**AGREEMENT OF JOINT OWNERSHIP AND JOINT MANAGEMENT OF PATENT**

**BETWEEN**

**STAZIONE ZOLOGICA ANTON DOHRN** (hereinafter "SZN") with registered office in Naples, Villa Comunale, VAT number and Tax Code 04894530635, represented by the President, Prof. \_\_\_\_\_\_\_\_\_\_\_\_

**And**

(hereinafter referred to as “\_\_\_\_\_\_\_\_”), with registered office in \_\_\_\_\_\_\_\_, \_\_\_\_\_\_\_\_\_ – ZIP Code \_\_\_\_\_, Tax Code \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_, VAT number \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_, represented by the head of the "\_\_\_\_\_\_\_\_\_\_\_" Unit of the \_\_\_\_\_\_\_\_\_\_\_\_\_\_, Dr. \_\_\_\_\_\_\_\_\_\_\_\_\_

- hereinafter also referred to individually as the "Party" and jointly as the "Parties" -

WHEREAS

1. \_\_\_\_\_\_\_\_ is \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_, among its aims, the enhancement for productive and social purposes and the technological transfer of the results of the research carried out and coordinated by its scientific network and, to this end, it encourages and supports collaboration between its research groups and third parties, public and private;
2. \_\_\_\_\_\_\_\_\_\_\_ (hereinafter referred to as “\_\_\_\_\_\_\_\_\_”) has extensive experience in \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ issues;
3. SZN, National Institute of Marine Biology, Ecology and Biotechnology is a national public non-instrumental research institution having, among its institutional purposes, research in the field of marine sciences, for the study of the fundamental and applied biology of marine organisms, their biodiversity and evolution, through an integrated and interdisciplinary approach;
4. SZN conducts research in the field of marine sciences through collaborations with research institutions and companies for the development of knowledge and its application to environmental protection and the improvement of quality of life;
5. As part of the \_\_\_\_\_\_\_\_ project “\_\_\_\_\_\_\_\_”, funded by the \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_, coordinated by SZN and conducted in collaboration with \_\_\_\_\_\_, \_\_\_\_\_\_\_ and \_\_\_\_\_\_\_, Dr. /Drs. \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ for SZN and Dr. /Drs. \_\_\_\_\_\_\_\_\_\_\_ for \_\_\_\_\_\_\_ devised \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(hereinafter “Invention”) and by mutual agreement decided to proceed with the filing of a patent application in order to protect the Invention;
6. in consideration of all activities carried out by each other within the framework of the \_\_\_\_\_\_\_ project and in light of the inventive contribution made by each inventor, the Parties have agreed to share ownership of the patentable results according to the following ownership shares: \_\_% SZN - \_\_% \_\_\_\_;
7. in order to protect the Invention, the Parties jointly on \_\_/\_\_/\_\_\_\_, with the help of the patent agent mutually chosen, the Italian patent application no. \_\_\_\_\_\_\_\_\_\_\_\_\_\_ entitled “\_\_\_\_\_\_\_\_” (hereinafter “Application for Priority”);
8. following this contract (hereinafter referred to as the “Agreement”), the Parties now intend to regulate the procedures for the joint ownership management of the Priority Application and its possible extensions abroad (hereinafter collectively referred to as the "Patent"), as well as to agree on the methods of commercial exploitation and the property rights deriving from it.

Now therefore, the following is stipulated and agreed:

**Art. 1 - PREAMBLE**

The premises forms an integral and substantial part of this Agreement.

**Art. 2 – OBJECT**

This Agreement regulates the relationship between the Parties regarding the co-ownership, management, use and economic exploitation of the property rights to the Patent.

**Art. 3 - PATENT OWNERSHIP, PATENT PROTECTION COSTS AND ROLES OF THE PARTIES**

3.1 Ownership of the Patent has been granted between the Parties according to the following shares: SZN \_\_% (\_\_\_\_\_\_\_ percent) - \_\_\_\_ \_\_% (\_\_\_\_\_ percent).

