

**MEMBERSHIP AGREEMENT
FOR
THE UNIVERSITY OF TENNESSEE
CENTER FOR MATERIALS PROCESSING**

THIS AGREEMENT is entered into and made effective the ____ day of _____, by and between The University of Tennessee, on behalf of the College of Engineering, at The University of Tennessee, Knoxville, and its Center for Materials Processing (hereinafter referred to as **THE UNIVERSITY** or **CENTER**) and having an office in _____ (hereinafter referred to as **MEMBER**).

WITNESSETH:

In consideration of the mutual covenants contained herein, the parties agree as follows:

1. **THE UNIVERSITY** has established a Center for Materials Processing as part of the College of Engineering at the Knoxville campus of **THE UNIVERSITY**. This **CENTER** is a research program of The University of Tennessee. The purpose of the **CENTER** is to conduct research in areas relevant to the processing of materials, including development of new or improved materials and methods for processing them. The cost of such research will be funded by a Center of Excellence Award from the State of Tennessee, membership fees received from full paid members, contributions from supporting members and royalties from licenses granted by **THE UNIVERSITY** to non-members in accordance with this Agreement and **THE UNIVERSITY**'s Statement of Policy on Patents, Copyrights, and Licensing.
2. **THE UNIVERSITY** shall maintain the Center's principal office on **THE UNIVERSITY**'s Knoxville campus. At the present time, it is anticipated that the Center's work will be carried out in the facilities of **THE UNIVERSITY** of **TENNESSEE**. **THE UNIVERSITY** hereby reserves the right in its sole discretion to utilize such other personnel or facilities in carrying out the **CENTER**'s work as **THE UNIVERSITY** deems appropriate.
3. **THE CENTER** will keep **MEMBER** informed of the progress and results of research through the issuance of an annual report, and other means determined appropriate by **CENTER**.
4. Although **THE UNIVERSITY** intends that research undertaken by the **CENTER** will be conducted in accordance with accepted scientific principles on a reasonable effort basis, it does not guarantee the results of such work or that patentable inventions will result therefrom. **THE UNIVERSITY** specifically disclaims all warranties, either expressed or implied, as to the research to be performed by the **CENTER**. The parties agree that **THE UNIVERSITY** shall have no liability to **MEMBER** except the duties and obligations specifically stated herein.
5. Title to any and all results of the work performed pursuant to this Agreement, in whatever form, including any discoveries or inventions, whether patentable or not, computer software or firmware, copyright able matter, and trade secret material (hereinafter referred to as **CENTER TECHNOLOGY**) shall vest in **THE UNIVERSITY**. **CENTER TECHNOLOGY** shall also be deemed to include title to all copyrights and all patent applications and patents, both domestic and foreign, which are based on the results of work performed pursuant to this Agreement, as described in the immediately preceding sentence. No member or any representative or employee of same shall assert an ownership right in any patent based on information which becomes known to such member, representative, or employee solely as a result of participation in or support of the **CENTER**.
6. Consistent with **THE UNIVERSITY**'s Statement of Policy on Patents, Copyrights, and Licensing, its right in **CENTER TECHNOLOGY** may be assigned to The University of Tennessee Research Foundation (hereinafter referred to as **UTRF**). Therefore, all references to **THE UNIVERSITY** in this Agreement shall be deemed to include

UTRF when pertaining to copyright registration, the filing, prosecution, or maintenance of patent applications and patents, or the negotiation or execution of license agreements and the distribution of royalty income.

7. MEMBER certifies that it is an industrial company incorporated in the United States and agrees to comply with applicable state and federal statutes and regulations which may apply to this Agreement. MEMBER agrees to sign all documents and take any other action reasonably necessary for the protection of THE UNIVERSITY's title to CENTER TECHNOLOGY and for the filing, prosecution, and maintenance of patent applications and patents hereunder.

8. Upon execution of this Agreement, MEMBER agrees to pay to THE UNIVERSITY, for support of the CENTER, the sum of \$ _____ as payment of one year full membership fee. MEMBER may continue its membership on an annual basis in subsequent years by paying on or before the Anniversary Date each year the required membership fee as established by THE UNIVERSITY in accordance with Paragraph 8 herein.

9. As stated in the immediately preceding paragraph, MEMBER's annual membership fee for the first year of membership shall be \$ _____. THE UNIVERSITY shall, however, have the right to change the amount of the membership fee for any subsequent year by giving MEMBER at least twelve (12) months written notice of such change.

10. Subject to the provisions of Paragraph 15 herein, THE UNIVERSITY hereby grants to MEMBER a royalty-free, non-exclusive, non-transferable license to all CENTER TECHNOLOGY generated during any membership year in which MEMBER has paid the full required membership fee. In addition, MEMBER shall have the following rights during the period that full paid membership continues:

- a. Pre-publication access to research results.
- b. Right to attend seminars on research results.

11. THE UNIVERSITY, at its sole discretion, shall have the right to dissolve the CENTER at any time upon twelve (12) months written notice to all members. Such dissolution shall not constitute a breach of this Agreement, and THE UNIVERSITY shall incur no liability to MEMBER therefore.

