



Regione Toscana



UFFICIO REGIONALE DI TRASFERIMENTO TECNOLOGICO

FORM

PATENT AND KNOW-HOW EXCLUSIVE LICENSE FOR THE INVENTION

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**PATENT AND KNOW-HOW EXCLUSIVE LICENSE
FOR THE INVENTION**

BY AND BETWEEN

The University of, Tax Code/V.A.T. number, with registered office in (hereinafter, the 'LICENSOR or the 'UNIVERSITY'), represented by as [position of the authorized representative]

AND

..... (company name) Tax Code/V.A.T. number, with registered office in (hereinafter, the 'LICENSEE'), represented by as [position of the authorized representative]

Hereinafter jointly referred to as the 'PARTIES' and separately as the 'PARTY.'

WHEREAS

**CHOOSE OPTION: A Foreword on ownership of the invention
or B Foreword on existing intellectual property rights related
to the invention**

OPTION A1 – Institutional research invention

- a) The UNIVERSITY, under the deed of assignment of [*specify the date*] with the inventors Prof. [*indicate the inventors who assigned the invention to the university*], is the exclusive owner of the economic rights to the invention entitled pertaining to the following industrial field (hereinafter, the INVENTION);

OPTION A2 – Contract or collaborative research invention

- a) The UNIVERSITY is the exclusive owner of the economic rights to the

invention entitled pertaining to the following industrial field (hereinafter, the INVENTION) generated within the scope of a collaborative or contract research project on which there are no rights of third party principals or collaborators;

OPTION B 1 – Patent application

- a) The UNIVERSITY on has filed an Italian patent application n. entitled [optional granted on number] claiming the INVENTION;

OPTION B 2 – Granted patent

- a) The UNIVERSITY owns the following industrial property rights describing the INVENTION:
- b) Italian Patent number granted according to application number dated entitled
- c) International patent application PCT number dated entitled, [optional granted on number..... and validated in the following countries] as extension of the prior Italian patent application number
- d) European Patent Application number dated entitled, [optional granted on number and designated for the following countries] as the regional phase regarding the prior international patent application PCT number [in alternative as extension of the prior Italian patent application number];
- e) Furthermore, the UNIVERSITY owns know-how related to the INVENTION and regarding its use, fulfilment, experimentation and

manufacture as described in Annex A;

- f) The UNIVERSITY wishes to assign the industrial property right related to the INVENTION as stated in recitals' point b) and c) and has therefore arranged to publish the selling offer in accordance with the regulations applicable to public tenders and to administrative procedures;
- g) By letter of, the LICENSEE has expressed its interest in the exclusive license of the intellectual property rights related to the INVENTION;
- h) On, the exclusive license offer has been positively evaluated and approved by competent UNIVERSITY decision-making bodies [e.g., Patent Commission, Board of Directors] as per the administrative decision/other equivalent act with reference number

**NOW, THEREFORE THE PARTIES HERETO AGREE AS
FOLLOWS**

Art. 1 Recitals and Annexes

1.1. The recitals and annexes of the CONTRACT are an integral and substantial part of it and bind its interpretation and implementation.

Art. 2 Definition

2.1. The words used in the upper case in the CONTRACT shall have the meaning specified by the CONTRACT.

2.2. "PATENTS" refers to patent applications and patents as stated in point b) of the recitals, as well as any economic rights and faculties deriving thereof, including, but not limited to, priority rights, regional and international extensions, continuation rights as well as the right to institute proceedings also regarding their violations.

2.3. "KNOW-HOW" refers to all information and technical expertise related to the INVENTION which do not fall into public domain and conferring technological or competitive advantages, including, but not limited to

knowledge, operating manuals, prototypes, data, methods, technologies, secrets, algorithms, programs, formulas, experimental results, documents, designs, working drawings, processes, and materials, whether protected or not by intellectual property rights, as better described in Annex A.

2.4. "INTELLECTUAL PROPERTY RIGHTS" refers to both PATENTS and KNOW-HOW.

