

Sponsored Design Research Agreement with the OEDK

The **Sponsored Design Research Agreement** is a mechanism under which companies can sponsor an undergraduate engineering design project at the Oshman Engineering Design Kitchen and own resulting intellectual property, if any, that results from the project.

- Sponsors will work with faculty to develop a specific project definition to pitch to students at the start of the course.
- Often companies chose to offer mentoring to the team, usually through an assigned engineer who will meet with the team regularly- on the phone or in person.
- At the conclusion of the project sponsors will own the IP that the students developed as part of their course-work while working on the design challenge.
- This sponsorship is \$12,000 or \$15,000 (depending on company size or nonprofit status) for capstone or two-semester long projects, or \$5,000 or \$6,500 (depending on company size or nonprofit status) for underclassman or one-semester long projects). Both of which is used to directly support the design team's efforts as well as to supply and maintain the OEDK facility.
- **Agreement is 'turn-key.' As such, the terms are not negotiable.** We have worked hard to meet the needs of our many corporate sponsors. For the value of the agreement, it is not possible to engage in negotiations over details in this agreement. The primary purpose of the agreement is to facilitate the ownership issues over IP while offering our students excellent real-world design challenges to enhance their engineering education. Occasionally, novel IP is developed. Our sponsors most often engage in a sponsored agreement in order to simplify the issues around IP if novel IP is developed in the course of the project.
- Project will be offered to the appropriate course for students to select. Agreement will only be executed if a team of students is formed.

Benefits: This kind of sponsorship is a wonderful opportunity to get a company and projects that are of particular interest to that company in front of senior engineering students at Rice University. These projects contribute significantly to the education of our students and can also serve to make the students aware of the work of the sponsor companies.

- Team of 4-6 students will work on a specific project of interest to their sponsor over the course of one academic year.
- Team will design, build and evaluate a prototype solution to the challenge which can go to the sponsor at the end of the year
- Team will submit a final report to the sponsor
- Company logo prominently on the wall at the OEDK, on the team's web page and shown at OEDK events as an OEDK team sponsor
- Sponsor will own the IP, if any, created while working on this project. As such the sponsor may choose to file patents, including the students as inventors, continue the work on the project, or otherwise protect any novel IP. Students agree to provide timely information on their projects as needed by the company.

Non-disclosure agreements:

- We encourage sponsor companies to NOT divulge confidential information to student teams or faculty.
- There is a Non-Disclosure Agreement built in to the primary contract. Rice will educate the students on the particular clauses of this agreement and will remind the students at all times to maintain confidentiality. We ask the company sponsors to alert course faculty and OEDK director if any confidential information has been disclosed to students so that we can be even more vigilant in ensuring these clauses are understood and flowed.

Timeline:

Mid-April to Mid-July	Faculty and OEDK seek design project ideas from prospective sponsors
Mid-July	<p>Project definitions for sponsored design research agreements completed or near completion. Sponsor will work with faculty in specific courses to draft the project so that it meets the needs of the sponsor and the course. Templates are available for many courses.</p> <p>All relevant information for Rice to prepare agreement contract is provided by company. Rice will provide contract to sign as quickly as possible after information is received.</p> <p>PLEASE FILL OUT THIS FORM: http://oedk.rice.edu/IP-ContactForm</p>
Mid-August	Company returns signed Sponsored Design Research Agreement. Without this agreement having been signed by sponsor, we will be unable to present the project to students for the fall semester
Mid-August (due date determined by faculty)	Sponsors may provide <5 minute video pitch about project. Students will be able to view all project pitches before selecting their top choice projects.
Mid-August (due date determined by faculty)	Project options, descriptions and 5 minute project pitches videos (if sponsor chooses to prepare) are provided to appropriate students.
Mid-August (due date determined by faculty)	Classes Begin
First week of class – usually last week of August	Sponsor Fair at OEDK for BIOE, ECE, MECH projects. Other departments may vary
~Early September	Teams Formed, Rice executes previously signed agreements for project that have formed teams, Students and faculty sign Participation Agreements, Projects begin.
~Late September	Students present Project Pitches
~Early November	Elevator Pitch Competition – optional for students
~December	Design Reviews
~February	Prototype Evaluations; Students provide sponsors with invention disclosure documents so that company can protect IP, if desired before public disclosure in April.
Mid-April	Design Showcase – PUBLIC DISCLOSURE OF DESIGN

The agreement template is included on the next pages. Rice will prepare the contract for signatures once all the relevant information is received.

