INTER-INSTITUTIONAL AGREEMENT
between
STC.UNM and EASTERN NEW MEXICO UNIVERSITY

This Inter-Institutional Agreement ("Agreement") is made as of the Effective Date by and between STC.UNM, a New Mexico nonprofit corporation, with its principal office at 801 University Blvd. SE, Suite 101, Albuquerque, New Mexico 87106 ("STC") and Eastern New Mexico University with its principal office at 1500 S Avenue K, Portales, NM 88130 ("Institution") (each a "Party" and collectively the "Parties"). In consideration of the mutual covenants contained herein, the Parties agree as follows:

1. Background. Eastern New Mexico University is the sole owner of the Invention and the related Patent Rights described on attached Schedule 1. STC has relationships that would be valuable in commercializing the Invention and the Patent Rights. Each of the Parties therefor has an interest in: (a) procuring and maintaining the Patent Rights; and (b) licensing the Patent Rights to third parties with the ability to commercialize the Patent Rights, thereby providing public benefit from the Invention and the Patent Rights. The Parties acknowledge and agree that their respective interests are best served and advanced by entering into this Agreement with respect to the prosecution, maintenance and commercialization of the Patent Rights. A Capitalized term used in this Agreement and not defined elsewhere in this Agreement shall have the meaning ascribed to it in the attached Glossary.


   (a) As of the Effective Date, Institution grants to STC the exclusive right, power, and license to: (i) prosecute and maintain the Patent Rights; and, (ii) to market, negotiate, and enter into Sublicense Agreements and Option Agreements, each in accordance with this Agreement. STC shall be responsible for preparing, filing, prosecuting and maintaining the Patent Rights. STC shall make decisions regarding the filing and prosecution of the Patent Rights and the payment of Patent Procurement Fees in its sole discretion, but shall consult with and keep Institution informed as to the preparation, filing, prosecution and maintenance of the Patent Rights, and will obtain Institution’s prior written consent before incurring Patent Procurement Fees in excess of $5,000, and again before each $5,000 interval in such Patent Procurement Fees thereafter. If Institution does not consent to the additional $5,000 interval of Patent Procurement Fees, STC, at its option, may either terminate this Agreement or pay the Patent Procurement Fees. In the event that STC elects to pay such Patent Procurement Fees, Institution shall not have any obligation to reimburse STC for such Patent Procurement Fees, but STC may be reimbursed for such Patent Procurement Fees under a Sublicense Agreement or an Option Agreement. Without limiting the foregoing, STC will provide Institution with copies of any applications filed with the USPTO and in any foreign jurisdiction and any correspondence or notifications received from the USPTO or the foreign jurisdiction or any filings made in the USPTO or with the foreign jurisdiction with respect to such Patent Rights. STC will retain counsel of its choosing to prepare, file, and prosecute the Patent Rights.
(b) STC shall pay the Patent Procurement Fees. Institution shall reimburse STC for all Patent Procurement Fees, other than Patent Procurement Fees not consented to by Institution under Section 2(b), above, within thirty (30) days after receipt of an invoice from STC for such fees. With respect to foreign jurisdiction filing, prosecution, and maintenance of Patent Rights, Institution may at any time notify STC that Institution does not wish to share the Patent Procurement Fees in one or more specified foreign jurisdictions, in which event, the provisions of subsection (d), below shall apply.

(c) The Parties agree to cooperate with each other and will execute and deliver any information, documents or instruments reasonably necessary with respect to the preparation, filing, and prosecution of patent applications and the maintenance of the Patent Rights.

