

Memorandum of Understanding
Between
Memorial University of Newfoundland
And

Memorial University of Newfoundland of Faculty of Association

"Without Prejudice"

✓ E-MAILED AF+16

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-12- 16 2016

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In full and final settlement of Association Grievance A-14-16 (Researcher Participation Agreement) the parties agree that:

1. The Researcher Participation Agreement ("RPA"), a copy of which is attached as Schedule A, shall only be used in respect of Research Contracts that contain any Third Party License or Third Party Assignment. It will not be used in respect of TriCouncil funding, except where such funding is leveraged and/or is to be used for a Project that is the subject of such a Research Contract. The execution and delivery to the University by the Principal Investigator of a signed RPA shall be a precondition to the execution by the University of the corresponding Research Contract; provided however nothing in this section abrogates from the right of the University to determine the terms and conditions of the applicable Research Contract.
2. Where the University negotiates a Research Contract, it shall take reasonable efforts not to assign or license Research Data to any third party. For the purpose of this MOU, "Research Data" means "the recorded factual material commonly accepted in the scientific community as necessary to validate research findings". In addition, "reasonable efforts" means as follows:
 - (a) Subject to paragraphs (b),(c), (d) and (e) below, the University shall request that the following language be included in the Research Contract (as defined in the RPA):

"Notwithstanding anything else in this Agreement, no right, title or interest in or to any Memorial Research Data is granted to any other party. 'Memorial Research Data' means the recorded factual material commonly accepted in the scientific community as necessary to validate research findings, as generated, created or collected by Memorial researchers, faculty and/or students."
 - (b) Where the Project (as defined in the RPA) involves the collaboration of one or more University researchers with one or more third party researchers ("Collaborators"), there shall be no obligation to insert the above language into the applicable Research Contract, provided that all Collaborators shall be entitled to access Research Data for the purpose of the Project, including the validation of research findings. Where the Research Contract involves both Collaborators and non-Collaborators, the University shall seek to include the above language in the

Research Contract modified to ensure the non-Collaborators do not obtain any right, title or interest in or to any Memorial Research Data. The University shall rely on the applicable Principal Investigator for the purpose of determining who constitutes a "Collaborator".

- (c) Where a third party refuses to include the above wording in a Research Contract, or is willing to include modified wording in a Research Contract, the University shall notify the Principal Investigator of this. If the Principal Investigator elects to proceed with the Research Contract without including the above language, or with the inclusion of modified language, the University shall be free to proceed and will be deemed to have made reasonable efforts for the purpose of this section 2 of the MOU.
- (d) A modification by the University of the language set out in paragraph (a) shall not in and of itself constitute a breach of the University's obligation to make "reasonable efforts" pursuant to this section 2 of the MOU where the spirit and intent of the modified language is in keeping with the spirit and intent of paragraph (a).
- (e) Where a Principal Investigator notifies the University in advance that (s)he does not wish to seek to have the language set out in paragraph (a) included in the Research Contract, the University shall be under no obligation to make any request of the third party(ies) to the Research Contract to include such wording or similar wording. In such case, the obligations of the University set out in this section 2 of the MOU shall not apply.

3. Capitalized terms used in this MOU that are not otherwise defined herein shall have the meaning attributed to them in the Research Participation Agreement attached as Schedule A.



Basil Kavanagh (for)
Memorial University of Newfoundland
Faculty Association



Ian McKinnon (for)
Memorial University of Newfoundland

Nov 16/2017
Date

Dec 16/16
Date

Schedule A

RESEARCHER PARTICIPATION AGREEMENT

(Not for Use with Students)

For the purpose of facilitating the research project described below (the "Project"), Memorial University of Newfoundland ("Memorial") must enter into an agreement with a third party or parties. In order for Memorial to meet its contractual obligations with the third parties in relation to the Project, the researchers involved in the Project and Memorial must enter into an agreement as to their respective rights and obligations with respect to the Project. As such, Memorial and the researcher named below (the "Researcher") have agreed to sign this Researcher Participation Agreement (the "Agreement") prior to participating in the Project. This Agreement covers matters relating to intellectual property, including the rights of each party to ownership, licensing, and/or access to any intellectual property generated by or used in the Project, publication, confidentiality and liability. To understand the impact of this Agreement on the Researcher, including the Researcher's intellectual property rights, it is necessary that this Agreement be read in conjunction with the Research Contract between Memorial and the third party or parties.