3.2 The Parties hereby establish that all the costs of filing, obtaining and maintaining the Patent shall be divided among them in proportion to their respective shares of joint co-ownership, without prejudice to the right of the Parties to make use of services free of charge or to receive financial resources intended for this purpose, offered by public and/or private entities for the aforementioned activities.

3.3 The Parties shall also be responsible alike for relationship with the firm chosen by mutual agreement, taking care of the technical aspects relating to the procedures for examining, granting and maintaining the Patent, also through the support and collaboration of the inventors, and providing, if necessary, the required instructions and documentation to the firm for all actions relating to the Patent, agreed in advance.

3.4 The Parties will receive a copy of the documents and communications sent by the claims representatives so that the decisions regarding the management of the Patent are discussed and deliberated within the required timeframe by the patent protection procedures in place.

**Art. 4 – EXTENSION ABROAD AND MANAGEMENT OF THE PATENT**

4.1 - Extension abroad

The Parties undertake to agree in advance on the possible extension abroad of the Priority Application, in generally on any action of a onerous nature relating to the phases of protection, examination and granting of the Patent in Italy and/or abroad, implementing a shared management strategy on the basis of criteria of expediency and reasonableness of both a technical-patent and commercial nature.

In the event that the overseas extensions of the Priority Application become stand-alone titles, the related foreign patents shall be governed in accordance with this Agreement.

If a Party waives the right to extend and/or continue the procedure for the protection of the Patent abroad, the other Party may extend or continue – exclusively in its own name – the related right. In this case, the non-waiving Party shall bear all related expenses on its own, which cannot be the subject of a request for reimbursement from the withdrawing Party. The waiving Party undertakes to sign and have its inventors sign all the documentation necessary to allow a correct procedure for the extension and/or continuation of the Patent.

4.2 – PATENT WAIVER MODALITIES

If a Party decides, for any reason, not to extend, continue or maintain the Patent ("Waiver"), even limited to one or more States where patent protection is active, it undertakes to give timely written notice of waiver – including by certified e-mail – to the other Party ("Waiver Notice"), in order to allow it to take over free of charge, and exclusively, in the ownership, management and economic enhancement of the Patent in the territory of Waiver. The Waiver becomes irrevocable if, within 15 (fifteen) days of receipt of the Notice of Waiver, it is not expressly withdrawn by the Waiving Party. It is understood that the Waiver will also entail the waiver of any economic claim in relation to the rights to exploit the Patent in the territory of Waiver.

If there is an the interest of the Receiving Party to accept the Waiver and take over the other Party's share of the Patent, it shall notify the Renouncing Party in writing within 30 (thirty) days of receipt of the Waiver Notice. In this case, the renouncing Party undertakes to sign, to have its inventors sign, all the deeds and documentation necessary to formalize the successor of ownership as well as to allow the other Party to continue the Patent in the territory of Waiver. The costs of protecting the Patent in the territory of Waiver shall be borne in full by the Successor Party from the date of formalization of the successor Party's takeover of the Renunciating Party's share of ownership. Such expenses may not be the subject of a request for reimbursement from the renunciating Party. The costs of transferring and transcribing the share of the Patent owned by the renouncing Party shall be borne by the Party acquiring such share.

**Art. 5 - USE AND EXPLOITATION OF THE PATENT**

The Parties undertake to diligently promote the Invention and the Patent in the common interest of the Parties.

The Parties agree that the use of the Patent will be regulated as follows:

5.1 - Own use for research and teaching purposes

Each Party has the right to the full use of the Invention for its own institutional purposes of research, teaching, dissemination and scientific dissemination (publications, conferences, seminars, fairs, etc.), without the prior consent of the other Party, provided that this does not prejudice Patent and/or Patent protection or actions for its enhancement and economic exploitation.

