

Intellectual Property Assignment Agreement

I, _____, hereby acknowledge that I have read the Howard Hughes Medical Institute's (HHMI's) Intellectual Property Policy (the "Policy") attached hereto. In consideration of my HHMI employment and my use of HHMI facilities and equipment, I do hereby:

- agree to abide by the Policy;
- assign and agree to assign to HHMI all of my rights in any and all subject property (as that term is defined in the Policy), including without limitation all patent, copyright and other proprietary rights that may be secured in any place under laws now or hereafter in effect, and agree to execute confirmations of such assignments and any other documents that may be requested by HHMI in connection with the subject property; and
- agree to abide by the terms of any agreement entered into by HHMI as a condition of receiving research materials or of using software or other proprietary technology, or in connection with a research collaboration, or otherwise in connection with HHMI's operations.

I understand and agree that HHMI may change the Policy from time to time and will notify me of any such changes either by email, by posting a notice on its internal website, or by such other means of notification as chosen by HHMI. I understand that such changes shall be effective once the notice has been emailed to me, posted, or otherwise communicated, but shall not apply to rights accrued prior to that time. I understand and agree that if I continue to work at the HHMI after being notified of such modifications or changes that such continued employment shall indicate my assent to and acceptance of the changed Policy.

I understand that this Intellectual Property Assignment Agreement (the "Agreement") shall continue in full force and effect unless and until HHMI and I mutually agree in writing to modify or terminate it, and such written agreement is signed by an officer of HHMI. I also understand that this Agreement shall extend to and be binding upon my heirs, personal representatives, successors, and assigns and that it extends to the successors and assigns of HHMI. This Agreement supersedes any other agreements I may have signed, or to which I may be bound, in respect of the subject matter hereof.

I have executed and delivered this Agreement on the _____ day of _____, 20____.

Signature: _____

HHMI Intellectual Property Policy

Research Policies

Intellectual Property Policy (SC-600)

Purpose

As a medical research organization, the Howard Hughes Medical Institute (“**HHMI**”) conducts scientific research in the public interest. HHMI has adopted this intellectual property policy to help ensure that inventions, discoveries, and other fruits of HHMI’s research are made available for the benefit of the public, and that the associated financial costs and rewards are fairly allocated.

Policy

1. Scope

HHMI has employees at host institutions and at Janelia Research Campus. In this policy, HHMI laboratories at host institutions are referred to as “**host-based sites**” and Janelia Research Campus, which is not a host institution or a host-based site, is referred to as “**Janelia**”. In this policy, “**subject property**” means intellectual property resulting from research by HHMI employees, alone or with others, whether or not patentable or copyrightable, and whether funded in whole or in part by HHMI. All HHMI laboratory employees at host-based sites are subject to this policy, and this policy applies to all subject property they develop.

All HHMI employees at Janelia, whether or not they work in a laboratory, are subject to this policy, and this policy applies to all subject property they develop.

Except as otherwise provided in this policy, an employee is considered to be “**at**” the HHMI location to which he or she is primarily assigned.

The share of royalties of HHMI employees who contribute to development of a subject property shall be determined in accordance with this policy.

Except as otherwise provided in this policy, all rights in subject property are owned by HHMI, and all HHMI employees are required to execute any assignment or other documents that may be requested by HHMI in connection with such subject property.

2. Agreement to Comply With Policy

Compliance with this policy is a condition of employment for all HHMI employees to whom this policy applies. Each such employee is required to sign a document memorializing his or her agreement to comply with this policy prior to commencing HHMI employment. Any failure to sign shall not affect the applicability of this policy or relieve any HHMI employee who is subject to this policy from the obligations imposed by it.

