

**EUFOOD-STA: EUROPEAN FOOD STUDIES & TRAINING ALLIANCE**

554312-EPP-1-2014-1-AT-EPPKA2-KA

January 2015-April 2018

**Deliverable D8.6**

**Template IPR Agreement (for collaborative research)**

**Prepared by:** Sara Proença (IPC)

**Contributors:** Rui Costa (IPC); Mariana Marques (Frulact)

**Delivery date:** M39

Dissemination Level		
<b>PU</b>	Public	x
<b>PP</b>	Restricted to other programme participants (including Commission services and projects reviewers)	
<b>CO</b>	Confidential, only for members of the consortium (including EACEA and Commission services and projects reviewers)	

**Summary:**

The scope of this document is to provide templates for IPR management in the context of university-industry collaborative research.

The first template is applicable to R&D results and the second one is applicable to stay periods of teachers or students in companies.

Note: These templates are based on models provided by the Portuguese Institute of Industrial Property.



## **Content**

R&D Results Ownership Agreement .....	3
Bilateral Confidentiality Agreement .....	9

The European Commission support for the production of this publication does not constitute endorsement of the contents which reflects the views only of the authors, and the Commission cannot be held responsible for any use which may be made of the information contained therein.

### **Project Coordinator:**

GERHARD SCHLEINING | BOKU – Universitaet fuer Bodenkultur Wien | [office@food-sta.eu](mailto:office@food-sta.eu)

## R&D RESULTS OWNERSHIP AGREEMENT

---

Between:

..., with its registered office at ..., legal person n<sup>o</sup>..., represented by ..., in his/her capacity of ..., having legal and statutory powers of representation, as the First Party, hereinafter RD;

and

..., with its registered office at ..., legal person n<sup>o</sup>..., represented by ..., in his/her capacity of ..., having legal and statutory powers of representation, as the Second Party, hereinafter COMPANY;

Whereas:

- The parties are involved in the ongoing research action/project identified as "...";
- The distinct intellectual and financial capacities of the RD and the COMPANY for said action/project are recognized;
- The feasibility of commercial exploitation and consequent market value of the research results emerging from said action/project;
- The need to protect said results, namely through patent rights;
- The will of the contracting parties to establish ownership of the intellectual property rights to said results and the criteria for sharing the costs for that protection and possible revenue resulting from commercial exploitation;
- The desired operability in terms of the possible licensing of the exclusive right to be constituted.

The above identified parties enter into this R&D RESULTS OWNERSHIP AGREEMENT, which is governed by the following clauses:

## **CLAUSE ONE**

(Object)

The purpose of this contract is to:

- a) Determine ownership of the rights to the R&D results of the aforementioned research action/project;
- b) Entitle one Party to apply for a patent right claiming those R&D results;
- c) Establish the formula for sharing revenue arising from commercial exploitation of the said R&D results;
- d) Ensure current management of the patent right and other parties' rights and obligations.

## **CLAUSE TWO**

(Scope)

- a) The above-mentioned research action/project falls within the particular specialist/technical field of..., and is aimed at developing a solution...
- b) The research action/project shall observe the following work plan: ...

## **CLAUSE THREE**

(Intellectual Property Rights)

- a) The intellectual property rights on all the R&D results arising from the research action/project are granted, definitively and unconditionally, under payment, to the COMPANY.
- b) In conformity with the above, the COMPANY is the sole and exclusive holder of the right to request protection of said R&D results by means of patent right or utility model, and is responsible for defining the scope of protection and for all expenses with prior art researches, drafting and submission of patent applications or utility model rights and their subsequent maintenance, namely the payment of fees, annuities and all expenses to be borne for the guardianship and protection of said industrial property rights.
- c) If the COMPANY is not interested in applying for protection of the research results, the RD will hold the rights for the invention and may solely apply for the respective protection and at its own expense.
- d) In exercising the right provided for in b), the COMPANY undertakes to identify, as inventors, the following workers/managers of RD, on any application for patent right: ...  
[FULL NAMES]



- e) The COMPANY owns the exclusive right to use, reproduce, exploit and market said results, at its own initiative or that of a third party, without prejudice to the special rights attributed to the RD in Clause Five and the remuneration provisions established in Clause Six herein.

#### **CLAUSE FOUR**

(Background Knowledge)

The COMPANY is expressly authorised to use and benefit from the pre-existing knowledge mobilised by the RD in the context of the R&D action/project.

