subject invention with the inventor, including Federal employee co-inventors (when the agency deems it appropriate) when the subject invention is assigned in accordance with 35 U.S.C. 202(e) and 37 CFR 401.10;
3. The balance of any royalties or income earned by the contractor with respect to subject inventions, after payment of expenses (including payments to inventors) incidental to the administration of subject inventions, will be utilized for the support of scientific research or education; and

1. 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 contractor 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 contractor 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 contractor. However, the contractor agrees that the Federal agency may review the contractor's licensing program and decisions regarding small business applicants, and the contractor will negotiate changes to its licensing policies, procedures, or practices with the Federal agency when the Federal agency's review discloses that the contractor could take reasonable steps to implement more effectively the requirements of this paragraph (k)(4). In accordance with 37 CFR 401.7, the Federal agency or the contractor may request that the Secretary review the contractor's licensing program and decisions regarding small business applicants.
2. Communication

All communications required by this Patent Rights Clause should be sent to iEdison at <https://s-edison.info.nih.gov/iEdison/>.

1. Electronic Filing

Unless otherwise specified in the award, the information identified in paragraphs (f)(2), (f)(3), (f)(5), (f)(6), and (f)(7) may be electronically filed.

(End of Clause)

**2. 2 CFR Part 910, Subpart D, Appendix A, Rights in Data - Programs Covered Under Special Data Statutes (OCT 2003)**

(a) Definitions

*Computer databases*, as used in this clause, means a collection of data in a form capable of, and for the purpose of, being stored in, processed, and operated on by a computer. The term does not include computer software.

*Computer software*, as used in this clause, means (i) computer programs which are data comprising a series of instructions, rules, routines, or statements, regardless of the media in which recorded, that allow or cause a computer to perform a specific operation or series of operations and (ii) data comprising source code listings, design details, algorithms, processes, flow charts, formulae and related material that would enable the computer program to be produced, created or compiled. The term does not include computer data bases.

*Data*, as used in this clause, means recorded information, regardless of form or the media on which it may be recorded. The term includes technical data and computer software. The term does not include information incidental to administration, such as financial, administrative, cost or pricing or management information.

*Form, fit, and function data*, as used in this clause, means data relating to items, components, or processes that are sufficient to enable physical and functional interchangeability as well as data identifying source, size, configuration, mating and attachment characteristics, functional characteristics, and performance requirements except that for computer software it means data identifying source, functional characteristics, and performance requirements but specifically excludes the source code, algorithm, process, formulae, and flow charts of the software.

*Limited rights data*, as used in this clause, means data (other than computer software) developed at private expense that embody trade secrets or are commercial or financial and confidential or privileged.

*Restricted computer software*, as used in this clause, means computer software developed at private expense and that is a trade secret; is commercial or financial and confidential or privileged; or is published copyrighted computer software; including modifications of such computer software.

*Protected data*, as used in this clause, means technical data or commercial or financial data first produced in the performance of the award which, if it had been obtained from and first produced by a non-federal party, would be a trade secret or commercial or financial information that is privileged or confidential under the meaning of 5 U.S.C. 552(b)(4) and which data is marked as being protected data by a party to the award.

*Protected rights*, as used in this clause, mean the rights in protected data set forth in the Protected Rights Notice of paragraph (g) of this clause.

*Technical data*, as used in this clause, means that data which are of a scientific or technical nature. Technical data does not include computer software, but does include manuals and instructional materials and technical data formatted as a computer data base.

*Unlimited rights*, as used in this clause, means the right of the Government to use, disclose, reproduce, prepare derivative works, distribute copies to the public, and perform publicly and display publicly, in any manner and for any purpose whatsoever, and to have or permit others to do so.

(b) Allocation of Rights

1. Except as provided in paragraph (c) of this clause regarding copyright, the Government shall have unlimited rights in:

(i) Data specifically identified in this agreement as data to be delivered without restriction;

* + - * 1. (ii) Form, fit, and function data delivered under this agreement;
  1. Data delivered under this agreement (except for restricted computer software) that constitute manuals or instructional and training material for installation, operation, or routine maintenance and repair of items, components, or processes delivered or furnished for use under this agreement; and
  2. All other data delivered under this agreement unless provided otherwise for protected data in accordance with paragraph (g) of this clause or for limited rights data or restricted computer software in accordance with paragraph (h) of this clause.
  3. (2) The Recipient shall have the right to:­

1. Protect rights in protected data delivered under this agreement in the manner and to the extent provided in paragraph (g) of this clause;

(ii) Withhold from delivery those data which are limited rights data or restricted computer software to the extent provided in paragraph (h) of this clause;

(iii) Substantiate use of, add, or correct protected rights or copyrights notices and to take other appropriate action, in accordance with paragraph (e) of this clause; and

(iv) Establish claim to copyright subsisting in data first produced in the performance of this agreement to the extent provided in subparagraph (c)(1) of this clause.