WILLIAM MARSH RICE UNIVERSITY
SPONSORED DESIGN RESEARCH AGREEMENT

Oshman Engineering Design Kitchen

Agreement No. OEDK-FY<year>-_____

THIS SPONSORED DESIGN RESEARCH AGREEMENT ("Agreement"), dated as of <date>, ("Effective Date"), is made and entered into by and between _____ with a principal address at _____ ("Sponsor"), and William Marsh Rice University, a Texas non-profit corporation, with a principal address at 6100 Main Street, Houston, TX 77005 ("Rice"), with reference to the following:

- A. Sponsor is interested in scientific design research related to _____, as further described in Exhibit A ("Engineering Design Project"), and Rice has certain students in undergraduate engineering design classes interested in conducting scientific design research related to the Engineering Design Project.
- B. The Engineering Design Project contemplated by this Agreement is of mutual interest to Sponsor and Rice, and furthers Rice's educational, scholarship and research objectives as an institution of higher education.
- C. Sponsor desires to fund and support, and Rice desires to conduct, the Engineering Design Project contemplated by this Agreement subject to the provisions set forth herein.

NOW, THEREFORE, in consideration of the foregoing, the provisions set forth herein and the mutual benefits to be derived here from, and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Sponsor and Rice agree as follows:

SECTION 1. DEFINITIONS

- 1.1 "Course Director" shall mean Z. Maria Oden. The Course Director shall direct the Project Team, as defined below, in conducting the Engineering Design Project.
- 1.2 "Faculty Advisor" shall mean the faculty member who mentors the Student Project Team, as defined below.
- 1.3 "Intellectual Property" shall mean all patentable discoveries and inventions and software created during the Project Period by the Student Project Team, as defined below, and directed toward the Engineering Design Project.
- 1.4 "Intellectual Property Protections" shall mean the registration, application, filing, prosecution or maintenance of a patent or copyright for Intellectual Property.
- 1.5 "Project Funds" shall mean a non-refundable payment to be made by Sponsor to Rice to support the Engineering Design Project in the amount of _____ (\$ amount).
- 1.6 "Project Period" shall mean the period commencing as of <project dates>. The Project Period may be extended for additional semesters by written agreement of duly authorized representatives of Sponsor and Rice.
- 1.7 "Project Team" shall mean the Course Director, Faculty Advisor and the Student Project Team.
- 1.8 "Student Project Team" shall mean the undergraduate students conducting the Engineering Design Project.

SECTION 2. PROJECT FUNDS

Sponsor shall make full payment of the Project Funds within 30 days of the delivery of an invoice for such funds. Invoices shall be sent via e-mail to Sponsor's Financial Contact, as identified in Section 8. Payment shall be in U.S. dollars and be made by check payable to William Marsh Rice University and delivered to Rice's Financial Contact, as identified in Section 8.

