

INDUSTRY SPONSORED RESEARCH AGREEMENT NO. _____

This industry sponsored research agreement ("Agreement") is between _____
("Company") and the University of Oregon ("University").

Background

Company will provide payment as specified in this Agreement to University, for University to use reasonable efforts to perform the research described in **Exhibit A - Scope of Work** ("Work").

The performance of the Work is of mutual interest to Company and University, and is consistent with the instructional, scholarship, and research objectives of University as a tax-exempt educational institution and entity of the State of Oregon.

Terms and Conditions

In consideration of the foregoing and the promises contained in this Agreement, University and Company agree as follows:

1. Scope of Work

University has available and will provide all the personnel, equipment, and materials (except as this Agreement otherwise provides) necessary and appropriate and will use reasonable efforts to perform the Work.

2. Period of Performance

This Agreement is effective on the date of last signature below ("Effective Date") and expires on _____, unless either party exercises an option under this Agreement to terminate the Agreement earlier ("Termination Date"). University may incur expenses as of _____.

3. Payment

Company will pay University \$ _____ ("Fixed Fee") upon full execution of this Agreement.

Company will submit payments to:

University of Oregon
c/o Cashiers
PO Box 3237
University of Oregon
Eugene, OR 97403-0327

4. Key Personnel

4.1. Company. Company's Project Director is _____.

4.2. University. University's Project Director is _____. University's Project Director may not amend or modify this Agreement. University's Project Director will supervise and direct the Work. University may not change its Project Director without Company's prior written approval. University will notify Company promptly if its Project Director is unable or unwilling to continue the supervision and direction of the Work. Within 30 days after that notice, University will propose a successor Project Director for Company's approval and Company will not withhold its approval unreasonably.

5. Reports

5.1. Required Reports. University will provide the following reports to Company's Project Director:

- A. informal oral or written progress reports that Company's Project Director reasonably requests;
- B. a final technical report within 30 days after the Termination Date.

6. INDEMNITY, DISCLAIMER, AND LIMITATION OF LIABILITY

6.1. Generally. Each party remains liable for all risks of personal or bodily injury and property damage caused by the negligent or willful acts or omissions of that party but subject to and reserving all applicable immunities granted by law or constitution of either party.

6.2. Company. Section 6.1 notwithstanding, Company will protect, indemnify, and hold harmless University and its employees, officers, board members, and agents (together "Indemnitees") from and against any damage, cost, loss, liability, fee or expense (including reasonable attorneys' fees and expenses of litigation) incurred by or imposed upon University in connection with any claims, suits, actions, demands, or judgments arising out of or connected with the Work, including but not limited to the use, commercialization, or distribution of information, materials or products which result in whole or in part from the Work, any third party claims against Indemnitees for patent, copyright, and/or trademark infringement and/or patent interference, and any damages, losses, or liabilities whatsoever with respect to death or injury to any person and damage to any property arising from the possession, use, or operation of products/services produced or sold by Company, their Affiliates (as defined in section 11.1.A.) or their customers in any manner whatsoever, except to the extent that the liability is due to the gross negligence or willful misconduct of University. University will promptly notify Company of any claim and will cooperate with Company in the defense of the claim. Company will, at its own expense, provide attorneys reasonably acceptable to University to defend against any claim with respect to which Company has agreed to indemnify University. This indemnity is not excess coverage to any insurance or self-insurance University may have covering a claim. Company's indemnity is not limited by the amount of Company's insurance.

6.3. DISCLAIMER. UNIVERSITY DISCLAIMS ANY AND ALL PROMISES, REPRESENTATIONS, AND WARRANTIES WITH RESPECT TO THE WORK AND ANY DEVELOPMENTS (AS DEFINED IN SECTION 10.1), INCLUDING CONDITION, CONFORMITY TO ANY REPRESENTATION OR DESCRIPTION, THE EXISTENCE OF ANY LATENT OR PATENT DEFECTS THEREIN, MERCHANTABILITY OR FITNESS FOR A PARTICULAR USE OR PURPOSE, VALIDITY OF ANY INTELLECTUAL PROPERTY RIGHTS OR CLAIMS, OR NONINFRINGEMENT OF ANY THIRD PARTY INTELLECTUAL PROPERTY RIGHTS.