(c) Copyright

(1) Data first produced in the performance of this agreement. Except as otherwise specifically provided in this agreement, the Recipient may establish, without the prior approval of the Contracting Officer, claim to copyright subsisting in any data first produced in the performance of this agreement. If claim to copyright is made, the Recipient shall affix the applicable copyright notice of 17 U.S.C. 401 or 402 and acknowledgment of Government sponsorship (including agreement number) to the data when such data are delivered to the Government, as well as when the data are published or deposited for registration as a published work in the U.S. Copyright Office. For such copyrighted data, including computer software, the Recipient grants to the Government, and others acting on its behalf, a paid-up nonexclusive, irrevocable, worldwide license to reproduce, prepare derivative works, distribute copies to the public, and perform publicly and display publicly, by or on behalf of the Government, for all such data.

(2) Data not first produced in the performance of this agreement. The Recipient shall not, without prior written permission of the Contracting Officer, incorporate in data delivered under this agreement any data that are not first produced in the performance of this agreement and that contain the copyright notice of 17 U.S.C. 401 or 402, unless the Recipient identifies such data and grants to the Government, or acquires on its behalf, a license of the same scope as set forth in subparagraph (c)(1) of this clause; provided, however, that if such data are computer software, the Government shall acquire a copyright license as set forth in subparagraph (h)(3) of this clause if included in this agreement or as otherwise may be provided in a collateral agreement incorporated or made a part of this agreement.

1. Removal of copyright notices. The Government agrees not to remove any copyright notices placed on data pursuant to this paragraph (c), and to include such notices on all reproductions of the data.

(d) Release, Publication and Use of Data

1. The Recipient shall have the right to use, release to others, reproduce, distribute, or publish any data first produced or specifically used by the Recipient in the performance of this contract, except to the extent such data may be subject to the Federal export control or national security laws or regulations, or unless otherwise provided in this paragraph of this clause or expressly set forth in this contract.

(2) The Recipient agrees that to the extent it receives or is given access to data necessary for the performance of this agreement which contain restrictive markings, the Recipient shall treat the data in accordance with such markings unless otherwise specifically authorized in writing by the Contracting Officer.

1. Commercialization Plan

Notwithstanding paragraph (c)(1) of this clause, the Recipient agrees not to assert, establish, or authorize others to assert or establish, any claim to copyright subsisting in specified computer software and data sets, without prior written permission of the Contracting Officer. The specified computer software products and specified data sets shall be identified and negotiated in the Commercialization Plan described below. Permission of the Contracting Officer shall be granted as long as the Recipient provides and ARPA-E, at its sole discretion, accepts a Commercialization Plan regarding the specified computer software and data sets. The Commercialization Plan is included in this Attachment 2 as an ADDENDUM and is an enforceable part of this Agreement.

The Commercialization Plan shall include:

1. a listing and brief description of the specified computer software and data sets that will be the subject of the commitments made by the Recipient under the Commercialization Plan;
2. measurable commitments by the Recipient to bring the listing of specified computer software and data sets to their relevant markets including describing any benefits to the U.S. economy;
3. Reporting During Performance or at Closeout: a commitment by the Recipient to report to ARPA-E / DOE (a) any of the specified computer software and data sets from the Commercialization Plan; and (b) any associated trademarks for commercializing the specified computer software and data sets, where the reporting occurs per the reporting requirements set forth in Attachment 4 of this agreement; and
4. Reporting Following Performance: a commitment by the Recipient to report on the utilization of the listed, specified computer software and data sets to ARPA-E for a period of ten (10) years following the award period of performance. Such a report is to include: (a) a description of any modifications made to the specified computer software or data sets; (b) any associated trademarks for commercializing the specified computer software or data sets; (c) the manner in which such computer software, data sets, and modifications are being commercialized; and (d) such other data and information as the agency may reasonably specify.

