

PATENT, RESEARCH, AND
PROPRIETARY RIGHTS AGREEMENT

I understand that my duties as an employee or student of Michigan Technological University (the "University") may include some form of research and access to proprietary data. I agree that the facilities, equipment, funds, and stimulation provided to me may greatly contribute to my research efforts, and to the conception or reduction to practice of Proprietary Information as defined below and the creation of documentation, data, and reports related to Proprietary Information.

I agree that for the purposes of this agreement "Proprietary Information" means, collectively and individually,

- (1) patentable and unpatentable inventions of all types, including without limitation discoveries, developments, methods, apparatus, and software, and
- (2) any and all documentation, data, and reports related to or associated with any such patentable or unpatentable inventions which are reduced to practice, conceived, or created by me, either solely or jointly with others, within the scope of my duties as an employee of the University, or through the use of the facilities and equipment of the University, whether during my usual working hours or otherwise.

A. In consideration of my employment with and the salary paid to me by the University or in consideration of access to facilities granted to me by the University; and

In order to settle in advance any questions regarding the ownership of any Proprietary Information;

I agree that the University shall own all Proprietary Information and the University also shall own any patents or copyrights relating to such Proprietary Information.

I further agree:

1. I will promptly and fully disclose all Proprietary Information to the University.
2. With respect to all Proprietary Information, the University may 1) determine, in its sole discretion, that the ownership of the Proprietary Information will not be retained by the University and it will notify me of the relinquishment of its rights to me, 2) notify me that the Proprietary Information will be retained by it on a provisional basis, or 3) retain the Proprietary Information. No action is required by the University to retain the Proprietary Information
3. I will cooperate with the University in making application for U.S. and foreign patents or copyrights relating to any Proprietary Information at the request of and at the expense of the University should it determine, in its sole discretion, that an application is warranted. I will do all acts required to assist the University in obtaining, maintaining, and enforcing patents and copyrights or other interests held by the University in Proprietary Information in any and all countries, all to be done without further compensation to me other than reimbursement for direct expenses in providing such assistance.

4. I hereby assign to the University all Proprietary Information, all applications for patents and other intellectual property protection relating to such Proprietary Information, and all patents, copyrights, and other government-granted rights or registrations issued on such Proprietary Information, with full rights, powers and privileges of ownership and agree to support the University in filing any such patents and copyrights and agree to execute any documents necessary and provide all necessary information to support this process.

5. The University may retain or may elect to assign the ownership of any Proprietary Information and/or applications, patents, or copyrights on such Proprietary Information back to me should it determine, in its sole discretion, that further expense for development is unwarranted. The University shall retain its ownership until execution of a formal written assignment from the University to me.

6. If Proprietary Information or patents or copyrights relating thereto, are sold or licensed by the University, the University shall share income from such sale or license ("Income") as follows:

- a. initial Income up to \$1,000 to me.
- b. Income from \$1,000 to \$30,000 divided 15% to me and 85% to the University.
- c. Income from \$30,000 to \$180,000 divided equally among the University, my department, and myself,
- d. Income in excess of \$180,000 divided 1/3 to me and 2/3 to the University.

Income payments will be made to me within 60 days of the end of the calendar year. If the Proprietary Information on which Income is received is the product of collaboration with others entitled to participate in the royalties who have entered into similar agreements with the University, payment will be made in proportionate shares as we (I and the others collaborating with me) may agree upon, the aggregate to all persons not to exceed the amount of percentage set forth in this agreement. If the University has not been advised of the amount of proportionate shares at the time a distribution is to be made under this agreement, the University may make such distribution as it, in its sole discretion, determines.

7. Progression to the sharing ranges of paragraph 6 above shall occur on the basis of cumulative income received by the University over the life of this agreement.

