

**Critical Materials Institute
Affiliates Program
MEMBER AGREEMENT
("Agreement")**

WHEREAS, The Ames Laboratory ("AMES"), a U.S. Department of Energy ("DOE") National Laboratory operated by Iowa State University of Science and Technology ("ISU") under the authority of its Contract DE-AC02-07CH11358, with administrative offices at 311 TASF, Ames, IA 50011-3020, is the recipient of funding from the U.S. Department of Energy's Office of Energy Efficiency and Renewable Energy ("EERE") to establish the Critical Materials Institute ("CMI") and WHEREAS ISU is a Team Member within the CMI for the purpose of eliminating materials criticality as an impediment to the commercialization of clean energy technologies;

AND WHEREAS, ISU acting as a Team Member is the administrator of the CMI Affiliates Fund, and WHEREAS ("Affiliate") desires to participate in the CMI Affiliates Program;

This Agreement is entered into ("Effective Date") by ISU and Affiliate. ISU and Affiliate are the "Parties" and ISU and Affiliate are each a "Party".

NOW, THEREFORE, ISU and Affiliate hereby agree to the following terms and conditions:

1. Definitions

Advisory Board serves to advise on the scientific focus areas of CMI, review project plans, and assess scientific quality and monitor progress by CMI toward goals.

Affiliates are members of the Affiliates Program who have paid an annual membership fee and signed the Agreement. There are two levels of Affiliates—Full and Observing.

Affiliates Fund is a fund consisting of membership fees paid by both Full and Observing Members.

Affiliates Fund Full Member is an Affiliate who signs the CMI Affiliates Program Member Agreement and pays the appropriate annual Full Member fee based on Article 3.2. Foreign entities are not eligible to join as Full Members.

Affiliates Fund Intellectual Property means technical information, inventions, developments, discoveries, methods, techniques, formulae, algorithms, data,

processes and other proprietary ideas, whether or not patentable or copyrightable, patent applications, patents copyrights trademarks, mask works, and other legally protectable information including computer software. Trade secrets are excluded from the definition.

Affiliates Fund Observing Member is an Affiliate who signs the CMI Affiliates Program Member Agreement and pays the annual Observing Member fee based on Article 3.3.

Affiliates Fund Subject Invention means any invention conceived or first actually reduced to practice by an Affiliate and/or a Team Member in the performance of a project funded by the Affiliates Fund.

Affiliates Program consists of a group of entities who have signed the Agreement and paid an annual membership fee as defined in Article 3. These entities are known as Affiliates (Full and Observing) and are interested in CMI outcomes or working with CMI on a consistent basis.

Confidential Information means information that is developed at private expense outside an Award, is marked as Confidential Information, and embodies (i) trade secrets or (ii) technical, commercial, or financial information which is privileged or confidential under the Freedom of Information Act (5 U.S.C. 552 (b)(4)).

CMI Award means the U.S. Department of Energy (DOE) funding award for the CMI that was to perform work under Work Authorization Number IF-480012-13, Agreement Number 26110-AMES-CMI and any and all fully executed Contracts between the Team Lead or DOE and a Team Member to perform Award Work.

Disclosing Party means, with respect to a particular item of Confidential Information, the Party that owns and/or is in rightful possession of the Confidential Information, originally provided it to the Receiving Party or made it available to the Receiving Party by way of inspection, intentionally, inadvertently or otherwise.

Disclosure Period means the period during which all disclosures subject to this Agreement will be made which ends on March 13, 2019, unless extended by mutual agreement.

Foreign Entity means 1) A foreign government or foreign government agency; 2) Any form of business enterprise organized under the laws of any country other than the United States or its possessions; 3) Any form of business enterprise organized or incorporated under the laws of the United States, or a State or other jurisdiction within the United States, which is owned, controlled, or influenced by a foreign

government, agency, firm, corporation or person; or 4) Any person who is not a U.S. citizen.

Receiving Party means the Party to whom the Disclosing Party provided or otherwise made available Confidential Information, and it includes any officer, employee, consultant, subcontractor, agent or other representative of the Party.

TEAM or Team Member is an entity with direct participation in the CMI research funded by EERE.

Team Lead is the Ames Laboratory.

2. CMI

- 2.1 The CMI is implemented, managed, and administered by designated staff at AMES. At the discretion of the CMI Director, any organization may become a member of the CMI's Affiliates Program. Additional members may be added at any time.
- 2.2 The CMI has established an Industry Council ("IC") composed of one representative from each Team Member and two or more representatives selected from the CMI's Affiliates Program Full Members. The function of the IC is to provide advice to the CMI consistent with the goals and objectives provided by EERE, including guidance on strategic direction, research activities, education programs and technology transfer efforts. The meeting logistics and other operating procedures of the IC shall be determined outside of this Agreement.