6.4. Limitation of Liability. In no event is University liable for Company's use of any Developments or any loss, claim, damage, or liability, of whatsoever kind or nature, which may arise from or in connection with Company's performance under this Agreement or use of Developments. IN NO EVENT SHALL EITHER PARTY BE LIABLE FOR INCIDENTAL, CONSEQUENTIAL OR INDIRECT DAMAGES WITH RESPECT TO THIS AGREEMENT.

7. Insurance

7.1. University. University is self-insured with adequate levels of excess general liability and commercial auto liability insurance for liabilities arising out of acts, omissions or negligence of the University, its officers and employees, subject to the limitations and conditions of the Oregon Tort Claims Act and the Oregon Constitution Article XI Section 7. In addition, the University, maintains workers' compensation insurance for its employees as required by law.

7.2. **Company.** Company will procure and maintain during the term of any license granted under this Agreement comprehensive liability and product liability insurance of a type and in an amount which is customary in Company's industry, with reputable and financially secure insurance carriers. Upon University's request, Company will provide University with a certificate of insurance evidencing this coverage.

8. Parties are Independent Contractors

Company and University are independent contractors and nothing in this Agreement creates a partnership, agency, or joint venture between the parties. Neither party has the power to bind or obligate the other in any manner, other than as this Agreement expressly sets forth. Each party is responsible for wages, hours and conditions of employment of its respective personnel under this Agreement.

9. Termination

- 9.1. **Mutual.** Both parties may agree in a writing appropriately referencing this Agreement, to terminate this Agreement at any time.
- 9.2. **Breach.** Either party may terminate this Agreement upon written notice to the other party if the other party materially breaches this Agreement and that party does not cure the breach within 14 calendar days of the notice of breach.
- 9.3. **Fees.** Any fees and expenses paid to University pursuant to this Agreement shall be non-refundable unless otherwise agreed in writing by University.

10. Results

- 10.1. **Ownership of Work.** University and Company will document and report inventions, discoveries, software, and other works of authorship made solely in the course of this Agreement ("Developments") to each other. Title to inventions and works of authorship made solely by University personnel shall belong solely to University. Title to inventions and works of authorship made solely by Company personnel shall belong solely to Company. Inventions made jointly by University and Company personnel shall be jointly owned by the parties. The parties will determine Inventorship in accordance with United States patent law and authorship in accordance with United States copyright law.
- 10.2. **No Implied Licenses.** Nothing in this Agreement grants a party, either directly or by implication, estoppel, or otherwise any license under any patents, patent applications or other proprietary interests of any other invention, discovery, software, data or other proprietary works of the other party.
- 10.3. **Research Collaboration Rights.** University and Company, under their respective intangible property rights, permit, to the extent they legally are able to do so, the use of information, works of authorship, inventions, materials, technology, and equipment as provided by one to the other for the performance of this Agreement, but for no other purposes except as specified in writing signed by an authorized official of University and Company.
- 10.4. **Reservations and United States Government Rights.** Company agrees and acknowledges that with respect to any license which may be granted to Company with respect to Developments owned by University ("University Developments"), (i) University will reserve the right to use and to permit others to use the University Developments for research, education, and non-commercial use, and (ii) such license may be subject to the rights of the United States government under applicable law.
- 10.5. **Equipment.** University shall own any equipment, components, supplies, or tangible materials acquired or produced by University in the performance of the Agreement unless this Agreement provides otherwise.

11. License Rights by Company

11.1. Base Government Rights License. University grants to Company a royalty free, non-exclusive, worldwide, license for internal purposes only to: a) make and use any Developments that are inventions; and b) copy, perform and create derivatives of any Developments that are works of authorship. This license does not include the right to sell or further license any Developments.

A. Confirmatory License. University grants to Company, and Company accepts, a non-exclusive, royalty free, worldwide, paid-up license, to: a) make, use and sell any Developments disclosed to University's Innovation Partnership Services ("IPS") ("Disclosed Developments") that are inventions; and b) copy, perform, create derivatives of and distribute any Disclosed Developments that are works of authorship in accordance with the terms and conditions of this Agreement. This license includes the right of sublicense to Affiliates. "Affiliates" means (i) any corporation, company, or other entity in which Company directly or indirectly owns or controls at least fifty-one percent (51%) of the stock entitled to vote in election of the board of directors or (ii) any corporation, company, or other entity that directly or indirectly owns or controls at least fifty-one percent (51%) of the stock of Company entitled to vote in the election of directors. This license continues until (i) the expiration of the last expiring patent covering the Subject Invention or (ii) in the case a Work of Authorship, on expiration of copyright.