(d) In the event that: (i) STC elects not to file for or continue the prosecution or maintenance of Patent Rights in any foreign jurisdiction; or (ii) Institution notifies STC under subsection (b) above that it does not wish to share the Patent Procurement Fees in one or more specified foreign jurisdictions, then in each case the other Party (the “Sole Foreign Rights Party”) reserves the right to file for, prosecute and maintain Patent Rights in such foreign jurisdiction at the sole expense of the Sole Foreign Rights Party. The Sole Foreign Rights Party shall thereafter be solely responsible for the filing for and prosecution and maintenance of Patent Rights in such foreign jurisdiction and for licensing of the Patent Rights in such foreign jurisdiction, without any obligation to share Sublicensing Income generated from such foreign Patent Rights under this Agreement. Each of the Parties agrees that it will notify the other Party of its intention to elect to become a Sole Foreign Rights Party under this subsection.


(a) STC shall be responsible for and will use its best efforts consistent with industry standards and best practices applicable to university technology transfer to seek one or more Sublicensees for the commercial development of the Invention and the exploitation of the Patent Rights. STC shall be solely responsible for entering into exclusive or nonexclusive Sublicense Agreements with respect to the Invention and the Patent Rights, and Institution agrees that it will not enter into any license agreements, Sublicense Agreements or Option Agreements with respect to the Invention or the Patent Rights. Institution shall refer all inquiries with respect thereto to STC.

(b) Any Sublicense Agreement shall include provisions consistent with and that reserve: (i) the rights of Institution to use the Invention and Patent Rights for non-commercial purposes, internal research, development, and educational purposes; (ii) ownership of all right title and interest in or to the Invention and the Patent Rights to Institution, including without limitation a disclaimer by the Sublicensee for itself and on behalf of all its personnel of any ownership right, title, or interest of any kind or character in or to the Invention or the Patent Rights; and, (iii) if the Inventions are subject inventions as defined under 35 U.S.C. §201(e), provisions reflecting the rights of the United States government with respect thereto, including: (A) that the United States Government has a
nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the subject invention throughout the world (and in some cases the right to assign or have assigned foreign patent rights); (B) that the United States Government retains “march-in” rights, in accordance with 35 U.S.C. §203; and (C) that licensing of the subject inventions is subject to other restrictions, including that preferences be given to small business firms (35 U.S.C. §202(c)(7)(D) and for U.S. manufacturing (35 U.S.C. §204). The Parties agree that any Sublicense Agreement shall include provisions consistent with the rights of and obligations to the United States Government as described in this Section 3(b) and notifying the Sublicensee of the rights of the United States Government in and obligations of the Sublicensee with respect to the subject inventions.

(c) Each Sublicense Agreement shall include an indemnification provision providing, at a minimum, that each Sublicensee is obligated to indemnify, hold harmless and defend STC, Institution, their respective Affiliates, each of their respective regents, trustees, directors, officers, employees and agents, and the Inventors against any and all claims, suits, losses, damages, costs, liabilities, fees and expenses (including reasonable fees of attorneys) resulting from or arising out of exercise by the Sublicensee, its Affiliates, or sub-sublicensees of: (i) any right or license granted under the Sublicense Agreement; or (ii) any negligent act, error, or omission of the Sublicensee, its Affiliates, or sub-sublicensees or any of their respective directors, officers, employees, or agents.

(d) Each Sublicense Agreement shall include a provision requiring the Sublicensee to reimburse STC for: (i) Institution’s Pre-Effective Date Patent Procurement Fees; and (ii) all Patent Procurement Fees incurred after the Effective Date. As of the Effective Date, Institution’s Pre Effective Date Patent Procurement Fees are $0.

(e) STC will provide Institution with copies of each executed Sublicense Agreement and Option Agreement. Option Agreements will not contain terms longer than one year in duration. Option Agreements may provide for renewal terms, except that any termination of this Agreement will result in the non-renewal of such Option Agreement for the next occurring renewal term.

(f) STC shall pay all Sublicensing Procurement Costs. STC shall be paid an Administration Fee for procuring and managing the licensing activities equal to fifteen percent (15%) of all Sublicensing Income.

