Optional contractual provision: (provisions marked as “optional contractual provision” can be kept at user’s option or omitted without replacement)

[\_\_\_\_] alternative clauses and comments of industrial partners / public research institutes

[\_\_\_\_] options, alternatives

(\_\_\_\_) assistance for fill in areas, options, alternatives

\_\_\_\_\_\_\_\_\_\_\_ (to be completed by the user)

Sale and Purchase Agreement regarding [INVentionS] [PatentS] [supplementary protection certificates] [utility rights] [semiconductor topography rights] [plant variety rights] [Know-How]

concluded between

\_\_\_\_\_\_\_\_\_\_\_\_\_(university) (research institute)

represented by \_\_\_\_\_\_\_\_\_\_\_(name)

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(address)

(hereinafter referred to as “**Seller**”)

as the party of the first part

and

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(name/company)

a company established under \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(e.g. Austrian) law

\_\_\_\_\_\_\_\_\_\_\_\_\_\_(commercial register number), \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(competent court) having its registered office in\_\_\_\_\_\_\_\_\_\_(place)

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(place)

(hereinafter referred to as “**Buyer**”)

as the party of the second part

(together hereinafter referred to as the “**Parties**”)

# definitions

## **Third Parties**:

## **Third Parties** are all legal and natural persons that are not the **Parties**.

## **Object of the Sale**:

## **Object of the Sale** is/are

## Option:

## the patent \_\_\_\_\_\_\_\_\_\_\_(name, no.), [application filed in \_\_\_\_\_\_\_\_\_\_\_(country) on \_\_\_\_\_\_\_\_\_(date) [and granted on \_\_\_\_\_\_\_\_\_(date)][, for which a PCT procedure \_\_\_\_\_\_\_\_\_\_\_(PCT number) was initiated on \_\_\_\_\_\_\_\_\_(date)]] (“**IP Right \_\_\_\_\_**(number)“). This IP right shall be registered in at least the following countries: \_\_\_\_\_\_\_\_ (countries)].

## Option:

## the European patent \_\_\_\_\_\_\_\_\_\_\_(name, EP no.), [application filed on \_\_\_\_\_\_\_\_\_(date) [and granted on \_\_\_\_\_\_\_\_\_(date)][, for which a PCT procedure \_\_\_\_\_\_\_\_\_\_\_(PCT number) was initiated on \_\_\_\_\_\_\_\_\_(date)]] (“**IP Right \_\_\_\_\_**(number)”). This IP right shall be registered in at least the following countries: \_\_\_\_\_\_\_\_ (countries)].

## Option:

## [the application for a patent \_\_\_\_\_\_\_\_\_\_\_(name, no.), filed in the context of PCT procedure \_\_\_\_\_\_\_\_\_\_\_(PCT number) on \_\_\_\_\_\_\_\_\_(date) (“**IP Right \_\_\_\_\_**(number)”), which shall be registered as an IP right in the national phase for at least the following countries: \_\_\_\_\_\_\_\_ (countries)].

## Option:

## [the European patent \_\_\_\_\_\_\_\_\_(name, EP no.), application filed on \_\_\_\_\_\_\_\_\_(date) (“**IP Right \_\_\_\_\_**(number)”), which shall be designated for at least the following countries: \_\_\_\_\_\_\_\_ (countries)].

## Option:

[the patent/utility model \_\_\_\_\_\_\_\_\_(name, no.), application filed in [country] on \_\_\_\_\_\_\_\_\_(date) [and granted on \_\_\_\_\_\_\_\_\_(date)] (“**IP Right \_\_\_\_\_**(number)”)].

## Option:

## [the supplementary protection certificate\_\_\_\_\_\_\_\_\_(name, no.) based on basic patent \_\_\_\_\_\_\_\_\_(name, no.), application filed on \_\_\_\_\_\_\_\_\_(date) [and granted on \_\_\_\_\_\_\_\_\_(date)] (“**IP Right \_\_\_\_\_**(number)”)].

## Option:

## [the semiconductor topography right \_\_\_\_\_\_\_\_\_(name, no.), application filed on \_\_\_\_\_\_\_\_\_(date) [and granted on \_\_\_\_\_\_\_\_\_(date)] (“**IP Right \_\_\_\_\_**(number)”)].

## Option:

## [the plant variety right \_\_\_\_\_\_\_\_\_(name, no.), application filed on \_\_\_\_\_\_\_\_\_(date) [and granted on \_\_\_\_\_\_\_\_\_(date)] (“**IP Right \_\_\_\_\_**(number)”)].