3. Employee Inventions and Use Rights

This policy does not apply to, and HHMI will not assert rights in, any invention, discovery, improvement or other tangible or intangible idea or creation that an HHMI employee develops if all four of the following conditions apply to such invention:

- It was developed entirely on his or her own time;
- It was developed with no use or only minimal use of HHMI facilities (including laboratory and office equipment, supplies, and library and other resources);
- It is not related to actual or demonstrably anticipated work of HHMI of which the employee is aware; and
- It is not related to any work performed by the employee for HHMI.

If an employee wishes to claim that HHMI does not have ownership rights in an item of intellectual property under this section, the employee must demonstrate to HHMI's satisfaction that all of these conditions have been met.

Subject to any applicable patent, copyright, or trademark rights, and subject to any obligations HHMI may have to third parties, HHMI employees shall have the right to use ideas, concepts, skills, and experience they develop or learn in the course of their HHMI employment. This right is personal, and cannot be assigned, licensed, sublicensed, or otherwise transferred to any other person.

4. Scholarly Publications, Software and Other Materials Subject to Copyright

HHMI generally will allow an HHMI employee who authors or contributes to a published scientific manuscript, journal article, student thesis, textbook, or other scholarly work to own the copyright in that work. This policy is intended to accommodate the requirement of many publishers, including most scientific journals, that copyright be assigned by the author(s) to the publisher before publication can proceed. Please note, however, that HHMI personnel at host-based sites must follow any applicable host institution policy with respect to copyrighted materials.

Although HHMI generally will allow an employee to own the copyright in a particular scholarly work, HHMI still owns all other rights, such as patent rights, in any ideas or other matter described in that work. In addition, HHMI owns all rights in any non-scholarly works created by HHMI employees in the course of their employment, such as computer software, databases, user interfaces, user or other technical manuals or documentation, and other computer-related materials, all of which are subject property under this policy.

HHMI owns all rights in works authored or co-authored by HHMI employees that are prepared for HHMI business purposes, although these are not considered subject property for purposes of the disclosure and royalty-sharing provisions of this policy. By way of example, HHMI would own all rights to any writings, photographs, videos, or sound recordings created or made by HHMI employees that are prepared for possible inclusion in an internal HHMI resource, an HHMI print publication, or on HHMI's website;

however, these materials need not be disclosed under this policy, and the HHMI employees creating these materials have no rights to share in any royalties or other revenue received with respect to these materials.

5. Agreements That May Relate to Intellectual Property

a. Materials Transfer, Research Collaboration, and Other Agreements

HHMI routinely enters into agreements with other organizations, for example as a condition of receiving research materials or of using software or other proprietary technology, or in connection with a research collaboration, or otherwise in connection with HHMI operations. HHMI employees shall abide by the terms of such agreements.

b. Agreements with Host Institutions

For host-based sites, HHMI has entered into an agreement with the host institution that generally provides for the following, among other terms, regarding intellectual property:

- It is the mutual objective of the host institution and HHMI to disseminate subject property developed at the site for public use and benefit on a nondiscriminatory basis (it is intended that this may include dissemination through exclusive licensing where necessary and appropriate);
- HHMI will assign rights in subject property developed by HHMI employees at the site to the host institution, except that HHMI retains a fully paid-up, non-exclusive, irrevocable, worldwide license to exercise any intellectual property rights with respect to the subject property for research purposes. At some of its sites, HHMI also has the right to sublicense to non-profit and governmental entities, but with no other rights to assign or sublicense;
- The host institution's technology transfer office takes the lead on licensing or other commercialization activities with respect to subject property developed at the site;
- HHMI and the host institution share expenses and income with respect to subject property; and
- The policies of the host institution with respect to sharing royalties with individual inventors apply.

HHMI personnel working at a host-based site should contact the HHMI attorney responsible for their site if they have any questions about this policy or about HHMI's procedures relating to subject property.

c. United States Government Funding

HHMI does not seek or accept research funding from the United States government. However, at host-based sites only, host institutions may apply for United States government funding for their faculty members who are HHMI investigators. HHMI personnel working at a host-based site should contact the HHMI attorney responsible for their site if they have questions about HHMI policy on whether they can be supported by a specific type of government grant.

d. Non-Government Outside Funding

As a general matter, HHMI does not seek or accept research funding from other organizations. At HHMI host-based sites, host institutions may apply to not-for-profit organizations for grant funding for their faculty members who are HHMI investigators. Any such funds are received and administered by the host institution.

