

AGREEMENT RELATING TO INTELLECTUAL PROPERTY

During and within the scope of my employment or other affiliation with the New Jersey Institute of Technology (NJIT), I may engage in research or scholarly endeavors which result in inventions, discoveries or the creation of work product which constitutes intellectual property (IP) and is subject to NJIT policy governing same. By way of illustration, this includes works which are or may be eligible for patent, copyright or trademark protection, or may form the basis for “know-how” or trade secrets.

I understand that I receive support from NJIT in a variety of forms, such as salary, imputed compensation, usage of equipment, dedicated personnel, materials, offices and facilities that are available and may lead to the creation of IP during my employment at, or affiliation with NJIT. I also understand that I may participate in research, funded by grants or contracts with government agencies, corporations, foundation or other third parties who may directly or indirectly sponsor my activities. I further understand that these grants or contracts usually require that NJIT protect sponsoring agency rights to IP that may result from such sponsored research or activities.

As such, I hereby acknowledge that NJIT has an uncompromisable responsibility to secure, whether for itself or for sponsoring agencies, title to all IP resulting from research, work products and/or discoveries conceived and/or made by me either with substantial use of NJIT resources or within the scope of my employment, as defined by NJIT policy, including patent and copyright policy.

Accordingly, as consideration for and as a term of, my employment/affiliation, I agree that I am under a continuing obligation to abide by NJIT IP policies, specifically including its Patent, Copyright, Trademark and Trade Secret policies, and furthermore, hereby agree, for all inventions, discoveries or other creations made either within the scope of my employment or through substantial use of NJIT resources, to assign to NJIT and/or sponsoring agencies (as applicable), all rights to IP, including patents, trademarks or applicable copyrights, and agree to affirm NJIT and/or applicable sponsoring agency ownership of all “know-how” and trade secrets.

Therefore, I specifically agree that I will:

1. Promptly disclose, through a fully completed NJIT authorized and provided invention disclosure form, to the Office of Technology Development (OTD), its express designee or successor in interest, the information concerning inventions, discoveries or other creations that I may make, for evaluation as to ownership, as well as determination of the feasibility of filing for protection and engaging in commercialization of the IP;
2. Assign to NJIT, or its designee, all of my right, title or interest to such inventions, discoveries or other creations which may be protected by patent applications, issued patents, copyright protections, trade secrets, “know-how” or trademark protections;

3. Execute, upon request of NJIT, any document necessary and proper to secure the issue of letters patent, United States or foreign, and for securing any other rights in IP, including trademark or copyright;
4. Prevent, to the extent reasonably within my control, dissemination, publication or disclosure of patentable or otherwise protectable inventions or discoveries until NJIT has examined the invention or discovery for purposes of protection of the IP policies and has either: (a) take formal legal action, such as filing in the United States Patent Office, for letters patent on the submitted invention disclosure; or (b) explicitly given me, through its authorized agents, written permission to disseminate, publish or disclose the invention or discovery;
5. Assist in any other activities that relate to the affirmation and procurement of all manner of IP rights, including, but not limited to, cooperation solely with NJIT designated legal counsel in patent prosecution and IP litigation;
6. Cooperate fully with OTD in any NJIT evaluation and/or commercialization efforts or other authorized evaluation and commercialization programs as needed;
7. Covenant not to withhold, from OTD, potential inventions, discoveries and/or creations which were created within the scope of NJIT's IP policies, specifically including the Patent, Copyright and Trademark policies, and further pledge not to commercialize, or cause or permit others to commercialize, any aspect of potential inventions, discoveries or creations which were created within the scope of NJIT's IP policies, except where explicitly authorized in writing by the Executive Committee for Technology Development (ECTD).
8. Covenant not to incorporate, into work done during my employment/affiliation with NJIT, any third party IP to which I do not have proper rights of use;
9. Attest that I am presently not under any restrictions from any previous employers nor any contractual agreements to which I am a party, pertaining to any field of work that I will be engaged in during my employment/affiliation with NJIT that have not been formally, explicitly disclosed to OTD, or its express designee or successor in interest;
10. Hereby record, on the attached Schedule A, a listing of all previously filed IP, specifically including patents and registered copyrights where I was an inventor, assignee or owner of interest.

I understand that NJIT's IP policies provide for sharing of income arising from inventions, discoveries or patents that I assign to NJIT under this Agreement. I understand that such sharing and other policies and practices that are set forth in NJIT's IP policies, may properly change from time to time, and as such, I agree to abide by the terms in effect at the time of receipt by OTD of a completed, timely filed disclosure of an invention or discovery.

Also, I understand that, from time to time NJIT's IP policies or any one or more of them may be amended. Accordingly, I agree to abide by the controlling policy at the time of the invention or discovery, and I understand that I may be asked to sign annual certifications relating to intellectual property that are consistent with such policy(ies) during my employment/affiliation with NJIT. Furthermore, I understand that portions of this Intellectual Property Agreement, such as the obligation to assist with patent application and/or prosecution resulting from an invention disclosure, which I may submit under the obligations of NJIT Patent Policy, will survive the term of my employment/affiliation with NJIT.

SIGNED,

DATE:

Signature

PRINT FULL NAME, TITLE AND DEPARTMENT/CENTER:

Name/Title

Department/Center

Return completed form(s) to the Office of Legal and Employment Affairs, Cullimore Hall, Room 211.

SCHEDULE A

PATENTS (Pending/Issued):

- 1). Title: _____
Patent Number/Application No. _____
Inventor(s) _____
Assignee(s): _____

- 2). Title: _____
Patent Number/Application No. _____
Inventor(s) _____
Assignee(s): _____

- 3). Title: _____
Patent Number/Application No. _____
Inventor(s) _____
Assignee(s): _____

- 4). Title: _____
Patent Number/Application No. _____
Inventor(s) _____
Assignee(s): _____

REGISTERED COPYRIGHTS

- 1). Title of Work: _____
Filing No: _____
Creator(s): _____
Assignee(s): _____
Was This Software? _____ Yes _____ No

- 2). Title of Work: _____
Filing No: _____
Creator(s): _____
Assignee(s): _____
Was This Software? _____ Yes _____ No

- 3). Title of Work: _____
Filing No: _____
Creator(s): _____
Assignee(s): _____
Was This Software? _____ Yes _____ No