

**GENERAL TERMS AND CONDITIONS FOR  
DOE SBIR AND STTR PHASE I AND PHASE II AWARDS**

**SBIR/STTR-GTC-0001 EXPLANATION**

- a. These general terms and conditions do not restate all the provisions of applicable statutes and regulations, nor do they represent an exhaustive listing of all requirements applicable to this Assistance Agreement. Rather, they highlight and are consistent with those requirements which are especially pertinent to research awards in general. They are emphasized by inclusion here because:
  - (1) they are invoked with high frequency; and
  - (2) their violation is a matter of especially serious concern.
- b. In addition to these general terms and conditions, the recipient must comply with all governing requirements, including those identified in block 9 of the Assistance Agreement face page and those included in the “Special Terms and Conditions for Use in SBIR/STTR Awards” attached to this Assistance Agreement package.

**SBIR/STTR-GTC-0003 DEFINITIONS**

- a. Grants/Agreements Officer. This may be any Contracting Officer of the awarding office. The terms, “the Contracting Officer named on the face page of this award,” “the Contracting Office,” “a DOE Contracting Officer,” “Grants Officer,” and “Agreements Officer” refer to this person as well. The address to be used in corresponding with the Grants/Agreements Officer appears in block 16 of the Assistance Agreement.
- b. Grant Administrator/Assistance Agreement Administrator. The individual named as the DOE Assistance Agreement Administrator on the Continuation Sheet of the Assistance Agreement.
- c. Principal Investigator. As used herein, the scientist or other programmatic expert named in block 14 of the Assistance Agreement, designated by the recipient organization to direct the scientific/technical efforts being supported.
- d. Prior Approval. A written or electronically-transmitted statement from the Grants/Agreements Officer that a cost may be incurred or an action may be taken. The approval may take the form of a letter, e-mail message, or a modification to the Assistance Agreement.
- e. Director, SBIR/STTR Programs Office. The DOE Headquarters manager in charge of the SBIR/STTR programs. The Program Director’s address is:

U.S. Department of Energy  
SC-29/Germantown Building  
1000 Independence Avenue, SW  
Washington, DC 20585-1290

**SBIR/STTR-GTC-0004 REVISION OF BUDGET AND PROGRAM PLANS**

The Recipient must obtain the Grants/Agreements Officer’s prior approval for the following changes:

- (1) budget revisions as described in 2 CFR 200.308 Revision of Budget and Program Plans to include the transfer of funds among direct cost categories, functions, and activities for awards in which the Federal share of the project exceeds the simplified acquisition threshold (as defined at 48 C.F.R. 2.101), and the cumulative amount of such transfers exceeds or is expected to exceed 10 percent of the total budget as last approved by DOE (does not apply to Phase I awards made on a fixed obligation basis).
- (2) change in scope or the objectives of the project,
- (3) the need for additional funding,
- (4) a change in approved principal investigator or other key personnel specified in the application of award document,
- (5) an absence of more than 3 months or a reduction of 25 percent, or more, in the approved Principal Investigator’s time devoted to the project,

- (6) the inclusion of pre-award costs for periods greater than 90 calendar days from the official project start date (not applicable to Phase I awards),
- (7) a “no-cost” extension of the period of performance per SBIR/STTR-GTC-0009 EXTENSIONS,
- (8) any subaward, transfer, or contracting out of substantive program performance under the award, that was not described in the application and funded in the approved award,
- (9) the purchase of real property or equipment, not described in the application and funded in the approved award

**SBIR/STTR-GTC-0005 ALLOWABLE COSTS/APPLICABLE COST PRINCIPLES**

- a. In accordance with the applicable cost principles cited below, the allowable costs of this award shall consist of the actual allowable direct costs incident to performance of the project, plus the allocable portion of the allowable indirect costs, if any, of the organization, less applicable credits. The allowable costs shall not exceed the amount shown on the face page of this Assistance Agreement for the total approved budget for the current budget period (Block 13, Funds Obligated) or as otherwise stipulated in the award Special Terms and Conditions.
- b. The allowability of costs for work performed under this award and any subsequent subaward will be determined in accordance with the Federal cost principles applicable to the recipient or subrecipient in effect on the date of award or the date of the subaward, except as modified by other provisions of this award or subaward. The recipient or subrecipient shall specify in any cost-reimbursement contract under the award or subaward the applicable cost principles cited in this provision that apply to the contractor.
- c. The Federal cost principles applicable to specific types of recipients, subrecipients, and contractors under awards and subawards are stated in 2 CFR 910.352 Cost Principles.