*[The COMPANY will likewise own the rights to all associated know-how resulting from the action/project described and better identified in Annex ...]*

#### **CLAUSE FIVE**

(Future Projects)

- a) The RD retains the right to carry out research and development activities based on the results of the research action/project, either on its own or in cooperation with any other entity, regardless of its nature, in any similar areas and regardless of whether the applications in question may compete with any COMPANY activities, provided that the latter's intellectual property rights are safeguarded, as well as confidentiality obligations set forth in Clause Seven.
- b) The RD shall own the intellectual property rights on all R&D results achieved within the scope of the activities provided for in a); the COMPANY has no rights, licences or options on these whatsoever, unless otherwise contractually stipulated.
- c) The ID and the COMPANY may carry out other R&D projects in the future on the basis of the R&D results regulated in this agreement.
- d) All new R&D projects involving the parties shall have their own separate agreements, which shall not be conditioned by the options agreed upon by the parties in this agreement.

#### **CLAUSE SIX**

(RD Compensation)

- a) In return for effective granting to the COMPANY of all intellectual property rights on R&D results arising from the research action/project, the latter undertakes to pay financial compensation to the RD as follows.

- b) The COMPANY undertakes to pay to the RD the initial sum of EUR \_\_\_\_\_.00 (... euros), plus VAT at the legal rate in force. This amount shall be paid upon conclusion of the R&D work and notification thereof by the RD.

The payment provided for in b) shall be effected by the COMPANY as the R&D work to be carried out progresses, in accordance with the following milestones:

- ...% upon the signing of this agreement;
- ...% within ... (...) months after the date on which the agreement is signed;
- ...% within ... (...) months after that date;
- ...% at the end of ... (...) of validity of the contract.

- c) In addition to the initial payment provided for in b) , the COMPANY undertakes to pay the royalties indexed to effective exploitation of the results of the research action/project, in accordance with the following:

A percentage of ...% (... per cent) of the net profits perceived.

- d) Net profits are defined as all revenue received by the COMPANY arising from exploitation of the results of the research action/project minus all direct and indirect costs incurred for their protection and for the marketing efforts:

- For the incorporation and marketing of the results in its own products;
- For all services to third parties making use of the same results;
- For patent licensing and for the sale, or any other form of definitive transfer of any patent rights claiming all or part of the R&D project results;
- For the licensing of industrial secrets or know-how;
- For the sale, or other means of definitive transfer, of said results.

- e) The net profits referred to above shall be determined on a 6 (six) – month basis by the COMPANY (January to June and July to December of each calendar year).

- f) The amounts payable for royalties shall be paid by the COMPANY to the RD within a period of no more than 90 (ninety) days after the end of each 6 (six) – month period.

- g) The parties recognise that the amounts established in this clause are a fair and equitable compensation, at market prices, for the mobilisation and transfer of the RD's pre-existing knowledge and other specific research work applied in this project.

- h) The COMPANY acknowledges and accepts the right of the RD to periodically, at its own cost, audit the COMPANY accounts provided that it gives 30 (thirty) days' written notice thereof.

- i) If 3 (three) consecutive 6 (six) - month periods for royalty determination lasts without the COMPANY receiving any revenue, the latter undertakes to grant the RD a free and non-exclusive exploitation licence that is not limited in time and has the option of sub-licensing on all research results covered by this agreement.



## **CLAUSE SEVEN**

(Confidentiality and Scientific/Academic Publications)

- a) The parties acknowledge and accept a duty of confidentiality in relation to all technical, scientific, commercial and internal organisational information, regardless of the form of disclosure or the support medium of such information, to which each has access regarding the activities of the counterparty within the scope of this agreement or the preliminary negotiations leading to its conclusion.
- b) The duty of confidentiality extends to all parties' staff members that are involved in activities on the premises of the counterpart, or in any place chosen by it, that have to do with execution of this agreement and R&D work regulated herein.
- c) The duty of confidentiality does not comprise information that is in the public domain or is freely accessible and all other information disclosed with express waiver of confidentiality. All RD staff members involved in the R&D work covered by this agreement have the right to publish information of an academic/scientific nature.
- d) The disclosure of information must respect the demands of confidentiality and always requires the prior authorisation of the COMPANY.
- e) The COMPANY shall be informed in advance by the interested party of the information to be disclosed and the particular form of dissemination and shall respond within a maximum period of 15 (days) from the date of acknowledgement of the intended content and the projected form of dissemination. Should the COMPANY fails to respond within said period, the dissemination shall be considered authorised, with the COMPANY recognising that it cannot, in any way, make the disclosing party and/or the RD liable for any damage resulting from the disclosure, namely in terms of lack of novelty industrial property right protection.
- f) The duty of confidentiality provided for in this clause binds the parties for a period of 5 (five) years beginning on the date of the particular disclosure of the information, regardless of whether this agreement is terminated for any reason beforehand.

