

**U.S. DEPARTMENT OF VETERANS AFFAIRS
AND UNIVERSITY
INVENTION MANAGEMENT AGREEMENT**

This Invention Management Agreement ("Agreement" or "IMA") is made by and between the United States Department of Veterans Affairs ("VA"), as represented by the Technology Transfer Program ("TTP"), Office of Research and Development, having an address at 810 Vermont Avenue NW, Washington, D.C. 20420, and _____ University ("University"), having an address at _____ (individually, "Party" and collectively, "Parties").

This Agreement is effective upon the last date of signature of the Parties ("Effective Date") and shall terminate in accordance with Article 10.

RECITALS

- A. VA, in accordance with Executive Order 10096, 37 C.F.R. §§ 501-501.11, 38 C.F.R. §§ 1.650-1.663, and 15 U.S.C. § 3710a et seq., and University, through its policies and contractual employment relationship with certain faculty and staff, have an interest in inventions made by their employees.
- B. It is the mutual desire of VA and University that when they each have an ownership interest in the same Subject Invention, as defined below, said interests will be administered jointly, under this Agreement, in a manner to ensure the rapid commercialization of the Patent Rights and to make their benefits widely available to the public.
- C. This Agreement does not apply to any invention made under the authority of 15 U.S.C. § 3710a, Cooperative Research and Development Agreement (CRADA) or any similar research agreement, between VA and a third party to which University is not a party.
- D. Each Party shall distribute inventor's royalties according to its own policy.
- E. VA may assert rights to its employee's inventions meeting the criteria set forth in 37 C.F.R. §§ 501-501.11 via a determination of rights process.
- F. University, through its Policy _____ [Insert reference to specific University Policy], set forth in Appendix C, and contractual employment relationship with certain faculty and staff, has an interest in inventions made by its employees. University obtains an assignment from its employees [*select one, depending on University policy: upon commencement of employment/upon disclosure of an invention/once it is determined University has an interest in the invention*].

1. DEFINITIONS

- 1.1 "**Administrative Fee**" means fifteen percent (15%) of Net Revenues. Administrative Fee shall be retained by Lead Party in consideration of Lead Party's patenting and commercialization efforts for a Subject Invention.
- 1.2 "**Dual Appointment Personnel (DAP)**" means any person who is employed, with or without compensation, by both VA and University.

- 1.3 **“Employee Invention Disclosure”** means a document received by VA’s TTP of complete written information from the inventor describing and disclosing the invention.
- 1.4 **“Expenses”** mean reasonable, documented, out-of-pocket payments by Lead Party to third parties for the prosecution of patent applications and licensing of intellectual property related to a Subject Invention. Expenses may include, without limitation, foreign and domestic attorney fees incurred for patent preparation and prosecution, patent office application filing and prosecution fees, patent and patent application maintenance fees and third party fees for marketing and market analysis. Expenses do not include payments by Lead Party for patenting and licensing activities which have been reimbursed by a licensee or other third party. Expenses explicitly exclude attorney litigation and all other fees and charges incurred in validity, infringement or other legal actions.
- 1.5 **"Government"** means the federal government of the United States of America.
- 1.6 **“Gross Revenues”** means all consideration received by Lead Party from the licensing of a Subject Invention, including, but not limited to, license issue and maintenance fees, minimum royalties, earned royalties, milestone payments and any other payments arising from the licensing of a Subject Invention. Consideration in a form other than cash, e.g., equity or other property, will be considered part of Gross Revenues upon sale or other disposition and receipt of cash therefrom by Lead Party. Gross Revenues explicitly excludes any reimbursements received from third parties to cover Lead Party Expenses. Any reasonable documented amounts returned to a laboratory budget as compensation for costs for providing a tangible Subject Invention shall not be included in Gross Revenues.
- 1.7 **“Invention Disclosure Report”** means a written report submitted from one Party to another Party in accordance with Article 3.
- 1.8 **"License Agreement"** means any fully executed agreement authorized under this Agreement that grants the right to, or provides an exercisable option to negotiate the right to, make, use, sell, offer for sale, or import products or services claimed or disclosed in a patent application covering a Subject Invention. The term License Agreement explicitly excludes collaborative research agreements including but not limited to sponsored research agreements and CRADAs as defined at 15 U.S.C. § 3710(a).
- 1.9 **“Lead Party”** means either VA or University, who by mutual agreement of the Parties, will manage and administer a Subject Invention, including patenting and licensing, under this Agreement.
- 1.10 **"Net Revenues"** means, for each Subject Invention, Gross Revenues, less Expenses and any amounts due and paid to non-party co-owners of the Subject Invention.
- 1.11 **“Non-Lead Party”** means the Party who is not the Lead Party.
- 1.12 **“Patent Rights”** means any domestic, foreign, or international patent application (including U. S. provisional patent applications and Patent Cooperation Treaty applications) any continuations, divisions, continuations-in-part, to the extent they are entitled to the priority date of the original or parent patent application, and any patents which issue on said application including patents of