In addition, at HHMI host-based sites, host institutions may seek, receive, and administer funding from for-profit companies in support of research in HHMI laboratories if the funding arrangement is consistent with HHMI's policy on [Company Funding Arrangements – Host-based Sites \(SC-350\)](#) and approved in advance by HHMI.

HHMI personnel working at a host-based site should contact the HHMI attorney responsible for their site if they have questions about HHMI policies regarding non-government outside funding.

Under limited circumstances, HHMI may accept non-government, not-for-profit research funding for research to be conducted at Janelia; see the Janelia policy on grants and awards.

e. Use of Name, Voice, Statements, and/or Likeness

HHMI may use the name, voice, statements, and/or likeness of any of its employees for all purposes of education, instruction, public information, or presentation of information about HHMI and HHMI activities, in any format and in any medium now known or later developed (including, for example, newspaper, magazine, television, radio, and the Internet) without obligation or notice to the particular employee.

6. Reporting and Management of Subject Property

a. Reporting

HHMI employees at host-based sites must disclose subject property to the appropriate office of the host institution—typically the host institution's technology transfer office—in accordance with host policies. By agreement, host institutions are required to provide HHMI with a copy of disclosures of subject property. HHMI employees at a host-based site are required to disclose to the host institution and HHMI any additional information regarding subject property as may be requested, and to sign forms confirming assignment to HHMI of their rights in the subject property and other documents as requested by HHMI. To preserve patent rights, researchers at host-based sites who are preparing to publish on what may constitute an invention or discovery may wish to consult with their host technology transfer office regarding whether patent protection should be filed for before publication.

HHMI employees at Janelia must disclose subject property to HHMI using the Report of Invention form, in accordance with Janelia policies. HHMI employees at Janelia are required to disclose to HHMI any additional information regarding subject property as may be requested, and to sign assignments and other documents as requested by HHMI. To preserve patent rights, Janelia researchers who are preparing to publish on what may constitute an invention or discovery should consult with the Janelia technology transfer office regarding whether patent protection should be sought before publication and what methods should be used to ensure the broadest dissemination and maximum adoption of such invention or discovery. Similarly, Janelia

researchers who are contemplating the release of software should consult with the Janelia technology transfer office regarding how the software will be made available.

b. Dissemination or Commercialization

At host-based sites, the host institution is generally responsible for the dissemination of subject property, in accordance with the terms of the collaboration agreement between HHMI and the host institution. If the host institution, HHMI, and any other organizations with rights in the subject property decide not to pursue dissemination or commercialization of the subject property, the inventor may be given a written release subject to HHMI's rights and applicable host institution policies.

HHMI will be responsible for dissemination of subject property developed at Janelia, including patentable inventions and inventions for which patent protection is not available or is not pursued (e.g., certain unique biological materials or computer code). Licensing of Janelia subject property will be consistent with [HHMI policies on sharing of research tools and published materials](#). If HHMI decides not to pursue dissemination or commercialization of subject property developed at Janelia, the inventor may be given a written release subject to HHMI's rights. Releases also will normally be subject to conditions such as reimbursement of HHMI for past patent expenses in the event income is subsequently received by the inventor from commercialization.

c. Division of Royalties Arising from Commercialization of Subject Property

For subject property developed at host-based sites, the host institution's policies for determination and distribution of the individual inventors' share of royalties apply.

