

For use with those institutions that have an existing and active DOE Facility User Agreement with the Board of Trustees of Leland Stanford, Jr. University acting through SLAC National Accelerator Laboratory.

CryoEM Facility Access Agreement

WHEREAS _____ (“Institution”) has an existing and active DOE Facility User Agreement (“User Agreement”) with the Board of Trustees of Leland Stanford, Jr. University acting through SLAC National Accelerator Laboratory (“SLAC”);

WHEREAS Institution wishes to access the CryoEM Facility located at SLAC to perform research, which is of the type of work within the Scope of Work of the User Agreement;

WHEREAS the CryoEM Facility is not a DOE Designated User Facility, and thus amendments to the User Agreement are required prior to accessing the CryoEM Facility;

SLAC and the Institution (collectively, “the Parties”), for good and valuable consideration, including the right to access the CryoEM Facility, agree as follows solely with respect to Institution’s work performed at the CryoEM Facility:

1. All Articles and terms of the User Agreement except those identified herein shall apply with respect to Institution’s work performed at the CryoEM Facility;
2. **Article VIII. Patent Rights** is deleted with respect to work performed at the CryoEM Facility, and replaced as follows:

Article VIII. PATENT RIGHTS - USE OF FACILITIES (CLASS WAIVER)

1. Definitions
 - A. "Subject Invention" means any invention or discovery of the Contractor, or, to the extent the User is performing any work under this Agreement, of the User, conceived in the course of or under this Agreement, or, in the case of an invention previously conceived by the User, first actually reduced to practice in the course of or under this Agreement. "Subject Invention" includes any art, method, process, machine, manufacture, design or composition of matter, or any new and useful improvement thereof, or any variety of plant, whether patented under the patent laws of the United States of America or any foreign country, or unpatented.
 - B. "Patent Counsel" means the DOE Patent Counsel assisting the procuring activity which has the administrative responsibility for the facility where the work under this Agreement is to be performed.
2. Rights of the User; election to retain rights
Subject to the provisions of paragraph 3 with respect to any Subject Invention reported and elected in accordance with paragraph 4 of this article, the User may elect to obtain the entire right, title, and interest throughout the world to each Subject Invention and any patent application filed in any country on a Subject Invention and in any resulting patent secured by the User. Where appropriate, the filing of patent applications by the User is subject to DOE and other Government security regulations and requirements.
3. Rights of Contractor and Government
 - A. Assignment to either the Contractor or the Government
The User agrees to assign to either the Contractor or the Government, as requested by the Contractor, the entire right, title, and interest in any country to each Subject

Invention of the User and to each Subject Invention of the Contractor, where the User:

- (1) does not elect pursuant to this Clause to retain such rights; or
- (2) elects to obtain title to a Subject Invention pursuant to paragraph 2 but fails to have a patent application filed in that country on the Subject Invention or decides not to continue prosecution or not to pay any maintenance fees covering the invention.

B. Terms and Conditions of Waived Rights

- (1) To preserve the Contractor's and the Government's residual rights to Subject Inventions, and in patent applications and patents on Subject Inventions, the User shall take all actions in reporting, electing, filing on, prosecuting, and maintaining invention rights promptly, but in any event, in sufficient time to satisfy domestic and foreign statutory and regulatory time requirements, or, if the User decides not to take appropriate steps to protect the invention rights, it shall notify the Contractor in sufficient time to permit either the Contractor or the Government to file, prosecute, and maintain patent applications and any resulting patents prior to the end of such domestic or foreign statutory or regulatory time requirements.
- (2) The User shall convey or ensure the conveyance of any executed instruments necessary to vest in either the Contractor or the Government the rights set forth in this article.
- (3) With respect to any Subject Invention in which the User obtains title, the User hereby grants to the Government a non-exclusive, nontransferable, irrevocable, paid-up license to practice or have practiced by or on behalf of the United States the Subject Invention throughout the world.
- (4) The User shall provide the Government a copy of any patent application filed on a Subject Invention within 6 months after such application is filed, including its serial number and filing date.
- (5) Preference for U.S. Industry. Notwithstanding any other provision of this article, the User agrees that neither it nor any assignee will grant to any person the exclusive right to use or sell any Subject Invention in the United States unless such person agrees that any products embodying the Subject Invention or produced through the use of the Subject Invention will be manufactured substantially in the United States. However, in individual cases, the requirement for such an agreement may be waived by DOE upon a showing by the User 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.
- (6) March-In Rights. The User agrees that with respect to any Subject Invention of the Contractor in which it has acquired title, the DOE shall retain the right to require the User to grant a responsible applicant a nonexclusive, partially exclusive, or exclusively license to use the Subject Invention in any field of use, on terms that are reasonable under the circumstances, or if the User fails to grant such a license, to grant the license itself. DOE may exercise this right only in exceptional circumstances and only if DOE determines that:

