

# RESEARCH AGREEMENT

BETWEEN

THE RESEARCH FOUNDATION FOR THE STATE UNIVERSITY OF NEW YORK

AND

[SPONSOR]

This Agreement ("Agreement") dated \_\_\_\_\_ (the "Effective Date") is made by and between The Research Foundation for the State University of New York, a private, nonprofit, educational corporation existing under the laws of the State of New York, with an office located at Office of Sponsored Programs, W-5510 Melville Library, Stony Brook, New York 11794-3362, ("Foundation"), acting on behalf of The State University of New York, Stony Brook University ("University"), and \_\_\_\_\_, a corporation organized and existing under the laws of the state of \_\_\_\_\_, with its principal office located at \_\_\_\_\_, ("Sponsor"). Foundation and Sponsor may be referenced herein independently as "Party" or jointly as "Parties".

## WITNESSETH:

**WHEREAS**, Sponsor and Foundation have a mutual interest in promoting research related to \_\_\_\_\_, hereinafter referred to as the "Field;" and

**WHEREAS**, University has developed expertise relating to the Field; and

**WHEREAS**, Sponsor has approved funding to support a research project entitled " \_\_\_\_\_," hereinafter referred to as the "Project" which will be carried out by Dr. \_\_\_\_\_, an \_\_\_\_\_ employee of \_\_\_\_\_ University or Foundation appointed by the Foundation to supervise and direct the Project hereinafter referred to as the "Foundation Principal Investigator"; and

**WHEREAS**, the Project contemplated by this Agreement is of mutual interest and benefit to Foundation and Sponsor, will further the instructional and research objectives of University in a manner consistent with the Foundation's status as a nonprofit, tax-exempt, educational institution, and may provide benefits for both Foundation and Sponsor through inventions, improvements, and/or discoveries, and

**WHEREAS**, Foundation provides sponsored research, fiscal administration, and intellectual property management services for SUNY campuses, including University, pursuant to an agreement between Foundation and SUNY that became effective in 1977.

**NOW, THEREFORE** in consideration of the premises and the mutual covenants hereinafter contained, the Parties agree as follows:

### 1. Scope of Research

The Foundation agrees to conduct and carry out the Project described in the scope of work attached as Exhibit A. Sponsor and Foundation may at any time amend the Project. However, any amendment shall not be binding upon the Parties unless by mutual written agreement signed by authorized representatives of the Parties.

## **2. Key Personnel**

The Foundation Principal Investigator and Sponsor's Technical Contact, as identified in Exhibit C, agree to maintain close liaison with each other to ensure a timely, well-integrated project effort and to achieve the performance goals during the term of this Agreement. If for any reason the Foundation Principal Investigator is unable or unwilling to continue the Project and/or the responsibilities required to carry out the performance of their duties under this Agreement, the Parties shall negotiate the continuance of the Project and/or this Agreement in good faith. However, if another principal investigator cannot be agreed upon, either Party may terminate this Agreement in accordance with Article 4 by giving written notice to the other Party of such termination.

## **3. Reporting.**

- a) Written project reports shall be provided by Foundation to Sponsor in accordance with the reporting schedule set forth in Exhibit A, and a final report shall be submitted by Foundation to Sponsor within forty-five (45) days of the expiration of the Term or early termination of this Agreement.

## **4. Term**

This Agreement commences on the Effective Date and continues through \_\_\_\_\_ (the "Term"), unless terminated sooner or extended by mutual written agreement of the Parties hereto in accordance with provisions set forth elsewhere in this Agreement.

## **5. Termination**

- a) Either Sponsor or Foundation may terminate this Agreement at any time by giving thirty (30) days written notice of termination to the other Party. The thirty (30) day notice period will commence on the date of receipt of the written notice by the receiving Party.

b) In the event that either Party commits any breach or default in any terms or conditions of this Agreement, and also fails to cure such breach or default within thirty (30) days after receipt of written notice thereof, the non-breaching Party may, at its option and in addition to any other remedies which it may have in law or equity, terminate this Agreement by sending a notice of termination in writing to the other Party to such effect. Termination shall be effective as of the date of receipt of such notice by the receiving Party.

c) Foundation may, at its option, terminate this Agreement effective immediately upon notice to the other Party if: i) Sponsor has been declared insolvent, ceases or threatens to cease to carry on its business, or an administrator or receiver has been appointed over all or part of its assets; or ii) Sponsor fails to comply with any payment obligation provided in Article 6 of this Agreement.

d) Upon notification that this Agreement has been terminated as provided above, Foundation will immediately stop all work under this Agreement. Sponsor agrees to pay all costs and expenses for

non-cancellable commitments incurred by Foundation in performance of the Project prior to termination. Non-cancellable commitments will include but not be limited to salary, benefits, and tuition costs for graduate research assistants employed on the Project through the end of the University's semester during which notice of termination is received.

e) Any notice of termination shall be delivered to the non-terminating Party's administrative contact with a copy to the technical contact as identified in Exhibit C of this Agreement.

## **6. Compensation**

### **a) Research Compensation.**

- i. In consideration of Foundation's performance pursuant to this Agreement, Sponsor shall make fixed payments in the total amount of \_\_\_\_\_ US Dollars. Foundation shall use these funds in general accordance with the budget provided in Exhibit B (the "Budget"); however, deviations from specific budget line items are permitted, provided such deviations remain consistent with the overall aims of the research and do not result in an increase to the total funding obligation of the Sponsor. This amount shall be paid to Foundation within forty-five (45) days of submission of invoices according to the following schedule:

\_\_\_\_\_ - on execution of this Agreement

\_\_\_\_\_

- ii. Payment shall be made by check or wire as follows:

By check: The Research Foundation for The SUNY  
P.O. Box 9  
Albany, NY 12201-0009  
Attn: Cash Receipts Department

By wire: Key Bank of New York  
66 Pearl Street  
Albany, NY 12207-1501  
Routing No: ABA-0213-00077; Account No: 10970107

- iii. The Foundation shall retain title to all equipment, material, and supplies purchased and/or fabricated by it or the University with funds provided by Sponsor under this Agreement. Such title shall remain with the Foundation even if said equipment, material, and supplies are located in other than Foundation or University facilities.
- iv. An interest penalty of 1.5% per month will be added to the total invoice amount of payment if not received within forty-five (45) days of the invoice date.

### ***[Alternate language to be used as negotiation only- COST REIMBURSABLE]***

*a) In consideration of research services to be performed pursuant to this Agreement, Sponsor shall make payments to Foundation in an amount not to exceed \$ \_\_\_\_\_ US Dollars. Foundation shall spend these funds in general accordance*

*with the budget provided in Exhibit B, which is attached to and made an integral part of this Agreement. Foundation may deviate from the budget consistent with Project needs to complete the scope of work outlined in Exhibit A, provided that any budget deviations do not increase the total dollar amount to be paid by Sponsor.*

*b) Foundation will submit monthly to the Sponsor's financial contact listed in Exhibit C an invoice of costs incurred by the Foundation in the performance of this Agreement and claimed to constitute allowable costs. Within forty-five (45) days after receipt of each invoice, Sponsor shall make payment thereon.*

*c) An interest penalty of 1.5% per month will be added to the total invoice amount of payment if not received within forty-five (45) days of the invoice date.*

**b) License Fee.**

- i. In addition to the amounts due to Foundation per Exhibit B, Sponsor shall also pay to Foundation a fee in the amount of either twenty percent (20%) of the total Budget set forth in per Exhibit B, as amended during the Term, or fifteen thousand U.S. dollars (\$15,000), whichever is greater ("License Fee"). On or about the Effective Date, Foundation shall issue an invoice to Sponsor in the amount of the License Fee, and Sponsor shall deliver full payment of the License Fee to Foundation within forty-five (45) days of Sponsor's receipt of such invoice or on the date identified as the due date on the invoice, whichever is earlier.
- ii. If Sponsor does not pay the License Fee in accordance with this Section 6(b)(i), then Foundation will have the unilateral right to terminate Sponsor's commercial license as granted in section 8(b)(8) and Exhibit D of the Agreement, and this Agreement will be deemed to be amended to grant Sponsor an option to negotiate for an exclusive royalty-bearing commercial license to Foundation Project IP Rights ("Option"). The terms of the Option are set forth in paragraph 6 b)(iii).
- iii. Sponsor's Option to negotiate an exclusive commercial license to Foundation Project IP Rights shall expire six (6) months after disclosure of such Foundation Project IP Rights pursuant to section 8(c)(2) of this Agreement. All negotiations conducted by the parties under this paragraph b)(iii) shall be conducted in good faith using reasonable efforts to reach a mutually beneficial arrangement as soon as practical.
- iv. In the event the total dollar amount of the Budget set forth in Exhibit B increases by an amendment or modification to the Agreement after the Effective Date of the Agreement, Sponsor shall pay to Foundation within thirty (30) days after Agreement of each such amendment or modification to the Agreement the difference between the original License Fee paid by Sponsor under Section 6(b) and the greater of twenty percent (20%) of the total Budget set forth in Exhibit B, as amended, or fifteen thousand U.S. dollars (\$15,000).
- v. An interest penalty of 1.5% per month will be added to the total invoice amount of payment if not received within forty-five (45) days of the invoice date.

**7. Proprietary Information**

a) Unless otherwise agreed in a Non-Disclosure Agreement between the Parties attached hereto as Exhibit D, the following terms will apply to Proprietary Information.

b) The Parties acknowledge that they may possess certain proprietary or confidential information which may be utilized in performance of the Project. "Proprietary Information" means all proprietary or confidential information provided by the disclosing Party in writing and clearly marked "confidential" or bearing equivalent legend, or disclosed orally and summarized in writing and marked "confidential" or equivalent and transmitted to the receiving Party within 30 days of oral disclosure. Proprietary Information will only be disclosed to the employees, agents, consultants and students (if applicable) of the receiving Party who require the same to fulfill the purposes of the Project. The receiving Party will protect the disclosing Party's Proprietary Information with the same standard of care with which the receiving Party treats its own Proprietary Information of a similar nature. Proprietary Information will be used by the receiving Party only for the purposes permitted under this Agreement. The receiving Party receives no commercial grant of rights to the Proprietary Information of the disclosing Party. Each Party will, for a period of three (3) years after the termination of this Agreement, maintain the same level of care to prevent the disclosure of a Party's Proprietary Information, unless otherwise required by law. The Parties will give each other reasonable advance notice if compelled to make available Proprietary Information by operation of law or pursuant to a valid governmental or judicial order. The extent of disclosure will be determined by the legal counsel of the Party so compelled.

c) Neither Party will be liable for disclosure or use of the information of the other Party if said information was: 1) already in the possession of a Party at the time it was acquired from the disclosing Party; 2) generally available to the public, or subsequently becomes so available through no fault of the receiving Party; 3) received by a Party to this Agreement from a third party who did not acquire it directly or independently from a Party to this Agreement in confidence, or; 4) independently developed by the receiving Party without the use or reliance on Proprietary Information.

