

**FLORIDA ATLANTIC UNIVERSITY
SPONSORED RESEARCH AGREEMENT
CONTRACT #**

This Agreement is made by and between FLORIDA ATLANTIC UNIVERSITY Board of Trustees, having its business address at 777 Glades Road, P.O. Box 3091, Boca Raton, Florida 33431-0991 (hereinafter "UNIVERSITY") and <SPONSOR Name>, a <State, e.g. 'Florida'> corporation, having its business address at <street, city, state, zip> (hereinafter "SPONSOR").

SUBJECT

The purpose of this Agreement is to promote the increase of useful knowledge through research relating to _____.

IT IS AGREED:

Article 1.0 RESEARCH

- 1.1 UNIVERSITY agrees to use reasonable efforts to perform the research program as described in the Scope of Work, Appendix A to this Agreement (incorporated by reference herein), and such other Research as may be mutually agreed upon in an executed amendment to this Agreement (the "Research").
- 1.2 The Research and all work assignments shall be carried out under the direction of _____ (hereinafter "**PROJECT DIRECTOR**") while employed by UNIVERSITY, and by others (e.g. technician, graduate student, postdoctoral fellow, or faculty member, hereinafter collectively referred to as "**PERSONNEL**"), as assigned by PROJECT DIRECTOR.
- 1.3 UNIVERSITY agrees that there shall be no change of PROJECT DIRECTOR without prior written approval of SPONSOR.

Article 2.0 TERM

- 2.1 The Research commences on <month, day, year> the ("**Effective Date**"), and shall end on <month, day, year> ("**Expiration Date**"), unless extended by mutual agreement of the parties in an executed amendment to this agreement.

Article 3.0 FACILITIES AND EQUIPMENT

- 3.1 UNIVERSITY agrees to furnish such available laboratory facilities and equipment as it shall determine necessary for the Research, other than that specifically provided by SPONSOR under this Agreement.
- 3.2 Parties agree that all equipment and supplies purchased with funds obtained as a result of this Agreement become the property of the UNIVERSITY.

Article 4.0 PAYMENT

4.1 SPONSOR agrees to pay UNIVERSITY _____ Dollars for this Research in the following installments:

- <50%, or a fixed amount> upon execution
- <25%, or a fixed amount> in three months from the Effective Date
- <25%, or a fixed amount> in six months from the Effective Date

The foregoing payment by SPONSOR is acknowledged to be full and complete compensation for all Research and other obligations assumed by UNIVERSITY under this Agreement.

Make checks payable to: Florida Atlantic University

Mail checks to: Florida Atlantic University
P.O. Box 198660
Atlanta, GA 30384-8660

Article 5.0 REPORTS

5.1 The PROJECT DIRECTOR shall furnish SPONSOR with written reports and/or deliverables according to the Scope of Work, Appendix A.

Article 6.0 PUBLICATION

6.1 UNIVERSITY will be free to present or publish the results of the Research after providing the SPONSOR with a thirty (30) day period in which to review each presentation or publication to identify patentable subject matter, and to identify any inadvertent disclosure of Confidential Information. If necessary to permit the preparation and filing of U.S. patent applications, UNIVERSITY may agree to an additional review period not to exceed sixty (60) days. Any extension will require written agreement between the SPONSOR and UNIVERSITY.

6.2 Nothing in this Agreement shall entitle UNIVERSITY to disclose to others or publish any information disclosed to UNIVERSITY by SPONSOR which is confidential within the meaning of article 7.0 without the prior written approval of SPONSOR.

Article 7.0 CONFIDENTIALITY

7.1 UNIVERSITY acknowledges that SPONSOR may wish to disclose information which sponsor considers confidential in furtherance of the Research. SPONSOR acknowledges that UNIVERSITY has no mechanism to maintain or guarantee the confidentiality of information, and cannot sustain liability for inadvertent or other disclosure of confidential information. These considerations notwithstanding, if any such information is disclosed

by SPONSOR, it shall be clearly marked “confidential information” and furnished in writing only to the PROJECT DIRECTOR, or orally disclosed to the PROJECT DIRECTOR and reduced to writing by the SPONSOR within thirty (30) days of disclosure. Confidential information shall remain the property of the SPONSOR, and for a period of three (3) years from the Termination or expiration of the Agreement, shall not be used or disclosed to others except in furtherance of this Agreement. The foregoing obligation of non-use and non-disclosure shall not apply to:

- a. information which at the time of disclosure is in the public domain;
- b. information which after disclosure is published or otherwise becomes part of the public domain through no fault of the PROJECT DIRECTOR;
- c. information which was in the possession of the PROJECT DIRECTOR at the time of disclosure, and was not acquired from SPONSOR under an obligation of confidentiality;
- d. information for which SPONSOR provides written permission to disclose; or
- e. information UNIVERSITY must disclose by law or court order.