addition, reissue, or re-examination, as well as any foreign counterparts and any patents which issue thereon in each case that claims or discloses a Subject Invention.

- 1.13 **"Subject Invention"** means any invention, whether or not covered by a patent or patent application, or discovery which is or may be patentable or otherwise protectable under Title 35 of the United States Code, the Plant Variety Protection Act (7 U.S.C. § 2321 et seq.) or foreign patent law in which both Parties have a legal right to assert an ownership interest.
- 1.14 **"Term"** means this Agreement shall start on the Effective Date and remain in effect until terminated by operation of law or by the Parties in accordance with the terms of this Agreement.
- 1.15 **"University Intellectual Property ('IP') Policy"** means the University's policy relating to employee inventions, as set forth in Appendix C.
- 1.16 **"Vendorization"** means the process to officially make a party into a vendor in order to transfer VA funds to that party.

2. **VA AND UNIVERSITY OWNERSHIP INTEREST IN EMPLOYEE INVENTIONS**

- 2.1 University policies relevant to its rights in employee inventions are provided as Appendix C to this Agreement. University represents and warrants that the terms of their employee policies concerning ownership of intellectual property comply with all Federal, State and local laws. University will promptly notify VA TTP of any changes to their intellectual property ownership policies. University agrees that it will only act in accordance with their stated policies and applicable Federal, State and local law with respect to ownership of employee intellectual property.
- 2.2 VA ownership rights in employee inventions will be determined based on Federal law and regulation. Ownership of government employee intellectual property will be evaluated subject to the provisions of 37 C.F.R. § 501.6, as the regulation may from time to time be amended, and other applicable Federal Statutes and Regulations. Administration of VA intellectual property will be governed within VA subject to VA policy. Specifically, VA asserts rights to employee inventions meeting the criteria set forth in 37 C.F.R. §§ 501-501.11 via a determination of rights process. When VA asserts an ownership interest in an employee invention, the employee assigns any VA patents claiming the employee invention.
- 2.3 Both Parties agree to use reasonable efforts in evaluating ownership to title of inventions and agree to promptly correct recorded ownership interest should inaccuracies as to actual ownership be discovered, for example, where applicant information is incorrectly filed with a patent office or recorded patent application assignments do not list all owners.
- 2.4 University acknowledges that the assignment it obtains from any employee that is a DAP may be subject to VA's ownership rights in the Subject Invention set forth in Federal Statute and Regulation. Both Parties agree to use reasonable diligence in correcting chain of title if either Party becomes aware of inaccuracies in the recorded chain of title.
- 2.5 University shall assert an ownership interest in the Subject Invention of a DAP only when the invention was made while the DAP was working on University time or with a contribution by the University of facilities, equipment, materials, funds or information to the Subject Invention.

Notwithstanding the terms of University IP Policy set forth in Appendix C, University shall have no interest in any Subject Invention made by a DAP where VA has asserted an ownership interest and with no contribution of University facilities, equipment, materials, funds or information to the Subject Invention.

- 2.6 VA shall assert an ownership interest in a Subject Invention made by a DAP only when the criteria set forth in 37 C.F.R. §§ 501-501.11 are met.
- 2.7 The obligations of disclosure set forth in this Agreement shall apply to all inventions made by a DAP, except for any invention made under a research agreement including but not limited to a CRADA to which the University is not a party.

