

PROPRIETARY AGREEMENT
FOR USE OF THE
NATIONAL SYNCHROTRON LIGHT SOURCE ("NSLS")
A DOE DESIGNATED USER FACILITY

This Agreement is entered into by

BROOKHAVEN SCIENCE ASSOCIATES, ("Contractor"),

which operates Brookhaven National Laboratory ("Brookhaven"), Upton, New York 11973, under Contract No. DE-AC02-98CH10886 ("Prime Contract") with the United States Government as represented by the U.S. Department of Energy ("DOE"),

and Input Institution Name("User")

(Collectively, "the Parties")

ARTICLE I: SCOPE OF SERVICES

CONTRACTOR will make available to USER certain facilities, equipment, services, information and other material as set forth in this agreement.

Under the terms of this Agreement, the USER will be granted access to and use of the facility for the conduct of proprietary research, which research must first receive programmatic approval of the facility director and available scheduling therefor. It is understood and agreed that the approval determinations of the director of the facility are final.

It is understood that to receive such approval, the USER is obligated to provide a proposal disclosing a functional non-proprietary description of the experimental work, since such information is essential to the CONTRACTOR to operate the facility. Any proposal for proprietary research submitted to the CONTRACTOR which is not approved for performance at the facility shall be returned to the USER and the CONTRACTOR and DOE shall obtain no rights in such proposal.

ARTICLE II. TERM OF THE AGREEMENT

This Agreement shall become effective when signed by the parties hereto and shall continue as long as representatives from User are conducting research at the facility, unless sooner terminated upon written notice by either party.

ARTICLE III: COST

USER will bear its own costs and expenses associated with this Agreement. USER shall also be responsible for a fee for the use of the facility for proprietary work, which fee represents full cost recovery by the CONTRACTOR. Appendix A attached hereto sets forth the basic pricing policy applicable to proprietary users of the facility. The USER shall make a payment of the full amount to cover the CONTRACTOR'S costs incurred in the performance of the work under this Agreement if the estimated cost is \$25,000 or less OR for work that will be completed in 90 days or less. For estimated costs greater than \$25,000 and that will last longer than 90 days, sufficient advance funds shall be obtained to maintain approximately a 90-day advance of funds during the life of the project. The advance shall also cover any anticipated termination cost that the CONTRACTOR would incur if this agreement is terminated. The CONTRACTOR must receive full payment or the advance prior to commencement of work.

Upon completion of work, or upon termination of this agreement, the CONTRACTOR shall promptly return to the Sponsor any portion of the payment that is unexpended.

The CONTRACTOR has no obligation to make available to USER certain facilities, equipment, services, information and other material as set forth in this agreement or continue performance of the work at a cost in excess of any payment or advance received.

ARTICLE IV: ADMISSION REQUIREMENTS

- A. General** - USERS are subject to the administrative and technical supervision and control of CONTRACTOR; and will comply with all applicable rules of CONTRACTOR and DOE with regard to admission to and use of the facility, including safety, operating and health-physics procedures, environment protection, access to information, hours of work, and conduct. USER is required to obtain agreements from each of the employees or representatives as necessary to implement the provisions of the Agreement. USER's employees will not be considered employees of CONTRACTOR for any purpose.
- B. Safety and Health** - USER shall take all reasonable precautions with regard to the installation of equipment and performance of experiments to protect the safety and health of others and to protect the environment, and shall comply with all applicable safety and health regulations and requirements of the facility, the CONTRACTOR, and the Government. If USER fails to comply with said regulations or requirements, the CONTRACTOR may, without prejudice to any other legal or contractual rights, issue an order stopping all or any part of USER's activities at the facility.
- C. ISMS** - CONTRACTOR's Integrated Safety Management System ("ISMS") must be used by all Laboratory Staff and Users to establish work planning and control requirements at CONTRACTOR so that all work is planned and implemented properly, hazards and risks are identified and controlled, resources are scheduled and coordinated, and appropriate feedback mechanisms are in place. "Work" is defined as the activities that involve the design, conduct and completion of experiments by Brookhaven Staff or Users. The Work Planning and Control Management System includes the Environmental Safety and Health ("ESH") Standard 1.3.5, Planning and Control of Experiments and ESH Standard 1.3.6, Work Planning and Control for Operations.
- D. Training** - CONTRACTOR has established training programs in accordance with regulatory requirements for work to be performed, hazards that may be encountered, areas to be accessed, potential for risk, and general site requirements. CONTRACTOR's Training and Qualifications Program ensures that Laboratory staff and USERS are trained and qualified to perform their assigned tasks and job functions.
- E.** Individuals for whom USER is responsible, but who are not actual employees of USER, shall execute any and all documents required by CONTRACTOR to access and use the facility.