(g) After payment of the Administration Fee to STC as provided in Section 3(f), above, STC and Institution will share Net Revenue in accordance with their respective Sharing Percentage. Notwithstanding the foregoing: (i) amounts allocated under an Option Agreement or a Sublicense Agreement as reimbursement for Institution’s Pre-Effective Date Patent Procurement Fees shall be distributed one hundred percent (100%) to Institution; and, (ii) amounts allocated under an Option Agreement or a Sublicense Agreement to Patent Procurement Fees incurred after the Effective Date shall be distributed to the Party ultimately responsible for payment of such fees under this Agreement.
(h) If STC proposes to enter into a Sublicense Agreement or Option Agreement in which the Invention or the Patent Rights are bundled with a patent, patent application, or other type of intellectual property other than the Invention or the Patent Rights, then STC and Institution shall enter into discussions with respect to and shall enter into a separate written pooling agreement allocating the proceeds from such Sublicense Agreement or Option Agreement as between and among the Invention and the Patent Rights and the other patent, patent application, or other intellectual property included in the Sublicense Agreement or Option Agreement.

(i) To the extent that any portion of Sublicensing Income consists of equity interests in a Sublicensee, STC shall, at Institution’s option, either: (i) retain ownership of such equity interests until such time as such equity interests are liquidated and converted to cash proceeds; or (ii) distribute a proportional share of such equity interest to Institution, or its designee, based upon Institution’s Sharing Percentage. If Institution elects option (i) then, upon the liquidation of such equity interests, the proceeds shall be treated as Sublicensing Income at the time of receipt of the proceeds from the liquidation.

(j) Institution is responsible for making distributions to Inventors associated with the Institution that may be required under the policies of the Institution. Neither Party shall have any obligation to make any payments to Inventors associated with the other Party or the Affiliate of the other Party.

4. Reports and Records.

(a) On the last day of February of each year during the Term, if any Sublicensing Income has been received by STC during the previous calendar year, STC will provide Institution with a written report for the preceding calendar year accounting for the total amount of Sublicensing Income received from any Optionee or Sublicensee. Such report will also include the amount of the Patent Procurement Fees, the Institution Pre-Effective Date Patent Procurement Fees, the Administration Fee, the Net Revenue, the amount of the Net Revenue allocable to STC and the Institution for such period, and such other information reasonably necessary to accurately account for the income and expenses of STC related to the Invention and the Patent Rights. Simultaneously with the delivery of the report, STC will pay Institution the amount of any Net Revenue and any reimbursement of Patent Procurement Fees due to the Institution for such period. Notwithstanding the foregoing, if at any time the Sublicensing Income received by STC during a calendar year, if any, exceeds $25,000, then STC and Institution will arrange for quarter-annual or more frequent reports and payments as provided in this Section.

(b) Within thirty (30) days of the receipt of a written request for such information, STC shall provide Institution with a written report of the current status of STC’s prosecution and licensing activities related to the Invention and the Patent Rights.

(c) STC shall keep complete and accurate records of its activities related to this Agreement, including without limitation reasonable documentation of all out-of-pocket costs incurred in connection with the Patent Procurement Fees and all information
necessary to calculate Sublicensing Income. No more than once each calendar year, Institution and advisors of its choosing shall have the right to inspect and audit such records during normal business hours upon at least thirty (30) days prior written notice. Such inspection will be at Institution’s expense, except that if such inspection demonstrates underpayment of Net Revenue to Institution of five percent (5%) or more, STC will promptly reimburse Institution for Institution’s expenses incurred in connection with such inspection and audit and in such event, the number of times that Institution may inspect STC’s records shall be increased to no more than twice each calendar year thereafter. Any underpayment of Net Revenue will be promptly paid to Institution.

5. Infringement and Other Patent Disputes.

(a) If either STC or Institution shall learn of the material infringement of any Patent Rights by a third party, the Party learning of such infringement shall promptly provide the other Party with written notice of such infringement including the relevant facts and circumstances then known.

