

**NATIONAL OFFSHORE WIND RESEARCH AND DEVELOPMENT CONSORTIUM**

**INTELLECTUAL PROPERTY MANAGEMENT PLAN**

**Version 1.1**

## Preamble

The National Offshore Wind Research and Development Consortium (“Consortium”), an organization recognized as exempt from federal income taxation under Section 501(c)(3) of the Internal Revenue Code, was established to coordinate and promote strategies that facilitate and enhance the development and implementation of offshore wind power technology for the public purpose of increasing the performance and capability of the electric power supply and delivery system. With funding from the U.S. Department of Energy (DOE), the New York State Energy Research and Development Authority (NYSERDA) and other public and private sponsors, the Consortium supports scientific research in the public interest, including research and development activities that reduce the cost and risk of offshore wind development projects throughout the United States while supporting U.S.-based manufacturing and the offshore wind supply chain. Supporting and managing research and the generation and successful commercialization of intellectual property including inventions, discoveries, data sets, techniques, methods, best practices and other technical advancements is the Consortium’s primary means of achieving its goals.

This Intellectual Property Management Plan (“Plan”) sets out the basic guidelines on intellectual property (IP) rights for Consortium-funded research, and the sharing and transfer of such IP rights, applicable to the Consortium, its members, staff, project awardees and other interested parties including:

- University and independent research, testing and validation institutions
- Federally funded research and development centers (FFRDCs)
- Offshore wind project developers
- Resource assessment, environmental survey, geophysical and other site characterization providers
- Equipment manufacturers (OEMs)
- Service, maintenance and monitoring providers and supply chain
- Vessel, port and infrastructure operators and manufacturers
- New technology startups
- Investors, venture capital, licensing and other commercialization partners

The general purpose of this Plan is to address the protection and disposition of IP developed under competitive solicitations, grants and awards supported by the Consortium, within the framework of Federal intellectual property laws, regulations and policies. In addition, this Plan incorporates requirements that flow down from the U.S. Department of Energy office of Energy Efficiency and Renewable Energy (EERE) and New York State Energy Research and Development Authority (NYSERDA) award funding to the Consortium. **To the extent that this Plan may conflict in any way with the provisions of either the EERE or NYSEERDA award, in particular the intellectual property provisions therein, the EERE and NYSEERDA provisions shall take precedence.**

The objectives of this Plan include:

- Promoting the rapid commercialization of research results including patenting and licensing of Subject Inventions developed under Consortium grants and awards, and
- Promoting the rapid public dissemination of scientific data and information to help achieve the goals of the Consortium such as lowering overall costs, removing or reducing technological and

supply chain barriers to deployment, and lowering development risk for investors and developers.

## I. Definitions

This section defines key terminology used in the Plan, including but not limited to the following terms:

1. **“Award” and “Consortium Award”** refers to a grant of financial assistance from the Consortium to an entity or entities by means of a cooperative agreement, work authorization, Technology Investment Agreement, or other authorized financial assistance instrument, or any subaward or subcontract entered into thereunder.
2. **“Award Work”** means any work or activity performed by a Participant pursuant to and funded by a Consortium Award.
3. **“Background Technical Data”** means information, in hard copy or in electronic form, including, without limitation, documents, drawings, models, designs, data memoranda, tapes, records, and databases developed before or independent of performance under the Award that is necessary for the performance of Award Work.
4. **“Intellectual Property”** or **“IP”** means legally protectable technical information, Inventions, developments, discoveries, know-how, methods, techniques, formulae, algorithms, data, processes and other proprietary ideas (regardless of whether or not patentable or copyrightable). Intellectual Property also includes patent applications, patents, copyrights, trademarks, mask works, trade secrets, and any other legally protectable information, including computer software.
5. **“Invention”** means any discovery or a new or improved device, method, article of manufacture, composition of matter or process developed from study and experimentation that 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.).
6. **“Owner”** means a party, public or private, holding legal title to Intellectual Property, consistent with Federal laws and regulations.
7. **“Participant”** means an individual or entity who is a party to an Award.