2.5. "LICENSED PRODUCTS" means all past, present and future machines, artifacts, compositions of matter, methods, processes, apparatus, components, devices, hardware, software, applications, data, products, websites, systems and other products and services manufactured or sold by or for the LICENSEE or used, made, leased, sold, offered for sale, licensed or offered for license, imported, exported, or otherwise disposed of by or on behalf of the LICENSEE [or its AFFILIATES], which without this AGREEMENT would infringe, or could be accused of directly or indirectly infringing, one or more of the claims of the PATENTS or which incorporate the KNOW-HOW or whose development or production makes use thereof.

2.6. "REFERENCE REVENUE" means the gross annual revenue derived from LICENSEE's sale of LICENSED PRODUCTS or otherwise attributable to the exploitation of the INVENTION.

2.7. "TERRITORY" means the country(ies) in which the PATENTS are valid [or specify the countries for which the license is granted].

2.8. "FIELD OF USE" means any sector of economic activity [or specify the economic sector to which the license is limited, e.g., by reference to the EU 'NACE' classification of economic activities].

[applicable if the licensee belongs to a corporate group 2.X. "AFFILIATES" means companies or entities controlled by the LICENSEE or controlling the LICENSEE, where control is determined by directly or indirectly owning 50% or more of the equity interests or voting power or having the power to influence most of the governing body or the business].

2.9. 'CONFIDENTIAL INFORMATION' means any information, even if including public domain elements, qualified as 'confidential' according to the following paragraph, which a PARTY provides in tangible or intangible form

to the other PARTY in the framework of the CONTRACT and relating to the INVENTION.

The CONFIDENTIAL INFORMATION transmitted from one PARTY to the other in intangible form, the receipt of which shall be confirmed in writing by the receiving PARTY, shall be expressly identified as such by a stamp/watermark/indication bearing the wording 'Confidential'. CONFIDENTIAL INFORMATION transmitted in tangible form shall be identified either by the express mention of its secrecy or by written notice to the receiving PARTY to be provided by the disclosing PARTY within thirty (30) days after transmission in intangible form.

CONFIDENTIAL INFORMATION does not include information for which it can be proved that:

the information was in the public domain at the time of transmission or subsequently fell in the public domain without violating this CONTRACT;

the information was available to the recipient PARTY before the closing of the CONTRACT, or is later developed independently by the recipient PARTY or disclosed to it by third parties who have the right to do so;

a statute, court decision or administrative act compels to disclose provided that the PARTY involved notifies the other PARTY before the disclosure so that the PARTIES consult each other and agree on the timing and content of any disclosure limited to the requirements of the relevant law, court decision or administrative act.

Art. 3 Subject Matter

3.1. The LICENSOR hereby grants to the LICENSEE, who accepts, under the terms and conditions of the CONTRACT, an exclusive license to exploit the INTELLECTUAL PROPERTY RIGHTS valid in the TERRITORY for the FIELD OF USE. Therefore, by way of example, the LICENSEE shall have exclusive rights in the SCOPE of USE and in the TERRITORY to develop, produce, have produced, use, export, import, sell, distribute, market the LICENSED PRODUCTS [*applicable if the LICENSEE belongs to a corporate group, directly or in cooperation/through its AFFILIATES*].

3.2. The LICENSEE acknowledges and agrees that the LICENSOR reserves the right to use the INVENTION for institutional research and teaching purposes only [optional, including under collaborative and third-party contract research agreements with a commitment by LICENSOR to provide prior notice to LICENSEE].

[optional sub-licensing right 3.X. The LICENSOR hereby grants to the LICENSEE the right to sublicense the INVENTION to third parties provided that the names of the sublicensees are forwarded to LICENSOR together with the terms and conditions of the sublicenses for their prior conformity review under the CONTRACT].

3.3. The LICENSOR agrees to provide to the LICENSEE all the documents related to the KNOW-HOW, as specified in Annex A, within days after receipt of the first payment referred to in Art. 5.1.a. For the purpose of the CONTRACT, the LICENSOR shall make available to the LICENSEE, under the supervision of Prof., its own researchers involved in the achievement of the INVENTION for meetings [specify an appropriate number] each for the duration of hours [optional at its own premises or at LICENSEE's premises], within months from the closing of the CONTRACT [specify an appropriate due date, e.g. twelve months]. The meetings shall provide assistance and initial training to the LICENSEE's technical personnel for the exploitation and use of the INVENTION as better described in the enactment plan as outlined in Annex B. The assistance and support provided by the LICENSOR to the LICENSEE beyond the indicated meetings and deadlines shall be specifically negotiated and object of additional consideration.