SECTION 3. PUBLICATIONS AND PRESENTATIONS; OTHER RESEARCH RIGHTS; NAME AND LOGO USE

- 3.1 Publications and Presentations. Sponsor acknowledges that Rice and the Project Team members shall have the right to publish or otherwise publicly disclose at academic and professional conferences and other meetings the results of the Engineering Design Project, subject to the following limitations. A draft copy of the proposed publication or public presentation (except for student theses and dissertations) shall be provided to Sponsor for its review at least 30 days prior to submission for publication or public presentation. During such 30 day period, Sponsor may request that Rice delay the proposed publication or public presentation for up to an additional 30 days to allow for patent or copyright filings or other matters related to the protection of Intellectual Property. In addition, Sponsor may suggest changes to the proposed publication or public presentation, but the author shall retain final authority; provided, however, that the author shall be obligated to remove any Confidential Information furnished by Sponsor pursuant to Section 6 below. Notwithstanding anything in this Agreement to the contrary, copyrights in publications, public presentations and other scholarly writings shall be owned by their respective authors.
- 3.2 Other Research Rights. Sponsor acknowledges that this Agreement shall not be construed to limit the freedom of Rice or the Project Team members to engage in any other research. Notwithstanding any assignment to Sponsor of ownership of the Intellectual Property, Rice shall retain an irrevocable worldwide right to use and transfer such Intellectual Property on a non-exclusive royalty-free basis for research and education purposes, including collaborations with other researchers. Rice shall further retain the right to publish and disclose any results of such other research.
- 3.3 Name and Logo Use. Neither Sponsor nor Rice shall use the other party's name, trademarks or other logos, or the names of any individuals involved in the Engineering Design Project, including, but not limited to, the Project Team members, in any publication or public presentation without the prior written consent of such other party. The foregoing restriction shall not apply to the inclusion of an acknowledgment of Sponsor's funding of the Engineering Design Project in any such publication or public presentation. Notwithstanding the above, each party has the right to post on their websites that this award to Rice has been made and include a short public abstract.

SECTION 4. ASSIGNMENT OF INTELLECTUAL PROPERTY

Student Project Team members shall assign ownership of the Intellectual Property pursuant to the Participation Agreement attached hereto as Exhibit B. This assignment shall not include any right to use any other Rice owned or licensed, or third party owned or licensed, intellectual property. Furthermore, this assignment shall remain subject to Rice's research and publication rights as contemplated under Section 3 above.

SECTION 5. DISCLAIMER OF WARRANTIES; LIABILITY LIMITATION; INDEMNIFICATION; EXPORT COMPLIANCE

- 5.1 Disclaimer of Warranties. Notwithstanding anything in this Agreement to the contrary, Rice makes no representations or warranties of any kind, express or implied, concerning the results of the Engineering Design Project or any related Intellectual Property,

including, but not limited to, representations and warranties as to non-infringement, merchantability and fitness for any particular purpose.

- 5.2 Liability Limitation.** Rice shall not be liable for any direct, indirect, incidental, consequential, special or other economic damages, such as loss of anticipated business or profits, suffered by the other party in connection with this Agreement, the Engineering Design Project or any related Intellectual Property, including, but not limited to, any use or commercialization thereof.
- 5.3 Indemnification.** Notwithstanding anything in this Agreement to the contrary, Sponsor shall indemnify, hold harmless and defend Rice (including, but not limited to, its trustees, officers, employees, agents and representatives, and the Project Team members) for, from and against any and all demands, claims, causes of action, damages, losses, liabilities, costs and expenses (including, but not limited to, attorney's fees and court costs), of any nature (including, but not limited to any property damage or loss, bodily injury or death, patent or copyright infringement or product liability or defect) directly or indirectly arising as a result of or in connection with Sponsor's use or commercialization of the results of the Engineering Design Project or any related Intellectual Property, whether arising at law or in equity, and whether under contract, tort or strict liability principles. Sponsor's defense obligations shall be with attorneys approved by Rice, which approval shall not be unreasonably withheld.
- 5.4 Sponsor's Export Compliance.** All rights granted to Sponsor in connection with this Agreement, the Engineering Design Project and any resulting Intellectual Property are subject to compliance with U.S. laws and regulations controlling the export of technical data, computer software, laboratory prototypes and other commodities. Sponsor shall not, directly or indirectly, export any such controlled commodities in connection with this Agreement, the Engineering Design Project or any resulting Intellectual Property, unless the required authorization and/or license is obtained from the proper governmental authorities prior to export. By granting Sponsor rights in this Agreement, the Engineering Design Project and any resulting Intellectual Property, Rice does not represent that an export authorization and/or license will not be necessary or, if necessary, that such authorization and/or license will be granted.