8. **“Project Intellectual Property” or “Foreground IP”** mean and includes all Intellectual Property first conceived, discovered, developed, reduced to practice and/or generated in the performance of the Award, including all Intellectual Property embodied in a Subject Invention.
9. **“Project Team”** refers to a collective of Participants working in a collaborative manner to execute a Consortium funded project.
10. **“Project Technical Data”** means information (in hard copy or in electronic form) including, without limitation: documents, drawings, models, designs, data, memoranda, taps, records, and databases developed during the performance of Award Work.
11. **“Subject Invention”** means any Invention of a Participant that is conceived or first actually or conceptually reduced to practice in the performance of Award Work.
12. **“Protected Data”** is often referred to as “Confidential Information”. This includes project Technical Data or commercial or financial data first produced in the performance of the award which, if it had been obtained from and first produced by a non-federal party, would be a trade secret or commercial or financial information that is privileged or confidential under the meaning of 5 U.S.C. 552(b)(4) and which data is marked as being protected data by a party to the Award.
13. **“Background Intellectual Property” or “Background IP”** means Intellectual Property which was in existence prior to or is first produced outside of the Award, except that in the case of inventions, the inventions must have been conceived outside of the Award and not first actually or conceptually reduced to practice under the Award to qualify as Background Intellectual Property.

## II. Treatment of Protected Data

Sharing of information between participants, Consortium members and staff is essential for the success of the team. Some of this information may be Protected Data; it is important that all team members understand how and under what provisions confidential information may be shared.

Project teams making proposals for Consortium funding should carefully consider whether confidential information should be provided as part of the proposal. Criteria for this consideration should include whether the information is critical for evaluating the proposal, or whether general, non-confidential information may be adequate.

Information generated in the course of Consortium award work, unless explicitly identified as Protected Data, may be freely disclosed by the Consortium in whole or in part, in any manner and for any purpose.

No information will be treated as Protected Data by the Consortium unless such information is clearly so marked by the Project Team at the time it is disclosed. All parties including Project Teams, Consortium staff and members shall ensure that all such Protected Data is not disclosed to outside parties, including other Project Teams who may be executing other Award Work for the Consortium. Contracts governing Award Work will include appropriate terms requiring adherence to this principle, and parties may enter into additional non-disclosure agreements (NDAs) as needed to ensure that Protected Data may be shared appropriately for the benefit of the Project Team and the Consortium.

Information in Project Awards funded by public entities such as EERE and NYSERDA are subject to federal and state Freedom of Information Acts ("FOIA") which may require the public entity to make available to the public, on request, records and information they possess unless that information is statutorily exempt from disclosure. FOIA laws generally provide that access to records may be denied if they are trade secrets or are submitted to an agency by a commercial enterprise or derived from information obtained from a commercial enterprise and which if disclosed would cause substantial injury to the competitive position of the subject enterprise. However, public entities such as EERE and NYSERDA cannot guarantee the confidentiality of any information submitted.

### III. Background IP

Participants engaging in Award Work must identify any Background IP which may be used in performance of an Award to other Project Team members as well as Consortium members and staff. Each Participant may use the other Participant's identified Background IP solely in performance of work under an Award. This Plan, however, does not grant to any Participant any option, grant, or license to commercialize, or otherwise use the other Participant's Background Intellectual Property for purposes other than to perform Award Work. Licensing of Background Intellectual Property, if agreed to by the Participants of an Award, shall be the subject of separate licensing agreements between the Participants.

To facilitate collaboration, Participants may wish to share Background Technical Data and Project Technical Data. Project Teams may establish parameters for the use of Participants' Limited Rights Data and Protected Data, subject to the terms and conditions of the Consortium Award.

Requirements covering Background IP use as well as identification of specific Background IP and how they are to be used by other parties will be detailed in the Awards.

### IV. Foreground IP—Inventions, Data and other Project IP

Each Participant shall retain title to Subject Inventions and other Project IP developed solely by its employees and agents in the course of Award Work. Unless agreed otherwise, the Participant filing a patent application shall pay all preparation and filing expenses, prosecution fees, issuance fees, post issuance fees, patent maintenance fees, annuities, interference expenses, and attorneys' fees for that patent application and any resulting patent(s).

