

SAMPLE RESEARCH/INTELLECTUAL PROPERTY AGREEMENT

THIS AGREEMENT, effective this \_\_\_\_ day of \_\_\_\_\_, 20\_, is made by and between:

(company name) (street address) a ( insert state of incorporation) corporation, (hereinafter referred to as "Sponsor") and ( institution name) (street address) under the direction of the Tennessee Tech Board of Trustees, (hereinafter jointly referred to as "Institution").

WITNESSETH:

WHEREAS, the research project contemplated by this Agreement is of mutual interest and benefit to Sponsor and to Institution, will further the instructional and research objectives of Institution in a manner consistent with its status as a non-profit, tax-exempt, public institution of higher education, and may derive benefits for both Sponsor and Institution through inventions, improvements, and/or discoveries;

NOW, THEREFORE, in consideration of the promises and mutual covenants herein contained, the parties hereto agree to the following:

Article 1 - Definitions

As used herein, the following terms shall have the following meanings:

1.1 "Project" shall mean the project described in Appendix A hereof, under the direction of ( ), as principal investigator. The principal investigator is responsible for directing research activity.

1.2 "Contract Period" is \_\_\_\_\_ until \_\_\_\_\_.

Article 2 - Research Work

2.1 Institution shall commence the performance of Project promptly after the effective date of this Agreement, and shall use reasonable efforts to perform such Project substantially in accordance with the terms and conditions of this Agreement. Anything in this Agreement to the contrary notwithstanding, Sponsor and Institution may at any time amend the scope of the Project by mutual written agreement.

2.2 In the event that the principal investigator becomes unable or unwilling to continue Project, and a mutually acceptable substitute is not available, Institution and/or Sponsor shall have the option to terminate the Project.

2.3 Sponsor understands that the Institution's primary mission is education and advancement of knowledge and the Project will be designed to carry out this mission. The manner of performance of the Project will be determined solely by the Principal Investigator. The Institution will perform the Project on a "best efforts" research basis only and does not guarantee specific results. The Institution specifically disclaims all warranties or representations, either express or implied, for implied merchantability or for warranty of fitness for a particular purpose, including, without limitation, that any product does not infringe any patent, copyright or trademark right, as to any work performed under this Agreement, except as expressly set forth herein.

2.4 Sponsor understands that the Institution may be involved in similar research through other researchers on behalf of itself and others. Institution shall be free to continue such research provided that, during the term of this Agreement, it is conducted separately and by different investigators from the Project, and Sponsor shall not gain any rights via this Agreement to other research.

Article 3 - Reports and Conferences

3.1 If so requested, a final written report shall be submitted by Institution within 60 days of the conclusion of the Contract Period, or early termination of this Agreement.

3.2 If so requested by the Sponsor during the term of this Agreement, representatives of Institution will meet with representatives of Sponsor at times and places mutually agreed upon to discuss the progress and results, as well as ongoing plans, or changes therein, of Project to be performed hereunder.

Article 4 - Cost, Billings and Other Support

4.1 As consideration for the Institution's performance, Sponsor will pay the Institution an amount equal to its expenditures and reasonable overhead in conducting the Project. (It is agreed to and understood by the parties hereto that the total costs to Sponsor hereunder shall not exceed the sum of Dollars (\$\_\_\_\_\_)). Payment shall be made by Sponsor according to the following schedule:

(insert payment schedule).

4.2 In the event of early termination of this Agreement by Sponsor for convenience, Sponsor shall pay all costs accrued by the Institution as of the date of termination, including non-cancelable obligations, which shall include all non-cancelable contracts and fellowships or post-doctoral associates, which shall end no later than the end of the Institution's academic year following termination.

4.3 Institution shall retain title to all equipment purchased and/or fabricated by it with funds provided by Sponsor under this Agreement.