11.2. University will confirm this license in a letter substantially similar to **Exhibit B - Confirmatory License Letter.**

A. Without limiting the provisions of this Agreement and subject to its terms and conditions, Company may not export and/or re-export Disclosed Developments, or any portion thereof, without fully and completely complying with any and all United States export or munitions control regulations and laws.

11.3. Notice of Infringement. Company will notify University of any known infringement or other unauthorized use of the Disclosed Developments licensed in this Agreement and confirmed by a Confirmatory License Letter.

11.4. License Option. University grants to Company an option to negotiate a nonexclusive or exclusive worldwide, royalty-bearing, license to University Developments ("Option") as follows:

- A.** University will disclose to Company in writing any University Developments within 30 days of University receiving a completed disclosure from University's Project Director. During the 90 day period following the date of University's disclosure to Company, Company may exercise the Option by notifying University of Company's intent to seek a license with respect to such Developments.
- B.** If Company timely notifies University of its intent to seek a license, then during the 90 day period following the date on which Company notified University (the "Negotiation Period"), University and Company will in good faith negotiate the terms and conditions of the license. The license must contain reasonable terms consistent with industry practice and academic freedom of inquiry.
- C.** If Company does not timely exercise its right of first negotiation, or if the parties do not execute a license agreement prior to the end of the Negotiation Period (extended or otherwise), then the Option expires. University is then free to use and license others to use University Developments at its sole discretion.

Commented [OM1]: Annotation for Sample Agreement: Confirmatory Industry Standard License terms are included in the University's baseline industry sponsored research agreement and offered with an upfront payment of the Industry Standard License Fee (15% for in state companies or 20% for out of state companies) and approval of the University Project Director, their department head and other interested parties at the University. Official proposal's from the University of Oregon will be budgeted with the inclusion of the Industry Standard License Fee unless noted otherwise.

The University may remove this term and use the University's standard government rate if a Company would prefer to only have the Base Government Rights License and an option to negotiate a nonexclusive or exclusive license.

- D. Company agrees to reimburse University for any expenses University incurred or incurs protecting the intellectual property interests of any Developments under negotiation during the Negotiation Period.

12. Publication

University will have the right, at its sole discretion, to release information or to publish any material resulting from its performance under this Agreement. University will provide a copy of any proposed presentation or manuscript ("Proposed Publication") to Company at least 30 days before University's presentation or submission for publication. Company has those 30 days to review the Proposed Publication for any Confidential Information or to protect any intellectual property, and University agrees to delay presentation or submission for up to 30 additional days so that Company may protect any Confidential Information or up to 60 additional days so that Company may protect any intellectual property. University agrees to remove any Confidential Information Company finds in the Proposed Publication from the Proposed Publication.

13. Confidentiality

"Confidential Information" means any written information disclosed by a party to the other which the disclosing party marks as "Confidential," or non-written information disclosed by a party which it identifies at the time of disclosure as confidential and later reduces to writing marked "Confidential" and sends to the other party within 30 days of the non-written disclosure. The recipient agrees to protect Confidential Information with the same degree of care it uses to protect its own confidential information for a period of 3 years following the date of disclosure. The provisions of this Section 13 do not apply to information that is: (i) in the public domain at the time of disclosure or thereafter through no fault of the recipient, (ii) in the recipient's possession at the time of disclosure, (iii) independently developed by the recipient, or (iv) subject to disclosure pursuant to applicable law, including without limitation the Oregon Public Records Law.

14. Export Controls

The parties do not anticipate the need to disclose to each other technical data or information, whether in a tangible or intangible form, that are subject to export control regulations. Should one party believe it is necessary to disclose technical data or information that are controlled under export control regulations, the disclosing party will notify the other party's contact and provide specific identifying references as to the part of the EAR, ITAR, or other regulations under which the materials are qualified as "export controlled." The disclosing party will not transfer controlled materials without the prior written consent of the receiving party. Neither party is obligated to accept export controlled technical data or information. The receiving party incurs no liability if it elects not to accept export controlled technical data or information.