Participants shall be joint Owners of Project Intellectual Property that is developed jointly by those Participants. Each Owner shall have an undivided interest in the jointly owned Project Intellectual Property. The jointly developed Project Intellectual Property shall be protected with joint patent applications in which the joint Owners are co-applicants and/or each an assignee.

Notwithstanding the foregoing, some Award Work may be contracted with Participants for the express reason of obtaining data, inventions, or other intellectual property for use by the Consortium, its members and staff, or for public dissemination. In these cases the Award contract shall clearly state the ownership and expected uses of IP that will be generated in the course of any such Award Work contracted by the Participants.

## V. Intellectual Property Licensing, Commercialization and Technology Transfer

One of the Consortium's most important functions is to accelerate the adoption of new technology for the benefit of the U.S. offshore wind market, electricity ratepayers, innovation infrastructure, and supply chain. Therefore, project Participants are required to use commercially reasonable efforts to commercialize and/or grant licenses for any Intellectual Property they develop under a Consortium Award. The Consortium's advisor groups, especially the Tech to Market (TTM) and Manufacturing, Service and Supply Chain Council (MSSC) groups, are specifically chartered to provide ready commercialization paths and opportunities for licensing by IP generators.

If a Participant is granted an exclusive license to use a Subject Invention, then Participant shall be responsible for all expenses and fees, past and future, in connection with the preparation, filing, prosecution, and maintenance of any patent applications and patents claiming exclusively-licensed Subject Inventions. If such Participant is granted a non-exclusive license, then the Participant shall be responsible for a pro-rated share, divided equally among all licensees existing as of the effective date of the license, of expenses and fees for the non-exclusively licensed Subject Inventions.

Unless otherwise agreed, Participants who retain title to Project Intellectual Property may grant exclusive and non-exclusive licenses for use of technologies arising out of the Project Intellectual Property. Unless otherwise agreed, Joint Owners of Project Intellectual Property shall act in concert in licensing the Project Intellectual Property with all parties giving consent to all licenses, and shall share equally in paying licensing expenses, and any benefits from licensing (i.e. royalties and equity) received shall be distributed equally between joint Owners. Any such license that an Owner may grant shall be subject to a reservation of certain rights to the Federal Government under the provisions of 35 U.S.C. § 201 et seq, which include march-in rights and U.S. Competitiveness.

Any licensing of Project Intellectual Property shall be conducted pursuant to and in accordance with the terms of the Award under which the Project Intellectual Property was developed. Licensing of Project Intellectual Property shall not inhibit performance of Award Work.

A party retaining rights to intellectual property should consider reserving the option to permit private or public educational institutions to use the Project Intellectual Property on a royalty-free basis for research and education, but not for commercial purposes, subject to confidentiality requirements. The Consortium may favor applicants committing to the foregoing in making its Award decisions.

Certain Award Work may be directly funded, independently of DOE or NYSERDA funding, by parties, for example one or more Consortium members, with an interest in using Subject Inventions for commercial purposes. Participants may agree that the funding parties shall be granted exclusive rights to use Subject Inventions or other Project IP for a limited time before

such IP can be licensed to other parties, or provide other mutually agreeable consideration. This term of exclusive use shall not exceed five years.

## VI. Government Rights

Notwithstanding Section V., public sponsors of Consortium research such as EERE and NYSERDA may also hold certain Government rights in Subject Inventions. These Government rights will be detailed in the Award contract, and by incorporation of such documents as the U.S. DOE Model Cooperative Agreement. For reference, these provisions are generally that:

- with respect to any Subject Invention in which the Participant retains title, the Government shall have a non-exclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the U.S. the Subject Invention throughout the world
- any patents filed related to Award work must be fully disclosed to the public funding authority within a certain period of time, typically thirty (30) days, and with appropriate notices of funding source included in the patent application
- Participant must disclose Subject Inventions to the Government within two (2) months from when the Subject Invention is disclosed internally.
- The U.S. Government may, if a Subject Invention is not disclosed to the Government as required, if title is not elected as required, if a U.S. Manufacturing Plan submitted to the Government is breached, or if patent applications are not filed within a certain time in a particular country, have the right to obtain title to subject inventions and file patent applications in U.S. or other jurisdictions.
- Subject inventions and products produced using the subject inventions must be manufactured within the United States. This requirement may be waived by the U.S. DOE if the Participant or its licensee shows that reasonable efforts have been made to license the IP to U.S. manufacturers, or that domestic manufacture is not commercially feasible.