- (a) the action is necessary to meet health or safety needs that are not reasonably satisfied by the User; or
 - (b) the action is necessary to meet the requirements for public use specified by Federal regulations and such requirements are not reasonably satisfied by the User; or
 - (c) such action is necessary because a licensee of the exclusive right to use or sell any Subject Invention in the United States is in breach of the agreement required by paragraph 5 regarding preference for U.S. industry.
 - (7) The User agrees to refund any amounts received as royalty charges on any Subject Invention in procurement by or on behalf of the Government and to provide for that refund in any instrument transferring rights to any party in the invention.
 - (8) The User agrees to include, within the specification of any U.S. patent applications and any patent issuing thereon covering a Subject Invention, the following statement. "The Government has rights in this invention pursuant to Management & Operations Contract DE-AC02-76SF00515 between Stanford University and the Department of Energy."
- 4. Invention Identification, Disclosures, and Reports
 - A. The User shall furnish the Patent Counsel a written report containing full and complete technical information concerning each Subject Invention it makes within 6 months after conception or first actual reduction to practice, whichever occurs first, in the course of or under this Agreement, but in any event prior to any on sale, public use, or public disclosure of such invention known to the User. The report shall identify the contract and inventor and shall be sufficiently complete in technical detail and appropriately illustrated by sketch or diagram to convey to one skilled in the art to which the invention pertains a clear understanding, to the extent known at the time of disclosure, of the nature, purpose, operation, and the physical, chemical, biological, or electrical characteristics of the invention. The report should also include any election of invention rights under this article. When an invention is reported under this paragraph 4.A, it shall be presumed to have been made in the manner specified in Section (a)(1) and (2) of 42 USC 5908.
 - B. The Contractor shall report Subject Inventions it makes in accordance with the procedures set forth in contract DE-AC02-76SF00515. In addition, the Contractor shall disclose to the User at the same time as disclosure to the DOE any Subject Inventions made by the Contractor under this Agreement and the User shall notify the DOE within 6 months of receipt of such disclosure by the User of any election of patent rights under this article.
 - C. Requests for extension of time for election under subparagraphs A and B may be granted by Patent Counsel for good cause shown in writing.
- 5. Limitation of Rights

Nothing contained in this patent rights Clause shall be deemed to give the Government any rights with respect to any invention other than a Subject Invention except as set forth in the Facilities License of paragraph 6.
- 6. Facilities License

In addition to the rights of the Parties with respect to inventions or discoveries conceived or first actually reduced to practice in the course of or under this Agreement, the User agrees to and does hereby grant to the Government an irrevocable, non-

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

7. Early Termination of Agreement

The terms and conditions of this article shall survive the Agreement, in the event that the Agreement is terminated before completion of the Scope of Work.

3. **Article IX. RIGHTS IN TECHNICAL DATA** is deleted with respect to work performed at the CryoEM Facility, and replaced as follows:

Article IX. RIGHTS IN TECHNICAL DATA - USE OF FACILITY

1. The following definitions shall be used.
 - A. "Generated Information" means information produced in the performance of this Agreement.
 - B. "Proprietary Information" means information which is developed at private expense, is marked as Proprietary Information, and embodies (1) trade secrets or (2) commercial or financial information which is privileged or confidential under the Freedom of Information Act (5 USC 552 (b)(4)).
 - C. "Unlimited Rights" means the right 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, and to have or permit others to do so.
2. The User agrees to furnish to the Contractor or leave at the facility that information, if any, which is (1) essential to the performance of work by the Contractor personnel or (2) necessary for the health and safety of such personnel in the performance of the work. Any information furnished to the Contractor shall be deemed to have been delivered with Unlimited Rights unless marked as Proprietary Information. The User agrees that it has the sole responsibility for appropriately identifying and marking all documents containing Proprietary Information, whether such documents are furnished by the User or produced under this Agreement and made available to the User for review.
3. The User, Contractor, and the Government shall have Unlimited Rights in all Generated Information, except for information which is disclosed in a Subject Invention disclosure being considered for patent protection.
4. The Government and Contractor agree not to disclose properly marked Proprietary Information without written approval of the User, except to 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).

The User is solely responsible for the removal of all of its Proprietary Information from the facility by or before termination of this Agreement. The Government and Contractor shall have Unlimited Rights in any Proprietary Information which is not

removed from the facility by termination of this Agreement. The Government and Contractor shall have Unlimited Rights in any Proprietary Information which is incorporated into the facility or equipment under this Agreement to such an extent that the facility or equipment is not restored to the condition existing prior to such incorporation. The U.S. Government and Contractor shall have unlimited rights in any information which is not removed from the facility by or before termination of this Agreement.

5. The User agrees that the Contractor will provide to the DOE a nonproprietary description of the work performed under this Agreement.
6. Copyrights. The User may assert copyright in any of its Generated Information, and may also require the Contractor, at the User's expense, to register copyright and assign to the User copyright in any Generated Information produced by the Contractor which the User wishes to copyright. Subject to the other provisions of this article, and to the extent that copyright is asserted, the Government reserves for itself a royalty-free, world-wide, irrevocable, non-exclusive license for Governmental purposes to publish, disclose, distribute, translate, duplicate, exhibit, prepare derivative works, and perform any such data assigned to the User.
7. The terms and conditions of this article shall survive the Agreement, in the event that the Agreement is terminated before completion of the Scope of Work.
8. 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 Stanford University, acting under Contract No. DE-AC02-76-SFO0515. Neither Stanford University, 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.

4. Institution's access to the CryoEM Facility shall terminate no later than the expiration date of its User Agreement, **which expires** _____, unless the User Agreement is renewed.

FOR SLAC:

NAME OF AUTHORIZED OFFICER: Cathy Knotts, Authorized Stanford/SLAC Officer TITLE OF AUTHORIZED OFFICER: Manager, SSRL User Research Administration

SIGNATURE: _____ **DATE:** _____

FOR USER INSTITUTION (please type or print):

NAME OF AUTHORIZED OFFICER: _____

TITLE OF AUTHORIZED OFFICER: _____

ADDRESS: _____

TELEPHONE: _____ **EMAIL:** _____

SIGNATURE: _____ **DATE:** _____