15. Publicity.

Each party agrees not to authorize or commission the publication of any promotional materials containing any reference to the other party without the prior written approval of the other party provided, however, that University may include Company's name and research project title in listings of research sponsors and provide and/or release information concerning this Agreement as necessary to comply with federal and state disclosure, reporting, and audit requirements, as applicable.

16. Certifications

16.1. Each party certifies the following upon signing this Agreement:

- A. That it will comply with all applicable Federal, State and local regulations and policies governing the research activities performed under this Agreement.
- B. That it maintains a financial conflict of interest policy that complies with all applicable federal and state requirements.

17. Sovereignty

Nothing in this Agreement is a waiver of either party's sovereign or governmental immunities.

18. Notice

18.1. Generally. Except as this Agreement otherwise expressly provides, the parties will provide any communications or notices in writing by personal delivery, facsimile, first-class mail (postage prepaid) or email to the other party at its address below unless either party has designated a different contact with a previous notice.

A. University.

Administrative:

SPS Contact

Sponsored Projects Services
5219 University of Oregon
Eugene, OR 97403-5219
Tel. (541) 346-5131
Fax (541) 346-5138
SponsoredProjects@uoregon.edu

With a copy to:

IPS Contact

Innovation Partnership Services
1238 University of Oregon
Eugene, OR 97403-1238

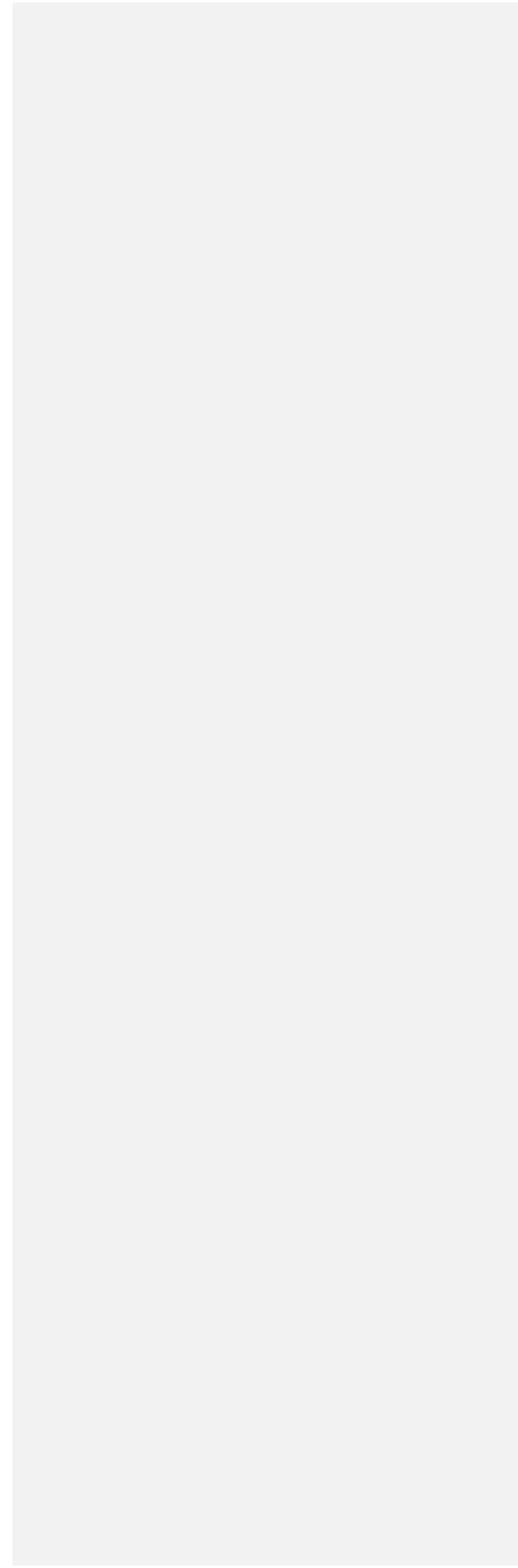
Technical:

University's Project Director

B. Company.

Administrative:

Technical:



18.2. Effective Date. All notices a party mails are effective 3 days after mailing. All notices a party sends by facsimile or email are effective when the transmitting machine generates receipt of the transmission. All notices a party delivers in person are effective when delivered.