In addition, as a sub-recipient of a government award Participants will be required to submit certain reports as detailed in the EERE Model Cooperative Agreement and in other documents incorporated to the Award contract. Examples include the requirements of the Intellectual Property Reporting Form (EERE357) and the Invention Utilization Report (EERE356), which should be disclosed and reported in the online iEdison system (<https://public.era.nih.gov/iedison>).

## VII. Publication and Dissemination

The Consortium is engaged in scientific research in the public interest within the meaning of Section 501(c)(3) of the Internal Revenue Code and, as such, the publication of the results of Consortium supported research is required. Discoveries, data, and other non-commercial intellectual property other than Protected Data generated as a result of Award Work shall be freely disseminated for the use of the U.S. offshore wind industry and the education of the interested public. It is understood that progress reports, final reports, data sets and other work products generated in the course of Award work may be made publicly available by the Consortium in whole or in part, unless specifically identified to contain Protected Data or other confidential or commercially sensitive information. In cases where the Award work product does contain such information, the Participant may be required to provide a redacted version suitable for publication. Publication may be reasonably delayed when necessary for specific purposes, such as during preparation of a patent filing.

Useful data generated under Consortium contract awards approved for public disclosure, e.g. site assessments and surveys, geophysical data, offshore wind equipment and substructure reliability data, etc., may be stored and disseminated in accordance with the Consortium's Data Management Plan.

Participants are encouraged to publish their findings and present results at Consortium-sponsored conferences and symposia, as well as at other industry conferences and other meetings where researchers and stakeholders would benefit. Participants shall notify the appropriate Consortium project management authority in sufficient advance to allow for appropriate pre-publication review, to ensure consistency with Consortium and sponsor requirements as well as to prevent inadvertent disclosure of any team member's Protected Data or other proprietary information.

## VIII. Change of Project Team Participants

New Participants in any Project Team shall, on joining such Project Team and upon executing any required NDAs or other instruments or agreements, have the same rights to Award background and foreground IP as existing members of that Project Team, as necessary to execute the Award Work. This may include the right to obtain a license to subject IP. In cases where the right to a license is in consideration of project sponsorship, the new member will be required to "buy in" to the project on similar terms to the other sponsors. Existing sponsors as well as the Award Participants may reserve the right to approve or disapprove such additional sponsor/licensees.

Participants who leave a Project Team may be required to forfeit IP rights obtained by virtue of Project Team membership, for example exclusive licenses to patents and other IP generated in the course of Award Work. Non-disclosure and other confidentiality agreements executed by the Consortium, its staff and Participants shall be constructed to remain in force for an appropriate period of time following a party's departure to prevent disclosure of commercially sensitive information.

## IX. Dispute Resolution

Any dispute between Participants relating to the management of Award IP, as provided for in this Plan, or to the interpretation of this Plan, shall be referred to the Participants' respective officers, as designated in the Award contract. Through the designated officers, Participants' 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 the Award and any laws, statutes, rules, regulations or guidelines to which the involved Participants are subject.

If the designated officers are unable to resolve the issues presented before them, and if the dispute cannot be settled through negotiation, the Participants agree first to try in good faith to settle the dispute by mediation administered by the American Arbitration Association under its Commercial Mediation Procedures before resorting to arbitration, litigation, or some other dispute resolution. If within 30 days after service of a written demand for mediation, the mediation does not result in settlement of the dispute, then any unresolved issues shall be settled by arbitration administered by the American Arbitration Association in accordance with its Commercial Arbitration Rules, and judgment on the award rendered by the arbitrator(s) may be entered in any court having jurisdiction thereof.