## Option:

## [the invention \_\_\_\_\_\_\_\_\_(name) (“**Invention**”), for which an IP right shall be registered in at least the following countries: \_\_\_\_\_\_\_\_ (countries). As long as no IP right protection has been applied for the invention, the invention shall in any case be subject to the provisions applicable to **Know-How**.]

## Option:

## [the **Know-How**.]

## Option: [the prototypes as specified in greater detail in **Annex ./1.2.**]

## Option: [the development documentation as specified in greater detail in **Annex ./1.2.a**.]

## **Know-How**:

## 1.3.1. **Know-How** shall refer to the entire technical expertise and experiences of the **Seller** in the area of \_\_\_\_\_\_\_\_\_\_\_\_\_(description).

## Alternative 1: [**Know-How** shall refer to the entire technical expertise and experiences of the **Seller** in the area of \_\_\_\_\_\_\_\_\_\_\_\_\_(description), which goes beyond the scope of the **IP Right** **\_\_\_\_\_**(number).]

## Alternative 2: [**Know-How** shall refer to the entire technical expertise and experiences of the **Seller** in the area of \_\_\_\_\_\_\_\_\_\_\_\_\_(description) as specified in greater detail in **Annex ./1.3.a.** If there is a constant exchange of **Know-How** between the **Parties**, **Annex ./1.3.a.** shall be amended on an on-going basis, which means that any and all amendments shall become an integral part of this **Agreement** and shall especially be subject to the confidentiality obligation specified in this **Agreement**.]

## 1.3.2. To the extent that the **Know-How** meets the requirements for the registration of **IP Rights**, the **Buyer** shall, in coordination with the **Seller**, register the relevant **IP Rights**.

## Alternative: [To the extent that the **Know-How** meets the requirements for the registration of **IP Rights**, the **Seller** shall, in coordination with the **Buyer,** register the relevant **IP Rights**. For a period of **\_\_\_\_**(e.g. 3 (three)) months after being informed of the application/registration of the **IP Right**, the **Seller** shall grant to the **Buyer**, with regard to this **IP Right** and the rights of exploitation related thereto, a [free] option to negotiate exclusively on

## Option 1: a transfer of the rights for a field of use corresponding to the **Buyer’s** business objective according to the sale and purchase agreement as defined in **Annex./1.3.b.**]

## Option 2: the possibility to acquire a [non-] exclusive license for a field of use corresponding to the **Buyer’s** business objective according to the license agreement as defined in **Annex./1.3.bb.**

## Alternative to the free-of-charge option: [The option fee amounting to EUR**\_\_\_\_**(amount) [excluding VAT] shall be payable per month or part thereof until the option is exercised or the period granted for exercising the option has lapsed.]

## **Products**:

## **Products** shall refer to all products produced applying or using the **Object of the Sale**.

## **IP Rights**:

## **IP Rights** shall refer to all IP rights that are part of the **Object of the Sale**.

## **Personal Data**:

## **Personal Data** are any information relating to an identified or identifiable natural person pursuant to Article 4 item 1 GDPR (General Data Protection Regulation).

## Optional provision:(if the compensation comprises variable parts depending on turnover)

## **Turnover**:

## **Turnover** shall refer to the amount charged by the **Buyer** [and by its licensees and sublicensees or affiliated companies] to the purchasers for the **Products**, less any turnover and value added taxes (commissions, discounts, risk premiums, bonuses or annual compensations, payment defaults, handling fees, packing, shipping, insurance, transport and other ancillary costs etc. cannot be deducted, return deliveries of **Products** to the **Buyer** cannot be charged.).

## Optional provision:

## **Affiliated Companies**:

## **Affiliated Companies** shall refer to a) companies in whose case a **Party** indirectly or directly owns more than half of the capital or the assets of the company or can appoint more than half of the members of the managing or administrative body or the bodies appointed for legal representation or is entitled to conduct the business of the company and b) companies which indirectly or directly have the rights and means of control mentioned under a) related to a contracting company and c) companies in whose case the contracting companies jointly have the rights and means of influence mentioned under a). Such jointly controlled companies are considered as affiliates of every contracting company.

alternative clause of industrial partners / public research institutes:

## **Affiliated Companies** are affiliated companies within the meaning of § 115 Limited Liability Company Act *(GmbHG)* or § 15 of the Stock Corporation Act *(Aktiengesetz, AktG)*.

## **Agreement**:

## Agreement shall refer to this Sale and Purchase Agreement.

# Preamble

## The **Seller** is the owner of the **Object of the Sale**. The **Seller** intends to transfer the ownership title in the **Object of the Sale** to the **Buyer**.

