

INTER-INSTITUTIONAL AGREEMENT

Emory University -- "[insert institution name]"

THIS AGREEMENT is effective this [date] day of [month], 200[year] (hereafter, "EFFECTIVE DATE") by and between Emory University, a Georgia nonprofit corporation with offices located at 1599 Clifton Road NE, 4th Floor, Mailstop 1599/001/1AZ Atlanta, Georgia 30322, (hereinafter "EMORY") and "[insert institution name]" with offices located at "[insert address]" (hereinafter "INSTITUTION").

BACKGROUND

Certain collaborative research performed at EMORY and at INSTITUTION resulted in the development of inventions disclosed in EMORY File No. "[insert number]" and INSTITUTION Case No. "[insert number]" (hereinafter "INVENTIONS").

INSTITUTION wishes to appoint EMORY as its sole representative and agent for the sole purpose of administering and licensing the PATENT RIGHTS (as defined below) covering the INVENTIONS.

Therefore, in consideration of the mutual obligations set forth below, EMORY and INSTITUTION agree as follows:

1. DEFINITIONS.

- 1.1 "PATENT RIGHTS" means all right, title and interest in, to and under the patent applications listed in Appendix A and any substitutions, extensions, divisionals, continuations, or foreign counterparts of the foregoing patent applications and patents which issue thereon anywhere in the world, including reexamined and reissued patents.
- 1.2 "NET REVENUES" means gross proceeds received by EMORY from the licensing of PATENT RIGHTS less all reasonable and actual out-of-pocket costs (exclusive of any salaries, internal administrative, or other indirect costs) incurred by EMORY and INSTITUTION in the preparation, filing, prosecution, and licensing of PATENT RIGHTS, and litigation (except for those litigation costs covered by Article 6) and maintenance of resulting patents.
- 1.3 "LICENSE AGREEMENT" means any license agreement that is entered into by EMORY under this AGREEMENT and grants to LICENSEE (as defined below) thereunder the right to make, have made, use, import, offer to sell and/or sell products covered by PATENT RIGHTS, or any agreement granting an option for such a license.
- 1.4 "LICENSEE" means any licensee to a LICENSE AGREEMENT.

2. PATENT PROSECUTION AND PROTECTION

- 2.1 EMORY shall direct the filing, prosecution and maintenance of all patent applications and patents under the PATENT RIGHTS. EMORY shall prepare and file appropriate United States and foreign country patent applications covering the INVENTIONS and shall provide to INSTITUTION all serial numbers and filing dates, together with copies of all the applications, including copies of all patent prosecution actions, responses and other communications. As reasonable under the circumstances and relevant deadlines, EMORY will give INSTITUTION an opportunity to comment during all such patent prosecutions.
- 2.2 If foreign patent application filings are contemplated after the Effective Date, EMORY shall, after consulting with INSTITUTION and within two (2) months in advance of any deadline to file foreign patent applications (PCT or national stage applications), make an election whether, when, and in what countries, it wishes to file foreign patent applications. EMORY shall notify INSTITUTION, in writing, of its election regarding foreign filing. If foreign applications are filed, EMORY shall provide to INSTITUTION all serial numbers and filing dates. EMORY also shall provide to INSTITUTION copies of foreign patent applications and patent office actions as INSTITUTION may request in the course of prosecution.
- 2.3 EMORY shall bear "[insert number]" percent ("[insert number]" %) and INSTITUTION shall bear "[insert number]" percent ("[insert number]" %) of the costs for filing, prosecution, maintenance and enforcement of the PATENT RIGHTS. If EMORY anticipates the possibility of any extraordinary costs, EMORY shall provide INSTITUTION with full particulars and shall discuss with INSTITUTION a mutually acceptable course of action prior to incurring such expenditures. If LICENSEE(s) agrees to pay for any portion of costs for PATENT RIGHTS, EMORY shall be responsible for "[insert number]" percent ("[insert number]" %) and INSTITUTION shall be responsible for "[insert number]" percent ("[insert number]" %) of costs not reimbursed by licensee(s). Costs paid by the parties and specifically reimbursed later by a LICENSEE shall be split between the parties using the same percentage as previously specified in this Paragraph 2.3- "[insert number]" percent ("[insert number]" %) to EMORY and "[insert number]" percent ("[insert number]" %) to INSTITUTION. INSTITUTION shall reimburse EMORY for its share of all costs within thirty (30) days of receipt of an invoice from EMORY and copies of invoices paid or incurred by EMORY for which EMORY is requesting reimbursement. Reimbursement by INSTITUTION shall be made by check made payable to Emory University and sent to EMORY according to the provisions for notices in Article 8 herein.
- 2.4 If INSTITUTION elects not to share the expenses or assist in filing a patent application under the PATENT RIGHTS or chooses not to prosecute or maintain a patent application or issued patent within the PATENT RIGHTS, in any country, it shall notify EMORY in writing. Under such circumstances, INSTITUTION has the right and may have the obligation to release such PATENT RIGHTS to INSTITUTION inventors, the United

States Government or another research funding entity. EMORY may, at its sole discretion and sole expense, contract with INSTITUTION inventors to continue the prosecution and/or maintenance of such application or patent if such PATENT RIGHTS are released to INSTITUTION inventors.