Art 4. CHOOSE OPTION: A or B

OPTION A – Term equal to the patent life

4.1. Without prejudice to the effects of any termination or withdrawal, the CONTRACT shall be valid until the expiration date of the last of the PATENTS. Upon expiration of the CONTRACT, the LICENSEE [and its AFFILIATES] may continue to use the KNOW-HOW subject to the confidentiality obligations set forth in Article 10. below.

OPTION B – Limited term and renewal

4.1. Without prejudice to the effects of any termination or withdrawal, the term of the CONTRACT shall be 5 (five) years as from the closing date and may be renewed for the same term upon written request of the LICENSEE sent to the LICENSOR within 6 (six) months before the term of the CONTRACT. Upon expiration of the CONTRACT, the LICENSEE shall cease to use the INTELLECTUAL PROPERTY RIGHTS and return to the LICENSOR the documents referred to in Annex A.

4.2. For the duration of the CONTRACT and its renewals, if the LICENSOR intends to transfer the INVENTION to a third party, it shall give prior notice to LICENSEE who has a pre-emption right over it. In this case, the LICENSOR will inform the LICENSEE via certified e-mail of the negotiations that have taken place, or the offers received, indicating the conditions of the purchase offer and the references of the bidder. The LICENSEE must exercise the pre-emption right at conditions equal to those offered by third parties by means of a written declaration sent via certified e-mail to the LICENSOR under penalty of forfeiture within days [for example 60] after receipt of the communication of the third party offer, after which the right of pre-emption will be considered renounced and the LICENSOR may assign the INVENTION without prejudice to the right of the LICENSEE to terminate the CONTRACT.

4.3. The LICENSEE may exercise an option right to purchase the INVENTION upon written request sent via certified e-mail to the LICENSOR within 3 (three) months before the expiration of the CONTRACT.

Art. 5 – CHOOSE OPTION A OR B

OPTION A – Lump sum payment

5.1. As consideration for the exclusive license of the INVENTION, the LICENSEE agrees to pay the LICENSOR the lump sum of € + VAT, to be paid as follows:

-% to be paid within days (e.g. 60) from the signing of the CONTRACT upon receipt of electronic invoice -

SDI recipient code or certified e-mail address through the pagoPA system;

- The remaining amount to be paid upon conclusion of the enactment plan as per Attachment B within the essential term of 30 (thirty) days from receipt of the electronic invoice - SDI recipient code or certified e-mail address through the pagoPA system.

OPTION B – Combined ongoing payment

5.1. As consideration for the exclusive license of the PATENTS, the LICENSEE undertakes to pay to the LICENSOR the following amounts upon receipt of appropriate electronic invoices - SDI recipient code or certified e-mail address through the pagoPA system:

a) reimbursement of expenses incurred by the LICENSOR up to the time of signing the CONTRACT for the prosecution of patents over the INVENTION amounting to € + VAT to be paid in 4 instalments as indicated below:

a. € + VAT within 30 days from the signing of the CONTRACT;

b. € + VAT within 6 (six) months from the signing of the CONTRACT;

c. € + VAT within 12 (twelve) months from the signing of the CONTRACT;

d. the balance of € + VAT within 24 months from the signing of the CONTRACT.

b) a royalty equal to % (e.g. between 0,5 and 5%) of the REFERENCE REVENUE;

5.2. As consideration for the exclusive license of the KNOW-HOW, the LICENSEE undertakes to pay the LICENSOR from the first day of the third contractual year the annual amount of € (e.g. 1500) + VAT.

[applicable if LICENSEE is entitled to sub-license 5.X. As consideration for the sub-licensing right, the LICENSEE agrees to pay a royalty equal to 10% (ten percent) of the net sales obtained from the INVENTION sub-licenses].

5.3. Expiration or early termination of the CONTRACT shall not relieve the LICENSEE of its obligations related to the payment of the consideration accrued up to the date of expiration or termination.