THIS FACULTY RESEARCHER PARTICIPATION AGREEMENT ABROGATES FROM CERTAIN RIGHTS SET OUT IN THE COLLECTIVE AGREEMENT BETWEEN MEMORIAL AND THE MEMORIAL UNIVERSITY OF NEWFOUNDLAND FACULTY ASSOCIATION, INCLUDING ARTICLE 20: COMPLAINTS, GRIEVANCE AND ARBITRATION, AND ARTICLE 27: PATENTS AND COPYRIGHTS.

Researcher: _____
Name

Address _____
Number Street

Address _____
City Prov. Postal Code

Date of Execution: _____ Email: _____
Date

Project: _____

Principal Investigator: _____

Project Sponsor(s): _____

ROMEO No.: _____

In consideration of the benefits to Memorial and the Researcher in participating in the Project, and other good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the Researcher and Memorial agree as follows:

Article 1 Definitions

Capitalized terms used in this Agreement shall have the meanings set forth below.

- 1.1 **"Assigned IP"** means the Project IP that is the subject of a Third Party Assignment.
- 1.2 **"Background Intellectual Property"** means all Intellectual Property and all Intellectual Property Rights therein, other than Project IP and Intellectual Property Rights in the Project IP.
- 1.3 **"Confidential Information"** means anything and any information that is required to be kept confidential pursuant to the Research Contract.
- 1.4 **"Intellectual Property"** includes all data, documents, reports, analyses, tests, specifications, charts, plans, drawings, ideas, inventions, discoveries, creations, schemes, correspondence, communications, lists, manuals, technology, techniques, methods, processes, services, routines, systems, procedures, practices, operations, modes of operations, know-how, trade or other secrets, contracts, financial information, engineering reports, environmental reports, field notes, sketches, photographs, computer programs, records or software, specifications, models, database rights, service marks, scientific or technical advancements, improvements, devices, products, concepts, designs, prototypes, samples, technical information, materials, works of authorship, patterns or other information, and includes the media on which such Intellectual Property is stored, obtained or received.
- 1.5 **"Intellectual Property Rights"** means any and all proprietary rights anywhere in the world provided under (i) patent law, (ii) copyright law, (iii) design patent or industrial design law, (iv) semi-conductor chip or mask work or integrated circuit topography law, (v) trade-mark law or (vi) any other statutory provision or common law principle, including trade secret law, which may provide rights in Intellectual Property or the expression or use of such Intellectual Property.
- 1.6 **"Licensed IP"** means the Project IP that is the subject of a Third Party License.
- 1.7 **"Memorial IP Policies"** means the Intellectual Property Policy of Memorial and applicable collective agreements, as each may be amended or replaced from time to time.
- 1.8 **"Principal Investigator"** means the Principal Investigator(s) of the Project.
- 1.9 **"Project IP"** means all Intellectual Property arising or resulting from or created, conceived, developed or produced in the course of the Project, whether in oral, written or other form, together with all Intellectual Property Rights therein.
- 1.10 **"Research Contract"** means the contract or funding agreement in final form as will be executed by Memorial and the Project Sponsor(s) in relation to the Project, whether or not the Researcher or other researchers involved in the Project are also parties to that contract or funding agreement.
- 1.11 **"Third Party License"** means a grant of rights in any Project IP to any third party, where such rights are not fully assigned to the third party, or a grant to any third party of contingent or future right(s) to receive a license or sublicense of any Project IP (including an option or right of first refusal).

- 1.12 "Third Party Assignment" means a full assignment of rights in any Project IP to any third party or a grant to any third party of contingent or future right(s) to receive an assignment of any Project IP (including an option or right of first refusal).

