Optionale Vertragsbestimmung: (Als "Optionale Vertragsbestimmungen" gekennzeichnete Bestimmungen

können nach Wunsch beibehalten oder ersatzlos weggelassen werden)

[\_\_\_\_] Alternativklauseln und Kommentare Industriepartner/öffentliche Forschungseinrichtungen

[\_\_\_\_] Optionen, Alternativen

(\_\_\_\_) Hilfestellung für Eingabefelder, Optionen, Alternativen

patent licensing agreement

**PATENT AND KNOW-HOW LICENSING AGREEMENT**

concluded between

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

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

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

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

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)

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

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

as the party of the second part

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

# Definitions

## **Objects of the Agreement:**

**Objects of the Agreement** shall be the **Contractual Products** described under **Contractual IP Rights** and/or produced in the scope of or with the help of the **Licensed Procedures**.

## **Contractual IP Rights:**

**Contractual IP Rights** shall refer to the following [registered]/[granted] (choose alternative) [patents][utility models][patentable inventions] (choose alternative):

[Group of IP Rights I]

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 at least in 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 at least in the following countries: \_\_\_\_\_\_\_\_ (countries)].

Option:

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

[Group of IP Rights II]

To the extent that **Contractual IP Rights** are applied for in the countries mentioned in these definitions, these IP rights shall become an object of this Agreement.

## **Contractual Products:**

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(description)

## **Field of Use:**

There are the following **Fields of Use** for **IP Right** \_\_\_\_(IP right number):

**Field of Use** \_\_\_\_(Field of Use number): \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(description)

**Field of Use** \_\_\_\_(Field of Use number): \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(description)

## **Contractual Territory:**

**Contractual Territory** \_\_\_\_(number) shall be \_\_\_\_\_\_\_\_\_\_\_\_ [worldwide].

## **Know-How:**

**Know-How** shall refer to the entire technical expertise and experiences of the **Licensor** in the area \_\_\_\_\_\_\_\_\_\_\_(description) [as specified in greater detail in **Annex 1./6.**] which goes beyond the scopeof the **Contractual IP Rights**.

[If there is a constant exchange of **Know-How** between the **Parties**, the annex **Annex 1./6.** shall be amended on an on-going basis, and 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 under Item 6.]

[To the extent that the **Know-How** meets the requirements for the registration of **IP Rights**, the **Licensor** shall, in coordination with the **Licensee**, register the relevant **IP Rights**, which shall then also become an integral part of this Agreement.]

## **Licensed Procedures:**

Licensed Proceduresshall refer to the procedures described under **Contractual IP Rights**.

## **Exclusive License:**

An **Exclusive License** shall refer to a license granted to the **Licensee** by the **Licensor** for **exploiting** the **Contractual IP Rights** [and the **Know-How**] [for specific **Fields of Use**] in a specific **Contractual Territory**, while no other licensee is entitled to **exploit** the specified **Contractual IP Rights** in the **Contractual Territory**. The **Exclusive License** shall not prevent the **Licensor** from using the **Contractual IP Rights** and [the **Know-How**][the **Contractual Software**](choose alternative) for research and training purposes [and for patient care].

Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

An **Exclusive License** shall refer to a license granted to the **Licensee** by the **Licensor** for **exploiting** the **Contractual IP Rights** [and the **Know-How**][for specific **Fields of Use**] in a specific **Contractual Territory**, while no other licensee is entitled to **exploit** the specified **Contractual IP Rights** in the **Contractual Territory**. The **Exclusive License** shall not prevent the **Licensor** from using the **Contractual IP Rights** [and the **Know-How**][the **Contractual Software**] for research and training purposes [and for patient care]; it does not, however, entitle the **Licensor** to itself produce **Contractual Products** in this context. It shall be explicitly clarified that any use for research and training purposes does not comprise commercial research (including, without limitation, contract research for companies, R+D co-operations with companies) and training.

## **Non-Exclusive License:**

A **Non-Exclusive License** shall refer to a license granted to the **Licensee** by the **Licensor** for **exploiting** the **Contractual IP Rights** [and the **Know-How**] [for specific **Fields of Use**] in a specific **Contractual Territory** together with the **Licensor** itself and other licensees.

Zusatzklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

## **Sublicense:**

A **Sublicense** shall be an **Exclusive** or **Non-Exclusive License** granted by the **Licensee** to a further licensee designated by it (sublicensee) for **exploiting** the **Contractual IP Rights** within the scope of the rights granted to the **Licensee** itself.

