VO-12 IP MANAGEMENT PLAN

U.S. Department of Energy (DOE) Office of Electricity (OE) Grid Innovations Facility and Testing (VO-12): ENERGYWERX PIA Voucher Opportunity (VO)

IP MANAGEMENT PLAN SUMMARY

The purpose of the Grid Innovations Facility and Testing Voucher Opportunity (VO-12) is to provide electric grid technology developers (referred to in this plan as Voucher Recipients or Recipients) with access to a United States-based electric grid testbed (referred to as the Voucher Providers). While the testing undertaken in VO-12 is unlikely to produce significant new intellectual property and know-how, it will result in raw data and results from the testing of these electric grid technology devices.

VO-12, administered by DOE-OE, is operated in part through a Partnership Intermediary Agreement (PIA) with ENERGYWERX who is responsible for contracting with Voucher Providers who are not a federally owned laboratory or part of the national laboratory (federally funded research and development centers – FFRDCs) system (collectively called Voucher Providers). VO-12 requirements and provisions regarding intellectual property (IP) are dictated and governed by the Research and Development Agreements established between ENERGYWERX and the Voucher Providers. VO-12 requirements and provisions regarding intellectual property for Voucher Providers that are members of the national laboratory system (National Labs) or are federally owned (Federal Labs) (collectively called Lab Members), will be contained in the provisions of VO-12 direct award contracts by DOE to these Lab Members and the Cooperative Research and Development Agreements (CRADAs) entered into between those Lab Members and the Voucher Recipients. Those requirements and provisions are generally set forth in this IP Management Plan, on the VO-12 Website (https://www.energywerx.org/opportunities/voucher-opportunity-12---grid-innovations-facility-and-testing-providers-vo-12), and more specifically set forth in the Project Documents, which consist of the following, all of which are incorporated herein by this reference (collectively the Project Documents):

(a) VO-12 Voucher Opportunity Rules Document;
(b) The Master Agreement, which pertains to the following documents based on the type of voucher provider.
  - For Voucher Providers, the Research and Development Agreement (RDA) between ENERGYWERX and the Voucher Providers;
  - For Federal Labs, the Interagency Agreement (IAA) between DOE and the Federal Lab.
  - For National Labs, the Annual Operating Plan (AOP) between DOE and the National Lab.

(c) All attachments, exhibits, schedules, and any other documents itemized on the List of Attachments, Exhibits, and Schedules to the Master Agreement;
(d) Any and all amendments to or modifications of the Master Agreement entered into by the parties after the Effective Date of the Master Agreement;

(e) Each agreement entered into (pursuant to the Master Agreement) by the Voucher Providers and a Recipient with respect to the implementation of a project applied for by the Recipient and approved by ENERGYWERX and the Voucher Providers; and

(f) All task orders as signed by ENERGYWERX from time to time pertaining to Recipient Projects implemented under the terms of the Master Agreement (collectively Task Orders):

As between a Voucher Providers and a Recipient, the rights and obligations regarding intellectual property and intellectual property issues will be set forth in each agreement that is entered into by the Voucher Providers and a Recipient with respect to the implementation of a project applied for by the Recipient and approved by ENERGYWERX. Such agreement will not be inconsistent with the intellectual property requirements and provisions of (a) VO-12 Voucher Opportunity Rules Document, and (b) any ENERGYWERX issued Task Orders (collectively the VO-12 IP Provisions). The Voucher Providers shall assure that the Project Documents are in a form reasonably satisfactory to ENERGYWERX evidencing the agreement of each of the Voucher Providers and the Recipient to comply with the VO-12 IP Management Plan. The Voucher Providers and the Recipient shall enter into a Joint Work Agreement describing the testing and research activities to be undertaken by Recipient at the Facility.

IP PLAN OUTLINE

1. Treatment of Confidential Information Shared Between Facilities and Recipients.

Where desirable, in the commercially reasonable judgment of the Voucher Providers and the Recipient, those parties may enter into non-disclosure agreements to protect confidential or business sensitive information (Confidential Information), provided that the provisions of any such agreements shall not be inconsistent with the terms of this Agreement and the VO-12 IP Provisions. The non-disclosure agreement to be used by Voucher Providers and a Recipient, if any, shall be included in the Project Documents.

2. Facility Background Intellectual Property.

The Voucher Providers may include any pre-existing Voucher Providers-specific intellectual property rights and obligations supplementing and not inconsistent with the VO-12 IP Provisions in each set of Project Documents (Facility Background Intellectual Property).

3. Recipient Background Intellectual Property.

Recipients may include any pre-existing Recipient-specific intellectual property rights and obligations supplementing and not inconsistent with the VO-12 IP Provisions in the Project Documents (Recipient Background Intellectual Property).

