

Innovation Management Guidance Notes (IMGN)

Sponsored Research Agreements (SRAs)

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TOPIC: Overview of Intellectual Property (IP) Related Clauses in Sponsored Research Agreements (SRAs)	AUTHORS: Devanshi Patel Vijay Iyer Premnath Venugopalan NCL Innovations A 208, PAML Building National Chemical Laboratory Pune 411008, Maharashtra, India Phone: (+91) 20 2590 2982 Email: dt.patel@ncl.res.in
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SCOPE: This White Paper provides guidance for scientists about Intellectual Property (IP) related clauses that are typically incorporated in Sponsored Research Agreements (SRAs)	DATE: April 22, 2013
TABLE OF CONTENTS: A. Classification of IP related clauses B. Sample clauses C. References	

Disclaimer: Due care has been taken to ensure the coverage of the publicly available Intellectual Property related clauses in Sponsored Research Agreements. All the contract templates have been cited from various websites on the internet and the citations have been clearly listed. Any suggestions regarding the structure or improvements that can be made to the document are welcome. For queries/ suggestions please contact Devanshi Patel at dt.patel@ncl.res.in

A. BROAD CLASSIFICATION OF IP RELATED CLAUSES AND SUBCLAUSES:

IP clause head	Sub head	Context	Clause #
Intellectual Property (IP)	-NA-	<ul style="list-style-type: none"> IP can broadly include inventions, patents, trademarks, copyrights, know-how, and trade secrets 	C1 (ctrl+click to follow link)
Disclosures	Reporting disclosures and election to manage IP	<ul style="list-style-type: none"> Prompt notification to the Sponsor regarding new knowledge acquired during the performance of the project including inventions, tangible research materials, and knowhow. Sponsor has the option to elect the administration of the new knowledge created. 	C2
Confidentiality Obligations	-NA-	<ul style="list-style-type: none"> Sponsor shall keep confidential all invention disclosures submitted to Sponsor by the Institution until such information becomes publicly available through patents or publications. 	C3
Publication Rights	-NA-	<ul style="list-style-type: none"> The Institution agrees to delay publications if such publications contain Sponsor's proprietary matter. 	C4
Ownership	Solo IP	<ul style="list-style-type: none"> An invention may be solely owned by either the Sponsor or the Institution if such invention was made entirely by either the Sponsor or the Institution, respectively. 	C5
	Joint IP	<ul style="list-style-type: none"> An invention involving contributions from the Sponsor and the Institution shall be jointly owned. 	C6
	Background IP	<ul style="list-style-type: none"> Project related IP created and owned, separately, by the Sponsor and the Institution prior to the effective date of the project. 	C7
	Project IP	<ul style="list-style-type: none"> Solo/Joint IP created by Sponsor and/or Institution during the performance of the project. 	C8
	Tangible Research Property (TRP)	<ul style="list-style-type: none"> Mice models, prototypes, novel reagents 	C9
	Knowhow	<ul style="list-style-type: none"> Technical information of a proprietary nature which <i>may or may not</i> be under patent protection. 	C10
	Trade Secret	<ul style="list-style-type: none"> Technical information of a proprietary nature that will remain a secret and will neither be published nor be shared under confidentiality. 	C11
	Copyright	<ul style="list-style-type: none"> Solely owned copyright Jointly owned copyright 	C12
IP Administration and Management	Administration	<ul style="list-style-type: none"> Decision related to taking the lead on administering and protecting Project IP. Typically, one party is responsible for the preparation and prosecution of patent applications and the maintenance of any patents that issue on inventions made during the course of the project. 	C13
	Filing and Expenses	<ul style="list-style-type: none"> If the Sponsor requests the Institution to file patents, Sponsor shall reimburse all out-of-pocket costs incurred for the filings. 	C14
Option Rights	-NA-	<p><i>Patents</i></p> <ul style="list-style-type: none"> Sponsor is granted the option to license Project IP. If the Sponsor does not elect the option to license Project IP, Institution shall be free to license Project IP to other parties. <p><i>Copyrights</i></p> <ul style="list-style-type: none"> Sponsor is granted the option to license the copyright. 	C15
License Rights	-NA-	<p><i>Patents</i></p> <ul style="list-style-type: none"> Exclusive License <ul style="list-style-type: none"> Solely owned IP 	C16

		<ul style="list-style-type: none">○ Jointly owned IP• Non-exclusive License• Third party rights (Applicable to exclusive and non-exclusive licenses) <p><i>Copyrights</i></p> <ul style="list-style-type: none">• Sponsor obtains a royalty free license for internal use.• Sponsor obtains a royalty bearing license for commercial use.	
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B. SAMPLE CLAUSES CORRESPONDING TO THE CLAUSE NUMBERS REFERENCED EARLIER:

Sample clause #	Sample clauses
C1	<p>Intellectual Property (IP) <i>Definition:</i></p> <ul style="list-style-type: none"> • "Intellectual Property" means (i) inventions, devices, design, marks, circuit layouts and new varieties of plants (ii) patent rights, utility model rights, design rights, trademark rights, circuit layout rights, plant breeders' rights, and rights to obtain registration in any country for establishment of any patent rights, utility model rights, design rights, trademark rights and circuit layout rights, and rights to obtain plant variety registrations, and (iii) copyrights for computer programs and databases, and (iv) technical information of a proprietary nature which will be kept confidential (hereinafter called "Know-how"). www.rpip.tohoku.ac.jp/files/H24.3.9_eibunkeiyaku_WEB_UPDATE/Sponsored_Research_Agreement_2.doc - Tohoku University) • Anything developed by anyone covered by the <i>Intellectual Property Policy</i> that fits, but is not limited to, one or more of the following categories: <ul style="list-style-type: none"> a) an invention; b) an issued patent; c) a copyrighted work; d) a legal right inherent in a patent, copyright, trademark, know-how or trade secrets; or e) tangible research property, including, but not limited to, compositions, biologicals, materials, illustrations and drawings, prototypes, devices, and equipment. http://www.assurance.vcu.edu/Policy%20Library/Corporate-Sponsored%20Research%20Agreements.pdf – Virginia Commonwealth University)
C2	<p>Reporting disclosures and election to manage IP</p> <ul style="list-style-type: none"> • University and Sponsor shall promptly provide a complete written disclosure to each other of any Intellectual Property. The Sponsor shall, upon reviewing the disclosure, determine whether to request the University to file and prosecute any patent application, domestic or foreign, or application for other protection directed to University Intellectual Property or to Jointly Owned Intellectual Property described in such disclosure. • During the term of the Project, the University shall promptly disclose any Project IP to The Sponsor, which: <ul style="list-style-type: none"> ○ at The Sponsor's option, The Sponsor shall be entitled to manage the filing, prosecution and maintenance of any patent applications, issued patents and/or other forms of intellectual property protection relating to Project IP, at The Sponsor's cost; ○ should The Sponsor elect not to take responsibility for the management of Project IP as envisaged in 10.3.1 above, the University shall be given the option to do so, on terms to be agreed between the Parties; • The University and The Sponsor shall be named as co-applicants on patent applications, unless agreed otherwise between the Parties. http://www.iphandbook.org/handbook/resources/Agreements/ - Capetown University) • Stanford will provide Sponsor with a complete, written, confidential disclosure of any Stanford Technology after the disclosure is received by the Stanford Office of Technology Licensing. http://www.iphandbook.org/handbook/resources/Agreements/ - Stanford University) • The Sponsor shall be notified of any Joint Invention promptly after an invention disclosure is received by the M.I.T. Technology Licensing Office. M.I.T. shall have the first right to file patent applications on Joint Inventions in the names of both parties. All expenses incurred in obtaining and maintaining any patent on such Joint Invention shall be equally shared except that if one party declines to share in such expenses, the other party may take over the prosecution and maintenance thereof, at its own expense, provided that title to the patent remains in the names of both parties. http://www.iphandbook.org/handbook/resources/Agreements/ - Massachusetts Institute of Technology) • University agrees to promptly provide Sponsor a copy of any complete invention disclosure submitted to it by the PI describing a sole University or a joint invention made during the term of this Agreement. Sponsor agrees to promptly provide University a copy of any complete invention disclosure or comparable document submitted to it describing a joint invention(s). http://osp.uconn.edu/sponsored_research.php - University of Connecticut)