5.2 - Actions of Enhancement

The Parties will be free to conduct, even independently, the activities they deem most appropriate for the enhancement of the Patent (such as, but not limited to participation in technological showcases, fairs, events, etc.). Each Party undertakes to keep the other Party informed of the enhancement actions it undertakes and [what has been achieved](https://context.reverso.net/traduzione/inglese-italiano/what+has+been+achieved).

If the Parties intend to entrust third parties (i.e. technology brokers) with the enhancement of the Patent by professional assignments, even of a onerous nature, each assignment must be agreed in advance between SZN and \_\_\_\_\_. The terms, costs and expenses related to this professional assignment will be agreed in advance between the Parties.

5.3 - Granting of Licences to third parties

5.3.1 Non-Exclusive Licenses

Each Party may grant to third parties one or more non-exclusive licenses of use, unlimited in duration, for the exploitation of the Patent and/or Invention, subject to the consent of the other Party. If a Party intends to grant a non-exclusive license to a third party, it shall notify the other Party in writing of its intention to communicate its position and the reasons for its disagreement within 30 days of receipt of the notice from the Party that it intends to grant the license. If, within the aforementioned period, no notice is received, the non-exclusive license shall be deemed to have been accepted by the other Party. Proceeds from granting of licences to third parties will be divided between the Parties in proportion to their respective shares of joint ownership.

5.3.2 Exclusive Licenses

Should the Parties deem it appropriate and/or strategic to grant an exclusive license to the use of the Patent and/or the economic exploitation of the Invention in the territories not covered by the Patent to third parties, the relevant contracts, the terms of which must be agreed in advance between the Parties, must also be signed jointly by both joint owners. The proceeds deriving from the granting of licences to third parties will be divided between the Parties in proportion to their respective shares of joint ownership.

5.4 - Assignment of the Patent to third parties

If the Parties deem it strategic to enhance the value of the Patent through the definitive transfer, in full, of the ownership to third parties, such assignment must be agreed, approved and jointly signed by the Parties. The amounts set for the assignment of the Patent will be divided between the Parties in proportion to their respective shares of joint ownership. It is understood that the assignment of the Patent will not preclude the economic enhancement of the Invention in territories where the Patent/Patent is not in force.

**Art. 6 - DISSEMINATION OF THE INVENTION AND SCIENTIFIC PUBLICATIONS**

6.1 Dissemination activities covering all, or part of, the contents of the Invention covered by the Patent must be compatible with the protection of intellectual property rights, confidentiality obligations and the legitimate interests of the Parties.

6.2 During the period of secrecy (18 months from the first filing) dissemination activities having as their subject matter all, or part of, the contents of the Invention subject of the Patent must be agreed in advance. With specific reference to the scientific publications by the inventors of the object of the agreement, each Party must give prior written notice, also in electronic form (e.g. e-mail), to the other Party, providing a complete copy of the material that is intended to be used in the dissemination and divulgation actions, notwithstanding the above for any obligation deriving from paragraph 6.1. In the event that, due to non-compliance with the provisions of paragraph 6.1 above, the other Party expresses a negative opinion on the request for publication within 20 days of the aforementioned communication, publication may be delayed until adequate measures are taken to bring it into compliance. The negative opinion must therefore be duly motivated and such as to allow the indisputable identification of the part of the scientific publication that infringes the obligations referred to in paragraph 6.1 above. After 20 days from the aforementioned communication, silence agreement will be applied. Only in the event that the scientific publication consider as co-authors persons in any capacity belonging to both contracting parties, such communication is considered not due, as it is considered that the content of the scientific publication is already known by each of the Parties.

6.3 The Parties undertake, in the context of press releases, papers, presentations and, more generally, any other form of scientific dissemination concerning - even if only partially - the Invention covered by the Patent, to report that the results achieved derive from research conducted jointly between the Parties.

