

Commercialization of Intellectual Property by Universities and Academic Institutions in the United States: Sample Agreements and Secondary Sources

Submitted to the Intellectual Property Court of the Russian Federation

Bruce Alexander McDonald¹

**Moscow, Russia
November 25, 2016**

Table of Contents

American Jurisprudence Legal Forms 2d

§ 196:91. Exclusive License By Research University	1
§ 196:93.70. Exclusive License From One Pharma Company to Another for Research, Development, Manufacturer and Commercialization of Products Containing Licensor's Proprietary Compounds	15
§ 196:107. Ownership of Licensed Patents and Applications – Warranty as to Ownership Except for Rights of Federal Government - University	46
§ 196:181. Licensor's Reservation of Rights – University Licensor's Reservation of Rights to Use Licensed Subject Matter for Research, Teaching, and Publication of Research Findings	47
Anawalt, Sample License Agreement Between Corporation and University	48
Bastani, <i>Technology Transfer in Nanotechnology: Licensing Intellectual Property From Universities to Industry</i> , 1 Nanotechnology L. & Bus. 166 (2004)	58
Biotechnology and the Law	
§ 10:22. Consideration – Milestone Payments / Timetables.....	66
Burkhardt, <i>Bayh-Dole Compliance in Academic Technology Transfer</i> (2011)	68
Carnegie Mellon University, Sample Agreement Between University and Corporation	77
Catholic University of America, <i>The Bayh-Dole Act of 1980 (Patent Rights in Inventions Made with Federal Assistance)</i>	96
Cohen, <i>The Research-Oriented Approach to University IP: A Reinvention of University IP Management Away From a Focus on Licensing to a Focus on Research</i> , 45 les Nouvelles 97 (2010)	100
Corporate Counsel's Guide to Licensing	
§ 4:23. Exclusive License Agreement Between Rib-X Pharmaceuticals, Inc. and Yale University	105
§ 10:29.University Licensing	108

¹ Partner, Smith, Gambrell & Russell, LLP, 1050 Thomas Jefferson St., N.W., Suite 400, Washington, D.C. 20007, tel. (202) 263-4362, bmcdonald@sgrlaw.com.

§ 22:3. Concerns When Licensing Technology From a University – Overview - Consideration	109
§ 22:4. Concerns When Licensing Technology From a University – Overview – Due Diligence.....	110
§ 22:5. Concerns When Licensing Technology From a University – Overview – Financial Risk.....	111
§ 22:6. Concerns When Licensing Technology From a University – Overview - Federal Government’s Rights	112
§ 22:7. Concerns When Licensing Technology From a University – Overview - Consideration	115
§ 22:8. Concerns When Licensing Technology From a University – Checklist for Licensing Technology From Universities	116
§ 30:5. Legal Aspects of Research and Development Licenses – Research Arrangements With Universities - Introduction	117
§ 30:6. Legal Aspects of Research and Development Licenses – Research Arrangements With Universities – Staffing of the Research Project	118
§ 30:7. Legal Aspects of Research and Development Licenses – Research Arrangements With Universities – Ownership of Project-Related Technology	119
§ 30:8. Legal Aspects of Research and Development Licenses – Research Arrangements With Universities – Restricting Disclosures to Third Parties	120
§ 30:9. Legal Aspects of Research and Development Licenses – Research Arrangements With Universities – Publications and Presentations.....	121
§ 30:10. Legal Aspects of Research and Development Licenses – Research Arrangements With Universities – Indemnification and Insurance Coverage	122
§ 30:11. Legal Aspects of Research and Development Licenses – Research Arrangements With Universities – Restrictions on Promotional Advertising	123
§ 30:12. Legal Aspects of Research and Development Licenses – Research Arrangements With Universities – Rights Regarding Additional Research Projects.....	124
§ 30:13. Licenses Involved in Research and Development: License Agreement Between Calypte Biomedical Corporation and Leland Stanford Junior University	125
§ 36:2. Text of Agreement Between Renovis, Inc. and The Regents of the University of California (2004).....	135

Corporate Counsel’s Guide to Technology Management & Transfer

§ 13:49. Technology Development Agreement	155
§ 14:24. University Technology Licensing Arrangements.....	170
§ 14:29. Sample University Licensing Agreement	172

Bruce Alexander McDonald, Submitted to Intellectual
Property Court of the Russian Federation, Nov. 25, 2016

