

**INTELLECTUAL PROPERTY MANAGEMENT PLAN (IPMP)
FOR THE
UNIVERSAL INTEROPERABILITY FOR GRID-FORMING INVERTERS (UNIFI) CONSORTIUM**

The principal goals of this Intellectual Property (IP) Management Plan are to (i) clarify IP rights, contributions, and obligations among UNIFI Consortium Members, and (ii) provide pathways to effectively commercialize technologies using IP developed by the Members.

1. DEFINITIONS

- 1.1 **Computer Software** or **Software** is defined as (i) computer programs that comprise a series of instructions, rules, routines, or statements, regardless of the media in which recorded, that allow or cause a computer to perform a specific operation or series of operations; and (ii) recorded information comprising source code listings, design details, algorithms, processes, flow charts, formulas, and related material, including manuals and instructional materials, that would enable the computer program to be produced, created, or compiled.
- 1.2 **Core Stack IP** is defined as UNIFI IP and/or Pre-existing IP that is designated as such through the process described in Section 3.
- 1.3 **Federally Funded Work** is defined as any UNIFI Work performed by a Member that is pursuant to and funded by an award under DOE Funding Opportunity Number DE-FOA-0002437. For clarity, this includes any work, research, or activity using such federal funding or using any cost share funding contractually provided by Members during the Participation Period.
- 1.4 **Federally Funded UNIFI IP** is defined as UNIFI IP conceived of, first actually reduced to practice, or authored in the performance of Federally Funded Work.
- 1.5 **Intellectual Property (IP)** is defined as legally protectable technical information, Inventions (defined below), developments, discoveries, methods, techniques, formulae, algorithms, data, processes, patent applications, patents, copyrights, trademarks, mask works, and other proprietary ideas (whether or not patentable or copyrightable), and any other legally protectable information, including Computer Software.
- 1.6 **Inter-Institutional Agreement (IIA)** is an agreement between 2 or more joint owners of UNIFI IP that describes how the IP is to be managed.
- 1.7 **Invention** is defined as any discovery or a new device, method, or process developed from study and/or 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.).

- 1.8 **Member** is defined in the UNIFI Consortium Bylaws.
- 1.9 **Owner** is defined as a party, public or private, holding legal title to Intellectual Property, consistent with applicable laws and regulations.
- 1.10 **Participation Period** is defined as the period of time during which a Member is part of the UNIFI Consortium.
- 1.11 **Participating Researcher** is defined as any employee or agent of a Member who performs UNIFI work.
- 1.12 **Pre-existing IP** is defined as Intellectual Property of which a Member is an Owner that was in existence prior to or first produced outside of UNIFI Work, except that, in the case of inventions, the Intellectual Property must have been both conceived outside of UNIFI Work and not first reduced to practice through UNIFI Work.
- 1.13 **Technology Transfer Office (TTO)** is defined as an organization, such as a non-profit organization or a foundation, or a division or department of a Member entity that engages in transferring technology on behalf of the Member.
- 1.14 **UNIFI IP** is defined as all Intellectual Property conceived of, first actually reduced to practice, or authored in the performance of UNIFI Work as well as other Intellectual Property created by UNIFI Consortium Members in the performance of UNIFI Work (e.g., code, algorithms, etc.). Copyright in scientific and technical articles published in academic, technical or professional journals, symposia proceedings or similar works is specifically excluded from "UNIFI IP". UNIFI IP can be either Federally Funded or Member funded.
- 1.15 **UNIFI IP Working Group** is defined in the UNIFI Bylaws.
- 1.16 **UNIFI Leadership Team** is defined in the UNIFI Bylaws.
- 1.17 **UNIFI Work** is defined as any work, research, or activity performed by a Member using funding received from or contractually directed by the Consortium during the Participation Period (defined above).
- 1.18 **Universal Interoperability for Grid-Forming Inverters ("UNIFI") Consortium** is a forum to address fundamental challenges in the seamless integration of grid-forming (GFM) technologies into power systems. Membership in the UNIFI Consortium is described in the UNIFI Bylaws.