## Optional provision:

## Non-exclusive licenses with regard to the **Object of the Sale** have already been granted for \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ (descpription for which patents/application for a patent, fields of use, customer groups, territories non-exclusive licenses have already been granted).

## The **Buyer** knows the **Object of the Sale** and has already familiarised itself with the potentials for use of the **Object of the Sale**. The **Buyer** would like to purchase the **Object of the Sale**.

## Alternative clause of industrial partners / public research institutes:

## The **Buyer** would like to purchase the **Object of the Sale**.

# Object of the Agreement

## The **Seller** hereby sells the **Object of the Sale** to the **Buyer** and the **Buyer** hereby buys the **Object of the Sale** with all related rights and obligations.

## Optional provision:

## The **Buyer** may use and exploit the **Object of the Sale** at its sole discretion, unless provided otherwise in this **Agreement**.

# Transfer

## The **Seller** undertakes, [at its own cost] [at the **Buyer’s** cost](chose alternative) to immediately take all actions and measures required to transfer the **Object of the Sale** to the **Buyer** with full effect. In particular, the **Seller** shall immediately, upon the **Buyer’s** request, sign deeds of transfer in the required form. The costs of the transfer shall include, without limitation, certification fees and registration costs arising in connection with the transfer as well as the costs for executing the deed of transfer.

## The deed of transfer, **Annex ./4.2.**, informing the authority in charge of registration on the transfer of the ownership title in the **Object of the Sale**, is to be filed with the said authority by the **Seller** pursuant to Item 6.1. immediately, at the latest, however, within \_\_\_\_(e.g. 14 (fourteen)) days after receipt of the purchase price.

## If the Buyer sells the Object of the Sale or part of it to a Third Party, Buyer is obliged to also assign the Third Party all obligations towards the Seller arising from this Agreement.

# Handover of documents

## The **Seller** undertakes to hand over to the **Buyer** any and all research documentation, tables, test reports etc. and all documents relating to the **Object of the Sale** (research reports, registration documents etc.). Such handover shall take place immediately, at the latest, however, within \_\_\_\_\_\_\_(e.g. 30 (thirty)) days after the payment of the agreed purchase price pursuant to Item 6.1.

alternative clause of industrial partners / public research institutes:

The **Seller** undertakes to hand over to the **Buyer** any and all research documentation, tables, test reports etc. and all documents relating to the **Object of the Sale** (research reports, registration documents etc.) in any form whatsoever, provided that such handover does not violate any rights granted to **Third Parties**. Such handover shall take place immediately, at the latest, however, within \_\_\_\_\_\_\_(e.g. 30 (thirty)) days after the payment of the agreed purchase price pursuant to Item 6.1.

## If any of the documents pursuant to item 5.2. contain **Personal Data**, the **Seller** undertakes to take all precautions to enable the **Buyer** to process the **Personal Data** lawfully and to provide the **Buyer** with all necessary information. The information pursuant to Chapter III GDPR shall be provided by the **Seller**[**Buyer**](chose alternative).

# Purchase price

## The purchase price for the **Object of the Sale** shall amount to EUR \_\_\_\_, of which EUR \_\_\_\_ are to be paid for \_\_\_\_\_\_\_\_\_\_\_(e.g. IP Right 1, …) and EUR\_\_\_\_ for the **Know-how**[, the prototypes as specified in **Annex ./1.2.** and the development documentation as specified in **Annex ./1.2.a.**]. The **Seller** shall invoice such amount at the earliest upon signing this Agreement. The purchase price shall be due for payment within \_\_\_\_\_\_\_(e.g. 60 (sixty)) days from receipt of a duly issued invoice.

