This draft is dated \_\_\_\_\_\_\_\_\_\_\_\_\_\_, \_\_\_\_\_, and is solely for purposes of negotiation. No contract shall exist until a final, written agreement is signed by WiSys and an authorized representative of Institution. This draft shall expire thirty (30) days after the above date.

Inter-Institutional Agreement

for

WiSys Ref.: \_\_\_\_\_\_\_\_\_\_-T\_\_\_\_\_\_\_\_\_\_

[Title of Invention Disclosure]

This Inter-Institutional Agreement (“**Agreement**”), is dated and made effective as of the \_\_\_\_\_day of, \_\_\_\_\_\_\_\_ (the “**Effective** **Date**”), by and between WiSys Technology Foundation (hereinafter “**WiSys**”), having an address at 401 Charmany Dr. Suite 205, Madison, Wisconsin 53719 and \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(hereinafter “**Institution**”), having an address at \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_.

**WHEREAS**, \_\_\_\_\_\_\_\_\_ and \_\_\_\_\_\_\_\_\_\_, both researchers at the University of Wisconsin \_\_\_\_\_\_\_\_\_\_ (“University”), working together with \_\_\_\_\_\_\_\_\_\_\_\_\_\_, a researcher at Institution, have developed the Invention described below;

**WHEREAS**, the Invention may be afforded certain Patent Rights, which will be owned jointly by WiSys and Institution; and

**WHEREAS**, WiSys and Institution wish to enter into this Agreement to establish a means for filing and prosecuting the Patent Rights, for administering and licensing the Patent Rights, and for sharing income derived from licensing of the Patent Rights;

**NOW**, **THEREFORE**, the parties agree as follows:

# Definitions.

For purposes of this Agreement, the definitions set forth in Appendix A shall apply.

# Grant.

## Patent Rights.

### Institution hereby grants to WiSys the exclusive right to prepare, file, prosecute, maintain, reexamine and reissue Patent Rights. WiSys shall have the sole discretion to make decisions with respect thereto.

### WiSys hereby agrees to file a United States patent application claiming the Inventions. WiSys and Institution shall mutually agree in which foreign countries WiSys will pursue foreign patent protection for the Inventions. WiSys reserves the right to file foreign patent applications in jurisdictions other than those agreed to by Institution at WiSys’s own expense; provided, however, any income generated in such jurisdictions shall be excluded from Income shared under this Agreement.

### During the term of this Agreement, neither party will assign its undivided interest in the Patent Rights without the prior written consent of the other party.

## Licensing.

### Institution hereby grants to WiSys the exclusive right to negotiate, execute, administer, and enforce License Agreements.

### WiSys will seek one or more Licensees for the commercial development of the Inventions, and will administer all License Agreements for the mutual benefit of WiSys and Institution.

## Research Grant.

Institution hereby reserves, and WiSys hereby grants to Institution, the right to use the Inventions for non-commercial research purposes.

# Consideration.

## Patent Rights.

### In consideration for the rights granted in Section 2B, WiSys agrees to pay to Institution \_\_\_\_\_\_\_ percent (\_\_\_%) of all Net Revenues derived from License Agreements granted in the Licensed Territory.

### In consideration for the rights and obligations set forth in Section 2A, Institution shall pay to WiSys \_\_\_\_\_\_\_\_\_\_ percent (\_\_\_%) of the actual costs incurred by WiSys in filing, prosecuting and maintaining the Patent Rights in the Licensed Territory. Institution shall pay to WiSys such costs within thirty (30) days of receiving an invoice from WiSys.

## Administration Fee.

In consideration for securing and administering License Agreements under Section 2B, WiSys shall be entitled to retain an Administration Fee prior to paying Institution pursuant to Section 3A(i) above.

## Accounting; Payments.

### WiSys will keep account of all Income received by it under each License Agreement, and will pay to Institution its share of Net Revenues due under this Agreement every twelve (12) months by September 30 for the preceding period beginning July 1 and ending June 30. Each party shall be solely responsible for calculating and distributing its share of Net Revenues to its respective inventors in accordance with its own policy.

### In licensing the Patent Rights, WiSys may include rights under other patents and/or proprietary rights to which WiSys owns a part of or all right, title and interest. WiSys may also include certain aspects of the Patent Rights in other licenses directed primarily to subject matter or technology other than that contemplated by this Agreement. In such event, WiSys shall have the authority to assign relative values to the Patent Rights and the other patent and proprietary rights as are included in such license. The portion of the gross receipts from royalties received by WiSys under such license, which shall be Income hereunder to be divided with Institution as provided in Section 3A(i), shall be determined in accordance with the relative values assigned to the Patent Rights in proportion to the total value represented by all patent rights and proprietary rights included within said license.

