

UNIVERSITY of HOUSTON



Letter of Agreement

The University of Houston (Houston, Texas, USA 77204-5641) ("UH"), an agency of the State of Texas pursuant to Chapter 111, Texas Education Code, and

(_____) ("Research Institute") wish to enter into an investigation, or Joint Collaborative Study ("Joint Study")

The Principal Investigators are _____ at UH and _____ at Research Institute ("Principal Investigators") who jointly are responsible for the direction and conduct of Joint Study.

1. **Scope of Work and Reporting of Results.** Efforts will be made to _____ . These investigations will utilize _____ .

_____ shall provide _____ with a mutually agreed upon number of compounds and Research Institute shall perform _____ as mutually agreed.

_____ and _____ will communicate with each other on a frequent and informal basis as agreed upon between these Principal Investigators. The communications will include reporting of results of the testing of _____ in both verbal and/or written data form.

2. **Term of Joint Study.** Joint Study will be carried out during the period _____. Either party may terminate Joint Study by giving the other party thirty (30) days written notice. Terms and provisions concerning Intellectual Property, Confidentiality and Publication survive the termination of this Agreement in addition to those terms and provisions surviving by operation of law.

3. **Budget and Funding.** \$_____ is expected to change hands in the conduct of this Joint Study. Each party to this Agreement agrees to provide or obtain the appropriate level of support internally to facilitate the work planned under Joint Study.

4. **Confidentiality.**

a. Confidential Information. For the purposes of this Agreement Confidential Information ("Confidential Information") means:

- (1) information disclosed between UH and Research Institute;
- (2) any business or technical information of UH or Research Institute, including but not limited to any information relating to UH's or Research Institute's product plans, designs, costs, product prices and names, finances, marketing plans, business opportunities, personnel, research, development or know-how;
- (3) any information that is designated by the disclosing party as "confidential" or "proprietary" or, if orally disclosed, reduced to writing by the disclosing party within thirty (30) days of the disclosure; and
- (4) information clearly marked as "Confidential" or "Not for Publication: at the time of disclosure.

b. Exclusions. Confidential Information does not include information that:

- (1) is developed by the receiving party independently and without use of or concerning the disclosing party's Confidential Information;

- (2) is obtained by the receiving party from a third party without restriction on disclosure and without breach of a nondisclosure obligation;
- (3) is in or enters the public domain other than through the fault or negligence of the receiving party and without breach of the Agreement;
- (4) the receiving party possesses before first receiving it from the disclosing party; or
- (5) is legally required to be disclosed by law, at which point the disclosing party will notify the other party.

c. **Obligation.** Except as required by law, each party will maintain in strict confidence, and will not use or disclose, except to facilitate work under this Agreement, ANY Confidential Information received from the other party. The information clearly marked as “Confidential” or “Not for Publication” at the time of disclosure will be safeguarded and not disclosed to anyone without a “need to know” within UH or Research Institute. Each party further agrees to use the same degree of care to maintain the confidentiality of all Confidential Information received from the other party that it uses to maintain the confidentiality of its own information of similar importance, but in no event will it use less than reasonable care. This obligation of confidentiality expires _____ month(s) after termination of this Agreement. These conditions of confidentiality are subject to the publication conditions in the following section.

5. **Publications.** The parties agree that it is part of each party’s function to disseminate information and to make the information available for scholarship and research. They further recognize that the publication of certain technical information may destroy its commercial value. The parties will cooperate in appropriate publication of the results of Joint Study to allow the predominating interest to obtain patent protection for any patentable subject matter. It is agreed that before any public disclosure, the party proposing disclosure will send the other party a copy of the information to be disclosed, and allow the other party thirty (30) days from the date of receipt in which to determine whether the information to be disclosed contains subject matter for which patent protection should be sought before disclosure. If the non-disclosing party believes the subject matter maybe patentable, it will so notify the disclosing party in writing, who will then delay public disclosure of the information for an additional period of up to six (6) months to permit the preparation and filing of a patent application on the subject matter to be disclosed. If notification is not received during the thirty (30) day period, the party proposing disclosure is free to proceed with the disclosure, provided that no party is permitted to publish any confidential and proprietary information of the other party without the other party’s prior written consent. The authorship for any paper is determined by accepted scientific practice.

6. **Intellectual Property.** It is anticipated that Joint Study will identify new _____ that may exhibit _____ primarily, but not exclusively for _____. The proprietary rights to any subject and _____ uses or other inventions (collectively “Joint Inventions”) arising from the conduct of this Joint Study that are not embraced by existing patents, patent applications, disclosures or the agreements between UH and a third party will be shared equally between UH and Research Institute. This assignment of rights will be implemented regardless of whether the new Joint Invention was first discovered at UH or at Research Institute, so long as it resulted from Joint Study.

If a license is issued on any Joint Invention developed by either party to this Agreement, the resulting revenues generated shall be split equally after the deduction of all reasonable and customary expenses of filing, prosecuting or maintaining any patent application or patent on Joint Invention. If the revenue generating patent (“New Patent”) used relies upon a prior composition of matter patent (“Prior Patent”) filed in the name of either of the two above Principal Investigators, then New Patent will be weighted as one share and Prior Patent will be weighted as one share. The owner of the Prior Patent shall receive 100% of the revenues

attributable to Prior Patent's one share plus 50% of the revenues attributable to the one share of New Patent. This division of revenues will be in force until the longest living patent expires.

UH retains all proprietary rights to new _____ developed or identified at UH other than those developed or identified under this Joint Study. UH also retains all rights to any _____ selected for study in Joint Study that is already embraced by existing disclosures filed at UH ("UH Inventions").

Research Institute retains all proprietary rights to new subject of study developed or identified at Research Institute other than those developed or identified under this Joint Study. Research Institute also retains all rights to any subject of study selected for study in Joint Study that is already embraced by existing disclosures filed at Research Institute ("Research Institute Inventions").

- 7. **Patents.** UH has the right at its option and expense, to prepare, file and prosecute patent applications for UH Inventions and Joint Inventions. For Joint Inventions, UH agrees to use a patent law firm selected and agreed upon jointly by UH and Research Institute, and retained by UH. If UH elects to file, prosecute and maintain patent applications for any Joint Inventions, Research Institute shall cooperate with the efforts, at UH's expense, to prepare and prosecute all the patent applications and in the maintenance of any patents issued. Research Institute agrees to assign to UH any Patent Rights to Joint Inventions. If UH elects not to file, Research Institute is then free to take any action desired for Joint Inventions without further obligation, except for the above revenue-sharing agreement, to UH under this Agreement.
- 8. **Governing Law.** The laws of the State of Texas and the United States govern the validity and interpretation of this Agreement and the legal relation of the parties.

The parties have caused this Agreement to be executed by their duly authorized representatives.

UNIVERSITY OF HOUSTON

RESEARCH INSTITUTE

Signature Date
Name: _____
Title: _____

Signature Date
Name: _____
Title: _____

Note: Modification of this Form requires approval of OGC