## Optional provision:

## To the extent that and as soon as the **Buyer** reaches a [global] **Turnover** of at least EUR \_\_\_\_ (“minimum threshold”) with the **Products**, the **Seller** is entitled to \_\_\_\_(percentage)% of the relevant **Turnover** as additional purchase price (for avoidance of doubt, the **Turnover** generated up to the minimum threshold of EUR \_\_\_\_ shall be part of the relevant **Turnover**). The turnover figures relating to the **Products** may not be manipulated by giving away the **Products** free of charge or by a pricing policy that is not in conformity with market rules. If **Products** are not sold in conformity with market rules, such sales shall be treated as if they had been made in conformity with market rules when assessing the additional purchase price. The **Buyer** shall provide the **Seller** with accounts on the **Turnover** related to the **Products** on \_\_\_\_\_(e.g. 31 January) (“Due Date”) for the preceding calendar year and shall, within a further \_\_\_\_\_(e.g. 30 (thirty)) days, transfer the resulting purchase price to the **Seller’s** account \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(account number, branch sort code/BIC, IBAN), stating as reference \_\_\_\_\_\_\_\_\_\_\_\_ (if **Turnover** is generated in a currency other than the euro, it shall be translated, at the **Seller’s** discretion, either based on the exchange rate valid as at the date when the proceeds generated based on the **Products** are received by the relevant **Seller** or at the Due Date). Any and all transfer costs shall be borne by the **Buyer**. In the case of payment default, default interest in the amount of \_\_\_\_(e.g. 3 (three))% above the relevant marginal lending rate of the European Central Bank (base interest rate pursuant to § 352 of the Austrian Business Code *(Unternehmensgesetzbuch, UGB)*) shall become payable. The obligation to pay additional purchase price parts depending on turnover as defined in Item 6.2. shall end in any case upon the end of the period of protection of **IP Right \_\_\_\_\_**(number) (“Maximum Term”), irrespective thereof at the latest, however, on **\_\_\_\_\_**(e.g. 31 December).

alternative clause of industrial partners / public research institutes:

The purchase price for the **Object of the Sale** shall amount to EUR\_\_\_\_, of which EUR\_\_\_\_ shall be paid for IP Right **\_\_\_\_\_**(number and EUR \_\_\_\_ for the **Know-how** and EUR \_\_\_\_ for the prototypes as specified in **Annex ./1.2.** and EUR \_\_\_\_ for the development documentation as specified in **Annex ./1.2a.** The **Seller** shall invoice such amount at the earliest upon signing this Agreement. The purchase price shall be due for payment within \_\_\_\_\_\_\_(e.g. 60 (sixty)) days upon receipt of a duly issued invoice. Furthermore, the **Seller** shall be entitled to an additional purchase price of \_\_\_\_\_(percentage) % of the relevant **Turnover**, at least, however, to EUR \_\_\_\_ per calendar year. The minimum turnover shall apply, for the first time, to the year \_\_\_\_\_\_\_\_(year). The turnover figures relating to the **Products** may not be manipulated by giving away the **Products** free of charge or by a pricing policy that is is not in conformity with market rules. If **Products** are not sold is not in conformity with market rules, such sales shall be treated as if they had been made if not in conformity with market rules when assessing the additional purchase price. The **Buyer** shall provide the **Seller** with accounts on the **Turnover** related to the **Products** on \_\_\_\_\_\_\_(e.g. 31 January) (“Due Date”) for the preceding calendar year and shall, within a further \_\_\_\_(e.g. 30 (thirty)) days, transfer the resulting purchase price to the **Seller’s** account \_\_\_\_\_\_\_\_\_\_\_(account number, branch sort code/BIC, IBAN), stating as reference \_\_\_\_\_\_\_\_\_\_\_\_ (if **Turnover** is generated in a currency other than the euro, it shall be translated, at the **Seller’s** discretion, either based on the exchange rate valid as at the date when the proceeds generated based on the **Products** are received by the relevant **Seller** or at the Due Date). Transfer costs shall be borne in equal parts by both the **Buyer** and the **Seller.** In the case of payment default, default interest in the amount of \_\_\_\_(e.g. 3 (three))% above the relevant marginal lending rate of the European Central Bank (base interest rate pursuant to § 352 of the Austrian Business Code *(Unternehmensgesetzbuch, UGB)*) shall become payable. The obligation to pay additional purchase price parts depending on turnover as defined in Item 6.2. shall end in any case upon the end of the period of protection of **IP Right \_\_\_\_\_**(number) (“Maximum Term”), irrespective thereof at the latest, however, on **\_\_\_\_\_**(e.g. 31 December).

## Alternative 1: [Depending on the realisation of defined milestones pursuant to **Annex ./6.2.**, the following additional purchase price parts shall become payable: EUR\_\_\_\_ when milestone 1 is achieved, EUR\_\_\_\_ when milestone 2 is achieved, EUR\_\_\_\_, when milestone **\_\_\_\_\_**(number) is achieved]

## The **Buyer** shall be obliged to inform the **Seller** on the achievement of defined milestones, describing all material circumstances.