3. SELECTION OF LEAD PARTY

- 3.1 Each Party shall report in writing to the other Party each invention via an Invention Disclosure Report within sixty (60) days of employee disclosure of the invention. For purposes of this Section 3.1 “employee invention disclosure” means receipt of invention information by a Party’s technology transfer office and in addition, specifically for VA, the receipt of sufficient information to perform the determination of Government ownership rights in employee inventions required by 37 C.F.R. § 501.6 . The Invention Disclosure Report shall contain (1) a detailed description of the invention, (2) a listing of all possible inventors and their affiliations with corresponding contact information, (3) information concerning the use of third party materials in the making of the invention or in the invention itself, (4) any supporting documents and manuscripts provided by the inventors and (5) a statement of whether any Government funds, facilities, materials, equipment, information or the time or services of other VA employees on official duties contributed to this invention. Invention Disclosure Reports required under Section 3.1 shall also indicate whether the invention occurred under a sponsored research agreement, containing terms that grant rights in, or grant options to exercise rights in, intellectual property arising under the research agreement. Information disclosed under Section 3.1 is subject to the confidentiality terms of Article 7.
- 3.2 If a Party issues a written rights notice or decision to an inventor for an invention, that Party will promptly provide a copy of such notice or decision to the other Party. If both parties assert rights, the invention becomes a Subject Invention.
- 3.3 Except as provided under Sections 3.5 and 3.6, the Parties will designate, using the addendum form in Appendix A, the Lead Party for each Subject Invention, within sixty (60) days of receipt of the Invention Disclosure Report specified in Section 3.1 by one Party to the other Party of the Subject Invention. Lead Party will have the obligation to manage and administer the patent prosecution and licensing activities for the Subject Invention on behalf of both Parties, as set forth in Articles 4 and 5.
- 3.4 Following mutual agreement on the selection of a Lead Party, the Parties will mutually agree and designate, using the addendum form provided in Appendix B, what the Lead Party share and Non-Lead Party share will be of Net Revenue. In general, this will reflect the contributions made by the inventors (VA and non-VA) and their relative contributions to the Subject Invention.
- 3.5 If VA has entered into a CRADA or a similar agreement with a third party under the Federal Technology Transfer Act and an invention arises from such arrangement, the disclosure obligations

of this Article 3 shall not apply. As a result, the University shall have no ownership interest in any invention developed under a CRADA or a similar research agreement.

- 3.6 Where the University has entered into a sponsored research agreement with a third party that involves use of a Subject Invention and the agreement contains a grant of rights or an option to exercise rights in intellectual property arising under the agreement, University will be Lead Party.

4. PATENT PROSECUTION

- 4.1 Both Parties agree that Lead Party will have the exclusive right and obligation, even as between the Parties, to direct the domestic and foreign patenting strategy, including the preparation of patent applications, for each of its designated Subject Inventions. For each Subject Invention, Non-Lead Party will grant Lead Party, or Lead Party's legal representative, power of attorney to file and prosecute U.S. and foreign patent applications disclosing or claiming the Subject Inventions on the behalf of Non-Lead Party. Both Parties shall reasonably cooperate with each other with respect to the prosecution of patent applications, including providing access to inventors and documentation, executing documents and taking all other actions necessary to advance prosecution. Lead Party will be responsible for paying all patent prosecution costs, including, without limitation, patent attorney fees, patent office fees, patent issuance, annuity and maintenance fees. These costs will be considered Expenses as defined in Article 1, unless paid or reimbursed by a licensee or other third party.
- 4.2 Within thirty (30) days of filing a patent application on a Subject Invention under this Agreement, Lead Party shall provide Non-Lead Party with the application serial number, filing date and a complete copy of the patent application. The patent application reporting obligation under Section 4 applies to any and all domestic, foreign national, foreign regional and international patent applications claiming or disclosing a Subject Invention. Upon written request, the Lead Party will promptly provide copies of all office actions, responses, and all other communications to and from the United States Patent and Trademark Office or its international and foreign equivalents regarding any Subject Invention. Non-Lead Party reserves the right to comment on patent prosecution matters, and Lead Party agrees to reasonably incorporate Non-Lead Party's comments into its patent prosecution strategy with respect to a Subject Invention.
- 4.3 Within thirty (30) days of written request, Lead Party shall provide Non-Lead Party with a brief summary suitable for public release of any patent application directed to a Subject Invention in which Lead Party has filed or will file an application. If Lead Party has submitted a patent application, then such summary will include the title, patent application number, filing date and a brief abstract for the Subject Invention. However, if Lead Party has not yet submitted a patent application, then such summary will include title of the research, abstract of the research and anticipated patent application filing date. Any licensing inquiries received by Non-Lead Party will be forwarded to Lead Party within thirty (30) days of receipt of inquiry.
- 4.4 Lead Party shall provide Non-Lead Party with written notification of the issuance of any patent claiming or disclosing a Subject Invention within forty-five (45) days of the issue notice. Such notification shall include, minimally, VA and University invention identifying numbers, the patent number and the earliest claimed priority date. Both Parties may post and freely disseminate information concerning the granting of any patents related to a Subject Invention. Licensing