	<p>Non-election to manage IP</p> <ul style="list-style-type: none"> • If Sponsor elects not to exercise its option in accordance with the provisions of this Agreement or decides to discontinue the financial support of the application for intellectual property protection, USC shall be free to file or continue prosecution and maintenance on any such application, at USC's sole expense. If Sponsor elects to discontinue the financial support of the application for intellectual property protection prior to issuance of a valid patent, Sponsor thereby waives and gives up any right it may have under this Agreement to license the USC Intellectual Property as provided in the agreement. (http://nysstlc.syr.edu/media/documents/2010/7/NYSTAR_Sponsored - Research Project For New York State Foundation for Science, Technology and Innovation: Sponsored Research Agreement Template (19 Feb 2010); Syracuse University New Technology Law Center) • In the event the Sponsor declines or ceases to reimburse Michigan Tech for its costs in the securing and maintaining of any patent on any aspect of the Intellectual Property, Michigan Tech may continue to secure and maintain the patent at its own cost and without any obligation or license to the Sponsor for that patent. (http://www.mtu.edu/research/administration/sponsored-programs/pdf/resagreement.pdf - Michigan Technological University)
C3	<p>Confidentiality</p> <ul style="list-style-type: none"> • The Sponsor shall retain all invention disclosures submitted to Sponsor by M.I.T. in confidence and use its best efforts to prevent their disclosure to third parties. <ul style="list-style-type: none"> ◦ The Sponsor shall be relieved of this obligation only when this information becomes publicly available through no fault of the Sponsor. (http://www.iphandbook.org/handbook/resources/Agreements/ - Massachusetts Institute of Technology) • Sponsor shall retain all invention disclosures submitted by University in confidence and use its best efforts to prevent disclosure to third parties. Sponsor shall be relieved of this obligation only when this information becomes publicly available through no fault of Sponsor. (http://osp.uconn.edu/sponsored_research.php - University of Connecticut) • The receiving party may only disclose Confidential Information to persons with a “need to know” who shall be made aware of, and be required to observe and comply with the covenants and obligations contained herein, and the Confidential Information shall only be used for the purpose of the Research Plan. • A receiving party may disclose Confidential Information pursuant to the requirements of a government agency or pursuant to a court order, provided that the receiving party gives the disclosing party sufficient notice to enable it to seek an order limiting or precluding such disclosure. (www.research.uwaterloo.ca/forms/craig/Sponsored%2520Research%2520Agreement.pdf -Waterloo University) • Confidentiality Obligation for Know-how <ul style="list-style-type: none"> ◦ When any Know-how to be kept confidential is acquired as the Research Result, the parties hereto shall, upon mutual consultation, identify the said Know-how in writing and specify a period of confidentiality and keep the same in confidence. ◦ The confidentiality obligation imposed on the parties [under the above mentioned article] shall continue for two (2) years from the day following the date of completion or discontinuation of the Sponsored Research, provided, however, that the parties may, upon mutual consultation, extend or shorten the confidentiality period. (www.rpip.tohoku.ac.jp/files/H24.3.9_eibunkeiyaku_WEB_UPDATE/Sponsored_Research_Agreement_2.doc - Tohoku University)
C4	<p>Publication rights</p> <ul style="list-style-type: none"> • The University will advise the Project Director that if the Project Director proposes to publish any results or conclusions from the Project, he or she must allow the Sponsor to review any proposed publication thirty (30) days prior to submitting it for publication. If within said period, the Sponsor identifies proprietary information of Sponsor which it desires to protect and notifies the University in writing that it wishes publication of identified portions to be delayed, the University will use its best efforts to cause publication to be delayed for up to an additional sixty (60) days in order that a patent application may be prepared and filed; such delay shall not, however, be imposed on the filing of any student thesis or dissertation. (www.ora.ra.cwru.edu/ospa/forms/CASE_SPONSORED_RESEARCH_AGREEMENT_INDUSTRY.doc – Case Western Reserve University) • The University will submit to the Sponsor, in writing, details of any Results and any of the Sponsor's Background that any employee or student of the University intends to Publish, at least [30][60] days before the date of the proposed submission for Publication. The Sponsor may, by giving written notice to