## Alternative 2: [In addition to the flat-rate purchase price, the following additional purchase price parts shall become payable: EUR \_\_\_\_ upon registration of **IP Right** **\_\_\_\_\_**(number) in \_\_\_\_\_\_\_\_\_\_(country), EUR\_\_\_\_ after **IP Right** **\_\_\_\_\_**(number) has been in force for \_\_\_\_(number) years, EUR \_\_\_\_ upon positive completion of the clinical trials, EUR \_\_\_\_ upon approval for sale of \_\_\_\_\_\_\_\_\_\_(description) in the material sales markets \_\_\_\_\_\_\_\_\_\_\_\_\_\_(define countries).]

## Alternative 3: [In addition to the flat-rate purchase price, the following additional purchase price parts shall become payable: In addition to the purchase price pursuant to Item 6.1., the **Buyer** shall pay an additional purchase price fee in the amount of EUR\_\_\_\_ per **\_\_\_\_\_**(concrete description) [produced] [put into circulation], which shall be due for payment [on the day of production] [upon delivery to customers]. The **Buyer** shall inform the **Seller**, by the \_\_\_\_(e.g. 10th (tenth)) day of each month, on the number of items sold in the preceding month and the resulting additional purchase price fee. The additional purchase price fee shall be paid at the latest by the \_\_\_\_(e.g. 30th (thirtieth)) day of the relevant month, or otherwise be subject to the consequences of default as described in Item 6.1.]

## The fees payable for registering the **IP Rights** have [not yet] been paid. \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(Please indicate the exact payment status of the registration fees). These shall be paid by the **Buyer** or reimbursed by the **Buyer** after receipt of a corresponding invoice.

## Moreover, the **Buyer** shall pay the patent attorney costs incurred by the **Seller** until the day of signing the Agreement, at the latest, however, until \_\_\_\_\_(date), for creating, registering and maintaining the validity of the **IP Rights** after having received a duly issued invoice within the payment period set forth in Item 6.1., up to a maximum amount of EUR\_\_\_\_(excluding VAT).

## If an **IP Right** is declared void or revoked at a later point in time [for reasons outside the **Seller’s** sphere of influence], this shall not give rise to the obligation to repay the purchase price already paid. [The purchase price payments referred to under 6.2. shall be due for payment also if no IP right is granted or if an **IP Right** expires before its maximum term or ceases to exist for any other reason, such as revocation or nullity, but the **Buyer** uses the invention[, unless the **Seller** were to be in violation of the provisions of Item 11.]. [However, the additional purchase price which might become due in cases where no **IP right** is granted or the **IP Right** ceases to exist does not amount to \_\_\_\_\_\_\_\_(percentage)% (see Item 6.2.), but merely to \_\_\_\_\_\_\_\_(percentage)% of the **Turnover**, unless the fact that the **IP Right** is not granted, expires or ceases to exist is caused by an action or omission on the part of the **Buyer**.]

## The **Seller** shall pay any and all statutory compensation due to inventors with regard to the **Object of the Sale**, unless there is a separate agreement stipulating that the **Buyer** shall directly compensate the inventors. [However, the **Buyer** shall indemnify and hold harmless the **Seller** against any and all inventor compensation claims if and to the extent that such inventor compensation is due from the **Seller** because the agreed purchase price for the **Object of the Sale** did not match its value. Indemnification and holding harmless shall be contingent on the **Seller** having been ordered by a court to pay such inventor compensation with final legal effect.

alternative clause of industrial partners / public research institutes:

Once all the amounts due mentioned in this Item 6 (Purchase Price) have been paid, the **Seller** shall have no further claims for payment under this **Agreement**. Any claims raised by employees for inventor compensation with regard to the **Object of the Sale** shall be borne in full by the **Seller**.

## Optional provision:

## Should the **Buyer** transfer or contribute the **Object of the Sale** to **Third Parties**, any and all of the **Buyer’s** obligations under this **Agreement** shall each be transferred/assigned to its full extent to the respective **Third Party**. The **Seller** shall be informed thereof without delay.

# ASSISTANCE and SUPPORT PROVIDED BY THE Seller

## To the extent desired by the **Buyer**, the **Seller** shall, after the conclusion of this **Agreement**, continue to provide assistance and support in the preparation and implementation of the registration, expansion and assignment of IP Rights, the drafting of comments and opinions in the context of the procedure for the granting of IP Rights or the defending of IP Rights, as well as technical assistance or initial training. [The **Seller** shall be under no obligation to provide such services] The services provided by the **Seller** shall be carried out by the employees (inventors) involved in developing the **Object of the Sale**. Compensation shall be based on the amount of time actually spent based on the hourly rates set forth in **Annex ./7.**

## alternative clause of industrial partners / public research institutes:

## To the extent desired by the **Buyer**, the **Seller** shall, after conclusion of this **Agreement**, continue to provide assistance and support in the preparation and implementation of the registration, expansion and assignment of **IP Rights**, the drafting of comments and opinions in the context of the procedure for the granting of **IP Rights** or the defending of **IP Rights**, as well as technical assistance or initial training for a period of \_\_\_\_ \_\_\_\_(e.g. 3 (three)) years without any separate compensation. The services provided by the **Seller** shall be carried out as far as possible by the employees (inventors) involved in developing the **Object of the Sale**.