(b) Under a Sublicense Agreement, a Sublicensee may have the first right to proceed at its own expense to defend the Patent Rights against claims or threatened claims from third parties and/or to take action against any infringement of Patent Rights by a third party. If a Sublicensee exercises such right, then the Parties shall cooperate with the Sublicensee as provided for under Section 5(d), below.

(c) In the event that either: (i) a Sublicensee with a right described in Section 5(b), above elects not to defend the Patent Rights or to take action against any infringement of the Patent Rights; or (ii) at such time there is no Sublicensee having such a right, STC and Institution shall confer with the intent of reaching mutual agreement on whether and in what manner to enforce or protect the rights of the Institution in and to the Invention and the Patent Rights, whether by appropriate legal proceedings or otherwise. Upon mutual agreement, the Parties shall enter into a separate written agreement regarding allocation of payments of costs and legal fees for enforcement or defense of such action or proceeding. Any sums recovered with respect to any such action shall be applied first to reimburse out-of-pocket expenses incurred by a Party relating to the action or proceeding and the remaining sums shall be deemed Net Revenues under this Agreement and shared by the Parties as provided in Section 3(g). If a Party elects not to participate in an action or proceeding (a “Non-Participating Party”), it shall notify the other Party in writing. Under such circumstances, the other Party may elect to prosecute or defend such action or proceeding at its sole expense (the “Participating Party”) provided that (A) the Participating Party shall pay all costs and expenses arising out of such prosecution or defense, (B) the Participating Party shall not have any right to surrender the rights of the Non-Participating Party or to grant any infringer any rights other than a Sublicense Agreement subject to the conditions that would apply to the grant of any other Sublicense Agreement, and (C) notwithstanding the provisions of Sections 3(f), 3(g), and 3(i), all sums recovered with respect to any such action or proceeding shall be paid over to the Participating Party without any obligation to share such recovery with the Non-Participating Party.

(d) Each Party agrees to cooperate with the other Party and any Sublicensees in any infringement or other patent proceedings but at the expense of the Party (or Sublicensee) bringing such action or proceeding. Each Party agrees to be named in and
consents to join in any suit or proceeding as a party to the suit or proceeding to the extent necessary to establish standing in the suit or proceeding.

6. Termination

(a) This Agreement shall commence on the Effective Date and continue for a period of four years, unless terminated earlier in accordance with this Agreement.

(b) A Party may terminate this Agreement for any reason or for no reason upon at least ninety (90) days written notice to the other Party.

(c) Termination or expiration of this Agreement shall not affect any Option Agreement or Sublicense Agreement then in effect (except with respect to non-renewal of an Option Agreement as described in Section 3(e) above), and Sublicensing Income received from such Sublicense Agreement, or from a Sublicense Agreement entered into upon the exercise by an Optionee of its rights under an Option Agreement, shall be subject to and distributed as set forth in this Agreement. Institution agrees that following any expiration or termination of this Agreement, it will not enter into any option or licensee agreement inconsistent with the rights of any Optionee or Sublicensee.

(d) Upon termination by Institution, Institution shall pay to STC any unreimbursed Patent Procurement Fees, not including however, Patent Procurement Fees not consented to by Institution under Section 2(b) or paid by STC as the Sole Foreign Rights Partner under Section 2(d).

(e) Expiration or termination of this Agreement will not relieve any Party of any obligation or liability accrued under this Agreement before expiration or termination or rescind any payments made or due before expiration or termination. Sections 3(k), 4, and 5 through 11 shall survive termination of the Agreement. Sections 3(f) through 3(i) of this Agreement shall also survive termination of this Agreement with respect to any Sublicense Agreement entered into prior to termination or as a result of the exercise of an Option Agreement entered into prior to termination.

