



Intellectual Property Management Plan

Intellectual Property (IP) Management Plan for the Sustainable Manufacturing
Innovation Alliance REMADE Institute, (“REMADE”)

The principal goal of this IP Management Plan (“Agreement”) is to provide effective and coordinated efforts to commercialize technologies developed by the REMADE Institute and its Members.

1. DEFINITIONS

- 1.1. “Academic Member” is defined as a Member who is a public or private university and contributes Cost Share at one of three levels (each, a “Tier”) as set forth in the Bylaws.
- 1.2. “Affiliate Member” is defined as a Member who is a local or state government or affiliated entity (e.g., state economic development office), a not-for-profit organization, and/or a trade organization. There is no required membership fee or Cost Share for Affiliate Members. Organizations who meet the definition of Affiliate Member may elect to participate in REMADE as an Industry Member at the Tier 1 or Tier 2 level, in which case the Industry Member membership fee, Cost Share contribution and membership benefits for the respective Tier selected will apply.
- 1.3. “Background IP” or “BIP” is defined as Intellectual Property (i) in existence prior to or first produced outside any work funded by REMADE, except in the case of invention, the inventions must have been conceived outside of work funded by REMADE and not first actually reduced to practice through work funded by REMADE, (ii) legally necessary for performance of REMADE Work, and (iii) identified in writing by the Intellectual Property owner or licensee who has been provided the right to sublicense.
- 1.4. “Bylaws” is defined as the Bylaws of the REMADE Institute, adopted September 6, 2017.
- 1.5. “Cost Share” is defined as a cash or in-kind contribution to the total cost of the REMADE Institute, that is allowable and verifiable under the applicable Federal cost principles (2 CFR 200.306 as amended by 2 CFR 910.130). Cost Share may or may not be a contribution to a REMADE Project, however all Cost Share must be necessary and reasonable for proper and efficient accomplishment of the goal of the REMADE Institute.
- 1.6. “DOE Award” means DOE Award NO. DE-E0007897, the cooperative agreement between DOE and SMIA to establish and operate REMADE.
- 1.7. “DOE National Lab Member” is defined as a Member who is a federally funded research and development center operating under a Prime Contract with the Department of Energy (for which there is no required membership fee or Cost Share).
- 1.8. “Industry Member” is defined as a Member who is a for-profit company, who contributes annual membership fees and contributes Cost Share at one of three levels as set forth in the Bylaws.
- 1.9. “Intellectual Property” or “IP” is defined as all technical information, inventions,

developments, discoveries, methods, techniques, formulae, algorithms, data, computer programs, software applications, trade secrets, know-how, processes, whether or not patentable or copyrightable, copyrights, copyright registrations and applications, patent and patent applications, trademarks, and any other legally protectable information. Information that is in the public domain which is not patented, patent pending, or copyrighted is not IP.

- 1.10. "Inventing Member" is defined as the Member whose Participating Researcher is an inventor or creator of REMADE IP.
- 1.11. "Limited Rights Data" means data developed at private expense (i.e., without federal funds or Cost Share) that embody trade secrets or are commercial or financial and confidential or privileged.
- 1.12. "Member" - REMADE is comprised of a consortium of members (each a "Member" or collectively "Members"), including industry, universities, trade organizations, and other stakeholders. "Member" means respectively an individual REMADE member organization or the REMADE member organizations collectively that are signatories to the REMADE Membership Agreement.
- 1.13. "Member Publications" are defined as scientific and technical articles published in academic, technical or professional journals, symposia proceedings or similar works created as a result of REMADE Work.
- 1.14. "Non-Commercial Internal Research" means (a) in the case of Industry Members, internal research conducted by an Industry Member, whereby such research, the results thereof and REMADE IP generated through performance thereof are not in any way embodied or used in a product or service offered by or on behalf of the Industry Member to customers or other third parties, and (b) in the case of all other Members, non-commercial internal research conducted by such Members.
- 1.15. "Participating Researcher" is defined as any individual who is performing REMADE Work for a Member.
- 1.16. "Participation Period" is defined as the period of time during which a Member is part of REMADE.
- 1.17. "Project Agreement" is an agreement, which may be in the form of a master agreement with project-specific appendices, which governs a REMADE Project pursuant to the DOE Award, awarded by SMIA to a Member and performed under the auspices of REMADE.
- 1.18. "Project IP" is defined as REMADE IP specific to a particular REMADE Project.
- 1.19. "REMADE" - The REMADE Institute ("REMADE") is a Manufacturing USA institute focused on Reducing Embodied-energy And Decreasing Emissions in America, established and operated by the Sustainable Manufacturing Innovation Alliance ("SMIA"), and funded through a combination of the Department of Energy (DOE) Office of Energy Efficiency and Renewable Energy ("EERE") funding, and other public and private funds.
- 1.20. "REMADE IP" is defined as all patentable Intellectual Property conceived or first actually reduced to practice in the performance of REMADE Work or other Intellectual Property created