- 2.5 In the event that INSTITUTION elects not to share the expenses or assist in filing a patent application under the PATENT RIGHTS or chooses not to prosecute or maintain a patent application or issued patent within the PATENT RIGHTS, in any country, and such PATENT RIGHTS are not released to INSTITUTION inventors, the United States Government or another research funding entity, INSTITUTION shall assign ownership of such PATENT RIGHTS to EMORY and shall execute an agreement so assigning such rights.
- 2.6 For the PATENT RIGHTS in any country in which INSTITUTION elects not to prepare or file a patent application under the PATENT RIGHTS or chooses not to prosecute or maintain a patent application or issued patent, EMORY shall have no obligation to INSTITUTION under the terms in Sections, 2.3, 3, 4, 5, and 6 of this AGREEMENT for such PATENT RIGHTS.
- 2.7 If EMORY elects not to prepare or file a patent application under the PATENT RIGHTS or chooses not to prosecute or maintain a patent application or issued patent within the PATENT RIGHTS, in any country, it shall notify INSTITUTION in writing. Under such circumstances, EMORY has the right and may have the obligation to release such PATENT RIGHTS to EMORY inventors, the United States Government or another research funding entity. INSTITUTION may, at its sole discretion and sole expense, contract with EMORY inventors to continue the prosecution and/or maintenance of any such application or patent, where such rights have been waived to EMORY inventors.
- 2.8 In the event that EMORY elects not to prepare or file a patent application under the PATENT RIGHTS or chooses not to prosecute or maintain a patent application or issued patent within the PATENT RIGHTS, in any country, and such PATENT RIGHTS are not released to EMORY inventors, the United States Government or another research funding entity, EMORY shall assign ownership of such PATENT RIGHTS to INSTITUTION and shall execute an agreement so assigning such rights.
- 2.9 For the PATENT RIGHTS in any country in which EMORY elects not to prepare or file a patent application under the PATENT RIGHTS or chooses not to prosecute or maintain a patent application or issued patent, INSTITUTION shall have no obligation to EMORY under the terms in Sections, 2.3, 3, 4, 5, and 6 of this AGREEMENT for such PATENT RIGHTS.
- 2.10 EMORY shall record Assignments of PATENT RIGHTS in the United States Patent and Trademark Office and shall provide INSTITUTION with a photocopy of each recorded Assignment.

- 2.11 EMORY shall promptly provide to INSTITUTION copies of all patents issued under PATENT RIGHTS.
- 2.12 EMORY makes no representations and grants no warranties, and INSTITUTION will hold EMORY harmless, regarding the scope of any patents that might issue or that any patents will issue among the PATENT RIGHTS.

3. LICENSING

- 3.1. Other than for the specific purpose of INSTITUTION research, education or internal uses, INSTITUTION shall not grant to any person any right, license, title, or interest in, to or under PATENT RIGHTS. INSTITUTION grants to EMORY the sole responsibility for administering and licensing the PATENT RIGHTS, subject to the provisions of this AGREEMENT.
- 3.2. INSTITUTION hereby appoints EMORY as its sole agent in negotiating, executing and maintaining LICENSE AGREEMENTS and grants EMORY the exclusive right to execute LICENSE AGREEMENTS on INSTITUTION's behalf. INSTITUTION will have the right to review, comment upon and approve any proposed LICENSE AGREEMENT or amendment thereto, prior to execution, such approval not be unreasonably withheld. INSTITUTION agrees that its approval will not be withheld due to the financial terms of the agreement. EMORY shall diligently seek a LICENSEE for the commercial development of commercial products under the PATENT RIGHTS and shall promptly provide to INSTITUTION copies of all executed LICENSE AGREEMENTS relating to the INVENTIONS. EMORY shall have the final authority to enter into negotiations and to execute LICENSE AGREEMENTS and shall exercise its reasonable efforts to ensure that any LICENSEE shall fully comply with the terms of any LICENSE AGREEMENT. Under no circumstances shall EMORY be liable to INSTITUTION for monetary damages for any alleged failure by EMORY to meet the obligations stated in this Paragraph 3.2.
- 3.3. Any LICENSE AGREEMENT must include, but is not limited to, the following terms: indemnification of EMORY and INSTITUTION by LICENSEE, a disclaimer of warranties on the part of INSTITUTION and EMORY and a prohibition against the use of the name of INSTITUTION or EMORY. Any LICENSE AGREEMENT may further include an earned royalty, payment of patent costs by the LICENSEE, product development milestones, and product development diligence terms. Any LICENSE AGREEMENT will further stipulate that nothing in the LICENSE AGREEMENTS confers by estoppel implication or otherwise, any license or rights under any patents of EMORY and INSTITUTION other than PATENT RIGHTS, regardless of whether such patents are dominant or subordinate to the PATENT RIGHTS.
- 3.4. LICENSE AGREEMENTS will expressly reserve to INSTITUTION and EMORY the right to practice the PATENT RIGHTS for educational, research and internal purposes. The LICENSE AGREEMENTS will also expressly reserve to INSTITUTION and

