

**INTER-INSTITUTIONAL AGREEMENT
BETWEEN
UNIVERSITY OF ROCHESTER
AND XXXXXX**

This Agreement is dated and effective as of the date of signature of the last party to sign, as indicated below, and is by and between the University of Rochester, an educational corporation under the laws of the State of New York, and having a place of business located at 601 Elmwood Avenue, Box OTT, Rochester, New York 14642 (hereinafter "ROCHESTER") and XXXXX, A corporation organized under the laws of _____, and having a place of business located at _____ (hereinafter "XXXX").

RECITALS

A. _____ (URMC INVENTOR(S)) was an employee [were employees] of ROCHESTER at the time the INVENTION (as defined below) was created.

B. _____ (XXXX INVENTOR(S)) was an employee [were employees] of XXXX at the time the INVENTION was created.

C. In the course of research programs at ROCHESTER and XXXX, URMC INVENTOR(S) and XXXX INVENTOR(S) (collectively, JOINT INVENTORS) created the INVENTION; therefore, INVENTION is jointly owned by ROCHESTER and XXXX.

D. ROCHESTER and XXXX (hereinafter the PARTIES or PARTY) have separate agreements with JOINT INVENTORS whereby they agree to assign all right, title and interest in the INVENTION to their respective institutions, and whereby the JOINT INVENTORS agree to assist their respective institutions in preparing, filing, prosecuting, defending, and maintaining patent applications and patents relating to the INVENTION throughout the world.

E. The PARTIES desire to jointly exploit the INVENTION.

NOW, THEREFORE, in consideration of the mutual covenants and premises herein contained, the PARTIES agree as follows:

1. EFFECTIVE DATE

This AGREEMENT is effective _____ (EFFECTIVE DATE).

2. DEFINITIONS

2.1 INVENTION means all discoveries, know-how, information, and inventions in _____ created by JOINT INVENTORS and further described in ROCHESTER Invention Disclosure attached as Exhibit 1 (ROCHESTER file reference ____) and XXXX Invention Disclosure attached as Exhibit 2 (XXXX file reference _____).

2.2 LICENSE REVENUE means the transfer of value from third parties to PARTIES in consideration of granted licenses or other rights to the INVENTION which may include, but is not limited to: actual royalties, fees, payments, equity securities and other sums.

2.3 PATENT EXPENSES means all out-of-pocket expenses, as evidenced by actual invoices that were incurred in searching, preparing, filing, prosecuting, defending, and maintaining INVENTION.

2.4 PATENT RIGHTS means the PARTIES' respective rights in discoveries, know-how, information and inventions covered in patents and/or patent applications, whether domestic or foreign, which identify JOINT INVENTORS as inventors and which relate to the INVENTION, and any patent application(s) claiming the benefit of priority thereof including all divisions and continuations of these applications, all patents issuing from such applications, divisions and continuations, and any reissues, reexaminations, and extensions of all such patents to the extent that JOINT INVENTORS are named as inventors thereon.

3. WARRANTY: SUPERIOR-RIGHTS

3.1 Except for the rights, if any, of the government of the United States of America (GOVERNMENT), as set forth below, the PARTIES, to the best of their knowledge, are under no obligation to anyone other than JOINT INVENTORS with respect to INVENTION and PATENT RIGHTS.

3.2 The INVENTION may have been developed under a funding agreement with the GOVERNMENT and, if so, the GOVERNMENT may have certain rights relative thereto. This AGREEMENT and future licenses are explicitly made subject to the GOVERNMENT'S rights under any agreement and any applicable law or regulation. If there is a conflict between any agreement, applicable law or regulation and this AGREEMENT, the terms of the GOVERNMENT agreement, applicable law or regulation shall prevail.

4. PATENT PROSECUTION AND PROTECTION

4.1 The PARTIES are equal owners of INVENTION.

4.2 The PARTIES will jointly select and approve outside counsel prior to incurring any PATENT EXPENSES.

4.3 The PARTIES will each use their best efforts to ensure that JOINT INVENTORS fully cooperate in the preparation, filing, prosecution and maintenance of PATENT RIGHTS.

4.4 ROCHESTER is responsible for preparing, filing, prosecuting, defending, and maintaining PATENT RIGHTS made in the name of both PARTIES and will consult with and keep XXXX fully informed of PATENT RIGHTS status. ROCHESTER will copy XXXX on all patent related communications, including, but not limited to, patent applications, office actions, and responses. The PARTIES each have the right to review and comment upon the wording of specifications, claims, and responses to office actions prior to their submission to the appropriate patent office. PATENT RIGHTS will not be abandoned without the written consent of both PARTIES. If ROCHESTER anticipates extraordinary PATENT EXPENSES arising from the preparation, filing, prosecution, maintenance or defense of any patent application or patent contemplated by this AGREEMENT, then ROCHESTER will provide XXXX with full details and together the PARTIES will determine a mutually acceptable course of action prior to incurring such expenditures.