**SBIR/STTR-GTC-0006 AUDITS**

Recipients that expend \$750,000.00 or more in a year under DOE awards are subject to the audit requirements of 2 CFR 910.501 Audit Requirements and are responsible for compliance with those requirements.

**SBIR/STTR-GTC-0007 PRE-AWARD COSTS**

Recipients may incur pre-award costs up to ninety (90) calendar days prior to the effective date of an award. Pre-award costs for periods preceding ninety (90) calendar days prior to the effective date of the award are allowable only if approved in writing, prior to incurrence, by a DOE Grants/Agreements Officer. Any pre-award expenditures (including those made after DOE approval) are made at the recipient’s risk and do not impose any obligation on the DOE.

**SBIR/STTR-GTC-0009 EXTENSIONS**

In accordance with 2 CFR part 200.308(e)(2)(i), a recipient is prohibited from granting itself an extension to the period of performance of this award. A recipient must instead request approval from the DOE Grants/Agreements Officer for any extension. All such requests must be submitted through the Portfolio Analysis and Management System (PAMS). Requests should be submitted as soon as the need for an extension is known and should be submitted sufficiently in advance of the end date of the period of performance to allow sufficient time for the request to be processed prior to the expiration of the award. PAMS is available at <https://pamspublic.science.energy.gov>.

**SBIR/STTR-GTC-0010 MAXIMUM DEPARTMENTAL OBLIGATION**

DOE's maximum obligation to the recipient is the amount shown in block 13, Funds Obligated. DOE shall not be obligated to make any additional, supplemental, continuation, renewal or other award for the same or any other purpose.

### **SBIR/STTR-GTC-0011 PROPERTY**

#### Real Property, Equipment and Supplies

- (1) No real property may be acquired under this Assistance Agreement.
- (2) Equipment and supplies acquired by the recipient with Federal funds:
  - Equipment

The recipient shall be accountable for equipment under the award with an acquisition cost per unit of \$5,000.00 or more, in accordance with 2 CFR 910.360. The recipient shall not encumber or permit any encumbrance on the equipment without the prior written approval of the DOE Contracting Officer.
  - Supplies

Any unused supplies that exceed an aggregate fair market value of \$5,000.00 must be accounted for during closeout of the award. The recipient may retain these supplies under the following conditions:

    - Supplies are needed for other Federally sponsored projects or programs.
    - The recipient compensates DOE for its share for those supplies that are sold or used on non-Federally sponsored activities.
- (3) Management Policy and Procedures. Recipient shall follow property management policies and procedures that provide for adequate control of the acquisition and use of the assets acquired under the award as required in 2 CFR 200.313(d).
- (4) Insurance. In accordance with 2 CFR 910.360(e), the recipient must, at a minimum, provide the equivalent insurance coverage for equipment acquired or improved with Federal funds as provided to property owned by the recipient.
- (5) Additional Uses During and After the Project: Equipment may be made available for use on other projects or programs as authorized by 2 CFR 910.360(f).
- (6) Disposition. In addition to the disposition procedures of 2 CFR 910.360, title to personal property may be transferred to the recipient where the DOE determines such transfer would be more cost effective than recovery of the property by the government.

### **SBIR/STTR-GTC-0012 PRINCIPAL INVESTIGATOR**

- a. The principal investigator is named in Block 14 of the Assistance Agreement.
- b. Because the DOE decision to fund a project is based, to a significant extent, on the qualifications and level of participation of the principal investigator, a change of principal investigator or of the level of effort of the principal investigator is considered a change in the approved project. There shall be only one principal investigator at any one time during the performance of this award. Department of Energy Grants/Agreements Officer approval must be obtained prior to any change of the principal investigator.
- c. The recipient represents that either it or, if this is a STTR award, the research institution (as defined in the Funding Opportunity Announcement) is the source of primary employment of the principal investigator at the time of the award of this grant/cooperative agreement, and agrees it or, if this is a STTR award, the research institution, will continue to be such during the project period of the award.

