**Cisco Master Sponsored Research Agreement Project Team Member Checklist**

**and**

**Non-Standard Terms Acknowledgement**

**RESEARCH PROJECT TITLE**: insert title here

**RESEARCH PROJECT TEAM MEMBERS**: insert names here

# PART I: PROJECT TEAM MEMBER CHECKLIST

NOTE: This information will be used to complete the Research Addendum (i.e. the task order template) in the Master Agreement Exhibit B:

1. Is your Research Project team going to use Cisco Property (i.e any information from Cisco defined in the Master Agreement Exhibit A) in your Research Project?
	1. No: [ ].
	2. Yes: [ ]. If yes, please list such information:
		1. Describe Cisco item #1
		2. Describe Cisco item #2
		3. Describe Cisco item #3
2. Is your Research Project team going to use any University Property (such as unpublished proprietary data, information, know-how, and/or NC State patents or patent applications as defined in the Master Agreement Exhibit A) in your Research Project?
	1. No: [ ].
	2. Yes: [ ]. If yes, please list such information:
		1. Describe University item #1
		2. Describe University item #2
		3. Describe University item #3
3. Is your Research Project team planning to use third party materials or software in the project as defined in the Master Agreement’s Article 8?

**[NOTE: Ensure than any third party software incorporated in a project’s results that are subject to a Cisco “Open Source” license will also allow that third party software or any modifications and/or improvements thereof can be released via an open source software license (i.e. no GLP v3 nor Apache 2.0).]**

* 1. No: [ ].
	2. Yes: [ ]. If yes, please list such information:
		1. Describe third party item #1
		2. Describe third party item #2
		3. Describe third party item #3
1. Please list the type of intellectual property (IP) you expect to develop under the Research Project (e.g. patentable IP, know-how, algorithms, copyrightable, etc)?
	1. Describe possible IP #1
	2. Describe possible IP #2
	3. Describe possible IP #3

# PART 2: NON-STANDARD MASTER AGREEMENT TERMS TO ACCEPT:

1. **Facilities & Administrative Fees**: ***Use the fully-burdened (i.e. non-negotiated) Facilities & Administrative (F&A) rate for industry sponsors while calculating the project’s budget.*** Verify the current, fully-burdened rate with the Sponsored Programs office (Sponsored Programs to provide rate after confirming rate with the Director of Contracts & Grants) before proceeding with the project’s budget.
2. **Other Outputs** (Master Agreement, Article 4.2): “‘Other Outputs are defined to include all and any information developed under the Research Project (e.g. “Data, know-how, residual knowledge, feedback, tangible and intangible results, and other useful items arising out of the Parties’ work under the [Master] Agreement” that does not constitute “New Intellectual Property” as defined by the Master Agreement’s Exhibit A).

**Cisco has a non-exclusive right to use such Other Outputs for any purpose without any restriction or financial obligation to NC State. As such, NC State and the Research Project team will not receive any license fee or royalty payment for Cisco’s use of NC State’s “Other Outputs”. By signing this document, each Research Project team member agrees to waive his/her right to receive a portion of the revenue that the University would otherwise receive under POL 10.00.01 Patent and Tangible Research Policy if a license fee or royalty payment would have been paid for such license.**

1. **Publicity** (Master Agreement, Article 5): The master states that “...neither Party will use the name, logo, trademark, trade name, or other marks (together, “Marks”) of the other Party, including in connection with any advertising, sales promotions, press releases, or other publicity matters, without that Party’s prior written consent. No press release or other public announcements regarding this Agreement or any Research Projects will be made without prior review and written agreement signed by a duly authorized representative of each Party.”

**These provisions mean that the University and its faculty and staff cannot issue any type of public release regarding this agreement nor its projects without Cisco’s written consent.**

**This article also ties in with the publication provisions below.**

1. **Publication and Academic Rights** (Master Agreement, Article 6): NC State has the right to publish or publicly disclose results from Research Projects that do not include Cisco Confidential Information (Master Agreement, Article 7) or information that could lead to loss of IP protection. Given these provisions, Research Project team members must follow the following process:
	1. **Submit pre-publication material to Cisco for review and comment at least sixty**

**(60) days prior to planned submission for publication. If Cisco does not respond within 60 days, NC State can proceed with publication. “Cisco's funding will be acknowledged in any publications or presentations, as required by any publisher, and if not required by a publisher, University shall give Cisco the option of receiving an acknowledgement.”**

