Question #4

PATENT MANAGEMENT ORGANIZATIONS WITH WHICH

IPA HOLDERS HAVE AGREEMENTS

Research Corporation

California Institute Research Foundation

Battelle Development Corporation

University of Illinois Foundation

University of Iowa Research Foundation

Iowa State University Research Foundation, Inc.

The Kansas University Endowment Association

The Ohio State University Research Foundation

The Pennsylvania Research Corporation

Concept Development Corporation

Noned Corporation

Rutgers Research and Educational Foundation

Wisconsin Alumni Research Foundation

AGREEMENT ATTACHMENT F

THIS AGREEMENT, made this 3rd day of March , 1953, between THE UNIVERSITY OF ROCHESTER, a New York corporation with offices at 15 Prince Street, Rochester, New York, hereinafter called "UNIVERSITY", and RESEARCH CORPORATION, a New York corporation with offices at 405 Lexington Avenue, New York 17, New York, hereinafter called "RESEARCH":

WITNESSETH THAT:

A. WHEREAS, UNIVERSITY believes that patentable inventions may be made by members of its faculty, its associates or employees and desires to have such inventions evaluated for patentability and commercial and scientific utility, and to have patent applications filed thereon where justified; and

B. WHEREAS, UNIVERSITY desires that all of these inventions be administered in an effective manner and with due regard for the public interest; and

C. WHEREAS, UNIVERSITY further desires that any net income from these inventions be used to provide means for the advancement and extension of technical and scientific investigation, research, experimentation and education; and

D. WHEREAS, RESEARCH has had broad experience in the handling of inventions and patents and in making them more available and effective in the useful arts and manufactures and for scientific purposes and otherwise; and

E. WHEREAS, RESEARCH is a corporation organized for the purpose of providing means for the advancement and extension of

I. UNIVERSITY'S Duties: UNIVERSITY agrees to:

1) Recommend to members of its faculty, its associates and employees, in such cases as UNIVERSITY may in its discretion determine, that they assign to RESEARCH such inventions as they may make.

2) Afford to RESEARCH, upon request, the advice and assistance of UNIVERSITY'S faculty, associates and employees, in seeking patents upon such inventions or introducing them into public use, without charge therefor, but solely to the extent that the giving of such advice and assistance will not interfere with their normal academic duties with or for UNIVERSITY.

3) Act upon and/or accept such tenders and assignments as may be made to it by RESEARCH under this agreement.

II. RESEARCH'S Duties: RESEARCH agrees at its own sole cost and expense to:

1) Accept such of said inventions as it may determine, in its discretion, should be made the subject of patent applications.

2) File United States patent applications thereupon, and prosecute the same in good faith with the intention of securing issuance of patents.

3) File corresponding foreign patent applications thereupon, and prosecute the same in good faith with the intention of securing issuance of patents thereon, and maintain such patents and cause them to be worked, all to the extent that it may in its

(except pursuant to Article II, paragraph 10, or Article IV, paragraph 1(b), of this agreement) without the prior written consent of UNIVERSITY in each case first obtained; and provided, further, that RESEARCH shall not issue to any person, firm or corporation, under any such invention, patent application or patent any license to be exclusive, in favor of the licensee thereunder, for a period of more than seven (7) years from the issuance of such license, without the prior written consent of UNIVERSITY in each case first obtained.

5) Issue to each inventor so assigning to it a letter-agreement, substantially in the form attached hereto as Exhibit A, entitling him to participation hereunder.

6) Pay to each such inventor, his heirs, assigns and personal representatives, not later than March 15 in each year a fixed percentage (to be determined by UNIVERSITY in each case and communicated by it to RESEARCH) not exceeding a total of fifteen (15%) per centum, of all moneys received by it against the preceding calendar year by reason of RESEARCH'S ownership and/or management of such inventions, patent applications and patents, as he shall be entitled to under the pertinent letter-agreement or letter-agreements issued under Article II, paragraph 5, hereof, and furnish to him simultaneously a report showing the computation thereof.

7) Pay to UNIVERSITY, its successors and assigns, not later than March 15 in each year, fifty per centum (50%) of [illegible] received by it against the pre-

and prosecution of foreign patent applications and maintenance and working of foreign patents, (ii) litigation in courts of record to obtain, or to assert or defend the validity of, any patent, and (iii) extraordinary commercial development, as RESEARCH and UNIVERSITY may have previously agreed upon in writing. The remaining fifty per centum (50%) shall be retained by RESEARCH for the general purposes of its charter.

8) Furnish simultaneously to UNIVERSITY a report showing (a) activities during the preceding calendar year in connection with each such invention, and (b) the computation of payments made under Article II, paragraphs 6 and 7 of this agreement.

9) Maintain at its offices, in usual form, books of record, ledgers and accounts relating to its activities under this agreement all of which shall be open to examination by UNIVERSITY or its nominees, during usual business hours.

10) Assign to UNIVERSITY or its nominee or nominees, upon any termination of this agreement, but subject to any letter-agreements which RESEARCH may have entered into with inventors with respect thereto under Article II, paragraph 5 of this agreement, and subject also to any licenses, grants, working rights, agreements or other contracts theretofore made by RESEARCH with respect thereto, all inventions received by RESEARCH hereunder, and patent applications filed and patents issued thereon.