### **SBIR/STTR-GTC-0015 RESEARCH EFFORT**

For both SBIR and STTR, there are requirements on the amount of the funded research or analytical effort that must be performed by the small business. The research or analytical effort is defined as the total requested funding minus the cost of any work performed by a consultant, a DOE National Laboratory contractor, and any other subcontractor, including TABA. These requirements are:

- a. **SBIR:**
  - (1) Phase I: A minimum of two-thirds of the funded research or analytical effort must be performed by the recipient; a maximum of one-third of the effort may be performed by consultants or subcontractors.
  - (2) Phase II: A minimum of one-half of the research and analytical effort of Phase II must be performed by the recipient; up to one-half of the research or analytical effort may be performed by

consultants or subcontractors.

b. **STTR:**

- (1) Phase I: A minimum of 40% of the work must be performed by the small business and at least 30% of the work must be performed by a single non-profit research institution partner.
- (2) Phase II: The same as STTR Phase I.

**SBIR/STTR-GTC-0016 FOREIGN TRAVEL**

Foreign travel is not authorized except as identified in the approved budget.

**SBIR/STTR-GTC-0017 CONSULTANT SERVICES**

Costs of consultant services are allowable in accordance with the applicable cost principles. These principles include the requirement that the consultant not be an employee of the recipient organization.

**SBIR/STTR-GTC-0021 PUBLIC ACCESS TO INFORMATION**

The Freedom of Information Act, as amended, and the DOE implementing regulations (10 CFR 1004), require DOE to release certain documents and records regarding awards to any person who provides a written request. The intended use of the information will not be a criterion for release. These requirements apply to information held by DOE and do not require recipients, their subrecipients, or their contractors to permit public access to their records.

**SBIR/STTR-GTC-0022 SUSPENSION AND TERMINATION**

Under the provisions of 2 CFR 200.339, Remedies for Noncompliance and 2 CFR 200.340 Termination, DOE may suspend or terminate the award, in whole or in part:

- (1) If the recipient fails to comply with the terms and conditions of the award;
- (2) To the greatest extent authorized by law, if an award no longer effectuates the program goals or agency priorities;
- (3) With the consent of the recipient, in which case the two parties must agree upon the termination conditions, including the effective date and, in the case of partial termination, the portion to be terminated;
- (4) Upon receiving written notification from the recipient, setting forth the reasons for such termination, the effective date, and, in the case of a partial termination, the portion to be terminated. If it is determined, in the case of a partial termination, that the reduced or modified portion of the award will not accomplish the purposes in which the award was made, DOE may terminate the award in its entirety.

**SBIR/STTR-GTC-0023 INTEREST**

The requirements of this paragraph are not applicable when the Grants/Agreements Officer affirmatively determines that its inclusion would not be in the best interests of the Government.

a. Notwithstanding any other term or condition of the award, all amounts that become payable by the recipient to the Government under the award shall bear simple interest from the date due until paid unless paid within 30 days of becoming due. The interest rate shall be the interest rate established by the Secretary of the Treasury (Secretary) as provided in Section 11 of the Debt Collection Act of 1982 (31 U.S.C. 3717), 2 CFR 200.346 Collection of Amounts Due, which is applicable to the period in which the amount becomes due, as provided in paragraph b. below, and then at the rate applicable for each 3-month period as fixed by the Secretary until the amount is paid.

b. Amounts shall be due at the earliest of the following dates:

- (1) The date fixed under the award.

## Not Specified/Other

- (2) The date of mailing or hand-delivery of the first written demand for payment consistent with the award, including any demand resulting from a termination.
- (3) The date the Government transmits to the recipient a proposed agreement to confirm completed negotiations establishing the amount of debt.

c. The interest charge made under this provision may be reduced in accordance with the procedures prescribed in 4 CFR 102.13 Interest, Penalties, and Administrative Costs or in accordance with agency regulations in effect on the date of original award of the grant/cooperative agreement.

### **SBIR/STTR-GTC-0024 PATENT RIGHTS**

*\*The standard patent rights clause at 37 CFR 401.14 has been modified to (1) reflect DOE required subcontracting instructions pursuant to 37 CFR 401.5(a) as well as the deletion of the definition of contractor that does not apply based on the subcontracting instructions; (2) change acquisition terms of contractor, contract and subcontract to financial assistance terms of recipient, award, subaward or agreement pursuant to 37 CFR 401.5(c); and (3) include paragraph (m) U.S. competitiveness provision pursuant to the Determination of Exceptional Circumstances under the Bayh-Dole Act to Further Promote Domestic Manufacture of DOE Science and Energy Technologies executed by DOE on June 7, 2021.*

#### (a) Definitions

- (1) 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. 2321 et seq.).
- (2) Subject invention means any invention of the Recipient conceived or first actually reduced to practice in the performance of work under this agreement, 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 agreement performance.
- (3) 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.
- (4) Made when used in relation to any invention means the conception or first actual reduction to practice of such invention.
- (5) 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.
- (6) 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.
- (7) 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.

