

INTELLECTUAL PROPERTY AGREEMENT

This AGREEMENT (“Agreement”), effective as of the date on which the last Party hereto signs this Agreement (“Effective Date”), is entered into by and between the Board of Regents of the University of Oklahoma, a constitutional state entity of the State of Oklahoma, by and through the Office of Technology Development having offices at 301 David L. Boren Boulevard, Suite 3120, Norman, Oklahoma, 73019 (“UNIVERSITY”) and [insert name of collaborator] (“COLLABORATOR”), having a principal place of business at [insert COLLABORATOR address]. COLLABORATOR and UNIVERSITY may hereinafter be referred to herein in the singular as “Party” or collectively as the “Parties.”

This Agreement defines the rights of use, reproduction, distribution, modification and redistribution of certain technology originally created as part of the Artificial Intelligence for Environmental Sciences (AI2ES) program under National Science Foundation proposal number 2019758 (“Program”). Anyone who uses, reproduces, distributes, modifies or redistributes the subject technology, by that action, is accepting in full the responsibilities and obligations contained in this Agreement.

WHEREAS COLLABORATOR(S) and UNIVERSITY each have interest in cooperating individually and with other collaborators in the development of Artificial Intelligence for Environmental Sciences (AI2ES).

NOW THEREFORE, in consideration of the mutual promises and obligations contained herein, the sufficiency of which is hereby acknowledged, the parties agree as follows:

1. “INVENTION” shall mean any invention, discovery, improvement, concept, product, or idea made during the Program whether or not patentable or copyrightable, including but not limited to processes, machines, methods, computer software, formulas, and know-how directly relating thereto. An INVENTION is “made during the Program” if it arises from work performed pursuant to the Program, conducted under this Agreement by a person assigned to the Program and is made during the PERIOD OF PERFORMANCE.
2. As long as inventor(s) of an INVENTION is/are employed by UNIVERSITY in any capacity, it shall be conclusively presumed that such INVENTION conceived of entirely by such INVENTOR(s) was made in his/her capacity as an employee(s) of UNIVERSITY and shall be promptly disclosed to and exclusively owned by UNIVERSITY regardless of the circumstances surrounding the conception and/or reduction to practice. As long as inventor(s) of an INVENTION is/are employed by COLLABORATOR and not UNIVERSITY, it shall be conclusively presumed that such INVENTION conceived of entirely by such INVENTOR(s) was made in his/her capacity as an employee(s) of COLLABORATOR and shall be promptly disclosed to and exclusively owned by COLLABORATOR regardless of the circumstances surrounding the conception and/or reduction to practice. In the event the inventors of an INVENTION are employed by UNIVERSITY and by COLLABORATOR, such INVENTION will be considered a JOINT INVENTION.
3. COLLABORATOR and UNIVERSITY agree that any computer software and its related documentation and/or databases (“Software”) resulting from the Program shall be dedicated to the public domain by waiving all rights to the Software worldwide under copyright law through the Creative Commons Zero 1.0 Universal Public Domain Declaration.
4. The PERIOD OF PERFORMANCE shall commence September 1, 2020, and expire when August 31, 2025.

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5. Notwithstanding anything in this Agreement to the contrary, any and all knowledge, know-how, practices, processes, or other information (“CONFIDENTIAL INFORMATION”) disclosed or submitted in writing or in other tangible form hereunder which is marked “Confidential Information” to either Party by the other shall be submitted to the designated representative identified in **Section 20** and maintained by the receiving Party in strict confidence and shall not be disclosed to any third party. Furthermore, neither Party shall use CONFIDENTIAL INFORMATION for any purpose other than those purposes specified in this Agreement. The Parties may disclose CONFIDENTIAL INFORMATION to employees requiring access for accomplishing the purposes of this Agreement; provided, however, that prior to making any such disclosures, the employee(s) shall be apprised of the duty to maintain CONFIDENTIAL INFORMATION in confidence and not to use such information for any purpose other than in accordance with the terms and conditions of this Agreement.