inquiries received by Non-Lead Party will be forwarded to Lead Party within thirty (30) days of receipt of the inquiry.

- 4.5 Lead Party shall obtain assignments from each inventor of the Subject Invention. Lead Party will promptly, but no later than sixty (60) days after full execution of the assignment, record assignments in each country in which a patent application Subject Invention is filed. Lead Party shall provide Non-Lead Party with a copy of each recorded assignment within ninety (90) days of recordation. VA's interest as an assignee shall read "The United States as represented by the Department of Veterans Affairs (Washington, D.C.)." University's interest as an assignee shall read "[insert text]".
- 4.6 Lead Party shall notify Non-Lead Party of its intent to abandon prosecution or maintenance of any patent within the Patent Rights (or of its decision not to file for foreign patent protection on a Subject Invention (each a "Disclaimed Patent Right"), in each case, at least ninety (90) days before any legal deadline for action required to avoid a loss of rights (each a "Disclaimed Patent Right"). Upon receiving notice of a Disclaimed Patent Right, Non-Lead Party may, at its sole discretion and expense, take over the filing, prosecution or maintenance of the Disclaimed Patent Right. Non-Lead Party taking over prosecution of a Disclaimed Patent Right shall consider Lead Party's costs associated with the Disclaimed Patent Right incurred before the date of the notice as an Expense under this Agreement but shall have no further obligation to account to the other Party for Gross Revenues or any other third party consideration arising from the Disclaimed Patent Right. Lead Party shall reasonably cooperate with Non-Lead Party with respect to the prosecution of any Disclaimed Patent Right, including providing access to inventors and documentation, executing documents and taking all other actions necessary to advance prosecution.
- 4.7 Lead Party may, by notice to Non-Lead Party, disclaim the right and obligation to file patent application on any Subject Invention (a "Disclaimed Subject Invention"). Notice of intent to disclaim a Subject Invention must be provided to the other Party at least ninety (90) days prior to any event which could prejudice the ability to obtain patent rights in the United States or abroad. Non-Lead Party may decide at its sole expense and discretion to file a patent application on the Disclaimed Subject Invention. Non-Lead Party will have no further obligation to account to the other Party for Gross Revenues or any other third party consideration arising from the Disclaimed Subject Invention. Lead Party shall reasonably cooperate with Non-Lead Party with respect to the filing of a patent application and the prosecution of any Disclaimed Subject Invention, including providing access to inventors and documentation, executing documents and taking all other actions necessary to advance prosecution and commercialization.
- 4.8 Any Party disclaiming an interest in a Patent Right or a Subject Invention under Section 4.6 or Section 4.7 shall, within thirty (30) days, effect an assignment transferring its ownership interest in the Disclaimed Patent Right or Disclaimed Subject Invention to the other Party.

5. LICENSING

- 5.1 Lead Party shall have the exclusive right to negotiate, execute and administer License Agreements intended to facilitate the commercial development of its designated Subject Inventions. Non-Lead Party hereby authorizes Lead Party to grant exclusive, non-exclusive or partially exclusive licenses

(each a “License Agreement”) in and to Non-Lead Party’s Patent Rights for Subject Inventions. Lead Party shall use reasonable efforts in evaluating the financial and technical capability of potential licensees and shall grant licenses only to third parties with the capability to bring the Subject Invention to the point of practical application, as that term is defined in 37 C.F.R. § 404.3(d).