(b) Allocation of Principal Rights

The Recipient 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 Recipient 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.

(c) Invention Disclosure, Election of Title and Filing of Patent Application by Recipient

(1) The Recipient will disclose each subject invention to the Federal Agency within two months after the inventor discloses it in writing to Recipient personnel responsible for patent matters. The disclosure to the agency shall be in the form of a written report and shall identify the agreement 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 Recipient 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 Recipient.

(2) The Recipient 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.

(3) The Recipient 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 Recipient 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 Recipient 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 Recipient 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 Recipient, may file such application at its own expense, provided that the Recipient retains the ability to elect title pursuant to 35 U.S.C. 202(a).

(5) 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 Recipient 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 Recipient within 60 days of receiving the request.

(d) Conditions When the Government May Obtain Title

## Not Specified/Other

The Recipient will convey to the Federal agency, upon written request, title to any subject invention -

(1) If the Recipient 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 Recipient fails to file patent applications within the times specified in paragraph (c) of this clause; provided, however, that if the Recipient 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 Recipient shall continue to retain title in that country.

(3) In any country in which the Recipient 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) Upon breach of paragraph (m) U.S. Competitiveness on of this Patent Rights clause.

(e) Minimum Rights to Recipient and Protection of the Recipient Right to File

(1) The Recipient will retain a nonexclusive royalty-free license throughout the world in each subject invention to which the Government obtains title, except if the Recipient fails to disclose the invention within the times specified in (c), above. The Recipient's license extends to its domestic subsidiary and affiliates, if any, within the corporate structure of which the Recipient is a party and includes the right to grant sublicenses of the same scope to the extent the Recipient was legally obligated to do so at the time the agreement 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 Recipient's business to which the invention pertains.

(2) The Recipient'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 Recipient 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 Recipient, its licensees, or the domestic subsidiaries or affiliates have failed to achieve practical application in that foreign country.

(3) Before revocation or modification of the license, the funding Federal agency will furnish the Recipient a written notice of its intention to revoke or modify the license, and the Recipient will be allowed thirty days (or such other time as may be authorized by the funding Federal agency for good cause shown by the Recipient) after the notice to show cause why the license should not be revoked or modified. The Recipient 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.

(f) Recipient Action to Protect the Government's Interest

(1) The Recipient 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 Recipient 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.

## Not Specified/Other

(2) The Recipient 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 Recipient each subject invention made under agreement in order that the Recipient can comply with the disclosure provisions of paragraph (c) of this clause, to assign to the Recipient the entire right, title and interest in and to each subject invention made under agreement, 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 Recipient 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.

(3) For each subject invention, the Recipient 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.

(4) The Recipient 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 agreement) awarded by (identify the Federal agency). The government has certain rights in the invention."

### (g) Subawards

(1) The Recipient will include this clause, suitably modified to identify the parties, in all subawards, regardless of tier, for experimental, developmental or research work to be performed by a domestic small business firm or nonprofit organization. The subrecipient will retain all rights provided for the Recipient in this clause, and the Recipient will not, as part of the consideration for awarding the subaward, obtain rights in the subrecipient's subject inventions.

(2) The Recipient will include in all other subawards, regardless of tier, for experimental developmental or research work the patent rights clause directed by the Contracting Officer.

### (h) Reporting on Utilization of Subject Inventions

The Recipient 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 Recipient 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 Recipient, and such other data and information as the agency may reasonably specify. The Recipient 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 Recipient.

### (i) Preference for United States Industry

Notwithstanding any other provision of this clause, the Recipient 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



## Not Specified/Other

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 Recipient 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.

### (j) March-in Rights

The Recipient 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 Recipient, 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 Recipient, 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 Recipient 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 Recipient, 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 Recipient, 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.

### (k) Special Provisions for Agreements with Nonprofit Organizations

If the Recipient 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 Recipient;
- (2) The Recipient 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 Recipient 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
- (4) 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 Recipient 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 Recipient 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 Recipient. However, the Recipient agrees that the Federal agency may review the Recipient's licensing program and decisions regarding small business applicants, and the Recipient will negotiate changes to its licensing policies, procedures, or practices with the Federal agency when the Federal agency's review discloses that the Recipient 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 Recipient may request that the Secretary review the Recipient's licensing program and decisions regarding small business applicants.