* 1. Once pre-publication materials are submitted to Cisco, NC State will remove any Cisco Confidential Information identified by Cisco, and the Parties will work in good faith to prevent or delay dissemination of NC State Confidential Information that may lead to loss of intellectual property (IP) protection. Such discussion will occur within the 60 days review period and if parties agree to delay such publication in order to file for patent protection, said delay can be for an additional ninety (90) days maximum.
1. **Confidential Information** (Master Agreement, Article 7): “‘Confidential Information’ means information disclosed in confidence from one Party (“Disclosing Party”) to the other Party (“Receiving Party”) in furtherance of the Research Projects, including, but not limited to, information regarding each Party's intellectual property, products, services, product designs, plans and roadmaps, prices and costs, trade secrets, know-how, inventions, development plans, techniques, processes, programs, schematics, software, data, customer lists, financial information, sales and marketing plans, business opportunities, personnel data, research and development activities, and pre-release products, and any other information which the Receiving Party is informed by the Disclosing Party as confidential, proprietary or trade secret information of the Disclosing Party or that by its nature a person familiar with the industry would recognize that it is Confidential Information. The Receiving Party is obliged to treat as confidential only information disclosed by the Disclosing Party that is (i) clearly marked as “Confidential,” “Proprietary” or a similar legend if information is disclosed in writing or other tangible form; or (ii) clearly identified as confidential, proprietary, or the like at the time of disclosure and summarized in writing within thirty (30) days of disclosure if information is disclosed orally.”

**These terms require each Party to disclose its confidential information as “confidential”, “proprietary”, “trade secret”, etc. at the time of its disclosure, and each Party may only utilize the other Party’s confidential information in order to complete the project itself. In order to comply with the Master, disclose and mark all NC State confidential information as “confidential” at the time of its disclosure, and hold all Cisco Confidential Information disclosed to you in confidence.**

1. **Cisco Property** (Master Agreement, Exhibit A, Articles 1.1 and 2.4):
	1. “‘Cisco Property’ means all Cisco intellectual property, technology, equipment, property, materials, information, techniques, data, and/or processes furnished or furnished and used in a Research Project, or all derivatives, improvements, or modifications thereto, including all Intellectual Property Rights of Cisco to such Cisco Property, regardless of which Party first made, created, conceived of, or reduced them to practice.”

**This provision means that all derivatives, improvements, or modifications to Cisco Property created by NC State and the intellectual property rights associated with those NC State-created derivatives, improvements, or modifications to Cisco Property will be owned by Cisco. NC State will not receive any license fee or royalty**

**payment for the assignment of such NC State-created derivatives, improvements, or modifications to Cisco. By signing this document, each Research Project team member agrees to waive his/her right to receive a portion of the revenue that the University would otherwise receive under POL 10.00.01 Patent and Tangible Research Policy if a license fee or royalty payment would have been paid for any such IP assignment.**

* 1. Cisco Property will need to be listed in the Research Project Addendum if known prior to the start of the project or included in a modification to Research Addendum if added during the life of the Research Project.
1. **New Intellectual Property** (Master Agreement, Exhibit A, Articles 1.4, 3, and 4): “means any new intellectual property (and all associated documentation), including all Intellectual Property Rights [article 1.3] first identified or created by the University during its performance of a Research Project, but excluding all Cisco Property [article 1.1] and University Property [article 1.8].”

**As New Intellectual Property includes all current and future patents and all other types of IP (e.g. know-how, confidential information, etc.), Cisco might have rights in additional IP that is generated by NC State after completion of the Research Project (irrespective of the source later funding).**

* 1. **As a result, will need to keep track of IP developed under the Cisco Project even after completion of the project.**
	2. **Since Cisco has rights to any type of IP developed under the Cisco Research Project, all principal investigators (PIs) will need to submit an invention disclosure at the end of each Research Project irrespective of what type of IP is developed (meet obligations under Other Outputs and also to be able to identify all IP developed under the Cisco Research Project).**
	3. **PIs will need to disclose and list all University Property (BIP) that will be used in the Research Project.**
	4. **In order to meet NC State’s obligations under the Cisco MRA, each Research Project team will need to submit one or more invention disclosures within thirty (30) days of the end of each Research Project as Cisco has certain rights to any and all IP developed under the project (e.g. patents, copyrights, data, information, know-how, etc).**
1. **University Property** (Master Agreement, Exhibit A, Articles 1.8, 2.1, 2.2, 2.3, and 2.5): “
	1. University Property “means all University intellectual property of any Research Project team member, technology, equipment, property, materials, information, techniques, data,

and/or processes first made, created, conceived of, or reduced to practice by University prior to this Agreement and an applicable Research Addendum and/or outside of this Agreement and an applicable Research Addendum and furnished or furnished and used in a Research Project. University Property includes all derivatives, improvements, or modifications thereto including all Intellectual Property Rights of University to such University Property, regardless of which Party first made, created, conceived of, or reduced them to practice.”