## **8. Intellectual Property**

### **a) Definitions.**

As used in this Agreement, the following terms will have the meanings set forth below.

1. Incidental Use of SUNY Resources. "Incidental Use of SUNY Resources" means the use of SUNY or Foundation resources and facilities such as meeting rooms, office space, office supplies, photocopiers, telephones, fax machines, and other standard office equipment, personal-type computers, commercially-available software installed on such computers, and computer and communications networks, including internet access and data storage, that is occasional and/or non-essential to the creation of Intellectual Property.
2. Invention(s). "Invention(s)" means any invention or discovery that is potentially patentable, and conceived and reduced to practice under this Agreement. "Sponsor Invention" means an Invention that is invented solely by Sponsor personnel with no more than Incidental Use of SUNY Resources. "Foundation Invention" means an Invention that is invented solely by Foundation or University personnel; "Joint Invention" means an Invention that is (i) invented jointly by Sponsor and Foundation personnel, or (ii) invented by Sponsor personnel with more than Incidental Use of SUNY Resources.

3. Intellectual Property. "Intellectual Property" or "IP" means all proprietary rights in Inventions, patent applications, patents, copyrightable works, mask works, trademarks, trade secrets, and any information embodying proprietary data, such as technical data and computer software.
4. Background Intellectual Property. "Background Intellectual Property" or "BIP" means the Intellectual Property of a party that was created prior to the Effective Date of this Agreement, is related to the Field, and is used in the Project. "Sponsor BIP" means the Background Intellectual Property of Sponsor, if any, as identified in Exhibit A hereto. "Foundation BIP" means the Background Intellectual Property of Foundation known to the Principal Investigator and listed in Exhibit A.
5. Other Intellectual Property. "Other Intellectual Property" means any IP created or owned by either party that is neither Background IP nor an Invention.
6. Project Reports. "Project Reports" means the written reports prepared by Foundation and delivered to Sponsor during the Project, as set forth in Exhibit A.
7. Research Results. "Research Results" means all data, findings, know-how, methods, techniques, intangible results, tangible materials, software, prototypes, and work product that result from the performance of the Project, as set forth in Exhibit A. For purposes of clarity, Research Results does not include Project Reports.

b) IP Rights and Obligations of Sponsor.

1. Ownership of IP. Sponsor will own all Sponsor BIP, Sponsor Inventions, Sponsor's Other Intellectual Property, and copyright in the Project Reports. Sponsor will jointly own, together with Foundation, all Joint Inventions.
2. Invention Disclosures. Sponsor will notify Foundation in writing within thirty (30) days of receipt of an Invention disclosure covering a Sponsor Invention or Joint Invention. All Invention disclosures exchanged under this Agreement will be kept confidential by the parties.
3. Sponsor Inventions. Sponsor will control and bear the expense of the preparation, filing, prosecution, and maintenance of all United States and foreign patent applications claiming Sponsor Inventions.
4. Joint Inventions. Sponsor will control and bear the expense of the preparation, filing, prosecution, and maintenance of all United States and foreign patent applications claiming Joint Inventions, with Foundation's cooperation and assistance. Notwithstanding the foregoing, for any Joint Invention, if Sponsor does not wish to file a patent application, continue prosecution of a pending patent application, or maintain a patent through its full term, Sponsor will notify Foundation in writing no less than ninety (90) days in advance of the relevant patent deadline and Foundation shall have the option, but not the obligation, to take over control of the prosecution and maintenance of the patent or application, and Sponsor will assign the entirety of its right in the patent or application to Foundation.
5. Trade Secrets. Sponsor will not disclose any Sponsor trade secret(s) except on a limited, need to know basis as strictly necessary for Foundation's performance of Project(s) under this Agreement. Prior to disclosing any trade secret(s), Sponsor and Foundation will mutually agree on a set of procedures to govern such disclosure and protect the trade secret(s). Such procedures must be documented in writing as an addendum to this Agreement signed by the Authorized Official for each Party.

6. Third Party Rights. Sponsor will disclose to Foundation any third party rights, known to Sponsor's official signing this Agreement, including federal, private or individual claims that impact the ownership of IP arising from or used as background for performance of the Project under this Agreement.
7. Research Licenses. Sponsor grants to Foundation a non-exclusive, non-commercial research license: i) to use Sponsor BIP and Sponsor Invention(s) in the performance of the Project, and ii) to use the Project Reports. Sponsor grants no other license under this Agreement. Sponsor is granted by Foundation a non-exclusive, non-commercial research license to use Foundation BIP, Foundation Invention(s), and the Research Results in the performance of the Project.
8. Exclusive Commercial License. Foundation shall draft, and the Parties shall execute, one or more exclusive licenses to Foundation's rights in Foundation Inventions, Foundation's rights in Joint Inventions and the Research Results ("Foundation Project IP Rights") under materially the same terms contained in the template license agreement attached at Exhibit D (each, a "License Agreement"). After the Parties have executed a License Agreement to specific Foundation Project IP Rights, then that License Agreement shall control with respect to the Foundation Project IP Rights identified therein. Unless and until both Parties have executed a License Agreement to specific Foundation Project IP Rights, the following provisions at this Section 8(b)8.1-8.4 shall control with respect to such Foundation Project IP Rights.

8.1. Lead in Prosecution and Maintenance. Sponsor shall be responsible for the preparation, filing, prosecution, and maintenance of the Foundation Project IP Rights, as Sponsor may elect, including for example patent protection, copyright protection, trademark protection, as well as any the payment of any costs associated therewith. Sponsor shall provide Foundation with copies of all filings, official actions, and pertinent correspondence pertaining to such activities so as to give Foundation a reasonable opportunity to advise and comment on such activities. Sponsor shall reasonably consider Foundation's advice/comments on such prosecution, filings and maintenance of the Foundation Project IP Rights.

- i) If Sponsor does not wish to file, prosecute or maintain a patent application/patent or intellectual property protection, Sponsor will notify Foundation in writing 10 (ten) business days prior to the deadline and Foundation shall have the option, but not the obligation, to take over control of such patent or application, and Sponsor will assign the entirety of its right in the patent or application to Foundation, if any.

8.2. U.S. Government Rights. In the event that a Party is required to grant, and/or has granted, to the U.S. Government any rights in and to Foundation Project IP Rights, then the Parties agree that their rights to such Foundation Project IP Rights are subject to those rights of the U.S. Government and the provisions of 37 CFR 401, *et seq.*

8.3. No Implied Licenses or Background IP Rights. No rights or obligations other than those expressly recited herein are granted or may be implied by this Agreement. Nothing herein constitutes a license or other transfer of rights in or to any Intellectual Property that is not explicitly included within the Foundation Project IP Rights.

8.4. Retained Rights. Foundation reserves the right to: (1) use the Foundation Project IP Rights for research and educational purposes, (2) to grant licenses to Foundation Project

IP Rights to other educational and non-profit institutions to do the same, and (3) to publish the Foundation Project IP Rights in accordance with Section 24 of this Agreement.

c) IP Rights and Obligations of Foundation.

1. Ownership of IP. Foundation will own all Foundation BIP, Foundation Inventions, Foundation's Other Intellectual Property, and the Research Results. Foundation will jointly own, together with Sponsor, all Joint Inventions.
2. Invention Disclosures. Foundation will notify Sponsor in writing within thirty (30) days of receipt by its technology transfer or equivalent office of an Invention disclosure covering a Foundation Invention or Joint Invention. All Invention disclosures exchanged under this Agreement will be kept confidential by the Parties.
3. Foundation Inventions. Sponsor will control and bear the expense of the preparation, filing, prosecution, and maintenance of all United States and foreign patent applications claiming Foundation Inventions pursuant to the terms set forth in Section 8(b)8.
4. Joint Inventions. Foundation will cooperate with and assist Sponsor in the prosecution and maintenance of patent applications and patents claiming Joint Inventions, as set forth in section 8(b)(4).
5. Third Party Rights. Foundation will disclose to Sponsor any third party rights, known to Foundation's official signing this Agreement, including federal, private, or individual claims that impact the ownership of IP arising from or used as background for performance of the Project under this Agreement.
6. Research Licenses. Foundation is granted by Sponsor, and grants to Sponsor, the non-commercial research licenses as set forth in section 8(b)(7).
7. Exclusive Commercial License. Foundation grants to Sponsor the right to an exclusive commercial license as set forth in section 8(b)(8). Sponsor and Foundation will work cooperatively to execute the exclusive commercial license as set forth in Exhibit D.
8. No other licenses. Except as expressly set forth herein, Foundation grants no other licenses under this Agreement.