**Art. 7 - ASSIGNMENT OF INDIVIDUAL PATENT SHARES**

7.1 Each Party undertakes not to negotiate with third parties the assignment of its share of the Patent without having previously informed the other Party.

7.2 In the event that a Party intends to transfer for any reason, even free of charge, including the contribution to the company, its share of ownership of the Patent to Third Parties, it must notify in writing, by registered mail or certified e-mail, to the other Party who will enjoy a right of pre-emption. The communication must indicate the invitation to exercise the right of pre-emption as well as the terms and conditions of trade. In order to allow the exercise of the right of pre-emption referred to in this paragraph, the transferring joint controller undertakes to communicate, subject to the assumption of a confidentiality commitment by the receiving joint controller the exact amount of the offer received from third parties, which the transferring joint controller will request from such third party to be formalized in writing, with an indication of the price and any other contractual or negotiation conditions, with an express commitment to make the assignment on equal terms with the consent of the receiving Party. Where necessary, in the case of a contribution or donation, as well as in any other case in which the transfer is not accompanied by an indication of the price of the transfer, the Parties reserve the right to avail themselves of an appraisal of the estimate of the value of the technology in question, carried out by an expert, chosen by mutual agreement. In this case, the cost of the appraisal will be divided proportionally to the respective joint ownership shares. If the other Joint Controller Party concerned intends to exercise the right of pre-emption, it must, within 30 days, notify the transferring Joint Controller Party by the same means. The assigning Joint Owner Party undertakes to sign all necessary documents so that the transferee Joint Owner Party, whether it is the other Joint Owner Party or a Third Party, can enter into full ownership and ownership of the shareholding of the Patent.

7.3 - In no case does the transfer of ownership of the share of the Patent, in conformity with the previous commas, transfer of ownership carried out by one of the Parties as a contribution of assets in the context of the establishment of spin-off research companies participated by said Party or its inventors constitute a transfer of ownership of the Patent. The intellectual and industrial property rights belonging to each Party may be included to the spin-off on the basis of specific assignment or license agreements in compliance with the Parties' Regulations and compatibly with the enhancement activity in progress and the contractual commitments undertaken, between them and/or with other third parties.

**Art. 8 - PATENT DEFENCE, VIOLATION OF THIRD PARTY RIGHTS**

8.1 In the event of infringement by a third party of the rights deriving from the Patent, or in the event that a third party acts for the declaration of invalidity or revocation of the Patent, the Party that first becomes aware of this circumstance must promptly notify the other Party.

8.2 Each Party may act for the defense of the Patent, either jointly with the other or separately and autonomously, upon written notice to the other Party, which within 30 (thirty) days of receipt of notification must decide whether or not to adhere, by means of a specific written notice to the Party that intends to act.

8.3 The costs will be allocated in proportion to the respective shares of Patent’s ownership; only in the event that other Party decides not to be interested in the defense of the Patent, the costs of the same will be borne by the Party that initiated the action. Likewise, any compensation obtained will be only of the Party that initiated the action.

8.4 In the event of the granting of exclusive licences of use to third parties, the Parties shall assess the advisability and feasibility of negotiating, within the scope of the contractual terms, direct support for legal fees by the licensees.

**Art. 9 – REFINEMENT AND DEVELOPMENT OF THE INVENTION**

9.1 The ownership of any improvements and developments of the Invention that may in the future result from the continuation of the activity of the Parties, carried out individually, jointly or even together with other Parties, shall be determined in relation to the inventive, material, financial, engineering and design contribution made by each Party to the activity from which such improvements originated. The management and commercial exploitation of such improvements and related rights of property rights that may arise from them will be managed according to a new agreement that will be stipulated between the Parties.

9.2 Improvements means the subsequent modifications, developments or advancements of the Invention, even if they are the subject of new patents, know-how, or other exclusivity, even if they relate to specific aspects or modifications of the Invention, resulting from the research and development activities carried out by the Parties.