in the performance of REMADE Work. Copyright in scientific and technical articles published in academic, technical or professional journals, symposia proceedings or similar works is specifically excluded from “REMADE IP”.

- 1.21. “REMADE Project” is defined as research, development and demonstration (RD&D) projects, training development and deployment projects, or other projects funded in whole or in part by the DOE Award.
- 1.22. “REMADE Work” is defined as any work, research, or activity performed by a Member during its respective Participation Period in REMADE pursuant to the DOE Award.
- 1.23. “Technology Transfer Office” is defined as an organization, such as a non-profit organization or a foundation, or a division or department of a Member that engages in transferring technology on behalf of the Member including, but not limited to, patent law departments and intellectual property licensing organizations.

2. BACKGROUND INTELLECTUAL PROPERTY

- 2.1. Each Member shall retain ownership of its own Background Intellectual Property and any data specified as “Limited Rights Data”. Nothing contained in this Agreement shall be deemed to grant either directly or by implication, estoppel, or otherwise any license to any Background Intellectual Property or Limited Rights Data of any Member. As a requirement for REMADE project consideration and in any event prior to beginning REMADE Work, Members shall disclose to REMADE and list Background Intellectual Property and Limited Rights Data in the REMADE Project Agreement specific to such work by the Member that is contributing the Background Intellectual Property and Limited Rights Data for use under the REMADE Work. The decision to make available any Background Intellectual Property and Limited Rights Data for any use shall be at the sole discretion of each Member and subject to a separate agreement.

3. REMADE INTELLECTUAL PROPERTY INVENTORSHIP AND OWNERSHIP

- 3.1. Intellectual Property created by employees of Federally Funded Research and Development Centers (FFRDC) will be subject to their respective Management and Operating (M&O) contract terms and conditions with respect to ownership of inventions and creative works made by their employees. The M&O contract generally provides that the laboratory contractor has the right to elect to retain title to inventions made by their lab employees.
- 3.2. Inventorship of REMADE IP will be determined in accordance with the intellectual property laws of the United States, including patent and copyright law. Subject to the terms and conditions of the DOE Award, each Inventing Member shall have the right to retain title to its ownership interest in any REMADE IP invented or created by its Participating Researchers.

4. REMADE INTELLECTUAL PROPERTY MANAGEMENT

- 4.1. REMADE may provide advisement on intellectual property filings, prosecution, maintenance and licensing of REMADE IP. Inventing Members may solicit input from REMADE, but shall retain sole authority to select IP counsel and shall promptly provide or instruct external counsel to provide REMADE with all serial numbers, filing dates, and shall give notice to REMADE of the abandonment or issuance of all patents within sixty (60) days of such abandonment or issuance.