(l) Communication

Unless otherwise directed by DOE Patent Counsel, all reports and notifications required by this clause shall be submitted in accordance with the instructions provided in the Federal Assistance Reporting Checklist (FARC) of this agreement.

(m) U.S. Competitiveness

The Recipient agrees that any products embodying any subject invention or produced through the use of any subject invention will be manufactured substantially in the United States unless the Recipient can show to the satisfaction of DOE that it is not commercially feasible. In the event DOE agrees to foreign manufacture, there will be a requirement that the Government's support of the technology be recognized in some appropriate manner, e.g., alternative binding commitments to provide an overall net benefit to the U.S. economy. The Recipient agrees that it will not license, assign or otherwise transfer any subject invention to any entity, at any tier, unless that entity agrees to these same requirements. 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 or other such entity receiving rights shall ensure continual compliance with the requirements of this paragraph (m) and shall inform DOE, in writing, of the change in ownership within six months of the change. The Recipient and any successor assignee will convey to DOE, upon written request from DOE, title to any subject invention, upon a breach of this paragraph (m). The Recipient will include this paragraph (m) in all subawards/contracts, regardless of tier, for experimental, developmental or research work.

(n) The requirements, rights and administration of paragraph (m) are further clarified as follows:

1. Waivers. The Recipient (or any entity subject to paragraph (m)) may request a waiver or modification of paragraph (m). Such waivers or modifications may be granted when DOE determines that (1) the Recipient (or any entity subject to paragraph (m)) has demonstrated, 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.
2. Final determination of breach of paragraph (m). If DOE determines the Recipient is in breach of paragraph (m), the Department may issue a final written determination of such breach. If such determination includes a demand for title to the subject inventions under the award, the demand for title will cause an immediate conveyance and assignment of all rights to all subject inventions under the award to the United States Government, including all pending U.S. and foreign patent applications and all U.S. and foreign patents that cover any subject invention, without compensation. Any such final determination shall be signed by the cognizant DOE Contracting Officer with the concurrence of the Assistant General Counsel for Technology Transfer & Intellectual Property. Advanced notice will be provided for comment to the Recipient before any final written determination by DOE is issued.
3. Pursuant to Recipient's agreement in paragraph (m) to not license, assign or otherwise transfer rights to subject inventions at any tier unless the entity agrees to paragraph (m): any such

- license, assignment, or other transfer of right to any subject invention developed under the award shall contain paragraph (m) suitably modified to properly identify the parties. If a licensee, assignee, or other transferee of rights to any subject invention is finally determined by DOE in writing to be in breach of paragraph (m), the applicable license, assignment or other transfer shall be deemed null and void. Advanced notice will be provided for comment to the non-complying party before any final written determination by DOE is made.
4. For clarity, if the forfeiture of title to any subject invention is due to a breach of paragraph (m), the Recipient shall not be entitled to any compensation, or to a license to the subject invention including the reserved license in section (e)(1), unless DOE grants a license through a separately agreed upon licensing agreement.
  5. Authority. The requirements and administration of paragraph (m) is in accordance with the Determination of Exceptional Circumstances (DEC) under the Bayh-Dole Act to Further Promote Domestic Manufacture of DOE Science and Energy Technologies executed by DOE on June 7, 2021. A copy of the DEC is available at <https://www.energy.gov/gc/determination-exceptional-circumstances-decs>. By accepting or acknowledging the award, the Recipient is also acknowledging that it has received a copy of the DEC through the foregoing link. As set forth in 37 CFR 401.4, any nonprofit organization or small business firm as defined by 35 U.S.C. 201 affected by any DEC has the right to appeal the imposition of the DEC within thirty (30) working days from the Recipient's acceptance or acknowledgement of this award.

#### **SBIR/STTR-GTC-0025 RIGHTS IN DATA - SBIR/STTR PROGRAM**

(a) Definitions.