9. Warranties

**FOUNDATION MAKES NO WARRANTIES, EXPRESSED OR IMPLIED, AS TO ANY MATTER WHATSOEVER, INCLUDING WITHOUT LIMITATION THE CONDITION OR PERFORMANCE OF THE RESEARCH, RESEARCH RESULTS, DELIVERABLES, WORK PRODUCT, OR ANY INVENTIONS, INTELLECTUAL PROPERTY, PRODUCTS OR SERVICES, WHETHER TANGIBLE OR INTANGIBLE, CONCEIVED, DISCOVERED, REDUCED TO PRACTICE, OR DEVELOPED UNDER THIS RESEARCH AGREEMENT, OR THE OWNERSHIP, MERCHANTABILITY, FITNESS FOR ANY PARTICULAR PURPOSE, OR NON-INFRINGEMENT OF THE RESEARCH, RESEARCH RESULTS, DELIVERABLES, WORK PRODUCT, INVENTIONS, INTELLECTUAL PROPERTY, PRODUCT OR SERVICE. FOUNDATION WILL NOT BE LIABLE FOR ANY DIRECT, INDIRECT, CONSEQUENTIAL, SPECIAL OR OTHER DAMAGES SUFFERED BY THE SPONSOR OR ANY OTHER PARTIES RESULTING FROM THE USE OR MISUSE OF THE RESEARCH, RESEARCH RESULTS, DELIVERABLES, WORK PRODUCT, INVENTIONS, INTELLECTUAL PROPERTY, OR ANY PRODUCT OR SERVICE DERIVED THEREFROM.**

10. Export Controls



This Agreement is subject to all applicable government export and import laws and regulations. The Parties agree to comply and reasonably assist the other Party, upon request by that Party, in complying with all applicable government export and import laws and regulations. The Parties acknowledge that they may not directly or indirectly export, re-export, distribute or transfer any information of any value to any nation, individual, or entity that is prohibited or restricted by the International Traffic in Arms Regulation (ITAR), the Export Administration Regulations (EAR), the Office of Foreign Assets Controls (OFAC), the United States Department of State's State Sponsors of Terrorism, or by any other United States government agency without first obtaining the appropriate license.

Sponsor confirms that any information it discloses does not contain export controlled technology or technical data identified on any US export control list, including but not limited to the Commerce Control List (CCL) at 15 CFR 774 and the US Munitions List (USML) at 22 CFR 121. In the event Sponsor intends to provide Foundation Principal Investigator with export controlled information, Sponsor will inform Foundation's Export Control representative, as identified in Exhibit C, in writing thirty (30) days prior to the release of export controlled technology or technical data. Sponsor agrees not to provide any export controlled information to Foundation's Principal Investigator, or others at Foundation without the written agreement of Foundation's Export Control representative identified in Exhibit C.

#### **11. Indemnification**

Sponsor will indemnify, defend and hold harmless Foundation, its officers, agents, students and employees (the "Indemnified Parties") against any liability, damage, loss, or expense (including reasonable attorneys' fees and expenses of litigation) incurred by or imposed upon the Indemnified Parties or any one of them in connection with any third party claims, suits, actions, demands, or judgments arising out of (i) use or misuse of the Research Results, Project Reports, technology or Intellectual Property provided to Sponsor in connection with this Agreement, included under Section 8 herein, or (ii) arising out of any other activities to be carried out by or on behalf of Sponsor pursuant to this Agreement, except to the extent that the actions or claims are based upon the Foundation's gross negligence or willful misconduct.

#### **12. Insurance**

Foundation will, at its own expense, maintain insurance of the types and in the amounts specified below.

- a) Workers' Compensation (including occupational disease) and Employer's Liability: Statutory New York State Limits. Employers' Liability minimum limit of \$1,000,000;
- b) Disability Benefit Insurance as mandated by State law;
- c) Commercial General Liability: Bodily injury, Personal Injury, and Property Damage with minimum limit of \$2,000,000 per occurrence and \$5,000,000 aggregate. Limit may be provided through a combination of primary and umbrella/excess liability policies;
- d) Auto Liability (if applicable): \$2,000,000 combined single limit Bodily Injury/Property Damage per each accident (including owned, hired, leased and non-owned autos);

This insurance will be written by a company licensed to do business in New York State with a minimum A.M. best rating of A-IX. Sponsor waives all rights of subrogation to the extent damages are covered by the above described policies.

### **13. Dispute Resolution**

Sponsor and Foundation will attempt to resolve any dispute as follows:

- a) In good faith by direct, confidential and informal negotiations.
- b) If the Parties are unable to resolve the dispute informally, they may consent to mediation upon mutual agreement.
- c) Notwithstanding the above, either Party may pursue litigation in any court of competent jurisdiction in the State of New York.

### **14. Assignment**

Neither Party may assign or otherwise transfer this Agreement and the rights acquired hereunder without the prior written consent of the other Party; this consent will not be unreasonably withheld. Any assignment or transfer will be void unless the assignee agrees in writing to be bound by the terms and conditions of this Agreement.

### **15. Notices**

All notices, demands, and other communications hereunder, with the exception of technical information, will be sent by: i) U.S. First Class Mail, return receipt requested, ii) registered or certified mail, return receipt requested, or iii) by overnight or international delivery via the U.S. Postal Service or a commercial carrier with delivery tracking. Said notices will be delivered to the appropriate financial, administrative and/or technical party as identified in Exhibit C, unless notice of change of name or address is provided in writing.

Any notices, demands, and other communications delivered personally will be deemed to have been received at the time of its confirmed delivery. Any notices demands, and other communications mailed will be deemed to have been received on the date set forth in the delivery notice or return receipt. At the time of mailing the official notice, the sending Party will provide a courtesy copy of the notice to the receiving Party by email.

### **16. Status of Parties**

The relationship of the Parties will be that of principal and independent contractor and not of an employer-employee relationship.

This Agreement will not be construed to contain any authority, either express or implied, enabling Foundation to incur any expense or perform any act on behalf of Sponsor without express written consent.

### **17. Binding Effect**

This Agreement will be binding upon and inure to the benefit of the Parties hereto and their respective successors or assigns.

**18. Governing Law**

This Agreement will be construed, governed, interpreted and applied in accordance with the laws of the State of New York, without regard to conflict of law provisions, and will be deemed to have been executed in the state of New York. Any litigation will be brought to an appropriate court within the State of New York.

**19. Modifications**

This Agreement may not be changed, amended, modified or extended unless in writing and duly signed by the Parties hereto.

**20. Severability**

In the event any provisions of this Agreement are determined to be invalid or unenforceable under any controlling body of law, such invalidity or unenforceability will not affect the validity or enforceability of the remaining provisions hereof.

**21. No Waiver**

No waiver by either Party hereto of any breach or default of any of the covenants or agreements herein set forth will be deemed a waiver as to any subsequent or similar breach or default.

**22. Headings**

The headings of the articles and sections are inserted for convenience of reference only and are not intended to influence the interpretation of this Agreement.

**23. Use of Name**

The Parties agree not to use the name and any trademarks, logos or symbols of the other Party in any advertising, sales promotion, or other publicity matter without the prior written approval of the other Party. However, this provision is not intended to restrict either Party from disclosing the existence and nature of this Agreement, or from including its existence in the routine reporting of the Party's activities.

**24. Publications**

The Foundation shall have the right to publish or otherwise disclose information gained in the course of the Project conducted under this Agreement. Foundation shall provide Sponsor with a copy of any proposed manuscript or oral presentation for review and comment at least sixty (60) days prior to planned submission for publication. Sponsor shall notify Foundation within thirty (30) days of receipt of such material whether they contain Sponsor's Proprietary Information as described in Section 6. If Foundation does not receive a written response from Sponsor within thirty (30) days from date Foundation sent proposed manuscript or oral presentation, Foundation may proceed with publication and/or release of information as proposed. Sponsor may require an additional thirty

(30) day delay in publication in order to coordinate the filing of any invention disclosures with Foundation. In no event shall this delay exceed a total of sixty (60) days without mutual written agreement by both Parties. Subject to its obligation not to disclose Sponsor's Proprietary Information, Foundation shall have the final authority to determine the scope and content of any publications.

**25. Compliance**

The Parties agree that in completing their obligations under this Agreement they will comply with all applicable laws and regulations.

**26. Survival**

In the event of termination of this Agreement for any reason, the following sections will survive termination: 6, 7, 8, 9, 10, 11, 12, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27 and 29. Section 7 shall survive according to the terms set in Section 7b.

**27. Entire Agreement**

This Agreement represents the entire agreement and understanding of the Parties hereto. No prior writings, conversations, or representations of any nature will be deemed to vary the provisions of this Agreement.

**28. Counterparts and Electronic Signatures**

This Agreement may be executed in two or more counterparts, each of which will be deemed an original, but all of which together will constitute one and the same instrument. The counterparts of this Agreement may be executed and delivered by facsimile, email, or other electronic transmission by any of the Parties to any other Party and the receiving Party may rely on the receipt of such document so executed and delivered by facsimile, email, or other electronic means as if the original had been received, and the parties may execute the Agreement using electronic or digital signatures.

**29. Order of Precedence**

In the event of any inconsistency between clauses 1-29 of this Agreement, and the attached exhibits, the inconsistency should be resolved by giving precedence to clauses 1-29.

**IN WITNESS WHEREOF**, the Parties hereto have executed this Agreement as of the Effective Date set forth above.

**THE RESEARCH FOUNDATION FOR  
THE STATE UNIVERSITY OF NEW YORK**

**SPONSOR**

By: \_\_\_\_\_

By: \_\_\_\_\_

Name: \_\_\_\_\_

Name: \_\_\_\_\_

Title: \_\_\_\_\_

Date: \_\_\_\_\_

Title: \_\_\_\_\_

Date: \_\_\_\_\_

## Exhibit A – SCOPE OF WORK

1. Statement of Project Objectives:
2. Project Start Date:
3. Project Completion Date:
4. Location where the work will be performed:
5. Scope of Research to be Conducted by SBU PI:
6. Sponsor Background Intellectual Property (if known):
7. SBU Background Intellectual Property (if any):
8. Milestones and Schedule:

Milestone	Due Date

9. Project Reports and Deliverables.

The following written project reports and/or deliverables will be submitted to Sponsor during the Project:

**Disclaimer: This Scope of Work is a research project. The performance objectives provided above are merely targets and not a promise to provide deliverables that can perform at the specifications provided above.**

## Exhibit B - BUDGET

1. The Budget for the Project will be as set forth below:


### Exhibit C – PROJECT CONTACTS

FOUNDATION	SPONSOR
<b><i>Administrative Contact</i></b> Name: Address: W5510 Melville Library, Stony Brook, NY 11794-3362  Telephone: Fax: 631-632-6963 Email: osp_contracts@stonybrook.edu	<b><i>Administrative Contact</i></b> Name: Address:  Telephone: Fax: Email:
<b><i>Principal Investigator</i></b> Name: Address:  Telephone: Fax: Email:	<b><i>Technical Contact</i></b> Name: Address:  Telephone: Fax: Email:
<b><i>Financial Contact</i></b> Name: Address:  Telephone: Fax: Email:	<b><i>Financial Contact</i></b> Name: Address:  Telephone: Fax: Email:
<b><i>Authorized Official</i></b> Name: Address: W5510 Melville Library, Stony Brook, NY 11794-3362  Telephone: Fax: 631-632-6963 Email:	<b><i>Authorized Official</i></b> Name: Address:  Telephone: Fax: Email:
<b><i>Export Control</i></b> Name: Susan Gasparo Address: W5530 Melville Library, Stony Brook, NY 11794  Telephone: 631-632-1954 Fax:	



Email: <a href="mailto:susan.gasparo@stonybrook.edu">susan.gasparo@stonybrook.edu</a>	
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## Exhibit D- Exclusive License Agreement Template

This agreement (hereinafter, "Agreement") is made and is effective as of the date last signed (hereinafter, "Effective Date") by and between The Research Foundation for The State University of New York, a nonprofit, educational corporation existing under the laws of the State of New York with an office located at Intellectual Property Partners, N5002 Frank Melville Jr. Memorial Library, Stony Brook, New York 11794-3369, for and on behalf of the State University of New York at Stony Brook, (hereinafter, "Foundation"), and Licensee, a <<State>> <<corporation/limited liability company>>, having a primary address at <<Licensee Address>> (hereinafter, "Licensee").