- 5.2 Lead Party shall ensure that any License Agreement entered into under this Agreement contains a term stating that the License Agreement is subject to the provisions of 37 C.F.R. § 401 and to the rights retained by the Government under this Agreement, including, inter alia, the requirement for substantial manufacture in the United States.
- 5.3 Both Parties agree that any License granted under this Agreement will have the following obligatory term:

“The U.S. Government shall have the irrevocable, royalty-free, paid-up right to practice and have practiced the Patent Rights throughout the world by or on behalf of the U.S. Government and on behalf of any foreign government or international organization pursuant to any existing or future treaty or agreement to which the Government is a signatory.”

Any license granted by the University under the terms of this Agreement shall be subject to this right of the U.S. Government.

- 5.4 Lead Party shall consult with Non-Lead Party in the negotiation of all License Agreements. Lead Party will provide to Non-Lead Party a final draft copy of each proposed License Agreement (or sublicense allowed under this Agreement) at least forty (40) days prior to execution. Information included with the draft License Agreement must include information indicating in what state or country the proposed licensee is primarily registered and whether the business is Veteran, woman or minority owned or a small business as defined by the Government. Final draft and execution copies of the License Agreement must include a reference to both VA and University invention disclosure or matter numbers identifying the Subject Invention(s) covered by the License Agreement. Lead Party shall accommodate any reasonable request from Non-Lead Party for changes to the License Agreement, provided Non-Lead Party must make written requests for changes to the License Agreement within twenty (20) business days of receipt of the final draft copy.
- 5.6 Disclaimed Subject Inventions and Disclaimed Patent Rights. Where a Party has disclaimed a Subject Invention or Patent Right, as set forth in Sections 4.6 or 4.7, the disclaiming Party also disclaims any right or obligation as Lead Party for licensing purposes.

6. REVENUES

- 6.1 Lead Party will collect Gross Revenues paid or transferred pursuant to the License Agreement. If other invention(s) that are not Subject Inventions are licensed together with Subject Invention(s) under a single License Agreement, Lead Party will allocate Gross Revenues according to a plan

negotiated in good faith between Lead Party and Non-Lead Party at the time of licensing such other invention(s) and the Subject Invention(s).

- 6.2 Lead Party shall pay Non-Lead Party's share of Net Revenues, as shown in Appendix B of this Agreement, to Non-Lead Party within ninety (90) days of receipt of Gross Revenues by Lead Party. Such payments shall be made in U.S. Dollars, and shall be made by check or bank draft drawn on a United States bank. University consents to the federal government Vendorization process in order to receive the University's share of Net Revenues.
- 6.3 Payments under Article 6 will be accompanied by a confidential itemized accounting of the calculation of Non-Lead Party's share of Net Revenues for each individual Subject Invention, and shall include VA identification number, Gross Revenues, and itemized Expenses.
- 6.4 Payments to VA including all VA inventor's royalties, shall be payable to the "Department of Veterans Affairs (royalty)." All such payments shall be sent to the following address:

Department of Veterans Affairs
Director Technology Transfer (10P9TT)
810 Vermont Avenue NW
Washington, D.C. 20420

- 6.5 Payments to University shall be payable to [*Insert University Notice.*] All such payments shall be sent to the following address:

[*Insert University Address*]

7. USE OF NAME and CONFIDENTIALITY

- 7.1 Use of Name. Neither Party may use or allow its licensees to use the name, logos or trademarks of the other Party in any way for advertising or publicity without the express written consent of the other Party. The name of the other Party may be used, however, to provide correct and accurate information about ownership of the Subject Invention, in connection with negotiating a License Agreement or sublicense agreement and where required by law.
- 7.2 Confidentiality. The Party receiving information from the other Party pursuant to this Agreement that is disclosed to it, whether disclosed in writing, orally, or in any other manner and which is identified or labeled as "confidential" at the time of disclosure agrees that such information is (1) to be treated as confidential, (2) to be used only for the purposes of this Agreement, and (3) not to be disclosed by the receiving Party, its directors, officers, agents or employees without the prior written consent of the other Party except to the extent that the receiving Party can establish that such information:
- 7.2.1 Was in the public domain at the time of disclosure;
- 7.2.2 Later became part of the public domain through no act or omission of the receiving Party, its employees, agents, successors or assigns;
- 7.2.3 Was lawfully disclosed to the receiving Party by a third party having the right to disclose it;

