



Office of Research Initiatives
Santa Clara University
500 El Camino Real
Santa Clara, CA 95053
(408) 551-1817 phone
(408) 551-1873 fax

Sponsored Research Agreement Joint Intellectual Property

This agreement is entered into effective _____, by and between _____ (hereinafter referred to as the “Sponsor”) and the PRESIDENT AND BOARD OF TRUSTEES OF SANTA CLARA COLLEGE, dba SANTA CLARA UNIVERSITY (hereinafter referred to as the “University”).

WHEREAS, the project contemplated by this Agreement is of mutual interest and benefit to the University and to the Sponsor and will further the instructional and research objectives of the University in a manner consistent with its status as a non-profit, tax-exempt, educational institution,

NOW, THEREFORE, the parties hereto agree as follows:

1. **STATEMENT OF WORK.** The University agrees to use its reasonable best efforts to perform the project described in the statement of work (the “Project”) in Exhibit A, which may be modified by mutual written agreement of the parties (the “Statement of Work”) and is hereby incorporated and made a part of this agreement. The Sponsor understands that the University’s primary mission is education and advancement of knowledge and the project will be designed to carry out that mission. The manner of performance of the project shall be determined solely by Principal Investigator (as defined below). University does not guarantee specific results.

The Statement of work shall include a budget for the Project. University shall have the flexibility to revise the budget as necessary during the term of the Project so as to provide the Principal Investigator the opportunity to use resources as he or she deems most reasonable, provided any changes are within the scope of the Project.

2. **PRINCIPAL INVESTIGATOR.** The Project will be supervised by the individual set forth in the Statement of Work (the “Principal Investigator”). If, for any reason, s/he is unable to continue his/her involvement in the project, and a successor acceptable to both the University and the Sponsor is not available, this Agreement may be terminated by either party with ten (10) days notice.
3. **TERM.** The project shall be conducted during the period set forth in the Statement of Work, unless the otherwise agreed to in writing by the parties, and will be subject to renewal only by mutual written agreement of the parties (the “Term”).
4. **REIMBURSEMENT OF COSTS.** In consideration of the foregoing, the Sponsor will reimburse the University for costs incurred by it in connection with the Project up to a maximum amount that is set forth in Exhibit A or as otherwise agreed to in writing by the parties.

The University will maintain records of its costs hereunder and of funds received in accordance with its regular policies and procedures based on recognized institutional accounting principles consistently applied. Sponsor shall have the right to examine the University's accounting records during the Term and for a period of one (1) year following the expiration of this Agreement. A final financial report setting forth costs incurred and funds received by the University under this Agreement shall be submitted within 90 days after termination of this Agreement. The report shall be accompanied by a payment by University in the amount, if any, of the excess funds advanced over allowable costs and commitments incurred.

5. PAYMENT. Sponsor shall make payments to the University as set forth in Exhibit A or if no payment schedule is described, Sponsor shall make payments when requested by University but such payments shall not be requested more than once a month during the Term. The

7. PUBLICATION. The Principal Investigator shall have the right to publish freely or otherwise publicly disclose the results of the Project subject to Section 8 of this Agreement, policies of the University and the following procedure. If University reasonably determines that any subject matter to be disclosed in such a publication is patentable, University will

without Sponsor's prior approval. In any permitted statement, the parties shall describe the scope and nature of their participation accurately and appropriately.

10. **APPLICABLE LAW.** Each party agrees to abide by all applicable laws, including any export laws, in the conduct of activities or exercise of rights hereunder. Sponsor represents and warrants that Sponsor has notified University in writing of any export control requirements.

11. **REPRESENTATIONS AND WARRANTIES.**

(a) University represents and warrants that University will perform the Project in conformance with any applicable laws and regulations. University also represents that all of its employees, students and consultants who participate in the Project will be obligated to assign to University all of their rights in the University Inventions and Joint Inventions.

(b) EXCEPT AS OTHERWISE PROVIDED HEREIN, THE UNIVERSITY MAKES NO WARRANTIES, EXPRESS OR IMPLIED, AS TO ANY MATTER WHATSOEVER, INCLUDING, WITHOUT LIMITATION, THE CONDITION OF THE RESEARCH OR ANY INVENTION(S) OR PRODUCT(S), WHETHER TANGIBLE OR INTANGIBLE, CONCEIVED, DISCOVERED, OR DEVELOPED UNDER THIS AGREEMENT; OR THE OWNERSHIP, MERCHANTABILITY, OR FITNESS FOR A PARTICULAR PURPOSE OF THE RESEARCH OR ANY SUCH INVENTION OR PRODUCT. THE UNIVERSITY SHALL NOT BE LIABLE FOR ANY DIRECT, CONSEQUENTIAL, OR OTHER DAMAGES SUFFERED BY ANY LICENSEE OR ANY OTHERS RESULTING FROM THE USE OF THE RESEARCH OR ANY SUCH INVENTION OR PRODUCT.