5.4. Should any and all PATENTS be judged as entirely invalid by administrative or judicial decision of a competent authority which cannot be appealed, the royalty payment obligations under paragraph Art. 5.1. shall cease with retroactive effect. It is understood that in this case the obligation to pay royalties as per paragraph 5.2 shall continue.

5.5. The amount of sums accrued in currencies other than the Euro will be converted by LICENSEE into the Euro equivalent according to the conversion rate on the date on which LICENSEE collected such sums under the CONTRACT.

5.6. Interest at the legal interest rate applicable at the time payment default will be charged on outstanding amounts since notice of default to the LICENSEE.

Art. 6 Licensee's obligations

6.1. The LICENSEE shall take all reasonable steps to develop and commercially exploit the INVENTION in order to maximize the financial return to both PARTIES. By [e.g., June 15] of each calendar year, the LICENSEE shall send to the LICENSOR a detailed report of what it has done to develop the INVENTION and commercialize the LICENSED PRODUCTS.

6.2. The LICENSEE shall notify the LICENSOR of any changes in the company name, residence, or corporate composition that affect LICENSEE within 30 (thirty) days of the formalization of such changes.

[applicable to combined ongoing payment]. By the same date as in paragraph 6.1, the LICENSEE shall also send to the LICENSOR a statement as per the model in Annex C indicating the REFERENCE REVENUE [if

applicable, as well as the turnover obtained from sub-licensing] for the previous calendar year. The amount accrued for each calendar year must be paid within 30 (thirty) days from the issuance of the regular electronic invoice by the LICENSOR. For the purpose of easy determination of the consideration due, the LICENSEE [and sub-licensees] will keep complete and accurate records of all LICENSED PRODUCTS and maintain related documentation. For the sole purpose of determining the accuracy of the REFERENCE REVENUE statement, the LICENSOR shall have the right to audit at its own expense, including by inspection by its designated representatives, such documentation once per calendar year, during normal business hours and following forty-eight (48) hour notice via certified e-mail to the LICENSEE. If the audit reveals a discrepancy greater than [e.g., 10%] to the detriment of LICENSOR, the LICENSEE shall reimburse the LICENSOR for the costs of such review].

Art. 7 Management, maintenance and defence of the INTELLECTUAL PROPERTY RIGHTS

7.1. The patent prosecution strategy for the INVENTION, including but not limited to the extension, maintenance, grants, translations, divisions, continuations, possible oppositions or appeals concerning the PATENTS, as from the date of entering the CONTRACT, is the responsibility of the LICENSEE, who shall bear all related expenses and charges. The LICENSOR undertakes to issue all necessary powers of attorney and signatures. The LICENSEE shall promptly inform the LICENSOR of all decisions relating to patent proceedings and the contact details of any patent attorneys it may use.

7.2. If the LICENSEE does not intend to proceed with any of the activities referred to in the preceding paragraph, it will notify the LICENSOR of its decision via certified e-mail, sixty (60) days in advance of the deadlines envisaged in the various patent prosecution phases. The LICENSOR reserves the right to continue in these phases of patenting independently and at its own expense. It is understood that in this case, the CONTRACT shall be considered as not extended and ineffective with respect to the abandoned PATENTS or those which the LICENSEE has renounced.

7.3. The PARTIES shall inform each other immediately about any possible infringement of the INTELLECTUAL PROPERTY RIGHTS by third parties and shall provide mutual and prompt assistance in case of legal actions. If during the term of the CONTRACT, a PARTY becomes aware of any alleged infringement of the INTELLECTUAL PROPERTY RIGHTS, it shall be entitled and entitled, but not obliged, to take any legal action deemed appropriate against any infringer at its own expenses. Any action by either PARTY against a third party shall be promptly communicated to the other PARTY, which PARTY may join at its discretion. Each PARTY shall have the right, but not the obligation, to negotiate or take other steps that, in its sole discretion, may be appropriate to resolve a pending and likely upcoming dispute. It is precluded to the PARTIES to reach settlements to disputes that determine disbursements and/or limitations in the exercise of the rights of each of them.