3. Affiliates Program Membership

- 3.1 There are two levels of Affiliates—Full and Observing.
- 3.2 The **Full Member** will provide a non-refundable membership payment (U.S.\$) in accordance with the following schedule:
 - 3.2.1 \$1,000 annually for a Start-up company that has been incorporated for less than 5 years and has not completed an IPO, or
 - 3.2.2 \$6,000 annually for a Government, University, or Not-for-Profit Entity, or
 - 3.2.3 \$6,000 annually for a non-Start-up company with less than 500 employees, or
 - 3.2.4 \$36,000 annually for a non-Start-up company with greater than or equal to 500 employees.
- 3.3 The **Observing Member** will provide a non-refundable membership payment (U.S.\$) in accordance with the following schedule:
 - 3.3.1 \$500 annually for a Start-up company that has been incorporated for less than 5 years and has not completed an IPO, or
 - 3.3.2 \$3,000 annually for a Government, University, or Not-for-Profit Entity, or

- 3.3.3 \$3,000 annually for a non-Start-up company with < 500 employees, or
- 3.3.4 \$18,000 annually for a non-Start-up company with ≥ to 500 employees.

- 3.4 An Association who is an Affiliate does not transfer the rights given under this Agreement to its membership.
- 3.5 Payment shall be made within thirty (30) days after the execution of this Agreement. This Agreement shall be the invoice for the first year membership payment. Affiliate shall be invoiced on or about the Effective Date each year thereafter. Payment is due within thirty days (30) of Effective Date of each subsequent year or receipt of invoice by ISU, whichever is later. Affiliate status shall expire if renewal payment(s) is not made in accordance with this Article 3.

- 3.6 Payment shall be sent by Affiliate to:

Affiliates Fund Membership Coordinator
Ames Laboratory
311 TASF
Ames, IA 50014-3020
515-294-5932

Payment payable to Iowa State University (“CMI Affiliates Membership” in memo).

- 3.7 An Affiliate shall be entitled to the rights expressly set forth in this Agreement.
- 3.8 An Affiliate may terminate the Agreement by giving thirty (30) days written notice of such termination. Payments paid or accrued prior to termination will not be refunded.

4. Full Member Benefits and Responsibilities

- 4.1 Benefits and responsibilities that accrue to the Full Member are:
 - 4.1.1 Input into selection of research projects funded from the Affiliates Fund.
 - 4.1.2 Representation on the IC, as selected. If selected, Full Member has right to decline.
 - 4.1.3 Invitation to attend the CMI Annual Meeting.
 - 4.1.4 Access to CMI researchers, graduate students, expertise and unique capabilities.
 - 4.1.5 CMI newsletters.
 - 4.1.6 Priority notification of CMI Award inventions available for licensing.¹
 - 4.1.7 Option to request R&D and Commercial licenses to Affiliates Fund Intellectual

¹ Due to Fairness of Opportunity requirements, notification of CMI Award inventions available for licensing will be made through the usual channels but, by engaging with the CMI on a regular basis, Affiliates may be more likely to hear about CMI Award inventions available for licensing before the general public.

Property as defined in 4.3, 4.4, and 4.5 of this Agreement.

4.1.8 To serve as a mentor on Affiliates Fund research projects related to the Full Member's needs.

4.2 Subject to the terms and conditions of this Agreement, Full Member shall have the right to request and receive a three-month option to a non-exclusive internal research & development use license to Affiliates Fund Subject Inventions that are specifically related to the company's deployment needs. Such license shall not include the right to make, use, or sell products or processes for commercial purposes or to sublicense.

4.3 Full Member shall also have the right to request and receive a six month option where the six months begins at disclosure of the Affiliates Fund Subject Invention to Full Member by ISU, to negotiate a commercial license to Affiliates' Fund Subject Inventions that are specifically related to the Full Member's commercial needs. If more than one Full Member of the CMI Affiliate's Program requests a license within the same field of use, only a fee and/or royalty bearing, non-exclusive license shall be available for that field. After the six months option period has elapsed, if only one Full Member desires a license in a field of use, such Full Member shall have the right to negotiate for a fee and/or royalty bearing exclusive license in such field of use. Such licenses shall be consistent with industry standards and the objectives and mission of the CMI. The technology will not be licensed outside of the Parties for a period of six months after disclosure of the Affiliates Fund Subject Invention to Full Member by ISU. The Parties understand that they may not be able to negotiate mutually acceptable terms for a license and the negotiation term specified herein may expire without an acceptable license agreement to execute.