12. **FORCE MAJEURE.** The University shall not be liable for any failure to perform as required by this Agreement, to the extent such failure to perform is caused due to circumstances reasonably beyond its control, such as labor disturbances or labor disputed of any kind, accidents, failure of any governmental approval required for full performance, civil disorders or commotions, acts of aggression, acts of God, energy or other conservation measures, general failure of the Internet, explosions, failure of utilities, mechanical breakdowns, material shortages, disease, or other such occurrences.

13. **TERMINATION.** Either party may terminate this Agreement for any reason upon 30 days written notice to the other party after the completion of a Statement of Work or as otherwise set forth in the Statement of Work. University may terminate this Agreement for non-payment by Sponsor in excess of forty-five (45) days from invoice by Sponsor. Upon termination by either or both parties, the University will be reimbursed as specified in Article 4 for all non-cancelable commitments and other costs already incurred in the performance of the Agreement. Sections 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21 and 22 shall survive any expiration of this Agreement.

14. **INDEMNIFICATION.** The Sponsor agrees to indemnify, defend, and hold harmless the University, its trustees, directors, employees, agents and students (each, a "University Indemnitee") from any and all liability, loss (including attorneys' fees) or damage any University Indemnitee may suffer as a result of any third party claims arising out of or connected with the Project, except to the extent that such claim is due to gross negligence or

willful misconduct by a University Indemnitee, or a breach of any applicable law or regulation by a University Indemnitee related to the Project. The University Indemnitee shall promptly notify the Sponsor of any such claim and shall cooperate with the Sponsor in the defense of the claim.

- 15. **NONDISCRIMINATION.** University and Sponsor shall not discriminate against any employee or applicant for employment because of race, religion, national origin, sex, age or physical limitation, except where sex, age, or physical limitation is a bona fide occupational qualification.
- 16. **ASSIGNMENT.** Neither party shall assign this Agreement to another without the prior written consent of the other. Any such purported assignment shall be void.
- 17. **SEVERABILITY.** In the event a court of competent jurisdiction holds any provision of this Agreement to be invalid, such holding shall have no effect on the remaining provisions of this Agreement, and they shall continue in full force and effect.
- 18. **INDEPENDENT CONTRACTOR.** The University and Sponsor are independent contractors and neither is an agent, joint venturer, or partner of the other.
- 19. **GOVERNING LAW.** This Agreement shall be governed by the laws of the State of California. Any legal action arising out of or connected with the Agreement shall be adjudicated in the State of California.
- 20. **PROPERTY.** Title to all property purchased by the University with funds provided by the Sponsor pursuant to this Agreement shall become and remain property of the University unless otherwise agreed to in writing by both parties.
- 21. **NOTICES.** Any notices given under this agreement shall be in writing and delivered by first-class mail, postage prepaid, and addressed to the party to receive such notice at the address given below, or such other address as may be hereafter be designated by notice in writing:

University: Director of Sponsored Projects
 Sponsored Projects Office
 Santa Clara University
 500 El Camino Real
 Santa Clara, CA 95053-0250

Sponsor: _____

- 22. **ENTIRE AGREEMENT—CHANGES.** This Agreement constitutes the entire and only understanding between the University and the Sponsor relating to the subject matter of the Project. Any alterations or supplements to this Agreement must be made in writing and signed by duly authorized representatives of both parties.

IN WITNESS WHEREOF, the University and the Sponsor have caused this Agreement to be executed by their duly authorized representatives.

