Technology Transfer and Commercialization
Faculty Technology Transfer Cooperation Agreement

October 10
Technology Transfer Cooperation Agreement
(A limited intellectual property agreement)

PASSHE FACULTY

Purpose: This form is to be completed and signed by “covered University faculty” engaged in “covered research”. Signing this document does NOT assign your ownership of intellectual property. Assignment of Intellectual Property at some future point in time does NOT negate your rights to royalties, licensing fees, and other income resulting from the commercialization of assigned intellectual property in accordance with the Collective Bargaining Agreement. This agreement is to be signed prior to the initiation of covered research; therefore it should be signed by all covered University faculty at the time of award of sponsored research, including internally sponsored research, or at the time of initiation of research which potentially and foreseeably utilizes Substantial Use of University Resources/Support/Facilities. (Non-faculty personnel involved in the project, except clerical and non-technical staff, sign the Intellectual Property Agreement – PASSHE NON-FACULTY PERSONNEL)

Definitions:
“Covered research” includes

(1) any federally funded grant or contract proposal,
(2) continuation of prior federally assisted research,
(3) any non-federal grant or contract proposal with applicable sponsor requirements,
(4) any grant or contract proposal, when the use of University resources, support, and facilities meets the threshold of Substantial Use of Institutional Resources by the named faculty.
(5) any independent, self-directed faculty research, when the use of University resources, support, and facilities meets the threshold of Substantial Use of Institutional Resources by the named faculty.

“Covered University Faculty” include “tenured”, “probationary non-tenured faculty” and “non-tenure track faculty” who may be in a position to make, conceive or reduce to practice inventions or otherwise develop technology. University faculty members who are NOT in a position to make, conceive or reduce to practice inventions or otherwise develop technology are NOT expected to sign this document.

“University” shall mean the ____________________ University of Pennsylvania.

Additional definitions are found in the PASSHE Technology Transfer and Commercialization Guidelines.

Instructions: All “Covered Faculty” read and sign Part A, and read and sign EITHER Part B OR Part C, as applicable. The original signed agreement should be returned to the University Sponsored Projects Office or equivalent via your department of employment.

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Part A.

1. I agree it is my responsibility to read and understand PASSHE Technology Transfer and Commercialization Guidelines, and University procedures. This information is available at www.passhe.edu/techtransfer, and/or my University Sponsored Project Office.

2. I agree, as a condition of my association on the following research project [PROJECT NAME] to abide by the terms of the PASSHE Technology Transfer and Commercialization Guidelines currently in effect, as well as any subsequent revisions thereto. In so agreeing, I especially note the responsibilities set forth herein.

3. I understand that this agreement is part of the terms of my association with the above stated project and is limited to University Intellectual Property resulting from such project.

4. My responsibility set forth in Part B Section (3), or Part C Section 4 (a) will continue after termination of my association with the University.

5. In the event I submit an Invention Disclosure as outlined in Part B.1. or Part C.1. I understand that, as an employee covered by a Collective Bargaining Agreement, the Office of the Chancellor has agreed to provide my Collective Bargaining Agent notice of my participation in the Technology Transfer and Commercialization Services. Only my name and University affiliation will be released. This does not preclude me from discussing any issues or questions with University or Office of the Chancellor administrators and local APSCUF.

______________________________  _____________________________
Faculty  Printed Name  University ID # or Individual Taxpayer Identification Number

______________________________  _____________________________
Signature  Date

PART B. Applicable to Federally sponsored research projects, specific sponsor requirements, and voluntary assignments of faculty Intellectual Property.

I agree:

(1) to submit invention disclosures to the University promptly following the completion of conception or the first reduction-to-practice of any invention, discovery, rights of patent or software (hereinafter "Intellectual Property");

(2) to assign to the University (or its designee) all rights which I have or may acquire in inventions, discoveries, rights of patent therein, or software which are conceived and reduced-to-practice by me:
   a. with the assistance of federal funds and/or the continuation of a previously federally funded research, or
b. with the support of a non-federal sponsor according to the terms of the sponsorship agreement, or in cases where the University and I mutually and voluntarily elect (Items (2) a. through (2) b. is hereinafter referred to as University Intellectual Property.)