7.4. Any judicial or extrajudicial compensation for the infringement of the INTELLECTUAL PROPERTY RIGHTS shall be shared as follows:

- i. firstly, the compensation shall be used to reimburse the trial costs and legal fees incurred by the PARTIES to bring the action in defence of the INTELLECTUAL PROPERTY RIGHTS;
- ii. secondly, the indemnification shall be charged as consideration that would have been due to the LICENSOR under the CONTRACT in proportion to the decrease in REFERENCE REVENUE attributable to the infringement;
- iii. the remainder shall accrue to the LICENSEE.

Art. 8 Improvements and distinctive signs

8.1. In case of results of activities or research eventually carried out by one PARTY during the contractual term and constituting improvements, developments or derivations of the INVENTION, the PARTIES undertake to give each other a mutual and adequate communication within 30 days from the achievement and agree that their ownership shall be exclusive of the PARTY who has achieved them. If such improvements, developments, or derivations of the INVENTION result from the substantial, joint, and

inseparable contribution of both PARTIES, as evidenced by the presence among the inventors of personnel belonging in various capacities to both PARTIES, their ownership will be the subject of specific co-ownership agreements between them. The LICENSEE also has the pre-emption right for the exclusive license to use the improvements, developments or derivations of the INVENTION obtained by the LICENSOR on equal terms with those offered to third parties through public tenders. The pre-emption right may be exercised by the LICENSEE within days from the communication by the LICENSOR of the third-party proposal and its conditions.

8.2. The LICENSEE [if applicable, whether directly or by means of AFFILIATES] may not use LICENSOR's distinctive signs publicly for advertising, promotional or other purposes without LICENSOR's written authorisation, to be given on a non-exclusive basis for each initiative relating to the exploitation of the INVENTION. The LICENSOR may withdraw the authorization to use its distinctive signs at any time without any claim on the part of the LICENSEE if their use does not comply with the terms of the authorization granted.

Art. 9 Warranties and liability limitations

9.1. The LICENSOR represents and warrants that it is the owner of the INTELLECTUAL PROPERTY RIGHTS, that they are in full force and effect, that it has paid all patent and renewal fees due up to the date of, and that, to its knowledge, no administrative or judicial proceedings are pending for their revocation, cancellation, or infringement. In addition, the LICENSOR declares that the INTELLECTUAL PROPERTY RIGHTS are not already the subject of licenses, options, real or personal liens in favour of third parties.

9.2. Although LICENSOR is not aware of any facts or information that may affect the patentability, validity or enforceability of the INTELLECTUAL PROPERTY RIGHTS, the LICENSOR does not guarantee that they may not be invalidated in the event of future civil or administrative proceedings by third parties, any costs and expenses of which shall be borne exclusively by LICENSEE.

9.3. The LICENSEE acknowledges that the INVENTION is experimental in nature, (optional and might have hazardous properties) and is exclusively licensed as is without any express or implied warranties, such as warranties of merchantability, fitness for a particular purpose, immunity from defects, and non-infringement of third-party proprietary rights. [Optional: Nevertheless, the LICENSOR hereby undertakes to carry out an analysis, at LICENSEE's instruction, based on the database [indicate the patent database to which the entity has access for a fee or, alternatively, indicate a freely accessible database such as ESPACENET] and limited to the territories of [indicate the countries of interest] on the freedom to operate within the scope of the INVENTION in order to identify possible interferences with third parties' intellectual property rights, providing the LICENSEE with a report on the analysis carried out.]

9.4. Within the limits of Article 1229 of the Civil Code, the LICENCEE will be solely responsible for any direct or indirect damage, for any reason whatsoever, arising from the use or marketing of the INVENTION, [possibly also by sub-licensees entitled by LICENCEE itself,] the LICENSOR being unassailable by any such liability claim. To this end, the LICENSEE irrevocably and unconditionally undertakes to indemnify the LICENSOR substantially and procedurally and to insure it against any and all losses, damages, liabilities, costs or expenses, including legal costs, arising from or in any way connected to claims, licenses or disputes by third parties, relating to the use in economic activity or, in any case, the commercialisation of the INVENTION or parts of it.