## If, after conclusion of this **Agreement**, the **Seller** provides assistance and support in connection with the further development and exploitation of the **IP Rights** on the market, compensation shall be based on the amount of time actually spent based on the hourly rates set forth in **Annex ./7**.

# RESEARCH PROVISO

## The **Seller** reserves the right to use the **Object of the Sale** as well as the documents handed over (Item 5) for research and teaching purposes [as well as patient care]. [This shall also include the right to use the **Object of the Sale** within the framework of research and development cooperation agreements – also with business partners.] The **Buyer** shall thus grant to the **Seller** a free, non-transferable, irrevocable, non-exclusive license regarding the **Object of the Sale** to the required extent.

alternative clause of industrial partners / public research institutes:

The **Seller** reserves the right to use the **Object of the Sale** as well as the documents handed over (Item 5) for research and teaching purposes [as well as patient care] without, however, being entitled itself to manufacture **Products** covered by the **Object of the Sale** in this connection. [This shall also include the right to use the **Object of the Sale** within the framework of research and development cooperation agreements – also with business partners.] The **Buyer** shall thus grant to the **Seller** a free, non-transferable, non-exclusive license regarding the **Object of the Sale** to the required extent. The **Buyer’s** interests in terms of confidentiality and competition shall be safeguarded. If Item 11 of this **Agreement** is not complied with, the **Buyer** may revoke this license at any time.

# CONFIDENTIALITY OBLIGATION WITH REGARD TO KNOW-HOW

## The **Seller** shall provide the **Buyer** with **Know-How** [pursuant to **Annex ./1.3a.**]. The documents / **Annex ./1.3a.** shall be handed over [after receipt of the purchase price payment] [after all approvals and authorisations necessary for this **Agreement** to take effect have been granted] [within \_\_\_\_ \_\_\_\_(e.g. 3 (three)) weeks after this **Agreement** has entered into force].

## Optional provision:

## Unless there is any explicit written consent by the **Seller** stating otherwise, the **Buyer** undertakes to treat **Know-How** with utmost confidentiality [and to refrain from using it for purposes other than those mentioned for the performance of this **Agreement** – exploitation of the **Object of the Sale**] and to ensure that unauthorised **Third Parties**, including, without limitation, suppliers or subcontractors, cannot gain any knowledge thereof. The **Buyer** takes all required adequate measures in order to keep the **Know-How** confidential.

## Optional provision:

## The **Buyer** undertakes to disclose **Know-How** exclusively to those employees who need to have access to it for the purpose of performing this **Agreement** and to ensure that these employees are bound by this confidentiality obligation in verifiable written form. The confidentiality obligation shall continue after termination of the employment relationship.

## Optional provision:

## It shall be permitted to make copies of written documents which contain **Know-How** or which are provided in any other form (e.g. on data storage devices) exclusively for the purpose of performing this **Agreement**.

## Optional provision:

## With respect to the scope of the confidentiality obligation, the **Buyer** bears the burden of proof for establishing the fact that the **Know-How** of which it gained knowledge based on this **Agreement** had already been disclosed without the **Buyer** being at fault.

# BOOK-KEEPING DUTIES and AUDIT RIGHTS on the part of the seller

## The **Buyer** is obliged to keep book-keeping records on the production and worldwide distribution of the **Object of the Sale**, including license income, documenting the proceeds of sales, the license fees and the exact number of items produced as well as any **Products** distributed for free or sold at below-market prices.

## Once a year, the**Seller** is entitled, upon giving \_\_\_\_(e.g. 14 (fourteen)) days’ written advance notice, to have the correctness of the book-keeping and accounting records checked, at its own expense, by auditors, chartered accountants or tax advisers bound to professional secrecy. If incorrectnesses of more than \_\_\_\_(e.g. 1 (one))% are uncovered, the costs for checking the accounts shall be borne by the **Buyer**[, however, only to the extent that such costs do not exceed the costs charged by an auditor domiciled in the **Buyer’s** registered place of business (which means that travel, accommodation and similar costs shall not be reimbursed)]. Furthermore, any shortfalls uncovered shall be paid by the **Buyer** to the **Seller** within 14 (fourteen) days.