Article 2 Licensing and Assignment of Project IP

- 2.1 The Researcher acknowledges that in reliance on the mutual covenants of this Agreement, Memorial will enter into the Research Contract and permit the Researcher to participate in the Project. Memorial represents and warrants that (i) it has disclosed the Research Contract, in its final form, to the Researcher; (ii) it has disclosed in writing to the Researcher all other agreements affecting the Project IP of which it is aware as of the date of execution of the Research Contract; and (iii) it will disclose to Researcher in a timely manner any further agreements or amendments to agreements affecting the Project IP it executes in the future. The Researcher therefore agrees as follows:
- (a) Where the Research Contract contains a Third Party License, the Researcher hereby irrevocably licenses to Memorial the Researcher's interest in the Licensed IP; provided, however, the license by the Researcher under this paragraph shall only be to the extent necessary to enable Memorial to sublicense the Licensed IP in accordance with the Third Party License and to enable Memorial to comply with the Research Contract;
 - (b) Where the Research Contract contains a Third Party Assignment, the Researcher hereby irrevocably assigns to Memorial the Researcher's interest in the Assigned IP; provided, however, the assignment by the Researcher under this paragraph shall only be to the extent necessary to enable Memorial to grant rights in the Assigned IP in accordance with the Third Party Assignment and to enable Memorial to comply with the Research Contract; and
 - (c) Where the Research Contract makes provision for the joint ownership of any Project IP between Memorial and any third party or third parties ("Joint Project IP"), the Researcher shall be deemed to hereby irrevocably assign to Memorial the Researcher's interest in the Joint Project IP and agrees that he or she shall have no right, title or interest in or to such Joint Project IP except the non-exclusive, royalty-free right to use such Joint Project IP for non-commercial academic, research and educational purposes, subject always to the limitations set out in section 4.2 hereof. In the event Memorial obtains any compensation, including royalties, in respect of such Joint Project IP, it shall share such compensation with the Researcher and other Project researchers in accordance with section 2.4 hereof.
- 2.2 Where the Researcher is a Principal Investigator, the Researcher will promptly disclose all Project IP to Memorial so that Memorial may comply with the terms of the Research Contract and, where the Researcher is not a Principal Investigator, to the Principal Investigator.
- 2.3 The Researcher agrees, upon request of Memorial, to do all acts and things and to execute such further and other documents, including all licensing and assignment documentation, instruments and papers, as may be reasonably necessary to enable Memorial to comply with the terms and conditions of the Research Contract.
- 2.4 The Researcher acknowledges that the terms of compensation, including royalties, payable to the Researcher in respect of the Licensed IP, the Assigned IP or any Joint Project IP, if any, shall be as set out in the Research Contract and/or Memorial IP Policy, as applicable. In the case of conflict, the terms of the Research Contract shall govern. In the case that neither the Research Contract nor the Memorial IP Policy contains terms of compensation to the Researcher, the Researcher shall have no right to compensation.
- 2.5 Where a Third Party License terminates or expires, the license granted under this Agreement by the Researcher to Memorial to enable Memorial to grant such Third Party License shall terminate or expire at

the same time. Thereafter, the rights of Memorial in such Licensed IP shall be as determined by the applicable Memorial IP Policy. In the event the Licensed IP is subject to multiple Third Party Licenses pursuant to the Research Contract, then Memorial shall retain rights in such Licensed IP to enable it to grant and comply with the remaining Third Party Licenses.

- 2.6 The Researcher may request that Memorial re-assign Assigned IP or a part thereof by submitting a request to Memorial in writing. Such request may only be submitted once the rights of all third parties in the Assigned IP or the part thereof that is the subject of the request, as the case may be, have been ascertained and all such rights of the third parties have been exercised or expired. Memorial shall, within four weeks of receipt of such request, re-assign to the Researcher that part of the Assigned IP that (i) does not need to be retained by Memorial in order to enable it to meet its obligations under the Research Contract, and (ii) the Researcher would be entitled to own (but for the Research Contract) pursuant to the Memorial IP Policies that are applicable to such Assigned IP.
- 2.7 Notwithstanding anything else in this Agreement, Memorial and the Researcher shall retain the royalty-free, perpetual, non-exclusive right to use the Licensed IP or Assigned IP for non-commercial academic, research and educational purposes. Either party may, in its sole discretion, waive that party's right in writing where it deems it appropriate to do so.
- 2.8 All requests by the Researcher to re-assign Assigned IP pursuant to this Agreement shall be submitted in writing to Research Grant and Contract Services at Memorial.