- (1) Computer Software. Computer programs, source code, source code listings, object code listings, design details, algorithms, processes, flow charts, formulae, and related material that would enable the software to be reproduced, recreated, or recompiled. Computer Software does not include Computer Databases or Computer Software Documentation.
- (2) Data. All recorded information, regardless of the form or method of recording or the media on which it may be recorded. The term does not include information incidental to contract or grant/cooperative agreement administration, such as financial, administrative, cost or pricing or management information.
- (3) Form, Fit, and Function Data. Data relating to items, components, or processes that are sufficient to enable physical and functional interchangeability, and data identifying source, size, configuration, mating and attachment characteristics, functional characteristics, and performance requirements. For Computer Software it means data identifying source, functional characteristics, and performance requirements, but specifically excludes the source code, algorithms, processes, formulas, and flow charts of the software.
- (4) *Reserved*
- (5) Operations, Maintenance, Installation, or Training Purposes (OMIT) Data. Data that is necessary for operation, maintenance, installation, or training purposes (but not including detailed manufacturing or process data).
- (6) SBIR/STTR Computer Software Rights. The Federal Government's rights during the SBIR/STTR Protection Period in specific types of SBIR/STTR Data that are Computer Software.
  - (A) The Federal Government may use, modify, reproduce, release, perform, display, or disclose SBIR/STTR Data that are Computer Software within the Government. The Federal Government may exercise SBIR/STTR Computer Software Rights within the Government for:
    - (1) Use in Federal Government computers;

Not Specified/Other

- (2) Modification, adaptation, or combination with other Computer Software, provided that the Data incorporated into any derivative software are subject to the SBIR/STTR Computer Software Rights described herein and that the derivative software is marked as containing SBIR/ STTR Data;
  - (3) Archive or backup; or
  - (4) Distribution of a computer program to another Federal agency, without further permission of the Awardee, if the Awardee is notified of the distribution and the identity of the recipient prior to the distribution, and a copy of the SBIR/STTR Computer Software Rights included in the Funding Agreement is provided to the recipient.
- (B) The Federal Government shall not release, disclose, or permit access to SBIR/STTR Data that is Computer Software for commercial, manufacturing, or procurement purposes without the written permission of the Awardee. The Federal Government shall not release, disclose, or permit access to SBIR/STTR Data outside the Government without the written permission of the Awardee unless:
- (i) The non-Governmental entity has entered into a non-disclosure agreement with the Government that complies with the terms for such agreements outlined in § 8 of the U.S. Small Business Administration’s SBIR/STTR Program Policy Directive; and
  - (ii) The release or disclosure is—
    - (I) To a Federal Government support service contractor or their subcontractor for purposes of supporting Government internal use or activities, including evaluation, diagnosis and correction of deficiencies, and adaptation, combination, or integration with other Computer Software provided that SBIR/STTR Data incorporated into any derivative software are subject to the SBIR/STTR Computer Software Rights described herein; or
    - (II) Necessary to support certain narrowly-tailored essential Government activities for which law or regulation permits access of a non-Government entity to a contractors’ data developed exclusively at private expense, non- SBIR/STTR Data, such as for emergency repair and overhaul.
- (7) SBIR/STTR Data. All Data developed or generated in the performance of an SBIR or STTR award, including Technical Data and Computer Software developed or generated in the performance of an SBIR or STTR award. The term does not include information incidental to contract or grant/cooperative agreement administration, such as financial, administrative, cost or pricing or management information.
  - (8) SBIR/STTR Data Rights. The Federal Government’s license rights in properly marked SBIR/STTR Data during the SBIR/STTR Protection Period are as follows: SBIR/STTR Technical Data Rights in SBIR/STTR Data that are Technical Data or any other type of Data other than Computer Software; and SBIR/STTR Computer Software Rights in SBIR/STTR Data that is Computer Software. Upon expiration of the protection period for SBIR/STTR Data, the Federal Government shall have Unlimited Rights and is relieved of all disclosure prohibitions and assumes no liability for unauthorized use of these data by third parties. The Federal Government receives Unlimited Rights in Form Fit, and Function Data, OMIT Data, and all unmarked SBIR/STTR Data.
  - (9) SBIR/STTR Protection Period. The period of time during which the Federal Government is obligated to protect SBIR/STTR Data against unauthorized use and disclosure in accordance with SBIR/STTR Data Rights. The SBIR/STTR Protection Period begins at award of an SBIR/STTR Funding Agreement and ends twenty years from that date.
  - (10) SBIR/STTR Technical Data Rights. The Federal Government’s rights during the SBIR/STTR Protection Period in SBIR/STTR Data that are Technical Data or any other type of Data other than Computer Software.