# Warranties and Representations.

## WiSys warrants and represents that the University Inventor(s) has/have assigned to WiSys all of his/her/their right, title and interest in and to any and all Patent Rights.

## Institution warrants and represents that the Institution Inventor(s) has/have assigned to Institution all of his/her/their right, title and interest in and to any and all Patent Rights.

## Institution warrants and represents that it has not granted any licenses or other rights to any other party under any Patent Rights.

## In the event either party now or in the future holds or acquires an interest in technology that can compete in the marketplace or otherwise with all or any part of any inventions or patents held by either of the parties, whether as a consequence of this Agreement or otherwise, the parties hereto agree that each of them may so proceed in their efforts to commercialize their technology (other than the Patent Rights) as, in their sole and best judgment, each deems appropriate. Furthermore, this Agreement in no way restricts either party from cooperating with or receiving cooperation from other public and private agencies, organizations, and individuals with respect to any of the normal activities of either of the parties.

# Records and Reports.

## WiSys shall keep books and records sufficient to verify WiSys’s accounting referred to above, including without limitation, invoice records relating to Income. Such books and records shall be preserved for a period not less than six (6) years after they are created during and after the term of this Agreement.

## WiSys shall take all steps necessary so that Institution may, within thirty (30) days of its request, review and copy at a single U.S. location WiSys’s books and records to verify WiSys’s compliance with this Agreement and the accuracy and completeness of its accounting referred to above. Such review may be performed not more than once annually by a duly authorized agent or representative of Institution, upon reasonable notice and during regular business hours.

# Term and Termination.

## This Agreement is effective from the date recited on page one and will remain in effect until the expiration of the last-to-expire patent under the Patent Rights.

## If no License Agreement remains in effect (or is being negotiated) by the \_\_\_th anniversary of the issuance of a patent in connection with the Patent Rights, WiSys or Institution may terminate this Agreement after providing sixty (60) days’ notice to the other party.

## If either party at any time defaults in the timely payment of any monies due to the other, or commits any breach of any other covenant herein contained, and such party fails to remedy any such breach or default within ninety (90) days after written notice thereof by the non-breaching party, this Agreement shall terminate and each party shall be free to license the technology in accordance with United States Patent Law. However, in the event of termination, Institution hereby agrees that it shall not have the right to license in territories where it elected not to pay its share of the patent costs.

## Any termination of this Agreement will not affect the rights and obligations set forth in Section 8.

# Assignability.

This Agreement binds and inures to the benefit of the parties, their successors or assigns, but may not be assigned by either party, whether pursuant to a change-of-control event or otherwise, without the prior written consent of the other party, which consent shall not be unreasonably withheld.

# Confidentiality.

## WiSys and Institution, respectively, will maintain the other party’s proprietary information relating to the Invention or the Patent Rights, including the business, licensing, patent prosecution, software, engineering drawings, process and technical information relating thereto (“Proprietary Information”) in confidence using reasonable procedures at least as stringent as those used by the party to protect its own Proprietary Information of a like nature for a period from the date of disclosure until five years after the date of termination of this Agreement. Either party shall have the right to disclose the other party’s Proprietary Information to the extent such disclosure is necessary or appropriate to the conduct of such party’s obligations hereunder.

## Nothing contained herein will in any way restrict or impair the right of WiSys or Institution to use, disclose, or otherwise deal with any Proprietary Information that:

### recipient can demonstrate by written records was previously known to it;

### is now or becomes in the future public knowledge, other than through acts or omissions of recipient; or

### is lawfully obtained without restrictions by recipient from sources independent of the disclosing party.

## Nothing contained herein will in any way restrict or impair the right of WiSys or Institution to disclose Proprietary Information:

### to a governmental entity to the extent such disclosure is required in connection with the seeking of any governmental or regulatory approval, or is otherwise required by law; or

### to another party, Licensees or potential Licensees, with similar confidentiality restrictions imposed on the other party, as evidenced in writing.

# Legal Actions.

## WiSys shall have the sole and exclusive right to determine whether or not the parties hereto shall engage in and prosecute any legal actions involving the Patent Rights, including infringement, interference, opposition and appeals. Such legal actions shall be at WiSys’s cost and shall be under the exclusive control of WiSys. Upon WiSys’s request, Institution shall join in any action and otherwise provide WiSys with such assistance and information as may be useful to WiSys in connection with WiSys taking such action. WiSys shall reimburse Institution for Institution’s reasonable out-of-pocket expenses incurred in providing such assistance. WiSys shall have the right to assign its rights under this Section 9 to any Licensees under the Patent Rights.

## Any monetary recoveries actually received and retained by WiSys from actions referred to in Section 9A shall first be allocated to reimburse WiSys for costs incurred in engaging in such legal actions. Any sums remaining after WiSys has been fully reimbursed, shall be treated as Income.