### RECITALS

WHEREAS, Foundation owns certain intellectual property rights created in the performance of a certain Research Agreement by and between the parties dated [Effective Date of Research Agreement] (the "Research Agreement"); and

WHEREAS, pursuant to the terms of the Research Agreement the Foundation desires to license the Foundation Project IP Rights, as defined in the Research Agreement, to Licensee for commercial use and for the benefit of the public; and

WHEREAS, Licensee desires to obtain rights to such intellectual property rights, as provided herein, for development and commercialization purposes.

NOW, THEREFORE, subject to the term and conditions contained herein, and in consideration of the premises and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:

### 1. DEFINITIONS

All capitalized terms used in this Agreement will have the meanings stated below or defined elsewhere in the Agreement.

- 1.1. "Affiliate"** means any corporation or other business entity, listed in Appendix A, that controls, is controlled by, or is under common control with Licensee. A corporation or other entity will be regarded as in control of another corporation or entity if it owns or directly or indirectly controls at least fifty percent (50%) of the outstanding shares or other voting rights of the other corporation or entity having the right to elect directors or such lesser percentage that is the maximum permitted to be owned by a foreign entity in those jurisdictions where majority ownership by foreign entities is prohibited, or (i) in the absence of the ownership of at least fifty percent (50%) of the outstanding shares or other voting rights of a corporation, or (ii) in the case of a non-corporate business entity, if it possesses, directly or indirectly, the power to

direct or cause the direction of the management and policies of the corporation or non-corporate business entity, as applicable, whether through the ownership or control of voting securities, by contract or otherwise.

- 1.2. **“Cover” or “Covered By”** means (i) infringes a Valid Claim, or (ii) would infringe Valid Claim if it existed in an issued patent.
- 1.3. **“Field”** means all field(s) of use
- 1.4. **“Independent Auditor”** means individuals and/or auditors, selected by the Foundation in its sole discretion, who are not full-time employees of the Foundation or The State University of New York, at Stony Brook University
- 1.5. **“Indemnified Parties”** has the meaning assigned and ascribed in Section 9.1(a).
- 1.6. **“Licensed Patents”** means the patents and patent applications listed in Appendix B including (i) all divisionals, continuations, continuations in part (but only the claims that claim priority to the patent and/or patent applications listed in Appendix B), (ii) any valid domestic and foreign patents which may issue from such patent applications and any reissues, renewals, substitutions, or extensions of or to any such patents or patent applications; and (iii) any corresponding foreign patents and foreign patent applications that claim priority to the patent and/or patent applications listed in Appendix B.
- 1.7. **“Licensed Subject Matter”** means the Licensed Patents and Technical Information.
- 1.8. **“Material Obligations”** has the meaning assigned and ascribed in Section 10.1(a).
- 1.9. **“Net Sales”** means (i) the total of the gross amounts invoiced, from the manufacture, use, sale, lease, or other transfer of any Product by Licensee, Affiliates and Sublicensees less the following deductions where applicable and separately listed: sales and/or use taxes, import and/or export duties imposed on certain products, transportation charges; or credits because of rejections or returns (as reflected on the invoice, and not to exceed the original billing amount); and (ii) the Fair Market Value of any non-cash consideration received by Licensee, Affiliates and Sublicensees for the manufacture, use, sale, lease, or other transfer of a Product. For purposes of this Section, the Fair Market Value shall be an amount equal to the customary amount invoiced as if the Product were sold to a third party in similar quantities in an equivalent country, assuming an arm’s length transaction made in the ordinary course of business.
- 1.10. **“IP Costs”** means all costs incident to preparing, filing, prosecuting, and maintaining the Licensed Patents in the United States and elected foreign countries, and any and all costs incurred in filing continuations, divisional applications, or related applications thereon and any re-examinations, reissue, or similar post-grant

proceedings thereof (e.g., Inter Partes review, oppositions). IP Costs also include the cost of preparing, filing, prosecuting, maintaining and defending intellectual property protection for the Licensed Subject Matter (e.g., copyright, trademark)

- 1.11. **“Patent Product(s)”** means all products that (i) if developed, made, manufactured, used, offered for sale, sold, imported, exported, leased or otherwise transferred within the Territory, but for the license granted herein, would infringe the Licensed Patents, (ii) are made by using a Patent Service, or (iii) when used, practice a Patent Service. As used within this Agreement, the term “Patent Product(s)” includes “Patent Service(s)”.
- 1.12. **“Patent Service(s)”** means any method, process, procedure or service that, but for the license granted herein, would infringe the Licensed Patents.
- 1.13. **“Other Product”** means all products that are developed, made, manufactured, use, used, discovered, offered for sale, sold, imported, exported, leased and/or otherwise transferred with the use of the Technical Information in whole or in part. As used within this Agreement, the term “Other Product(s)” includes “Other Service(s)”.
- 1.14. **“Other Service”** means any method, process, procedure or service that incorporates or uses Technical Information, or any part thereof.
- 1.15. **“Payments Due”** means, individually or collectively, any Royalties, late payment fees, or other amounts due to Foundation under this Agreement.
- 1.16. **“Product”** or **“Products”** shall include Patent Products and Other Products.
- 1.17. **“Reporting Period”** means a calendar quarter.
- 1.18. **“Royalty”** and **“Royalties”** shall mean a non-refundable, non-creditable running royalty of one percent (1%) of the Net Sales of Products during the Term and in the Field and Territory.
- 1.19. **“Sublicense Agreement”** or **“Sublicense”** means the agreement under which Licensee grants to an authorized Sublicensee any or all of the rights granted to Licensee under this Agreement or an option to any or all of the rights granted to Licensee under this Agreement.
- 1.20. **“Sublicensee”** means any non-Affiliate third party to whom Licensee grants a Sublicense of any or all of the rights granted to Licensee under this Agreement.
- 1.21. **“Technical Information”** shall mean any know-how and technical information, reports, research results, software or disclosures concerning research or inventions provided or disclosed to Licensee under the Research Agreement.
- 1.22. **“Term”** means the period of time beginning on the Effective Date and, unless terminated pursuant to Article 10 or amended pursuant to Section 18.2, ending on

the later of: (i) the expiration date of the last to expire Licensed Patent; or (ii) twenty (20) years from the date of the first sale of a Product.

**1.23. “Territory”** means worldwide.

**1.24. “Third Party”** means shall any entity or person other than Licensee, Foundation, Sublicensees, or Affiliates.

**1.25. “Valid Claim”** means any unexpired claim in an issued unexpired patent, or any claim of a pending patent application or supplementary protection certificate within the Licensed Patents that has not been revoked, abandoned, disclaimed or withdrawn, or held unenforceable, unpatentable, or invalid by a court of competent jurisdiction in a final judgment that has not been appealed within the time allowed by law or from which there is no further appeal.

## **2. GRANT OF RIGHTS AND RETAINED RIGHTS**

**2.1. Exclusive License.** Subject to the terms of this Agreement, including without limitation Section 2.2 and Section 4.4, Foundation grants to Licensee and it’s Affiliates a revocable, in accordance with the termination provisions set forth in this Agreement, exclusive license under the Licensed Subject Matter to develop, make, manufacture, have made, use, sell, have sold, import, export, lease, otherwise transfer, and/or offer for sale Product(s) in the Territory and in the Field during the Term, including the right of Licensee and it’s Affiliates to sublicense as set forth in Section 5. All foregoing grants are subject to the overriding obligations to the U.S. Government set forth in 35 U.S.C. §§ 200-212 and any future amendments thereto, and applicable governmental implementing regulations, including but not limited to those described in Section 13 herein.

**2.2. Retained Rights.** Foundation reserves all rights not specifically granted in Section 2.1. Accordingly, except as expressly provided under this Section 2, no right or license is granted (expressly or by implication or estoppel) by Foundation to Licensee or its Affiliates under any tangible or intellectual property, materials, patent, patent application, trademark, copyright, trade secret, know-how technical information, data or other proprietary right. In addition, Foundation reserves the right for itself, Stony Brook University and its inventors and developers to:

Use the Licensed Subject Matter for academic, educational, and research purposes, including, without limitation, sponsored research and collaborations;

Publish or otherwise disseminate any information about the Licensed Subject Matter, at any time; and

Allow, at Foundation's sole discretion, other educational and nonprofit institutions to use the Licensed Subject Matter for internal academic, educational, and research purposes only.

- 2.3. Delivery of Technical Information.** The Parties hereby acknowledge that Foundation provided the Technical Information subject to the Research Agreement. For avoidance of doubt, Foundation provides Technical Information as-is and Foundation shall not be required to (i) provide maintenance, service, or updates or (iii) assist in the understanding or use of Technical Information.