* 1. **If any rights to University Property are needed for Cisco to exercise its rights to New Intellectual Property under this Agreement, then, subject to any third-party rights to such University Property, University will negotiate a license with Cisco on fair and reasonable terms, for the sole purpose of and only to the extent necessary for enabling Cisco’s use of the New Intellectual Property.**
		1. **University Property will need to be listed in the Research Project Addendum if known prior to the start of the project or included in a modification to Research Addendum if added during the life of the Research Project.**
1. **Foreground Property and Patent Filing & Expenses** (Master Agreement, Exhibit A, Articles 3 and 7): New Intellectual Property is subject to one of the three licensing options. Option A is an exclusive license. Option B. is a non-exclusive option. Option C requires NC State to place project deliverables . Two options have fixed fees. One option has no fee.

**Under the Master, Cisco is not paying for patent expenses (unless otherwise agreed upon at a later date for a specific Research Project) and will have at least non-exclusive rights to any New Intellectual Property created under the Research Project. In light of this and potential cost for seeking and obtaining patent protection, it is very unlikely that NC State will file for patent protection unless Cisco subsequently agrees to pay for patent expenses.**

1. **Third Party Property** (Master Agreement, Exhibit A, Article 8): “University will use reasonable efforts to ensure that it has sufficient right regarding any third party materials or software included in the New Intellectual Property of which it has actual knowledge, and shall disclose to Cisco any third-party patents of which it has actual knowledge as of the date of the final report for the applicable research project in New Intellectual Property, including without limitation any use or inclusion of third-party open source software.”

**PIs will need to disclose and list all Third Party Property that will be used in the Research Project prior to the start of the Research Project or prior to incorporating the use of any Third Party Property during the term of the Research Project.**

# PART 3: NON-STANDARD TERMS ACKNOWLEDGEMENT:

By signing, we (“Project Team Member”) acknowledge that we have read and understood the terms of the above-referenced master agreement with Cisco, and we agree to comply with these terms in our performance of the Research Project described therein (“Project”). In particular, we understand and agree to comply with the terms related to publication, confidential information, intellectual property, licensing and/or intellectual property assignment. We agree to cooperate fully with the Office Research Commercialization (ORC), to promptly disclose any intellectual property developed under the Project, and to provide such assistance as may be required in connection with the filing, prosecution, maintenance, defense, and/or licensing or assignment of any patent applications resulting from this Project.

Each Project Team Member understands that there can be no comingling of funds, materials, third party software including open source software, or other items funded by any source other than Cisco, including, but not limited to, funds from federal, state, and industry sources; unless otherwise approved by Cisco and ORC.

Each Project Team Member understands that it is their responsibility to notify ORC of any University background intellectual property that may be used in connection with this project prior to commencement of the project. Any questions regarding University background intellectual property may be addressed to the Director of Licensing for the Office Research Commercialization (ORC) (kultaran\_chohan@ncsu.edu).

Each of the undersigned Project Team Members understands that it is their responsibility to make any NC State employee or student participating in the project aware of the terms of the Project agreement before assigning work related to the Project. No external contractors, consultants or collaborators may be brought into the project without working with Sponsored Programs and Regulatory Compliance Services (SPARCS) to put in place a subcontract or collaboration agreement.

Any upfront consideration for intellectual property (e.g. “Upfront Consideration”) paid by Cisco to University will be treated as gross revenue as defined in the POL 10.00.01 Patent and Tangible Research Policy. Accordingly, the inventors' and College/Department’s share of this upfront consideration shall be held by ORC until completion of the Project. Thirty (30) days following the completion of the Project, ORC shall confirm with the PIs that all resulting inventions have been documented and submitted to ORC as invention disclosures. ORC shall then determine the appropriate distribution of the upfront consideration among inventor(s), College(s) and Department(s) in accordance with NC State's Patent and Tangible Research Policy.

We acknowledge these statements with our signature below:

Signature of lead Principal Investigator: Printed Name: Date: Title:

Signature of co-investigator: Printed Name: Date: Title:

Signature of co-investigator: Printed Name: Date: Title:

Signature of other Project Team Member: Printed Name: Date: Title:

Signature of other Project Team Member: Printed Name: Date: Title:

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