## **Turnover:**

**Turnover** shall refer to the amount charged by the **Licensee** [and by its sublicensees] to its/the customers for **exploiting** the **Objects of the Agreement**, minus turnover and value added taxes (commissions, discounts, risk premiums, bonuses or annual compensations, payment defaults etc. cannot be deducted, return deliveries of **Objects of the Agreement** to the **Licensee** cannot be charged).

## **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 and 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 influence 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**.**

## **Contractual Software:**

**Contractual Software** shall refer to \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(description, version number) pursuant to the specification in **Annex 1/13.** The **Licensor** has the [right to use] [permission to use] the **Contractual Software.** The **Contractual Software** shall be delivered in computer code on a data storage device; the source code shall not be part of the **Object of the Agreement**.

## **Exploitation/Exploiting:**

**Exploitation/Exploiting** shall refer to using, producing, offering, placing on the market, marketing and offering for sale of the **Objects of the Agreement** and the **Licensed Procedures**.

## **Third Parties:**

**Third Parties** shall refer to all legal and natural persons excluding the **Parties**.

## **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).

# Preamble

## The **Licensor** is the owner of **IP Rights** regarding \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(general description).

## **[Non-Exclusive Licenses] Exclusive Licenses** have already been granted for \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(description regarding which patents/applications for a patent, fields of use, group of clients, areas licenses have already been granted).

# OBJECT AND SCOPE OF THE LICENSE

## The **Licensor** shall grant to the **Licensee**

#### an **Exclusive License** for the **Contractual IP Rights** \_\_\_\_(IP right number) for **Field of Use** \_\_\_\_(Field of Use number) for the **Exploitation** of the **Licensed Procedures** and **Objects of the Agreement** in **Contractual Territory** \_\_\_\_(number).

#### a **Non-Exclusive License** for the **Contractual IP Rights** \_\_\_\_(IP right number) for **Field of Use** \_\_\_\_(Field of Use number) for the **Exploitation** of the **Licensed Procedures** and **Objects of the Agreement** in **Contractual Territory** \_\_\_\_(number).

## [**Field of Use** \_\_\_\_(Field of Use number) shall not be subject to the license.]

# RegistrAtion

## To the extent that this is permissible, the **Licensee** shall be entitled to register, at its own expense, this license in the relevant registers. For this purpose, the **Licensor** shall provide all necessary signatures in the required form.

# Transferability, Sublicenses

## The transfer to or contribution into a company of rights and obligations associated with this license to **Third Parties** shall not be permitted [without the explicit and written consent of the **Licensor**]. [**Affiliated Companies** shall not be considered **Third Parties** in this context.]

## [To the extent that the license is transferred or contributed, the **Licensee** shall continue to be liable for any and all license fees as if it still was the licensee.]

## The **Licensee** shall not be entitled to grant **Sublicenses** [except for sublicenses granted to **Affiliated Companies**] [without the explicit and written consent of the **Licensor**].

Alternative: The **Licensee** shall be entitled to grant **Sublicenses** [to **Affiliated Companies**].

## If **Sublicenses** are granted, the **Licensee** shall ensure in any case that the provisions of this Agreement are not violated, that the obligations under this Agreement are also assigned to the sublicensee and that the sublicensing agreement shall terminate automatically if this Agreement is terminated. The **Licensee** shall be liable for the license fees and for rendering of accounts by the sublicensees.

## The basis of assessment for the license fee to be paid by the **Licensee** shall include the **Turnover** of its sublicensees.

## Alternative: in the case of item-based licenses: The **Objects of the Agreement** produced/placed on the market by the sublicensees in the **Field of Use** \_\_\_\_(Field of Use number) in the **Contractual Territory** \_\_\_\_(number) shall be subject to the license fee to be paid by the **Licensee**.

## Alternative: The license fee amounts to \_\_\_\_% (e.g. 3 (three)) of the **Licensee’s** net income from sublicenses.

# CONFIDENTIALITY OBLIGATION WITH REGARD TO KNOW-HOW

## The **Licensor** shall provide the **Licensee** with **Know-How** [pursuant to **Annex 1./6.**]. The documents [of **Annex 1./6.**] shall be delivered [after receipt of the first payment of license fees] [after all approvals necessary for this Agreement to take effect have been granted] [within \_\_\_\_ (e.g. 3 (three)) weeks] after the Agreement has entered into force.

## Unless there is any explicit written consent by the **Licensor** stating otherwise, the **Licensee** undertakes to treat the **Know-How** with utmost confidentiality and to refrain from using the **Know-How** in any way other than for the performance of this Agreement. The **Licensee** takes any adequate measures in order to keep confidential **Know-How**.

## Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

## Unless there is any explicit written consent by the **Licensor** stating otherwise, the **Licensee** undertakes to treat the **Know-How** with utmost confidentiality, to refrain from disclosing, disseminating or publishing the **Know-How** and to refrain from using **Know-How** in any way other than for the performance of this Agreement.

## The **Licensee** shall ensure that unauthorised **Third Parties**, including, without limitation, suppliers or subcontractors cannot gain any knowledge of the **Know-How**.

## Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

## The **Licensee** that was granted an **Exclusive License** may transfer **Know-How** to **Third Parties** with which it has a contractual relationship (e.g. advisors suppliers, subcontractors, persons with which it has works contracts or contracts to provide services, freelancers and any other persons or companies acting for the **Licensee** in any other way), that have to know the **Know-How** for the purpose of fulfilling their contractual obligations towards the **Licensee**, at the longest, however, for the duration of this Agreement. [Optional addition: The **Licensee** shall immediately inform the **Licensor** in writing on the identity of any **Third Parties** to which the **Know-How** was transferred.]

## If the **Licensee** was granted a **Non-Exclusive License**, any transfer of **Know-How** to a **Third Party** shall require the **Licensor’s** prior written consent, which shall not be unreasonably withheld.

## If **Sublicenses** are granted, the **Licensee** shall ensure that, in each individual case in which **Know-How** is disclosed to **Third Parties**, the **Licensor’s** prior written consent is obtained. The **Licensee** shall guarantee to the **Licensor** that the relevant **Third Parties** will comply with the obligation to maintain confidentiality provided for in this clause in all individual cases. The **Licensee** shall, furthermore, indemnify the **Licensor** and shall hold the **Licensor** harmless for any violation of this confidentiality obligation committed by the relevant **Third Parties** and shall take all measures necessary to stop such violation and prevent any repetition thereof.

## The **Licensee** 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. In the case of employees, the confidentiality obligation shall survive the term of employment.

## Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

## The **Licensee** may disclose **Know-How** to those of its employees who have to know the **Know-How** for the purpose of fulfilling their tasks in connection with this Agreement and shall ensure that its employees comply with this confidentiality obligation, as far as possible even after the termination of their relevant employment relationships. [Optional additional clause if provision is required to be stricter: Upon the **Licensor’s** request, the **Licensee** shall immediately disclose to the **Licensor** the names of all persons who have access to **Know-How**.]

## 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.

## Upon termination of this Agreement, the **Licensee** shall immediately return and/or verifiably destroy any and all documents transmitted.

## Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

## Upon termination of this Agreement, the **Licensee** shall immediately return any and all documents transmitted and/or verifiably destroy any and all copies made as well as its own records about **Know-How** uponthe **Licensor’s** request. The **Licensee’s** [\_\_\_\_ (e.g. legal advisor/legal department)] may retain one single copy of the **Know-How** in the files for evidence purposes; such copy must not be accessible to employees of the **Licensee**.

## Even after the termination of this Agreement, the **Licensee** shall treat the **Know-How** with utmost confidentiality and shall pass on this obligation [in a verifiable written form] to any and all persons to which **Know-How** was transmitted.

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

## Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

## With respect to the scope of the confidentiality obligation, the **Licensee** bears the burden of proof for establishing the fact that the **Know-How** of which it was informed based on this Agreement had already been disclosed or is being disclosed without the **Licensee** being at fault, that it obtained the **Know-How** from a **Third Party** entirely lawfully and without any obligation to maintain confidentiality or that it developed or obtained knowledge of the **Know-How** independently from the **Licensor**.

# TECHNICAL ASSISTANCE AND TRAINING

## If the **Licensor** provides technical assistance or training, the scope and the fees to be paid as well as the reimbursement of expenses shall be determined by **Annex .7/1.**

# WARRANTY AND LIABILITY

## The **Licensor** warrants that it is the unlimited holder of the **Contractual IP Rights** at the time of the Agreement’s entry into force and that it is entitled to grant the license subject to this Agreement [and that it holds the right to use the **Contractual Software**]. Apart from the above, the **Licensor** does not give any warranty as to the legal validity of the **Contractual IP Rights** after the Agreement has entered into force.

## Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

## The **Licensor** guarantees that, at the time of the Agreement’s entry into force, it is the unlimited holder of the **Contractual IP Rights** [, it is the **Licensee** of the **Contractual IP Rights**], [the **Know-How** is subject to corresponding protection] and that it is entitled to grant the license subject to this Agreement [and that it holds the right to use the **Contractual Software**] and that, to the best of its knowledge, there are no pending proceedings concerning violations or nullification of IP rights. Apart from the above, the **Licensor** does not give any warranty as to the legal validity of the **Contractual IP Rights** after the Agreement has entered into force.