4. License Agreements.

To the extent any Background Intellectual Property of the Voucher Providers or a Recipient will be implicated in connection with the Project Documents, the Voucher Providers and the Recipient may enter into commercially reasonable licensing agreements detailing the arrangements between those parties relating to the shared use of that Background Intellectual Property so as to facilitate implementation of the Project Documents. A copy of the Background Intellectual Property license agreement to be used by a Voucher Providers and a Recipient, if any, shall be included in the Project Documents.

5. Treatment of Inventions Made Under the Award.

Invention disclosure obligations and disposition will be set forth in the Project Documents and will be consistent with the following:

(a) The Voucher Providers will disclose (and will cause Recipient to disclose) to ENERGYWERX any inventions which arise from the implementation of the Project Documents that may be patentable or otherwise protectable under the Patent Act.

(b) ENERGYWERX will disclose any and all such inventions to DOE within two (2) months after the inventor first discloses the invention to ENERGYWERX.

(c) Voucher Providers and Recipient will respectively own title to any invention made solely by its employees or agents. Title to jointly made inventions will be jointly owned. If either Voucher Providers or Recipient elects not to retain its interest in a jointly made invention, the other party shall have the first option to acquire by assignment of the exclusive title to such invention. DOE (or its designee) may obtain title to any invention that is not retained by Voucher Providers and Recipient.

(d) Voucher Providers (and as applicable the Recipient) will respectively be responsible for the payment of all costs relating to U.S. and foreign patent application filings and prosecutions and all costs relating to maintenance fees for U.S. and foreign patents, which are filed or registered solely by that party.

(e) Voucher Providers acknowledges (and will cause the Recipient to acknowledge) that DOE may obtain title to each invention reported (that arises from the implementation of the Project Documents) for which a patent application or applications are not filed or for which any such patent application(s) or any issued patents are not maintained by the Voucher Providers or the Recipient. The Voucher Providers or the Recipient must notify DOE at least two (2) months prior to any statutory deadlines related to such invention.

(f) Voucher Providers acknowledges (and will cause the Recipient to acknowledge) that with respect to any and all invention(s) (the title to which is held by Voucher Providers or by Recipient in connection with the implementation of the Project Documents) DOE (or its designee) retains a non-exclusive, non-transferable, irrevocable, paid-up license to practice (or to have practiced for or on behalf of the United States) each and every such invention.

6. Treatment of Data Produced Under the Award.

Voucher Providers will make available and submit (and will cause Recipient to make available and submit), to or at the direction of DOE, all relevant data (both meta and raw) to support charts and figures presented in Recipient's Project Summary Report in connection with the implementation of the Project Documents (collectively Project Data). All such Project Data will be made available and submitted jointly by the parties (or submitted by either of them in the case of an individual submission) in a form capable of being uploaded to a secure upload folder. Compliance by Voucher Providers and Recipient with the provisions of this section (the Public Disclosure Requirement) is a condition precedent to any payment or reimbursement by ENERGYWERX to Voucher Providers in connection with or relating to the Project Documents and this Agreement.

(a) At a minimum, Voucher Providers will cause the Recipient to upload to a secure upload folder, the quantitative data underlying "figures" (including, but not limited to, all charts, graphs, and tables) contained in the Recipient's final report. This data must be formatted in a way that makes it clear how to reproduce each figure from the published data and, in the case of relatively complicated figures, the submission should include any required scripts or narrative to achieve that objective.

(b) All final Project Summary Reports will be reviewed and approved by Voucher Providers and DOE prior to acceptance. Artificially limiting the number of figures in the final report to avoid providing underlying data will be considered non-compliance with final reporting requirements.

7. Handling of IP Disputes Between Partners

In the event any disputes arise between Voucher Providers and Recipient regarding IP that is developed in connection with the implementation of the Project Documents, Voucher Providers will provide (and will cause Recipient to provide) prompt notice to ENERGYWERX of the existence of that dispute. Any such notice will include a thorough description of the nature of the dispute and the relevant facts pertaining to the dispute. Voucher Providers will include a provision in the Project Documents that Voucher Providers and Recipient will in good faith seek to resolve any such dispute amicably among themselves for a period of at least thirty (30) days before proceeding with any attempt to formally resolve the dispute by arbitration, litigation, or other third-party dispute resolution mechanism. ENERGYWERX will have no responsibility to mediate or determine the resolution of any such dispute, but to the extent requested by Voucher Providers and Recipient, ENERGYWERX may assist in Voucher Provider's and Recipient's good faith attempts to resolve the dispute amicably.