(f) The terms of this Agreement are contingent upon sufficient appropriations from the State of New Mexico being made to Institution for the performance of this Agreement. If sufficient appropriations are not made, this Agreement will terminate automatically without liability to either Party. Institution’s decision as to whether sufficient appropriations are available will be accepted by STC and will be final. Institution represents and warrants that sufficient appropriations have been made to Institution for the performance of this Agreement at least through its current fiscal year end on June 30, 2018.


(a) Institution represents and warrants to STC that:
(i) except as otherwise provided under this Agreement with respect to U.S. Government interests in subject inventions and the rights of the Institution as described in Section 3(b): (A) it is the owner of the Invention and the Patent Rights and has the right and power to enter into in this Agreement; and (B) it has not granted any rights or licenses to the Invention or the Patent Rights to any Person;

(ii) it has complied with all requirements necessary in order to obtain title to the Invention and the Patent Rights including but not limited to: (A) obtaining assignments or acknowledgments of policy or ownership from the Inventors; and, (B) electing title under 35 U.S.C. §202 with respect to any subject invention;

(iii) except as otherwise provided under this Agreement with respect to U.S. Government interests in subject inventions and the rights of the Institution as described in Section 3(b), no Person has any ownership interest in or claim to an ownership interest in the Invention or the Patent Rights based upon any association, affiliation, employment, agreement or other relationship between such Person and Institution; and,

(iv) other than the Inventors identified as being associated with the Institution, there are no other individuals associated with the Institution that contributed to the Invention such that the individual would be an inventor under applicable law.

(b) STC covenants, represents and warrants to Institution that:

(i) STC has experience and expertise in the prosecution of patents and the commercialization of inventions and will during the term of this Agreement diligently pursue the prosecution or maintenance of Patent Rights, including without limitation by meeting all applicable filing or similar deadlines in the United States and in any foreign jurisdiction in which STC elects to file for or continue the prosecution or maintenance of Patent Rights, other than as a Sole Foreign Rights Party;

(ii) STC will use its best efforts consistent with industry standards and best practices for university technology transfer to seek prompt protection for the Invention and Patent Rights and commercial development for the Invention and Patent Rights; and

(c) Nothing in this Agreement shall be construed as:

(i) a warranty or representation by either Party as to the validity or scope of any right included in the Patent Rights or that Patent Rights will issue with respect to the Invention;

(ii) a warranty or representation that the exercise of the Patent Rights will or will not infringe intellectual property rights of third parties;
(iii) an obligation to bring or prosecute actions or suits against third parties for infringement of the Patent Rights or to defend the Patent Rights in any action or suit brought by a third party;

(iv) an obligation to furnish any know-how not provided in the Patent Rights or any services other than those specified in this Agreement; or

(v) a warranty or representation by either Party that it will not grant licenses to others to make, use, sell or import products not covered by the claims of the Patent Rights that may be similar and/or compete with products made or sold by any Sublicensee or any sub-sublicensee of a Sublicensee.

(c) EXCEPT AS EXPRESSLY PROVIDED IN THIS AGREEMENT, NEITHER PARTY MAKES ANY WARRANTY, EXPRESS OR IMPLIED, WITH RESPECT TO THE INVENTION, THE PATENT RIGHTS, OR THE PERFORMANCE OF ITS DUTIES AND OBLIGATIONS UNDER THIS AGREEMENT, INCLUDING, WITHOUT LIMITATION, ANY IMPLIED WARRANTY OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE. NO WARRANTY IS GIVEN BY EITHER PARTY THAT PATENT RIGHTS WILL BE OBTAINABLE, OR THAT ANY RESULTING PATENT RIGHTS WILL BE ENFORCED OR ENFORCEABLE. IN NO EVENT SHALL A PARTY BE LIABLE FOR CONSEQUENTIAL, INCIDENTAL, SPECIAL OR INDIRECT DAMAGES, OR FOR ACTS OF NEGLIGENCE THAT ARE NOT INTENTIONAL OR RECKLESS IN NATURE, REGARDLESS OF WHETHER IT HAS BEEN ADVISED OF THE POSSIBILITY OF SUCH DAMAGES. ANY LIABILITY OF INSTITUTION SHALL BE SUBJECT IN ALL CASES TO THE IMMUNITIES AND LIMITATIONS OF THE NEW MEXICO TORT CLAIMS ACT, SECTIONS 41-4-1-ET SEQ. NMSA 1978, AS AMENDED.