## The **Licensor** declares – without being subject to a special obligation to investigate in the course of customary state-of-the-art searches – that according to [the best of] its knowledge, at the time of the Agreement’s entry into force, the production, use and distribution of the [**Objects of the Agreement**] [use of the **Licensed Procedures**](choose alternative) do not and could not breach any third-party IP rights. Apart from the above, the**Licensor** does not give any warranty that the **Contractual IP Rights** do not interfere with any third-party IP rights.

## Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

## The **Licensor** declares that according to [the best of] its knowledge – in the course of customary state-of-the-art searches [in the course of searches in \_\_\_\_\_\_(description of the databases) databases and] on relevant documents, published by \_\_\_\_\_\_(date), laid out in **Annex 8./2.** – at the time of the Agreement’s entry into force, the production, use and distribution of the [**Objects of the Agreement**] [use of the **Licensed Procedures**](choose alternative) do not and could not breach any third-party IP rights and that there are no violations of any third-party IP rights.

## The **Licensor** does not warrant the economic and commercial exploitability, the producibility or the suitability for manufacture of the **Objects of the Agreement** and the applicability of the **Licensed Procedures**.

## Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

## The **Licensor** does not warrant the economic and commercial exploitability, the producibility or the suitability for manufacture of the **Objects of the Agreement** and the applicability of the **Licensed Procedures**, the **Licensor** does, however, warrant the practicability and reproducibility of the invention.

## Any liability on the part of the **Licensor** for slight negligence shall be excluded in any case.

## Further claims or claims other than those stated under Item 8. on the part of the **Licensee** vis‑à‑vis the **Licensor** shall be excluded irrespective of their legal basis.

# LABELLING RIGHTS

## The **Licensee** shall be obliged to attach a label to the **Objects of the Agreement**, which clearly states: “produced under the licence of \_\_\_\_\_\_\_\_\_\_\_”. (add trademark or logo of Licensor).

# Contractual Software

## The **Licensee** acquires the non-exclusive right to use the **Contractual Software** in the **Contractual Territory** \_\_\_\_(number) for the purpose of [producing the **Objects of the Agreement**] [using the **Licensed Procedures**](choose alternative). The **Licensee** shall be entitled to reproduce the **Contractual Software** in order to install it in its in-house network and [on an unlimited number of workstations] [on \_\_\_(number) workstations], to load the **Contractual Software** and to run it.

## It shall only be permitted to manipulate or change the **Contractual Software** in cases mandatorily provided for by the law for the purposes of error fixing or for making it interoperable with other computer programmes. The **Licensor** shall be informed thereof.

## The retranslation of the object code into the source code and/or reverse engineering and decompilation shall generally not be permitted, except in cases in which this is necessary in order to make the programmes interoperable or to ensure error fixing and this is not done by the **Licensor**. Furthermore, § 40e of the Austrian Copyright Law (*Urheberrechtsgesetz, UrhG*) shall apply.

## The **Licensee** shall be entitled to reproduce the **Contractual Software** only to the extent necessary for using the **Contractual Software** in line with its intended use. The **Licensee**, however, has the right to make backup copies of the **Contractual Software**. Backup copies shall be clearly marked as such.

## The **Licensee** shall not be entitled to reproduce the user documentation or any parts thereof or to disclose it to **Third Parties**.

## To the extent that the **Licensee** is entitled to replace hardware, it undertakes to fully and irretrievably remove the **Contractual Software** from the devices replaced.

## The **Licensee** shall keep copies of the **Contractual Software** safe and shall take all necessary precautions in order to prevent them from falling into the hands of **Third Parties**.

# QUALITY, PRODUCT LIABILITY

## The **Licensee** shall produce the **Objects of the Agreement** in a quality which corresponds to the state of the art.

## The **Licensee** shall indemnify the **Licensor** with respect to any and all product liability claims of **Third Parties** regarding the [**Objects of the Agreement**][**Licensed Procedures**](choose alternative). The same shall apply to advertising statements made by the **Licensees** on the [**Objects of the Agreement**][**Licensed Procedures**](choose alternative).

# IMPROVEMENT And new Fields of Use, EXCHANGE OF EXPERIENCE

## The **Parties** shall closely cooperate in constantly improving the [**Objects of the Agreement**][**Licensed Procedures**](choose alternative) for the duration of this Agreement and shall immediately inform one another about any changes, improvements and new **Fields of Use**.

## Alternative:

## [The **Parties** agree on a mutual exchange of **Know-How** in the relevant **Fields of Use**. [For this purpose, each **Party** may, after prior consultation with the other **Party**, send employees to the relevant departments/institutes of the other **Party** on a monthly/quarterly basis in order to exchange information on the status of possible improvements or new **Fields of Use** or other relevant **Know-How**.]

## Zusatzklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

## The services provided by the [**Licensor**][**Licensee**] in connection with the above shall be compensated based on the terms laid down in **Annex 12./1.**

## Changes effected by the **Licensor** shall be made available to the **Licensee** [in return for payment] [free of charge] in order to improve the production of the [**Contractual Products**][**Licensed Procedures**](choose alternative) for the duration of the Agreement.

## The **Licensor** undertakes to inform the **Licensee** about improvements and new**Fields of Use** of the [**Contractual Products**] [**Licensed Procedures**](choose alternative), even if they are not patentable, and to offer them to the **Licensee** for exclusive or non-exclusive use in [**Fields of Use**][**Contractual Territories**](choose alternative) to be defined. If the **Licensee** accepts this offer, all other terms of this Agreement shall be deemed agreed in this respect subject to an appropriate increase in the license fees, unless explicitly agreed otherwise in writing.

## The **Licensee** shall reimburse the Licensor for any inventor’s royalties concerning the **Licensor**.

## The **Licensee** shall grant to the **Licensor** a worldwide, free **Non-Exclusive License** for improvements and new **Fields of Use** it developed regarding the **Contractual IP Rights** for the purposes of research, training [and patient care].

## Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

## The **Licensee** shall grant to the **Licensor** a [worldwide] free **Non-Exclusive License** [limited to the **Contractual Territory**] for improvements and new **Fields of Use** it developed regarding the **Contractual IP Rights** for the purposes of [even commercial][non-commercial](choose alternative) research, training [and patient care] without entitling the **Licensor** to itself produce **Contractual Products** in this context.

# REGISTRATION AND MAINTENANCE OF IP Rights

## The **Licensor** shall be obliged to maintain the **Contractual IP Rights** for the duration of the Agreement.

## Alternative:

## The **Licensor** shall not be obliged to maintain the **Contractual IP Rights** for the duration of the Agreement.

## Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

## The **Licensor** shall not be obliged to maintain the **Contractual IP Rights** for the duration of the Agreement, to the extent that they are irrelevant for the **Object of the Agreement** according to both **Parties**.

## If the**Licensor** decides, at any time during the duration of the Agreement, that it does not wish to further pursue a **Contractual IP Right***,* even if only in certain countries, it shall offer transferring this **Contractual IP Right** to the **Licensee**. To the extent that the **Licensee** wishes to accept the **Contractual IP Right** offered, the **Licensee** shall bear any and all costs associated with the transfer (registration and legal fees, costs arising in connection with the drawing up of the agreement, expenses).

## The costs (registration and legal fees, expenses) for the registration and maintenance of the **Contractual IP Rights** shall be borne by the **Licensor** in the case of **Non-Exclusive Licenses**. To the extent that an IP right is registered based on the **Licensee’s** wish, the **Licensee** shall bear all costs associated with the registration and maintenance.

## The costs (registration and legal fees, expenses) for the registration and maintenance of the **Contractual IP Rights** shall be borne by the **Licensee** in the case of **Exclusive Licenses.** The **Licensee** shall reimburse the **Licensor** for the costs within \_\_\_\_(e.g. 3 (three)) weeks upon issuance of the related invoice.

Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

The costs (registration and legal fees, expenses) for the registration and maintenance of the **Contractual IP Rights** [shall be borne by the [**Licensor**] [**Licensee**] (choose alternative) in the case of **Exclusive Licenses**] [shall be shared between the **Licensor** and the **Licensee** at a ratio of \_\_\_\_\_\_\_(e.g. 1 (one) to 1 (one))]. The **Licensee** shall reimburse the **Licensor** for the costs within \_\_\_(e.g. 3 (three)) weeks upon issuance of the related invoice, to the extent that it agreed to bear such costs and up to the agreed amount.

## To the extent that the **Licensor** grants further **Exclusive Licenses** for other **Fields of Use** of an **IP Right**, the **Licensor** will strive to reach an agreement to the effect that the further exclusive licensees assume part of the costs for the registration and maintenance of the relevant **IP Right**. To the extent that the further exclusive licensees agree to bear part of the costs, the costs to be borne by the other exclusive licensees shall decrease accordingly.

Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

To the extent that the **Licensor** grants further **Exclusive Licenses** for other **Fields of Use** of an **IP Right**, the **Licensor** will strive to reach an agreement to the effect that the further exclusive licensees assume part of the costs for the registration and maintenance of the relevant **IP Right**. To the extent that the further exclusive licensees agree to bear part of the costs, the costs to be borne by the other exclusive licensees shall decrease accordingly. To the extent that the further exclusive licensees do not agree to bear part of the costs, the **Licensor** shall refund a reasonable part to the **Licensee** taking into account the number of further licensees.