## Not Specified/Other

- (A) The Federal Government may, use, modify, reproduce, perform, display, release, or disclose SBIR/STTR Data that are Technical Data within the Government; however, the Government shall not use, release, or disclose the data for procurement, manufacturing, or commercial purposes; or release or disclose the SBIR/STTR Data outside the Government except as permitted by paragraph (B) below or by written permission of the Awardee.
- (B) SBIR/STTR Data that are Technical Data may be released outside the Federal Government without any additional written permission of the Awardee only if the non-Governmental entity or foreign government has entered into a non-disclosure agreement with the Federal Government that complies with the terms for such agreements outlined in § 8 of the SBIR/STTR Policy Directive and the release is:
  - (i) Necessary to support certain narrowly-tailored essential Government activities for which law or regulation permits access of a non-Government entity to a contractor's data developed exclusively at private expense, non-SBIR/STTR Data, such as for emergency repair and overhaul;
  - (ii) To a Government support services contractor in the performance of a Government support services contract for internal Government use or activities, including evaluation, diagnosis or modification, provided that SBIR/STTR Technical Data incorporated into any derivative Data are subject to the SBIR/STTR Technical Data Rights, and the release is not for commercial purposes or manufacture;
  - (iii) To a foreign government for purposes of information and evaluation if required to serve the interests of the U.S. Government; or
  - (iv) To non-Government entities or individuals for purposes of evaluation.
- (11) Technical Data. Recorded information, regardless of the form or method of the recording, of a scientific or technical nature (including Computer Software Documentation and Computer Databases). The term does not include Computer Software or financial, administrative, cost or pricing, or management information, or other data incidental to contract or grant/cooperative agreement administration. The term includes recorded Data of a scientific or technical nature that is included in Computer Databases.
- (12) Unlimited Rights. The Government's rights to access, use, modify, prepare derivative works, reproduce, release, perform, display, disclose, or distribute Data in whole or in part, in any manner and for any purpose whatsoever, and to have or authorize others to do so.
- (b) Allocation of SBIR/STTR Data Rights.
  - (1) The Awardee retains ownership of all SBIR/STTR Data it develops or generates in the performance of an SBIR/STTR award. The Awardee retains all rights in SBIR/STTR Data that are not granted to the Federal Government in accordance with the SBIR/STTR Policy Directive. These rights of the Awardee do not expire.
  - (2) During the SBIR/STTR Protection Period, the Federal Government receives SBIR/STTR Technical Data Rights in appropriately marked SBIR/STTR Data that is Technical Data or any other type of Data other than Computer Software; and SBIR/STTR Computer Software Rights in appropriately marked SBIR/STTR Data that is Computer Software.
  - (3) After the protection period, the Federal Government shall have Unlimited Rights.
  - (4) The Federal Government receives Unlimited Rights in Form Fit, and Function Data, OMIT Data, and all unmarked SBIR/STTR Data.
- (c) Identification and Delivery of SBIR/STTR Data. Any SBIR/STTR Data delivered by the Awardee, and in which the Awardee intends to limit the Federal Government's rights to SBIR/STTR Data Rights, must be delivered with restrictive markings. The Federal Government assumes no liability for the access, use, modification, reproduction, release, performance, display, disclosure, or distribution of SBIR/STTR Data without markings or data submitted with an identified distribution other than SBIR/STTR Data. The Awardee or its subcontractors or suppliers shall conspicuously and legibly

mark all such SBIR/STTR Data with the appropriate legend and appropriately identify in all submissions to the Federal Government including proper identification as “20 YEAR SBIR/STTR DATA RIGHTS (2019)” in all submissions to Office of Scientific and Technical Information (OSTI).

- (1) The authorized legend shall be placed on the first page or cover page of the document containing SBIR/STTR Data. Subsequent pages shall also include the authorized legend or simply “SBIR/STTR Protected Data”. If only portions of a page are subject to the asserted restrictions, the SBIR/STTR Awardee shall identify the restricted portions (e.g., by circling or underscoring with a note or other appropriate identifier). With respect to SBIR/STTR Data embodied in Computer Software, the legend shall be placed on:
  1. The printed material or media containing the Computer Software; or
  2. the transmittal document or storage container.

The legend shall read as follows:

**20 YEAR SBIR/STTR DATA RIGHTS (2019)**

Funding Agreement No \_\_\_\_\_ (e.g. DE-SC000nnnn)

Award Date \_\_\_\_\_ (Block 27 on the Assistance Agreement)

SBIR/STTR Protection Period: Twenty years from Award Date

SBIR/STTR Awardee \_\_\_\_\_

This report contains SBIR/STTR Data to which the Federal Government has received SBIR/STTR Technical Data Rights or SBIR/STTR Computer Software Rights during the SBIR/STTR Protection Period and Unlimited Rights afterwards, as defined in the Funding Agreement. Any reproductions of SBIR/STTR Data must include this legend.

