

University of Louisville Research Foundation Sponsored Research Agreement

THIS AGREEMENT made this _____ day of _____ 20____, by and between the University of Louisville Research Foundation, Inc. (hereinafter "ULRF") a Kentucky non-profit corporation having an office at MedCenter One, 501 E. Broadway, Suite 200, Louisville, KY 40202-1798 as the agent of the University of Louisville (hereinafter "UofL") for receiving grants and research agreements from external funding sources and which owns and controls intellectual property on behalf of UofL (ULRF and UofL collectively hereinafter "Institution"), and _____ with a principal place of business at _____ (hereinafter "Sponsor").

WHEREAS, the research project contemplated by this Agreement is of mutual interest and benefit to the Institution and Sponsor and will further the instructional, research and public service objectives of the Institution in a manner consistent with its status as a non-profit, tax-exempt, educational institution; and

WHEREAS, SPONSOR desires to provide research funding in support of the research project in return for receiving certain rights in the research results.

NOW, THEREFORE, the parties hereto agree as follows:

1. DEFINITIONS

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

- 1.1 "Principal Investigator" shall mean the Institution investigator under whose supervision the Research is performed and shall mean Dr. _____ of UofL's Department of _____.
- 1.2 "Research" shall mean the project of basic or applied research described in the statement of work entitled _____, a copy of which is attached hereto as Appendix A and hereby made a part of this Agreement.
- 1.3 "Research Period" is the time period during which the Research will be performed by Institution and shall be _____, 20____ to _____, 20____.
- 1.4 "Intellectual Property" shall mean individually and collectively all inventions, improvements, modifications and/or discoveries which are conceived and first reduced to practice or authored in performance of the Research, and all United States and foreign patent and copyright applications which may be filed at any time thereon.
- 1.5 "Institution Intellectual Property" shall mean individually and collectively all Intellectual Property which is conceived and first reduced to practice or authored by one or more employees and/or students of Institution, and all United States and foreign patent and copyright applications which may be filed at any time thereon; provided, Institution Intellectual Property shall include only such Intellectual Property to which Institution is eligible to retain title under its Intellectual Property Policy (<http://louisville.edu/thinker/ip-policy.html>).
- 1.6 "Joint Intellectual Property" shall mean individually and collectively all Intellectual Property which is conceived and first reduced to practice or authored jointly by one or more employees and/or students of Institution and by one or more employees of Sponsor in performance of the Research, and all United States and foreign patent and copyright applications which may be filed at any time thereon; provided, Joint Intellectual Property shall include only such Intellectual Property to which Institution is eligible to retain title under its Intellectual Property Policy (<http://louisville.edu/thinker/ip-policy.html>).

2. RESEARCH

- 2.1 Institution shall commence the performance of the Research promptly after the effective date of this Agreement, provided all approvals required by Institution, law and/or regulation have been obtained (e.g. Institutional Animal Care and Use Committee ("IACUC") approval for use of live vertebrate animals in the Research). Institution shall use reasonable efforts to perform such Research substantially in accordance with the terms and conditions of this Agreement and as described in Appendix A.
- 2.2 If for any reason the Principal Investigator becomes unable or unwilling to continue Research, and a successor acceptable to both parties is not available, ULRF and/or Sponsor shall have the option to terminate this Agreement pursuant to Section 10 hereof.
- 2.3 If the nature of the Research is such that Institution is required to have approval of a review committee(s) (e.g. conflict of interest, IACUC), Principal Investigator (or additional investigator(s) as appropriate), shall prepare and file the Research protocol/outline of work, and/or other required information and documents with the appropriate Institution review committee(s).
- 2.4 Institution has a written conflict of interest policy that is consistent with the policy established by the National Institutes of Health, and to Institution's reasonable knowledge, all financial disclosures required by Institution's policy have been made and appropriate management plan(s) have been developed.
- 2.5 Both parties acknowledge that each reserves the right to terminate the Research and this Agreement if an applicable Institution review committee does not initially approve or subsequently suspends or withdraws its approval of the Research.
- 2.6 Institution and Sponsor agree that Research conducted by Institution hereunder will not constitute a clinical trial or clinical research in which human subjects receive clinical/medical intervention.