2. UNIFI IP OWNERSHIP AND USE

- 2.1 To the extent that this Agreement may conflict in any way with the provisions of any funding agreement (including award agreements, financial assistance agreements, work authorizations, and sub-tier agreements thereunder) resulting from DOE Funding Opportunity Number DE-FOA-0002437, the provisions of such funding agreement shall take precedence.
- 2.2 Intellectual Property created by employees of DOE National Laboratories will be subject to their respective Management and Operating (M&O) contract for each DOE lab, which includes terms and conditions with respect to ownership of Inventions made by its employees. The M&O contract generally provides that the laboratory contractor has the right to elect to retain title to Inventions made by its employees. The M&O contract also provides that the laboratory contractor may assert copyright in Computer Software made by its employees, upon receipt of authorization from the DOE to do so.
- 2.3 Inventorship and authorship of UNIFI IP will be determined in accordance with applicable intellectual property laws, including patent and copyright law of Member countries. Subject to the terms of the applicable funding agreement or award, each Member shall own any UNIFI IP invented, authored, or created by such Member's Participating Researchers. Members must ensure they have the right IP assignments in place with their Participating Researchers.
- 2.4 Ownership of Pre-existing IP shall remain unchanged by this IPMP, and nothing herein shall be construed to transfer or change title in or to Pre-existing IP. Prior to initiating participation in any work on the Federally Funded UNIFI Work, Members shall make reasonable efforts to declare in writing and share with other Members involved in such UNIFI Work, any Pre-existing IP of which the Member is an Owner and which the Member reasonably believes to be necessary to perform the UNIFI Work. Declared patentable and patented subject matter should include filing dates of any patent applications filed, serial numbers of such patent applications, and patent offices in which such applications were filed. Listed copyrightable subject matter should include a description of subject matter, corresponding copyright registration numbers, and offices with which such copyright was registered. The Member should periodically update this declaration when additional Pre-existing IP may need to be declared. Members shall have the sole discretion as to whether or not to contribute their Pre-existing IP in UNIFI Work.
- 2.5 To the extent that a Member does not have an ownership interest in certain Pre-existing IP or UNIFI IP that is Proprietary Information under the UNIFI NDA, such

Member shall not disclose such UNIFI IP and Pre-existing IP to a third party except with the Pre-existing IP Owner's prior written permission and under confidentiality obligations substantially the same as those contained in the UNIFI NDA.

3. Core Stack IP Determination and Access for Carrying Out UNIFI work

- 3.1 The UNIFI IP Working Group is made of Members with at least one representation from national laboratories, universities, and industry. Members of the IP Working Group must be Foundational, Full, Start-up, or Non-Profit Members.
- 3.2 The UNIFI IP Working Group will review Pre-existing IP and any new UNIFI IP and/or Federally Funded UNIFI IP on a quarterly basis to determine if it should be listed as Core Stack IP. The UNIFI Working Group will share its determinations with the UNIFI Leadership Team. If there are disputes within the UNIFI Working Group, the UNIFI Leadership Team will resolve such disputes.
- 3.3 IP included in the Core Stack can change over time as determined by the UNIFI IP Working Group.
- 3.4 Only after UNIFI IP Working Group obtains permission from the Owner(s) of UNIFI IP, Federally Funded UNIFI IP, and/or Pre-existing IP, will UNIFI IP, Federally Funded UNIFI IP, and/or Pre-existing IP be determined to be Core Stack IP.
- 3.5 If the UNIFI IP Working Group proposes that certain Pre-existing IP should be included in the Core Stack IP, then Owner(s) of such IP shall make the final determination if they want such IP to be included in the Core Stack IP. As part of the final determination, the Owner(s) of such IP is responsible for determining whether the Owner(s) may legally grant the rights and licenses associated with the Core Stack IP designation as described herein in Sections 3 and 4. If Owner(s) decides to make it accessible, then it will be included in the Core Stack IP list and access shall be granted per Sections 3-4. If Owner(s) decide not to make such IP available as Core Stack IP, then such IP will not be included in the Core Stack IP list.
- 3.6 If the UNIFI IP Working Group proposes that certain UNIFI IP (including Federally Funded UNIFI IP) should be included in the Core Stack IP, then Owner(s) of such IP shall make the final determination if they want such IP to be included in the Core Stack IP. If Owner(s) decides to make it accessible, then it will be included in the Core Stack IP list upon Leadership Team and WG approval and access shall be granted per Section 4. If the Owner decides to not make such IP available as Core Stack IP, then that Member is barred from requesting and receiving licenses to other Core IP. Such Owner cannot participate in the IP Working Group.