# WARRANTY AND LIABILITY

## The **Buyer** is sufficiently familiar with the characteristics of the **Object of the Sale** and has had sufficient opportunity to become familiar with the characteristics of the **Object of the Sale**.

## The **Seller** warrants that, at the time this **Agreement** is concluded, it is the unrestricted owner of the **Object of the Sale** [and that no licenses regarding the **Object of the Sale** have been granted to any **Third Parties**] [, but that a non-exclusive license regarding \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(description of the scope of the license, when the license entered into force, etc.) has been granted to \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(name, company, address)].

alternative clause of industrial partners / public research institutes:

The Seller warrants that, at the time of the **Agreement’s** entry into force, it is the unrestricted owner of the **Object of the Sale** and that, to the best of its knowledge, no infringement or nullification proceedings are pending [and that no licenses regarding the **Object of the Sale** have been granted to any **Third Parties**] [, but that a non-exclusive license regarding \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(description of the scope of the license, when the license entered into force, etc.) has been granted to \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(name, company, address)]. The **Seller** shall notify any possibly existing licensees of the sale.

## To the best of the **Seller**’s knowledge at the time this **Agreement** is concluded, and without the **Seller** being subject to any special obligation to investigate by carrying out research into the state of the art or on publications, no actions prejudicial to novelty, such as publications, have been taken [and no circumstances exist that would result in a failure of the **IP Right** being granted or the invention being dependent on other patents] [and the **Object of the Sale** does not infringe any third-party **IP Rights**].

alternative clause of industrial partners / public research institutes:

To the best of the **Seller**’s knowledge at the time this **Agreement** is concluded – in the course of customary research into the state of the art [in the course of searches in \_\_\_\_\_\_\_\_\_\_\_\_\_(description of databases) databases] on relevant documents published by \_\_\_\_\_\_\_\_(date), laid out in **Annex ./11.3.** – no actions prejudicial to novelty, such as publications, have been taken and no circumstances exist that would result in a failure of the **IP Right** being granted or the invention being dependent on other patents] [nor does the **Object of the Sale** infringe any third-party **IP Rights**, and the production, use and distribution of the **Objects of the Agreement**/[procedures used with the **Object of the Agreement**] do not and could not infringe any third-party IP rights and no infringements of IP rights of **Third Parties** have occurred.

## The **Seller** shall continue to refrain from taking any actions that are prejudicial to novelty.

## Optional provision:

## The **Seller** furthermore warrants not to have infringed any formal conditions (such as incorrect indication of inventors) which might prevent the **IP Right** being granted.

## The **Seller** does not accept any further warranty or liability for freedom from defects, including, but not limited to, dependence on other IP rights, novelty, or economic or commercial exploitability of the **Object of the Sale**, or producibility or suitability for manufacture of the **Products** produced using the **Object of the Sale**.

alternative clause of industrial partners / public research institutes:

The **Seller** does not accept any further warranty or liability for freedom from defects, including, but not limited to, dependence on other IP rights, novelty, or economic or commercial exploitability of the **Object of the Sale**, or producibility or suitability for manufacture; the **Seller** does, however, warrant the practicability and reproducibility of the invention.

## Any liability on the part of the **Seller** for slight negligence shall be excluded in any case. Further claims or claims other than those stated under Item 11. on the part of the **Buyer** shall be excluded irrespective of their legal basis.

# CostS

## Each of the **Parties** shall bear its own legal costs. Any and all costs for re-registration of ownership in the **Object of the Sale** shall be borne by the **Buyer**. Any charges possibly arising from or in connection with the execution and for any stamp duties relating to this Agreement or similar charges shall be borne by the **Buyer**.

# Jurisdiction and applicable law

## [Exclusive] Jurisdiction for any dispute, controversy or claim arising out of and relating to this **Agreement**, also with regard to its existence and after its termination, shall lie with the court competent for commercial matters in \_\_\_\_\_\_\_(place). The **Agreement** shall be governed by Austrian law excluding its conflict-of-law rules. The application of the United Nations Convention on Contracts for the International Sale of Goods shall be explicitly excluded.

## [Alternative: Arbitration]

## Any dispute, controversy or claim arising under, out of or relating to this **Agreement** and any subsequent amendments of this **Agreement**, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, shall be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules.

## The arbitral tribunal shall consist of a sole arbitrator. The place of arbitration shall be \_\_\_\_\_\_\_(place). The language to be used in the arbitral proceedings shall be \_\_\_\_\_\_\_(e.g. German). The dispute, controversy or claim shall be decided in accordance with the law of \_\_\_\_\_(country).