3. REPORTING

- 3.1 Principal Investigator shall provide written technical reports on the Research to Sponsor every ____ (#) months, and a final written technical report shall be submitted by the Principal Investigator within sixty (60) days of the conclusion of the Research Period. Institution shall maintain records of the use of the funds provided by Sponsor and during the Research Period shall make such records available to Sponsor upon reasonable notice during regular Institution's business hours, but not more frequently than once each calendar year.
- 3.2 Subject to the provisions for (i) non-use and non-disclosure of Institution's Confidential Information under Section 5 (CONFIDENTIALITY), (ii) the prerogative of Research investigators to first publish Research results in accordance with Section 7 (PUBLICATIONS), and (iii) filing of application(s) for statutory protection of Intellectual Property prior to enabling disclosure thereof in accordance with Section 8 (INTELLECTUAL PROPERTY) herein, Sponsor may use the information provided in written technical reports submitted pursuant to this Section 3 and disclose such information to any third party. Information contained in such written technical reports which remains subject to the terms and conditions of Section 5, Section 7, and/or Section 8 herein shall not be disclosed by Sponsor except on an "as needed" basis (a) to those parties with whom Sponsor has entered into written confidentiality agreements at least as restrictive as the terms of Section 5 herein and has received Institution's prior written permission to make such disclosures, which permission shall not be unreasonably withheld, or (b) in a submission to the United States Food & Drug Administration or a similar foreign agency that regulates approval of new drugs and/or devices, provided that Sponsor

gives Institution sixty (60) days prior written notice of such disclosure and receives Institution's prior written permission, which shall not be unreasonably withheld.

4. PAYMENT OF COSTS

- 4.1 Sponsor will not use any government funds to support the Research hereunder. In consideration of Institution's performance hereunder, Sponsor agrees to support costs incurred in performance of the Research in the amount not to exceed \$_____. Payment by Sponsor shall be sent to the address specified below or on any Institution invoice. Invoices not paid within thirty (30) days of the specified due date are subject to 1% per month interest on the unpaid balance for any amounts not in dispute. Institution reserves the right to discontinue the Research and terminate this Agreement if Sponsor fails to make payment within thirty (30) days of a specified due date. The payment schedule is set forth **{immediately below or in Appendix A}**.
- 4.2 Institution shall retain title to any equipment purchased with funds provided by Sponsor under this Agreement.
- 4.3 The determination of allowable cost for Institution's activities will be made in accordance with the applicable Federal Cost Principle inclusive of all amendments in effect as of the date of this Agreement, and any subsequent amendments: Institutions of Higher Education (OMB Circular A-21)
- 4.4 In the event of termination of this Agreement pursuant to Section 10, Sponsor shall reimburse Institution for all costs incurred and non-cancelable obligations made up to and including the effective date of such notice of termination.

5. CONFIDENTIALITY

- 5.1 In performance of the Research, either party may need to disclose to the other party certain business and/or technical information which is owned or otherwise controlled by the disclosing party and which the disclosing party considers to be proprietary and confidential (hereinafter "Confidential Information"). All such information shall be designated confidential at the time of disclosure by the disclosing party either orally or in writing. If designated confidential orally, the disclosing party shall within thirty (30) days of the date of disclosure confirm in writing the confidential nature of such information. The receiving party shall use reasonable efforts to ensure said Confidential Information is kept confidential as set forth herein. Except as otherwise provided herein, for a period of five (5) years following the date of such disclosure, the receiving party will not disclose the Confidential Information without the consent of the disclosing party and shall use such Confidential Information only for the purposes of this Agreement. Notwithstanding the foregoing, the receiving party may transfer the disclosing party's Confidential Information to those of receiving party's employees, students, officers, directors and agents as may be reasonably necessary to carry out the performance of this Agreement. Information shall not be subject to the aforementioned restrictions where the:
 - (a) information was possessed by receiving party prior to receipt from disclosing party other than through prior disclosure by the disclosing party as evidenced by receiving party's business records;
 - (b) information was published or available to the general public other than through a breach of this Agreement;
 - (c) information was obtained by receiving party from a third party with a valid right to disclose it, provided that said third party is not under a confidentiality obligation to the disclosing party;
 - (d) information was independently developed by employees, students, agents or consultants of receiving party who had no knowledge of or access to the information as evidenced by receiving party's business records;
 - (e) information was disclosed by the receiving party after obtaining the disclosing party's prior written permission to publish or is disclosed in the necessary course of the prosecution of patent

applications upon Institution Intellectual Property or Joint Intellectual Property pursuant to this Agreement; or

- (f) information is required to be disclosed by operation of law, regulation, Attorney General decisions that carry the force of law, or court order.