EMORY the right to grant licenses for PATENT RIGHTS to the United States Government, in accordance with Public Law 96-517, 37 CFR, Part 401 and other statutes, regulations, and Executive Orders as now exist or may be amended or enacted.

4. FINANCIAL TERMS

- 4.1 EMORY shall distribute to INSTITUTION "[insert number]" percent ("[insert number]" %) of NET REVENUES within sixty (60) days of receiving proceeds under the LICENSE AGREEMENT. With such distribution, EMORY shall provide a financial accounting showing gross revenue received during the preceding calendar year and all deductions therefrom.
- 4.2. Each party is solely responsible for calculating and distributing to its respective inventors any portion of that party's share of NET REVENUES received under this AGREEMENT as may be due in accordance with its respective patent policy.

5. RECORDS AND REPORTS

- 5.1 EMORY shall keep complete, true, and accurate accounts of all expenses and of all NET REVENUES received by it from each LICENSEE for a period of five (5) years and shall permit INSTITUTION to allow its own agents or a certified public accounting firm which is reasonably acceptable to EMORY to examine its books and records in order to verify the payments due or owing under this AGREEMENT. INSTITUTION shall pay the cost of each examination and shall request no more than one (1) examination per year.

6. PATENT INFRINGEMENT

- 6.1 (a) In the event that EMORY or INSTITUTION becomes aware of the infringement or claim of infringement of any patent within any territory under the PATENT RIGHTS, each shall inform the other in writing of all details available. If the PATENT RIGHTS have not already been licensed, the parties shall confer with the intent of reaching mutual agreement on whether and in what manner to enforce the rights of the parties thereto, whether by appropriate legal proceedings or otherwise (including, without limitation, the settlement or abandonment of any claim either party may have against any third party). EMORY and INSTITUTION shall share all costs relating to any such agreed upon enforcement action in the same proportions as the parties will share revenues under Section 4 herein. Any sums recovered with respect to any such action shall be applied first to reimburse out-of-pocket expenses incurred by EMORY and INSTITUTION relating to the enforcement action and the remaining sums shall be deemed NET REVENUES hereunder and shall be shared by the parties as set forth in Section 4 above.
- (b) If either EMORY or INSTITUTION elects not to enforce or to continue to enforce the PATENT RIGHTS, it shall notify the other in writing. Under such circumstances, the

other party, may elect to prosecute the infringers at its sole expense provided that (i) the party electing to prosecute shall pay all costs and expenses arising out of such prosecution, (ii) the party electing to prosecute shall not have any right to surrender the non-prosecuting party's rights or to grant any infringer any rights other than a license subject to the conditions of Article 3 herein, and (iii) any sums recovered with respect to any such action shall be applied first to reimburse out-of-pocket expenses incurred by the parties relating to the enforcement action and the remaining sums, including NET REVENUES, shall be shared by the parties in proportion to their financial contribution toward the enforcement action.

In any infringement suit instituted to enforce the PATENT RIGHTS pursuant to this AGREEMENT, both parties shall, at the request and expense of the party initiating such suit, make a reasonable effort to cooperate in all respects and, to the extent possible, have its employees testify when requested and make available relevant records, papers, information, samples, and the like.