SECTION 6. SPONSOR'S CONFIDENTIAL PROPRIETARY INFORMATION AND DESIGN LICENSE

- 6.1 Definition.** The term "Confidential Information" shall include all information disclosed by Sponsor to the Project Team in any manner or media. Any Confidential Information disclosed by Sponsor must be marked as 'confidential' at the time of disclosure or, if disclosed orally or visually, must be identified as such at the time of disclosure and reduced to written, printed or other tangible form, marked as 'confidential' and delivered to the Course Director, in accordance with Section 8, within ten (10) days from the date of disclosure.
- 6.2 Limitations on Disclosure and Use.** The Project Team shall, for a period of three (3) years after receipt of the Confidential Information, hold all Confidential Information in strictest confidence and shall not record, reproduce, reference, disseminate or disclose any part thereof in any manner or media without the prior written consent of Sponsor. The Project Team shall use all Confidential Information solely for the purpose of the Engineering Design Project and not for the benefit of any other person or entity.
- 6.3 Permitted Disclosures.** The Project Team shall not be required to keep confidential any Confidential Information that (i) is already available without restriction to the general public, (ii) becomes available without restriction to the general public through no act or omission of the Project Team or any breach of this Agreement, (iii) is independently obtained by the Project Team without being subject to any confidentiality obligation, or (iv) is required to be disclosed by the Project Team in order to comply with any subpoena or other mandatory legal process or requirement. Prior to disclosing any information pursuant to clause (iv) above, the Project Team shall provide (if legally permitted under the circumstances) the Sponsor with prompt prior written notice of such request or requirement so that the Sponsor may seek a protective order or other legal protection of such

disclosure.

- 6.4 This Agreement shall not be deemed to grant or convey to the Project Team any license or other right to any Confidential Information. The Project Team shall deliver to Sponsor all manifestations in any manner or media (including, but not limited to, all copies and other reproductions and recordings) of Confidential Information upon the earlier to occur of (i) a request by the Sponsor or (ii) the expiration or termination of this Agreement.
- 6.5 Sponsor shall inform Rice prior to the disclosure of any Confidential Information of Sponsor that is restricted from export from the United States (including, but not limited to, deemed export to foreign nationals in the US) and Rice shall have the option to refuse receipt of such Sponsor Confidential Information.
- 6.6 Sponsor's Design License. Sponsor grants to Rice a non-exclusive, non-transferable, non-royalty bearing license to use and make derivative works of Sponsor's Intellectual Property solely for the purpose of conducting the Engineering Design Project under this Agreement.

SECTION 7. TERMINATION; ACTIONS UPON TERMINATION; SURVIVAL OF OBLIGATIONS

- 7.1 Termination. This Agreement may be terminated prior to the expiration of the Project Period as follows:
 - (a) By written agreement of the parties, effective upon the date set forth in such agreement;
 - (b) By Rice, if Project Funds are not received in accordance with Section 2;
 - (c) By either Sponsor or Rice in the event the other party fails to cure any material breach of this Agreement, other than 7.1 (b) above, within 30 days after receipt of written notice of such breach from the terminating party, effective upon receipt of written notice from the terminating party, after the expiration of the 30 day cure period; and
 - (d) By either Sponsor or Rice in the event the Faculty Advisor is no longer able to conduct the Engineering Design Project on behalf of Rice, effective upon receipt of written notice from the terminating party, unless both parties agree upon a mutually acceptable replacement.
- 7.2 Survival of Obligations. Notwithstanding anything in this Agreement to the contrary, the provisions of Sections 3, 4, 5 and 6 shall survive any expiration or termination of this Agreement, and each party shall remain obligated under any other provisions that expressly or by their nature survive any expiration or termination of this Agreement.