5.2 Except as otherwise provided herein, upon termination of this Agreement or at the written request of the disclosing party, whichever occurs earlier, the receiving party will use reasonable efforts to destroy or return all of the disclosing party's Confidential Information, including copies thereof. The parties acknowledge that Confidential Information communicated and/or stored in electronic form may be routinely backed up such that return or destruction is not practical and/or feasible, in which case the receiving party will use reasonable efforts to keep such back-up copies secure until the back-up media is recycled or destroyed. The receiving party may retain one (1) archival copy of the disclosing party's Confidential Information received hereunder for the purpose of the receiving party's monitoring its obligations under this Agreement. All copies of the disclosing party's Confidential Information which are retained by the receiving party as permitted under this Section 5.2 shall continue to be protected by the receiving party in accordance with this Section 5.

6. PUBLICITY

- 6.1 Sponsor will not use the name of the Institution, nor of any employee, student, trustee or officer thereof, in advertising or publicity, including news releases, without the prior written consent of the Institution. Institution will not use the name of the Sponsor, nor any employee of Sponsor, in any advertising or publicity, including news releases, without the prior written approval of Sponsor.
- 6.2 Notwithstanding anything to the contrary in this Agreement, the Institution may disclose the identity of the Sponsor, the title of the Research, the name of the Investigator, the Research Period, and the amount of funding support provided to Institution by the Sponsor for the Research.

7. PUBLICATIONS

- 7.1 Sponsor recognizes that under Institution policies, the results of the Research must be publishable and agrees that Institution and Institution investigators have the right to publish and otherwise publicly disclose any information gained in the course of the Research; provided, Sponsor retains the right to preclude publication or other public disclosure of Sponsor's Confidential Information. In order to permit Sponsor an opportunity to determine if patentable inventions or Sponsor's Confidential Information are disclosed therein, the Principal Investigator will provide Sponsor with copies of any proposed publication or presentation by Institution's Research investigators prior to submission for publication. Whenever possible, efforts will be made by the Principal Investigator to provide copies of drafts of intended articles or abstracts as soon as they reach a stage suitable for distribution. Sponsor shall have thirty (30) days, after receipt of said copies, to object to such proposed presentation or proposed publication because it contains potentially patentable subject matter which needs protection and/or because it discloses Sponsor's Confidential Information. In the event that Sponsor makes an objection because its Confidential Information is disclosed in the proposed presentation or publication, such Confidential Information will be deleted from the proposed presentation or publication by the Principal Investigator and other Institution Research investigators before proceeding with publication or presentation. In the event that Sponsor makes an objection because potentially patentable subject matter is disclosed in the proposed publication or presentation, the Principal Investigator and other Institution Research investigators shall refrain from making such publication or presentation for a reasonable time, not to exceed three (3) months from the date of receipt of such objection, in order for the Institution or Sponsor to file a patent application(s) directed to the patentable subject matter contained in the proposed publication or presentation, in accordance with Section 8 (INTELLECTUAL PROPERTY) below.