Art. 10 Confidentiality obligations

10.1. The PARTIES undertake to maintain the secrecy of all CONFIDENTIAL INFORMATION exchanged, received or obtained in the frame of the conclusion or in the performance of the CONTRACT and pertaining to the INVENTION, including information relating to contractual negotiations and conditions, applying all measures they respectively take to treat and protect their own CONFIDENTIAL INFORMATION of the same nature and not to disclose its content to any third party without the prior authorization of the disclosing PARTY. The

confidentiality obligations set forth in the CONTRACT shall survive for the period of five (5) years [assess appropriateness of term] from the date of expiration of the CONTRACT.

Art. 11 Publications

11.1. The LICENSOR is expressly forbidden from publishing or presenting results or information relating to the INVENTION without the prior written consent of the LICENSEE, which shall be withheld based on reasonable grounds such as privacy protection, confidentiality, and intellectual property. The LICENSOR willing to publish information relating to the INVENTION shall solicit by written request via certified e-mail, attached to a copy of the relevant documents, the LICENSEE's permission at least sixty (60) [evaluate if the term is appropriate] days prior to submission to the journal or to the committee organising the event. Within thirty (30) days after receipt of the to be published document, the LICENSEE shall respond in writing verifying that the relevant documents comply with applicable data protection laws, do not contain any of its CONFIDENTIAL INFORMATION or otherwise affect the legal protection of the INTELLECTUAL PROPERTY RIGHTS. After the expiry of the thirty (30) day reply term, the authorisation shall be deemed to have been granted [silent consent]. If the document contains CONFIDENTIAL INFORMATION, the authorisation may require their omission and replacement with the words "[omissis]".

11.2. If the requested publication affects the filing of patent applications or the registration of other industrial property rights on the INVENTION, the PARTIES hereby agree to postpone the publication until ninety (90) days after receipt of the results of the verification of the substantive requirements for obtaining any titled industrial property rights.

11.3. No prior authorization or notice shall be required for the publication of research whose content is already in the public domain, including already published applications for industrial property rights.

Art. 12 Termination and withdrawal

12.1. The CONTRACT may be terminated by right as a result of the simple declaration of the LICENSOR to make use of this termination clause

pursuant to art. 1456 of the Italian Civil Code - faculty recognized and accepted by the LICENSEE - in the following cases:

- b) failure of the LICENSEE to comply with the obligations set out in Article 6 (LICENSEE's obligation) and Article 7 (Management, maintenance and defence of the INTELLECTUAL PROPERTY RIGHTS);
- c) Failure to comply with the provisions of Article 5 (Consideration) not remedied by the LICENSEE within 180 (one hundred and eighty) days of notice of default by the LICENSOR;
- d) Failure to market LICENSED PRODUCTS or marketing agreements signed with any distributor within 3 (three) years of entering into the CONTRACT;
- e) LICENSEE's application for admission to any winding or insolvency proceedings.

12.2. The LICENSEE is entitled, as acknowledged and accepted by the LICENSOR, to terminate the CONTRACT for breach of the exclusivity right as set forth in article 3.1. of the CONTRACT.

12.3. Starting from the twelfth month and not later than the twenty-fourth month of the CONTRACT term, the LICENSEE may terminate the AGREEMENT with a notice period of 3 (three) months in case of justified impossibility to exploit the licensed INTELLECTUAL PROPERTY RIGHTS, upon presentation of an economic and technical feasibility report attesting the experiments undertaken and the impossibility found, communicated via certified e-mail to the LICENSOR.

12.4. Starting from the twenty-fourth month of the term of the contract, the LICENSEE may terminate the CONTRACT by giving 3 (three) months' notice via certified e-mail to the LICENSOR.

12.5. In any case of early termination of the CONTRACT, the LICENSEE undertakes to stop any and all exploitation of the INVENTION, and at the same time, the LICENSOR shall be entitled to retain the amounts already collected by the LICENSEE as well as to the payment of the accrued and outstanding amounts until the termination of the CONTRACT.

Art. 13 Penalty clause

13.1. The PARTIES agree that, in case of breach of CONTRACT, the non-performing PARTY shall be obliged to pay to the other PARTY the sum of € as penalty, pursuant to and for the effects of art. 1382 of the Italian Civil Code, without prejudice of the greater damages arising from the breach.