When claim to copyright is made, the notice and acknowledgement requirements and the government license set forth in paragraph (c)(1) applies. However, in exchange for the Commercialization Plan and the commitments made by the Recipient therein, the government license for the specified computer software and data shall not include the right by the Government to distribute copies to the public or to display publicly the specified computer software and data. If the Government desires to obtain copyright in data first produced in the performance of this agreement and permission has not been granted as set forth in subdivision (c)(1)(i) of this clause, the Contracting Officer may direct the Recipient to establish, or authorize the establishment of, claim to copyright in such data and to assign, or obtain the assignment of, such copyright to the Government or its designated assignee and provide a copy of source code and manuals necessary to enable use of the software.

A waiver of this section, including the Commercialization Plan and its commitments, is available upon sufficient written justification to ARPA-E and may be granted by ARPA-E in its sole discretion. However, if a waiver is granted, the Government license shall be as set forth in paragraph (c)(1). Additionally, a Recipient may petition ARPA-E to revise the Commercialization Plan at any time. Such a petition must include sufficient written justification to support the revision. The granting of such a petition is at ARPA-E’s sole discretion.

Noncompliance with the Commercialization Plan may be considered a material breach of this award. In case of such a material breach, the Contracting Officer may require, in addition to other possible remedies and after an opportunity to cure, revision of the Government license to restore the Government’s right to distribute copies to the public or to display publicly the specified computer software and data and to require delivery of the software or data sets to the Government.

1. Unauthorized Marking of Data
2. Notwithstanding any other provisions of this agreement concerning inspection or acceptance, if any data delivered under this agreement bears any restrictive or limiting markings not authorized by this agreement, the Contracting Officer may at any time either return the data to the Recipient or cancel or ignore the markings. However, the following procedures shall apply prior to canceling or ignoring the markings.
   1. The Contracting Officer shall make written inquiry to the Recipient affording the Recipient 30 days from receipt of the inquiry to provide written justification to substantiate the propriety of the markings;
   2. If the Recipient fails to respond or fails to provide written justification to substantiate the propriety of the markings within the 30-day period (or a longer time not exceeding 90 days approved in writing by the Contracting Officer for good cause shown), the Government shall have the right to cancel or ignore the markings at any time after said period and the data will no longer be made subject to any disclosure prohibitions.

(iii) If the Recipient provides written justification to substantiate the propriety of the markings within the period set in subdivision (f)(1)(i) of this clause, the Contracting Officer shall consider such written justification and determine whether or not the markings are to be cancelled or ignored. If the Contracting Officer determines that the markings are authorized, the Recipient shall be so notified in writing. If the Contracting Officer determines, with concurrence of the head of the contracting activity, that the markings are not authorized, the Contracting Officer shall furnish the Recipient a written determination, which determination shall become the final agency decision regarding the appropriateness of the markings unless the Recipient files suit in a court of competent jurisdiction within 90 days of receipt of the Contracting Officer's decision. The Government shall continue to abide by the markings under this subdivision (f)(1)(iii) until final resolution of the matter either by the Contracting Officer's determination become final (in which instance the Government shall thereafter have the right to cancel or ignore the markings at any time and the data will no longer be made subject to any disclosure prohibitions), or by final disposition of the matter by court decision if suit is filed.

1. The time limits in the procedures set forth in subparagraph (f)(1) of this clause may be modified in accordance with agency regulations implementing the Freedom of Information Act (5 U.S.C. 552) if necessary to respond to a request thereunder.
2. Omitted or Incorrect Markings
   1. Data delivered to the Government without either the limited rights or restricted rights notice as authorized by paragraph (i) of this clause, the protected data notice as authorized in paragraph (h), or the copyright notice required by paragraph (c) of this clause, shall be deemed to have been furnished with unlimited rights, and the Government assumes no liability for the disclosure, use, or reproduction of such data. However, to the extent the data has not been disclosed without restriction outside the Government, the Recipient may request, within 6 months (or a longer time approved by the Contracting Officer for good cause shown) after delivery of such data, permission to have notices placed on qualifying data at the Recipient's expense, and the Contracting Officer may agree to do so if the Recipient:­
3. Identifies the data to which the omitted notice is to be applied;