4.4 Sponsor agrees to obtain, at Sponsor's expense, a non-exclusive license for the Institution, the Principal Investigator, and any research assistant engaged by the Institution to work on the Project, to practice and/or use any patented technology or copyrighted material necessary to carry out the research contemplated by the scope of the Project. In the event that Sponsor is the owner of any patents or copyrights the practice of use of which is necessary for carrying out the Project, the Sponsor hereby grants the Institution, the Principal Investigator, and any research assistant engaged by the Institution to work on the Project, a non-exclusive license to practice and/or use any such patented technology or copyrighted material.

Article 5 - Publicity

Sponsor and Institution agree to cooperate, each with the other, in the preparation of any publicity, advertising, or news release related to the Project. At least seven days prior to any release or publication, the issuing party will provide the other party with a copy of the proposed material for approval. Sponsor will not thereafter make any use of the name of the Institution or any employee within the institution without the prior written approval of an authorized representative of the Institution. Authorized institution representatives include but are not limited to: (\_\_\_\_\_)

## Article 6 - Publications

6.1 Sponsor recognizes that under Institution policy, the results of Project must be publishable and agrees that Researchers engaged in Project shall be permitted to present at symposia, national or regional professional meetings, and to publish in journals, theses, dissertations, or otherwise of their own choosing, the methods and results of Project; provided, however, that Sponsor shall have been furnished copies of any proposed publication or presentation at least thirty days in advance of the submission of such proposed publication or presentation to a journal, editor, or other third party to permit Sponsor to object to such proposed presentation or proposed publication if Sponsor believes there is patentable subject matter or proprietary information which needs protection. Sponsor shall provide the Institution with such objection in writing within thirty days of receiving a proposed publication or forever waive its rights in this regard.

In the event that Sponsor makes objection, Institution shall refrain from making such publication or presentation for a maximum of three months from date of receipt of such objection in order for patent application(s) to be filed by the appropriate party and/or for the proprietary information to be removed or redacted.

6.2 In the event that the results of the Project are published or any product resulting from the Project is marketed to third parties, the Institution and/or the Project Director shall, at their option, have the right to receive attribution for their contribution to the published material or to have the Institution's and Project Director's names displayed on the product (in the case of published works, books CDs, DVDs or similar media) or the product packaging or literature (in the case of other types of products).

## Article 7 - Intellectual Property

It is understood that during the course of the Sponsored Research, valuable intellectual property may be generated by Institution personnel alone or jointly with Sponsor personnel. The following terms concerning intellectual property and inventions shall apply to this Agreement:

7.1 All rights and title to inventions and intellectual property, including but not limited to US and foreign patent applications and patents resulting therefrom, which are invented solely by Institution personnel, will belong to Institution. All rights and title to inventions and intellectual property, including but not limited to US and foreign patent applications and patents resulting therefrom, which are invented jointly by Institution and Sponsor personnel shall belong jointly to Sponsor and Institution.

7.2 At Sponsor's option, Institution and Sponsor agree to negotiate in good faith regarding the transfer of rights to inventions or other intellectual property held by the Institution that may have arisen from Project. Sponsor shall have three (3) months from disclosure of any invention or discovery to notify Institution that it wants to enter into such a license agreement. The parties shall negotiate in good faith for a period not to exceed six (6) months from Sponsor's notification or a longer period of time if the parties mutually agree to extend negotiations. If Sponsor and Institution fail to enter into such an agreement, the rights to such inventions or other intellectual property shall be disposed of in accordance with Institution policies, with no obligation to Sponsor. In the event that Sponsor elects to obtain said license, Sponsor shall bear the expense of the prosecution of any related patent applications, including without limitation, patentability investigation expenses, on behalf of Institution and Institution personnel.

7.3 In the event that Institution declines to file patent applications in the US or in any foreign countries on any patentable inventions, the rights to file will, with prior agreement of all persons engaged in the Project, and to the extent that any Inventions growing out of the Project also relied upon governmental sponsored research, the appropriate governmental agency, be transferred by

Institution and those persons to Sponsor, if Sponsor so requests. Under these circumstances, patent applications filed by Sponsor will be made with the understanding that a share in royalties equivalent to that provided to the inventor(s) under the current Institution patent policy will be provided to the inventor(s) by Sponsor and provided further that the Institution shall be granted a world wide, fully paid-up, non-exclusive license to any Inventions so patented.