Article 3 Background Intellectual Property

- 3.1 Where the Researcher is not the Principal Investigator, she or he agrees not to use in relation to, or incorporate into, the Project any Background Intellectual Property without the prior written consent of the Principal Investigator. The Researcher represents and warrants that, to his or her actual knowledge, any Background Intellectual Property he or she uses in relation to or incorporates into the Project does not, as of the date such Background Intellectual Property is so used or incorporated, infringe any third party proprietary or other rights.
- 3.2 Where the Researcher is also the Principal Investigator, he or she shall take reasonable efforts to ensure that no person uses in relation to, or incorporates into, the Project any Background Intellectual Property that may infringe any third party proprietary or other rights.

Article 4 Confidentiality and Publication

- 4.1 The Research Contract contains the following publication restrictions (CHECK ONE):
 - No publication restrictions.
 - Publication permitted on the terms set out in the Research Contract, which are in accordance with NSERC's Policy on Intellectual Property.
 - Other:

- 4.2 The Researcher agrees to maintain all Confidential Information in confidence in accordance with the terms of the Research Contract, as if the Researcher was a party to such Research Contract in place of

Memorial. The Researcher further agrees to use such Confidential Information solely for the purpose of the Project.

- 4.3 The Researcher agrees not to publish or disclose any Project IP except as expressly permitted pursuant to the Research Contract and further agrees that the terms of the Research Contract shall apply to all publications and disclosures prepared by the Researcher which relate to the Project or the Project IP.

Article 5 Other

- 5.1 The Researcher represents and warrants he or she has not made and will not make any commitments to any third parties that are inconsistent with or conflict with the Researcher's obligations under this Agreement or the Research Contract.
- 5.2 The Researcher agrees to (and where the Researcher is also the Principal Investigator agrees to use best efforts to cause all researchers participating in the Project to), diligently undertake the work and services comprising the Project including, without limitation, the obligation to deliver any deliverables, and to maintain all records relating to the Project, in accordance with the terms of the Research Contract and applicable professional and ethical standards.
- 5.3 Where the Researcher is also the Principal Investigator, (s)he shall not permit any person to participate in the Project without first receiving from such person a duly executed "Researcher Participation Agreement" and such other documents as may be required by Memorial. The Principal Investigator agrees to maintain all such signed agreements on file and to provide such documents to Memorial as it may direct.
- 5.4 The Researcher agrees to execute and deliver such further documents, assignments and instruments and provide such assistance as may be deemed necessary by Memorial in respect of the Project, including without limitation any assignment or license of Intellectual Property or Intellectual Property Rights necessary to enable Memorial to comply with the terms of the Research Contract. Where the Researcher is also the Principal Investigator, (s)he further agrees to make best efforts to ensure all researchers that participate in the Project adhere to this section.
- 5.5 The Researcher agrees to (and where the Researcher is also the Principal Investigator, he or she agrees to use best efforts to cause all researchers participating in the Project to) fully comply with all of Memorial's policies in effect from time to time including without limitation the Memorial IP Policies and the Integrity in Scholarly Research Policy.
- 5.6 The Researcher agrees to act at all times in accordance with all laws, regulations and orders of authority having jurisdiction that may be applicable to the Project.

Article 6 Term and Termination

- 6.1 This Agreement shall take effect on the earlier of the Date of Execution and the date upon which the Researcher commences participation in the Project (the "Effective Date") and it shall remain in effect until the later of the date upon which all obligations of Memorial pursuant to the Research Contract have been completed and the date upon which the Research Contract applicable to the Project has been terminated.
- 6.2 The provisions of Article 1, 2, 3, 4 and 7 and Sections 5.2, 5.3, 5.4 and this Section 6.2 shall survive termination or expiry of this Agreement.