13.2. The PARTIES also agree that, in case of mere delay in the performance of the obligations under the CONTRACT, the PARTY in default shall be obliged to pay to the other PARTY the sum of € for each day of delay, pursuant to article 1382 of the Italian civil code.

Art. 14 – CHOOSE OPTION A, B OR C

OPTION A – Court Resolution

14.1. Italian law applies to the CONTRACT.

14.2. Any and all disputes relating to the formation, validity, binding effect, interpretation, performance, breach, or termination of the CONTRACT, if not amicably settled, shall fall under the exclusive competence of the Court of - Specialized Section in Industrial and Intellectual Property.

OPTION B - Arbitration

14.1. Italian law applies to the CONTRACT.

14.2. Any and all disputes relating to the formation, validity, binding effect, interpretation, performance, breach, or termination of the CONTRACT, if not amicably settled, shall be submitted to an arbitrator appointed by mutual agreement or, failing that, by the President of the Tribunal of

OPTION C – Two-tier resolution: preliminary mediation plus court resolution or arbitration

14.1. Italian law applies to the CONTRACT.

14.2. Any dispute, controversy or claim arising out of or relating to the CONTRACT and any subsequent modification thereof, including without limitation its formation, validity, binding effect, interpretation, performance, breach, or termination, as well as non-contractual claims, shall be subject to a preliminary mediation attempt under the rules of the Mediation Body The place of mediation is The language of the mediation is

14.3. If the disputes are not resolved within [60][90] days from the commencement of mediation or if the mediation attempt fails, the disputes shall be submitted to the Court of which shall have exclusive jurisdiction [or such disputes shall be submitted to and finally determined by an arbitrator appointed by mutual agreement or, failing that, by the President of the Court of].

Art. 15 Registration and recording

15.1. The CONTRACT, drawn up in two originals, is subject to registration in case of use pursuant to art. 5, paragraph II, DPR dated 26/04/1986 No. 131 and following amendments, at the requesting PARTY's responsibility and expenses. PARTIES agree that stamp duty pursuant to Tariff - Part I, Article 2, as annexed Presidential Decree No. 642/1972 and following amendments and integrations, with charges to be borne in equal parts by both PARTY regarding each copy. The LICENSOR's stamp duty shall be paid virtually (Authorization of the Italian Revenue Agency dated).

15.2. The LICENSEE commits to record, at its own expenses, at the Italian Patent and Trademark Office (optional in the event of international extension: as well as at the additional competent national offices) the exclusive license within 30 (thirty) days from the signing of the CONTRACT. For the pursue of recording, the LICENSOR agrees to provide free of charge its own assistance upon the LICENSEE's request.

Art. 16 Exchange of information

16.1. Unless otherwise agreed, communications, requests, and other communications under the CONTRACT shall be made in writing by e-mail or

via certified e-mail. Official communications exchanged via certified e-mail shall be deemed to have been made at the time of their receipt at the addresses hereunder:

For the LICENSOR

Office

Street address

E-mail @/ certified e-mail

Telephone

For the LICENSEE

Office

Street address

E-mail @/ certified e-mail

Telephone

Art. 17 Personal data

17.1. The data provided by the PARTIES will be processed according to the purpose of the CONTRACT, in compliance with the principles of lawfulness, fairness, transparency, accuracy and necessity referred to in Art. 5, paragraph 1 of the General Data Protection Regulation (GDPR). The provision of such data between the PARTIES is compulsory to fulfil all the CONTRACT obligations in any case connected to the execution of the relationship established with this deed.

17.2. The data provided by the PARTIES will be collected and processed, manually, on paper and digitally, through their inclusion in paper and/or computer files and may be communicated only within the structure of the PARTIES for the management of the relationship established by this deed.

17.3. The UNIVERSITY privacy policy on the protection of personal data of economic operators related to the CONTRACT is available at the following link

17.4. The LICENSEE privacy policy on the protection of personal data of economic operators related to the CONTRACT is available at the following

link /OR is attached to the CONTRACT.