ARTICLE V: PROPERTY AND MATERIALS

USER reserves the right to furnish equipment, tooling, test apparatus, or materials necessary to assist in the performance of its experiment(s) at the 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 of this Agreement or will be disposed of as directed by USER. Any equipment that becomes integrated into the facility shall be the property of the 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 facilities and equipment needed for or involved in the Activity.

ARTICLE VII: INTELLECTUAL PROPERTY PROVISIONS

The rights of the parties in patents, Technical Data, copyrights and other intellectual property that may arise under this Agreement are set forth in Appendix B of this Agreement. Appendix B incorporates the provisions of the "Class Waiver for Proprietary Users of Energy Research Designated User Facilities" issued by DOE.

Individuals for whom USER is responsible, but who are not actual employees of USER, shall be considered employees of USER solely for the purposes of ownership of intellectual property in accordance with Appendix B.

The CONTRACTOR shall have the right to use, without payment of any compensation, any information delivered to the CONTRACTOR under the terms of this Agreement which is not marked as "proprietary data" of the USER pursuant to paragraph 3 of Appendix B of this Agreement.

ARTICLE VIII: 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.

ARTICLE IX: RECORDS AND ACCOUNTING SYSTEM

USER will maintain records of receipts, expenditures, and the disposition of all Government property in its custody, related to the Agreement.

ARTICLE X: PUBLICATIONS

USER will not use the name of CONTRACTOR or the United States 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 Government and CONTRACTOR.

ARTICLE XI: ADMINISTRATION OF THE AGREEMENT

This Agreement is entered into by CONTRACTOR under the authority of its Prime Contract with DOE. CONTRACTOR will administer this Agreement in all respects. Administration of this Agreement may be transferred from CONTRACTOR to DOE or its designee with notice of such transfer to USER, and CONTRACTOR will have no further responsibilities except as set forth in Article XVI of this Agreement.

ARTICLE XII: DISPUTES The parties will attempt to jointly resolve all disputes arising from this Agreement. If the parties are unable to jointly resolve a dispute within a reasonable period of time, the dispute will be decided by the DOE Contracting Officer. After the Contracting Officer's decision is made, either Party may request that the dispute be settled by arbitration in accordance with the then current and applicable rules of the American Arbitration Association. Judgment upon the award rendered by the Arbitrator(s) shall be nonbinding on the Parties, and any costs incurred therefrom shall be divided equally between the Parties.

ARTICLE XIII. CONFLICT OF TERMS

This agreement constitutes the primary document which governs the work described in the proposal. 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 XIV: INDEMNITY AND LIABILITY

A. Personnel Relationships - USER shall be responsible for the acts or omissions of its employees and agents and of all other persons that USER allows to participate in the activities under this Agreement.

B. Product Liability - To the extent permitted by applicable law, if USER elects to retain title to an invention pursuant to the terms of this Agreement, then USER hereby agrees to hold harmless and indemnify CONTRACTOR and the United States 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 the making, using, or selling of a product, process or service which was derived from the work performed under this Agreement by or on behalf of USER, its assignees or licensees.

C. General Liability - To the extent permitted by applicable law, USER hereby agrees to indemnify and hold harmless CONTRACTOR and the United States 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 or contributed to by the intentional or negligent act or willful misconduct of USER or its employees or representatives during the performance of the work under this Agreement.