SECTION 8. NOTICES

Any notice or other communication of the parties required or permitted to be given or made under this Agreement shall be in writing and be deemed effective upon receipt if delivered personally, by reputable courier, by facsimile or electronic transmission, or by certified registered mail, postage prepaid, return receipt requested, addressed to the other party as follows (or as changed by written notice pursuant to Section 8):

SponsorContractual and Administrative:

Phone:

Email:

Technical:

Phone:

Email:

Financial:

Phone:

Email:

RiceContractual and Administrative:

Asha Rajagopal
Office of Technology Transfer
Rice University
6100 Main Street, MS-705
Houston, TX 77005
Phone: 713.348.6231

Email: techtran@rice.edu

Technical:

Z. Maria Oden
Oshman Engineering Design Kitchen
Rice University
6100 Main Street, MS-390
Houston, TX 77005
Phone: 713.348.4156
Email: moden@rice.edu

Financial:

Amy Kavalewitz
Oshman Engineering Design Kitchen
Rice University
6100 Main Street, MS-390
Houston, TX 77005
Phone: 713.348.8065
Email: amy.k@rice.edu

SECTION 9. MISCELLANEOUS

- 9.1 Power and Authority; Due Authorization; No Conflict; Enforceability; Binding Effect. Each party represents and warrants to the other party that (i) such party has the power and authority to execute, deliver and perform its obligations under this Agreement, (ii) the execution, delivery and performance of this Agreement have been duly authorized by such party and does not and shall not conflict with any agreement or instrument to which it is bound, (iii) this Agreement constitutes the legal, valid and binding obligation of such party, enforceable against it in accordance with its terms, and (iv) this Agreement, and the interests, rights, duties and obligations hereunder, shall be binding upon, and inure to the benefit of, the parties and their respective successors and permitted assigns.
- 9.2 Entire Agreement; Further Assurances. This Agreement, including Exhibits A and B attached hereto, constitutes the entire agreement between the parties, and supersedes any prior or contemporaneous negotiations, understandings and agreements, with respect to the subject matter hereof. In addition, the terms of any purchase order or other purchasing document issued for this Engineering Design Project, and prepared and executed subsequent to signing this Agreement, shall not be applicable to this Agreement other than to provide for funding as identified herein. Each party shall execute and deliver such further documents and take such further actions as may be required or reasonably requested by the other party to effectuate the purposes of this Agreement.
- 9.3 No Assignment; No Amendment; No Waiver. This Agreement (i) may not be assigned or transferred, in whole or in part, by operation of law or otherwise, by either party without the prior written consent of the other party, and (ii) may not be amended or modified, by course of conduct or otherwise,

except in a writing duly executed by the authorized officials of each of the parties. Any waiver of any provision of this Agreement shall be in writing duly executed by the waiving party. The failure or delay by either party to seek redress for any breach or default under this Agreement, or to insist upon the strict performance of any provision of this Agreement, shall not constitute a waiver thereof or of any other provision of this Agreement, and such party shall have all remedies provided herein and at law and in equity with respect to such act and any subsequent act constituting the same.