	<p>the University ("a Confidentiality Notice"): require the University to delay the proposed Publication for a maximum of [??] month(s) after receipt of the Confidentiality Notice if, in the Sponsor's reasonable opinion, that delay is necessary in order to seek patent or similar protection for any of the Sponsor's Background or any Results that are to be Published; or prevent the Publication of any of the Sponsor's Background that is Confidential Information. The Sponsor must give that Confidentiality Notice within [15][30] days after the Sponsor receives details of the proposed Publication. If the University does not receive a Confidentiality Notice within that period, its employee or student may proceed with the proposed Publication, provided that, whether or not a Confidentiality Notice has been given, any of the Sponsor's Background that is Confidential Information may not be published.</p> <p>http://www.ipo.gov.uk/whyuse/research/lambert/lambert-mrc/lambert-mrc-agree/lambert-mrc-a1.htm - Lambert Model Research Collaboration Agreements)</p>
C5	<p>Solo IP</p> <p>Sponsor - solo</p> <ul style="list-style-type: none"> Title to any invention made solely by the Sponsor's personnel without the use of M.I.T. facilities ("Sponsor Inventions") shall remain with the Sponsor. Sponsor Inventions shall not be subject to the terms and conditions of this Agreement. (http://www.iphandbook.org/handbook/resources/agreements/ - Massachusetts Institute Of Technology) Inventions made during the performance of the Project solely by legal inventors or authors who are Sponsor's employees will be owned by Sponsor ("Sponsor IP").(http://osp.uconn.edu/sponsored_research.php - University of Connecticut) <p>Institution - solo</p> <ul style="list-style-type: none"> Title to any invention conceived or first reduced to practice in the performance of the Research solely by employees and/or students of M.I.T. shall remain with M.I.T. The Sponsor shall be notified of any such invention promptly after a disclosure is received by the M.I.T. Technology Licensing Office. M.I.T. (i) may file a patent application at its own discretion or (ii) shall do so at the request of the Sponsor and at the Sponsor's expense. (http://www.iphandbook.org/handbook/resources/Agreements/- Massachusetts Institute of Technology) Inventions made during the performance of the Project solely by legal inventors or authors who are University employees will be owned by University ("University IP"). By statute, University employee inventors are required to assign their rights to such inventions to University. (http://osp.uconn.edu/sponsored_research.php - University of Connecticut)
C6	<p>Joint IP</p> <p>[Note: In the event of a joint invention between the Sponsor and the Institution, the parties may want to execute a Joint Invention Administration Agreement]</p> <ul style="list-style-type: none"> Inventions made jointly by employees and/or students of M.I.T. and employees of the Sponsor in the performance of the Research or inventions made solely by employees of the Sponsor with significant use of M.I.T. facilities ("Joint Inventions") shall be jointly owned by both parties. (http://www.iphandbook.org/handbook/resources/Agreements/ - Massachusetts Institute of Technology) Inventions made during the performance of the Project jointly by legal inventors who are University's employees and Sponsor's employees will be owned jointly by University and Sponsor ("Joint IP"). By statute, University employee inventors are required to assign their rights to such inventions to University. (Http://osp.uconn.edu/sponsored_research.php - University of Connecticut)
C7	<p>Background IP</p> <ul style="list-style-type: none"> Background IP includes any intellectual property created and/or owned by each Party prior to the effective date of the Sponsored Research Project. The Institution will have a non-exclusive license to Sponsor's Background IP strictly for the purposes of the performance of the project. Upon Company's request, and subject to any pre-existing third party rights, Institute shall grant to Company a non-exclusive license, under any of Institute's Background Technology and Background IP for the purpose of exploiting any Project Result as provided under this Agreement, and the Parties shall negotiate in good faith the terms and conditions of an appropriate license agreement, including a reasonable royalty reflecting the market value of such Background Technology and Background IP, and taking into account the investments (to be) made by Company for commercially exploiting the same. Company shall not have the right to sub-license the Background IP license, given to it by Institute, to any other third party.²²

