

AGREEMENT FOR NON-APPLICATION OF IP POLICY

WHEREAS, [_____(name(s))], a [(faculty member)/(researcher)/(student)/(staff member)] (“RESEARCHER”) while at the University of Rochester, conceived, developed and disclosed to University of Rochester (“UNIVERSITY”), a technology described in [document, titled “_____”, dated _____] (collectively, the “Invention”); and

WHEREAS, rights of the RESEARCHER and UNIVERSITY in the Invention are governed by the terms of the University of Rochester Policy on Intellectual Property and Technology Transfer (“UR IP Policy”) dated February 1, 1997, and revised dated November 1, 2004, June 2013 and October 21, 2013; and

WHEREAS, the RESEARCHER has certified that the Invention was created by him/her/they as a [(faculty member)/(researcher)/(student)/(staff member)], that it was not generated as a result of sponsored research or government funding and that it did not use significant UNIVERSITY resources, as per UR IP Policy Sections 1.3, 1.8 and 2.1.1; and

WHEREAS, UNIVERSITY has incurred no expenses with regard to the Invention; and

WHEREAS, the RESEARCHER has requested clarity that UNIVERSITY has no interest or rights in the Invention, and for extra clarity that UNIVERSITY waives any intellectual property rights to the Invention back to her/him/them; and

WHEREAS, pursuant to the University of Rochester Policy on Intellectual Property and Technology Transfer, UNIVERSITY has determined that, if it has any interest in the Invention, it is willing to release to the RESEARCHER any such interest therein.

NOW, THEREFORE, the parties hereto agree as follows:

1. UNIVERSITY hereby agrees and clarifies that UR IP Policy does not provide UNIVERSITY with any rights in the Invention as developed by RESEARCHER, especially as the Invention was created and developed without government or sponsored funding and without the use of significant UNIVERSITY resources. Further, for clarity and in an abundance of caution should there be any question about UNIVERSITY’s rights or interests in the Invention, UNIVERSITY hereby releases and transfers to the RESEARCHER, and to her/his/their respective heirs, executors, administrators and assigns, any and all such right and interest in and to the Invention.
2. UNIVERSITY hereby declares that no patent or copyright relating to the Invention has been filed and none will be filed by UNIVERSITY. If the RESEARCHER wishes to have any intellectual property protection on the Invention, he/she/they should take appropriate action and obtain his own legal counsel. UNIVERSITY has had no and will have no obligation regarding any such action or intellectual property protection.
3. RESEARCHER agrees to indemnify and hold UNIVERSITY and its trustees, directors, officers, employees and affiliates harmless from and against any and all claims, demands, losses or causes of action related in any way to the patenting, production, marketing, enforcement or commercialization of the Invention.

4. RESEARCHER understands that the Invention is being released to him/her/them for his/her/their own personal activities. UNIVERSITY does not have any responsibility to further develop, support or market the Invention, and UNIVERSITY shall not be obligated to expend any funds (including without limits any patent prosecution or maintenance payments), equipment, facilities or other resources.

5. EXCEPT AS OTHERWISE EXPRESSLY SET FORTH IN THIS AGREEMENT, UNIVERSITY, ITS TRUSTEES, DIRECTORS, OFFICERS, EMPLOYEES, AND AFFILIATES MAKE NO REPRESENTATIONS AND EXTEND NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED, REGARDING THE INVENTION, INCLUDING BUT NOT LIMITED TO WARRANTIES OF MERCHANTABILITY, FITNESS FOR A PARTICULAR PURPOSE, VALIDITY OF PATENT RIGHTS CLAIMS, ISSUED OR PENDING, AND THE ABSENCE OF LATENT OR OTHER DEFECTS, WHETHER OR NOT DISCOVERABLE. NOTHING IN THIS AGREEMENT SHALL BE CONSTRUED AS A REPRESENTATION MADE OR WARRANTY GIVEN BY UNIVERSITY THAT THE PRACTICE BY RESEARCHER OF THE INVENTION GRANTED HEREUNDER SHALL NOT INFRINGE THE PATENT RIGHTS OF ANY THIRD PARTY. IN NO EVENT SHALL UNIVERSITY, ITS TRUSTEES, DIRECTORS, OFFICERS, EMPLOYEES AND AFFILIATES BE LIABLE FOR INCIDENTAL OR CONSEQUENTIAL DAMAGES OF ANY KIND, INCLUDING ECONOMIC DAMAGE OR INJURY TO PROPERTY AND LOST PROFITS, REGARDLESS OF WHETHER UNIVERSITY SHALL BE ADVISED, SHALL HAVE OTHER REASON TO KNOW, OR IN FACT SHALL KNOW OF THE POSSIBILITY.

6. This Agreement may not be assigned without the prior written mutual consent of the parties.

7. This Agreement shall be governed by the laws of the State of New York.

IN WITNESS WHEREOF, this release and assignment has been duly executed by UNIVERSITY and the RESEARCHER as of the date set forth below.