



Regione Toscana



UFFICIO REGIONALE DI TRASFERIMENTO TECNOLOGICO

FORM

PATENT ASSIGNMENT AND TECHNOLOGY TRANSFER AGREEMENT

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**PATENT ASSIGNMENT AND TECHNOLOGY
TRANSFER AGREEMENT REGARDING**
BY AND BETWEEN

University, Tax Code/V.A.T. number, with
registered office in (hereinafter, the 'ASSIGNOR' 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 'ASSIGNEE'),
represented by as (position of the authorized
representative)

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

WHEREAS

CHOOSE OPTION: A or B

OPTION A1 – Derivative acquisition of the invention

- a) The UNIVERSITY, in accordance with the assignment agreement regarding
..... signed with the inventors Prof.
(specify the inventors who have assigned the invention to the university), is
the sole owner of the economic rights related to the invention
entitled pertaining to the following industrial field
..... (hereinafter, the INVENTION);

OPTION A2 – Original acquisition of the invention

- b) The UNIVERSITY, in accordance with the assignment agreement regarding

..... signed with the inventors Prof.
(specify the inventors who have assigned the invention to the university), is
the sole owner of the economic rights related to the invention
entitled pertaining to the following industrial field
..... (hereinafter, the INVENTION);

c) ALTERNATIVE

d) The UNIVERSITY is the sole owner of the economic rights related 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

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

OPTION B 2 – Granted patent

f) The UNIVERSITY owns the following industrial property rights describing
the INVENTION:

1. Italian Patent number granted according to
application number dated
..... entitled

2. 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
.....;

3. 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];

- g) Furthermore, the UNIVERSITY owns know-how related to the INVENTION and regarding its use, fulfilment, experimentation and manufacture as described in Annex A;
- h) 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;
- i) With letter dated, the ASSIGNEE has expressed its interest in the purchase of the intellectual property rights related to the INVENTION for consideration of Euro
- j) On, the purchasing offer has been approved by the Patent Committee and approved by the Board of Administrators of the UNIVERSITY as stated in the administrative provision/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 predating the CONTRACT date.

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, prototypes, data, methods, technologies, secrets, algorithms, programs, formulae, experimental result, documents, projects, executive drawings, processes and materials, protected or not by intellectual property rights, better described in Annex A.

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

2.5. 'CONFIDENTIAL INFORMATION' means any information, even if including general 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 RESEARCH, including but not limited to: records, documents, drawings, product samples, data, analyses, reports, studies, graphical representations, elaborations, evaluations, technology or productive process assessments, models, tables including also the results of the RESEARCH under the CONTRACT.

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/photogram/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 [apparently] 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 ASSIGNOR assigns in accordance with this deed, for all legal purposes, the full and sole ownership of the INTELLECTUAL PROPERTY RIGHTS, as they are, to the ASSIGNEE, which accepts acknowledging the existing moral rights regarding the authorship of the INVENTION.

3.2. From the signing date of the CONTRACT, the ASSIGNEE may use and exploit the INVENTION at its sole discretion, bearing the INTELLECTUAL PROPERTY RIGHTS' management and maintenance including the applicable economic burdens and charges.

Art. 4 Assignor's obligation

44.1. Upon written notice sent by the ASSIGNEE, the ASSIGNOR commits to sign and to let its involved personnel sign the necessary documentation for the recording of the assignment in the applicable patent offices' registries. The recording shall occur within 14 (fourteen) days from the signing of the CONTRACT on behalf of the ASSIGNEE and at its cost. The ASSIGNOR furthermore commits to draft ed execute any other document reasonably requested by the ASSIGNEE in order to prosecute, maintain or extend the PATENTS. *(Optional: For the recording, the PARTIES attach to the CONTRACT*

the declaration of intervened patent assignment, Annex B).

4.2. The ASSIGNOR commits to deliver to the ASSIGNEE all the documents related to the KNOW-HOW, as specified in Annex A, within days from the reception of the first part of the consideration as stated in Art. 5.1..