7.2.4 Was already known by the receiving Party at the time of disclosure;

7.2.5 Was independently developed by the receiving Party;

7.2.6 Was required by law, court order or regulation to be disclosed; provided, however, that the, to the extent possible, the disclosing Party provides the other Party with prior written notice of such required disclosure and an opportunity to participate in drafting a protective order or otherwise limiting the disclosure ; or

7.2.7 Was required to be disclosed by receiving Party to a regulatory authority in connection with regulatory filings related to a Subject Invention.

7.3 Each Party's obligation of confidentiality hereunder shall be fulfilled by using at least the same degree of care with the other Party's confidential information as it uses to protect its own confidential information. This obligation shall exist while this Agreement is in force and for a period of two (2) years after the date of disclosure of the other Party's confidential information or two (2) years after termination of this Agreement, whichever occurs first.

8. RECORDS AND REPORTS

- 8.1 Lead Party shall keep complete, true, and accurate accounts of all Expenses, third party reimbursements, and of all Gross Revenues received by it under each License Agreement and shall permit Non-Lead Party or Non-Lead Party's designated agent, not more than once per year and at Non-Lead Party's sole expense, to audit Lead Party's books and records in order to verify compliance with this Agreement.
- 8.2 Lead Party must provide a written report, at least once a year, covering the prior twelve-month period setting forth the status of all patent prosecution, commercial development, royalty income, and licensing activity concerning Subject Invention(s), and upon written request of the Non-Lead Party, copies of patents issued and License Agreements executed during that period.
- 8.3 The report required under Section 8.2 shall also be made within sixty (60) days of the termination of this Agreement.

9. PATENT INFRINGEMENT

- 9.1 In the event Non-Lead Party or Lead Party, including its licensees, shall learn of the infringement of any patent subject to this Agreement, the Party who learns of the infringement shall promptly notify the other Party in writing and shall provide the other Party with all available evidence of the infringement. Lead Party and its licensees, in cooperation with Non-Lead Party, shall use their best efforts to eliminate the infringement without litigation. If the efforts of the Parties are not successful in eliminating the infringement within ninety (90) days after the infringer has been formally notified of the infringement by Lead Party, Lead Party shall have the right, after consulting with Non-Lead Party, to commence suit on its own account. Non-Lead Party may join Lead Party's suit or commence its own suit; however, with respect to VA, any such action is subject to approval by the U.S. Department of Justice (DOJ).

- 9.2 Lead Party may permit its licensees to have first right to bring suit on their own account. Non-Lead Party agrees, to the extent it is able to get approval, in the case of the VA from the DOJ, in the case of the University from the Board of Regents, to join or be joined in such suit if legally necessary.
- 9.3 Legal action or suits to eliminate infringement or recover damages pursuant to Article 9 shall be at the full expense of the Party by whom suit is brought. All monies awarded in litigation shall first be used to reimburse each Party for its expenses relating to the legal action, and the remainder of the damages shall be considered Net Revenues.
- 9.4 Each Party agrees to cooperate with the other in litigation proceedings and may be represented, at its expense, by counsel of its choice in any suit.