## **CLAUSE EIGHT**

(Unforeseeable Circumstances)

- a) Neither of the parties shall be made liable if, due to unforeseeable circumstances or a situation of force majeure, namely strikes or other collective industrial conflicts, it is unable to comply with its obligations in this agreement in a timely fashion.
- b) The party invoking unforeseeable circumstances or force majeure shall communicate and justify such a situation to the other party, informing it of the expected period for re-establishing normal conditions.



## **CLAUSE NINE**

(Liability)

- a) Failure by one of the parties to comply with obligations arising from this agreement confers upon the other party, under the general applicable Law, the right to terminate the agreement, without prejudice to corresponding legal compensation.
- b) For the purposes of the preceding paragraph, definitive non-compliance is defined as a delay in compliance with contractual obligations of more than 30 (thirty) working days.

## **CLAUSE TEN**

(Duration and Termination)

- a) This agreement enters into force immediately after it is signed and shall remain in force:
  - For a period of 20 (twenty) years beginning on the date of exploitation of the research results;or
  - For a period of 20 years beginning on the date of submission of the first patent application for said research results or a part of them;Whichever of the two is the longest.
- b) The agreement can be revoked at any time or partly revised through the unanimous agreement of the parties. Such an agreement must observe written form and must be annexed to this agreement.

## **CLAUSE ELEVEN**

(Law and Conflict Resolution)

- a) This agreement is subject to ... Law.
- b) For settlement of any disputes arising from this agreement, the District Court of... shall be the competent court.

DATE AND SIGNATURES OF THE PARTIES



## BILATERAL CONFIDENTIALITY AGREEMENT

---

Between:

..., with its registered office at ..., legal person n<sup>o</sup>..., represented by ..., in his/her capacity as ..., with powers of representation under the Law, as the First Party

*[..., ID n<sup>o</sup> ..., issued on ... by the ... Identification Service, tax number ..., address ..., as the First Party] – Individual person*

and

..., with its registered office at ..., legal person no. ..., represented by ..., in his/her capacity as ..., with powers of representation under the Law, as the Second Party

*[..., ID n<sup>o</sup> ..., issued on ... by the ... Identification Service, tax number ..., address ..., as the Second Party] – Individual person*

Whereas:

- Contacts have been initiated by the parties for the purpose of ...;
- There is a need in this context to exchange restricted and/or non public information between the parties;
- Said information is a critical asset of the parties, with its own value, irrespective of whether or not any cooperation instrument is signed between them or between one of them and any third parties;

The parties enter into this CONFIDENTIALITY AGREEMENT, which is subject to the following clauses:

### CLAUSE ONE

(Object)

- a) The aim of this agreement is to guarantee the confidentiality and protection of the information classified as protected, confidential, non public or other similar description exchanged by the parties with the exclusive purpose fixed in Clause Two below.



- b) Protected or confidential information, hereinafter referred to generally as the “Information”, is all information that, irrespective of the medium used, comprises:
- Unpublished works of any nature, such as graphic, written or sound;
  - Unpublished compilations or selections of information;
  - Financial documents;
  - Know-how, technological data, methods, formulas, demonstrations, samples or studies;
  - Computer programs, software or software programming blocks in the form of source code or object code;
  - Commercial documents, such as customer lists;
  - Reports, drafts and memoranda;
  - Any intellectual assets, as a set of any and all research results, whether or not they are protected by any industrial property right;
  - Any other information disclosed by the Disclosing Party to the Recipient in said context.
- c) In the meaning set out in this agreement, the parties shall be called the “Disclosing Party” and “Recipient” in accordance with their capacity in the exchange of Information to be regulated.

## **CLAUSE TWO**

(Purpose of disclosure and duty of confidentiality)

- a) The Information shall be disclosed for the exclusive purpose of ... .
- b) The First and Second Parties undertake not to use, disclose or transfer, for any reason or interest, the information disclosed by the other party for any purpose other than that set out in a), unless authorised to do so in writing by the Disclosing Party.
- c) The Recipient must protect the information disclosed by the Disclosing Party using the same degree of care that it uses to prevent the unauthorised dissemination and publication of its own information.
- d) The Recipient shall take all necessary measures to prevent improper use of the information by any person who has access to it and guarantee the appropriate means to prevent the disappearance or loss of the information. It shall always inform the Disclosing Party of the occurrence of incidents of this nature, although said notification does not rule out its liability.