§ 14:30. Sample License Agreement: University Research Program	186
Corporate Counsel Licensing Letters	
License Agreement Between NewLink Genetics Corporation and Lankenau Institute for Medical Research, 119 Corp. Couns. Licensing Letter 2 (2011)	198
Exclusive Patent License Agreement Between The Arizona Board of Regents on Behalf of the University of Arizona and Wildcap Energy, Inc., 123 Corp. Couns. Licensing Letter 3 (2011)	204
Exclusive License Agreement Beteen NeurogesX, Inc. and the Regents of the University of California, 104 Corp. Cpouns. Licensing Letter Article II (2009)	217
Technology License Agreement Between the Board of Trustees of the University of Illinois and Acuity Pharmaceuticals, Inc., 86 Corp. Couns. Licensing Letter Article III (2008).....	229
Daniels, <i>Keep the License Agreements Coming: The Effects of J.E.M. AG Supply, Incorporated v. Pioneer Hi-Bred International, Incorporated on Universities' Use of Intellectual Property Laws to Protect Their Plant Genetic Research</i> , 2003 B.Y.U. Educ. & L. J. 771 (2003)	240
Dawsey, <i>University Licensing: Time to Step Back, Evaluate the Institution's Mission, and Build a Brand</i> , 8 No. 5 Landslide 5 (2016)	269
Eckstrom's Licensing in Foreign and Domestic Operations	
§ 11:30. Management of Technology Licensing – University Foundation	272
§ 12:5.50. Sponsored Research Agreement – Large University – Research and Development License Agreement	273
§ 12:47. Tripartite License Agreement Involving Inventor, University, and Commercial Company – Consulting Agreement Included.....	275
§ 12:5.50. Sponsored Research Agreement – Large University – Research and Development License Agreement	273
§ 12:11. Development of Patented Inventions to Commercial Stage – Assignment and License From University to Business Corporation	290
§ 12:12. Joint University Research and Licensing Agreement	311
§ 12:12.50. Exclusive Research and Development License Agreement.....	327
§ 12:43. Stanford University License for the Cohen-Boyer Patents	345
§ 12:44. University License to a Research-Oriented Company	355
§ 12:51. License From a University to a Private Corporation	371
§ 12:52. Standard Exclusive University License Agreement	385
§ 12:52.20. Exclusive University License Agreement	401

§ 12:52.50. University Patent License Agreement.....	424
§ 14:34. Exclusive License Agreement.....	440
§ 18:15. Biotechnology Intellectual Property License Agreement	460
Model Clause 24-30[a]. Milestone Payments	493
Model Clause 28-14. Sublicenses	494
Model Clause 28-17. Sublicensing	496
Model Clause 4-11. Best Efforts; Diligence Requirements	497
§ 4:2.70. Agreements to Develop and Market New Technology – Multi-Stage and Option Arrangements; Term Sheet – Outline of Key Terms	499
§ 4:50.80. Exclusive License Agreement – Major Pharmaceutical Company	509
§ 5:45. Nonexclusive Licenses; Patent License Agreement - University	530
Model Clause 9-31.30. Sublicensing Revenue.....	551
Epstein, <i>The Commercialization of University Inventions: From Technology Transfer to Technology Partnership</i> , § 26.05 Licensing / Research Contracts, DLICA	552
Garcia, <i>University Licensing: An Introduction to Licensing Technology From Universities</i> , 11 No. 1 Cyberspace Law. 6 (2006)	568
Kim-Helms, <i>Review of Key Clauses in University / Biotechnology Industry Licensing Agreements</i> , 42 les Nouvelles 371 (2007)	574
Larus, <i>Patent Licensing and Assignment with an Eye Toward Enforcement: Tips for University Patent Owners</i> , 48 les Nouvelles 13 (2013)	590
Lindey on Entertainment, Publishing & the Arts, 3d	
§ 8:64. College and University License Agreement; One Tier	601
§ 8:65. College and University License Agreement; Two Tier	607
§ 8:89. Colleges and University License Agreement (One Tier)	615
Martin, <i>Negotiating Pharmaceutical Licensing Deal Structures: Confrontation or Common Ground?</i> 44 les Nouvelles 205 (2009)	622
Multimedia and Technology Licensing Agreements	
§ 4:30. University Patent License	627
§ 4:31. Biotech Patent and Technology License Agreement	642
Ouellette, <i>How Many Patents Does it Take to Make a Drug? Follow-on Pharmaceutical Patents and University Licensing</i> , 17 Mich. Telecomm. & Tech. L. Rev. 299 (2010)	668

Ponzio, <i>License Compliance Issues for Biopharmaceuticals: Special Challenges for Negotiations Between Companies and Non-Profit Research Institutions</i>	700
Rooksby, <i>University Initiation of Patent Infringement Litigation</i> , 10 J. Marshall Rev. Intell. Prop. L. 623 (2011)	711
Stewart, <i>The Nanotech University Spinout Company: Strategies For Licensing, Developing, Commercializing and Financing Nanotechnology</i> , 2 Nanotechnology L. & Bus. 365 (2005)	779
Wikipedia	
Bayh – Dole Act,	791
Reduction to Practice	802
Wood, <i>Launching Patent Licensing for an Emerging Company</i> , 30 U. Dayton L. Rev. 265 (2004)	804