7. NOTICES

Any notice required or permitted to be given to the parties hereto is properly given if delivered in writing, in person, sent by first-class certified mail, or by overnight carrier, to the following addresses, or to such other addresses as may be designated in writing by the parties from time to time during the term of this AGREEMENT:

to INSTITUTION:

"[insert institution name]"
"[insert institution address]"
"[insert institution address]"

Attn.: Case No. : "[insert number]"

to EMORY :

Emory University
Office of Technology Transfer
1784 North Decatur Rd
Suite 130
Atlanta, GA 30322

Attn.: Case No. : "[insert number]"

8. TERMINATION

- 8.1 This AGREEMENT is in full force and effect from the EFFECTIVE DATE and remains in effect until the expiration of the last-to-expire patent in PATENT RIGHTS, unless otherwise terminated by operation of law or by acts of the parties in accordance with the terms of this AGREEMENT.

- 8.2 If this AGREEMENT has been in effect for at least three (3) years and if a LICENSE AGREEMENT(s) is (are) not in effect or in negotiation, then either party may terminate this AGREEMENT for any reason upon at least ninety (90) days written notice to the other party, but in any event not less than ninety (90) days prior to any patent prosecution deadline, whereby the failure to meet such deadline would result in any of the PATENT RIGHTS going abandoned. Nothing herein will be construed to release either party of any obligation matured prior to the effective date of termination, or rescind any payments made or due before termination.
- 8.3 Termination of this AGREEMENT shall not affect the obligation of the terminating party to pay its share of costs related to the PATENT RIGHTS in accordance with Article 2. Payment of such costs related to the PATENT RIGHTS shall continue for the life of each patent contained in the PATENT RIGHTS. Should either party decline to pay for its share of costs and charges associated with the filing, prosecuting, maintaining or enforcing the PATENT RIGHTS, it shall so notify the other party in writing pursuant to Sections 2.4 through 2.9 above.
- 8.4 Termination of this AGREEMENT shall not affect any LICENSEE AGREEMENT(s) then in existence, and NET REVENUES received from such LICENSEE AGREEMENT(s) shall be distributed as set forth in this AGREEMENT. EMORY and INSTITUTION agree that, upon termination, both parties will be permitted to grant nonexclusive licenses under the PATENT RIGHTS, without paying compensation to the other party to this AGREEMENT, provided that each party pays fifty percent (50%) of all costs incurred thereafter in the preparation, prosecution, and maintenance of PATENT RIGHTS. All such license agreement(s) granted after termination of this AGREEMENT shall not contain terms that would create a breach by EMORY or INSTITUTION of the provisions of any LICENSE AGREEMENT(s) granted prior to termination. Each party will be solely responsible for distributing any monies received from its own licensing of the PATENT RIGHTS according to its own policies, unless the parties otherwise agree in writing. Apart from the obligation to share patent costs and apart from the obligations accrued prior to termination, the parties will have no further rights or obligations under this AGREEMENT after effective termination.

9. CONFIDENTIALITY

- 9.1 Subject to each party's state law, if applicable, EMORY and INSTITUTION respectively shall hold in confidence and use only for the purposes of this AGREEMENT any written information and data supplied by to it by the other party under this AGREEMENT and marked as proprietary using at least the same degree of care as that party uses to protect its own proprietary information of a like nature. If proprietary information is orally disclosed, the disclosing party shall reduce the proprietary information to writing or to some other physically tangible form and deliver it to the receiving party within thirty (30) days of the oral disclosure, marked and labeled as set forth above.

- 9.2 Nothing in this AGREEMENT in any way restricts or impairs the right of INSTITUTION and EMORY to use or disclose any information or data that:
- (i) recipient can demonstrate by written records was previously known to it; or
 - (ii) is now, or becomes in the future, public knowledge other than through acts or omissions of recipient; or
 - (iii) is lawfully obtained without restrictions by recipient from sources independent of the disclosing party; or
 - (iv) was made independently without the use of proprietary information received hereunder; or
 - (v) is required by law or court order to be disclosed, provided that the receiving party uses its best efforts to notify the disclosing party immediately upon learning of such requirement in order to give the disclosing party reasonable opportunity to oppose such requirement.
- 9.3 The confidentiality obligations of the recipient under these terms will remain in effect for five (5) years from the date the proprietary information is received, and such obligations will survive termination of this AGREEMENT should this AGREEMENT terminate prior to completion of the period that the obligations are to remain in effect.

10. MEDIATION

- 10.1 In the event of any controversy, claim or dispute arising out of, or related to this AGREEMENT, the "[insert title]" of INSTITUTION and the Vice President for Research Administration of EMORY shall attempt to negotiate a settlement within thirty (30) days of notice.
- 10.2 Should a settlement not be reached within sixty (60) days of notice, both parties shall agree to resolve the dispute through the selection of an independent mediator agreed to by the parties. In the event of a dispute of inventorship, the mediator must be a patent agent or attorney registered with the USPTO. The individual appointed shall have no relationship, professional, personal or otherwise, with the parties. All costs of the mediation incurred shall be borne equally among the parties and the results of the mediation shall be final. Nothing contained herein shall prevent any party from enforcing its rights using any available remedy.