10. TERM, TERMINATION, ASSIGNMENT and SURVIVABILITY

- 10.1 Termination by Mutual Consent. University and VA may elect to terminate this Agreement, or portions thereof, at any time by mutual consent in writing. Before terminating this Agreement, University and VA will assess the impact of termination on other intellectual property agreements between the Parties and amend any other intellectual property agreements to ensure consistency with the termination of this Agreement.
- 10.2 Unilateral Termination. Either Party may terminate this Agreement unilaterally at any time by giving the other Party written notice not less than six (6) months prior to the proposed termination date. If this Agreement is terminated by either Party, each Party will abide by its previous commitments as to this Agreement as well as any other agreements made between the Parties with respect to each of its respective intellectual property portfolios.
- 10.3 Termination for Default. In the event a Party is in default in the performance of any material obligations under this Agreement, and the default has not been remedied within thirty (30) days after the date of written notice of the default, the other Party may terminate this Agreement by written notice.
- 10.4 Notwithstanding termination of this Agreement:
- 10.4.1 Fully executed License Agreements granting rights in Subject Inventions entered into under this Agreement shall survive termination of this Agreement subject to the terms of the License Agreement. Modifications or amendments to License Agreements post-termination of this Agreement may be made only where all Parties to the License Agreement agree in writing on the amendment or modification.
- 10.4.2 Lead Party shall continue to administer gross proceeds and the distribution of Net Revenues to Non-Lead Party during the term of any such surviving License Agreement and any subsequent amendments.
- 10.4.3 The following sections shall survive expiration or earlier termination of the Agreement: 4, 5, 6, 7, 8 and 9.

- 10.5 No Waiver. It is agreed that no waiver by either Party hereto of any breach or default of any of the terms of this Agreement shall be deemed a waiver as to any subsequent and/or similar breach or default.
- 10.6 Assignment. This Agreement is binding upon and shall inure to the benefit of the Parties hereto, their successors or assigns, but this Agreement may not be assigned by either Party without the prior written consent of the other Party.

11. NOTICES

All notices or any other written information required or permitted by this Agreement to be given to the Parties hereto shall be deemed to have been properly given if (1) the notice contains invention identification numbers for both Parties, and (2) the notice is delivered in writing, in person or mailed by prepaid, first class, registered or certified mail or by an express/overnight delivery service provided by a commercial carrier, properly addressed to the other Party. Notice may also be sent via electronic mail and shall be deemed received by a party when that party acknowledges receipt via return email or acknowledges receipt by any other means specified in this Article 11.

Written notices or any other written information required or permitted by this Agreement shall be sent to the mailing address below, or alternative address(es) for individual Subject Invention(s) as identified in writing by the VA Director, Technology Transfer Program or by University.

To VA: Director (10P9TT)
Technology Transfer Program
Office of Research and Development
U.S. Department of Veterans Affairs
810 Vermont Avenue N.W.
Washington, D.C. 20420
Phone: (202) 632-7271
E-mail: va-ttp@va.gov

To University: []

12. DISPUTES, GOVERNING LAWS, MODIFICATION, ENTIRE AGREEMENT

- 12.1 Disputes: The Parties shall use their best efforts to amicably resolve any dispute arising under this Agreement. Any dispute that cannot be readily resolved shall be referred to officials of the Parties with authority to settle the relevant dispute.
- 12.2 Governing Laws. This Agreement shall be construed in accordance with U.S. Federal law and the law of the State of _____ when not in conflict with U.S. Federal law. U.S. Federal law and regulations preempt any conflicting or inconsistent provisions in this Agreement.
- 12.3 Modifications. Any modification or amendment to this Agreement must be in writing, agreed to and executed by both Parties.

- 12.4 Entire Agreement. This Agreement constitutes the entire understanding between the Parties concerning the subject matter herein. This Agreement further supersedes and replaces any existing agreement or understanding between the Parties regarding management of any intellectual property including any inventions. Upon the Effective Date, not only future inventions, but also past inventions and anything under the scope of management of intellectual property between the Parties shall be governed by only this Agreement as it is the intent of both Parties that any and all prior agreements relating to the subject matter herein is superseded by the terms of this Agreement.

U.S. Department of Veterans Affairs

University

By: _____
NAME:
Director, Technology Transfer Program

By: _____
NAME:
TITLE:

Date: _____

Date: _____

Appendix A

Addendum Form for Designating Lead Party for a Subject Invention

Subject to the terms and conditions of the Invention Management Agreement (the “IMA”) entered into by and between the Department of Veterans Affairs (“VA”) and [UNIVERSITY OR NONPROFIT ORGANIZATION] (“University”) on [EFFECTIVE DATE OF IMA], VA and University (each a “Party”) wish to designate Lead Party responsible for the the management of a certain Subject Invention.