- 4.2. Each Member agrees that if it is an owner of jointly owned REMADE IP, it will promptly disclose the REMADE IP to any Members who are potentially a co-owner of such rights, together with any documentation and information necessary to enable such Member to establish any rights to which it may be entitled.
- 4.3. Each Member will require its Participating Researchers to report all REMADE IP to its respective Technology Transfer Office (the date of receipt of such REMADE IP by the Technology Transfer Office shall be the "Receipt Date") in accordance with its own policies on disclosures of Intellectual Property.
- 4.4. The Inventing Member shall have sixty (60) days from the Receipt Date to report all REMADE IP to REMADE, who shall then distribute copies of invention records to DOE and the Members as appropriate.
- 4.5. Provided they have a reasonable opportunity to seek any patent or other protection for its respective REMADE IP, Members agree to share their research findings resulting from REMADE work with Members through REMADE meetings and events.
- 4.6. Members are encouraged to publish the findings and results of REMADE Project activities. Prior to publication, each Member must furnish REMADE with a copy of any proposed Member Publications thirty (30) days in advance of the proposed publication date for pre-publication review of content that might impact the rights of DOE, REMADE or REMADE Members (e.g., inadvertent release of proprietary information, protection of the potential patentability of any REMADE IP). REMADE and those REMADE Members participating in such REMADE Project may request an additional thirty (30) days' delay to allow for any patent filing. Any publication will comply with the data sharing policies set forth in the REMADE Institute Data Management Plan.

5. LICENSING OF REMADE INTELLECTUAL PROPERTY

- 5.1. Option to License REMADE IP - The Inventing Member(s) of any REMADE IP shall grant an option to license such REMADE IP to Members, provided that such REMADE IP was created or first reduced to practice during the Participation Period of the Member exercising such option. The order and type of option for such licenses are determined by the membership level and project participation, as it was at the time such REMADE IP was created or first reduced to practice. Any licenses granted under 5.1 shall be subject to any licenses granted under 5.2.

5.1.1. Any Industry Member(s) that are either Tier 1 Members or Tier 2 Members and that participate in a REMADE Project are eligible for the first option to a royalty-bearing exclusive/co-exclusive license to Project IP arising from such REMADE Project. Such Industry Member(s) may request a royalty-bearing exclusive license or co-exclusive license (if more than one such Industry Member wishes to exercise its option for the same REMADE IP). The Inventing Member(s) of any such licensed REMADE IP agree to negotiate commercially reasonable terms and conditions as further described herein. The term of said first option shall begin on the date upon which the REMADE IP is communicated ("Transmission Date") and shall expire sixty (60) days after the Transmission Date. Inventing Member(s) of REMADE IP subject to the first option described herein shall not unreasonably withhold consent to reasonable license terms proposed by Industry Member licensees.

5.1.2. Subject to Section 5.1.4, all Tier 1 Members are eligible for the second option to a royalty-bearing license to any REMADE IP rights that remain after the expiration of the option under 5.1.1, if any. Tier 1 Members may request a royalty-bearing exclusive license or co-exclusive license (if more than one Tier 1 Member wishes to exercise its option for the same REMADE IP). The Inventing Member(s) of any such licensed REMADE IP agree to negotiate commercially reasonable terms and conditions as further described herein. The term of said second option, if any, shall begin on the day after the end of the option period set forth in Section 5.1.1 and shall expire sixty (60) days thereafter. Inventing Member(s) of REMADE IP subject to the second option described herein shall not unreasonably withhold consent to reasonable license terms proposed by Member licensees.

5.1.3. Subject to Section 5.1.4, all Tier 2 Members are eligible for the third option to a royalty-bearing license to any REMADE IP rights that remain after the expiration of the options under 5.1.1 and 5.1.2, if any. Tier 2 Members may request a royalty-bearing exclusive license or co-exclusive license (if more than one Tier 2 Member wishes to exercise its option for the same REMADE IP), but only if no participating Industry Members (under 5.1.1) or Tier 1 Members (under 5.1.2) have exercised their option. The Inventing Member(s) of any such licensed REMADE IP agree to negotiate commercially reasonable terms and conditions as further described herein. The term of such third option, if any, shall begin on the day after the end of the option period set forth in Section 5.1.2 and shall expire thirty (30) days thereafter. Inventing Member(s) of REMADE IP subject to the third option described herein shall not unreasonably withhold consent to reasonable license terms proposed by Member licensees.