Each party may disclose the other party’s Confidential Information if required by law, but, if possible, it must inform that other party first (with as much prior notice as possible), and use all reasonable endeavors to limit the terms of that disclosure as reasonably requested by that other party.

Article 8.0 PATENT AND OTHER INTELLECTUAL PROPERTY RIGHTS

8.1 SPONSOR INTELLECTUAL PROPERTY. Title to any invention conceived or first reduced to practice in performance of the Research solely by the SPONSOR’s personnel without significant use of UNIVERSITY administered funds or facilities (“**SPONSOR Invention**”) shall remain with the SPONSOR. Title to, and the copyright in, any copyrightable material first produced or composed in the performance of the Research solely by the SPONSOR’s personnel without significant use of UNIVERSITY administered funds or facilities (“**SPONSOR Copyright**”) shall remain with the SPONSOR. Neither SPONSOR Inventions nor SPONSOR Copyrights shall be subject to the terms and conditions of this Agreement.

8.2 JOINT INTELLECTUAL PROPERTY

a. JOINT INVENTIONS. The Parties shall have joint title to: (i) any invention conceived or first reduced to practice jointly by employees and/or students of UNIVERSITY and the SPONSOR’s personnel in the performance of the Research; and (ii) any invention conceived or first reduced to practice by the SPONSOR’s personnel in the performance of the Research with significant use of funds or facilities administered by UNIVERSITY (each, a “**Joint Invention**”). The SPONSOR shall be notified of any Joint Invention promptly after

an invention disclosure is received by UNIVERSITY's Office of Technology Development ("**OTD**"). UNIVERSITY shall have the first right to file a patent application on a Joint Invention in the names of both Parties. All expenses incurred in obtaining and maintaining any patent on such Joint Invention shall be equally shared. If one Party declines to share in such expenses, the other Party may take over the prosecution and maintenance of the patent, at its own expense, and the Party that declines to pay such expenses shall assign its ownership rights to the Party that pays the expenses.

- b. **LICENSES.** If neither Party has declined to equally share the payment of expenses incurred in obtaining and maintaining any patent on such Joint Invention, then 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 request, within three (3) months after UNIVERSITY's notification to the SPONSOR that a patent application has been filed, an exclusive license to UNIVERSITY's interest in a Joint Invention as provided under paragraph 8.3.b.(i) below.
- c. **JOINTLY DEVELOPED COPYRIGHTABLE MATERIALS.** Copyrightable materials, including computer software, developed in the performance of the Research: (i) jointly by employees and/or students of UNIVERSITY and the SPONSOR's personnel; or (ii) by the SPONSOR's personnel with significant use of funds or facilities administered by UNIVERSITY, shall be jointly owned by both Parties, who shall each have the independent, unrestricted right to dispose of such copyrightable materials and their share of the copyrights therein as they deem appropriate, without any obligation of accounting to the other Party.

8.3 UNIVERSITY INTELLECTUAL PROPERTY

- a. **UNIVERSITY INVENTIONS.** UNIVERSITY shall have sole title to: (i) any invention conceived or first reduced to practice solely by employees and/or students of UNIVERSITY in the performance of the Research (each an "**UNIVERSITY Invention**"); and (ii) any invention conceived or first reduced to practice by the SPONSOR's personnel with significant use of funds or facilities administered by UNIVERSITY, if the invention is conceived or reduced to practice other than in the performance of the Research. The SPONSOR shall be notified of any UNIVERSITY Invention promptly after a disclosure is received by UNIVERSITY's OTD. UNIVERSITY may (i) 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, provided SPONSOR notifies UNIVERSITY within thirty (30) days of its receipt of the invention notice from UNIVERSITY.
- b. **LICENSING OPTIONS.** For each UNIVERSITY Invention on which a patent application is filed by UNIVERSITY, UNIVERSITY hereby grants the SPONSOR a non-exclusive, non-transferable, royalty-free license for non-commercial internal research purposes. The SPONSOR shall further be entitled to elect an option to the following commercial license by notice in writing to UNIVERSITY within three (3) months after UNIVERSITY's notification to the SPONSOR that a patent application has been filed:

(i) a royalty-bearing, limited-term, exclusive license (subject to third party rights, if any, and in a designated field of use, where appropriate) to the SPONSOR, including the right to sublicense, in the United States and/or any foreign country elected by the SPONSOR pursuant to Section 8.3.c. below, to make, have made, use, lease, sell and import products embodying or produced through the use of such invention. This option to elect an exclusive license is subject to UNIVERSITY's concurrence, and the negotiation of commercially reasonable license terms and conditions, and is conditioned upon SPONSOR's payment to UNIVERSITY for the costs of patent prosecution and maintenance in the United States, and any elected foreign country, and to cause any products produced pursuant to this license that will be used or sold in the United States to be substantially manufactured in the United States.

If the SPONSOR and UNIVERSITY do not enter into a license agreement within three (3) months after the SPONSOR's election to proceed under paragraph 8.3.b(i) above, the SPONSOR's rights under paragraph 8.3.b(i) will expire.

- c. **FOREIGN FILING ELECTION.** If the SPONSOR elects a license under 8.3.b(i), the SPONSOR shall notify UNIVERSITY of those foreign countries in which it desires a license in sufficient time for UNIVERSITY to satisfy the patent law requirements of those countries. The UNIVERSITY shall provide SPONSOR with an invoice in the amount of a good faith estimate for the anticipated out-of-pocket costs, including patent filing, prosecution and maintenance fees, related to those foreign filings. SPONSOR shall pay the invoice amount as soon as possible to avoid the UNIVERSITY having to pay those costs prior to receiving SPONSOR's payment. To the extent that the estimated amount is greater or smaller than the actual incurred costs, the parties shall settle the differential amount as soon as possible after the actual amount is known.
- d. **CONFIDENTIALITY OF INVENTION DISCLOSURES.** The SPONSOR shall retain all invention disclosures submitted to the SPONSOR by UNIVERSITY in confidence and use its best efforts to prevent their disclosure to third parties. The SPONSOR shall be relieved of this obligation only when this information becomes publicly available through no fault of the SPONSOR.
- e. **COPYRIGHT OWNERSHIP AND LICENSES.** Title to, and the copyright in, any copyrightable material first produced or composed in the performance of the Research solely by employees and/or students of UNIVERSITY shall remain with UNIVERSITY.
 - (i) For computer software and its documentation, and/or informational databases, which are required to be delivered to the SPONSOR in accordance with APPENDIX A, SPONSOR shall have a royalty-free, non-transferable, non-exclusive right and license to use, reproduce, make derivative works based upon, and display, such computer software and its documentation, and/or databases, for internal, non-commercial purposes.

(ii) For computer software and its documentation, and/or informational databases, which are required to be delivered to the SPONSOR in accordance with APPENDIX A, the SPONSOR shall be entitled to elect, by notice to UNIVERSITY within three (3) months following UNIVERSITY's notification or delivery to the SPONSOR of such software, documentation, or databases, a commercially reasonable royalty-bearing, non-transferable, exclusive right and license to use, reproduce, make derivative works based upon, display, and distribute to end users for commercial purposes, such software, documentation, or databases.

(iii) If the use of the software described in 8.3.e (i) and (ii) and would infringe claims of a patent application filed pursuant to paragraph 8.3.a. ("UNIVERSITY Inventions"), then the SPONSOR will need to elect license rights in such patent as set forth in 8.3.b. above in order to receive any license described in this paragraph 8.3.e. If such computer software is a derivative of UNIVERSITY software existing prior to the start of the Research, then SPONSOR will need to obtain a license to such pre-existing software, which license may be royalty-bearing if SPONSOR elects the exclusive commercial license described in 8.3.e (ii) above.