# License fee

## The **Licensee** shallpay the following fees to the **Licensor** for granting this license:

#### Option:

#### [a one-time] [annual](choose alternative) flat-rate license fee in the amount of EUR \_\_\_\_ for the costs paid up to this point in connection with the development and registration of the IP rights, for transferring the **Know-How** and for granting the use of the **Contractual Software**, which shall be payable within \_\_\_\_(e.g. 14 (fourteen)) days after the Agreement’s entry into force [after the beginning of each calendar year], the annual flat-rate license fee being payable on a pro rata basis in the first year of the Agreement. This flat-rate license fee shall not be repaid and cannot be offset with other license fees, not even if the Agreement is terminated prematurely, nor if the **Know-How** is disclosed to the public or if the **Contractual IP Rights** are restricted, declared invalid or not granted.]

#### Option:

#### [a minimum license fee depending on the realisation of defined milestones pursuant to **Annex 14./1.** of EUR\_\_\_\_ when milestone 1 is achieved, of EUR\_\_\_\_ when milestone \_\_\_\_(number) is achieved, which shall be payable within \_\_\_\_(e.g. 14 (fourteen)) days from realisation of the relevant milestone and which can [not] be offset with license fees which depend on turnover.]

#### Option:

#### [an annual minimum license fee of EUR\_\_\_\_, which can be offset with license fees which depend on turnover. [The Agreement only enters into force upon payment of the first minimum license fee.] The first minimum license fee shall be payable immediately after the Agreement has entered into force. Further minimum license fees shall be payable at the beginning of each calendar year.]

Alternative: a minimum license fee of EUR\_\_\_\_ for calendar year 1, of EUR\_\_\_\_ for calendar year 2, of EUR\_\_\_\_ for calendar year \_\_\_\_(number), which shall be payable at the beginning of each calendar year and which can be offset with license fees which depend on turnover.

#### Option:

#### [a license fee in the amount of \_\_\_\_(percentage)% of its **Turnover** [and the **Turnover** of its sublicensees] [in the **Contractual Territories** \_\_\_\_(number) in the **Field of Use** \_\_\_\_(number), which shall be payable on the day on which the **Licensee** delivers the **Objects of the Agreement** to its purchasers. It does not matter when payment is received.]

Alternative: a license fee in the amount of EUR\_\_\_\_ per **Object of the Agreement** [produced] [placed on the market] [also by its sublicensees] in the **Field of Use** \_\_\_\_(number) in the **Contractual Territory** \_\_\_\_(number).

## To the extent that the**Licensor** is or shall be obliged to pay VAT on the license fee, the payment to be made by the **Licensee** shall increase by the same amount.

## If the **Licensor** is obliged to pay statutory inventor’s royalties which are not covered by the license fees received, the **Licensee** shall reimburse the **Licensor** for the difference.

# RENDERING ACCOUNT AND PAYMENT

## The **Licensee** shall render an itemised account of the license fees within one month of the end of each \_\_\_\_\_\_\_\_\_\_\_\_\_(period of time, e.g. calendar quarter) and, at the same time, transfer the resulting amount to the **Licensor’s** account. Any and all costs associated with the transfer shall be borne by the**Licensee**. [Any exchange rate risk shall be borne by the **Licensee**.]

## If the **Licensee** defaults on a payment, default interest in the amount of 8% above the respective discount rate of the European Central Bank [of the 3-month EURIBOR rate plus 4% ]shall be charged.

## The **Licensee’s** itemised accounts shall contain any and all information – broken down and clearly presented – relevant for assessing the fees. Upon the **Licensor’s** request, the **Licensor** shall be granted access to the relevant documents.

Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

The **Licensee’s** itemised accounts shall contain any and all information – broken down and clearly presented – relevant for assessing the fees. Upon the **Licensor’s** request, the **Licensor** or its tax adviser/auditor shall be granted access to the relevant documents.

## The itemised accounts shall also refer to license fees generated by sublicensees.

# BOOK-KEEPING DUTIES, AUDIT RIGHTS

## The **Licensee** shall be obliged to keep separate book-keeping records [on the production of the **Objects of the Agreement**] [the use of the **Licensed Procedures**] and the **Exploitation** by sublicensees in order to document the exact number of the **Objects of the Agreement** it produced under this Agreement, the recipients and the delivery dates as well as any other relevant circumstances.