Article 7 Miscellaneous

- 7.0 If a dispute arises out of, or in connection with, this Agreement and the parties do not resolve the dispute through negotiation within 15 working days, then either party may refer the dispute to a single arbiter for binding arbitration pursuant to the terms of the Arbitration Act, R.S.N.L. 1990, c. A-14, as amended.
- 7.1 This Agreement and the rights and obligations of the parties hereunder shall be governed by and construed and interpreted in accordance with the laws in effect in the Province of Newfoundland and Labrador and the federal laws of Canada applicable therein. The Researcher attorns to the exclusive jurisdiction of the courts of Newfoundland and Labrador.
- 7.2 Neither this Agreement nor any other agreement or document executed by the Researcher in relation to the Project may be assigned by the Researcher without the prior written consent of Memorial. Any purported assignment in violation of this clause shall be void and of no force or effect.
- 7.3 All notices and other communications required under this Agreement shall be in writing and shall be addressed to the parties at the addresses or facsimile numbers set forth below, or to such other addresses or facsimile numbers one party specifies to the other by notice:
- (a) if to the Researcher, at the address shown on the first page of this Agreement; and
- (b) if to Memorial, at:
- Vice President (Research)
Memorial University of Newfoundland
St. John's, NL A1C 5S7
Fax: (709) 864-2552
- 7.4 This Agreement can be amended only by written document signed by both parties.
- 7.5 The Researcher represents and warrants that he or she is at least 19 years of age as of the date of execution of this Agreement.
- 7.6 The parties each acknowledge and agree that their respective obligations under this Agreement and any other agreement or document executed by them in respect of the Project shall survive the termination or expiry of same and termination or completion of the Project. The Researcher further agrees that such obligations shall continue notwithstanding that he or she is no longer associated with the Project or with Memorial, whether as an employee, student or otherwise.
- 7.7 The Researcher acknowledges having been advised to seek and having been given the opportunity to obtain independent legal and other advice concerning the interpretation and effect of signing this Agreement and participating in the Project. The Researcher further acknowledges having been provided with a copy of the Research Contract and a reasonable opportunity to review such Research Contract prior to signing this Agreement.
- 7.8 To the extent of any inconsistency between any provision of this Agreement and any other document or instrument executed by the Researcher in relation to the Project, the provisions of this Agreement shall take precedence. To the extent of any inconsistency between any provision of this Agreement and the Research Contract, the provisions of the Research Contract shall take precedence.
- 7.9 The Researcher acknowledges and agrees that this Agreement constitutes an external, research or development contract for the purposes of the Memorial IP Policies.

- 7.10 This Agreement, together with the Research Contract(s) and, if the Project is subject to more than one Research Contract, such other contracts, embodies the entire agreement between the Parties hereto with respect to the Project and supersedes all prior agreements, representations, understandings, negotiations and discussions, whether oral or written related specifically to the Project.
- 7.11 If any provision of this Agreement or the application of it to any person or circumstance is invalid or unenforceable to any extent, the remainder of this Agreement and the application of such provision to any other person or circumstances shall not be affected or impaired and will be valid and enforceable.
- 7.12 This Agreement may be executed in one or more counterparts each of which, including any fax or other electronic image of any executed pages of the Agreement, shall for all purposes be deemed to be an original and all of which, when taken together, shall constitute one and the same instrument. This Agreement may be executed and delivered by facsimile or other electronic transmission, and a fax or other electronic image of the Agreement may be treated as an original instrument.

By virtue of the presentation of this Agreement for execution by Memorial to the Researcher, this Agreement shall be deemed to be executed by Memorial as of the Effective Date, and upon signature by the Researcher below, be binding upon the Researcher as of the Effective Date:

Witness

Researcher

By: _____

By: _____

Name: _____

Name: _____

Date: _____

Date: _____