

PETITION FOR ASSIGNMENT OF PATENT RIGHTS TO INVENTOR

The undersigned Inventor(s), an employee(s) of The Pennsylvania State University, seeks to have the patent rights covering the Invention described in PSU Inv. Disc. No. _____ (which patent rights are described in Appendix A) (hereafter "Patent Rights") assigned from The Penn State Research Foundation ("PSRF") to them under the terms of University Policy No. RA-12. Inventor warrants and represents the following to be true:

1. **Compliance with My Obligations to IPO.**

I have complied with all obligations under University policy to adequately and accurately disclose the Invention and all corresponding data which would assist the University in identifying and negotiating with potential licensees. Similarly, I have complied with the obligation to fully disclose the usefulness of the Invention and any related inventions which are made or imminently will be made in my laboratory or facilities. I understand that if I have failed to so discharge these responsibilities to the University, no assignment will be considered. Similarly, if PSRF determines within two years after an assignment that I have failed to discharge these responsibilities, PSRF will have the right to reclaim title to the invention, and to rescind any assignment.

2. **Agreement Among Joint Inventors.**

PSRF will only assign an equal, undivided interest in the Patent Rights to all inventors who have an obligation to assign to The Pennsylvania State University. In such an instance, it is the responsibility of the inventors to determine in a separate agreement, to which PSRF is not a party, arrangements for commercialization and apportionment of royalties or revenues.

3. I understand that PSRF's assignment of patent rights shall be conditioned upon the following:

a. **Permission from Sponsors.**

Wherever the invention in question has been funded by either an industrial sponsor or a government agency, the University must strictly comply with all statutory and contractual obligations to seek permission, concurrence, or approval of any such entity prior to assignment. The University will diligently seek to do so. I understand that there is never a guarantee that the University will obtain this consent, and that in any event the process of seeking consent can take several months. I will cooperate with any government approval process, including signing any necessary forms, and abiding by any applicable governmental requirements.

b. **Patent Expenses My Responsibility.**

I will be responsible to ensure that PSRF receives reimbursement for all outside patent fees incurred by the Intellectual Property Office in protecting the Invention. In the event I receive royalties or other income from the commercialization of the Invention, half of any receipt by inventor(s) of royalties or other income will be shared with PSRF until it has recovered all of its reasonable out of pocket expenses incurred in protecting the technology.

Furthermore, in the event there are patenting fees which are due or coming due after the time I submit this petition, I agree as a condition of submitting the petition that I will be responsible for all of those patent costs as they are incurred. Upon request, the IPO will provide me with an estimate of what these costs will be and when they will be incurred. Even if the petition is denied because of failure to obtain governmental approvals or any other good faith reason, I understand I will remain liable for these "interim" expenses.

c. Exclusion of Related Inventions.

In the event the petition for reassignment is granted, it will only cover the Patent Rights based upon the specific Invention covered by the invention disclosure, and will not cover "future inventions" or "related inventions" which may arise out of my laboratory, or to any "background rights" that may be needed to practice the Invention. The only Patent Rights subject to this petition are those expressly referenced in Appendix A. It will not cover any continuation-in-part applications where new matter is added that is not covered by the assignment.

d. Protection of University from Liability.

Any time the University licenses or assigns its intellectual property rights, it obtains complete indemnity and insurance protection from the licensee/assignee. This must remain true in any assignments back to inventors. Furthermore, we agree that any licenses we enter or agreements we enter will contain the language in Appendix B protecting PSRF and the University, and that unless PSRF agrees in writing, no product will be sold by you or any licensee or assignee until adequate insurance coverage is in place.

e. Non-exclusive Right to University.

I agree that PSRF and the University will retain a non-exclusive, royalty-free right to practice the Invention, and any resulting patents, for their own internal, non-commercial research purposes, including the right to sublicense to other research entities.

f. Compliance with Conflict of Interest Policies.

I agree that any further research I conduct that is related to the Invention will be covered by a Memorandum of Understanding under guidelines and University Policies RA 11 and RA 12.

4. Royalty.

In consideration for PSRF's assignment of Patent Rights to me, I agree that I will pay to PSRF a one (1%) percent royalty or other income based upon sales of any product or service covered by Patent Rights. This obligation to pay royalties shall apply to any licensee, assignee of Patent Rights, or of any other party making, selling or commercially using the Patent Rights.

Sworn to and subscribed

before me this ____ day of

Inventor: _____

_____ 20__.

Date: _____

Notary Public

My Commission Expires:

Sworn to and subscribed

before me this ____ day of

_____ 20__.

Notary Public

My Commission Expires:

Inventor: _____

Date: _____

Sworn to and subscribed

before me this ____ day of

_____ 20__.

Notary Public

My Commission Expires:

Inventor: _____

Date: _____

APPROVED BY:

Research Dean

Date

THE PENN STATE RESEARCH FOUNDATION

By: _____

Name: David E. Branigan

Title: Treasurer

Date: _____

APPENDIX A

PATENT RIGHTS

APPENDIX B

INDEMNITY AND INSURANCE REQUIREMENTS

I agree that all licenses, assignments, or other written documents between me and any other entity or person which transfer or grant rights to the subject Invention, including any entity or business owned in full or in part by me, will contain the standard indemnity and insurance provisions below and shall state the University, PSRF, its trustees, directors, officers, employees, affiliates, agents, and students (“Protected Parties”) are agreed to be third party beneficiaries of said agreement. Any such agreement which is entered without said clauses incorporated, and without specifically referencing the Protected Parties as set forth above, shall be null and void, shall constitute a material breach of such agreement, and shall be grounds for University to revoke the assignment of the subject Invention. Under no circumstances will you sell, offer for sale, or allow sales of products incorporating said Invention without said products being covered by appropriate level of product liability insurance, as set forth below:

At all times during the terms and thereafter, of any license agreement, assignment or other written documents which transfer or grant rights to the subject Invention, any entity or business owned in full or in part by any of the Inventor(s), PSRF, its trustees, directors, officers, employees, affiliates, agents, and students are to be indemnified, defended and held harmless against all claims, proceedings, demands and liabilities of any kind whatsoever, including legal expenses and reasonable attorneys’ fees, arising out of the death of or injury to any person or persons or out of any damage to property, or resulting from the production, manufacture, sale, use, lease, consumption or advertisement of any product incorporating the Invention, or which falls within the claims of any issued or pending patent of the subject Invention, or arising from any obligation thereof.

Prior to the first commercial sale of any product incorporating said Invention, full force and effect commercial general liability insurance which shall protect the Protected Parties shall be obtained. Such insurance shall be written by a reputable insurance company authorized to do business in the Commonwealth of Pennsylvania, shall list PSRF and The Pennsylvania State University as an additional insured thereunder, shall include product liability coverage and shall require thirty (30) days written notice to be given to PSRF prior to any cancellation or material change thereof. The limits of such insurance shall not be less than One Million Dollars (\$1,000,000) per occurrence with an aggregate of Three Million Dollars (\$3,000,000).