# Use of Names.

Neither party may use the name of the other party in any way for advertising or publicity without the express written consent of the other party, provided, however, that WiSys has the right to use the name of Institution within the context of a License Agreement.

# Notices.

Any notice or payment required to be given pursuant to the provisions of this Agreement will be deemed to have been properly given if delivered, in writing, in person, by electronic transmission, i.e., email, or mailed by first-class certified mail to the following addresses, or another address as may be designated in writing by the parties from time to time during the term of this Agreement:

#### WiSys Technology Foundation

Attn: Contracts Manager

614 Walnut Street

Madison, Wisconsin 53726

Phone: (608) 263-2500

Facsimile: (608) 263-1064

Email: contracts@warf.org

#### Institution:

Attn:

Phone:

Facsimile:

Email:

# United States Government Interests.

It is understood that if the United States Government (through any of its agencies or otherwise) may have funded research, during the course of or under which any of the Inventions were conceived or made, the United States Government is entitled, as a right, under the provisions of 35 U.S.C. § 200-212 and applicable regulations of Chapter 37 of the Code of Federal Regulations, to a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced the Inventions for governmental purposes. Any license granted to a Licensee shall be subject to such right.

# Miscellaneous.

This Agreement shall be governed by and construed in all respects in accordance with the laws of the State of Wisconsin. If any provisions of this Agreement are or shall come into conflict with the laws or regulations of any jurisdiction or any governmental entity having jurisdiction over the parties or this Agreement, those provisions shall be deemed automatically deleted, if such deletion is allowed by relevant law, and the remaining terms and conditions of this Agreement shall remain in full force and effect. If such a deletion is not so allowed or if such a deletion leaves terms thereby made clearly illogical or inappropriate in effect, the parties agree to substitute new terms as similar in effect to the present terms of this Agreement as may be allowed under the applicable laws and regulations. The parties hereto are independent contractors and not joint venturers or partners.

# Integration.

This Agreement constitutes the full understanding between the parties with reference to the subject matter hereof, and no statements or agreements by or between the parties, whether orally or in writing, except as provided for elsewhere in this Section 14, made prior to or at the signing hereof, shall vary or modify the written terms of this Agreement. Neither party shall claim any amendment, modification, or release from any provisions of this Agreement by mutual agreement, acknowledgment, or otherwise, unless such mutual agreement is in writing, signed by the other party, and specifically states that it is an amendment to this Agreement.

# Authority.

The persons signing on behalf of WiSys and Institution hereby warrant and represent that they have authority to execute this Agreement on behalf of the party for whom they have signed.

**IN WITNESS WHEREOF**, the parties hereto have duly executed this Agreement on the dates indicated below.

**WISYS TECHNOLOGY FOUNDATION**

By: Date: ,

Appropriate WiSys representative, Title

**INSTITUTION**

By: Date: ,

Name and Title:

WiSys Ref: \_\_\_\_\_\_\_\_\_ - T\_\_\_\_\_\_\_\_

APPENDIX A

1. “Administration Fee” shall mean a fee equal to fifteen percent (15%) of Income to be retained by WiSys pursuant to Section 3B as consideration for securing and administering License Agreements.
2. “Income” shall mean any monetary payments received by WiSys under the terms of a License Agreement in consideration for Patent Rights, whether as royalties or fees from a License Agreement or monetary recoveries less costs incurred by WiSys pursuant to Section 9.
3. “Institution Inventor(s)” shall mean the following persons: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ or any other person employed by the Institution who is hereafter named as an inventor of the Patent Rights.
4. “Invention” shall mean the inventions disclosed to WiSys in WiSys Ref.:\_\_\_\_\_\_\_\_\_\_\_, - T\_\_\_\_\_\_\_\_\_, entitled .
5. “License Agreement” or “License Agreement(s)” shall mean any agreement(s) entered into by WiSys on behalf of Institution and WiSys that grants a Licensee rights under the Patent Rights in the Licensed Territory.
6. “Licensed Territory” shall mean the United States and those countries in which WiSys and the Institution have mutually agreed to file patent applications.
7. “Licensee” or “Licensees” shall mean any party that enters into a License Agreement with WiSys.
8. “Net Revenues” shall mean Income less the Administration Fee.
9. “Patent Rights” shall refer to and mean all patent applications, patents, reissues, divisionals, continuations, and continuations-in-part (“CIP”) in the Licensed Territory claiming the Invention or any part thereof where there are University Inventor(s) and Institution Inventor(s).
10. “University Inventor(s)” shall mean the following persons: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ or any other person employed by the University of Wisconsin who is hereafter named as an inventor of the Patent Rights.