4.3. Furthermore, for the purposes of the transfer of the KNOW-HOW, the ASSIGNOR provides to the ASSIGNEE, 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 ASSIGNEE's premises], within months from the conclusion of the CONTRACT (*specify an appropriate due date, e.g. twelve months*). The meetings shall provide assistance and initial training to the ASSIGNEE's technical personnel for the exploitation and use of the INVENTION as better described in the enactment plan as outlined in Annex C. The assistance and support provided by the ASSIGNOR to the ASSIGNEE beyond the indicated meetings and deadlines shall be specifically negotiated and object of additional consideration.

Art. 5 Consideration

5.1. Based on the assignment and on the other CONTRACT obligations, the ASSIGNEE shall pay the ASSIGNOR a consideration of Euro plus VAT, in the following ways:

-% at the time of entering the CONTRACT;
- The remaining part at the conclusion of the enactment plan as outlined in Annex C.

5.2. The ASSIGNEE shall make the payment within 30 (thirty) days after the receipt of the electronic invoice – SDI recipient code or PEC address in accordance with the provisions of Decree Law No. 76/2020 of 16 July 2020 solely by means of the PagoPA system in favor of the UNIVERSITY.

5.3. Upon payment of the consideration, the ASSIGNOR recognizes to have no additional consideration claim against the ASSIGNEE, regardless of the economical and commercial use the latter will make of the INTELLECTUAL PROPERTY RIGHTS, such as their assignment to third parties, potential modifications or improvements and such.

Art. 6 Scientific license grant-back

6.1. The ASSIGNOR reserves the right to use INTELLECTUAL PROPERTY RIGHTS solely for scientific and educational purposes (optional, including collaborative research and contract research agreements). By virtue of the CONTRACT, the ASSIGNEE therefore grants back to the ASSIGNOR a perpetual, free, non-revocable, non-exclusive, non-transferable, non-assignable, without sub-license right, valid in every country of validity of the PATENTS, license for the INTELLECTUAL PROPERTY RIGHTS limited to the abovementioned scientific and educational purposes.

Art. 7 Representations and Warranties

7.1. The ASSIGNOR represents that it owns the PATENTS, that they are effective, all their prosecution and renewal fees due up to..... are paid up, and as far as it knows, the PATENTS are not subject to pending administrative nor judicial procedures concerning their revocation, annulment, or violation. Furthermore, the ASSIGNOR states that the INTELLECTUAL PROPERTY RIGHTS are not the object of contracts, options, real or personal liens in favor of third parties.

Art. 8 Limitation of Liability

8.1. The ASSIGNOR is not aware of facts or information which may compromise the patentability, validity or enforcement of the INTELLECTUAL PROPERTY RIGHTS. Yet, the ASSIGNOR does not guarantee that the INTELLECTUAL PROPERTY RIGHTS may not be annulled in the event of future civil or administrative actions pursued by third

parties, whose potential costs and expenses shall be solely borne by the ASSIGNEE.

8.2. The ASSIGNEE acknowledges the experimental nature of the INVENTION, (optional which might have hazardous properties) and which is assigned without any explicit or implicit warranty, such as such as, for example, guarantees of merchantability, fitness for a particular purpose, and non-infringement of third parties' exclusive rights. [Optional: Nevertheless, the ASSIGNOR undertakes to carry out an analysis, at the ASSIGNEE's request, based on the database (specify the patent database paid for or freely accessed such as ESPACENET) and limited to the territories of (specify 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 ASSIGNEE with a report on the analysis conducted.

8.3. Within the limits of Art. 1229 of the Italian Civil Code, the ASSIGNEE shall be solely liable for any damages, direct or indirect, for any reason whatsoever, arising from such use or commercialisation, including those caused by third parties entitled by the ASSIGNEE, the ASSIGNOR being unassailable by any such liability claim. Accordingly, the ASSIGNEE undertakes to substantially and procedurally indemnify the ASSIGNOR 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. 9 Confidentiality obligations

9.1. Each PARTY shall observe the secrecy obligations on the CONFIDENTIAL INFORMATION exchanged, received or obtained in occasion of the signing or the execution of the CONTRACT and related to the INVENTION, including the information concerning the negotiation and the clauses of the CONTRACT. Each PARTY also ensures to adopt all measures it employs for the protection and treatment of its own CONFIDENTIAL INFORMATION of the same nature and to not communicate it to third

parties without the prior consent of the disclosing PARTY. The confidentiality obligations set forth in this CONTRACT shall last for a period of 5 (five) years (evaluate if the term is appropriate) as from the date each CONFIDENTIAL INFORMATION is communicated to the receiving PARTY.

