

**AGREEMENT FOR RELEASE OF INVENTION RIGHTS
AND ASSIGNMENT OF RIGHTS**

WHEREAS, [Insert Inventor(s) Name(s)] (“Inventor(s)”) has/have conceived and disclosed to University of Rochester, an invention titled **[Insert Invention Title and UR Technology Number, and Patent Application information (if any)]** U.S. Patent Applications Serial No. [] drawn to the Invention] (collectively, “Invention”); and

WHEREAS, the said Invention was conceived and/or first reduced to practice under the auspices of University of Rochester, a State of New York non-profit, tax-exempt, educational institution located in Rochester, New York (referred to herein as “Rochester”); and

WHEREAS, rights of the Inventor(s) and Rochester in the Invention are governed by the terms of the University of Rochester Policy on Intellectual Property and Technology Transfer dated February 1, 1997, and revised November 1, 2004, June 13, 2013 and October 21, 2013 and as may be further updated; and

WHEREAS, Federal funding from _____ (“Agency”) under grant number _____, and/or sponsored research funding from _____ (“Entity”) under Sponsored Research Agreement No. _____ has been used to support the research that resulted at least in part in Invention; and

WHEREAS, any release or assignment contemplated hereunder is subject to prior approval from Agency or Entity and subject to Inventor’s agreement to any requirements or obligations from Agency or Entity, including, without limitation, Inventor’s execution of this Agreement; for clarity, if Agency or Entity do not provide prior approval and/or if Inventors do not agree to such requirements or obligations, there will be no release or assignment hereunder; and

WHEREAS, pursuant to the University of Rochester Policy on Intellectual Property, Rochester has determined that it does not wish to participate in the sale or licensing of the Invention, and that it is willing to release to the Inventor(s) Rochester’s interest therein, subject to Inventor(s)’ agreement to the terms in this Agreement.

NOW, THEREFORE, the parties hereto agree as follows:

1. Rochester, as of the last date set forth below in the signature blocks (“Effective Date”), hereby releases, conveys, assigns and transfers to the Inventor(s), and to his/her/their heirs, executors, administrators and assigns, and Inventor(s) hereby accept/s the release, conveyance, assignment and transfer from Rochester of all of Rochester’s right, title and interest in and to the Invention, including, without limitation, any patents (if filed and listed above) specifically covering said Invention
2. Inventor(s) represent that, to their knowledge, they are the only Inventor(s) of the Invention. Inventor(s) further agree that if other individuals contributed to the Invention, then those additional contributions will be contingent upon the Inventor(s) obtaining agreements assigning full ownership and control of those additional contributions to the Inventor(s) without cost to Rochester; provided, however, that if and to the extent any such rights are determined to have been assigned or are required to be assigned to Rochester, it shall assign or cause the same to be assigned to Inventor(s).

2020-4-28 WAIVER-RELEASE TEMPLATE

Inventor(s) assert/s they have made a full disclosure of the Invention and of all third party interest of which Inventor(s) is/are aware.

[If Invention was NOT developed with the use of external funds, use:

Inventor(s) assert/asserts the Invention was not developed with the use of external funds (including funds provided by the US Government or other sponsor); and

[If Invention was developed with the use of external funds, use alternate paragraph(s):

[alternative paragraph i]: Inventor(s) acknowledge/s external funds from the Agency (listed above) of the US Government were used in the development of the Invention. Inventor(s) agrees that the US Government has certain rights in the Invention and that rights to the Invention are subject to certain terms and conditions imposed by the Agency of the US Government, including, without limitation, 37 CFR Part 401; and

[alternative paragraph ii]: Inventor(s) acknowledge/s external funds from a non-government Entity (listed above) were used in the development of the Invention. Inventor(s) agrees that the Entity may have rights in the Invention and that rights to the Invention may be subject to certain terms and conditions imposed by the Entity; and

{For both alternative i and alternative ii, include the following: Inventor(s) agree/agrees to cooperate with any Agency and/or Entity assignment approval process, including completion and execution of any required forms and additionally agrees to abide by any applicable Agency or Entity requirements}.

3. The Inventor(s) hereby grant/s to Rochester, a perpetual irrevocable, non-exclusive, non-transferable, royalty-free license to practice said Invention internally for educational and research purposes only (the "Reservation of Rights"). Inventor(s) hereby release/s, now and forever, any and all claims, known or unknown as of the Effective Date, he/she/they have or may have against Rochester that relate to Rochester's handling, management, or commercialization of the Invention and any related Intellectual Property prior to the Effective Date.