4.4 If a Foreign Entity requests an exclusive license in a field of use after the six month option period ends and no other member requests a license within that same field, such license may only be granted with prior approval from DOE.

4.5 At the end of such period of six months, the Parties shall have the right to grant licenses to an Observing Member(s) and/or third party(s). For any licenses granted to an Observing Member or third party(s), the Parties shall make reasonable efforts in good faith to ensure that the terms and conditions of such licenses shall be on terms no more favorable than terms and conditions offered to Full Members for similar licenses.

5. Observing Member Benefits and Responsibilities

5.1 Benefits and responsibilities that accrue to the Observing Member are:

5.1.1 Invitation to attend the CMI Annual Meeting.

- 5.1.2 Access to CMI researchers, graduate students, expertise and unique capabilities.
- 5.1.3 CMI newsletters.
- 5.1.4 Priority notification of CMI Award inventions available for licensing.²

6. **Licensing and IP Rights**

- 6.1 The granting of fee and/or royalty bearing licenses to an Affiliate(s) herein shall be subject to any third party rights or restrictions and to the payment of patent costs by an Affiliate(s). Licensing Affiliate(s) shall pay to the institution prosecuting the relevant Affiliates Fund Subject Invention(s) its proportional share, divided equitably among licensees, of patent costs of the Affiliates Fund Subject Invention(s) for which an Affiliate(s) has elected to take a license.
- 6.2 All Affiliates Fund Intellectual Property created by an investigator(s) of the Parties under Affiliates Fund projects will be in accordance to the DOE Work for Others (WFO) Class Patent Waiver and corresponding Master WFO agreement for work to be performed by the CMI with affiliate funds. Foreign Entities may or may not be eligible for the DOE Patent Class Waiver dependent on DOE approval.

7. **Publishing**

The Parties acknowledge and agree that the goals of the CMI may be met by both public disclosure of results of CMI Affiliates Fund projects and by protection of patentable subject matter arising or resulting from CMI Affiliates Fund projects. The Parties agree to secure internal pre-publication review and, if appropriate, provide all authors performing work on the publication content, an opportunity for review and comment. The publishing Party also agrees to submit the publication for review to the CMI Director at CMIpubreview@ameslab.gov. The Parties, authors and CMI Director shall have up to 45 days, from notification, in which to provide publishing Party with comments. If comments have been received, the publishing Party will consider and remedy such comments in good faith and is afterwards free to publish. Remedies may include, but are not limited to, exclusion of proprietary data or Confidential Information if academic integrity is not affected, delay of publication until proper intellectual property protection is in place, and the delay of a thesis or dissertation for not more than six months to be able to protect the proprietary interests. Parties and authors may suggest modifications, but cannot restrict the publication/presentation of the research results. The authors shall be acknowledged in accordance with customary scientific practice.

² Due to Fairness of Opportunity requirements, notification of CMI Award inventions available for licensing will be made through the usual channels but, by engaging with the CMI on a regular basis, Affiliates may be more likely to hear about CMI Award inventions available for licensing before the general public.

8. Confidentiality

- 8.1** The Receiving Party shall maintain the Confidential Information in confidence, to prevent the unauthorized disclosure of Confidential Information by using no less than the same degree of care that the Receiving Party uses to protect its own information of similar nature.
- 8.2** The Receiving Party shall restrict access to Confidential Information to those employees of the Receiving Party's organization that require access to such Confidential Information in order to accomplish the purposes of this Agreement, and only disclose information to those employees if there is a clear understanding by such employees of the obligation to maintain such Confidential Information in confidence and to refrain from making any unauthorized use or disclosure of such Confidential Information. The Parties also agree to disclose the Disclosing Party's Confidential Information only to parties who are contractually obligated to receive and protect Confidential Information.
- 8.3** Each Party agrees that it will not directly nor indirectly use, disclose or otherwise employ all or any portion of the Disclosing Party's Confidential Information except in furtherance of the business relationship contemplated by this Agreement or as otherwise authorized by the Disclosing Party.
- 8.4** The obligations of this Agreement shall not prevent the Receiving Party from using or disclosing any Confidential Information which:
- 8.4.1** at the time of the disclosure is in the public domain;
 - 8.4.2** after disclosure becomes part of the public domain through no fault of the Receiving Party;
 - 8.4.3** the Receiving Party can demonstrate was in its possession prior to the time of disclosure hereunder;
 - 8.4.4** after disclosure hereunder is lawfully acquired by the Receiving Party from a third party, who insofar as the Receiving Party was aware, has no obligation to the Disclosing Party not to disclose such Confidential Information; or
 - 8.4.5** is independently developed by the Receiving Party without access to the Disclosing Party's Confidential Information.
- 8.5** In the event that the Receiving Party is required by judicial or governmental administrative process to disclose any Confidential Information of the Disclosing Party, the Receiving Party shall promptly notify the Disclosing Party so that the Disclosing Party may seek appropriate means to protect the proprietary nature of its Confidential Information. In absence of such means, if the Receiving Party is compelled to disclose such Confidential Information, the Receiving Party may disclose only the Confidential Information that is required by judicial or