(End of Legend)

- (2) Data submitted without correct or appropriate markings may be corrected within 6 months from the date the data is delivered.
- (d) Relation to patents. Nothing regarding SBIR/STTR Data Rights in this clause shall imply a license to or imply a requirement to license to the Federal Government any patent to a Subject Invention (as defined under the Bayh-Dole Act implemented at 37 CFR 401) made under an SBIR/STTR award.

(End of Clause)

(e) Copyright.

- (1) Data first produced in the performance of this contract.
  - (i) Except as otherwise specifically provided in this contract, the Awardee may assert copyright subsisting in any data first produced in the performance of this contract.
  - (ii) When asserting copyright, the Awardee shall affix the applicable copyright notice of 17 U.S.C. 401 or 402 and an acknowledgment of Government sponsorship (including award number).
  - (iii) For data other than computer software, the Awardee 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 computer software, the Awardee grants to the Government, and others acting on its behalf, a paid-up, nonexclusive, irrevocable, worldwide license in such copyrighted computer software to reproduce, prepare derivative works, and perform publicly and display publicly, by or on behalf of the Government.
- (2) Data not first produced in the performance of this contract. The Awardee shall not, without prior written permission of the Contracting Officer, incorporate in any data that are not first produced in the performance of this award unless the Awardee (i) identifies such data and (ii) grants to the Government, or acquires on its behalf, a license of the same scope as set forth in paragraph (c)(1)

of this clause.

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

(f) Protection of limited rights data and restricted computer software.

The Awardee may withhold from delivery qualifying limited rights data and restricted computer software that are not identified in paragraphs (b)(1)(i), (ii), and (iii) of this clause. As a condition to this withholding, the Awardee shall identify the data being withheld, and furnish form, fit, and function data instead.

- (g) Subcontracting. The Awardee shall obtain from its subcontractors all data and rights therein necessary to fulfill the Contractor's obligations to the Government under this contract. If a subawardee refuses to accept terms affording the Government those rights, the Awardee shall promptly notify the Contracting Officer of the refusal and not proceed with the subaward award without further authorization in writing from the Contracting Officer. SBIR/STTR rights apply to all SBIR/STTR awards, including subawards to such awards, that fall within the statutory definition of Phase I, II, or III of the SBIR/STTR Program, as described in the SBIR/STTR Policy Directive.
- (h) Relationship to patents. Nothing contained in this clause shall imply a license to the Government under any patent or be construed as affecting the scope of any license or other right otherwise granted to the Government.

**SBIR/STTR-GTC-0029 FEE**

SBIR/STTR recipients may be paid a fee or profit as stated in the approved budget.

## **GENERAL TERMS AND CONDITIONS APPLICABLE TO PHASE I ONLY**

### **SBIR/STTR-GTC-0032 PHASE I OBLIGATIONS**

If this award is less than or equal to \$250,000.00, then this is a fixed amount award in accordance with 2 CFR 200.201 Use of Grant Agreements (Including Fixed Amount Awards), Cooperative Agreements, and Contracts. Awards greater than \$250,000.00 are not fixed amount awards.

The unobligated balance of Federal funds at the end of the Phase I project period shall not be applied to any Phase II effort and shall be de-obligated by DOE.

### **SBIR/STTR-GTC-0033 PRE-AWARD COSTS FOR PHASE I AWARDS**

Notwithstanding clauses SBIR/STTR-GTC-0007 PRE-AWARD COSTS and SBIR/STTR-GTC-0004 REVISION OF BUDGET AND PROGRAM PLANS, Grants/Agreements Officer approval of Phase I pre-award expenditures is not required per 2 CFR 200.308 Revision of budget and program plans.

## **GENERAL TERMS AND CONDITIONS APPLICABLE TO PHASE II ONLY**

### **SBIR/STTR-GTC-0034 PHASE II OBLIGATIONS**

The unobligated balance of Federal funds at the end of the Phase II project period shall not be applied to any follow-on Phase IIA or Phase IIB Sequential efforts and shall be de-obligated by DOE.

### **SBIR/STTR-GTC-0035 REPORTING NON-FEDERAL SUPPORT**

The recipient agrees to provide the SBIR/STTR Program Manager an annual report during Phase II and for five years after completion of this project detailing the sources and amounts of non-Federal funding used to continue support or commercialization of the research funded under this award.