11) Continue to administer and report as to any licenses, grants, working rights, agreements or other contracts as to any inventions, patent applications and patents as are not to

graph 1, of this agreement, and patent applications filed and patents issued thereon.

13) Issue to any third party any license required by any contract between UNIVERSITY and such third party as to any invention accepted by it under Article II, paragraph 1, of this agreement, and patent applications filed and patents issued thereon.

III. UNIVERSITY'S Reserved Right: UNIVERSITY reserves the right to terminate this agreement upon ninety (90) days' written notice to RESEARCH at any time.

IV. RESEARCH'S Reserved Rights: 1) RESEARCH reserves the right to:

a) Terminate this agreement upon ninety (90) days' written notice to UNIVERSITY.

b) Give written notice to UNIVERSITY of its intention to abandon any patent application or foreign patent subject to this agreement, or not to proceed further with the introduction into public use of any invention, patent application or patent subject to this agreement, and, unless UNIVERSITY shall, within sixty (60) days after such notice, require the assignment of such invention, patent application, or patent to UNIVERSITY or its nominee, to abandon or take no further action as to such invention, patent application, or patent.

2) Following termination of this agreement and assignment pursuant to Article II, paragraph 10, the following distribution shall obtain as to any sums of money received by UNIVERSITY and/or

a) Not later than March 15 in each year each SUCCESSOR shall report ' RESEARCH in writing: (i) he sums of money so received by it and not theretofore so reported; (ii) the total amount of money theretofore expended by it out-of-pocket (A) for payments to inventors of such inventions, patent applications and patents as a share of, from or against such sums of money; (B) for payments for filing and prosecuting foreign patent applications, and maintaining and working foreign patents; (C) payments for litigation in courts of record to obtain, or to assert or to defend the validity of any patent on any invention so assigned; and (D) for payments for extraordinary commercial development of any invention so assigned. The total of items (ii) A through D, inclusive, shall be deducted from item (i) by each person so reporting. Of any remainder, RESEARCH shall therewith be paid thirty (30%) per centum by the person so reporting.

b) Mutatis mutandis, the provisions of Article II, paragraphs 8 and 9, shall apply to discharge of Article IV, paragraph 2, by each SUCCESSOR.

V. General: The parties agree that:

1) Any controversy or claim arising out of or relating to this agreement or the breach thereof, shall be settled by arbitration, in accordance with the Rules, then obtaining, of the American Arbitration Association, and judgment upon the award rendered may be entered in the highest court of the forum, state or federal, having jurisdiction.

2) This agreement is entered into for the express benefit of, and shall be binding upon, all members of the faculty,

3) Neither the name of the UNIVERSITY nor that of any member of the faculty, associate, or employee of the UNIVERSITY shall be used by RESEARCH for promotional or advertising purposes without prior written consent thereto by the UNIVERSITY and, as respects the name of a member of the faculty, associate, or employee, such consent by him as well. Each license, grant or working right issued or granted by RESEARCH under Article II, paragraph 4, shall impose a like limitation on the licensee or grantee.

4) RESEARCH shall not join or use the name of the UNIVERSITY as a party in any action, suit or proceeding brought by RESEARCH, nor shall it so join the name of any member of the faculty, associate or employee of the UNIVERSITY save in Patent Office, administrative or legal proceedings incident to prosecution of a patent application filed pursuant to Article II, paragraph 2 or 3, appeal therefrom, review thereof, or relief thereon.

* * *

IN WITNESS WHEREOF, the parties hereto have caused this agreement to be signed and their corporate seals to be hereunto affixed, all by their corporate officers thereunto duly authorized, and as of the day and year first above written.

RESEARCH CORPORATION

Attest:

By /s/ J.W.Barker
President

/s/ J.W. Hinkley
Secretary

THE UNIVERSITY OF ROCHESTER

EXHIBIT A

(Name and address
of inventor)

Dear Sir:

In accordance with the agreement between Research Corporation and The University of Rochester dated , 195 , under which Research Corporation handles the inventions and patents made by the members of the University's faculty, and through its management, introduces them into public use, the University has advised us that your invention described as , is to be patented and developed by us under that agreement, in furtherance of the University's regular patent policy.

The specific terms of the agreement with The University of Rochester are available to you through the University. Briefly, they provide that patent applications or inventions shall be assigned to Research Corporation by the inventor and that the patent prosecution and introduction into use shall be taken care of by us at our expense. From any income that may be derived from the patent, before deduction of any expenses, the agreement provides that there shall be paid by us to the inventor, his heirs, assigns and personal representatives, a percentage of that income which is established in each case by the University. In the case of your invention the University has informed us that this figure should be per cent. Payments of this amount and reports as to the progress of the invention will be made to you on March 15 of each year.

You might be interested in knowing that the balance of any income is, in general, divided on a fifty-fifty basis between the University and Research Corporation. The amount remaining with Research Corporation after payment of expenses is used for the general purposes of our charter for the support of technical and scientific investigation and research in educational institutions through our grants-in-aid program. A booklet that is descriptive of Research Corporation's activities is enclosed for your information.

There is attached to this letter in duplicate a standard form of assignment, and if you have no further questions concerning the matter, it would be appreciated if you would:

1) Sign the enclosed copy of this letter and return it to us; and

2) Sign the enclosed form of assignment, swear to it before a notary public, and return one copy