6. Nothing contained herein will, in any way restrict or impair a Party’s right to use, disclose, or otherwise deal with any CONFIDENTIAL INFORMATION which at the time of its receipt:

- (a) Is generally available to the public, or thereafter becomes available to the public through no act of the receiving Party; or
- (b) Is documented to be independently known prior to receipt thereof, or is made available to the receiving Party as a matter of lawful right by a third party; or
- (c) The receiving Party can demonstrate by means of written records to have been independently developed by the receiving Party without the aid, application or use of the other’s CONFIDENTIAL INFORMATION by receiving Party’s employees, advisors, and consultants who have not had access to the other’s CONFIDENTIAL INFORMATION; or
- (d) Is required by applicable law(s), federal or state regulation(s), or valid court order to be released; provided, however, that prior to any such release, the disclosing Party will be notified so that it may take protective measures if it deems necessary.

7. The above obligations for CONFIDENTIAL INFORMATION shall be in effect during the PERIOD OF PERFORMANCE and for a period of three (3) years from the expiration of the PERIOD OF PERFORMANCE.

8. Either Party may terminate this Agreement at any time during the PERIOD OF PERFORMANCE by giving not less than twenty (20) days prior written notice to the other Party. Either Party shall give notice of termination of this Agreement by sending written notice in accordance with **Section 20**. Such termination shall be considered effective twenty (20) days after date of mailing of the notice. Termination of this Agreement by either Party for any reason shall not affect the rights and obligations of the Parties accrued prior to the effective date of termination of this Agreement. An automatic termination of this Agreement shall occur upon the execution of a license agreement. The rights and duties of **Sections 9 and 22** of this Agreement shall survive termination of this Agreement for any reason.

9. Neither Party to this Agreement may use the name and/or trademarks, including, but not limited to, any wordmark(s), trade name(s), logo(s), and/or service mark(s), of the other or the name(s) of the other’s employees in news releases, publicity, advertising, or product promotion without the prior written permission of the other Party.

10. This Agreement may not be assigned by either Party in whole or in part without the prior written

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permission of the other Party.

11. THIS AGREEMENT SHALL BE GOVERNED BY THE LAWS OF THE STATE OF OKLAHOMA, WITHOUT GIVING FORCE AND EFFECT TO ITS CHOICE OF LAW PROVISIONS OR TO WHICH PARTY DRAFTED PARTICULAR PROVISIONS OF THIS AGREEMENT. ANY LEGAL ACTION IN CONNECTION WITH THIS AGREEMENT SHALL BE FILED IN A STATE COURT OF COMPETENT JURISDICTION IN THE STATE OF OKLAHOMA, TO WHICH JURISDICTION AND VENUE THE PARTIES EXPRESSLY AGREES.

12. If any provision(s) of this Agreement shall be held invalid, illegal, or unenforceable by a court of competent jurisdiction, the validity, legality, and enforceability of the remaining provisions shall not in any way be affected or impaired thereby.

13. This Agreement constitutes the entire agreement and understanding between the Parties and supersedes all prior and/or contemporaneous discussions, representations, or agreements, whether written or oral, of the Parties relating to the subject matter contained herein. This Agreement may only be extended, renewed or otherwise amended upon the prior, mutual written agreement of the Parties.

14. This Agreement may be executed in several counterparts, each of which shall be deemed the original, but all of which shall constitute one and the same instrument.

15. The Parties agree that this Agreement shall be binding upon their respective successors, assigns or transferees of any nature, if assignment and/or transfer is permitted in accordance with the terms of this Agreement.

16. In the performance of all matters hereunder, the Parties shall be deemed to be and shall be independent contractors and, as such, neither shall be entitled to any benefits applicable to employees of the other. Neither Party is authorized or empowered to act for the other for any purpose and shall not on behalf of the other enter into any contract, warranty, and/or representation as to any matter. Neither shall be bound by the acts or conduct of the other.