(ii) Demonstrates that the omission of the notice was inadvertent;

1. Establishes that the use of the proposed notice is authorized; and
2. Acknowledges that the Government has no liability with respect to the disclosure, use, or reproduction of any such data made prior to the addition of the notice or resulting from the omission of the notice.
   1. The Contracting Officer may also:
   2. Permit correction at the Recipient's expense of incorrect notices if the Recipient identifies the data on which correction of the notice is to be made, and demonstrates that the correct notice is authorized; or
   3. Correct any incorrect notices.
3. Rights to Protected Data

(1) The Recipient may, with the concurrence of DOE, claim and mark as protected data, any data first produced in the performance of this award that would have been treated as a trade secret if developed at private expense. Any such claimed ”protected data'' will be clearly marked with the following Protected Rights Notice, and will be treated in accordance with such Notice, subject to the provisions of paragraphs (f) and (g) of this clause.

PROTECTED RIGHTS NOTICE

These protected data were produced under agreement no.\_\_\_\_ with the U.S. Department of Energy and may not be published, disseminated, or disclosed to others outside the Government until 5 years after development of information under this agreement, unless express written authorization is obtained from the recipient. Upon expiration of the period of protection set forth in this Notice, the Government shall have unlimited rights in this data. This Notice shall be marked on any reproduction of this data, in whole or in part. (End of notice).

1. Any such marked Protected Data may be disclosed under obligations of confidentiality for the following purposes:

(a) For evaluation purposes under the restriction that the ``Protected Data'' be retained in confidence and not be further disclosed; or

(b) To subcontractors or other team members performing work under the Government's program of which this award is a part, for information or use in connection with the work performed under their activity, and under the restriction that the Protected Data be retained in confidence and not be further disclosed.

(3) The obligations of confidentiality and restrictions on publication and dissemination shall end for any Protected Data.

(a) At the end of the protected period;

(b) If the data becomes publicly known or available from other sources without a breach of the obligation of confidentiality with respect to the Protected Data;

(c) If the same data is independently developed by someone who did not have access to the Protected Data and such data is made available without obligations of confidentiality; or

* 1. If the Recipient disseminates or authorizes another to disseminate such data without obligations of confidentiality.

(4) However, the Recipient agrees that the following types of data are not considered to be protected and shall be provided to the Government when required by this award without any claim that the data are Protected Data. The parties agree that notwithstanding the following lists of types of data, nothing precludes the Government from seeking delivery of additional data in accordance with this award, or from making publicly available additional non-protected data, nor does the following list constitute any admission by the Government that technical data not on the list is Protected Data.

<INSERT>

(5) The Government's sole obligation with respect to any protected data shall be as set forth in this paragraph (h).

1. Protection of Limited Rights Data

When data other than that listed in subparagraphs (b)(1)(i), (ii), and (iii) of this clause are specified to be delivered under this agreement and such data qualify as either limited rights data or restricted computer software, the Recipient, if the Recipient desires to continue protection of such data, shall withhold such data and not furnish them to the Government under this agreement. As a condition to this withholding the Recipient shall identify the data being withheld and furnish form, fit, and function data in lieu thereof.

1. Subaward/Contract

The Recipient has the responsibility to obtain from its subrecipients/contractors all data and rights therein necessary to fulfill the Recipient's obligations to the Government under this agreement. If a subrecipient/contractor refuses to accept terms affording the Government such rights, the Recipient shall promptly bring such refusal to the attention of the Contracting Officer and not proceed with subaward/contract award without further authorization. See Section 6 of this Attachment 2 for instructions regarding intellectual property provisions for subawards under this agreement.

1. Additional Data Requirements

In addition to the data specified elsewhere in this agreement to be delivered, the Contracting Officer may, at any time during agreement performance or within a period of 3 years after acceptance of all items to be delivered under this agreement, order any data first produced or specifically used in the performance of this agreement. This clause is applicable to all data ordered under this subparagraph. Nothing contained in this subparagraph shall require the Recipient to deliver any data the withholding of which is authorized by this clause or data which are specifically identified in this agreement as not subject to this clause. When data are to be delivered under this subparagraph, the Recipient will be compensated for converting the data into the prescribed form, for reproduction, and for delivery.