5.1.4. If no options provided by 5.1.1, 5.1.2 or 5.1.3 are exercised, then the option grant shall terminate and Inventing Member owning such REMADE IP may transfer or license such REMADE IP to a non-REMADE Member. If one or more Members exercise an option under Section 5.1.1, then the initiation of the option period under Section 5.1.2 shall be tolled until either: (a) one or more licenses are consummated within the time period set forth in Section 5.3, in which case the option period under Section 5.1.2 shall begin, to the extent that rights remain available for licensing with respect to the subject REMADE IP, on the date upon which the consummation of the last of the one or more licenses is communicated, or (b) no license is consummated within the time period set forth in Section 5.3, in which case the option period under Section 5.1.2 shall begin on the date upon which the unconsummated negotiation of all licenses is communicated. If one or more Members exercise an option under Section 5.1.2, then the initiation of the option period under Section 5.1.3 shall be tolled until either: (a) one or more licenses are consummated within the time period set forth in Section 5.3, in which case the option period under Section 5.1.3 shall begin, to the extent that rights remain available for licensing with respect to the subject REMADE IP, on the date upon which the consummation of the last of the one or more licenses is communicated, or (b) no license is consummated within the time period set forth in Section 5.3, in which case the option period under Section 5.1.3 shall begin on the date upon which the unconsummated negotiation of all licenses is communicated.

52. Non-Exclusive License for Non-Commercial Internal Research and for Participation in REMADE Projects – Tier 1 and Tier 2 Members will be granted a non-exclusive royalty-free license to use either all REMADE IP or Project IP, for Non-commercial Internal Research, based on their membership tier level.
- 5.2.1. The owning Member(s) of any REMADE IP agree to grant to Tier 1 Members a non-exclusive royalty-free license to use such REMADE IP for Non-Commercial Internal Research, if such REMADE IP was created or developed during the requesting Member's Participation Period. If requested, any such license agreement shall be granted under a separate written license issued by the owning Member.
- 5.2.2. The owning Member(s) of any Project IP agree to grant to Tier 2 Members who were Participating Researchers in the affiliated REMADE Project, a non-exclusive royalty-free license to use such Project IP for Non-Commercial Internal Research, if such Project IP was created or developed during the requesting Member's Participation Period. If requested, any such license agreement shall be granted under a separate written license issued by the owning Member.
- 5.2.3. All REMADE Members shall grant a non-exclusive royalty-free license to their respective REMADE IP to each Member participating in a REMADE Project for the sole purpose of each such Member performing its obligations in the course of the REMADE Project.
53. All licenses will be negotiated in good faith between the Inventing Member and Members and in accordance with academic or industry standard terms and conditions as applicable within one hundred and twenty (120) days from Member's written notification to the owning Member(s) of its desire to enter into a license agreement. The right to continue to negotiate for a license in good faith will terminate at the end of the one hundred and twenty (120) day period unless extended by mutual written consent of the negotiating Parties. The license agreement may include royalty payments, field of use limitations, patenting cost reimbursements, sublicensing rights both to Members and non-REMADE Members (whereby any sublicensees remain subject to all relevant terms and conditions applicable to Member licensees of REMADE IP) and development and diligence obligations consistent with the ability of the Member to commercialize the REMADE IP.
54. Notwithstanding anything to the contrary in this Section 5, Inventing Member(s) retain the right to deny a Member licensee request if (a) disclosing such REMADE IP would (in an Inventing Member's sole discretion) require a license from a United States export control agency, and/or (b) disclosing the technical data related to such REMADE IP would violate the written internal regulatory compliance policies of such Inventing Member.
55. Members who elect to exercise their respective rights to receive a license for REMADE IP under Section 5.1 agree to identify all countries in which they desire Intellectual Property protection to owning Member(s) at the time of election. Such Members exercising the licensing options under Section 5.1 also agree to pay for the costs of preparation, filing, prosecution and maintenance of such Intellectual Property protection. If a Member elects not to pay for any Intellectual Property protection costs, the owning Member(s) shall have the right to: (i) abandon

some or all of such rights at their discretion, or (ii) incur those costs at their own expense; in either case, the owning Member(s) shall have the right to exclude such rights from the licenses granted. In such event, the owning Member(s) shall be free to license such rights to other members in accordance with this plan and finally to third parties.