8. Notices. All notices and other communications shall be written and sent by electronic mail and confirmed upon dispatch of electronic mail by one of the following methods: hand delivery, or by private overnight courier service, or by registered or certified U.S. mail, postage prepaid, return receipt requested, and addressed to the Party to receive such notice or other communication at the address given below, or such other address as may hereafter be designated by notice:

As to STC:  
STC.UNM  
801 University Blvd. SE, Suite 101  
Albuquerque, NM  87106  
Attn: President  
Email:  kuuttila@stc.unm.edu

As to Institution:  
Eastern New Mexico University  
1500 S Avenue K  
Portales, NM 88130  
Attn: President  
Email:  Jeff.Elwell@enmu.edu

9. Dispute Resolution/Arbitration.
(a) In the event of any dispute arising out of or in connection with this Agreement, either Party may initiate resolution of such controversy by providing to the other Party a brief and concise written statement of the initiating Party’s claims, together with relevant facts supporting them, and referring to this Section 9. For a period of sixty (60) days after the date of such statement, or such longer period as the Parties may agree in writing, the Parties will make good faith efforts to settle the dispute. Such efforts must include, without limitation, full presentation of the Parties’ respective positions before the respective presidents or equivalent officers of their respective institutions.

(b) In the event that the Parties are unable to resolve the dispute in the manner described in Section 9(a), above, the dispute shall be settled by arbitration in Albuquerque, New Mexico before a single arbitrator chosen jointly by the parties, the arbitration to be conducted otherwise in accordance with the Rules of the American Arbitration Association including the Association’s Supplementary Patent Rules. Judgment on the award rendered by the arbitrator may be entered in any court having jurisdiction thereof.

**10. Protection of Proprietary Information**

(a) For the purpose of this Agreement, “Proprietary Information” means all information that is disclosed hereunder by one Party (“Discloser”) to the other Party (“Recipient”), provided that when disclosed the information is identified as Proprietary Information or is of a kind or disclosed under circumstances such that Recipient knows or should know of its proprietary nature.

(b) Recipient will treat and maintain the Discloser’s Proprietary Information using at least the same degree of care as the Recipient uses to protect its own proprietary information of a like nature.

(c) Each party may use and disclose Proprietary Information to their employees, agents, consultants, contractors provided that such parties are bound by a like duty of confidentiality as that found Section 10. Each Sublicense Agreement and Option Agreement will contain confidentiality provisions at least as restrictive as those contained in this Section 10. Notwithstanding anything to the contrary contained in this Agreement, Institution may release this Agreement or any Sublicense Agreement or Option Agreement and the terms thereof, and information regarding Sublicensing Income, on a confidential basis, to the Inventors and to the senior administrative officials of Institution.

(d) Nothing contained in this Section 10 will restrict or impair in any way the right of either Party to use or disclose any Proprietary Information that: (i) Recipient can demonstrate by written records was known to it prior to its disclosure by Discloser; (ii) Recipient can demonstrate by written records is now, or becomes in the future, public knowledge, other than through acts or omissions of Recipient; (iii) Recipient can demonstrate by written records was obtained lawfully and without restrictions on Recipient from sources independent of Discloser; or (iv) Recipient can demonstrate it has developed independently of Proprietary Information received from Discloser.
(e) Either Party may disclose Proprietary Information that is required to be disclosed (i) to a governmental entity or agency in connection with seeking any governmental audit or other governmental requirement, or (ii) by applicable law, provided in either case that the Recipient gives the Discloser sufficient notice of such required disclosure to allow the Discloser a reasonable opportunity to object to, and to take legal action to prevent such disclosure.