	<ul style="list-style-type: none"> • “University Background Intellectual Property” means all Intellectual Property which has been created by or in the possession of the University prior to the date of the Agreement and reduced to practice by the University prior to the date of the Agreement or which is developed independently of the Agreement by the University, whether or not patentable, patented or the subject of a pending application for patent in the United States of America or any foreign country, including, but not limited to, any art, method, process, or procedure, machine, manufacture, design, composition of matter, or any new and useful improvement of any of the foregoing. The University shall retain the entire right, title and interest in and to University Background Intellectual Property under the Agreement. If Sponsor desires to license University Background Intellectual Property, which is necessary to utilize University Intellectual Property, in conjunction with any of the licensing options set forth in the section above, a license may be negotiated with University on the standard terms and conditions of the University’s licenses and subject to negotiation of and agreement between the University and Sponsor on economic conditions. • “Sponsor Background Intellectual Property” means all Intellectual Property which has been created by or in the possession of the Sponsor prior to the date of the Agreement and reduced to practice by Sponsor prior to the date of the Agreement or which is developed independently of the Agreement by Sponsor, whether or not patentable, patented or the subject of a pending application for patent in the United States of America or any foreign country, including, but not limited to, any art, method, process or procedure, machine, manufacture, design, composition of matter, or any new and useful improvement of any of the foregoing. The Sponsor shall retain the entire right, title and interest in and to Sponsor Background Intellectual Property under the Agreement. www.ora.ra.cwru.edu/ospa/forms/CASE_SPONSORED_RESEARCH_AGREEMENT_INDUSTRY.doc – Case Western Reserve University) • It is acknowledged and understood by the parties hereto that any and all intellectual property rights and research materials, which are in the possession of TU and COMPANY respectively prior to the conclusion [i.e. signing] of this Agreement, are independent property of the respective parties and in no way affected by this Agreement. www.rpip.tohoku.ac.jp/files/H24.3.9_eibunkeiyaku_WEB_UPDATE/Sponsored_Research_Agreement_2.doc - Tohoku University) • Each Party grants the other a royalty-free, non-exclusive licence to use its Background for the purpose of carrying out the Project, but for no other purpose. Neither party may grant any sub-licence to use the other's Background except that the Sponsor may allow its Group Companies, and any person working for or on behalf of the Sponsor or any Group Company, to use the University's Background for the purpose of carrying out the Project, but for no other purpose. http://www.ipso.gov.uk/whyuse/research/lambert/lambert-mrc/lambert-mrc-agree/lambert-mrc-a1.htm - Lambert Model Research Collaboration Agreements)
C8	<p>Project IP</p> <ul style="list-style-type: none"> • During the term of the Project, the University shall promptly disclose any Project IP to The Sponsor, which: <ul style="list-style-type: none"> ○ at The Sponsor’s option, The Sponsor shall be entitled to manage the filing, prosecution and maintenance of any patent applications, issued patents and/or other forms of intellectual property protection relating to Project IP, at The Sponsor’s cost; ○ should The Sponsor elect not to take responsibility for the management of Project IP as envisaged in 10.3.1 above, the University shall be given the option to do so, on terms to be agreed between the Parties; ○ The University and The Sponsor shall be named as co-applicants on patent applications, unless agreed otherwise between the Parties. • The University shall retain the right to use the Project IP internally for teaching and research. http://www.iphandbook.org/handbook/resources/Agreements/ - Capetown University) • [The University][Each of the parties] will notify the [Sponsor][other] promptly after identifying any Result that [the University][it] believes is patentable, and will supply the [Sponsor][other] with copies of that Result. The University will notify other Results to the Sponsor in the reports provided under clause 2.4. http://www.ipso.gov.uk/whyuse/research/lambert/lambert-mrc/lambert-mrc-agree/lambert-mrc-a1.htm - Lambert Model Research Collaboration Agreements)
C9	<p>Tangible Research Property (TRP)</p> <ul style="list-style-type: none"> • <i>Definition:</i> Products of research that include, but are not limited to, compositions, biologics, materials, illustrations and drawings, prototypes, devices and equipment. http://www.assurance.vcu.edu/Policy%20Library/Corporate-Sponsored%20Research%20Agreements.pdf – Virginia Commonwealth University) • In the event that M.I.T. elects to establish property rights other than patents to any tangible research property (TRP), including but not limited to biological materials, developed during the course of the Research, M.I.T. and the Sponsor will determine the disposition of rights to such property by separate agreement. M.I.T. will, at a minimum, reserve the right to use and distribute TRP for non-commercial research purposes.

	http://www.iphandbook.org/handbook/resources/agreements/ - Massachusetts Institute Of Technology)
C10	<p>Knowhow</p> <ul style="list-style-type: none"> • <i>Definition:</i> Unpatented technical information (including, without limitation, information relating to inventions, discoveries, concepts, methodologies, models, research, development and testing procedures, the results of experiments, tests and trials, manufacturing processes, techniques and specifications, quality control data, analyses, reports and submissions) that is not in the public domain http://www.ipo.gov.uk/whyuse/research/lambert/lambert-mrc/lambert-mrc-agree/lambert-mrc-a1.htm - Lambert Model Research Collaboration Agreements)
C11	<p>Trade Secret</p> <ul style="list-style-type: none"> • <i>Definition:</i> Information, including a formula, pattern, compilation, program device, method, technique, or process, that: (i) derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use; and (ii) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy. http://www.assurance.vcu.edu/Policy%20Library/Corporate-Sponsored%20Research%20Agreements.pdf – Virginia Commonwealth University) • Any new knowledge created by the Institution during the course of the project shall not be considered a trade secret.²²
C12	<p>Copyrights</p> <p>Solely owned copyright</p> <ul style="list-style-type: none"> • Title to any copyrighted or copyrightable works first developed in the performance of the Research solely by employees of the Institution shall remain with the Institution.²² • Title to any copyrighted or copyrightable works first developed in the performance of the Research solely by employees of the Sponsor (“Sponsor Copyrighted Works”) shall remain with the Sponsor. Neither Sponsor Inventions nor Sponsor Copyrighted Works shall be subject to the terms and conditions of this Agreement. <p>Jointly owned copyright</p> <ul style="list-style-type: none"> • Copyrightable materials, including computer software, developed jointly in the performance of the Research by employees and/or students of M.I.T. and employees of the Sponsor, or copyrightable materials, including software, developed solely by employees of the Sponsor with significant use of M.I.T. facilities, shall be jointly owned by both parties, who shall each have the independent, unrestricted right to dispose of such copyrightable materials as they deem appropriate, without any obligation of accounting to the other party. http://www.iphandbook.org/handbook/resources/Agreements/ - Massachusetts Institute of Technology)
C13	<p>Administration</p> <ul style="list-style-type: none"> • The Sponsor shall, upon reviewing the disclosure, determine whether to request the University to file and prosecute any patent application, domestic or foreign, or application for other protection directed to University Intellectual Property or to Jointly Owned Intellectual Property described in such disclosure. • While the University shall be responsible for making decisions regarding scope and content of applications to be filed and prosecuted, the Sponsor shall be given an opportunity to review and provide input thereto. The University shall keep the Sponsor advised as to all developments with respect to such applications and shall promptly supply to the Sponsor copies of all papers received and filed in connection with the prosecution thereof in sufficient time for the Sponsor to comment. http://www.iphandbook.org/handbook/resources/Agreements/ - Cornell University) • Sponsor may, at any time, request University to file a patent application on University IP or Joint IP. <ul style="list-style-type: none"> ○ If such a request is made, Sponsor agrees to reimburse University for all patent costs. ○ Sponsor has the right to review all filings and office actions related to the patent applications, provided, however, that in an emergency when