4.5 Either PARTY may, upon reasonable written notice to the other PARTY, discontinue paying its portion of the PATENT EXPENSES associated with any particular patent application or patent within any national jurisdiction (Discontinuing PARTY). The Continuing PARTY may continue to pay PATENT EXPENSES and in so doing will own all right, title and interest in and to that patent application or patent within such national jurisdiction. The Discontinuing PARTY will have no further rights in and to that particular patent application or patent within such national jurisdiction and will execute any assignments necessary to transfer full title to the Continuing PARTY.

5. LICENSING

The PARTIES agree to cooperate to commercialize, utilize and exploit INVENTION and/or PATENT RIGHTS and will keep each other informed of all interest expressed by third parties. Notwithstanding the above, neither PARTY has any right to commercialize, utilize, exploit and/or license INVENTION and/or PATENT RIGHTS without the express written permission of the other PARTY, which will not be unreasonably withheld. All licenses with respect to INVENTION and/or PATENT RIGHTS will be made jointly in the name of and executed by both PARTIES and will be negotiated and administered by ROCHESTER.

6. EXPENSES, PAYMENTS AND REPORTS

6.1 The PARTIES agree to share PATENT EXPENSES. ROCHESTER will be responsible for paying ___% of PATENT EXPENSES and XXXX will be responsible for paying ___% of PATENT EXPENSES. Both PARTIES recognize the other PARTY may incur certain legal expenses regarding INVENTION and/or PATENT RIGHTS with matters pertaining solely to the other institution. In such circumstances, such expenses will not be considered PATENT EXPENSES. ROCHESTER will maintain adequate records showing all PATENT EXPENSES incurred, which will be made available to XXXX for inspection upon reasonable written notice. When possible, ROCHESTER will notify and obtain XXXX'S approval prior to incurring PATENT EXPENSES. If such notification is not provided prior to certain PATENT EXPENSES being incurred, then XXXX will have the right to decline to pay for such expenses that, in XXXX'S reasonable business judgment, were not incurred in a prudent manner or were not reasonably necessary in order to achieve the purposes of this AGREEMENT.

6.2 Within 45 days of receiving bills for any PATENT EXPENSES, ROCHESTER will provide XXXX with an invoice for PATENT EXPENSES reporting the amount of PATENT EXPENSES incurred, the purpose of incurring such PATENT EXPENSES, and the amount of PATENT EXPENSES owed by XXXX. Subject to the provisions of Section 6.1, XXXX will reimburse ROCHESTER within 45 days of receiving an invoice for PATENT EXPENSES from ROCHESTER.

6.3 Subject to the provisions of Section 4.5 and Article 5, LICENSE REVENUE will be shared by the PARTIES. In accordance with Section 4.5, the Discontinuing PARTY will receive no proceeds from LICENSE REVENUE attributable to a discontinued patent or patent application other than its reimbursement of contributed PATENT EXPENSES, if any. Any LICENSE REVENUE will be first applied to any unreimbursed PATENT EXPENSES incurred by XXXX and ROCHESTER. In addition, after reimbursement of PATENT EXPENSES, the PARTIES may mutually agree to hold all or a portion of any remaining LICENSE REVENUE in anticipation of future unreimbursed PATENT EXPENSES. When the PARTIES agree to distribute LICENSE REVENUE, ___% LICENSE REVENUE will be retained by ROCHESTER and ___% will be delivered to XXXX.

6.4 Within 45 days of receiving LICENSE REVENUE from any licensee, ROCHESTER will provide XXXX with a written report accounting for the total amount of LICENSE REVENUE received from any licensee, the amount of LICENSE REVENUE to reimburse PATENT EXPENSES, the amount of LICENSE REVENUE to be held in anticipation of future unreimbursed PATENT EXPENSES, the amount of LICENSE REVENUE retained by ROCHESTER, and the amount of LICENSE REVENUE due XXXX. Simultaneously with the report's delivery, ROCHESTER will pay XXXX the amount due XXXX. All payments to XXXX will be in U.S. Dollars, by check payable to _____ and sent to:

Attn: _____

6.5 XXXX will have the right to hire an independent, certified public accountant reasonably acceptable to ROCHESTER to audit financial records relating to LICENSE REVENUE and/or PATENT EXPENSES at its own expense. Such audits may be exercised during normal business hours upon at least 30 days prior written notice to ROCHESTER.

6.6 Each PARTY will be solely responsible for calculating and distributing LICENSE REVENUES as specified under its respective patent policy or royalty policy to its respective INVENTOR.

7. TERM AND TERMINATION

7.1 The term of this AGREEMENT is from the EFFECTIVE DATE until the PATENT RIGHTS expire, or the date the last license agreement for INVENTION terminates.

7.2 Either PARTY may terminate this AGREEMENT for any reasons upon 60 days written notice to the other PARTY.

7.3 Nothing herein will be construed to release either PARTY of any obligation matured prior to the effective date of termination.