9.3 Dissemination and scientific publications which have as their subject-matter, even partially, the improvements developed jointly between the Parties, are subject to the provisions of art. 6.

**Art. 10 - RELATIONS WITH INVENTORS**

10.1 The Parties undertake to regulate relations with their inventors in accordance with current legislation (Industrial Property Code, and subsequent additions and amendments) and in compliance with the provisions of their internal regulations or other agreements agreed with them.

Each Party shall indemnify the other against any claims of its Inventors.

**Art. 11 - DURATION**

11.1 This Agreement shall be effective on \_\_\_\_\_\_\_\_, the date of filing the Priority Application, (hereinafter referred to as the "Effective Date") and shall remain in force for as long as the Patent is in effect.

**Art. 12 - CONFIDENTIALITY**

12.1 The Parties undertake to maintain and ensure that their personnel maintain the strictest confidentiality on confidential and sensitive information relating to the other Party and on information and data relating to the Invention and its possible development, exploitation and use in general.

12.2 The Parties also undertake to make technical and commercial information available to potential licensees or sub-licensees under a Non-Disclosure Agreement (NDA) and limited to the purpose of commercial use of the Patent and its extensions.

12.3 The Parties further agree that, prior to the publication of the Patent Application, its viewing by third parties for any reason whatsoever will be granted only after signing an appropriate confidentiality agreement (NDA).

12.4 The Parties mutually acknowledge that, under no circumstances, may the following be considered confidential:

1. information which is already in the public domain at the time of its action, or that becomes so subsequently, without the Party receiving it having breached this Agreement;
2. information that at the time of its disclosure is already known to the receiving Party, provided that such knowledge has not been fraudulently obtained and the Party can provide evidence that it was already in possession of such information at the time it was disclosed to it;
3. information which at the time of its disclosure, is already known to the receiving Party, having previously been transmitted to it by a third party entitled to do so and not bound by an obligation of confidentiality relating to the use or disclosure of such information;
4. information that the Party is obliged to communicate or disclose pursuant to a lawful order of any authority, provided that in such case the Party receiving the order immediately notifies the Party that owns the Confidential Information in writing, so that the latter may seek the most appropriate judicial remedies to protect its interests or other appropriate remedy, or release the other Party from the obligation of confidentiality;
5. information the disclosure of which has been previously authorized in writing by the transmitting Party.

**Art. 13 - USE OF THE NAMES AND TRADEMARKS OF THE PARTIES**

13.1 Nothing in this Agreement confers any right to use for advertising purposes, or for any other promotional activity unrelated to the contents of this Agreement, any name, trademark, or other designation of either Party, including abbreviations.

**Art. 14 - MISCELLANEOUS**

14.1 In the event of any discrepancy between the contents of the present Agreement and other prior agreements or understandings, both oral and written, between the Parties in relation to the Invention or Patent, this Agreement shall prevail.

14.2 This Agreement may could be only modified by written agreement between the Parties.

14.3 All notices and communications between the Parties, which arise from the application of this Agreement, shall be made, according to specific uses and needs, in writing and/or communicated by e-mail, certified e-mail or registered letter with acknowledgment of receipt, to the following addresses (or to those other addresses that may subsequently be communicated in writing):

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| --- | --- |
| for SZN  Zoological Station "Anton Dohrn" Naples  Grant Innovation Office  Villa Comunale, 80121 Naples  E-mail: gio@szn.it  PEC: ufficio.protocollo@cert.szn.it  SZN Patent Contacts: \_\_\_\_ ([\_\_\_\_@\_\_\_\_)](mailto:silvia.cella@cnr.it)  SZN Agreement Contacts: \_\_\_\_\_\_ (\_\_\_\_\_\_\_[@](mailto:________@cnr.it)\_\_\_) | For\_\_\_\_\_\_:  \_\_\_\_\_\_\_\_\_\_\_\_ – \_\_\_\_\_\_\_\_\_  Unit "\_\_\_\_\_\_\_\_\_\_\_\_"  \_\_\_\_\_\_\_\_\_\_\_\_ n°\_, CAP\_\_\_\_\_  E-mail: \_\_\_\_\_\_\_\_\_\_  PEC: [\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_](mailto:protocollo-ammcen@pec.cnr.it)  Patent Contacts: \_\_\_\_\_\_\_ ([\_\_\_@\_\_\_\_)](mailto:silvia.cella@cnr.it)  Agreement Contacts: \_\_\_\_\_\_\_\_\_\_\_\_\_ (\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_[@](mailto:________@cnr.it)\_\_\_) |

