

UNIVERSITY OF MASSACHUSETTS AT AMHERST

PARTICIPATION AGREEMENT

-- Students --

The purpose of this Participation Agreement is to assure graduate students that their interests in intellectual property developed in whole or in part by them will be protected by the University. The University's policy on intellectual property has only a minor impact on your freedom to publish your work.

If you and your co-inventors wish to protect a piece of intellectual property, it may be necessary to delay publication briefly, for example, for the purpose of filing a patent. However, if you prefer not to protect the intellectual property in question you are under no obligation to do so and may publish your results as you see fit. Of course, the University encourages all its employees to disclose and protect intellectual property, since this will better enable the University to carry out its land-grant mission and to benefit the public interest. Indeed, the University wants to be as helpful as possible in providing service and advice to inventors who wish to see their intellectual property commercialized. Our intellectual property policy applies primarily to such individuals but also recognizes that some employees may simply wish to publish their work and not be involved commercialization activities.

Therefore, in consideration of the benefits that I receive as a result of my access to University facilities, equipment, University administered funds and/or University-funded time, I agree as follows:

1. Acknowledgment. I acknowledge that I have read and understood the Intellectual Property Policy (the "Policy") of the University of Massachusetts (the "University"), a summary of which is attached to this Agreement, and I agree to abide by the terms of this Policy, as amended. The full version of the policy can be found at www.umass.edu/research/ora/intel.html. I understand that capitalized terms used in this Agreement are defined terms that, if not defined in this Agreement, are defined in the Policy.

2. Scope. I understand and agree that I will not be required to disclose or assign to the University any Intellectual Property that I may have developed before I became a student of the University ("Prior IP"). However, if I continue to work on the Prior IP while I am a student at the University, the University may claim ownership of any new Intellectual Property as described in Section 3 below. In addition, I understand that this Agreement will apply to all projects that result in the creation of Intellectual Property in which I am involved, either as a student or a student employee at the University of Massachusetts. This Agreement will terminate when I am no longer employed by the University of Massachusetts, but my obligations and benefits under this Agreement will continue with respect to any Intellectual Property that I may have developed under this Agreement.

3. Disclosure. In accordance with Section III.C.1. of the Policy, I agree to make the following disclosures to the University Office of Commercial Ventures and Intellectual Property ("CVIP") or the Vice Chancellor for Research ("VC for Research"):

- (1) I am encouraged to disclose any Inventions, Copyrightable Works (except Exempted Scholarly Works), and commercially valuable Tangible Research Materials that (i) I develop with significant use of University resources or (ii) that closely resemble a specific research project in which I am engaged at the University; however, if I intend to commercialize such Intellectual Property, disclosure is required reasonably before I take any action to commercialize such Intellectual Property. Examples of commercial actions include, without

limitation, seeking patent or copyright protection, commencing discussions with potential investors or licensees, or transferring the Intellectual Property to a third party.

- (2) I am required to disclose any Inventions, Copyrightable Works (including Exempted Scholarly Works), and Tangible Research Materials that the University has specifically hired or commissioned me to develop, except as otherwise provided in a written agreement between me and the University; and
- (3) I am required to disclose any Inventions, Copyrightable Works (including Exempted Scholarly Works), and Tangible Research Materials that I develop in the course of research funded by a sponsor pursuant to a grant or research agreement that requires such disclosure, or which is subject to a materials transfer agreement, confidential disclosure agreement, or other legal obligation requiring such disclosure.

I agree to make such disclosures promptly and in reasonable detail on the appropriate University Disclosure Form. In the case of Inventions that I intend to commercialize, I understand that I should make such disclosure reasonably prior to public disclosure of the Invention in order to provide the University with an opportunity to file a patent application.