#### Article 8 - Term and Termination

8.1 This agreement shall become effective upon execution and shall continue in effect for the full duration of the Contract Period unless sooner terminated in accordance with the provisions of this Article. The parties hereto may, however, extend the term of this Agreement for additional periods as desired under mutually agreeable terms and conditions that the parties reduce to writing and sign.

8.2 Either party may terminate this Agreement for convenience upon \_\_\_\_\_ days prior written notice to the other, subject to Section 4.2 hereof.

8.3 If the Sponsor fails to fulfill in a timely and proper manner its obligations under this Agreement or if the Sponsor shall violate any of the terms of this Agreement, the Institution shall have the right to immediately terminate this Agreement and withhold payment in excess of fair compensation for work completed. Notwithstanding the foregoing, the Sponsor shall not be relieved of liability to the Institution for damages sustained by virtue of any breach of this Agreement by the Sponsor.

8.4 Any provisions of this Agreement which by their nature extend beyond termination, e.g., without limitation, Articles 4-7, 10-11, shall survive such termination.

#### Article 9 - Independent Contractor

In the performance of services hereunder:

9.1 Institution shall be deemed to be and shall be an independent contractor and, as such, neither Institution nor its employees shall be entitled to any benefits applicable to employees of Sponsor, nor shall Sponsor or its employees be entitled to any benefits applicable to employees of Institution.

9.2 Neither party is authorized or empowered to act as agent for the other for any purpose and shall not on behalf of the other enter into any contract, warranty, statement, commitment or representation as to any matter. Neither shall be bound by the acts or conduct of the other.

#### Article 10 - Indemnification

Sponsor shall indemnify and hold harmless Institution against any and all actions, claims, costs, or liabilities, including attorneys' fees and court costs at both trial and appellate levels, for any loss, damage, injury, or loss of life caused by (a) the actions of Sponsor, its officers, servants, agents or of any third party acting under authorization from Sponsor, or (b) for products developed or made by or as a result of information or materials received from the Institution.

Article 10 shall apply with the proviso that (a) Institution promptly notifies Sponsor in writing after Institution receives notice of any claim, (b) Sponsor shall defend the Institution or may be given the opportunity, at Institution's option, to participate and associate with Institution in control, defense, and trial of any claim and any related settlement negotiations, (c) Institution fully cooperates with Sponsor in the defense of any such claim, and (d) no settlement shall binding against the Institution without the consent of the Tennessee Attorney General. The defense and

indemnity provisions of Sponsor shall survive the termination or natural expiration of this Agreement.

#### Article 11 - Insurance

Sponsor shall procure and maintain the following insurance coverage:

11.1 Workers' compensation and employers' liability insurance at statutory limits for workers' compensation and no less than \$1,000,000 for employers liability.

11.2 Commercial general liability insurance, including contractual liability coverage and products and completed operations liability coverage, and, if necessary, commercial umbrella insurance, with a limit of not less than \$1,000,000 each occurrence. If such insurance includes a general aggregate limit, it shall apply separately to this Project. The Institution shall be included as an additional insured under the CGL policy.

#### Article 12 - Governing Law

This Agreement shall be governed by and construed in accordance with the laws of the State of Tennessee, without resort to its choice or conflict of laws principles. Sponsor hereby submits to the jurisdiction of the State of Tennessee.

#### Article 13 - Assignment

This Agreement shall not be assigned by either party without the prior written consent of the other.

#### Article 14 - Agreement Modification

Any agreement to change the terms of this Agreement in any way shall be valid only if the change is made in writing and executed by authorized representatives of the parties hereto.