## Once a year, the**Licensor** shall be entitled to have the correctness of the bookkeeping and accounting records checked, at its own expense, by auditors, chartered accountants or tax advisers bound to professional secrecy, who may call in a court-appointed and certified expert for technical matters.

## If incorrectnesses [of more than \_\_\_\_\_\_\_\_(percentage)% to the **Licensor’s** disadvantage] are uncovered, the costs for checking the accounts shall be borne by the **Licensee**.

## If the **Licensee** disagrees with the presented results of the accounts, it shall inform the **Licensor**thereof. If no agreement can be reached within \_\_\_\_(e.g. 15 (fifteen)) workdays after the **Licensee** has expressed its disagreement with the accounts, the accounts shall be checked with binding effect by an Austrian chartered accountant or tax advisor acting as arbitrator’s expert. If the **Parties** fail to agree on the appointment of an arbitrator’s expert within \_\_\_\_(e.g. 5 (five)) workdays after the negotiations on the accounts broke down, the arbitrator’s expert shall be appointed by the President of the Vienna Bar Association (*Rechtsanwaltskammer Wien*) upon the request of one of the **Parties**; this appointment shall be binding for all **Parties***.*

# NULLIFICATION, REFUSAL TO GRANT AND LIMITATION OF AN IP RIGHT

## If a **Contractual IP Right** is not granted, is nullified or limited in part, or if it turns out that it is dependent on an older patent, this shall not influence the license fees to be paid up until the time of notification regarding the refusal to grant or dependence or legal effectiveness of the decision on nullity or limitation; in particular, license fees which have already been paid cannot be reclaimed. Insofar as the **Contractual IP Rights** can be used to the same extent as before despite their nullity, limitation, cancellation or dependence or if the economic value essentially remains the same, the license fees shall not be reduced. If this is not the case, the license fees shall be reduced to a reasonable degree from the time when the nullity, limitation, cancellation or dependence of **Contractual IP Rights** becomes known.

Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

If a **Contractual IP Right** is not granted, is nullified or limited in part, or if it turns out that it is dependent on an older patent and if, at the same time, this constitutes a breach of the provisions on warranty agreed, this shall lead to a [pro rata] repayment of license fees.

## To the extent that any and all **Contractual IP Rights** become invalid while the **Know-How** associated therewith, in the context of a know-how license, or an **IP Right** converted into a utility model is still used and only an extremely limited use is possible or the economic value has decreased substantially, the **Licensee** shall be entitled to demand that the license fees be adjusted to a reasonable extent [by up to \_\_\_(percentage) %].

Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

To the extent that any and all **Contractual IP Rights** become invalid while the **Know-How** associated therewith, in the context of a know-how license, or an **IP Right** converted into a utility model is still used and only an extremely limited use is possible or the economic value has decreased substantially, the **Licensee** shall be entitled to terminate the Agreement [within \_\_\_(\_\_\_\_(e..g.. 5 (five))) [days] [weeks]] [with immediate effect] (choose alternative) or to demand that the license fees be adjusted to a reasonable extent [by up to \_\_\_\_\_\_\_(percentage)%]. If the Agreement is terminated, the confidentiality obligations contained in Item 6. (Confidentiality) shall remain in force in any case and the **Know-How** may not be used in any case, unless the **Know-How** is no longer subject to the confidentiality obligation in accordance with Item 6.8.

# INFRINGEMENTS OF IP RIGHTS

## The **Parties** shall inform one another about any and all infringements of **Contractual IP Rights**. [Both **Parties** are not obliged to take any legal steps against those who infringe **Contractual IP Rights**.]

## If a **Third Party** infringes a **Contractual IP Right**, the **Licensee** shall be entitled [and obliged] to also take legal steps against the acts of infringement at its own expense. The **Licensor**shall grant any required power of attorney to be represented by the **Licensee** in such proceedings. To the extent that the **Licensee** receives payments in the course of such proceedings concerning the infringement of IP rights that do not constitute any reimbursement of costs of the proceedings, [these payments shall also be subject to the assessment basis for the license fee to be paid to the **Licensor**] [the **Licensor** shall receive \_\_\_\_\_\_\_(percentage)% of the payments] (choose alternative).

Option:(mainly in the case of **Non-Exclusive Licenses**):

[If a **Third Party** infringes a **Contractual IP Right**, the **Licensee** shall be entitled [and obliged] to also take legal steps against the acts of infringement at its own expense. To the extent that the **Licensee** receives payments in the course of such proceedings concerning the infringement of IP rights that do not constitute any reimbursement of costs of the proceedings, these payments shall be payable to the **Licensor** and the **Licensee**/the **Licensees** on a pro rata basis based on its/their contributions to the costs of the proceedings and legal representation.]