12. THE UNIVERSITY shall have the right to grant any non-member company a non-exclusive, royalty-bearing, non-transferable license to CENTER TECHNOLOGY upon such terms as THE UNIVERSITY shall deem appropriate at the time of license negotiations. Companies becoming members after an invention under this Agreement has been reduced to practice may obtain a license under this paragraph in the same manner as companies not participating as members.

13. No license granted under this Agreement may be sub-licensed except to a subsidiary company of the original licensee. The term "subsidiary company" shall mean any corporation in which the original licensee owns more than fifty percent (50%) of the outstanding voting stock, defined as that stock ordinarily entitled to elect members of the Board of Directors.

14. THE UNIVERSITY, for itself and the research personnel of THE UNIVERSITY, reserves the right to publish in scientific journals and present at scientific meetings the results of research conducted under this Agreement. No such publication, presentation, or other public disclosure shall occur before the end of a six-month automatic moratorium, the beginning of which period shall start to run with submittal of a research paper or report to the member. During the six-month moratorium, MEMBER also agrees to keep such disclosures confidential in order to allow THE UNIVERSITY to evaluate the research results for patent purposes.

15. Should THE UNIVERSITY decide not to pursue patent protection for any particular invention, any member may request THE UNIVERSITY to file a patent application and THE UNIVERSITY shall be bound to do so, subject to the following provisions:
- a. When a member requests THE UNIVERSITY to pursue a patent application, whether domestic or foreign, such request shall be ineffective unless, at the time of making same, such member unconditionally agrees to be responsible for and pay all reasonable and necessary costs and expenses incurred in connection with the prosecution of such patent application and the maintenance of any resulting patent either in toto, or on a pro-rata basis with other members joining in such pursuit.
 - b. In the event a member requests THE UNIVERSITY to pursue a patent application, THE UNIVERSITY shall, upon receipt, give notice of such request to all other members, who will then have the right to join in such request in like manner as the original member so requesting same. A member failing to join in pursuit of a patent application, as provided for herein, shall waive all rights in said technology which otherwise may have inured to its benefit under Paragraph 10 hereof.
 - c. After appropriate request as set forth herein, THE UNIVERSITY shall diligently prosecute appropriate patent applications, and maintain regular reporting on the status thereof to the participating members.
 - d. Such applications shall be abandoned or terminated only upon the unanimous consent of all participating members.
 - e. In the event that more than one member participates in pursuit of a patent application as provided in this paragraph, and one or more of such members later elects to withdraw, each such withdrawing member shall be responsible for its pro-rata cost share through the date of such withdrawal, and shall waive all rights in said technology which otherwise may have inured to its benefit under Paragraph 10 hereof.
 - f. In the event that all participating members so withdraw, THE UNIVERSITY shall have the options of abandoning the application, pursuing the same at its own expense, or assigning or licensing the same pursuant to Paragraph 12 hereof, all without claim of right by any party having elected not to participate or having withdrawn from participation in the application.
 - g. If a member fails to participate in pursuit of a patent application at the onset, but later desires to join in and participate in such pursuit, it may do so only upon such terms and conditions as may reasonably be worked out between such party and THE UNIVERSITY and the participating members. The negotiation of such terms and conditions, however, shall be on a reasonable, good faith basis, on terms no less favorable than those offered or available to any non-member third party.
 - h. Any monies received by THE UNIVERSITY from licensing to a third party any patent application or patent which was filed or obtained under this paragraph shall be applied first to reimburse THE UNIVERSITY for its direct expenses of licensing and patenting pertaining thereto. Any remaining monies shall be applied to reimburse participating members on pro-rata basis for expenses of prosecuting and maintaining such patent application or patent incurred under this paragraph.
16. The parties agree that this Agreement shall not be deemed to prohibit any member of the CENTER or THE UNIVERSITY in association with any member (s) or other entities from engaging in sponsored research agreements covering research projects in the same scientific areas as those of the projects undertaken by the CENTER.
17. Any advertising or publicity relating to MEMBER's association with the CENTER shall be approved by THE UNIVERSITY and MEMBER prior to public release.

18. THE UNIVERSITY warrants that it has or will have in effect an agreement with THE UNIVERSITY employees who will conduct research at the CENTER, which agreements shall (a) vest in THE UNIVERSITY, or enable THE UNIVERSITY to acquire title to CENTER TECHNOLOGY in accordance with THE UNIVERSITY's Statement of Policy on Patents, Copyrights, and Licensing and subject to any march-in-rights which the United States government may otherwise possess and (b) otherwise permit the implementation of this Agreement as stated herein.

19. All notices and communications sent hereunder shall be in writing and shall for all purposes be deemed to be fully given and received on the date of delivery if and-delivered or three (3) days after the date of mailing when forwarded by registered or certified mail to the recipient's address as set out below:

A. If to **THE UNIVERSITY:**

Dr. Claudia J. Rawn
Director, Center for Materials Processing
513 East Stadium Hall
University of Tennessee
Knoxville, TN 37996-0750

B. If to **MEMBER:**

Either party may change its address by written notice duly given to the other party.

20. This Agreement shall not be binding until executed by both parties.

IN WITNESS WHEREOF, the parties have executed this Agreement by affixing hereto the signatures of their duly authorized representatives.

MEMBER

THE UNIVERSITY OF TENNESSEE

By: _____

By: _____

Associate Vice Chancellor
for Research Development

Title: _____