5.6. All licenses granted to REMADE IP created with U.S. government funding are subject to overriding obligations to the United States Federal Government under 35 U.S.C. §§200-212 (Bayh-Dole Act); applicable regulations (including a non-exclusive, non-transferable, irrevocable, paid up license to practice or have practiced the REMADE IP for or on behalf of the United States Government throughout the world) and the commitments to U.S. manufacturing as set forth in the REMADE Institute U.S. Manufacturing Plan.

5.6.1. Class Patent Waiver: DOE has issued a class waiver that applies to the REMADE Institute. Under this class waiver, domestic large businesses may elect title to their subject inventions similar to the right provided to the domestic small businesses, educational institutions, and nonprofits by law. In order to avail itself of the class waiver, a domestic large business must agree that any products embodying or produced through the use of a subject invention first created or reduced to practice under REMADE will be substantially manufactured in the United States, as per the U.S. Manufacturing Plan.

5.7. Notwithstanding the grant of any licenses thereto, all Members retain the right on behalf of themselves to practice their respective REMADE IP for educational and non-commercial research purposes, including sponsored research and collaborations, the right to publish (subject to 4.6), and, subject to 5.6, Industry Members retain the right on behalf of themselves to practice their respective REMADE IP for any purpose.

5.8. Training Materials – Certain training materials (“Training Materials”) may be developed by or on behalf of REMADE and/or its Members in support of various REMADE programs and activities and through use of REMADE funding, including, without limitation, in connection with the Education and Workforce Development program. REMADE shall provide Members with a limited, non-exclusive, nonsublicensable, royalty-free, revocable license to access and use Training Materials, whether in print or electronic format, in performing such Members’ obligations under this Agreement. Subject to the foregoing license, REMADE or its Members who create each item of Training Materials shall own all right, title and interest in and to such Training Materials.

5.9. The REMADE Project Agreement specific to a particular REMADE Project may include additional terms and conditions applicable to REMADE IP, including, without limitation, a sharing with REMADE of a portion of the proceeds received by a Member through the licensing of REMADE IP.

6. GOVERNMENT RIGHTS

6.1. Consistent with the IP provisions of the DOE Award, the Government is provided certain rights regarding IP. Government IP provisions, Attachment 4 of the DOE Award (e.g., Government-purpose license, march-in rights), are located at <http://remadeinstitute.org/stc>

6.2. In addition, the Government may require delivery of Limited Rights Data in order to (a) monitor

technical progress and evaluate the potential of proposed technologies to reach specific technical and cost metrics, and (b) validate the results of REMADE Work.

7. DISTRIBUTION OF LICENSING REVENUE

Each Member will comply with its respective policies regarding the distribution of licensing revenue, subject to any agreement in an inter-institutional agreement if applicable.

8. REPORTING REMADE IP

- 8.1. On a quarterly basis during the Participation Period, Members shall provide to REMADE a report of technology transfer transactions, such as patent options, licenses and assignments involving REMADE IP.
- 8.2. On a quarterly basis, REMADE will make a full report on all technology transfer transactions to DOE.
- 8.3. In order to ensure that REMADE Members holding title to subject inventions are taking the appropriate steps to commercialize subject inventions, DOE requires that, upon request, each Member holding title to REMADE IP submit annual reports for 10 years from the date the REMADE IP was disclosed to DOE on the utilization of the REMADE IP and efforts made by Member or their licensees or assignees to stimulate such utilization. The reports must include information regarding the status of development, date of first commercial sale or use, gross royalties received by the Member, and such other data and information as DOE may specify.