### **3. CONSIDERATION AND PAYMENT TERMS**

The parties hereto understand that the fees and royalties payable by Licensee to Foundation under this Agreement are partial consideration for the license granted under this Agreement. Licensee shall pay Foundation:

- 3.1. Licensee Fee.** Foundation hereby acknowledges payment by Licensee of an upfront, nonrefundable, payment of \_\_\_\_\_ U.S. Dollars (US\$\_\_\_\_\_) pursuant to the terms and conditions of the Research Agreement. The Parties hereby acknowledge that such payment was paid on XX,YY, 202X, by Licensee to Foundation, and is fully creditable against the Licensee Fee set forth in this Section 3.1. As such, no additional license fee is due upon execution under this Section 3.1.
- 3.2. Importance of Technical Information.** Licensee has requested, and Foundation has agreed, to grant certain rights to Technical Information. Licensee requires these rights in order to develop and commercialize the intellectual property licensed hereunder. Because of the importance of Technical Information, Licensee has agreed to pay certain royalties to Foundation Products, as specified below, even if it is not Covered By Licensed Patents, in order to obtain rights to Technical Information. Licensee has agreed to these payments because of the commercial value of Technical Information, separate and distinct from the commercial value of the Licensed Patents that Licensee acknowledges will provide a commercial advantage. Licensee acknowledges that it would not have entered into this Agreement without receiving the rights to the Technical Information. Licensee further acknowledges that licenses to Technical Information, and each patent and application within the definition of Licensed Patents were separately available to license, and that for convenience and because of the preference of Licensee, the parties executed this combined license to the Licensed Patents and 3.3 Technical Information.
- 3.3. Royalties on Net Sales.**
- a) Beginning in the Reporting Period that the cumulative gross amounts invoiced from the manufacture, use, sale, lease, or other transfer of any Product by

Licensee, Affiliates and Sublicensees of all Products reach twenty million U.S. dollars (\$20,000,000.00), Licensee shall pay to Foundation a running Royalty as defined in Section 1.18.

- b) In the event that one or more licenses of a Third Party's patent(s) are required to exploit Licensee's rights under this license agreement, starting on the effective date of such Third Party license agreement, Licensee may deduct 25% of any royalties payable to a Third Party from the Royalties otherwise due to Foundation with respect to such Product in such country. In no event shall the deduction exceed 50% of the Royalties payable to the Foundation for any Product as set forth in this Agreement.

**3.4. Payment Terms and Supporting Documentation.** All dollar amounts for Payments Due referenced herein will refer to U.S. Dollars. Payments with designated payment dates are due and payable on or before those dates. Royalties will be due and payable within thirty (30) days after the end of each Reporting Period for the Net Sales received during such Reporting Period. Each payment of Royalties shall be accompanied by documentation supporting the calculation of such Royalties (from Net Sales). An officer of Licensee will sign and certify each report required by this Section 3.4, and all such reports will be prepared in accordance with Generally Accepted Accounting Principles. When Product(s) are sold for currencies other than U.S. Dollars, Royalties will first be determined in such foreign currency and then converted into equivalent U.S. Dollars per the exchange rate quoted in the Wall Street Journal on the last business day of the applicable Reporting Period as such foreign currency per U.S. Dollar. For the avoidance of doubt, Licensee is solely responsible for bank transfer charges, including but not limited to, wire transfer fees.

**3.5. Payment Address.** All payments for Payments Due will be made payable to "The Research Foundation for The State University of New York" and will be sent to the following address with a copy to [IPP\\_Receivable@connect.stonybrook.edu](mailto:IPP_Receivable@connect.stonybrook.edu):

The Research Foundation for The State University of New York  
Attention: Cash Management  
P.O. Box 9  
Albany, NY 12201-0009  
United States

**For Wire Transfers:**

**Bank:** Key Bank of New York  
66 South Pearl Street  
Albany, NY 12207

**Account Number:** 10970107

**Routing Number:** ABA 0213-00077

**Swift Code:** KEYBUS33

**Please include the following notation on all payments:** “Intellectual Property Partners”.

- 3.6. Late Payment.** In the event that any Payments Due are not timely received by Foundation when due, Licensee will pay to Foundation, in addition to such Payments Due, interest on such Payments Due computed using the lesser rate of: (i) twelve percent (12%) per annum; or (ii) the maximum rate allowable under the applicable law. Interest will be calculated from the date payment was due until payment is actually received by Foundation, inclusive.
- 3.7. Foreign Charges.** Royalties due for sales that occur in any country may not be reduced by any deduction of withholding, value-added taxes, fees, or other charges imposed by the government of such country, except as permitted in the definition of Net Sales.
- 3.8. Licensee Responsibility for Affiliates and Sublicensees.** Licensee shall be responsible for obtaining the full compliance of its Affiliate(s) and Sublicensee(s) with the terms and conditions of the License and any Sublicense(s). For the purposes of payments, Licensee shall be fully and solely responsible for any Payments Due to Foundation, pursuant to the terms of this Agreement, from Sublicensee(s) and/or Affiliate(s) as a result of rights granted to Licensee in this Agreement.

#### **4. DUE DILIGENCE AND COMMERCIALIZATION ACTIVITIES**

Licensee shall use, and shall cause its Sublicensee(s) and Affiliates to use commercially reasonable efforts to bring Products to market, and to create, supply, and service throughout the Territory as large a market for Products as is reasonably possible. In no instance shall Licensee's, Affiliate's and/or Sublicensee's commercially reasonable efforts be less than efforts customary in Licensee's industry. Licensee acknowledges and agrees that a fundamental purpose of this Agreement is to achieve development and commercialization of the Licensed Subject Matter and Products, and the terms in this Section 4 constitute material terms of this Agreement. If Licensee fails to perform any of its obligations specified in this Section 4, then Foundation will have the unilateral right and option to: (i) terminate this Agreement; or (ii) modify the terms of the Agreement from an exclusive license to a non-exclusive license. This right to modify the terms, if exercised by Foundation, supersedes the rights granted in Section 2.1 of this Agreement.



## **5. SUBLICENSING**

- 5.1.** The license granted by this Agreement includes the right of Licensee and Affiliates to grant Sublicenses. With respect to Sublicenses granted pursuant to this Agreement, Licensee will:
- a) at least thirty (30) days prior to the execution of the Sublicense, provide Foundation with a draft copy of the Sublicense and any related documentation to seek Foundation's written consent, which shall not be unreasonably withheld, that the Sublicense includes all of the rights of, and obligations due to, Foundation under this Agreement;
  - b) promptly provide Foundation with a copy of each executed Sublicense; and
  - c) make all Payments Due and deliver all reports due to Foundation whether owed by Licensee, Affiliates, or Sublicensees, and use commercially reasonable efforts to collect all Payments Due, directly or indirectly, to Foundation from Sublicensees.
- 5.2.** Upon termination of this Agreement for any reason, Foundation, in its sole discretion, will determine whether Licensee will cancel or assign to Foundation any and all Sublicenses. Licensee will include a provision in each Sublicense which allows Foundation to assume the Sublicense if: (i) this Agreement is terminated; and (ii) Foundation chooses to assume the Sublicense.

## **6. PATENT PROSECUTION AND PATENT COSTS**

### **6.1. Licensed Subject Matter Management.**

- a) Licensee shall be responsible for the preparation, filing, prosecution, and maintenance of the Licensed Subject Matter, as Licensee may elect, including for example patent protection, copyright protection, trademark protection in the Territory, as well as any IP Costs associated therewith. Licensee shall provide Foundation with copies of all filings, official actions, and pertinent correspondence pertaining to such activities so as to give Foundation a reasonable opportunity to advise and comment on such activities. Licensee shall reasonably consider Foundation's advice/comments on such prosecution, filings and maintenance of the Licensed Subject Matter.
- b) If Licensee does not wish to file, prosecute or maintain any application, patent, copyright or other intellectual property protection, Licensee will notify Foundation in writing one hundred and eighty (180) days prior to any such discontinuation deadline, and Foundation shall have the option, but not the

obligation, to take over control of the same, at Foundation's sole expense, and Licensee will assign the entirety of its right in the same to Foundation.

## **7. BOOKS, RECORDS, AND REPORTS**

**7.1. Full and Accurate Records.** Licensee will keep, and will cause its Affiliates and Sublicensees to keep, full and accurate books and records in sufficient detail so that Licensee's compliance with its obligations under this Agreement can be properly determined without undue delay or difficulty. Such books and records will be maintained for at least six (6) years after the Reporting Period(s) to which they relate. Books and records will include, but not be limited to: accounting general ledgers; invoice/sales registers; original invoice and shipping documents; federal and state business tax returns; company financial statements; sales analysis reports; inventory and manufacturing records; sublicense and distributor agreements; price lists, product catalogs, and other marketing materials; and laboratory notebooks.

### **7.2. Inspection of Records.**

- a) Foundation may, from time to time and at any reasonable time, not exceeding once every twelve (12) months, through an Independent Auditor as Foundation may designate, inspect the complete and unredacted books and records of Licensee, its Affiliates, and its Sublicensees, in order to verify the accuracy of any reported statement by Licensee of Payments Due or amounts paid, or to determine compliance with any other obligation(s) of Licensee under this Agreement. Licensee agrees to cooperate fully with the Independent Auditor in connection with such review.
- b) After completion of any such inspection, Foundation will notify Licensee in writing of any discrepancies in Payments Due or amounts paid to Foundation. Such inspection will be made at the expense of Foundation, unless such inspection discloses an underpayment discrepancy of five percent (5%) or more in any calendar quarter, or if such underpayment is in excess of \$5,000 for any calendar quarter or an aggregate of \$10,000 for any calendar year. In such case, Licensee will be responsible for reimbursing Foundation for the inspection fee and expenses associated with such inspection within thirty (30) days after a written demand by Foundation. Licensee agrees to pay past due amounts for any deficiency error in Payments Due as determined by the Independent Auditor, including without limitation any payment deficiency since the Effective Date of the Agreement. Any underpayment as determined by the Independent Auditor will bear interest at one percent (1%) per month from the date the original payment was due. Foundation and the Independent Auditor will maintain in confidence such inspection and the resulting report. The Independent Auditor may from time to time consult the Foundation and any of its employees or Third Party counsel on questions as they relate to this Agreement. The

Independent Auditor may not disclose financial or proprietary information except as required to conduct the audit, to report the results of the audit, or as otherwise permitted by this Agreement or if the information already exists in the public domain. No other confidentiality agreement will be required to conduct the audit of the Licensee's books and records.

