

**APPENDIX A-\_\_**  
to  
**User Agreement No. NPUSR00xxxx**  
BETWEEN

**The Regents of the University of California**  
("CONTRACTOR")  
Facility Operator of Ernest Orlando Lawrence Berkeley National Laboratory ("Laboratory")  
under U.S. Department of Energy ("DOE") Contract No.DE-AC02-05CH11231

AND

**<Insert Legal Name of User Institution>**  
("USER")

Pursuant to the above identified User Agreement and subject to the terms and conditions stated therein, CONTRACTOR shall provide, furnish, or otherwise make available to duly authorized employees or representatives of the USER the following facilities, equipment, services, and/or materials:

**User Facility:**

**Joint Genome Institute ("JGI")**

**Scope of Work/Purpose/Proposal Description:**

This Appendix shall cover DNA Synthesis proposals for Work approved in accordance with JGI requirements. Upon approval by the JGI Project Manager, USER shall be permitted to submit sequencing data for synthesis by the CONTRACTOR related to the approved Work proposals.

**Period of Performance:**

Start date: CONTRACTOR execution date of this Appendix.

End date: term date of User Agreement

Unless otherwise approved by the JGI Project Manager, each approved proposal's Work shall be completed with 36 months from the date the proposal is approved by JGI.

**Patent Rights:**

This Patent Rights clause, which is binding on the Parties, shall cover DNA Synthesis proposals for Work approved in accordance with JGI requirements.

If research subject to this Agreement is performed by the USER under a federal agency grant or contract, then, to the extent that the patent rights provisions in the USER's grant or contract with a federal agency are inconsistent with the terms and conditions contained in this Article, the terms and conditions of the grant or contract shall apply.

**A. Definitions**

1. "Subject Invention" means any invention or discovery conceived or first actually reduced to practice in the course of or under this Agreement.
2. "USER Invention" means any Subject Invention of USER.
3. "CONTRACTOR Invention" means any Subject Invention of CONTRACTOR.

4. "Patent Counsel" means the DOE Counsel for Intellectual Property assisting the DOE Contracting activity.
- B. Subject Inventions
- CONTRACTOR and USER agree to disclose their Subject Inventions, which includes any inventions of their Participants, to each other, concurrent with reporting such Subject Inventions to DOE.
- C. CONTRACTOR's Rights
- Except as provided below in the case of joint inventions, CONTRACTOR Inventions will be governed by the provisions of CONTRACTOR'S Prime Contract for operation of the User Facility.
- D. USER's Rights
- Subject to the provisions herein, USER may elect title to any USER Invention and in any resulting patent secured by USER within one year of reporting the subject invention to DOE. The USER shall file a US patent application within a reasonable period of time. Where appropriate, the filing of patent applications by USER is subject to DOE security regulations and requirements.
- E. Joint Inventions
- For Subject Inventions conceived or first actually reduced to practice under this Agreement that are joint Subject Inventions made by CONTRACTOR and USER, each Party shall have the option to elect and retain title to its undivided rights in such joint Subject Inventions.
- F. Rights of Government
1. USER agrees to timely assign to the Government, if requested, the entire right, title, and interest in any country to each USER Invention where USER:
    - a. Does not elect to retain such rights; or
    - b. Fails to timely have a patent application filed in that country on the USER Invention or decides not to continue prosecution or not to pay the maintenance fees covering the Invention; or
    - c. At any time, no longer desires to retain title.
  2. USER shall provide the Government a copy of any application filed by USER promptly after such application is filed, including its serial number and filing date.
  3. USER hereby grants to the Government a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the USER Invention made under said project throughout the world.
  4. USER acknowledges that the DOE has certain March-in Rights to any USER Inventions elected by the USER in accordance with 48 C.F.R. 27.304-1(g) and that the USER is subject to the requirements with respect to preference for U.S. industry pursuant to 35 U.S.C. § 204 to any USER Inventions elected by the USER.
  5. The USER agrees to include, within the specification of any U.S. patent applications and any patent issuing thereon covering a USER Invention, the following statement: "The Government has rights in this invention pursuant to a User Agreement (specify number) between (USER name) and The Regents of the University of California, which manages and operates Ernest Orlando Lawrence Berkeley National Laboratory for the US Department of Energy."
  6. USER agrees to submit on request periodic reports to DOE no more frequently than annually on the utilization of USER Inventions or on efforts to obtain such utilization that are being made by USER or its licensees or assignees.

7. Facilities License: USER agrees to and does hereby grant to the Government a nonexclusive, nontransferable, irrevocable, paid-up license in and to any inventions or discoveries, regardless of when conceived or actually reduced to practice or acquired by USER, which are incorporated in the User Facility as a result of this Agreement to such an extent that the User 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 User Facility, and (2) to transfer such licenses with the transfer of that User Facility. The acceptance or exercise by the Government of the aforesaid rights and license shall not prevent the Government at any time from contesting the enforceability, validity or scope of, or title to, any rights or patents herein licensed.

G. Invention Report and Election

USER shall furnish the Patent Counsel a written report concerning each USER Invention within six months after conception or first actual reduction to practice, whichever occurs first. If USER wishes to elect title to the Invention, a notice of election should be submitted with the report or within one year of such date of reporting.

**FOR USER**

**FOR CONTRACTOR**

Sign: \_\_\_\_\_

Sign: \_\_\_\_\_

Name: \_\_\_\_\_  
(print/type)

Name: \_\_\_\_\_

Title: \_\_\_\_\_  
(print/type)

Title: \_\_\_\_\_

Date: \_\_\_\_\_

Date: \_\_\_\_\_