SANTA CLARA UNIVERSITY

(SPONSOR)

Signature: _____

Signature: _____

Name: _____

Name: _____

Title: _____

Title: _____

Date: _____

Date: _____

Exhibit A

Exhibit A

Statement of Work

Principal Investigator(s):

Description of the Project:

Deliverables:

Budget:

Payment Schedule:

Maximum Amount of Costs that will be reimbursed by Sponsor unless otherwise agreed to by the parties:

Appendix E



Appendix F



**Intellectual Property
Assignment Agreement for Class Projects**

1. The work product described in Exhibit A (the “Work Product”) was created as part of a Santa Clara University (“SCU”) class project for _____ (the “Third Party”).
2. Subject to the license retained by SCU set forth herein, SCU hereby assigns to the Third Party SCU’s right, title and interest in and to the

Exhibit A
Work Product

Appendix G



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Class Project Assignment Form for Students

_____ (“Project”)

_____ (“Student”)

1. The Project listed above will be created as part of a Santa Clara University (“SCU”) class project.
2. Whereas, in accordance with SCU’s patent policy (Section 3.7.5 of The Faculty Handbook), “discoveries or inventions that do not involve either University obligations to a third party or the significant use of funds, materials, or facilities administered by the University” shall be the property of the Student. The Student has enrolled and is participating in a class with a project that is delivered to a third party (“Third Party”) and as a result, Student has agreed to grant SCU assignment of his or her ownership rights in this Project so that SCU may assign such ownership rights to Third Party. SCU hereby grants Student a license to any intellectual property rights in the Project to the extent that SCU has the right to grant such intellectual property rights. SCU shall make good faith efforts to have Third Party give recognition to Student for Student’s contribution to the Project.
3. In order for SCU to obtain ownership rights, Student hereby irrevocably assigns, transfers, and conveys to SCU all of Student’s right, title and interest in and to the Project, any information (including, without limitation, business plans and/or business information), technology, know-how, materials, notes, records, designs, ideas, Projects, improvements, devices, developments, discoveries, compositions, trade secrets, processes, methods and/or techniques, whether or not patentable or copyrightable, that are conceived, reduced to practice or made that relate to the Project (collectively, “Work Product”). For clarity the Project and the Work Product do not include the features described in an attached exhibit, if any such exhibit has been agreed to by the parties, except for in accordance with SCU’s patent policy referenced herein, any discoveries or inventions that involve the significant use of funds, materials, or facilities administered by the University shall be the property of SCU. Student shall, in good faith, negotiate and enter into an agreement with SCU or the Third Party regarding a non-exclusive license to the intellectual property retained by Student described in the attached exhibit.
4. Student agrees to sign, execute and acknowledge or cause to be signed, executed and acknowledged without cost, but at the expense of SCU or Third Party, any and all

documents and to perform such acts as may be necessary, useful or convenient for the purposes of perfecting the foregoing assignments and obtaining, enforcing and defending intellectual property rights in any and all countries with respect to Work Product. It is understood and agreed that SCU or Third Party shall have the sole right, but not the obligation, to prepare, file, prosecute and maintain patent applications and patents worldwide with respect to the Work Product.

5. Student represents and warrants to SCU that Student has all rights necessary to effect the assignment granted herein, Student has not or will not grant any licenses or other rights to the Work Product to any third party, and to Student's knowledge, Student will not incorporate into the Project any intellectual property of any other party except for intellectual property from other students in the class.
6. This Agreement constitutes the final and complete agreement between the parties with respect to the subject matter hereof, and supersedes any prior or contemporaneous agreement, either written or oral. This Agreement shall be governed by the laws of the State of California, without regard to its conflicts of law provisions. Both parties hereby consent to the exclusive jurisdiction and venue of the state and federal courts located in Santa Clara, California. If any provision of this Agreement is held by a court of competent jurisdiction to be contrary to law, such provision will be changed and interpreted so as to best accomplish the objectives of the original provision to the fullest extent allowed by law, and if no feasible interpretation will save such provision, it shall be severed from this Agreement, and the remaining provisions remain in full force and effect. The failure of either party to enforce any provision of this Agreement or an express waiver shall in no way be construed to be a present or future waiver of such provision, nor in any way affect the right of either party to enforce such provision thereafter.

This Agreement is binding on me, my estate, heirs and assigns.

Student

Signed: _____

Date: _____

Acknowledged:

SCU

Signed: _____

Date: _____

Appendix H



property rights in any and all countries with respect to Work Product. It is understood and agreed that SCU or SCU's designee shall have the sole right, but not the obligation, to prepare, file, prosecute and maintain patent applications and patents worldwide with respect to the Work Product.

6. Researcher represents and warrants to SCU that Researcher owns the Work Product and has all rights necessary to effect the assignment granted herein, Researcher has not granted any licenses or other rights to the Work Product to any third party, and to Researcher's knowledge, the Work Product does not infringe or misappropriate any Intellectual Property Right of any third party.
7. This Invention Rights Assignment S2,Tj 9 0xdr

Exhibit A
Invention Disclosure Form