1. The Recipient agrees, except as may be otherwise specified in this agreement for specific data items listed as not subject to this paragraph, that the Contracting Officer or an authorized representative may, up to three years after acceptance of all items to be delivered under this contract, inspect at the Recipient's facility any data withheld pursuant to paragraph (i) of this clause, for purposes of verifying the Recipient's assertion pertaining to the limited rights or restricted rights status of the data or for evaluating work performance. Where the Recipient whose data are to be inspected demonstrates to the Contracting Officer that there would be a possible conflict of interest if the inspection were made by a particular representative, the Contracting Officer shall designate an alternate inspector.

(End of Clause)

**4. FAR 52.227-2 Notice and Assistance Regarding Patent and Copyright Infringement (Dec 2007)**

(a) The Recipient shall report to the Contracting Officer, promptly and in reasonable written detail, each notice or claim of patent or copyright infringement based on the performance of this contract of which the Recipient has knowledge.

(b) In the event of any claim or suit against the Government on account of any alleged patent or copyright infringement arising out of the performance of this contract or out of the use of any supplies furnished or work or services performed under this contract, the Contractor shall furnish to the Government, when requested by the Contracting Officer, all evidence and information in the Recipient's possession pertaining to such claim or suit. Such evidence and information shall be furnished at the expense of the Government except where the Recipient has agreed to indemnify the Government.

(c) The Contractor shall include the substance of this clause, including this paragraph (c), in all subcontracts that are expected to exceed the simplified acquisition threshold.

(End of clause)

**5. Enhanced U.S. Competitiveness**

(a) The Recipient agrees that any products embodying any elected subject invention or produced through the use of any elected subject invention will be manufactured substantially in the United States for any use or sale in the United States or outside of the United States, unless the Recipient can show to the satisfaction of DOE that it is not commercially feasible to do so. (Baseline U.S. Manufacturing Commitment)

(b) The Commercialization Plan submitted as part of the Application process is incorporated in this agreement as an Addendum to this Attachment 2 and shall be binding on the Recipient. In the event DOE agrees to foreign manufacture or to a revision of the Commercialization Plan, there will be a requirement that the Government’s support of the technology be recognized in some appropriate manner, e.g., recoupment of the Government’s investment, etc. The Recipient further agrees to make the above condition binding on any assignee or licensee of, or any entity acquiring rights to, any elected subject invention, including subsequent owners of Recipient acquiring a controlling interest, and including subsequent assignees and licensees.

(c) If the Recipient or a licensee of the Recipient fails to comply with the foregoing U.S. manufacturing requirement then:

(1) the Recipient shall and hereby forfeits and assigns all rights to all Subject Inventions under the award to the United States, including all pending U.S. and foreign patent applications and all U.S. and foreign patents that cover any Subject Invention, without compensation;

(2) the Recipient shall and hereby assigns to DOE all licenses that grant any rights to any Subject Inventions to an unaffiliated third party[[1]](#footnote-1) that is in compliance with the domestic manufacturing requirement of this provision;

(3) all licenses, not subject to (2), that grant any rights to any Subject Inventions shall immediately be terminated without compensation from DOE; and

(4) the Recipient shall not be entitled to the license provided in the minimum rights provision of the standard Patent Rights clause or any other license to the Subject Inventions, unless the United States grants a license through a separately agreed upon licensing agreement.

(d) The Recipient may request a waiver or modification of this U.S. Competitveness Provision. Such waivers or modifications will be granted only when (1) the Recipient demonstrates, with quantifiable data, that manufacturing in the United States is not commercially feasible and (2) a waiver or modification would best serve the interests of the United States and the general public.

(c) The Recipient agrees that it will not license (on an exclusive or nonexclusive basis), assign, or otherwise transfer any Subject Invention to any entity unless that entity agrees to these same requirements. Subject to any other provision regarding Change in Ownership in this Agreement, in the event that the Recipient or other such entity receiving rights in the Subject Invention undergoes a change in ownership amounting to a controlling interest, the Recipient shall ensure continual compliance with these requirements and shall inform DOE, in writing, of the change in ownership within 6 months of the change.