- c) **Sublicensee Reports.** Licensee will provide Foundation with copies of all reports Licensee receives from Sublicensees and Affiliates within thirty (30) days of Licensee's or their Affiliates' receipt of such reports.
- d) **Annual Reports.** Once per calendar year, on October 31st of each year, Licensee will provide progress reports to Foundation detailing Licensee's current progress toward development and commercialization of Products throughout the Territory for the previous year. The foregoing report will be provided on a country-by-country basis. Reports shall include the information, and conform to the format, attached hereto as Appendix C.

## **8. ENFORCEMENT OF LICENSED PATENTS**

- 8.1.** Foundation and Licensee will promptly inform the other in writing of any actual, alleged, or suspected infringement of a Licensed Patents or violation of any Licensed Patent by a third party, of which it is aware, and provide available evidence of infringement.
- 8.2.** With respect to any Licensed Patents licensed exclusively by Foundation to Licensee under this Agreement, Licensee shall have, for an initial period of ninety (90) days following notice under the provisions of Section 8.1, and only with Foundation's prior, written authorization, the first right, but not the obligation, to institute and control the prosecution of a suit or to take any other action for infringement of the Licensed Patents. Licensee will inform Foundation of its intent to institute such action, in writing, and Foundation will have fifteen (15) days to authorize such action by Licensee, in writing. For clarity, if Foundation does not provide a written authorization within the fifteen (15) day period, Licensee will not be authorized to institute such action. During the fifteen (15) day period, Foundation may also notify Licensee that Foundation will join Licensee in such action under the provisions of Section 8.4.
- 8.3.** Subsequent to Licensee's initial ninety (90) day period, Foundation shall have the right, but not the obligation, to institute and control the prosecution of a suit or to take any other action for infringement of any of the Licensed Patents. If Foundation decides to initiate a lawsuit to enforce Licensed Patents pursuant to this Section 8.3, Foundation will notify Licensee in writing. Licensee will have fifteen (15) days from receipt of such notice to notify Foundation that Licensee will join Foundation in such

lawsuit under the provisions of Section 8.4. If Licensee does not timely notify Foundation that it will be joining in such lawsuit, then it will be deemed that Licensee has assigned to Foundation all rights, causes of action, and damages resulting from any alleged infringement.

- 8.4.** Foundation and Licensee may agree to enforce Licensed Patents jointly, including by filing a lawsuit jointly. If a lawsuit is brought jointly in the names of both parties, then the out-of-pocket costs shall be borne equally, and any recovery or settlement shall be shared equally. Foundation and Licensee shall agree to the manner in which they shall exercise control over such lawsuit. Each party may, at its own option and expense, be represented by separate counsel of its own selection.
- 8.5.** If any suit is brought involving the enforcement or defense of the Licensed Patents, the other party hereto agrees, at the request and expense of the party initiating such suit, to reasonably cooperate and to make available relevant records, papers, information, samples, specimens and the like.
- 8.6.** No settlement or consent judgment or other voluntary final disposition of an enforcement or defense suit initiated by either party to this Agreement may be entered into without the consent of Foundation, which consent will not be unreasonably withheld.
- 8.7.** In the event that an action alleging invalidity including, without limitation, any Inter Partes Review, opposition or the equivalent thereof, or non-infringement of the Licensed Patents is brought against Licensee or Foundation, Foundation reserves the right, within thirty (30) days after commencement of such action, to intervene and take over the sole defense of the action at its own expense.
- 8.8.** The total cost of any action commenced or defended solely by Foundation will be borne by Foundation and Foundation will keep any recovery or damages derived therefrom.
- 8.9.** The cost of any infringement action commenced or defended by Licensee, including, without limitation, any Inter Partes Review, opposition or the equivalent thereof, will be borne by Licensee. Any recovery or damages resulting from such an action will first be applied to Licensee's out-of-pocket expenses and legal fees, and second will be applied to Foundation's out-of-pocket expenses, including legal fees. Ten percent (10%) of any excess recovery or damages will be paid to Foundation.

## **9. INDEMNIFICATION AND INSURANCE**

### **9.1. Indemnification.**

- a) Licensee shall indemnify, defend, and hold harmless Foundation, and its trustees, officers, staff, employees, students, and agents and their respective successors,

heirs, and assigns, and Stony Brook University, and its trustees, officers, staff, employees, students, and agents and their respective successors, heirs, and assigns, (the "Indemnified Parties"), against any liability, damage, loss, or expense (including reasonable attorneys' fees and expenses of litigation) incurred by or imposed upon the Indemnified Parties or any one of them in connection with any claims, suits, actions, demands, or judgments of third parties, Affiliates, and Sublicensees: (i) arising out of the design, production, manufacture, sale, use in commerce or in human clinical trials, lease, or promotion by Licensee or by an Affiliate, agent, or Sublicensee of Licensee of any Product, process or service relating to, or developed pursuant to, this Agreement; or (ii) arising out of any other activities to be carried out by or on behalf of Licensee pursuant to this Agreement provided that the liability, damage or loss is not attributable to the negligent activities of such Indemnified Party.

- b) Licensee agrees, at its own expense, to provide attorneys reasonably acceptable to Foundation to defend against any actions brought or filed against any Indemnified Parties with respect to the subject of indemnity to which such Indemnified Parties are entitled hereunder, whether or not such actions are rightfully brought. Foundation will cooperate in the defense thereof, provided, however, that Foundation will have the right, but not the obligation, to control the defense, at its expense, of any such actions. Foundation and the Indemnified Parties may, at their option and expense, have their own counsel participate in any proceeding which is under direction of Licensee and will cooperate with Licensee and its insurer in the disposition of any such matter; provided, however, that if Licensee shall not defend such actions or if there exists an actual or potential conflict of interest that makes representation of Indemnified Parties or Indemnified Parties and Licensee by the same counsel or the counsel selected by Licensee inappropriate, Foundation and the Indemnified Parties shall have the right to defend such actions themselves and recover from Licensee all reasonable attorneys' fees and expenses incurred by it during the course of such defense.
- c) Neither Foundation, the Indemnified Parties, nor Licensee shall enter into, or permit, any settlement of any such actions without the express written consent of the other parties, which shall not unreasonably be withheld.

## **9.2. Security for Indemnification.**

- a) At such time as any Product, process, or service relating to, or developed pursuant to, this Agreement, is commercially distributed or sold, or tested in clinical trials by or on behalf of Licensee, including by its Affiliates or Sublicensees, Licensee shall at its sole cost and expense, procure and maintain policies of comprehensive general liability insurance in amounts not less than

(i) \$2,000,000.00 per incident and \$4,000,000.00 annual aggregate during the period that such Product, process, or service is being tested prior to commercial sale, and (ii) \$2,000,000.00 per incident and \$4,000,000.00 annual aggregate during the period that such Product, process, or service is being commercially distributed or sold, and in each case naming the Indemnified Parties as additional insureds. Such comprehensive general liability insurance shall provide: (i) product liability coverage; and (ii) broad form contractual liability coverage for Licensee's indemnification obligations under Section 9.1 of this Agreement. If Licensee elects to self-insure all or part of the limits described above (including deductibles or retentions which are in excess of \$250,000 annual aggregate) such self-insurance program shall include assets or reserves which have been actuarially determined for the liabilities associated with this Agreement and must be acceptable to Foundation.

- b) The minimum amounts of insurance coverage required under this Section 9.2 shall not be construed to create a limit of Licensee's liability with respect to its indemnification obligations under Section 9.1 of this Agreement.
- c) Licensee shall provide Foundation with written evidence of such insurance upon request of Foundation. Licensee shall provide Foundation with written notice at least sixty (60) days prior to the cancellation, non-renewal, or material change in such insurance; if Licensee does not obtain replacement insurance providing comparable coverage by the end of such sixty (60) day period, Foundation shall have the right to immediately terminate this Agreement period without notice or any additional waiting periods.
- d) Licensee shall maintain such comprehensive general liability insurance beyond the expiration or termination of this Agreement during: (i) the period that any Product(s), process, or service, relating to, or developed pursuant to, this Agreement is being commercially distributed or sold or tested in clinical trials by or for Licensee, its Affiliates, or its Sublicensee(s) or used by an end-user or consumer of Product; and (ii) a reasonable period after the period referred to in (i) above which in no event shall be less than fifteen (15) years.
- e) Licensee shall use reasonable efforts to promptly recover amounts due to Foundation pursuant to Section 9.1.

## **10. TERMINATION**

### **10.1. Termination for Licensee Breach.**

- a) Licensee acknowledges and agrees that Licensee's obligations under the following provisions are material terms of this Agreement, and Licensee's

failure to meet its obligations under these provisions will be treated as a material breach of this Agreement (“Material Obligations”): (i) obligations under Section 3 to make Payments Due to Foundation on the schedule set forth therein; (ii) obligations under Section 4 to diligently pursue and achieve commercialization activities; (iii) obligations under Section 6 related to IP protection and payment of IP Costs; and (iv) obligations under Section 9 related to indemnification and insurance.

- b) If Licensee should: (i) fail to perform any covenant, condition, or undertaking of the Material Obligations of this Agreement; or (ii) materially breach any other provision of this Agreement; then Foundation may give written notice of such default to Licensee. If Licensee should fail to cure such default within thirty (30) days of notice of such default and provide adequate assurance of future performance, then this Agreement may, at Foundation’s option, be immediately terminated upon receipt of written notice by Licensee. The date of receipt of such notice shall be governed by Section 18.5.

**10.2. Automatic Termination.** This Agreement shall immediately terminate without any further action by the Foundation if Licensee, an Affiliate or Sublicensee thereof: (i) ceases to attempt to carry on its business with respect to the rights granted in the Agreement; (ii) becomes insolvent; (iii) makes an assignment for the benefit of creditors; or (iv) challenges, whether as an Inter Partes review (or the equivalent thereof), claim, cross-claim, counterclaim or defense, the validity or enforceability of any of Licensed Patents before any court, arbitrator, or other tribunal or administrative agency in any jurisdiction; then this Agreement will immediately terminate without any further action by Foundation.