## If a **Third Party** accuses the **Licensee** of having infringed an IP right as a result of the use of a **Contractual IP Right**, the **Licensee** shall inform the **Licensor** thereof. The costs of such proceedings shall be borne by \_\_\_\_\_\_\_\_\_\_\_\_(the **Licensor**/the **Licensee**) . The **Licensor** can join these proceedings at its own expense.

## If a **Third Party** attacks a **Contractual IP Right**, especially its legal validity, the **Licensor** shall be obliged to defend itself [, to the extent that the**Licensee** bears the costs for the defence].

## Settlements as well as the discontinuation of proceedings shall always require the**Licensor’s** consent.

# Duration

## The Agreement shall enter into force upon being signed by both Parties [on \_\_\_\_\_\_(date)] and once all approvals necessary for its implementation have been obtained [upon payment of the minimum fee]. The Agreement shall terminate on \_\_\_\_\_\_(date) [This Agreement shall terminate either on the date on which the last **Contractual IP Right** expires or becomes invalid or on which the **Know-How** enters the public domain, depending on which event occurs last.]

## The **Licensor** shall be entitled to terminate the Agreement with immediate effect for good cause. Good cause shall include, without limitation,

#### if the **Licensee** fails to comply with the provisions on the **Contractual Territory**, the deadlines for payment and accounting, **Sublicenses** or quality requirements in spite of having received a reminder and having been granted a reasonable grace period of at least 14 (fourteen) days;

#### if checks carried out pursuant to Item 16 show that the accounts rendered by the**Licensee** are incorrect by more than 50 (fifty)% to the **Licensor’s** disadvantage;

## if the Licensee attacks the validity of a **Contractual IP Right**;

#### if the license fees are less than EUR\_\_\_\_ per quarter in two consecutive calendar quarters;

#### if a settlement is concluded contrary to the provisions of Item 17;

#### if a **Third Party** directly or indirectly acquires a majority interest in the **Licensee** (Change of Control).

## The **Licensee** shall be entitled to terminate the Agreement with immediate effect for good cause. Good cause shall include, without limitation,

#### if the **Licensor** violates the provisions on the **Contractual Territory**;

Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

#### if all **Contractual IP Rights** are declared invalid;

#### if it is legally impossible to sell the **Objects of the Agreement** in all **Contractual Territories**.

## Upon termination of the Agreement, the **Licensee** shall discontinue using any and all **Contractual IP Rights**, the **Know-How** and the **Contractual Software**.

Alternativklauselvorschlag Industriepartner / öffentliche Forschungseinrichtungen:

The **Licensee** shall, however, still be entitled to sell the **Objects of the Agreement** within a period of four weeks after the termination of the Agreement.

# data protection

## If – within the ambit of this Agreement – the **Licensor** discloses to the **Licensee** **Personal Data** or the **Licensee** got otherwise knowledge of the **Personal Data** of the **Disclosing Party** and – provided the **Personal Data** are not processed by the **Licensee** as a data processor – these **Personal Data** may exclusively processed in performance of this Agreement and not processed for any other purposes, except as provided by the law. Specifically, these personal data may not be disclosed to third parties nor analysed for own purposes or used for profiling purposes.

## The **Licensee** ensures that **Personal Data** provided by the **Licensor** are only provided to those of his employees who have a need to know them in the performance of this Agreement.

## The **Licensee** establishes its internal organisation in a way that it can ensure compliance with the applicable data protection laws, including but not limited to technical and organisational measures taken to prevent **Personal Data** from misuse or loss. Employees that have access to **Personal Data** must be made subject to a confidentiality obligation that continues to apply after termination of the employment.

## The **Licensee** does not acquire any rights in the personal data disclosed and is obliged to correct, delete and/or restrict as provided by law the processing of personal data. Any retention rights in personal data are prohibited.

# 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

## 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.

## 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.

## 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).

## 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 on the transfer of material as such.

## Any legal fees or similar charges that may be related to this Agreement shall be borne by the **Licensee**. Each **Party** shall bear the costs for its own legal representation.

## 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 **Licensor** \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(name, position, precise address, e-mail, phone)

For the **Licensee** \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_(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./6.** Description of the **Know-How**

**Annex 1/13.** Specification of the **Contractual Software**

**Annex .7/1.** Regulation of fees to be paid for technical assistance and training

**Annex 8./2.** Description of search documents

**Annex 12./1.** Terms for improvement work

**Annex 14./1.** Milestones

# Signatures

For the **Licensor**

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

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

[Name and title/position] [Signature]

For the **Licensee**

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

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

[Name and title/position] [Signature]