19. Non-Waiver

If either party fails to enforce any term or provision of this Agreement it does not constitute that party's waiver of that or any other term or provision of this Agreement.

20. Assignment

Neither party may assign its rights or delegate its obligations under this Agreement without the other party's prior written consent.

21. Severability

If a court of competent jurisdiction determines any term or provision of this Agreement is invalid or unenforceable to any extent, it does not affect the remainder of this Agreement, and each remaining term and provision of this Agreement remains valid and enforceable to the fullest extent applicable law allows.

22. Survival

All terms of this Agreement that the parties would reasonably expect to survive termination of the Agreement survive termination of the Agreement.

23. Execution and Counterparts

The parties may execute this Agreement in counterparts, and via facsimile or electronically transmitted signature (i.e. emailed scanned true and correct copy of the signed Agreement), each of which the parties consider an original and all of which together constitute one and the same agreement. At the request of a party, the other party will confirm facsimile or electronically transmitted signature page by delivering an original signature page to the requesting party.

24. Governing Law

This Agreement is governed by and construed in accordance with the laws of the State of Oregon. The parties irrevocably and exclusively submit to the jurisdiction of the state and federal courts of or for the State of Oregon, including the related appellate courts, in any such action or proceeding. A party may obtain personal jurisdiction over the other party by mailing (postage prepaid) a summons or similar legal document to the other party's address for notices under this Agreement.

25. Entire Agreement; Modification

This Agreement, including all exhibits and attachments, constitutes the sole agreement between the parties with respect to its subject matter. The parties may only change or modify this Agreement by written agreement signed by an authorized representative of each party.