(f) Upon termination of this Agreement, the Recipient will destroy or return any of the Discloser’s Proprietary Information in its possession within fifteen (15) days. Each Party will provide the other, within thirty (30) days following termination, written notice that such Proprietary Information has been returned or destroyed.

(g) Nothing in this Agreement will relieve either Party of any obligation under a separate nondisclosure or confidentiality agreement.

11. Miscellaneous.

(a) This Agreement is made under and shall be governed by and construed in accordance with the laws of the State of New Mexico, excluding its choice of law provisions.

(b) This Agreement embodies the entire understanding of the Parties and supersedes all previous communications, representations or understandings, either oral or written, between the Parties relating to the subject matter hereof.

(c) No waiver by a Party hereto of any breach or default of any of the covenants or agreements herein set forth shall be deemed a waiver as to any subsequent or similar breach or default.

(d) If any provision of this Agreement shall be held to be invalid, illegal, or unenforceable in any respect, the validity, legality, and enforceability of the remaining provisions shall not in any way be affected or impaired thereby, and the invalid, illegal, or unenforceable provision shall be deemed amended to the minimum extent necessary to render it valid, legal, and enforceable, provided that the intent of the Parties in entering into the Agreement is not materially affected thereby.

(e) The Parties hereto are independent contractors and not joint venturers or partners.

(f) The Parties acknowledge that they are subject to and agree to abide by the United States laws and regulations (including the Export Administration Act of 1979 and Arms Export Control Act) controlling the export of technical data, computer software, laboratory prototypes, biological material, and other commodities. The transfer of such items may require a license from the cognizant agency of the U.S. Government or written assurances that it shall not export such items to certain foreign countries and/or foreign persons without prior approval of such agency. Neither Party represents that a license is or is not required or that, if required, it shall be issued.

(g) This Agreement binds and inures to the benefit of the Parties, their
successors or assigns, but may not be assigned by either Party without the prior written consent of the other Party, which consent will not be unreasonably withheld; except that a Party may assign all its rights, powers, duties, and obligations under this Agreement to the Affiliate of such Party.

(h) No Party shall use the name of the other Party or its Affiliate or the name of any Inventor in any sales promotion, advertising, or any other form of publicity without the prior written approval of the other Party.

(i) The Parties acknowledge that they are subject to and agree to abide by the New Mexico criminal laws prohibiting bribes, gratuities, and kickbacks.

IN WITNESS WHEREOF, STC and Institution have executed this Agreement on the dates set out below, to be effective as of the Effective Date.

STC.UNM
By: ____________________________
   Elizabeth J. Kuuttila
   President & CEO
Date: ____________________________

Eastern New Mexico University
By: J.S. Elwell
   Printed Name: Dr. Jeffrey Elwell
   Title: President
Date: 10/17/2017
GLOSSARY

“Administration Fee” means the fee payable to and retained by STC as consideration for securing and administering a Sublicense Agreement or an Option Agreement.

“Affiliate” means with respect to STC, The Regents of the University of New Mexico. With respect to a Sublicensee, “Affiliate” means a person or entity that directly or indirectly through one or more intermediaries controls, is controlled by, or is under common control with, the Sublicensee. For purposes of this definition, “control” and cognates thereof mean, with respect to an entity, the direct or indirect ownership of (a) at least fifty percent (50%) of the capital stock or share capital entitled to vote for the election of directors of the entity; or (b) at least fifty percent (50%) of equity or voting interests of the entity, or (c) the ability to otherwise direct the management and operations of the entity. A person or entity shall be considered an Affiliate of the Sublicensee only during the period that such control exists.

“Agreement” means this Inter-Institutional Agreement together with the attached Glossary and Schedule 1.