8. In some instances, the University may incur extraordinary expenses, for example, either in further developing a concept to reduce it to practice, or in enhancing the marketability for licensing by establishing a pilot project, or in enforcing its patents or other rights against infringers or others who have misappropriated the same or in defending the same from attack by others. In those extraordinary instances, before sharing any of the aforesaid income with me under paragraph 6 of this agreement, the University will reimburse itself for actual out-of-pocket

expenses incurred (for example, costs of land site, buildings, equipment, and labor in connection with a pilot project or legal fees and other expenses related to litigation). These extraordinary expenses will be reimbursed from all income received by the University, and, generally, expenses incurred in a given calendar year will be reimbursed from income received in that calendar year; however, if income does not cover all expenses in any given year, any remaining balance will be carried forward to succeeding years until credited in full but not back to prior years.

B. In the event that I am engaged in sponsored research or other projects under a contract between the University and an outside agency during my employment or enrollment with the University ("Sponsored Project Agreement"), I also agree that:

1. The terms of the Sponsored Project Agreement shall control as to any conflict with this agreement.
2. I will be bound by the Sponsored Project Agreement as to any obligation which extends beyond the term of this agreement and I will execute any and all documents which the University deems necessary, in its sole discretion.
3. Any change in the terms of this agreement or obligations imposed by this paragraph B shall be effective for the term of the Sponsored Project Agreement.

C. From time to time, during my employment or enrollment with the University I may undertake to perform consulting services for third parties ("Consulting Services") but will do so only if the Consulting Services do not conflict with University administrative policies and do not present a conflict of interest. In the event I do undertake to perform Consulting Services, I agree that:

1. I will advise the University if the Consulting Services will involve the use of University equipment and will use any such University equipment only with prior approval from the University and upon payment of a charge should the University, in its sole discretion, determine that such a charge should be imposed in return for the use of such equipment and in return for the University relinquishing the claim it would have on the results of Consulting Services because of the use of its equipment.
2. If the Consulting Services is governed by an agreement that includes the assignment of inventions and/or patents to the consultee, I will advise the University of the Consulting Services and the governing agreement before I start the Consulting Services. I will also advise the consultee of this agreement and of any rights held by the University in the area of the Consulting Services including but not limited to patent rights and copyrights. Also, I will not perform any Consulting Services if such Services are governed by an agreement that grants the consultee a license to any right held by the University, including but not limited to patent rights and copyrights. Any such agreement governing Consulting Services will be considered null and void.

D. I understand that paragraph B and C in no way diminishes my obligation to fully and promptly disclose to the University any Proprietary Information.

E. I will not directly or indirectly during the term of my employment or enrollment with the University and for a period of 2 years after termination of my employment or enrollment with the University, unless otherwise provided for under another agreement or legal order, 1) give to any person, not authorized in writing by the University to receive it, any information classified for purposes of internal University security or specifically designated by the University as "limited," "private," or "confidential;" or 2) give to any person not authorized in writing by the University to receive it, any of the University's proprietary data or information relating to products, programs, software, systems, inventions, ideas, processes, research, and the like and including, without limitation, drawings, programs, software, system sketches, layouts, formulae, specifications, reports, and other written manufacturing, technical, or scientific information. Notwithstanding the foregoing, I will not directly or indirectly disclose any information owned by the University deemed a trade secret under the Uniform Trade Secrets Act for as long as it is so deemed a trade secret.

F. This agreement constitutes the entire agreement between the parties with respect to its subject matter and supersedes all prior oral and written agreements between the parties with respect to the same subject matter. This agreement may not be modified or changed in whole or in part, except in a writing expressly accepted by the party against which enforcement is sought.

G. If any provision of this agreement is determined to be invalid, illegal, or unenforceable, the validity, legality, and enforceability of the remaining provisions of this agreement shall be unaffected.

H. This agreement shall be construed and governed by and under the laws of the State of Michigan, without regard to its conflicts of laws principles.

I have read and understood this agreement in its entirety (both sides of this document).

Signature

Date

Name (Printed or Typed)

Department