	<p>immediate action is needed to protect University IP or Joint IP, documents may be filed prior to review by the Sponsor and in such event, telephone or facsimile notice shall be given promptly by University or University's counsel of such action.</p> <ul style="list-style-type: none"> ○ University will use reasonable efforts to avoid emergency situations in cases where they have control over the timing of steps involved in protecting University IP or Joint IP. (Http://osp.uconn.edu/sponsored_research.php - University of Connecticut) <ul style="list-style-type: none"> • If, within forty-five (45) days after the date that an Initial Disclosure is provided to SPONSOR, SPONSOR notifies RUTGERS that it elects to negotiate a license and pay patent fees for the Intellectual Property described in the Initial Disclosure, RUTGERS shall cause patent applications to be filed and prosecuted in its name at SPONSOR's expense. After filing, RUTGERS will promptly advise SPONSOR and provide SPONSOR a copy of any such patent application. SPONSOR shall reimburse RUTGERS (or at the option of RUTGERS make payment directly to the vendor), within thirty (30) days of receipt of invoice from RUTGERS, all patent costs incurred by RUTGERS during the earliest to expire of the following periods beginning on the date SPONSOR notifies RUTGERS of its election to exercise its negotiation rights and ending on i) the expiration of the applicable three (3) month negotiation period described in b) below, ii) the execution date of the definitive license agreement between the parties or iii) the effective date of notice by SPONSOR to RUTGERS relinquishing SPONSOR's negotiation rights with respect to the applicable Intellectual Property. <ul style="list-style-type: none"> ○ In the event SPONSOR does not agree within forty-five (45) days after receipt of the initial Disclosure to support the filing of a patent application on such Intellectual property, and forfeit its rights to a license, RUTGERS may file a patent application on such Intellectual Property at its own expense, and SPONSOR shall have no further rights in that Intellectual Property or that patent application. (http://nysstlc.syr.edu/media/documents/2010/7/NYSTAR_Sponsored - Research Project For New York State Foundation for Science, Technology and Innovation: Sponsored Research Agreement Template (19 Feb 2010); Syracuse University New Technology Law Center)
C14	<p>Filing and Expenses</p> <ul style="list-style-type: none"> • The Sponsor shall bear all costs incurred in connection with such preparation, filing, prosecution, and maintenance of U.S. and foreign applications. The Sponsor shall cooperate with the University to assure that such applications will cover, to the best of the Sponsor's knowledge, all items of commercial interest and importance. (http://www.iphandbook.org/handbook/resources/Agreements/ - Cornell University) • If Sponsor elects not to pay for the filing, prosecution or maintenance of a patent application or patent on an University Invention or a joint Invention, Sponsor's rights with respect to such patent application or patent shall terminate immediately, and Sponsor shall have no further rights under any resulting patents except for the right to the invention for internal research purposes only. (www.iphandbook.org/handbook/resources/Agreements/ - Michigan State University) • DREXEL shall control the preparation and prosecution of all patent applications and the maintenance of all patents related to DREXEL INTELLECTUAL PROPERTY. SPONSOR shall reimburse DREXEL upon receipt of invoice for all documented expenses incurred in connection with the filing and prosecution of the patent applications and maintenance of the patents that SPONSOR has requested DREXEL to prosecute under Section 6.1. (www.research.drexel.edu/administration/Agreements/SRAs/Sample_SRA_Drexel.doc - Drexel University) • If the Sponsor elects the license option under 11.B.2., the Sponsor shall notify M.I.T. of those foreign countries in which it desires a license in sufficient time for M.I.T. to satisfy the patent law requirements of those countries. The Sponsor will reimburse M.I.T. for the out-of-pocket costs, including patent filing, prosecution and maintenance fees, related to those foreign filings. (http://www.iphandbook.org/handbook/resources/agreements/ - Massachusetts Institute Of Technology) • Sponsor will notify Stanford of those countries outside the United States in which it desires a license in sufficient time for Stanford to satisfy the patent-law requirements of those countries. Sponsor will reimburse Stanford for out-of-pocket costs for those filings, including patent filing, prosecution, and maintenance fees. (http://www.iphandbook.org/handbook/resources/Agreements/ - Stanford University)
C15	<p>Option Rights – Patents</p>