(3) to do whatever is required to enable the University (or its designee), at its expense, to protect the University Intellectual Property, whether by patent, copyright or otherwise; including:
   a. making myself available to meet with patent attorney and provide necessary documentation, data and research results to support the filing or prosecution of patent applications or
   b. reviewing and signing documents from patent attorney retained by the University (or its designee) to seek protection of University Intellectual Property, or
   c. to assist the University (or its designee) in seeking licensees to commercialize University inventions;

(4) to maintain laboratory documentation, including laboratory notebooks, where appropriate, to adequately demonstrate that inventions or discoveries were conceived or first reduced-to-practice by me including clear identification of any sponsorship;

(5) prior to completion of my association with work contracted pursuant to contracts or grants, a complete disclosure of all software, inventions or discoveries conceived or first reduced-to-practice by me with the utilization of time, money or facilities charged to contracts or grants, and copyrightable works vested there under, must be submitted to the University.

(6) If I serve as a principal investigator or director of a University research, development, or other type of project, I will determine whether each person who performs any part of the research or development work on the project for which I am responsible has signed an appropriate Intellectual Property Agreement; and if not, will obtain such additional Intellectual Property Agreements as are necessary, and forward them to the University Authorized Official.

I intend to be legally bound by this agreement.

______________________________  ______________________________
Faculty Printed Name          University ID # or Individual Taxpayer Identification Number

______________________________  ______________________________
Signature                     Date
PART C. Applicable to research projects, including independent, self-directed faculty research, when the use of University resources/support/facilities meets or foreseeably meets the threshold of Substantial Use of Institutional Resources by the named faculty. This includes sponsored research that has no specific sponsor requirements.

I agree:

1. to submit Invention Disclosures to the University promptly following the completion of conception or the first reduction-to-practice of any invention, discovery, rights of patent or software (hereinafter "Intellectual Property");
2. to negotiate in good faith with the University (or its designee) an assignment of rights of title which I have or may acquire in inventions, discoveries, rights of patent therein, or software which are conceived and reduced-to-practice by me, individually or jointly, when the use of University resources meets the threshold of Substantial Use of Institutional Resources on the named project.
3. to report, to the best of my ability, the type and amount of University resources I have utilized to support the named research project and complete timely review of the University documentation of Substantial Use.
4. If and when negotiations result in assignment of my rights of title in inventions, discoveries, rights of patent therein, or software to the University, I further agree
   a. to do whatever is required to enable the University (or its designee), at its expense, to protect the University Intellectual Property, whether by patent, copyright or otherwise; including:
      i. making myself available to meet with patent attorney and provide necessary documentation, data and research results to support the filing or prosecution of patent applications or
      ii. reviewing and signing documents from patent attorney retained by University (or its designee) to seek protection of University Intellectual Property, or
      iii. to assist the University (or its designee) in seeking licensees to commercialize University inventions;
   b. to maintain laboratory documentation, including laboratory notebooks, where appropriate, to adequately demonstrate that inventions or discoveries were conceived or first reduced-to-practice by me including clear identification of any sponsorship;
   c. to submit to the University, prior to completion of my association with work contracted pursuant to contracts or grants, a complete disclosure of all software, inventions or discoveries conceived or first reduced-to-practice by me with the utilization of time, money or facilities charged to contracts or grants, and copyrightable works vested there under.
   d. If I serve as a principal investigator or director of a University research, development, or other type of project, I will determine whether each person who performs any part of the research or development work on the project for which I am responsible has signed an appropriate Technology Transfer Cooperation Agreement or University Intellectual Property Agreement; and if not, will obtain such additional Agreements as are necessary, and forward them to the University Authorized Official.
I intend to be legally bound by this agreement.

______________________________  _____________________________
Faculty Printed Name University ID # or Individual Taxpayer Identification Number

______________________________  _____________________________
Signature Date