[Alternative: Arbitration and Mediation]

## Any dispute, controversy or claim arising under, out of or relating to this **Agreement** and any subsequent amendments of this **Agreement**, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, shall be submitted to mediation in accordance with the WIPO Mediation Rules. The place of mediation shall be \_\_\_\_\_\_\_(place). The language to be used in the mediation shall be \_\_\_\_\_\_\_(e.g. German).

## If, and to the extent that, any such dispute, controversy or claim has not been settled pursuant to the mediation within 60 (sixty) days of the commencement of the mediation, it shall, upon the filing of a Request for Arbitration by either **Party**, be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules.

## Alternatively, if, before the expiration of the said period of 60 (sixty) days, either **Party** fails to participate or to continue to participate in the mediation, the dispute, controversy or claim shall, upon the filing of a Request for Arbitration by the other **Party**, be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules. The arbitral tribunal shall consist of a sole arbitrator. The place of arbitration shall be \_\_\_\_\_\_\_(place). The language to be used in the arbitral proceedings shall be \_\_\_\_\_\_\_(e.g. German). The dispute, controversy or claim referred to arbitration shall be decided in accordance with the law of \_\_\_\_\_(country).

# Final provisions

## 14.1. This **Agreement** shall constitute the entire agreement between the **Parties** regarding the **Object of the Agreement**. There are no supplementary arrangements. Drafts, correspondence exchanged prior to signing, etc. may not form the basis for interpreting this **Agreement**.

## 14.2. Any changes or amendments of this **Agreement** must be made in writing (transmission via fax or e‑mail shall not suffice) in order to take effect. This shall also apply to any waiver of this requirement of written form.

## 14.3. Should individual provisions of this **Agreement** be or become invalid, void, illegal or unenforceable, this shall not affect the validity of the remaining provisions of this **Agreement**. The invalid, void, illegal or unenforceable provision(s) shall be replaced by (an) alternative provision(s) which most closely correspond(s) to the original intent of the **Parties** to the extent that this is legally possible and whose economic effect best correspond(s) to the effect intended by the invalid, void, illegal or unenforceable provision(s).

## 14.4. Without the other **Party’s** prior consent, no **Party** may inform any **Third Parties** of this **Agreement**, any parts thereof or any related matter, unless such **Party** is obliged to do so based on statutory provisions. This shall not apply to the fact of the conclusion of this **Agreement** as such.

## 14.5. 2 (two) copies of this **Agreement** shall be signed and each shall be deemed an original, with one being handed out to each of the **Parties**.

# ContaCt persons

Any and all correspondence is to be addressed to:

For the **Buyer** \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(name, position, precise address, e-mail, phone)

For the **Seller** \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(name, position, precise address, e-mail, phone)

Any change of the contact details is to be communicated to the respective other **Party** without delay. Otherwise, any and all communications shall be deemed duly delivered in any case.

# ANNEXES

**Annex ./1.2.** Specification of the prototypes

**Annex ./1.2.a** development documentation

**Annex ./1.3.a.** Description of the **Know-How**

**Annex./1.3b.** Defined sale and purchase agreement

**Annex./1.3bb.** Defined license agreement

**Annex ./4.2.** Deed of transfer

**Annex ./6.2.** Milestones

**Annex ./7.** Hourly rates

# Signatures

For the **Buyer**

Date: \_\_\_\_\_\_\_\_\_\_\_\_

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

[Name and title/position] [Signature]

For the **Seller**

Date: \_\_\_\_\_\_\_\_\_\_\_\_

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

[Name and title/position] [Signature]

Annex ./4.2.

DEED OF ASSIGNMENT

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ (full name and address, registration number) (Seller) herewith declare/s that the Patents:

* [Austrian Patent Application A: \_\_\_\_\_\_\_\_\_\_\_\_]
* [International Patent Application PCT/AT: \_\_\_\_\_\_\_\_\_\_\_\_\_\_]
* [European Patent Application EP: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_]

(choose alternative)

has/have been assigned in [full] [in part](choose alternative) for the following designated Contracting States \_\_\_\_\_\_\_\_\_(states) with all rights, titles and interest to:

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ (full name and adress, registration number) (Buyer)

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_              \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

[Place, Date]                              [Signature of present owner/s (assignor/s) in notarized form]

We accept this assignment with all rights and duties.

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_           \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

[Place, Date]                             [Signature of new owner/s (assignee/s)]