For inventions developed at Janelia, the following principles apply:

- Inventors are those individuals who (a) with respect to an invention that includes patent rights, have been determined by HHMI to be appropriately named as inventors on a patent based on applicable patent law or (b) with respect to an invention that does not include patent rights, have been determined by HHMI to have substantially contributed to the creative conception, design, or development of the subject property.
- Inventors who are HHMI employees at Janelia are Janelia inventors.
- Inventors who are HHMI employees at host-based sites, but who made substantially all of their contribution to an invention while visiting at Janelia, will be treated as Janelia inventors subject to arrangements with the relevant host institution(s).
- Although inventors working at Janelia who are not HHMI employees are not subject to this policy and will normally not be Janelia inventors, HHMI may in its discretion make exceptions in compelling circumstances so as to allow royalty-sharing with such inventors under this policy. Exceptions, if made, will be allowed only in cases where the inventor assigns rights to HHMI. Royalty-sharing (if any) for inventors who assign rights to another institution would be handled by the other institution.

- Janelia inventors will share in the net royalties derived by HHMI from the invention.
- Net royalties are gross royalties less the costs of protecting, patenting, licensing, and enforcing rights in the invention (including all legal or other third-party fees, filing fees, taxes, and other costs) (“**licensing costs**”). Gross royalties are royalties based on percentages of net sales, and any fees paid by the licensor such as up-front license fees or maintenance fees.
- The sharing percentage applied to net royalties will be 50% to the Janelia inventors collectively, and 50% to HHMI.
- If HHMI receives equity in a company in connection with commercializing subject property, the equity will be treated as gross royalties. If, after recouping licensing costs with respect to a subject property, there remain equity holdings as part of net royalties, HHMI will distribute the Janelia inventors’ share of equity or its equivalent to them but not until either (a) it can be freely traded without restriction or (b) the equity received is being sold or otherwise liquidated.
- Where there are two or more Janelia inventors, each Janelia inventor will share equally in the inventors’ share of royalties unless all inventors agree in writing to a different distribution.
- Distributions of the Janelia inventors’ share will be made at least annually for each year in which there are net royalties to distribute. When calculating distributions, HHMI will reserve funds to pay for expected future patenting and licensing costs. Ultimately, 50% of royalties remaining after all patenting and licensing costs are paid will be distributed to Janelia inventors according to the policy.
- Royalty-sharing with a Janelia inventor under this policy continues if the inventor is no longer at Janelia.

d. Enforcement of Intellectual Property Rights

HHMI employees are required to provide to HHMI all cooperation that HHMI deems necessary or desirable to secure and enforce institutional rights in subject property. This may include, without limitation, providing assistance to counsel in filing patent applications or other legal documents, providing testimony or otherwise participating in legal proceedings, and reviewing and signing legal documents during and after employment with HHMI. Such cooperation is a condition to receiving any royalties.

7. Confidentiality of Research Results and Operations

HHMI employees are expected to respect the confidentiality of unpublished research results generated in HHMI laboratories, consistent with standard practice in the academic research community.

In addition, HHMI employees generally should not disclose outside of HHMI information about HHMI’s research operations that they know or reasonably should know is of a

confidential or sensitive nature, without the approval of HHMI management. Examples include information about security features of HHMI facilities and systems, vendor pricing, and other information typically subject to confidentiality requirements. In some cases this information may need to be shared with other organizations with which HHMI has a business relationship, such as a host institution, an insurance carrier, or a contractor; care should be taken that disclosures are appropriately limited and will be kept confidential by the recipient organization.

8. Administration of Policy on Intellectual Property

a. Interpretation of Policy

Questions of interpretation concerning this policy shall be submitted to the Vice President and General Counsel.

b. Termination or Revision of Policy

This policy may be changed at any time by HHMI in its discretion. Such changes shall not affect rights accrued prior to the date of the change. Rights with respect to a subject property shall begin to accrue when the subject property is first conceived or fixed in a tangible medium of expression.

c. Effective Date

This Policy is effective June 29, 2012, and supersedes any previous policies and guidelines regarding intellectual property to the extent that they are inconsistent with this policy.

Issued by: Office of the President

Date: June, 2012