Art. 10 Publications

10.1. The ASSIGNOR is expressly forbidden from publishing or presenting results or information relating to the INVENTION without the prior written consent of the ASSIGNEE, which shall not be withheld without a reasonable ground. The ASSIGNOR willing to publish information relating to the INVENTION shall solicit by written request, attached to a copy of the relevant documents, the ASSIGNEE'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 ASSIGNEE shall respond in writing verifying that the relevant documents comply with applicable data protection laws, do not contain any CONFIDENTIAL INFORMATION belonging to it 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]".

10.2. 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.

10.3. 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. 11 Applicable law and submission clause

CHOOSE OPTION: A,B or C

OPTION A – Court Resolution

11.1. Italian law applies to the CONTRACT, with the express exclusion of the application of the United Nations Convention on Contracts for the International sale of goods signed in 1980.

11.2. 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

11.1. Italian law applies to the CONTRACT, with the express exclusion of the application of the United Nations Convention on Contracts for the International sale of goods signed in 1980

11.2. 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 – Preliminary Mediation

11.1. Italian law applies to the CONTRACT, with the express exclusion of the application of the United Nations Convention on Contracts for the International sale of goods signed in 1980.

11.2. 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

11.3. 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. 12 Registration and recording

12.1. The CONTRACT drawn up in two originals and 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 ASSIGNOR's stamp duty shall be paid virtually (Authorization of the Italian Revenue Agency dated).

12.2. The ASSIGNEE 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 assignment within 30 (thirty) days from the signing of the CONTRACT. For the pursue of recording, the ASSIGNOR agrees to provide free of charge its own assistance upon the ASSIGNEE's request.

Art. 13 Exchange of information

13.1 Communications, requests and other communications under the CONTRACT shall be made in writing by e-mail or PEC. Official communications exchanged by PEC shall be deemed to have been made at the time of their receipt at the addresses hereunder:

For the ASSIGNOR

Office

Street address

E-mail @/ PEC

Telephone

For the ASSIGNEE

Office

Street address

E-mail @/ PEC

Telephone

Art. 14 Processing of personal data

14.1. The data provided by the PARTIES will be processed according to the purpose of the CONTRACT, in compliance with the principles of lawfulness, fairness and transparency, data minimisation, 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.

14.2. 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.

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

14.4. The ASSIGNOR 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.

14.5. 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 ASSIGNOR, and data protection representatives are the for the UNIVERSITY and for the ASSIGNOR. 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. 15 General clauses

15.1. The CONTRACT constitutes the entire understanding of the PARTIES concerning the assignment 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.

15.2. 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.

15.3. 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.

15.4. 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.

15.5. Neither PARTY may assign the CONTRACT without the prior written

agreement of the other PARTY.

15.6. 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 COMPANY [place, date, signature]

The UNIVERSITY [place, date, signature]

ANNEXES

Annex A: Description of the Know-How

Annex B. Declaration of Patent Assignment (official stamped paper, max 25 written lines for each page, apply stamp duty tax amounting to €16)

The University....., Tax Code/V.A.T. number with registered office in, represented by as owner of the following patent n. granted on (in the event the patent has not been registered specify the date and the application number: filed on n..... at the Chamber of Commerce of)

declares

to have assigned on the same to(company name) Tax Code/V.A.T. number, with registered office in, represented by as, declares to have purchased it.

Date and place

Signature of the Assignor

Signature of the Assignee



Regione Toscana



URTT | UFFICIO REGIONALE DI TRASFERIMENTO TECNOLOGICO

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