Preliminary Patent Management Agreement ("Agreement")

This PPMA Agreement is entered into between the Lead Institution and Other Institution(s) identified below (collectively, "Institutions"). As co-owners of the Joint Invention identified below, Institutions enter into this Agreement for management of the Joint Invention and for their mutual benefit.

Lead Institution (Patent and Licensing) _____ _____ _____ _____ Attn: _____			Other Institution(s) _____ _____ _____ _____ Attn: _____	
Effective Date				
Joint Invention(s)	*Internal Reference No.*	*Serial No./Date of Filing*	*Title*	*Inventors (including employer at time of invention)*
Share of Patent Expenses	UTEP: ____ % [INSERT OTHER INSTITUTION]: ___%			
Share of Net Consideration (after reimbursement of patent expenses)	UTEP: ____ % [INSERT OTHER INSTITUTION]: ___%			
Administration Fee	___ %			
Third-Party Interests				

The Institutions hereby agree as follows:

1) Patent Prosecution. Lead Institution will seek patent protection and maintenance for the Joint Invention(s) identified in the table above jointly in the name of Lead Institution and Other Institution(s). Lead Institution will direct its patent counsel to copy Other Institution on standard correspondence.

Lead Institution shall consult with the Other Institution regarding the preparation, filing, prosecution and maintenance of all patents for the Joint Invention. While Lead Institution has the authority to make decisions regarding the scope and content of such patents and selection of patent counsel, Lead Institution shall give the Other Institution the opportunity to review, provide input thereto and approve such decisions, which approval shall not be unreasonably withheld.

Lead Institution shall not knowingly abandon any patent for the Joint Invention without providing at least sixty (60) days prior written notice to the Other Institution and an opportunity to take over the prosecution and maintenance of the patent.

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Lead Institution and Other Institution shall mutually determine the countries or jurisdictions where patent applications and patents will be prosecuted and maintained. If either the Lead Institution or the Other Institution declines to pay its share of patent expenses in any particular country or jurisdiction, the Party covering the expenses can continue prosecution in said country or jurisdiction and will be entitled to all financial burdens and benefits resulting from activity in that country or jurisdiction.

The Parties shall share the patent expenses as set forth in the table above. Lead Institution shall forward invoices for all such patent expenses to the Other Institution, and the Other Institution shall pay to the Lead Institution the Other Institution's share of the patent expenses no later than forty-five (45) days from its receipt of the invoice.

2) Licensing; Definitive IIA. Lead Institution will use reasonable efforts, consistent with its usual practices, to seek licensees for the Joint Invention(s). Neither Institution will execute a license covering the Joint Invention unless this Agreement is terminated or replaced with a definitive inter-institutional agreement ("Definitive IIA"). The Institutions currently intend to enter into a Definitive IIA when a licensee is identified, although an Institution may initiate negotiations of the Definitive IIA before then.

3) Economic Terms of Definitive IIA. The Institutions expect to share net consideration under the Definitive IIA in proportion to each Institution's Share of Net Consideration set forth in the table above. Net consideration means gross license revenue minus any unreimbursed patent expenses and, if any, the administrative fee set forth in the table above. If the Joint Inventions are licensed together with other joint or sole intellectual property of the Parties, the Parties shall negotiate in good faith to determine whether the share of net consideration should be altered to take into account the inclusion of such additional intellectual property in the license. In addition, the Parties agree to renegotiate the sharing of net consideration and patent expenses if there are material changes in circumstances, including but not limited to a determination by: outside patent prosecution counsel, or the Institutions jointly and in good faith, that the named inventors identified in the table above need to be changed.

4) Termination. While the intent is to give Lead Institution at least three years to identify a licensee, either Institution may terminate this Agreement at any time for any reason by providing 90 days advance written notice to the other Institution(s).

5) CREATE Act. Neither Institution will invoke the Cooperative Research and Technology Enhancement Act of 2004, 35 U.S.C. 103(c)(2)-(c)(3) without the prior written consent of the other Institution(s).

6) Third-Party Interests; Sponsor Reporting. To the knowledge of the licensing office of each Institution, there are no rights of research sponsors (other than the U.S. government) or other third parties in the Joint Inventions, except as set forth in the table at the beginning of this Agreement. Each Institution will manage its own sponsor reporting obligations, but if the Institutions both received federal funding for the research that resulted in the Joint Inventions, then Lead Institution will take responsibility for the federal reporting, and provide viewing rights or copies of sponsor reports to the Other Institution.

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7) LIMITATION OF LIABILITY. TO THE MAXIMUM EXTENT PERMITTED BY LAW, IN NO EVENT WILL AN INSTITUTION BE RESPONSIBLE FOR ANY INCIDENTAL, CONSEQUENTIAL, OR EXEMPLARY DAMAGES OF ANY KIND, LOST GOODWILL, LOST PROFITS, LOST BUSINESS AND/OR ANY INDIRECT ECONOMIC DAMAGES WHATSOEVER REGARDLESS OF WHETHER SUCH DAMAGES ARISE FROM CLAIMS BASED UPON CONTRACT, NEGLIGENCE, TORT (INCLUDING STRICT LIABILITY OR OTHER LEGAL THEORY), A BREACH OF ANY WARRANTY OR TERM OF THIS AGREEMENT, AND REGARDLESS OF WHETHER AN INSTITUTION WAS ADVISED OR HAD REASON TO KNOW OF THE POSSIBILITY OF INCURRING SUCH DAMAGES IN ADVANCE. THE INSTITUTIONS ACKNOWLEDGE THAT NOTHING IN THIS AGREEMENT SHALL CONSTITUTE A WAIVER OF INSTITUTION'S SOVEREIGN IMMUNITY.

8) Execution in Counterparts; Facsimile or Electronic Transmission: This Agreement may be executed in counterparts, and may be transmitted by facsimile or other electronic transmission.

IN WITNESS WHEREOF, the parties have caused this Agreement to be executed as of the Effective Date:

The University of Texas at El Paso		**[INSERT OTHER INSTITUTION]**	
By	_____	By	_____
Name	Dr. Roberto Osegueda _____	Name	_____
Title	Vice President for Research _____	Title	_____
Date	_____	Date	_____

Questions?

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