“Effective Date” means the later of: (i) the date of the approval of this Agreement by Institution’s Board of Regents in accordance with Institution’s Intellectual Property Policy, which date Institution will confirm to STC by written notice; or (ii) the date of the last of the Parties to execute this Agreement as reflected on the signature page of this Agreement.

“Institution’s Pre-Effective Date Patent Procurement Fees” means the out-of-pocket expenses incurred by Institution prior to the Effective Date in the amount of $0 to procure and maintain U.S. and foreign Patent Rights for the Invention including patent preparation and prosecution costs, attorneys’ fees and costs, and all USPTO and foreign jurisdiction fees including, but not limited to, filing, examination, issuance and maintenance fees.

“Invention” means the subject matter described in attached Schedule 1.

“Inventor” means each of the individuals identified as such on attached Schedule 1.

“Net Revenue” means Sublicensing Income less the Administration Fee.

“Option Agreement” means any agreement entered into by STC that grants to an Optionee an option to obtain a Sublicense Agreement.

“Optionee” means any Person that enters into an Option Agreement with STC.
“Party” shall refer to each of the parties to this Agreement named in the opening paragraph of this Agreement. “Parties” shall refer to both of the parties to this Agreement named in the opening paragraph of this Agreement.

“Patent Procurement Fees” means the out-of-pocket expenses incurred by STC to procure and maintain U.S. and foreign Patent Rights for the Invention including patent preparation and prosecution costs, attorneys’ fees and costs, and all USPTO and foreign jurisdiction fees including, but not limited to, filing, examination, issuance and maintenance fees.

“Patent Rights” means the Parties’ respective rights in inventions covered in patents and patent applications, whether domestic or foreign, which identify the Inventors as inventors and which relate to the Invention, including all provisionals, divisions, continuations, reissues, renewals, extensions and supplementary protection certificates of these patents and patent applications to the extent that the Inventors are named as inventors thereon.

“Person” means any individual, corporation, limited liability company, partnership, limited partnership, business trust, or entity of any nature.

“Sharing Percentage” means fifty percent (50%) each for STC and Institution.

“Sublicense Agreement” means any agreement entered into by STC that grants a Sublicensee the right to make, have made, use, sell or import products or use processes covered by the Patent Rights.

“Sublicensee” means any Person that enters into a Sublicense Agreement with STC.

“Sublicensed Products” means any product or part thereof which: (a) is covered in whole or in part by an issued, unexpired claim or a pending claim contained in the Patent Rights in any country in which any such product is made, used, sold, or imported; or (b) is manufactured by using a process that is covered in whole or in part by an issued, unexpired claim or a pending claim contained in the Patent Rights in any country in which any such process is used or in which any such product is used or sold.

“Sublicensing Income” means monetary payments or other forms of consideration received by STC from any activity involving commercializing the Invention or the Patent Rights, including, but not limited to, any amounts received pursuant to the terms of an Option Agreement or a Sublicense Agreement, such as option fees, license fees, royalty payments, milestone payments, reimbursement for Patent Procurement Fees and equity interests or proceeds from the liquidation of equity interests as provided under Section 3(i).

“Sublicensing Procurement Costs” means all costs, whether internal (salaries, overhead, etc.) or out-of-pocket third party costs incurred in connection with the licensing activities described under Section 3.
SCHEDULE 1

Invention Disclosures

<table>
<thead>
<tr>
<th>Institution/Affiliate Inventors:</th>
<th>[List Inventors]</th>
</tr>
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Bayh-Dole Act Invention: Yes ____ No ____


“Multi column plate adaptor (MCPA) for vacuum manifolds facilitates purification of biomolecules” (Dr. Elliott Stollar)

“Synergy with combinations of medicinal plant compounds and chemotherapeutic antimicrobial agents”; Compounds that increase the activity of certain antibiotics (Dr. Manuel Varela)

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<tr>
<th>Institution/Affiliate Inventors:</th>
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