- f. **RIGHTS IN TANGIBLE RESEARCH PROPERTY.** In the event that UNIVERSITY 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, UNIVERSITY and the SPONSOR will determine the disposition of rights to such property by separate agreement. UNIVERSITY will, at a minimum, reserve the right to use and distribute TRP for non-commercial research purposes.
- g. **LICENSE EFFECTIVE DATE.** All licenses elected by the SPONSOR pursuant to Sections b., e., and f. of this Article 8.3 become effective as of the date the Parties sign a separate license agreement

8.4 PATENT AND TRADEMARK ACT AMENDMENTS OF 1980 (BAYH-DOLE ACT)

SPONSOR acknowledges that it understands the provisions of the Patent and Trademark Act Amendments of 1980 (the "Bayh-Dole Act"), and that the Act applies to all UNIVERSITY Inventions and Joint Inventions which arise from UNIVERSITY research which in whole, or in part, is, or has been, funded by the federal government. Among other provisions, the Act provides that if the UNIVERSITY elects to retain title to an invention, it shall grant to the government a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the subject invention throughout the world.

Article 9.0 TERMINATION

- 9.1 Either party may terminate this Agreement prior to the Expiration Date by giving thirty (30) days written notice to the other.

9.2 Upon early termination of this Agreement, SPONSOR shall pay all costs accrued by UNIVERSITY as of the date of termination including non-cancelable obligations for the term of the Agreement, which shall include all appointments of research staff incurred prior to the effective date of the termination.

Article 10.0 INDEMNIFICATION AND NEGATION OF WARRANTY

10.1 SPONSOR agrees to indemnify, hold harmless and defend UNIVERSITY its officers, employees, and agents against any and all claims, suits, losses, damages, costs, fees, and expenses resulting from or arising out of the SPONSOR's use of the research data developed during the term of this Agreement.

10.2 UNIVERSITY makes no representation other than those specified in this Agreement. UNIVERSITY makes no express or implied warranties of merchantability of fitness for any particular purpose of data or technical information derived from this Research.

Article 11.0 ASSIGNMENT

11.1 This Agreement may not be assigned by SPONSOR without the prior written Agreement of UNIVERSITY.

Article 12.0 PUBLICITY

12.1 SPONSOR will not use the name of UNIVERSITY, nor of any member of UNIVERSITY'S PERSONNEL, in any publicity, advertising, or news release without the prior written approval of UNIVERSITY.

Article 13.0 NOTICES

13.1 Notices, invoices, payments and other communications hereunder shall be deemed to have been made when delivered, sent by email, or when mailed first class, postage prepaid, and addressed to the party at the address given below, or such other address as may hereafter be designated by notice in writing:

SPONSOR:

For Administrative matters:

Name:
Address:
City, State, Country:
Phone:
E-mail:

For Financial matters:

Name:
Address:
City, State, Country:

Phone:

E-mail:

FLORIDA ATLANTIC UNIVERSITY

For Administrative matters:

Miriam Campo
Assistant Vice President for Sponsored Programs
Division of Research
Building 104, Room 314
Boca Raton, FL 33431
Phone: 561-297-0853
campom@fau.edu

For Technical matters:

Project Director:
Address:
City, State, Zip:
Phone:
Email:

Article 14.0 MISCELLANEOUS

- 14.1 UNIVERSITY and SPONSOR agree that the PROJECT DIRECTOR and PERSONNEL are acting as employees of UNIVERSITY and not as agents or employees of SPONSOR.
- 14.2 This Agreement shall be binding upon and inure to the benefit of the respective parties and their successors.
- 14.3 This Agreement shall be governed by and construed according to the laws of the State of Florida.
- 14.4 This Agreement may not be assigned by the SPONSOR without the written permission of UNIVERSITY.
- 14.5 This Agreement embodies the entire understanding of the parties and supersedes all prior agreements, oral or written, and all other communications between the parties relating to the subject matter hereof.
- 14.6 No amendment or modification of this Agreement shall be valid or binding upon the parties unless made in writing and signed by their duly authorized employees.
- 14.7. Upon termination of this Agreement, neither party shall have any liability to the other, except for any provisions of this Agreement which by their nature extend beyond the termination or expiration until fulfilled and shall bind the parties and their legal representatives, successors and assigns.

14.8 The parties shall abide by the Financial Conflict of Interest (FCOI) federal regulations (42 CFR Part 50 Subpart F and 45 CFR Part 94) revised effective September 26, 2011.

The parties hereto have caused this Agreement to be executed by duly authorized representatives effective as of the later date indicated below:

SPONSOR

**FLORIDA ATLANTIC UNIVERSITY
BOARD OF TRUSTEES**

Name: _____

Name: _____

Title: _____

Title: _____

Date: _____

Date: _____

APPENDIX A
Scope of Work