9. CONFIDENTIALITY

- 9.1. Under the REMADE Institute, it will be essential for Members to exchange information. Disclosure and protection of any Confidential Information (as defined in the Non-Disclosure Agreement (NDA)) exchanged among the Members, including but not limited to Background IP, REMADE IP, and all other information disclosed by other Members, shall be subject to the terms and conditions of the NDA agreed by the Members.
- 9.2. Each Industry Member and Affiliate Member will maintain and enforce information and data privacy, export control and security procedures with respect to its access, use and storage of all REMADE IP that (a) are at least equal to industry standards taking into consideration the sensitivity of the relevant REMADE IP, and (b) provide reasonably appropriate administrative, technical, electronic and physical safeguards to protect against accidental or unlawful destruction, loss, alteration or unauthorized disclosure, access or use of REMADE IP.
- 9.3. Each Academic Member and DOE National Lab Member will maintain and enforce information and data privacy, export control and security procedures with respect to its access, use and storage of all REMADE IP with at least the same degree of care that such Academic Member or DOE National Lab Member employs to protect its own information of like kind.

10. DISPUTE RESOLUTION

Any dispute between Members relating to the management of REMADE IP, as provided for in this Intellectual Property Management Plan, or to the interpretation of this Plan, shall be referred to the Members' respective designated officers. Through the designated officers, Members agree to first attempt informal resolution of disputes, within a reasonable period of time and in a fair and equitable

manner, taking into consideration the objectives of REMADE and any laws, statutes, rules, regulations or guidelines to which the involved Members are subject.

11. CHANGE OF MEMBERSHIP

11.1. Addition of New Parties

The Members have agreed to or will separately agree to adhere to a Non-Disclosure Agreement (the "NDA"). New REMADE Members will sign the NDA in the form provided when they join REMADE, and sign this Intellectual Property Management Plan ("IP Management Plan"). Requiring every existing Member to re-sign the NDA and IP Management Plan every time a new Member is added to REMADE is cumbersome. Therefore, REMADE will facilitate the addition of new Members as follows: When a new party is proposed to be added as a Member, the REMADE Strategic Advisory Committee (SAC) will review the new member application. All SAC Members will make a good-faith effort to resolve any issues regarding the addition. In accordance with a vote by the SAC Members, the SAC Chair will make a recommendation to the Governance Committee to accept or reject the new member application. Approval of new Members will not be unreasonably withheld.

11.2. Member Termination/Withdrawal

Termination or withdrawal of membership will not relieve the Member of its non-disclosure and/or confidentiality obligations. The terminating/withdrawing Member will retain use of REMADE IP created or first reduced to practice during the Member's Participation Period, as set forth in this IP Management Plan. Terminating/withdrawing Member will have no further rights to REMADE IP developed subsequent to its departure. Termination/withdrawal of membership will not relieve a Member of its own obligations to make available to other Members any Project IP licensed during the terminating/withdrawing Member's Participation Period. Rights to IP licensed from or to the withdrawing Member will continue in accordance with existing licensing agreements. However, if the Member is terminated on grounds of breach of the Membership Agreement, terminated Member's IP rights will not continue unless set forth in a separate agreement.

12. RELATIONSHIP WITH THE INTELLECTUAL PROPERTY TERMS OF THE DOE AWARD

The DOE Award sets forth the treatment of and obligations related to intellectual property rights between DOE and REMADE, including the individual Members of REMADE. The Intellectual Property Management Plan of REMADE is an agreement between REMADE and its Members on how they will handle intellectual property rights and issues between the Members and REMADE.

In the event of a conflict between the DOE Award and the Intellectual Property Management Plan, the DOE Award takes precedence.

In order to elect and retain their rights, including ownership rights, in REMADE IP, Members are responsible for complying with the obligations of the DOE Award, the applicable terms of which are set forth in the Member Agreement.