11. GENERAL

- 11.1 Use of Names and Trademarks. Other than for the licensing activities contemplated by this AGREEMENT, this AGREEMENT does not confer any right to use any name, trade

name, trademark, or other designation of either party to this AGREEMENT (including contraction, abbreviation or simulation of any of the foregoing) in advertising, publicity or other promotional activities.

- 11.2 No Waiver. No waiver by either party hereto of any breach or default of any of the covenants or agreements herein set forth may be deemed a waiver as to any subsequent and/or similar breach or default.
- 11.3 No Implied License. This AGREEMENT relates solely to the PATENT RIGHTS and does not confer by implication, estoppel, or otherwise any license or rights under any patents of either party other than the PATENT RIGHTS, regardless of whether such patents are dominant or subordinate to PATENT RIGHTS.
- 11.4 Complete Agreement. This AGREEMENT constitutes the entire agreement, both written and oral, between the parties, and it supersedes all prior and contemporaneous agreements respecting the subject matter of this AGREEMENT, written or oral, expressed or implied.
- 11.5 INSTITUTION represents and warrants that as of the EFFECTIVE DATE, (i) INSTITUTION owns any and all right, title and interest of "[LIST UNIVERSITY INVENTORS]" in the PATENT RIGHTS and has the right to grant EMORY the exclusive right to enter into LICENSE AGREEMENTS on behalf of INSTITUTION under this AGREEMENT, (ii) INSTITUTION through its Office of Technology Transfer is not aware of and has not received any legal claims or assertions that would render the PATENT RIGHTS invalid or unenforceable, (iii) during the term of this AGREEMENT, INSTITUTION will not knowingly enter into any agreement, instrument or understanding that is inconsistent with or conflicts with its obligations under this AGREEMENT, and (iv) in the event of an inconsistent arrangement, INSTITUTION shall use its best efforts to eliminate the inconsistency without affecting the terms of this AGREEMENT. In no event shall the existence of any inconsistent arrangement affect the enforceability of any provision of this AGREEMENT or any of INSTITUTION's obligations hereunder.
- 11.6 Nothing in this AGREEMENT shall be construed as: (i) a warranty or representation by EMORY or INSTITUTION as to the validity or scope of any right included in the PATENT RIGHTS or the INVENTION (ii) a warranty or representation that anything made, sold, used or otherwise disposed of under any LICENSE AGREEMENTS granted pursuant to this AGREEMENT will or will not infringe on patents of third parties (iii) an obligation to bring or prosecute actions or suits against third parties for infringement of the PATENT RIGHTS (iv) an obligation to furnish any know-how not provided in the PATENT RIGHTS or INVENTION or any services other than those specified in this AGREEMENT, or (v) a warranty or representation by EMORY or INSTITUTION that they will not grant licenses to others to make, use or sell products not covered by the claims of the PATENT RIGHTS which may be similar and/or compete with products made or sold by any LICENSEE(s) or a sublicensee(s) of LICENSEE(s).

11.7 EMORY AND INSTITUTION MAKE NO REPRESENTATIONS, EXTEND NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED, AND ASSUME NO RESPONSIBILITIES WHATSOEVER WITH RESPECT TO USE, SALE, OR OTHER DISPOSITION BY ANY LICENSEE(S), ITS SUBLICENSEE(S) OR THEIR VENDEES OR OTHER TRANSFEREES OF PRODUCT INCORPORATING OR MADE BY USE OF THE PATENT RIGHTS OR INVENTIONS. This AGREEMENT binds and inures to the benefit of the parties, their successors or assigns, but may not be assigned by either party without the prior written consent of the other party, which consent will not be unreasonably withheld, and subject to approval by federal granting agencies, if required.

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IN WITNESS WHEREOF, the parties have caused this AGREEMENT to be executed by their respective duly authorized officers or representatives.

EMORY UNIVERSITY

"[INSERT INSTITUTION NAME]"

By: _____

By: _____

Name: Todd T. Sherer, Ph.D.

Name: [insert full name]

Title: Assistant Vice President for Research and
Director office of Technology Transfer

Title: [insert title]

Date: [insert date]

Date: [insert date]

IIA. "[insert number]" . "[insert number]"

APPENDIX A
PATENT RIGHTS