(End of Clause)

**6. Subawards**.

(a) Small Business Subawardees: The Recipient shall incorporate all of the intellectual property provisions found in Attachment 2 ARPA-E INTELLECTUAL PROPERTY PROVISIONS FOR COOPERATIVE AGREEMENT WITH DOMESTIC SMALL BUSINESSES INCLUDING ENHANCED U.S. COMPETITIVENESS AND A COMMERCIALIZATION PLAN of the ARPA-E Model Cooperative Agreement (published at https://arpa-e.energy.gov/?q=site-page/funding-agreements) in all subawards with domestic small businesses. In incorporating the above-referenced intellectual property provisions, the Recipient shall expressly require compliance with their terms and conditions, expressly including the terms related to the Commercialization Plan.

(b) University and Nonprofit Organization Subawardees: The Recipient shall incorporate all of the intellectual property provisions found in Attachment 2 ARPA-E INTELLECTUAL PROPERTY PROVISIONS FOR COOPERATIVE AGREEMENT WITH DOMESTIC UNIVERSITIES AND NONPROFIT ORGANIZATIONS INCLUDING ENHANCED U.S. COMPETITIVENESS AND A COMMERCIALIZATION PLAN of the ARPA-E Model Cooperative Agreement (published at  [https://arpa-e.energy.gov/?q=site-page/funding-agreements](%20https://arpa-e.energy.gov/?q=site-page/funding-agreements)) into all subawards with domestic universities or domestic nonprofit organizations. In incorporating the above-referenced intellectual property provisions, the Recipient shall expressly require compliance with their terms and conditions, expressly including the terms related to the Commercialization Plan.

(c) Large Business and Foreign Entity Subawardees:

(1) If a large business receiving a subaward provides cost sharing of at least 20% under its subaward the Recipient shall incorporate all of the intellectual property provisions found in Attachment 2 ARPA-E INTELLECTUAL PROPERTY PROVISIONS FOR COOPERATIVE AGREEMENT WITH LARGE BUSINESSES—WAIVER (PATENT RIGHTS)INCLUDING ENHANCED U.S. COMPETITIVENESS IN SUBAWARDS AND A COMMERCIALIZATION PLAN of the ARPA-E Model Cooperative Agreement (published at https://arpa-e.energy.gov/?q=site-page/funding-agreements) into its subaward with the large business.

(2) If a large business receiving a subaward does not provide cost sharing of at least 20% under its subaward or a foreign entity receiving a subaward, the Recipient shall incorporate all of the intellectual property provisions found in Attachment 2 ARPA-E INTELLECTUAL PROPERTY PROVISIONS FOR COOPERATIVE AGREEMENT WITH LARGE BUSINESSES—NO WAIVER (PATENT RIGHTS) INCLUDING ENHANCED U.S. COMPETITIVENESS AND A COMMERCIALIZATION PLAN of the ARPA-E Model Cooperative Agreement (published at https://arpa-e.energy.gov/?q=site-page/funding-agreements) into its subaward with the large business or foreign entity. Upon request to Patent Counsel for good cause shown, the right to use the Attachment 2 ARPA-E INTELLECTUAL PROPERTY PROVISIONS FOR COOPERATIVE AGREEMENT WITH LARGE BUSINESSES—WAIVER (PATENT RIGHTS) INCLUDING ENHANCED U.S. COMPETITIVENESS IN SUBAWARDS AND A COMMERCIALIZATION PLAN in the award to the large business or foreign entity may be granted.

(3) In incorporating the above-referenced intellectual property provisions, the Recipient shall expressly require compliance with their terms and conditions, expressly including the terms related to the Commercialization Plan.

(d) Subaward Unlimited Rights Data List: For any subaward/subcontract with a for-profit entity (including subcontracts with for-profit vendors) for experimental, developmental or research work, the Recipient will insert the unlimited rights data list found in paragraph (g)(4) under the Rights in Data clause into the corresponding Rights in Data provision in the subaward/subcontract.

(End of Clause)

**7. Commercialization Plan**

The Recipient agrees that a purpose of this contract is to provide substantial benefit to the U.S. economy. In exchange for the benefits and rights received under this contract, the Recipient agrees, in addition to other commitments contained in this agreement, to comply with the Commercialization Plan described above in Section 2(e) and which is an addendum to this Attachment 2.

(End of clause)

ADDENDUM

(INSERT APPROVED COMMERCIALIZATION PLAN HERE)

1. An "affiliate" of, or a person "affiliated" with, a specified person, is a person that directly, or indirectly through one or more intermediaries, controls, or is controlled by, or is under common control with, the person specified. [↑](#footnote-ref-1)