8. INTELLECTUAL PROPERTY

- 8.1 For the purposes of this Section 8, right and title to any intellectual property, whether patented, copyrighted or maintained as know-how, shall be determined in accordance with the provisions for determining authorship and inventorship under Titles 17 and 35 of the United States Code, respectively.
- 8.2 All rights and title to Institution Intellectual Property shall belong to ULRF and shall be subject to the terms and conditions of this Agreement.
- 8.3 All rights and title to Joint Intellectual Property shall belong to ULRF and Sponsor, and shall be subject to the terms and conditions of this Agreement.
- 8.4 Institution will promptly notify Sponsor of any Intellectual Property through performance of the Research and will supply Sponsor with a copy of any invention disclosure received from the Principal Investigator describing said Intellectual Property. Likewise, Sponsor will promptly notify Institution of any Intellectual Property created through performance of the Research and will supply Institution with a copy of any invention disclosure thereon received from Sponsor employee(s) describing said Intellectual Property. Sponsor shall have thirty (30) days from the date of Sponsor's receipt of an invention disclosure to decide whether a patent application or application for other intellectual property protection should be sought. If Sponsor decides that a patent application or application for other intellectual property protection should be filed on Institution Intellectual Property, ULRF shall promptly prepare, file and prosecute such U.S. and foreign application(s) in ULRF's name. If Sponsor decides that a patent application or application for other intellectual property protection should be filed on Joint Intellectual Property, ULRF shall promptly prepare, file and prosecute such U.S. and foreign application(s) in ULRF's and Sponsor's names. Sponsor shall bear all costs incurred in connection with such preparation, filing, prosecution and maintenance of U.S. and foreign applications directed to said Institution Intellectual Property or Joint Intellectual Property but may elect to discontinue its financial support of such prosecution and/or maintenance, provided, Sponsor notifies Institution in writing of such decision to discontinue reasonably in advance of Institution's need to respond to any statutory deadlines of which Sponsor has been made aware. Sponsor shall be given reasonable opportunity to review and contribute to the content of said application(s). Sponsor shall ensure that such application(s) to the best of the Sponsor's knowledge cover all items of commercial interest and significance. ULRF shall keep Sponsor advised as to all developments with regard to said application(s) and shall promptly provide to Sponsor copies of all documents received and/or filed in connection with the filing, prosecution or maintenance thereof in reasonable time, subject to statutory deadlines, for the Sponsor to comment and contribute thereto.
- 8.5 If the Sponsor elects not to support the filing of a patent application or other intellectual property protection for any Institution Intellectual Property or Joint Intellectual Property or decides to discontinue its financial support of the prosecution or maintenance of any applications, ULRF shall be free to file or continue prosecution or maintain any such application(s), and to maintain any issued patents thereon in the U.S. and any foreign country at Institution's expense. Such patent applications and issued patents shall be excluded from Sponsor's option under Section 9 hereof.

9. GRANT OF RIGHTS

- 9.1 In consideration of Sponsor's funding of the Research and payment for intellectual property protection as provided for in Section 8.4, ULRF grants, subject to any contractual obligations to third parties and to the extent Institution is able to do so under its policies, the Sponsor the exclusive first option for an exclusive or non-exclusive, at the Sponsor's sole election, license to any Institution Intellectual Property or Institution's interest in Joint Intellectual Property. Such license shall be for fair and valuable consideration and shall include a reasonable royalty rate and, subject to Institution's policies, shall include other such terms as are typical in licenses of similar technology from not-for-profit organizations to for-profit organizations. ULRF and Sponsor will negotiate in good faith to determine the terms of such license. Sponsor's option shall extend for an option time period of three (3) months from the date of disclosure of the Institution Intellectual Property or Joint Intellectual Property to Sponsor.

- 9.2 If Sponsor elects not to exercise its option pursuant to Section 9.1 or fails to negotiate a license agreement to the subject Institution Intellectual Property or Joint Intellectual Property within six (6) months after election of the option, then:
- (a) Institution shall have no further obligation to Sponsor and Sponsor shall have no further right with regard to such Institution Intellectual Property and Institution may license its interest in such Institution Intellectual Property to any party upon terms Institution deems appropriate;
 - (b) Sponsor shall pay to ULRF a royalty on any product that is covered by Joint Intellectual Property, such rate to be one-half the rate of the relevant industry standard;
 - (c) Either party is free to license any third party under Joint Intellectual Property. Each party shall fully account to the other for compensation derived from such license, with two-thirds of the compensation to the licensing party and one-third to the non-licensing party.
- 9.3 Any license granted to Sponsor by ULRF shall be subject, if applicable, to the rights of the United States government reserved under Public Laws 96-517, 97-256 and 98-620, codified at 35 U.S.C. 200-212, and any regulations issued thereunder, and shall include, at minimum, a fully paid-up, royalty-free, perpetual non-exclusive license in favor of the Institution and its employees who are determined in accordance with the University of Louisville Intellectual Property Policy to be creators of the licensed Institution Intellectual Property and Joint Intellectual Property, to use it for noncommercial, educational and research purposes.

