

Inventor Certification Form
For Provisional Patent Applications With Federal Funding

Institution: _____

Grant Number(s): _____ Federal Granting Agency EIR Number: _____

Title of Invention: _____

Inventor(s): _____

I am an inventor of the above-referenced subject invention and the current owner, identified above, has elected not to retain title to this invention or has agreed to assign this invention to me, and has permitted me to request that I be allowed to retain title pursuant to 37 CFR 401.9 and 35 U.S.C 35 202(d) or obtain title from the institution by assignment pursuant to 37 CFR 401.14(k)(1) and 35 USC 202(c)7. In support of the request that I be allowed to obtain title, I hereby certify that:

1. If allowed to retain or obtain title, I agree to be bound by any conditions imposed by the above-referenced institution, and at least those conditions that would apply to a small business firm under paragraphs (d)(1) and (3), (f)(4), (h), (I); and (j) of the clause at 37 CFR 401.14(a);
2. If allowed to retain or obtain title, I will seek patent protection for the subject invention within one year of the date of approval of title retention and provide the funding agency with documentation of the patent application number, filing date and inclusion of the Federal support clause;

And I certify, to the best of my knowledge and belief, that the statements herein are true, accurate, and complete. I understand that willful provision of false information is a criminal offense (Title 18 U.S. Code, Section 1001) and that any person making any false, fictitious, or fraudulent statement may, in addition to other remedies available to the government, be subject to civil penalties under the Program Fraud Civil Remedies Act of 1986 (45 CFR Part 79). I agree that the right to title to this invention shall immediately revert back to the U.S. Government if a patent application has not been filed on this subject invention within one year unless written approval is received from the federal granting agency for an extension of time.

(Information and signatures of additional inventors may be attached.)

Signature of Inventor Date: _____

Printed Name: _____

Street Address: _____

City, State, Zip Code: _____

Area Code / Phone Number: _____ E-mail: _____

(Information and signatures of additional inventors may be attached.)

As the authorizing official of the above-referenced institution or its invention management organization assignee, subject to the conditions attached hereto, I hereby approve the release of rights to the above-reference invention by the federal granting agency to all of the inventors if the institution has elected not to retain title, or alternatively, the institution requests the federal granting agency's permission to assign those rights to the inventors.

Authorizing Official's Signature and Title Date: _____

Organization (if other than Institution)

Continue: Patent-Related Information and Institution Conditions

Patent-Related Information

- 1. Date of patent application filing: _____
U.S. Serial Number (if any): _____
- 2. Date of presentation at a conference or symposium on which invention was disclosed (if applicable): _____
- 3. Publication information for article concerning this invention:
Date of Submission: _____
Date of Acceptance: _____
Date of Publication: _____
Publication Pending: _____
Citation: _____

Institution Conditions

This offer to transfer the patent rights to a technology to you is contingent upon your agreement to the following conditions:

- 1. You must file a regular, non-provisional patent application that claims priority to the provisional patent application referenced above.
- 2. You must successfully obtain an assignment of rights from your funding source to all of the University of Virginia (U.Va.) inventors listed on the patent or patent application. This offer is contingent on your funding source granting such an assignment upon receipt of this completed form.
- 3. You must disclose to the U.Va. Patent Foundation any and all (i) companies that you aware of which now have or previously had an interest in licensing or otherwise acquiring any of the patent rights; (ii) start-up companies that you have founded, are in the process of founding, or plan to found; and (iii) companies in which you and/or your immediate relatives own or have the right to acquire equity (other than via an individual retirement account) that exceeds 3 percent of the company's total equity or exceeds a value of \$10,000. You must agree not to license or assign any of the patent rights to any such entity, unless the U.Va. Patent Foundation has first consented to such license or assignment in writing.
- 4. Your funding source may have imposed requirements (e.g., non-exclusive research licenses, royalty sharing) as a condition of awarding the original grant, and your rights would be limited by those pre-existing obligations.
- 5. U.Va. and the U.Va. Patent Foundation retain a non-exclusive, fully paid-up right to practice under the patent rights for education, research, patient care and treatment, and other internal purposes. In order to avoid constraints on the inventors' future academic research, this same right regarding education and research also extends to any not-for-profit institution that employs or has employed you or any co-inventor who incorporates the invention into his or her research program during such employment.
- 6. As long as you are a U.Va. employee, you are subject to the requirements of the U.Va. Patent Policy and the federal Bayh-Dole Act, which require you to disclose to the U.Va. Patent Foundation any future inventions you make using U.Va. resources, even if those inventions are related to this invention.
- 7. You must agree not to use or allow your licensees or assignees to use the patent rights to block the U.Va. Patent Foundation or any of its licensees from commercializing any other inventions made by you or others at U.Va.
- 8. If you license or otherwise transfer the rights to a company that had declined a license from the U.Va. Patent Foundation prior to the date of this letter, you must notify the Patent Foundation and pay the foundation a reasonable royalty.