8. INFRINGEMENT

8.1 If either PARTY becomes aware of potential infringement of any PATENT RIGHTS, then that PARTY will notify the other PARTY as soon as possible and the PARTIES agree to discuss and determine how best to end such infringement. If the PARTIES agree to begin an action for patent infringement, then they agree that the reasonable expenses and disbursements paid in connection with such action will be considered PATENT EXPENSES and all monies actually received as a result of the patent infringement action will be considered LICENSE REVENUE. If the PARTIES cannot agree to begin such an action, then either PARTY will have the right to prosecute the patent infringement action, and that PARTY will bear all the expense and be entitled to retain all monies received from such action.

8.2 The PARTIES will each use their best efforts to ensure that JOINT INVENTORS cooperate and supply all assistance reasonably requested in connection with any patent infringement action.

8.3 If during a patent infringement action either PARTY decides to discontinue its participation in the action, then the continuing PARTY may pay all future expenses associated with such action and will retain all monies or consideration from such action after first reimbursing any infringement action related expenses incurred by the discontinuing PARTY at a rate equal to the percentage of total expenses contributed by the discontinuing PARTY.

9. CONFIDENTIAL INFORMATION

9.1 Subject to the publication rights as set forth in Sections 9.2 and 9.3 hereof, ROCHESTER, XXXX and JOINT INVENTORS will retain in confidence, and will not disclose to a third party without the written consent of the other PARTY: (i) INVENTION, (ii) all information in documents marked "confidential" forwarded to one by the other, (iii) all biological materials related to INVENTION, or (iv) any patent application included in PATENT RIGHTS. Each PARTY'S obligation of confidence hereunder will be fulfilled by using at least same degree of care with the other PARTY'S confidential information it uses to protect its own confidential information. This obligation will exist while this AGREEMENT is in force and for a period of 3 years thereafter.

9.2 Notwithstanding the provisions of Section 9.1, ROCHESTER, and XXXX will be free to: (i) publish information relating to INVENTION and/or PATENT RIGHTS in scientific journals, (ii) use INVENTION and/or PATENT RIGHTS in research, teaching and other educationally-related purposes, and (iii) maintain INVENTION and make it available to the nonprofit research community solely for non-commercial research, teaching and other educationally-related purposes, provided that any transfer of INVENTION will be administered by a suitable agreement barring commercial use of INVENTION (i.e., material transfer agreement, confidentiality agreement, etc.). Additionally, ROCHESTER, and XXXX agree to supply the other with a copy of any manuscript prior to its submission for publication to permit the other to evaluate it in order to determine if it contains patentable subject matter relating to INVENTION and/or PATENT RIGHTS. Within 30 days after receiving a manuscript intended for publication, the receiving PARTY will notify the submitting PARTY whether a patent application will be filed in accordance with the terms and conditions herein. At the request of the receiving PARTY, the submitting PARTY agrees to delay publication in order to enable the preparation and filing of a patent application on any patentable subject matter described in the manuscript. If at the end of the 30 day period the PARTIES are unable to mutually agree to an acceptable publication date to allow a patent application to be filed, then the submitting PARTY is free to publish without the receiving PARTY'S approval.

9.3 Nothing herein will preclude ROCHESTER or XXXX from making reports or disclosures as required by any organizations which provided funding that resulted in the creation of all or a part of INVENTION and/or PATENT RIGHTS.

10. GENERAL

10.1 Neither PARTY will use the name of ROCHESTER, XXXX, or JOINT INVENTORS without express written consent.

10.2 This AGREEMENT will not be assigned by either PARTY without the prior written consent of the other PARTY.

10.3 This AGREEMENT constitutes the entire and only agreement between the PARTIES for INVENTION and PATENT RIGHTS and all other prior negotiations, representations, agreements, and understandings are superseded hereby. No agreements altering or supplementing the terms hereof may be made except by a written document signed by both PARTIES.

10.4 Any notice required by this AGREEMENT must be given by facsimile transmission confirmed by personal delivery (including delivery by reputable messenger services such as Federal Express) or by prepaid, first class, certified mail, return receipt requested, addressed to:

ROCHESTER

Office: University of Rochester Medical Center, Office of Technology Transfer
Address: 601 Elmwood Avenue Box OTT
Rochester, New York 14642
ATTENTION: _____
Phone: _____
Fax: _____

or in the case of XXXX to:

ATTENTION: _____
Phone: _____
Fax: _____

or other addresses as may be given from time to time under the terms of this notice provision.

10.5 Both PARTIES agree to comply with all applicable national, state and local laws and regulations in connection with its activities pursuant to this AGREEMENT.

10.6 Failure of a PARTY to enforce a right under this AGREEMENT will not act as a waiver of that right or the ability to later assert that right relative to the particular situation involved.

10.7 Headings are included herein for convenience only and shall not be used to construe this AGREEMENT.

10.8 If any part of this AGREEMENT is for any reason found to be unenforceable, all other parts nevertheless remain enforceable.

IN WITNESS WHEREOF, PARTIES hereto have caused their duly authorized representatives to execute this AGREEMENT.

By _____
Name:
Title:

By
Name:
Title:

Date _____

Date

Approved as to Content:

By _____
Name:
Title:

Date _____