10. TERMINATION

- 10.1 This Agreement shall become effective upon the date first hereinabove written and shall continue in effect for the full duration of the Research Period unless sooner terminated pursuant to this Section. Either party may terminate this Agreement upon ninety (90) days prior written notice to the other.
- 10.2 In the event that either party hereto shall commit any breach of or default in any of the terms or conditions of this Agreement, and also shall fail to remedy such default or breach within thirty (30) days after receipt of written notice thereof from the other party hereto, the party giving notice may, at its option and in addition to any other remedies which it may have at law or in equity, terminate this Agreement by sending notice of termination in writing to the other party to such effect and such termination shall be effective as of the date of receipt of such notice.
- 10.3 Either party may terminate this Agreement immediately at any time by written notice to the other party if (a) the Principal Investigator becomes unwilling or unable to continue in that role and a successor acceptable to both parties is not available, or (b) the applicable Institution review committee does not initially approve or subsequently suspends or withdraws its approval of the Research.
- 10.4 Termination of this Agreement by either party for any reason shall not affect the rights and obligations of the parties accrued prior to the effective date of termination of this Agreement. No termination of this Agreement, however effectuated, shall release either party from its rights and obligations under Sections 4, 5, 6, 7, 8 and 12.

11. INDEPENDENT PARTIES

- 11.1 For the purposes of this Agreement, the parties shall be independent contractors. Nothing contained herein shall be deemed or construed to create between the parties hereto a partnership or joint venture or the relationship of agent and principal.

12. DISCLAIMER OF WARRANTIES, INDEMNIFICATION

- 12.1 Institution makes no warranties, express or implied, as to any matter whatsoever, including without limitation, warranties with respect to the conduct, completion, success or particular results of the

Research, or the condition, ownership, merchantability, or fitness for a particular purpose of the Research or any Institution Intellectual Property or Joint Intellectual Property. Institution shall not be liable for any direct, indirect, consequential, punitive or other damages suffered by Sponsor or any other person resulting from the Research or from the use of the results of the Research or any Institution Intellectual Property or Joint Intellectual Property.

12.2 Sponsor shall defend, indemnify and hold harmless Institution, the Principal Investigator and any of Institution's faculty, students, employees, trustees, officers, affiliates and agents and their respective successors, heirs and assigns (hereinafter referred to collectively as the "Indemnified Persons") from and against any and all liability, claims, lawsuits, losses, damages, costs or expenses (including attorney's fees) (collectively "Losses") which the Indemnified Persons may hereafter incur, or be required to pay as a result of Sponsor's use of the results of the Research or of any Institution Intellectual Property or Joint Intellectual Property or any act or omission of Sponsor, its employees, affiliates, contractors, licensees or agents. Notwithstanding the foregoing, Sponsor's indemnification obligations under this Section shall not apply to any Losses to the extent such Losses are attributable to the gross negligence or willful misconduct of any of the Indemnified Persons. Institution shall notify Sponsor upon learning of the institution or threatened institution of any such liability, claims, lawsuits, losses, damages, costs and expenses.

12.3 Sponsor hereby assumes any risks of personal injury and property damage attributable to the negligent acts or omissions of Sponsor, and of Sponsor's officers, employees, and agents, in the performance of the Research.

13. ASSIGNMENT

13.1 This Agreement shall not be assigned by Sponsor without the prior written consent of the ULRF.

14. GOVERNING LAW

14.1 This Agreement shall be governed and construed in accordance with the laws of the Commonwealth of Kentucky without giving effect to the conflict of laws provisions.

15. NOTICES

15.1 Notices, invoices, communications and payments hereunder shall be deemed made if given in writing and addressed to the party to receive such notice, invoice, communication or payment at the address given below, or such other address as may hereafter be designated by notice in writing. Notices shall be delivered by certified or registered first class mail (airmail if not domestic) or by commercial courier service, and shall be deemed to have been given or made (a) when delivered personally; (b) when sent by confirmed facsimile; (c) three (3) days after having been sent by registered or certified mail, return receipt requested, postage prepaid; or (d) three (3) days after deposit with a commercial overnight carrier with confirmed verification of receipt.. All communications will be sent to the addresses set forth below or to such other address as may be designated by a party by giving written notice to the other party pursuant to this Section.