4. Assignment of Rights. I hereby assign, transfer, and convey to the University all of my right, title, and interest in any Inventions, Copyrightable Works, and Tangible Research Materials for which the University asserts ownership under Section III.B. of the Policy. I understand that the University does not assert ownership of Exempted Scholarly Works (such as student theses and dissertations) unless such works are specifically commissioned by the University or are subject to a contractual obligation that requires assignment. I further understand the University will ordinarily waive its rights in other Copyrightable Works that the University determines are Scholarly Works. At the request of the University, I agree to execute and deliver promptly a specific assignment to the University of my right, title, and interest to such Intellectual Property, including without limitation any proprietary rights arising from patent applications or copyright registration in the United States and foreign countries. I further agree to supply the University with all information and to execute all documents necessary to obtain and maintain patents, copyrights, or other forms of legal protection for such Intellectual Property. I hereby appoint the University as my attorney to execute and deliver such documents on my behalf in the event that I should fail or refuse to fulfill my obligations under this Section within a reasonable period of time.

5. Income-Sharing; Relinquishment. I understand that, in accordance with Section III.G.1. of the Policy, I will receive a portion of all royalty income and other non-equity revenue derived from the licensing of Intellectual Property that I assign to the University. I will also have an opportunity to receive equity in a company either independently or together with the University (but not both ways). I further understand that, in accordance with Section III.C.3. of the Policy, if the University decides not to commercialize such Intellectual Property, I will have an opportunity to regain title so that I may pursue commercialization of the Intellectual Property.

6. Administrative Procedures. I understand and agree to abide by the administrative procedures for the transfer of Tangible Research Materials and Confidential Information, as set forth in the Policy.

Signature: _____

Date: _____

Printed Name: _____

Student ID Number _____

Department: _____

A Brief Description of Key Points in the University's Intellectual Property Policy

The University's Intellectual Property Policy (Doc. T96-040) is a fourteen-page document which should be read carefully by any graduate student who expects to be involved in research which could have commercial implications. There are three sections of the policy which are particularly important – Section III.B, Section III.C and Section III.G.

The first of these sections discusses the ownership of intellectual property. Basically, this section states that if you are employed by the University or make extensive use of University resources, then intellectual property developed by you through that employment or usage is owned by the University. However, you, along with any co-inventors, have rights to some of the benefits which may arise if the University commercializes the intellectual property, as will be explained shortly. Students will generally own the copyright of the text of their theses, although the University will have a royalty-free license to reproduce and publish the work.

Section III.C discusses the administrative procedures associated with inventions and copyrightable works. The University requests that if a student has made a patentable invention or created a copyrightable work he or she (along with any co-inventors) disclose this to the University so it can be protected by patent or copyright. If the inventors do not wish to protect the intellectual property in question they are, of course, free to publish it, but this will dramatically reduce the probability that the work will ever lead to a useful product or service.

Section III.C also discusses how the University evaluates the disclosure to determine whether or not the University wishes to protect the work in question. Under some circumstances the University may determine that you rather than the University are the owner of the work, and under some circumstances the University may decide that it does not want to bear the expense of protecting the work. You may then, if you wish, go through a simple process to have the work released to you and the other inventors (if any) as a group. In case of disagreement, there is an appeals process.

As mentioned above, you and your co-inventors have an interest in the proceeds which result from the commercialization of your intellectual property. This is discussed in Section III.G. Basically, 30% of non-equity income will be distributed to the inventors, with the sharing of this 30% to be agreed upon by the inventors in advance. If the University accepts equity in a company which is commercializing the intellectual property, the inventors may either elect to receive 30% of the University's equity or may negotiate directly with the company for equity, but not both.

There are other sections which discuss tangible research materials, confidentiality, appeals and so forth. As mentioned above, students with a serious interest in intellectual property matters should read the full policy carefully, since in signing the participation agreement you are agreeing to be bound by the actual

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policy, not merely by this brief summary of the policy's main features. The full policy is available on the web at <http://www.umass.edu/research/ora/intel.html>.

Individuals who desire clarification of any points in the full policy should call the campus office of Commercial Ventures & Intellectual Property.