- 3.7 Each Member shall have the right to practice or use all Core Stack IP for the sole purpose of carrying out UNIFI Work during its Participation Period.

4. CORE STACK AND UNIFI IP LICENSING

- 4.1 Except for UNIFI IP that is also Core Stack IP, the Owner(s) of UNIFI IP may make the UNIFI IP available for license to other Members at such Owner's discretion.
- 4.2 Once Owner(s) of the Core Stack IP have agreed to make their Core Stack IP available, then all Members of the UNIFI Consortium may request a royalty-bearing non-exclusive license using fair, reasonable, and non-discriminatory (FRAND) licensing principles for standard essential patents to be negotiated between the Owner and licensee(s). Members may also make Core Stack IP available at no cost.
- 4.3 If legally able to do so, the Owner(s) of any UNIFI IP agree(s) to grant to Member(s) a non-exclusive royalty-free license to use for non-commercial internal research purposes such UNIFI IP if such UNIFI IP was created or developed during the requesting Member's Participation Period and only during the requesting Member's Participation Period. If requested, any such license agreement shall be granted under a separate written license issued by the Owner(s).
- 4.4 All licenses granted to Federally Funded UNIFI IP are subject to overriding obligations to the United States Federal Government under 35 U.S.C. §§200-212 (Bayh-Dole Act) and applicable regulations and orders (including a non-exclusive, non-transferable, irrevocable, paid-up license to practice or have practiced the Federally Funded UNIFI IP for or on behalf of the United States Government throughout the world).
- 4.5 All Members shall retain the right on behalf of themselves: to practice their respective UNIFI IP for educational and research purposes, including sponsored research and collaborations; to license, derive, re-use, distribute, publish and/or otherwise make available for free or otherwise on a non-discriminatory basis their respective UNIFI IP or derivatives thereof without prior approval; and to optionally provide the above rights to other non-profit and government research institutions.

5. UNIFI IP MANAGEMENT

- 5.1 Except as required herein, each Member's Technology Transfer Office (TTO) shall manage UNIFI IP of which it is the sole Owner in accordance with its own policies on

licensing, including contract management, licensing income allocations, and reporting.

- 5.2 Members shall promptly disclose the UNIFI 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. Members of jointly owned UNIFI IP are encouraged to establish, in good faith, an Inter-Institutional Agreement (IIA) or like agreement under which one of the Members will manage the jointly owned UNIFI IP on behalf of the joint Owners. Such IIA specifies the details of how jointly owned UNIFI IP will be managed, the sharing of any costs related to legal protection of the UNIFI IP, and the allocation of any income from the sale or licensing of the UNIFI IP.
- 5.3 Each Member shall require its Participating Researchers to report all UNIFI IP to its TTO (the date of receipt of such UNIFI IP by the TTO shall be the "Receipt Date") in accordance with its own policies on disclosures of IP, but in any event within ninety (90) days of substantial development of such UNIFI IP. When a Member decides to pursue legal protection for any UNIFI IP, the Member shall report a non-confidential title and abstract to the Organizational Director within ninety (90) days of the Receipt Date. The Organizational Director will make the title and abstract available to other Members to review on request.
- 5.4 Each Member has the sole discretion to pursue legal protection of UNIFI IP of which it is the sole Owner. Members that are joint Owners of UNIFI IP shall work together in good faith to determine whether or not to pursue legal protection of the UNIFI IP.