Election

- University grants Sponsor the first option to negotiate a license to University Intellectual Property or to University's portion of Joint Intellectual Property. Said license shall be negotiated between the parties with terms and conditions that are mutually agreed upon. The option granted herein shall extend for 30 days from Sponsor's receipt of the invention report except in the event of termination for breach or default by Sponsor, no option is hereby granted.
(<http://www.iphandbook.org/handbook/resources/Agreements/> - Cornell University)
- Sponsor is hereby granted, without option fee other than the consideration of the research sponsored herein and the reimbursement of Duke for all patent expenses incurred to the date of disclosure related to the Invention, an option to acquire an exclusive, worldwide, royalty bearing license of Duke's rights to any Invention, which option shall extend for ninety (90) days after Sponsor's receipt of an Invention disclosure.
([Http://contracts.onecle.com/celsion/duke.research.1999.01.11.shtml](http://contracts.onecle.com/celsion/duke.research.1999.01.11.shtml) - Duke University)
- Sponsor may, at its option under 9.4(b), exclusively license Stanford's rights in Joint Technology.
([Http://www.iphandbook.org/handbook/resources/Agreements/](http://www.iphandbook.org/handbook/resources/Agreements/) - Stanford University)
- With respect to all IP generated in the project, Institution grants to Sponsor the 'First Right of Refusal' to negotiate licensing of Intellectual Property, at the time of invention disclosure. Sponsor has to exercise its 'First Right of Refusal' within 60 Calendar days from the date of offer of licensing of Potential IP by Institution to Sponsor. If Sponsor fails to exercise its 'First Right of Refusal' in writing within 60 working days, then Institution shall be free to offer licensing of potential IP to any other interested party.²²

Non-Election

- If Sponsor does not provide written notice of election to Stanford within 3 months of a written disclosure under Paragraphs 9.4, 9.6 or 9.8, Stanford has no further obligations to the Sponsor and may license the Stanford Technology to third parties.
([Http://www.iphandbook.org/handbook/resources/Agreements/](http://www.iphandbook.org/handbook/resources/Agreements/) - Stanford University)
- If Sponsor notifies Duke in writing of its exercise of the option within the option period, then the parties will proceed in good faith to negotiate a license agreement on commercially reasonable terms within ninety (90) days after notification of exercise, and if Sponsor does not exercise this option, or notifies Duke that it will not exercise this option, or the parties fail to sign a license agreement within said ninety (90) day period, then Sponsor shall no longer own any rights in the subject Invention.
([Http://contracts.onecle.com/celsion/duke.research.1999.01.11.shtml](http://contracts.onecle.com/celsion/duke.research.1999.01.11.shtml) - Duke University)
- If the Sponsor has not notified University in writing of its desire to enter a license negotiations within such ninety (90) day period, University shall have the right, but not the obligation, to license such rights to a third party.
- The right of first offer granted to the Sponsor hereunder shall not apply to University patents or patent applications issued or filed before the Effective Date of this Agreement.
(<http://www.pitt.edu/~offres/ResearchContract.html> - University of Pittsburgh)
- If, after good faith negotiations, a license has not been negotiated, or if the Sponsor decides to forgo the option, University shall be free to offer commercial license rights to any third party or to dispose of its inventions or other rights resulting therefrom in any other way it deems appropriate.
([Http://osp.uconn.edu/sponsored_research.php](http://osp.uconn.edu/sponsored_research.php) - University of Connecticut)

Option Rights – Copyrights

- The Sponsor shall be entitled to elect license rights from the following license options by notice in writing to M.I.T. within six (6) months after M.I.T.'s notification or delivery to the Sponsor of copyrightable material that is required to be delivered to the Sponsor in accordance with Attachment A.
(<http://www.iphandbook.org/handbook/resources/Agreements/> - Massachusetts Institute of Technology)
- Sponsor may elect to negotiate a non-exclusive or exclusive (subject to third party rights, if any) royalty-bearing license to use, reproduce, display, distribute and perform computer software and its documentation for commercial purposes in a designated field of use.
- Sponsor must elect within 3 months of notice of Stanford's disclosure of copyrightable material available for license. Computer software for which a patent