If to Sponsor:

If to URLF:

Director, Office of Industry Contracts
University of Louisville Research Foundation, Inc.

MedCenter One
501 East Broadway, Suite 200
Louisville, KY 40202-1798
Fax: 502-852-2590

With a copy to:

[Principal Investigator's Name]
[Dept and Building Address]
University of Louisville
Louisville, KY 402##

16. ADDITIONAL PROVISIONS

- 16.1 In the event any part, article, section, subsection, clause, paragraph or subparagraph of this Agreement shall be held to be indefinite, invalid, illegal or otherwise voidable or unenforceable, the entire Agreement shall not fail on account thereof, and the balance of the Agreement shall continue in full force and effect.
- 16.2 A waiver by either party of a breach or violation of any provision of this Agreement will not constitute or be construed as a waiver of any subsequent breach or violation of that provision or as a waiver of any breach or violation of any other provision of this Agreement.
- 16.3 No exercise of a specific right or remedy by any party precludes it from or prejudices it in exercising another remedy or maintaining an action to which it may otherwise be entitled either at law or in equity.
- 16.4 During the performance of this Agreement, Sponsor and Institution shall not discriminate against any employee or applicant for employment because of race, color, sex, sexual preference, age, religion, national or ethnic origin, handicap, or because he/she is a disabled veteran or veteran of the Vietnam era.
- 16.5 Each party shall comply with all laws, regulations and other legal requirements applicable to them in connection with this Agreement.
- 16.6 Prior to disclosure by Sponsor to Institution hereunder of any export controlled information and/or technology, including but not limited to export controlled Confidential Information, devices, software, chemical compounds or biological materials (hereinafter collectively "Controlled Information/Technology"), Sponsor shall so inform Institution and its Principal Investigator and shall provide the citation(s) of the U.S. export control law(s) or regulation(s) applicable to each item (or group of items) of Controlled Item/Technology. Institution shall have the option to decline acceptance of such Controlled Item/Technology, and if the parties cannot mutually agree to modify the statement of work set forth in Appendix A to accomplish the Research without requiring Institution's access to such Controlled Item/Technology, either party may terminate this Agreement immediately by providing written notice to the other in accordance with Section 15 or the parties may agree to amend the Agreement (and its associated budget) accordingly as needed to address these additional requirements.

17. AGREEMENT MODIFICATION

- 17.1 This Agreement is the final and complete understanding of the parties with respect to the subject matter hereof superseding all prior agreements, understandings and discussions relating thereto. No amendments or changes to this Agreement including, without limitation, changes to the field of Research, total cost or Research Period, shall be valid unless the change is made in writing and signed by authorized representatives of the parties hereto. The appendices will be binding upon the parties hereto except to the extent they may conflict with the terms and conditions contained within this Agreement, in which case the terms and conditions of the Agreement will govern.

[SIGNATURE PAGE FOLLOWS:]

IN WITNESS WHEREOF, authorized representatives of the parties hereto have executed this Agreement as of the date first above written.

THE UNIVERSITY OF LOUISVILLE
RESEARCH FOUNDATION, INC.

[SPONSOR NAME]

Signature: _____

Signature: _____

Printed Name: _____

Printed Name: _____

Title: _____

Title: _____

Date: _____

Date: _____

Principal Investigator, while not a party to this Agreement, by his/her signature acknowledges that he/she:

- (1) has read and agrees to abide by the terms and conditions that apply to the Principal Investigator,
- (2) agrees to communicate the terms and conditions of this Agreement to and use reasonable efforts to ensure compliance with its applicable obligations by all Institution personnel who are performing Research under his/her supervision or direction,
- (3) agrees to conduct/perform the Research as described in this Agreement and in Appendix A,
- (4) has no consulting agreements with SPONSOR, and
- (5) if applicable, will see that the Research within the scope of this Agreement is performed in accordance with an approved University/Institution management plan.¹

Principal Investigator's Name: _____

Signature: _____

Title: _____

Date: _____

¹ "**Management Plan**" means a written plan for the management, reduction or elimination of a potential financial conflict of interest relating to research. It relies upon, and is therefore limited by, good faith disclosures about significant financial interests made, and other information provided by, a covered individual to the University.