governmental administrative process without liability hereunder.

- 8.6 Upon request and expense of the Disclosing Party, the Receiving Party will forward to the Disclosing Party all extant writings or other tangible forms of Confidential Information received from the Disclosing Party, except that the Receiving Party may retain one copy of written Confidential Information for record purposes only.
- 8.7 Neither the execution of this Agreement, nor the disclosure of any Confidential Information hereunder, shall be construed, implicitly or otherwise, as granting Receiving Party a right or license to use the Confidential Information, or any right to ownership, with respect to the Confidential Information now or hereafter owned or controlled by the Disclosing Party.
- 8.8 Disclosure of Export Controlled Technical Data: The Parties do not anticipate the need to disclose to each other technical data that are subject to control under the Export Administration Regulations or other Regulatory Agencies (collectively, "Regulations"). The Parties acknowledge that there is a strong likelihood that staff involved in fulfilling this Agreement may qualify as foreign persons under the Regulations and, as a result, will have a duty to cooperate with the other Parties in assuring compliance with the regulations and identifying such information in advance. Any party may have the right to refuse to accept Regulated Information.
- 8.9 Termination of this agreement shall not affect the rights and obligations described in the Agreement with respect to Confidential Information provided or made available prior to termination, and such rights and obligations will remain in effect for 5 (five) years after termination of this Agreement.

9. Use of Names

Except as required by law, no party shall use the name, logos, marks, emblems and designs ("Mark") of the other Party, Affiliates, or Team Members in any publicity or advertisement, whether with respect to this Agreement or any other related matter, without the prior written approval of an authorized representative of the owner of the Mark. Acknowledgement of funding or participation in the CMI Affiliates Program in a factual statement shall not be considered to be publicity or an advertisement and shall not be restricted by this requirement.

10. Notices

Any notices required or permitted to be given hereunder will be in English and will be in writing delivered by first class mail, facsimile, or email to the following:

Iowa State University

Industry Contracts
Office of Intellectual Property and Technology Transfer
310 Lab of Mechanics
Ames, IA 50011-2131
Tel: 515-294-4740; Email: industry-contracts@iastate.edu

with a copy to:

The Ames Laboratory
CMI Affiliates Program
311 TASF
Ames, IA 50011-3020
Tel: 515-294-5932; Email: CMIaffiliates@ameslab.gov

11. Independent Parties

For purposes of this Agreement, the Parties shall be independent contractors, and none shall at any time be considered an agent or an employee of the other.

12. Indemnification

Affiliate shall indemnify, defend and hold the other Party, other Affiliates, Team Members, the Ames National Laboratory, and the United States Government, including each of their trustees, officers, directors, employees, students, affiliates, inventors, and authors, harmless against any and all claims, proceedings, demands, liabilities, and expenses, including legal expenses and reasonable attorneys fees, arising out of the death of or injury to any person or persons or out of any damage to property and against any other claim, proceeding, demand, expense and liability of any kind resulting from Affiliate's activities under this Agreement, use of results of this Agreement, and/or the production, manufacture, sale, use, lease, consumption or advertisement of products of Affiliate and/or its associates arising from any license right of Affiliate hereunder.

13. Entire Agreement

This Agreement sets forth the entire understanding among the Parties with respect to the subject matter hereto and supersedes all previous agreements written or otherwise. This Agreement may be amended only in writing by an authorized signatory on behalf of the Parties.

14. Signatures

This Agreement may be executed in any number of counterparts, including facsimile or scanned PDF documents. Each such counterpart, facsimile or scanned PDF document shall be deemed an original instrument, and all of which, together, shall constitute one and the same executed Agreement.