- 9.4 Force Majeure; Remedies Cumulative. Either party's delayed performance under this Agreement may be temporarily excused without liability, if such delay is a result of causes or conditions beyond that party's control and without that party's fault or negligence (such causes or conditions specifically do not include the financial incapacity to pay); provided, however, that such party must diligently pursue actions to remedy such cause or condition. The rights and remedies provided in this Agreement are cumulative in nature and shall be in addition to any such other rights and remedies available at law and in equity.
- 9.5 Resolution of Disputes. In the event of any dispute or disagreement between the parties either in interpreting any provision of this Agreement or about the performance of either party and upon the written request of either party, each of the parties will appoint a designated representative to attempt to resolve such dispute or disagreement. The designated representatives will discuss the problem and negotiate in good faith in an effort to resolve the dispute without any formal proceedings. The specific format of such discussion shall be left to the discretion of the designated representatives. No litigation for the resolution of such dispute may be commenced until the designated representatives have met and either party has concluded in good faith that amicable resolution through continued negotiation does not appear likely (unless either party fails or refuses to appoint a designated representative and schedule a meeting of such representatives within thirty (30) days after a request to do so by the other party).
- 9.6 Governing Law; Jurisdiction and Venue; Attorneys' Fees. This Agreement shall be governed by, and construed and enforced in accordance with, the laws of the United States and the laws of the State of Texas (without regard to the conflicts or choice of law principles thereof). Sponsor and Rice irrevocably consent to the jurisdiction of the State of Texas, and agree that any court of competent jurisdiction sitting in Harris County, Texas, shall be an appropriate and convenient place of venue to resolve any dispute with respect to this Agreement. In the event either party commences any proceeding against the other party with respect to this Agreement, the prevailing party (as determined by the authority before whom such proceeding is commenced) shall be entitled to recover reasonable attorneys' fees and court costs as may be incurred in connection therewith in addition to any such other relief as may be granted.
- 9.7 Severability. In the event any provision of this Agreement is determined to be invalid or unenforceable, it is the desire and intention of the parties that such invalidity or unenforceability not invalidate or render unenforceable the remainder of the Agreement and that such provision be reformed and construed in such a manner that it will, to the maximum extent practical, be deemed valid and enforceable, and the rights and obligations of the parties hereto shall be construed and enforced accordingly.
- 9.8 Construction of Agreement. The provisions of this Agreement shall not be construed more favorably toward one party than the other party as a result of one party being the primary drafter of the Agreement. This section and other headings in this Agreement are for convenience of reference only and shall not affect, expressly or by implication, the meaning or interpretation of any of the provisions hereof.
- 9.9 Independent Contractor Relationship; No Third Party Beneficiaries. Sponsor and Rice intend that their relationship under this Agreement shall be as independent contractors, and neither Sponsor nor Rice shall conduct themselves in a manner inconsistent with such independent contractor status. Nothing in this Agreement nor any performance hereunder is intended, or shall be construed, to create a partnership, joint venture or other form of business enterprise, or relationship of agency or employment, between Sponsor and Rice (including, but not limited to, the Course Director and the other Project Team members). Moreover, neither party shall have the authority to enter into contracts on behalf of the other party. Nothing in this Agreement, express or implied, is intended to

confer, any benefits, rights or remedies on any person, other than the parties hereto and their successors and permitted assigns.

9.10 Counterparts. This Agreement may be executed in multiple counterparts, each of which shall be deemed an original, but all of which taken together shall constitute one and the same instrument.

IN WITNESS WHEREOF, Sponsor and Rice have each duly executed and delivered this Agreement as of the date first written above.

William Marsh Rice University

By: _____

By: _____

Print: _____

Asha Rajagopal, Ph.D.

Title: _____

Director, Office of Technology Transfer

Exhibit A
Engineering Design Project

See Following Page

DELIVERABLES:

- Final Design Report - A final technical report shall be submitted to Sponsor at the conclusion of the Engineering Design Project.
- Prototype – A prototype developed by the Student Project Team in the course of their work on the project at its state of completion at the end of the Project Period.

**William Marsh Rice University
Oshman Engineering Design Kitchen
Sponsored Design Project Participation Agreement**

1. I hereby assign to Sponsor all right, title, and interest to any intellectual property invented, created, or developed by me in connection with the Project;
2. I hereby waive my rights under Rice University Policy 333 (including any University interpretation thereof) to own any intellectual property invented, created, or developed by me in connection with the Project, to participate in the development and commercialization efforts related thereof, and to share in any revenues related to any such development and commercialization efforts;
3. I will not incorporate any Intellectual Property resulting from research conducted by me (1) in another Rice class, (2) in any research project at Rice, or (3) using Rice equipment, laboratory or facilities other than in the Engineering Design Project Class into Intellectual Property invented, created or developed by me while conducting the Engineering Design Project;
4. I will maintain in confidence and use all Sponsor Confidential Information disclosed to me in connection with this Engineering Design Project in accordance with Section 6 of the Sponsored Design Research Agreement; and
5. I will execute and deliver such other documents and take such other actions as are necessary or reasonably required to allow Rice to fulfill its obligations to the Sponsor as set forth in the attached Sponsored Design Research Agreement.

[illegible]