#### Article 15 - Notices

Notices, invoices, communications, and payments hereunder shall be deemed made if given by United States registered or certified mail, postage prepaid, and addressed to the party to receive such notice, invoice, or communication at the address given below, or such other address as may hereafter be designated by notice in writing:

If to Sponsor: (insert information)                      If to Institution: (insert information)

#### Article 16 - Non-discrimination

The parties agree to comply with Titles VI and VII of the Civil Rights Act of 1964, Title IX of the Education Amendments of 1972, Section 504 of the Rehabilitation Act of 1973, Executive Order 11,246, the Americans with Disabilities Act of 1990 and the related regulations to each. Each party assures that it will not discriminate against any individual including, but not limited to, employees or applicants for employment and/or students because of race, religion, creed, color, sex, age, disability, veteran status or national origin.

The parties also agree to take affirmative action to ensure that applicants are employed, and that employees are treated during their employment, without regard to their race, religion, creed,

color, sex, age, disability, veteran status or national origin. Such action shall include, but not be limited to, the following: employment, upgrading, demotion or transfer, recruitment or recruitment advertising, layoff or termination, rates of pay or other forms of compensation, and selection available to employees and applicants for employment.

#### Article 17 – Illegal Immigrants

Tennessee Public Chapter No. 878 of 2006, TCA 12-4-124, requires that Contactor attest in writing that Contractor will not knowingly utilize the services of illegal immigrants in the performance of this Contract and will not knowingly utilize the services of any subcontractor, if permitted under this Contract, who will utilize the services of illegal immigrants in the performance of this Contract. The attestation shall be made on the form, Attestation re Personnel Used in Contract Performance (“the Attestation”), which is attached and hereby incorporated by this reference.

If Contractor is discovered to have breached the Attestation, the Commissioner of Finance and Administration shall declare that the Contractor shall be prohibited from contracting or submitting a bid to any Tennessee Board of Regents institution or any other state entity for a period of one (1) year from the date of discovery of the breach. Contractor may appeal the one (1) year by utilizing an appeals process in the Rules of Finance and Administration, Chapter 0620.

#### Article 18 – Conflict of Interest

The Sponsor warrants that no part of the total contract amount provided herein shall be paid directly or indirectly to any officer or employee of the State of Tennessee as wages, compensation, or gifts in exchange for acting as officer, agent, employee, subcontractor, or consultant to the Sponsor in connection with any work contemplated or performed relative to this contract. Notwithstanding anything to the contrary in the foregoing, nothing in this Paragraph shall be construed to prevent the Institution from paying any of its employees working on the Project from funds received from Sponsor.

#### Article 19. - Debarment and Suspension.

The Contractor certifies, to the best of its knowledge and belief, that it and its principals:

- a. are not presently debarred, suspended, proposed for debarment, declared ineligible, or voluntarily excluded from covered transactions by any Federal or state department or agency;
- b. have not within a three (3) year period preceding this Contract been convicted of, or had a civil judgment rendered against them from commission of fraud, or a criminal offence in connection with obtaining attempting to obtain, or performing a public (Federal, State, or Local) transaction or grant under a public transaction; violation of Federal or State antitrust statutes or commission of embezzlement, theft, forgery, bribery, falsification, or destruction of records, making false statements, or receiving stolen property;
- c. are not presently indicted for or otherwise criminally or civilly charged by a government entity (Federal, State, or Local) with commission of any of the offenses listed in section b. of this certification; and
- d. have not within a three (3) year period preceding this Contract had one or more public transactions (Federal, State, or Local) terminated for cause or default.

Article 20 – Entire Agreement

This written Agreement constitutes the entire and only agreement between the parties relating to the Project and supersedes all prior negotiations, representations, agreements and understandings. The parties expressly disclaim reliance on any such prior negotiations, representations, agreements or understandings.

IN WITNESS WHEREOF, the parties have caused these presents to be executed in duplicate as of the day and year first above written.

AGREED TO AND ACCEPTED BY:

(SPONSOR)

( INSTITUTION )

By: \_\_\_\_\_ By: \_\_\_\_\_

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