D. General Disclaimer - Except to the extent of their negligence or intentional misconduct, neither the Government nor the CONTRACTOR, nor persons acting on their behalf will be responsible for any injury to or death of persons or other living things or damage to or destruction of property or for any other loss, damage, or injury of any kind whatsoever resulting from the performance of services or furnishings of materials hereunder, unless provided otherwise by applicable law.

THE GOVERNMENT AND CONTRACTOR MAKE NO EXPRESS OR IMPLIED WARRANTY AS TO THE CONDITIONS OF 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. NEITHER THE GOVERNMENT NOR CONTRACTOR SHALL BE LIABLE FOR SPECIAL, CONSEQUENTIAL, OR INCIDENTAL DAMAGES ATTRIBUTED TO SUCH RESEARCH OR RESULTING PRODUCT, INTELLECTUAL PROPERTY, GENERATED INFORMATION, OR PRODUCT MADE OR DELIVERED UNDER THIS AGREEMENT.

ARTICLE XV: ENTIRE AGREEMENT

It is expressly agreed by the parties hereto that this Agreement constitutes the entire and only contract between the parties with respect to the proprietary research to be conducted at the facility; that there are no agreements, understandings or covenants between the parties hereto of any kind, nature or description, express or implied, oral or otherwise which have not been set forth herein, and that this Agreement cannot be modified, altered, amended or changed, nor any provision thereof waived or abrogated, except by an instrument in writing and duly executed on behalf of each of the parties hereto by the duly authorized representatives or officers of each party who have been expressly authorized in writing to execute such an instrument.

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.

ARTICLE XVII: APPROVAL

This Agreement is subject to the approval of the United States Department of Energy.

BROOKHAVEN SCIENCE ASSOCIATES:

By _____
(Signature)

Name Lori-Anne Neiger
Chief Intellectual Property Counsel
Office of Intellectual Property
Title and Sponsored Research

Date _____

USER:

By _____
(Signature)

Name Input Name

Title Input Title

Date _____

Mailing Address of Institution:
Input Address

APPENDIX A

BROOKHAVEN NATIONAL LABORATORY FULL COST RECOVERY RATE

- 1) Full Cost Recovery Rates are established at the beginning of each Fiscal Year (effective October 1) and are subject to revision to reflect changing cost factors during the Fiscal Year.
- 2) BSA will notify the User in writing at the beginning of each Fiscal Year and at any time during the Fiscal Year of any change in the full cost recovery rate for the facility.

APPENDIX B

Patent and Technical Data Provisions (User Facilities Class Waiver)

1. Patent Rights

(a) Definitions

- (1) "Sponsor" means the person or entity with which this agreement is made.
- (2) "Subject invention" means any invention or discovery of the Sponsor conceived or first actually reduced to practice in the course of or under this contract, and includes any art, method, process, machine, manufacture design, or composition of matter, or any new and useful improvement thereof, or any variety of plants, whether patented or unpatented under the Patent Laws of the United States of America or any foreign country.
- (3) "Facility Operator" means the operating contractor which manages and operates the Government-owned, contractor-operated facility where the work under this agreement is to be performed.
- (4) "Patent Counsel*" means the DOE Patent Counsel assisting the procuring activity.

(b) Rights of the Sponsor - Election to Retain Rights

Subject to the provisions of paragraph (c) of this clause with respect to any Subject Invention reported and elected in accordance with paragraph (d) of this clause, the Sponsor 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 the Sponsor. Where appropriate, the filing of patent applications by the Sponsor is subject to DOE security regulations and requirements.

(c) Rights of Government - Terms and Conditions of Waived Rights

- (1) The Sponsor shall promptly provide the Government with a copy of any patents issued on subject inventions.
- (2) Notwithstanding any other provision of this clause, the Sponsor 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 Sponsor 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.
- (3) Title to any Subject Invention shall revert to the Government in the event the agreement required by paragraph (c) (2) of this clause has not been obtained or waived with respect to such invention or because a licensee of the exclusive right to use or sell any such invention in the United States is in breach of such agreement.