6. DISTRIBUTION OF LICENSING REVENUE

Each Member shall comply with its respective policies regarding the distribution of licensing revenue, subject to the provisions of any applicable IIA.

7. REPORTING UNIFI IP

- 7.1 On an annual basis during its Participation Period, upon request, each Member shall provide to the Organizational Director a report of technology transfer transactions, such as option agreements, licenses and assignments, involving UNIFI IP.

- 7.2 On an annual basis, the Organizational Director will collect information submitted under Section 7.1 and make a full report on all technology transfer transactions to DOE. For clarity, this does not excuse other Members from complying with any reporting obligations of any applicable funding agreement.
- 7.3 In view of their management by or status as an institution of higher education, some Members may intend to conduct their activities covered by this IP Management Plan as fundamental research under U.S. Export Control regulations and have many foreign persons who are students and employees. Accordingly, Members shall not transfer to other Members any information that is known to be under U.S. Export Control by the transferring Member, at the time of such transfer, to be export controlled under the International Traffic in Arms Regulations or under the Export Administration Regulations and that has an Export Control Classification Number (ECCN) other than EAR99, except with the prior written concurrence of the respective Member.

8. DISPUTE RESOLUTION

The parties shall use best efforts to first settle any and all disputes between them in connection with or arising out of this Agreement by mutual consent. Disputes must first be referred to the Members' respective officers, who must hold a senior management role, to be designated at the time of the dispute. Through the designated officers, Members agree to first attempt informal resolution of dispute, within a reasonable period of time and in a fair and equitable manner, taking into consideration the objectives of the UNIFI Consortium and any laws, statutes, rules, regulations or guidelines to which the involved Members are subject.

9. UNIFI PUBLICATIONS

All Members shall have access to UNIFI Consortium reports. Members shall share their research findings resulting from UNIFI Work within the general research community through annual meetings, professional conferences, and publications, including publications to the general public. Members anticipate that their Participating Researchers may wish to publish their respective findings and results of research and development activities under the UNIFI Work, and Members may also wish to have a reasonable opportunity to seek any patent or other protection for their respective UNIFI IP.

Joint participants of UNIFI projects agree to the following pre-publication process to address any concerns:

Thirty (30) days prior to submission of a proposed public publication or presentation, each Member (“Submitter”) shall submit to the other Member(s) of the UNIFI Work project to which the publication or presentation pertains (“Recipient(s)”), in advance, the proposed publication or presentation. Proposed oral publications shall be submitted to the Recipient(s) in the form of a written presentation synopsis and a written abstract. The Recipient(s) shall provide a written response to the Submitter within thirty (30) days, either objecting or not objecting to the proposed publication. The proposed publication shall be deemed not objectionable unless the proposed publication contains proprietary information of Recipient or material that would create potential statutory bars to filing United States or corresponding foreign Patent applications, in which case Submitter shall redact proprietary information of Recipient prior to submission. In the event an objection is raised because of a potential statutory bar, the Recipient shall file its patent application within thirty (30) days of making such objection, after which time the Submitter shall be free to proceed with submission/publication.

EPRI retains the right to publish summary reports and other materials concerning the activities of UNIFI, for purchase or otherwise on a non-discriminatory basis, subject to EPRI’s confidentiality obligations as set forth in the UNIFI NDA.

10 IPMP AMENDMENTS

This IPMP may be amended, altered, or repealed only by the affirmative vote of two thirds of the Leadership Team, subject to the approval of the Organizational Director. Any changes will be sent to Organization Members with at least 30 days’ notice. If a Member does not wish to continue to abide by the revised IPMP, Member may, at its option, terminate its organization membership. No such withdrawal will entitle Member to any refund of any fees due and owing.