COMPANY

UNIVERSITY

Signature

Signature

Print Name

Print Name

Title

Title

Date

Date

Exhibit A - Scope of Work

Exhibit B - Confirmatory License: Industry Standard Plan

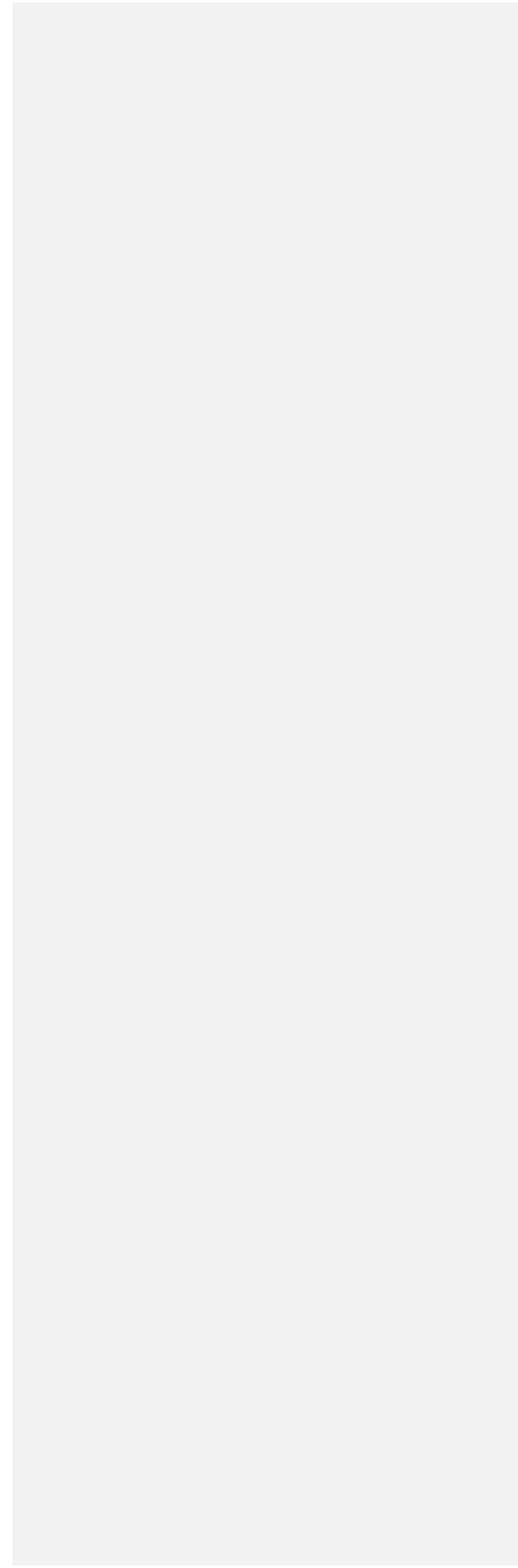


EXHIBIT A - SCOPE OF WORK

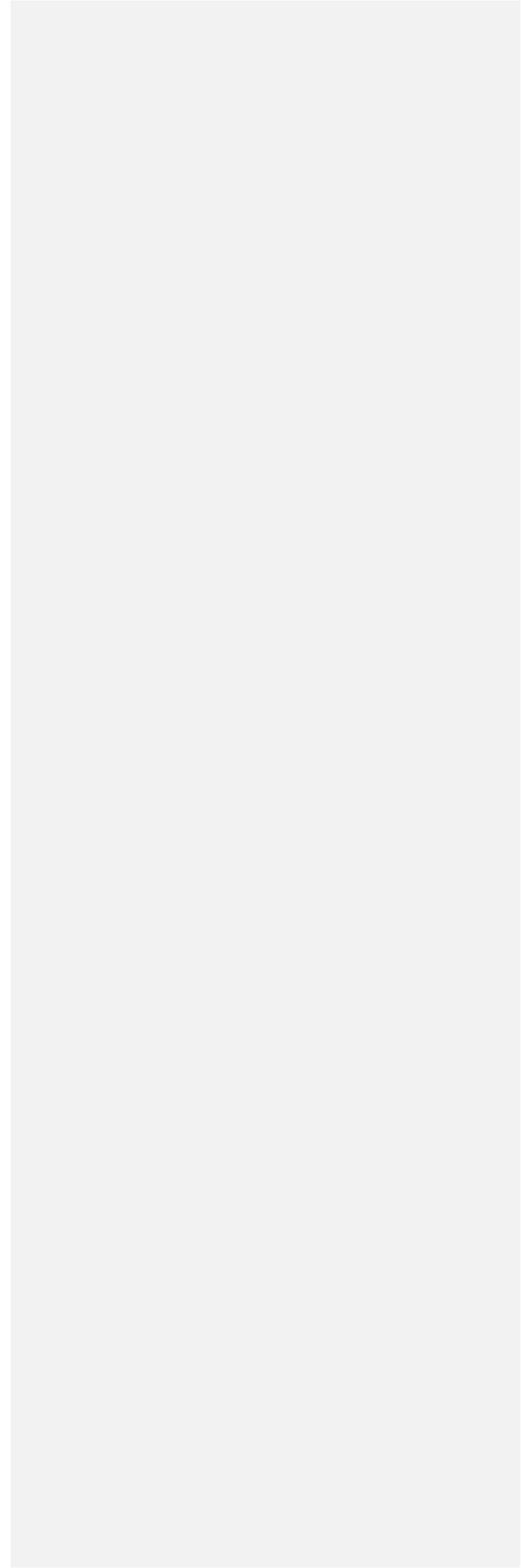


EXHIBIT B - CONFIRMATORY LICENSE LETTER

University of Oregon
Innovation Partnership Services
1238 University of Oregon
Eugene, OR 97403-1238

Company Name
Company Address

RE: Title of University Intellectual Property: _____ (“Disclosed Developments”)
University Project Director(s): _____ UO ID: _____

To Whom It May Concern:

The University of Oregon (“University”), during the performance of research under Industry Sponsored Research Agreement # _____ (“Agreement”) between the University of Oregon and _____ (“Company”) dated _____, conceived or created Disclosed Developments as identified above and described in the attached written description.

Pursuant to Section 11.2 of the Agreement University granted Company, and Company accepted, certain rights in and to Disclosed Developments, in accordance with the terms and conditions of the Agreement. This letter confirms that University granted to Company and Company accepted a non-exclusive, royalty-free, world-wide, paid-up license to: a) make, use and sell any Developments disclosed to University’s Innovation Partnership Services (“IPS”) (“Disclosed Developments”) that are inventions; and b) copy, perform, create derivatives of and distribute any Disclosed Developments that are works of authorship in accordance with the terms and conditions of the Agreement. This license includes the right of sublicense to Affiliates (as defined in the Agreement).

Signed this _____ day of _____, 201_

University of Oregon

Charles Williams, Ph.D., J.D., CLP
Associate Vice President for Innovation