**10.3. Licensee’s Right To Terminate.** Licensee may notify Foundation of their desire to terminate this Agreement at any time by giving Foundation ninety (90) days prior written notice. The termination will take effect on the day after such ninety (90) day period has elapsed.

**10.4. Accrued Obligations.** Termination of this Agreement will not relieve Licensee, including its Affiliates and Sublicensees, and Foundation of any obligation or liability accrued hereunder prior to such termination, or rescind or give rise to any right to rescind any payments made or other consideration given to Foundation hereunder prior to the time such termination becomes effective including, for example, Payments Due prior to the date of termination. Licensee will pay all attorneys’ fees and costs incurred by Foundation in enforcing any obligation of Licensee or accrued right of Foundation.

**10.5. Disposition of Products.** Upon expiration or termination of this Agreement by Licensee or Foundation, Licensee will provide Foundation with a written inventory

of all Products in process of manufacture, in use, or in stock. Licensee may dispose of any such Products within the ninety (90) day period following such expiration or termination, provided, however, that Licensee will pay Royalties and render reports to Foundation thereon in the manner specified herein.

**10.6. Effects of Termination.** Upon termination of this Agreement for any reason,

- a) Licensee shall cease all use of Licensed Subject Matter, and, at Foundation's election, delete, destroy, or return all copies of the Licensed Subject Matter and documentation in its possession or control. If Foundation requests deletion and/or destruction of Licensed Subject Matter, Licensee shall provide written certification of the same.
- b) Within ten (10) business days of expiration or termination of this Agreement for any reason, Licensee shall provide to Foundation a list of descriptions and amounts of Products on hand including, without limitation, all Products in development but not yet on the market.

**10.7. Survival.** The provisions Section 1 (Definitions), Section 7 (Books, Records and Reports), Section 9 (Indemnification and Insurance), Section 10.4 (Accrued Obligations), Section 10.5 (Disposition of Products), Section 10.6 (Effects of Termination), Section 10.7 (Survival), Section 11 (Warranty and Liability), Section 14 (Non-Use of Names), Section 17 (Confidentiality), Section 18 (Miscellaneous) and any other provisions which by their nature are inherently intended to survive will survive expiration or termination of this Agreement.

## **11. WARRANTY AND LIABILITY**

**11.1.** EXCEPT AS OTHERWISE EXPRESSLY SET FORTH HEREIN, FOUNDATION MAKES NO REPRESENTATIONS AND EXTENDS NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED, INCLUDING, BUT NOT LIMITED TO, WARRANTY OF MERCHANTABILITY, FITNESS FOR A PARTICULAR PURPOSE, AND VALIDITY OF LICENSED SUBJECT MATTER. ALL RIGHTS TO LICENSED SUBJECT MATTER PROVIDED BY FOUNDATION UNDER THIS AGREEMENT ARE PROVIDED "AS-IS". THE ENTIRE RISK AS TO THE QUALITY AND PERFORMANCE OF LICENSED SUBJECT MATTER IS WITH THE LICENSEE.

**11.2.** NO WARRANTY OR REPRESENTATION IS MADE THAT ANYTHING MADE, USED, SOLD, OR COMMERCIALY TRANSFERRED, UNDER THE TERMS OF THIS LICENSE, WILL BE FREE FROM INFRINGEMENT OF ANY THIRD PARTY INTELLECTUAL PROPERTY RIGHTS.

**11.3.** NOTHING IN THIS AGREEMENT, EITHER EXPRESS OR IMPLIED, OBLIGATES FOUNDATION EITHER TO BRING OR TO PROSECUTE ACTIONS OR SUITS AGAINST



THIRD PARTIES FOR PATENT INFRINGEMENT OR ENFORCEMENT OR TO FURNISH ANY INTELLECTUAL PROPERTY, INFORMATION OR MATERIALS NOT PROVIDED IN THE LICENSED SUBJECT MATTER.

- 11.4.** IN NO EVENT WILL FOUNDATION BE LIABLE FOR ANY INCIDENTAL, SPECIAL, PUNITIVE, OR CONSEQUENTIAL DAMAGES RESULTING FROM THE EXERCISE OF THIS LICENSE OR THE USE OF THE LICENSED SUBJECT MATTER, OR PRODUCTS, INCLUDING, WITHOUT LIMITATION, FOR LOST PROFITS, LOST BUSINESS OPPORTUNITY, INVENTORY LOSS, WORK STOPPAGE, LOST DATA, OR DOWNTIME, WHETHER OR NOT FOUNDATION HAS BEEN ADVISED OF THE POSSIBILITY OF SUCH DAMAGES.
- 11.5.** IN NO EVENT WILL FOUNDATION'S AGGREGATE LIABILITY TO LICENSEE, AFFILIATES, OR ANY THIRD PARTY FOR ANY CLAIMS, LOSSES, INJURIES, SUITS, DEMANDS, JUDGMENTS, LIABILITIES, COSTS, EXPENSES, OR DAMAGES, FOR ANY CAUSE WHATSOEVER (INCLUDING, BUT NOT LIMITED TO, THOSE ARISING OUT OF OR RELATED TO THIS AGREEMENT), AND REGARDLESS OF THE FORM OF ACTION OR LEGAL THEORY, EXCEED THE FEES RECEIVED BY FOUNDATION FROM LICENSEE OR ITS AFFILIATES PURSUANT TO THIS AGREEMENT. LIMITATIONS OF LIABILITY REFLECT THE ALLOCATION OF RISK BETWEEN THE PARTIES. THE LIMITATIONS SPECIFIED IN THIS ARTICLE 11 WILL SURVIVE AND APPLY EVEN IF ANY LIMITED REMEDY SPECIFIED IN THIS AGREEMENT IS FOUND TO HAVE FAILED OF ITS ESSENTIAL PURPOSE.
- 11.6.** THIS AGREEMENT DOES NOT CONFER BY IMPLICATION, ESTOPPEL, OR OTHERWISE ANY LICENSE OR RIGHTS TO ANY OTHER FOUNDATION PROPERTY OTHER THAN THOSE RIGHTS EXPRESSLY STATED HEREIN.

## **12. ASSIGNMENT.**

No part of this Agreement and the license granted hereunder may be assigned or transferred by Licensee without Foundation's written consent, and any such assignment or delegation shall in no event relieve Licensee of its primary responsibility for the same. Any such assignment shall be conditioned on and shall not be effective until the assignee or transferee has executed and delivered a written agreement assuming and undertaking all of the duties and obligations of the assignor or transferor under this Agreement. Licensee will give Foundation at least thirty (30) days prior written notice of any assignment or transfer of Licensee's business to which the license granted hereunder relates, and will provide Foundation with documentation executed by the assignee or transferee that confirms their agreement to be bound by the terms and

provisions of this Agreement. Any assignment made in violation of this Section will be *void ab initio*.

### **13. OBLIGATIONS TO FEDERAL GOVERNMENT AND OTHER SPONSORS**

- 13.1.** The Agreement will be subject to the rights of the United States Government, if any, resulting from any funding of the Licensed Subject Matter by the United States Government. This Agreement will also be subject to the rights of any other entities that may have contributed funding to development of the Licensed Subject Matter, if any. Licensee acknowledges that such rights, if applicable to Licensed Subject Matter, may reserve to the United States Government, a royalty-free, non-exclusive, non-transferable license to practice or have practiced on its behalf any government-funded invention claimed within any associated patents or patent applications as well as other rights.
- 13.2.** Licensee agrees that to the extent required under 35 U.S.C. Section 204, any Product used, sold, distributed, rented or leased by Licensee, Sublicensees, and their Affiliates in the United States will be manufactured substantially in the United States unless a waiver under 35 U.S.C. Section 204 is granted by the appropriate United States government agency.

### **14. NON-USE OF NAMES**

Licensee agrees that it will not use Foundation's name or State University of New York, or Stony Brook University, or any adaptation thereof (including trademarks, logos, and symbols associated with Foundation, "State University of New York", and "Stony Brook University") (collectively "SUNY"), or the names of the scientists, researchers, or others employed at or with SUNY in any advertising, promotional, or sales literature without first obtaining Foundation's prior written consent, or in the case of the names of such researchers, scientists, or employees, the prior written consent of the individuals, except that Licensee may state that it is a licensee of the Foundation.

### **15. FOREIGN LAWS**

When required by local or national law, Licensee will register this Agreement, pay all costs and legal fees connected therewith, and otherwise ensure that the local and national laws affecting this Agreement are fully satisfied.

## **16. COMPLIANCE WITH LAWS**

**16.1. General Compliance.** Licensee has the sole responsibility to ensure compliance with all applicable county, state, federal or foreign laws, rules, and regulations governing the production, use, marketing, sale, and distribution of Products.

**16.2. Compliance with Export Control Laws.** Licensee and Affiliates and Sublicensee(s) will comply with all U.S. export control laws and regulations. Except as provided in 16.2 (a) Licensee and Affiliates and Sublicensee(s) acknowledge that they may not directly or indirectly export, re-export , distribute or transfer any commodities, technology and technical data prohibited or restricted by the Export Administration Regulations of the U.S. Department of Commerce, the International Traffic In Arms Regulations of the U.S. Department of State, the Office of Foreign Asset Controls of the U.S. Department of Treasury, the Assistance to Foreign Atomic Energy Activities of the U.S. Department of Energy.

**a) Licensee Export.** Licensee and Affiliates and Sublicensee(s) will not export, directly or indirectly,: (i) any technical data received from Foundation under this Agreement; and (ii) any Product or technical data without any applicable export license from the appropriate U.S. federal agency, subject to any exemptions or exclusions thereof. Licensee shall be solely responsible for obtaining all licenses, permits, or authorizations as required from time to time by the U.S. and any other government for any such export or re-export. Foundation makes no representation that an export license is or is not required, nor does Foundation make a representation that, if required, a license will be issued by the U.S. Department of Commerce, U.S. Department of State, U.S. Department of Energy, U.S. Department of Treasury or other appropriate governmental entity.