14.4 Under this Agreement neither Party shall be liable for delays, defaults and damages, or their immediate and direct consequences, resulting from force majeure. The Party affected by the force majeure event shall in any case notify the other Party in writing, as soon as possible and in any case no later than 7 (seven) working days from the occurrence of the event, of the existence of the event and its impact on the affected Party's ability to perform the Agreement, in any case taking appropriate measures in order to ensure the timely restoration of compliance.

14.5 In the event that the Patent is not granted, due to lack of the necessary legal requirements or for any other reason, or is revoked or otherwise invalid, in one of the countries for which the grant is sought, this Agreement shall lose all effect limited to the country in which patent protection ceases, but the agreements regarding the exploitation of the Invention will remain valid within the terms established in art. 5.

**Art. 15 - APPLICABLE LAW AND DISPUTES**

15.1 This Agreement shall be governed by, construed and enforced in accordance with Italian law.

15.2 The Parties agree to settle amicably any dispute that may arise regarding the validity, interpretation, execution and termination of this Agreement. If an amicable agreement is not reached between the Parties, the Court of Naples will have exclusive jurisdiction.

**Art. 16 - REGISTRATION AND STAMP DUTY (IF ANY)**

16.1 This Agreement will be registered only in the case of use at a fixed fee pursuant to art. 5 and 39 of D.P.R. 131/86. All expenses related to the eventual registration costs of this Agreement shall be borne by the Party requesting the registration.

16.2 This agreement, digitally signed in a single original, is subject to stamp duty, which will be paid in full virtually by SZN in the amount of € 64.00 (euro sixty-four/00), with subsequent chargeback to \_\_\_\_ of 50% of the tax due equal to € 32.00 (euro thirty-two/00), excluding VAT (pursuant to Article 15 of Presidential Decree 633/1972).

**Art. 17 - NEGOTIATION**

17.1 The Parties acknowledge that this Agreement has been negotiated in its entirety and that the provisions of Articles 1341 and 1342 of the Civil Code do not apply to it.

**Art. 18 – PROTECTION OF PERSONAL DATA**

18.1 The personal data provided herein will be processed in compliance with current legislation on the processing of personal data (Legislative Decree 196/2003 and EU Regulation 679/2016), SZN will process all personal data acquired for the performance of institutional activities in relation to the protection, management and enhancement of the subject matter of this contract.

The Data Controller is the Stazione Zoologica Anton Dohrn (SZN).

Responsible for the processing of personal data and for the protection of personal data is \_\_\_\_\_\_\_\_\_\_ (\_\_\_\_@\_\_\_\_\_\_).

18.2 In accordance with the provisions of EU Regulation 2016/679, \_\_\_\_\_ - \_\_\_\_\_\_\_\_ will process all personal data acquired for the performance of institutional activities in relation to the protection, management and enhancement of the subject matter of this contract.

The Data Controller is \*\_\_\_\_\_\_\_\_ (\_\_\_\_\_\_\_).

The person responsible for the processing of personal data is \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ (\_\_\_\_\_\_@\_\_\_). Data Protection Officer: \_\_\_\_\_@\_\_\_

Read, approved and digitally signed.

|  |  |
| --- | --- |
| For SZN | For \_\_\_\_\_\_\_\_\_ |