17.5. By signing this deed, the PARTIES express their consent to the processing and communication of their personal data in the manner and purposes described above. The data controllers are the UNIVERSITY and the LICENSEE, and data protection representatives are the for the UNIVERSITY and for the LICENSEE. According to Art. of the UNIVERSITY privacy policy, the UNIVERSITY may use the data of this deed in anonymous form for statistical analysis on the progress of collaborative research activities.

Art. 18 Force majeure

18.1. Each PARTY may suspend the performance of its contractual obligations when such performance is rendered impossible or unreasonably burdensome by an unforeseeable impediment beyond its control, such as, for example, boycott, lockout, fire, war (whether declared or not), civil war, riots and revolutions, requisitions, embargo. The PARTY wishing to make use of this clause shall immediately notify in writing the other PARTY of the occurrence and termination of the force majeure circumstances. Should the suspension due to force majeure last more than six weeks, either PARTY shall be entitled to terminate the CONTRACT by giving 10 days prior notice in writing to the other PARTY.

Art. 19 General clauses

19.1. The CONTRACT constitutes the entire understanding of the PARTIES concerning the exclusive license of the INTELLECTUAL PROPERTY RIGHTS, and supersedes all contracts, agreements and/or understandings, written or oral, previously concluded and/or reached by the PARTIES concerning the same subject matter.

19.2. No agreement or arrangement modifying, derogating from, or extending the CONTRACT shall be binding on any PARTY unless made in writing, expressly referring to the CONTRACT and signed by the PARTIES and their respective duly authorised representatives.

19.3. If any provision of the CONTRACT is held invalid, void, or unenforceable, such defect shall not affect the remaining provisions of the

CONTRACT. The PARTIES shall be released from their rights and obligations under the conditions declared void, invalid or unenforceable to the extent such rights and obligations are directly affected by such defect. In such cases, the PARTIES shall negotiate in good faith the replacement of the invalid or void provisions by valid and effective ones following the PARTIES' intention.

19.4. In case either PARTY tolerates a behaviour of the other PARTY that may constitute a breach of the provisions of the CONTRACT, this shall not constitute a tacit waiver of the rights deriving from the breached provisions or of the right to require the fulfilment even partially of the terms and conditions set out in the CONTRACT, nor prevent the exercise of any other right or power of the PARTY under the CONTRACT.

19.5. Neither PARTY may assign the CONTRACT without the prior written agreement of the other PARTY. [Optional: The following two cases are an exception to the prohibition of the assignment of the CONTRACT:

- If the LICENSEE is subject to a merger or acquisition by a third party, the obligations arising from the CONTRACT are automatically transferred to its successor. To this end, the LICENSEE must notify the LICENSOR at least 30 (thirty) days prior to the formalization of the aforementioned operations, the name of the company acquiring the obligations, its registered office and legal representative;
- If the LICENSEE deems it necessary to set up a new company whose purpose is the development and marketing of the INVENTION, which would then qualify as a new legal entity controlled by LICENSEE for the achievement of said purpose, the LICENSOR hereby grants this new company the right to succeed LICENSEE in the CONTRACT, thus assuming all rights and obligations, subject to prior notice to the LICENSOR via certified e-mail of the name, registered office and legal representative of the company thus constituted, at least 30 (thirty) days before the formalization of the constitution.]

19.6. The PARTIES expressly state that the CONTRACT is the result of a negotiation regarding its entire content and each and every clause. Therefore,

Arts. 1341 and 1342 of the Italian Civil Code shall not apply.

The CONTRACT is signed electronically, by digital signature, under Art. 24(1) and (2) of Legislative Decree No. 82/2005 CAD – Digital Administration Code.

The LICENSOR [place, date, signature]

The LICENSEE [place, date, signature]

ANNEXES

Annex A: Description of the Know-How;

Annex B: Enactment plan;

Annex C: REFERENCE REVENUE statement model:

UNIVERSITY/SCHOOL RECORD No.	
This report is provided pursuant to the license agreement between THE UNIVERSITY/SCHOOL and (<i>name of LICENSEE</i>)	
Date of signature of the CONTRACT
Date of expiration of the CONTRACT
Royalty period
REFERENCE REVENUE
Royalty calculation on REFERENCE REVENUE
Sub-licensing revenue
Royalty calculation on sub-licensing revenue
Total royalty due
Comments



Regione Toscana



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