- e) The Recipient undertakes to return any copies, excerpts or parts of the Information referred to in 1.b) above within 8 (eight) days on mere request on the part of the Disclosing Party.

### **CLAUSE THREE**

(Ownership and integrity of the information)

- a) The Information is the exclusive property of the Disclosing Party.
- b) Disclosure of the Information to the Recipient does not grant it any intellectual property right, authority to apply for protection of any rights or any licence for any right or pending application for an industrial property right related to any information.
- c) The Disclosing Party does not directly or indirectly warrant any kind of protection of the Information, namely by copyright or industrial property rights under this agreement.
- d) The Recipient agrees and acknowledges that this agreement does not restrict the Disclosing Party's right to modify the information without prior notice.
- e) Said modifications do not entail any responsibilities for the Disclosing Party nor do they oblige it to develop, announce, hand over, maintain or finance any products or business plans based on the Information.

[TO BE INSERTED IF THE RECIPIENT IS A LEGAL PERSON (COMPANY, NON-PROFIT, R&D, UNIVERSITY)]

### **CLAUSE ...**

(Internal Disclosure of the Information)

The Recipient shall limit the disclosure of the Information to managers and employees to the extent that is strictly necessary for the purpose of this agreement. It shall give them appropriate instructions to this effect and enter into an equivalent written confidentiality agreement with them. The Recipient shall be fully liable to the Disclosing Party for its staff compliance with the commitments established herein and the Disclosing Party may claim proof of these agreements from the Recipient at any time.

### **CLAUSE FOUR**

(Duration)

- a) This agreement shall come into full effect on the date of signing by both parties and the recipient shall be bound by this confidentiality commitment on the exact terms stipulated above for a period of... (...) years from the date of the last disclosure of Information pursuant to this agreement.



- b) The parties may by agreement, at any time, revoke or amend the provisions of this agreement wholly or in part, provided that the confidentiality of the Information is not jeopardised.
- c) Its effects may also cease on signing of any contractual commitment between the Parties that stipulates the confidentiality of the information and thereby replaces the terms of this contract, without prejudice to the following paragraph.
- d) Nonetheless, under no circumstances are the parties bound under this agreement to enter into any legal business in the future.

## **CLAUSE FIVE**

### **(Liability)**

The recipient is liable to the Disclosing Party for any losses or injuries, including material losses and lost earnings, resulting from breach of or defective compliance with its obligations to maintain confidentiality, without prejudice to any criminal liability incurred in the event of breach of this obligation.

#### **[POSSIBLE APPLICATION]**

Without prejudice to the previous paragraph, breach by the recipient of any of the obligations set out in this agreement shall entail payment to the Disclosing Party, as penalty clause, the sum of EUR ... (...).

## **CLAUSE SIX**

### **(Exceptions to Confidentiality)**

- a) An item of Information IS NOT CONSIDERED TO BE COVERED by duty to maintain confidentiality:
  - If its disclosure has been expressly authorised by the Disclosing Party. Said authorization must be requested by the recipient and granted by the Disclosing Party in writing within 8 (eight) working days, after which, in the absence of an answer, authorisation shall be deemed to have been refused;
  - If it has been published, made public or in some other way clearly become part of the public domain before the time of disclosure;
  - If it has been made public after disclosure or become part of the public domain for reasons not imputable to the recipient by way of intent or negligence;
  - If the recipient can prove by means of written evidence that it was already in its possession before receiving from the Disclosing Party;



- If it was received by the Recipient from third parties with no duty to maintain confidentiality, provided that they had the right to provide this information and that they did not obtain it directly or indirectly from the Disclosing Party under conditions of confidentiality;
  - If the Recipient is obliged by law or judicial decision to disclose it, provided that the recipient notifies the Disclosing Party immediately and cooperates with it in all reasonable efforts to contest or limit the scope of said disclosure.
  - If it is developed independently by the recipient.
- b) The burden of proof of all exceptions to the obligation to maintain confidentiality set out in a) lies exclusively with the recipient.

### **CLAUSE SEVEN**

(Law and Conflict Resolution)

- a) This agreement is subject to ... Law.
- b) For settlement of any disputes arising from this agreement, the District Court of... shall be the competent court.

The parties recognise and accept the provisions of this Agreement, the content of which shall replace all previous negotiations and contacts between the parties.

DATE AND SIGNATURES OF THE PARTIES