	<p>application is filed is subject to Paragraph 9.4 http://www.iphandbook.org/handbook/resources/Agreements/ - Stanford University)</p>
C16	<p>License Rights – Patents</p> <p><i>Grant of exclusive rights to the Sponsor in solely owned intellectual property</i></p> <ul style="list-style-type: none"> • The University agrees to grant The Sponsor exclusive rights to the University’s interest in the Project IP, the terms of which shall be set out in an agreement between the Parties (“Licence Agreement”), which: <ul style="list-style-type: none"> ○ the Parties shall endeavour to negotiate and execute before the completion date of the Project; ○ shall without limitation provide for the payment of a reasonable royalty to the University by The Sponsor. http://www.iphandbook.org/handbook/resources/Agreements/ - Capetown University) • A royalty-bearing, limited-term, exclusive license (subject to third party rights, if any) to the Sponsor, including the right to sublicense, in the United States and/or any foreign country elected by the Sponsor (subject to (C) below), to make, have made, use, lease, sell and import (in a designated field of use, where appropriate) products embodying or produced through the use of such invention, provided that the Sponsor agrees to reimburse M.I.T. for the costs of patent prosecution and maintenance in the United States and any elected foreign country, and further agrees that any products produced pursuant to this license and that are sold in the United States, shall be substantially manufactured in the United States. • This license option is subject to M.I.T.’s concurrence and the negotiation of commercially reasonable terms and conditions within three (3) months after selection of this alternative. http://www.iphandbook.org/handbook/resources/agreements/- Massachusetts Institute Of Technology) • A royalty-bearing, limited-term, exclusive, field-of-use license (subject to third-party rights, if any), including the right to sublicense, in the United States or any other country elected by Sponsor (subject to Paragraph 9.7 below) to make, have made, use, and sell products covered by the patent application, in exchange for Sponsor’s agreement to diligently commercialize the invention and that any licensed products sold in the United States will be substantially manufactured in the United States. http://www.iphandbook.org/handbook/resources/Agreements/ - Stanford University) • From the date of SPONSOR’s notification in a) above to pay patent costs and negotiate a license for the Intellectual property described in the Initial Disclosure, SPONSOR shall have a three (3) month period to negotiate the terms of a license agreement and RUTGERS agrees to negotiate these license terms in goodfaith. During this period, RUTGERS will not offer a commercial license to any other party. If the parties do not execute a license agreement within this three (3) month period, RUTGERS is free to offer a license to such Intellectual Property to others and SPONSOR shall no longer thereafter have any negotiation or other rights with respect to the applicable Intellectual Property. • Any licenses granted to SPONSOR will provide (i) for SPONSOR (and its sub-licensees, if any) to diligently exert its best efforts to introduce products utilizing the licensed technology into public use as rapidly as practicable on terms acceptable to RUTGERS; (ii) for a royalty and other consideration that is usual and customary in the trade; (iii) for termination in the event SPONSOR has not introduced licensed products into public use within a time period commensurate with industry standards that is acceptable to RUTGERS; (iv) for indemnity and insurance terms acceptable to RUTGERS’ insurance carrier http://nysstlc.syr.edu/media/documents/2010/7/NYSTAR_Sponsored - Research Project For New York State Foundation for Science, Technology and Innovation: Sponsored Research Agreement Template (19 Feb 2010); Syracuse University New Technology Law Center) <p><i>Grant of exclusive rights to the Sponsor in jointly owned intellectual property</i></p> <ul style="list-style-type: none"> • Each party shall have the independent, unrestricted right to license to third parties any such Joint Invention without accounting to the other party, except that the Sponsor shall be entitled to elect an exclusive license to M.I.T.’s interest as provided under paragraph 11.B.2. below. http://www.iphandbook.org/handbook/resources/agreements/ - Massachusetts Institute Of Technology) <p><i>Grant of non-exclusive rights to the Sponsor</i></p> <ul style="list-style-type: none"> • A non-exclusive, non-transferable, world-wide, royalty-free license, without the right to sublicense (in a designated field of use, where appropriate), to the Sponsor to make, have made, use, lease, sell and import products embodying or produced through the use of such invention, provided that the Sponsor

agrees to (a) demonstrate reasonable efforts to commercialize the technology in the public interest and (b) pay all patent prosecution and maintenance costs in all countries, including the United States, in which the Sponsor is granted a non-exclusive license right under this paragraph (<http://www.iphandbook.org/handbook/resources/agreements/> - Massachusetts Institute Of Technology)

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