17. COLLABORATOR shall indemnify, defend, and hold harmless UNIVERSITY, its Regents, officers, agents, students, and employees from and against liability for any and all claims, demands, damages, liabilities, fines, penalties, losses, expenses, costs, and fees of any nature (e.g., attorneys' fees) including, but not limited to, bodily injury, death, personal injury, illness, product liability, property damage arising, and intellectual property infringement suits, including but not limited to, patent and/or copyright infringement, arising from COLLABORATOR's use of information or materials received from UNIVERSITY by COLLABORATOR or its officers, servants, agents, or of any third party acting on behalf of or under authorization from COLLABORATOR including without limitation, use of products, developed or made arising out of or in connection with this Agreement. UNIVERSITY will give COLLABORATOR notice of any claim it receives within ten (10) business days of receipt of a claim by UNIVERSITY.

18. UNIVERSITY agrees to be responsible for its own negligent acts and omissions and those of its employees and agents in accordance with the Oklahoma Governmental Tort Claims Act, 51 O.S. 1991 151, *et seq.*, as amended.

19. The Parties recognize that INVENTIONS or other proprietary information may arise from research sponsored in whole or in part by governmental agencies and shall be governed by the provisions of applicable law.

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20. All legal notices to UNIVERSITY, including notices of service of process, must be sent to the following address:

The Executive Secretary of the Board of Regents of the University of Oklahoma
660 Parrington Oval
Norman, Oklahoma 73019

All other notices, requests, demands and other communications required or permitted to be delivered hereunder shall be in writing. Such notices, requests, demands and other communications shall be deemed made as of the date of mailing, if given by overnight carrier service or by registered, certified, or first-class mail, postage prepaid, and addressed to the party to receive such notice or communication at the address(es) given below, or such other address as may hereafter be designated by notice in writing.

TO THE UNIVERSITY:

Regina K. McNabb
Technology Transfer Administrator
Office of Technology Commercialization
Five Partners Place, Suite 4400
201 David L. Boren Boulevard
Norman, Oklahoma 73019

TO COLLABORATOR:

Name:
Title:
COLLABORATOR:
Address:
Address2:
City, ST Zip:

21. The Parties agree to comply with all applicable U.S. export control laws and regulations in the performance of this agreement. The parties do not anticipate the need to disclose to each other technical data that are subject to control under the Commerce Control List of the Export Administration Regulations, 15 CFR 730-774, or the U.S. Munitions List of the International Traffic in Arms Regulations, 22 CFR 120-130, or Foreign Assets Control Regulations (FACR), 31 CFR 500-599, (collectively, "export controls"). In the event a party believes it is necessary to disclose technical data that are regulated under export controls, the Disclosing Party will clearly mark or otherwise identify such data as "Export Controlled" and provide sufficient notice and information, including Export Control Classification Numbers (ECCNs) and/or the Munitions List categories, to allow Receiving Party to comply with any applicable export controls. Neither party will export or reexport controlled items or technologies without first obtaining any necessary export licenses or other government approval such as qualifying for exemptions or license exceptions.

22. UNIVERSITY reserves the right to publish any and all UNIVERSITY information. UNIVERSITY shall provide COLLABORATOR a copy of such contemplated publication at least thirty (30) days prior to submission for publishing so as to allow COLLABORATOR to review such publication solely for the purpose of ensuring that publication does not compromise COLLABORATOR'S intellectual property rights or inadvertently divulge COLLABORATOR'S Confidential Information that has been furnished to UNIVERSITY under this Agreement. COLLABORATOR shall have no longer than thirty (30) days after receiving the contemplated publication to review such publication to obtain any intellectual property protection and redact any such COLLABORATOR's Confidential Information. COLLABORATOR agrees to limit disclosure of such copy to its employees solely for the purposes of review and comment unless otherwise agreed in writing by UNIVERSITY. No unreasonable delay shall be imposed on the filing, defense or publication of any student thesis or dissertation.

IN WITNESS WHEREOF, the Parties have caused these presents to be executed in duplicate as of the day and year last written herein below.

**THE BOARD OF REGENTS OF
THE UNIVERSITY OF OKLAHOMA**

COLLABORATOR

Andrew R. Pollock
Interim Executive Director
Office of Technology Commercialization

Date: _____

[Insert]
Title:
Department:

Date: _____