4. Inventor(s) understand/s that said Invention is being assigned to him/her/them for his/her/their own personal activities. Rochester does not have any responsibility to further develop the Invention, and Rochester shall not be obligated to expend any additional funds (including without limits any further patent prosecution or maintenance payments), equipment, facilities or other resources. Inventor(s) agree/s not to use any Rochester funds, equipment, facilities, or other resources to patent, market, license, sell or otherwise commercially develop said Invention after execution of this Agreement without Rochester's prior written approval and full reimbursement of the costs of such use. Inventor(s) understand/s that rights being released to him/her/them cover only the present Invention and not future related inventions or improvements to the present Invention that may be subsequently conceived as research continues. Nothing in this agreement is intended to license, nor will anything herein be construed as a license, to any University intellectual property not explicitly listed herein or any background intellectual property of the University, even if such is necessary to practice the Invention. Any license to background intellectual property must be by a separate written agreement between the University and Inventor(s). The rights of Inventor(s) and Rochester in any improvements to the Invention or new inventions stemming from continued research at Rochester will be governed by, to the extent applicable, the terms of the University of Rochester Policy on Intellectual Property in effect at that time.

5. EXCEPT AS OTHERWISE EXPRESSLY SET FORTH IN THIS AGREEMENT, ROCHESTER, ITS TRUSTEES, DIRECTORS, OFFICERS, EMPLOYEES, AND AFFILIATES MAKE NO REPRESENTATIONS AND EXTEND NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED, 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 ROCHESTER THAT THE PRACTICE BY INVENTOR(S) OF THE INVENTION GRANTED HEREUNDER SHALL NOT INFRINGE THE PATENT RIGHTS OF ANY THIRD PARTY OR OTHER PATENT RIGHTS OF ROCHESTER. NO LICENSE IS PROVIDED OR IMPLIED TO INVENTOR(S) TO OTHER PATENT RIGHTS OF ROCHESTER, INCLUDING BUT NOT LIMITED TO OTHER PATENT RIGHTS OF ROCHESTER NECESSARY TO PRACTICE THE INVENTION. IN NO EVENT SHALL EITHER PARTY BE LIABLE TO THE OTHER PARTY (AND IN THE CASE OF ROCHESTER, ITS TRUSTEES, DIRECTORS, OFFICERS, EMPLOYEES) OR ANY AFFILIATE THEREOF FOR INCIDENTAL OR CONSEQUENTIAL DAMAGES OF ANY KIND, INCLUDING ECONOMIC DAMAGE OR INJURY TO PROPERTY AND LOST PROFITS, REGARDLESS OF WHETHER ROCHESTER SHALL BE ADVISED, SHALL HAVE OTHER REASON TO KNOW, OR IN FACT SHALL KNOW OF THE POSSIBILITY.

6. Inventor(s) shall indemnify and hold Rochester and its trustees, directors, officers, employees and affiliates harmless from and against any and all claims, demands, losses or causes of action (together, "Claims") related in any way to the use, production, marketing, sales, offers to sell, distribution, manufacture, or commercialization by Inventor(s) of the Invention. Inventor(s) shall also indemnify and hold harmless Rochester from and against any and all loss, costs (including reasonable attorneys' fees), damages, judgments, and other liability incurred in connection with (i) a suit or proceeding to the extent arising from any action or omission of Rochester relating to the Invention; (ii) Rochester's assignment of, or grant of the right to enforce, herein any patent on the Invention, (iii) the joinder of Rochester as a necessary or indispensable party in any action, suit or proceeding involving the Invention in which Inventor is plaintiff (or declaratory judgment defendant), (iv) or enforcement of a patent related to the Invention against any third party. In addition, Inventor(s) shall promptly reimburse University in full within 30 days for any and all reasonable costs and expenses incurred and resources expended by University (including reasonable outside counsel fees, and reasonable time and materials charges) in connection with efforts to respond to a discovery demand, subpoena, order, information request in any action, suit or proceeding involving the Patent in which Inventor is plaintiff, party or declaratory judgment defendant, or other information request issued by a court or tribunal of competent jurisdiction in any action, suit or proceeding involving the Invention or related patent in which Inventor is plaintiff, party or declaratory judgment defendant.

7. No Endorsement. By entering into this Agreement, University neither directly nor indirectly endorses any product or service provided, or to be provided, by Inventor(s), whether directly or indirectly related to this Agreement. Inventor(s) will not state or imply that this Agreement is an endorsement by University or its employees.

8. Recordation. Within 30 days of the Effective Date, Inventor(s) shall record with the relevant patent authorities the transfer of ownership to Inventor(s) of any patent(s) listed above as part of the Invention.

9. This Agreement shall be governed by the laws of the State of New York. Any legal suit, action or proceeding arising out of or related to this Agreement shall be instituted and resolved exclusively in a federal or state court of competent jurisdiction located in the State of New York, Monroe County, and each party irrevocably submits to the exclusive jurisdiction of such courts in any such suit, action or proceeding.

IN WITNESS WHEREOF, this release and assignment has been duly executed by Rochester and the Inventor(s) as of the last date set forth below ("Effective Date").

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