(d) Invention identification, disclosures, and reports

The Sponsor shall furnish the Patent Counsel a written report containing full and complete technical information concerning each Subject Invention of the Sponsor within 6 months after conception or first actual reduction to practice, whichever occurs first, in the course of or under the contract, but in any event prior to any on sale, public use or public disclosure of such invention known to the Sponsor. 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 of the nature, purpose, operation, and to the extent known, the physical, chemical, biological, or electrical characteristics of the invention. The report should also include any election of patent rights under this clause. When an invention is reported under this paragraph (d), it shall be presumed to have been made in the manner specified in Section (a)(1) and (2) of 42 USC 5908.

(e) 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 (f).

(f) 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 contract, the Sponsor 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 actually reduced to practice or acquired by the Sponsor, which at any time through completion of this contract are owned or controlled by the Sponsor 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 that facility. The acceptance or exercise by the Government of the aforesaid rights and licensee shall not prevent the Government at anytime from contesting the enforceability, validity or scope of, or title to, any rights or patents herein licensed.

2. Patent and Copyright Indemnity-Limited

The Sponsor shall indemnify the Government and Facility Operator and their officers, agents, and employees against liability, including cost, for infringement of any United States patent or copyright arising out of any acts required or directed by the Sponsor to be performed under the agreement to the extent such acts are not normally performed at the facility. Further, the foregoing indemnity shall not apply unless the Sponsor shall have been informed in a reasonable time by the Facility Operator or the Government of the suit or action alleging such infringement, and such indemnity shall not apply to a claimed infringement which is settled without the consent of the Sponsor unless required by a court of competent jurisdiction.

1 Rights in Technical Data - Use of Facility

(a) Definitions

(1) “Technical Data” means recorded information, regardless of form or characteristic, of a scientific or technical nature. It may, for example, document research, experimental, developmental, demonstration, or engineering work to be usable or used to define a design or process or to procure, produce, support, maintain, or operate material. The data may be graphic or pictorial delineations in media such as drawings or photographs, text in specifications or related performance or design type documents, or computer software (including computer programs, computer software data bases, and computer software documentation). Examples of technical data include research and engineering data, engineering drawings and associated lists, specifications, standards, process sheets, manuals, technical reports, catalog item identification and related information. Technical data as used in this subpart does not include financial reports, cost analyses, and other information incidental to contract administration. “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:

- (i) Are not generally known or available from other sources without obligation concerning their confidentiality;
- (ii) Have not been made available by the owner to others without obligation concerning their confidentiality; and
- (iii) Are not already available to the Government without obligation concerning their confidentiality.

“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) The Sponsor agrees to deliver to DOE a nonproprietary description of the work performed under this agreement.
- (c) The Sponsor agrees to furnish DOE or the Facility Operator those data if any, which are (1) related to health and safety of personnel at the facility or (2) necessary to operate the facility. Any data furnished to DOE or the Facility Operator shall be deemed to have been delivered with “unlimited rights” unless marked as “proprietary data” of the Sponsor. Government shall not disclose properly marked proprietary data of the Sponsor outside the Government and the Facility Operator. The Government reserves the right to challenge the proprietary nature of

any markings on data.

The 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 Government shall have unlimited rights in any technical data (including proprietary data) which are incorporated into the facility or equipment under the agreement to such extent that the facility or equipment is not restored to the condition existing prior to such incorporation.

4. Notice and Assistance Regarding Patent and Copyright Infringement

The Sponsor shall report to the 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 the Sponsor has knowledge.

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 agreement or out of the use of any supplies furnished or work or services performed hereunder, the Sponsor shall furnish to the Government when requested by the Government, all evidence and information in possession of the Sponsor pertaining to such suit or claim. Such evidence and information shall be furnished at the expense of the Government except where the Sponsor has agreed to indemnify the Government.