(Terms not defined within this Amendment will have the meanings defined in the IMA)

Whereas, the Subject Invention titled “[TITLE OF INVENTION DISCLOSURE]” having an University identification number of [UNIVERSITY ID NUMBER] and VA identification number of [VA ID NUMBER] has been reported by [NAME OF INVENTOR (S)] (each an “Inventor”); and

Whereas, at least one of the named Inventors of the Subject Invention has employment or position appointment-related obligations to both VA and University; and

Whereas, the University has an ownership interest in the Subject Invention based on one or more of the the Inventors obligations’ to assign rights in intellectual property based on [EMPLOYEE CONTRACT OR SPECIFIC UNIVERSITY POLICY OR STATE LAW]; and

Whereas, VA has asserted an ownership right in the Subject Invention based on information provided by one or more of the Inventor’s and the inquiry required at 37 C.F.R. § 501.6 (“Criteria for the determination of rights in and to inventions”) for asserting rights in the intellectual property of federal government employees; and

Whereas, [ADDITIONAL INFORMATION RELAVANT TO THE SUBJECT INVENTION (e.g. PATENT APPLICATION NUMBERS), IF ANY];

ARTICLE 1

Both Parties agree that [VA/UNIVERSITY] will be Lead Party for the Subject Invention titled “[TITLE OF INVENTION DISCLOSURE]” and [VA/UNIVERSITY] will be Non-Lead Party.

Non-Lead Party hereby authorizes Lead Party to act on its behalf, to the extent specifically set foth in the IMA, with respect to the Subject Invention.

[VA/UNIVERSITY – LEAD PARTY] acknowledges its rights and obligatons under the IMA as the designated Lead Party and agrees to act on Non-Lead Party’s behalf, to the extent specifically set foth in the IMA, with respect to Subject Invention.

(Signatures on next page)

The “Effective Date” of this Amendment will be the date of the last authorized signature below.

U.S. Department of Veterans Affairs

University

By: _____
NAME:
Director, Technology Transfer Program

By: _____
NAME:
TITLE:

Date: _____

Date: _____

Appendix B

Addendum Form for Revenue Sharing for Specific Subject Invention

Subject to the terms and conditions of the Invention Management Agreement (the “IMA”) entered into by and between the Department of Veterans Affairs (“VA”) and [UNIVERSITY OR NONPROFIT ORGANIZATION] (“University”) on [EFFECTIVE DATE OF IMA], VA and University (each a “Party”) wish to set forth the terms for the distribution between the Parties of third party consideration for a license or other transaction involving the Subject Invention listed below. The Parties have designated (XXX) as the Lead Party.

(Terms not defined within this Amendment will have the meanings defined in the IMA)

(Template suggested language:)

Whereas, Lead Party has entered into a license agreement (the “License”) involving the grant of rights to [NAME OF LICENSEE] (the “Licensee”) in the Subject Invention entitled “[TITLE OF INVENTION DISCLOSURE]” having an University Identification Number [UNIVERSITY ID NUMBER] and VA identification number of [VA ID NUMBER].

Whereas, the Parties wish to provide for Lead Party and Non-Lead Party share of Net Revenues as set forth in Section 6.2 of the IMA;

As of the Effective Date of of this Amendment, the following patent applications have been filed based on the Subject Invention and are or will be the subject of the License:

[LIST OF PATENT APPLICATION(S) BY SERIAL NUMBER]

As of the Effective Date, the following individuals are named as inventors in the patent applications:

[NAME OF INVENTOR] – [AFFILIATION(S) OF INVENTOR] –[APPLICATION(S) AS INVENTOR]

The Parties agree to the following economic terms for the sharing of consideration arising from licensing of the Subject Invention:

SHARE OF NET REVENUES:	VA :	_____ %
	University:	_____ %

The “Effective Date” of this Amendment will be the date of the last authorized signature below.

U.S. Department of Veterans Affairs

University

By: _____
NAME:
Director, Technology Transfer Program

By: _____
NAME:
TITLE:

Date: _____

Date: _____

Appendix C

University Policy Relating to Its Employee Inventions