**b) Licensee Disclosure to Foundation.** Licensee will not disclose or transfer any export controlled technology or technical data identified on any US export control list, including, but not limited to, the Commerce Control List (CCL) at 15 C.F.R. § 774 and the U.S. Munitions List (USML) at 22 C.F.R. § 121. In the event Licensee intends to provide Foundation with export controlled information, Licensee will inform Foundation, in writing, thirty (30) days prior to the release of export controlled technology or technical data. Licensee agrees not to provide any export controlled information to Foundation without the written authorization of Foundation.

## 17. CONFIDENTIALITY

- 17.1. Confidential Information.** As used in this Agreement, “Confidential Information” will mean confidential or proprietary information exchanged between the parties and/or their Affiliates hereunder and relating to Licensed Subject Matter, or the performance of the obligations set forth herein, including without limitation: (i) written or other tangible information marked as confidential or proprietary; (ii) orally disclosed information that is identified as confidential and summarized in a notice delivered within thirty (30) days of the disclosure; (iii) the details of this Agreement; and (iv) information that should reasonably be considered confidential under the context in which the disclosure is made (*i.e.*, nonpublic patenting information and nonpublic infringement information).
- 17.2. Confidentiality Obligations.** Foundation, Licensee and Affiliate(s) agrees to: (i) maintain the other party’s Confidential Information with the same level of care as it does its own valuable and sensitive information of a similar nature and, in any event, with not less than a reasonable degree of care; and (ii) not disclose the other party’s Confidential Information to any other party, without the prior written consent of the disclosing party. Each party agrees to limit its use of the other party’s Confidential Information to the purposes permitted by this Agreement. The obligation of confidentiality under this Section 17.2 shall continue for five (5) years from the expiration or termination of this Agreement.
- 17.3. Exceptions.** The obligations of either party under Section 17.2 will not apply to information that the receiving party can demonstrate: (i) was in its possession at the time of disclosure and without restriction as to confidentiality; (ii) at the time of disclosure is generally available to the public or after disclosure becomes generally available to the public through no breach of agreement or other wrongful act by the receiving party; (iii) has been received from a third party without restriction on disclosure and without breach of agreement or other wrongful act by the receiving party unless the receiving party should reasonably conclude that the information is Confidential Information; (iv) is independently developed by the receiving party without regard to the Confidential Information of the other party; or (v) is required to be disclosed by law or order of a court of competent jurisdiction or regulatory authority; provided, however, the receiving party shall: (a) give disclosing party, to the extent possible, advance notice prior to disclosure so the disclosing party may contest the disclosure or seek a protective order; and (b) limit the disclosure to the minimum Confidential Information that is legally required to be disclosed.
- 17.4. Injunctive Relief.** The parties agree that the breach, or threatened breach, of any of the confidentiality provisions of this Article 17 may cause irreparable harm without adequate remedy at law. Upon any such breach or threatened breach, Licensee or

Foundation will be entitled to injunctive relief to prevent the other party from commencing or continuing any action constituting such breach, without having to post a bond or other security and without having to prove the inadequacy of other available remedies. Nothing in this Section will limit any other remedy available to either party.

## **18. MISCELLANEOUS**

- 18.1. Governing Law.** This Agreement will be construed, governed, interpreted and applied in accordance with the laws of the State of New York, except that questions affecting the construction and effect of any patent will be determined by the law of the country in which the patent was granted. The parties consent to the exclusive personal jurisdiction of the state and federal courts of the State of New York.
- 18.2. Entire Agreement.** This Agreement, including any Appendices or attachments hereto, embodies the entire agreement and understanding among the parties to this Agreement and supersedes all prior agreements and understandings relating to the subject matter of this Agreement. None of the terms or provisions of this Agreement may be altered, modified, or amended except by the execution of a written instrument signed by the parties hereto.
- 18.3. Severability.** The provisions of this Agreement are severable, and in the event that any provisions of this Agreement are determined to be invalid or unenforceable under any controlling body of law, such invalidity or unenforceability will not in any way affect the validity or unenforceability of the remaining provisions hereof. The term or provision held invalid or otherwise unenforceable shall be deemed modified to the extent necessary, consistent with the controlling body of law, to render such term or provision enforceable, preserving to the fullest permissible extent the intent and agreements of the parties.
- 18.4. Construction.** Both parties contributed equally to the drafting of all parts of this Agreement and agree to all of the terms herein. Both parties reviewed this Agreement thoroughly prior to execution.
- 18.5. Notices.** All notices, requests, consents, and other communications required or permitted under this Agreement or required by law in connection with this Agreement (each, a "Notice") must be provided in writing to the other party at the applicable address below through one of the following methods: (a) in person; (b) by certified or registered mail, or air mail, as appropriate, return receipt requested; (c) by nationally recognized overnight courier service; or (d) via email (and, if receipt is not confirmed within 2 business days, supplemented by one of the methods specified in (a), (b), or (c) of this section). Notices will be considered to have been given (1) at the time of actual delivery in person, (2) on the date of receipt by certified or

registered mail or air mail, (3) upon delivery to recipient by an overnight courier service, or (4) for email, the earlier of the date receipt is acknowledged by recipient and the date the supplemental Notice would otherwise be deemed given in accordance with this section. Either party may change its address for Notice by providing Notice of the change in accordance with this section. If an individual named as the recipient for Notices to a party ceases to work in the role specified or ceases to work for a party and that party fails to notify the other party of an alternative individual, delivery of Notices marked to the attention of an individual in the same or equivalent role at that party is deemed compliant with the Notice obligations.

If to Licensee, to:

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

If to Foundation, to:

Stony Brook University  
Intellectual Property Partners  
N5002 Frank Melville Jr. Memorial Library  
Stony Brook, New York 11794-3369  
Attn: Director  
[ori\\_ipp@stonybrook.edu](mailto:ori_ipp@stonybrook.edu)

- 18.6. No Waiver.** No delay in exercising any right or remedy will constitute a waiver of any right or remedy. Neither Party shall be deemed to have waived the exercise of any right that it holds under this Agreement unless such waiver is made in writing and signed by duly authorized representatives of the Parties.
- 18.7. Patent Marking.** As required by law, Licensee will mark, and will cause its Affiliates and Sublicensees to mark, all Products that are manufactured or sold under this Agreement with: (i) the number of each issued patent under the Licensed Patents that applies to such Product, if any; or (ii) the word 'patent' or the abbreviation 'pat.' together with an address of a posting on the Internet, accessible to the public without charge for accessing such address, that associates such Product with the number of the issued patent under the Licensed Patents, if any.
- 18.8. Independent Parties.** This Agreement will not be construed as creating a relationship of employment, agency, partnership, joint venture, or any other form of legal association between Licensee and Foundation. The relationship between the

parties shall never be construed to be that of employer-employee. Neither party has any power to bind the other party or to assume or to create any obligation or responsibility on behalf of the other party or in the other party's name.

**18.9. No Third Party Beneficiaries.** This Agreement is solely for the benefit of the parties and their respective successors and permitted assigns and, except as provided in Section 9, this Agreement shall not otherwise be deemed to confer upon or give to any other Third Party any right, claim, cause of action, or other interest herein.

**18.10. Force Majeure.** Neither party will be liable for failure or delay of fulfillment of all or part of this Agreement, directly or indirectly owing to acts of nature, governmental orders or restriction, war, warlike conditions, revolution, riot, looting, strike, lockout, fire, flood, or any other cause or circumstances beyond the parties' control.

**18.11. Headings.** The headings of the articles and sections are inserted for convenience of reference only, and are not intended to influence the interpretation of this Agreement.

**18.12. Counterparts.** This Agreement may be executed in two or more counterparts, each of which will be deemed an original, but all of which together will constitute one and the same instrument. Further, either party's signature to a copy of this Agreement will be deemed a signature to, and may be attached to, any other identical copy of the Agreement. Facsimile or electronic signatures will be as binding and effective as original signatures.

**18.13. Xerographic or Electronic Copies.** The parties agree that any xerographically or electronically reproduced copy of this fully-executed agreement has the same legal force and effect as any copy bearing original signatures of the parties.

**18.14. Cumulative Rights.** Any specific right or remedy provided in this Agreement will not be exclusive but will be cumulative of all other rights and remedies.

*[Signature page to follow]*

**IN WITNESS WHEREOF**, the parties have caused this Agreement to be executed by their duly authorized representatives.

**LICENSEE**

By: \_\_\_\_\_  
Name: \_\_\_\_\_  
Title: \_\_\_\_\_  
  
Date: \_\_\_\_\_

**THE RESEARCH FOUNDATION FOR THE  
STATE UNIVERSITY OF NEW YORK**

By: \_\_\_\_\_  
Name: \_\_\_\_\_  
Title: \_\_\_\_\_  
  
Date: \_\_\_\_\_



## **Appendix A: Affiliates**

**Appendix B:  
Licensed Patents**

Patent or Application Number	Location/Type of Patent or Patent Application	Title (RF Docket Number)	Filed	Issued

## **Appendix C: Annual Report Template**

LICENSE TITLE:

EFFECTIVE DATE:

1. Period Addressed in the Report:
2. Number, Name, and Type of Products made by or for Licensee, its Affiliates, and its Sublicensee(s):
  - a. Name of company(ies) manufacturing Products
  - b. Country where Products being manufactured (if U.S, country & State)
3. Gross Sales for each Number, Name, and Type of Products Sold by Licensee, its Affiliates, and its Sublicensee(s).
4. Identification of all Valid Claims that any Patent Product is Covered By:
5. Identification of any Hurdles Faced in Achieving Commercialization of Products and Details on Efforts to Overcome the Hurdles:
6. Identification of Technical Information Used or Incorporated in the Discovery, Development, Manufacture, Use, Sale, Offering for Sale, Importation, exportation, distribution, rental or lease of any Other Product:
7. Progress on the Commercialization and Development of the Licensed Subject Matter and Products (*i.e.*, new product development, improvements to Licensed Subject Matter generated by Licensee after the Effective Date (e.g., new patents filed), product evaluation and testing, marketing plans, sales forecasts, significant commercialization events, progress:
  - a. Calendar year of first commercial sale (if any)
8. Progress on Efforts to Secure Government Approval, if any, to Commercialize Products:
  - a. FDA (or foreign equivalent) approval type sought/received.
  - b. FDA (or foreign equivalent) approval number
  - c. FDA (or foreign equivalent) approval status.

**[Exhibit E – NDA (if applicable)]**