

# **JOINT OWNERSHIP AGREEMENT**

(hereinafter referred to as the “**Agreement**”)

## **BETWEEN:**

Fyzikální ústav AV ČR, v. v. i. (hereinafter referred to as “**FZÚ**”), a Public Research Institution established and existing under the laws of the Czech Republic, having its seat at Na Slovance 1999/2, 182 21 Praha 8, Czech Republic, Identification Number 68378271, Tax Identification Number CZ68378271, represented by RNDr. Michael Prouza, Ph.D., Director, registered in the Register of Public Research Institutions administered by the Ministry of Education, Youth and Sport of the Czech Republic,

on the one hand,

## **AND**

Istituto Nazionale di Fisica Nucleare (hereinafter referred to as “**INFN**”), a Public Research Institution established and existing under the laws of Italy, having its seat at via Enrico Fermi 40, 00044 Frascati, Italy, Identification Number 84001850589, represented by Bruno Quarta, Director General, registered in the Register of the Italian Ministry of Education, University and Research (MIUR),

on the other hand,

Individually or collectively hereafter referred to as the “**Party**” or the “**Parties**” respectively;

## **CONSIDERING THAT:**

- FZÚ, INFN and Fondazione Bruno Kessler, having its seat at Via Santa Croce 77, 381 22 Trento, Italy, registered in Commercial Register of Italy (hereinafter referred to as “**FBK**”) , conducted the joint research in the field of hadron therapy and achieved concrete results of the joint research including the invention entitled “**Device and method for imaging and**



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**enhanced proton-therapy treatment using nuclear reactions”** as described in detail in Annex 1 - European patent application number EP16178280 (hereinafter referred to as the **“Invention”**);

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- The Parties have applied and apply their rights to the Invention in accordance with the relevant applicable laws and agreements concluded between them and  
and in the case of FZÚ also in accordance with the Agreement on transfer of the property right to invention and on assignment of the right to file one or more patent or similar industrial property right applications on invention concluded between FZÚ and FBK on the 30<sup>th</sup> of June 2017 (hereinafter referred to as the **“Agreement between FZÚ and FBK”**); The share of Intellectual Property Right of Dr (20 %) has been transferred to INFN by the Agreement signed on the 16 of May 2017;
- The Parties wish to file and subsequently exploit patent(s) or similar industrial property right(s) for the Invention and to share costs and benefits related thereto;

## **IT IS AGREED AS FOLLOWS:**

### **ARTICLE 1 SCOPE OF THE AGREEMENT**

1.1 The Parties are the joint owners of all the intellectual property rights (hereafter referred to as the **“IPRs”**) to the Invention in accordance with the relevant applicable laws and agreements concluded between them and  
and in the case of FZÚ also in accordance with the Agreement between FZÚ and FBK, and all patent or similar industrial property right applications relating to the Invention shall be filed in the name of both Parties. The ownership shares of the Parties to the IPRs to the Invention are as follows:

- a) For FZÚ: 80 % (the ownership share of 60 % on the basis of its applied right to the Invention in accordance with the relevant applicable laws and agreements concluded between FZÚ and  
plus the ownership share of 20 % on the basis of transfer from FBK in accordance with the Agreement between FZÚ and



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FBK);

- b) For INFN: 20 % (the ownership share of 20 % on the basis of its applied right to the Invention in accordance with the relevant applicable laws and agreement concluded between INFN and ).

1.2 Subject to the conditions set out below, INFN herewith appoints FZÚ to act on its behalf with full power to take all steps and transact all business necessary for the protection of the Invention by patent or similar industrial property right.

## **ARTICLE 2 RIGHT TO USE OF THE INVENTION BY THE PARTIES**

The Parties hereby grant each other a royalty-free, non-commercial, perpetual, irrevocable, non-exclusive “sub-licensable” right to use the Invention for internal non-commercial purposes, including but not limited to research, fabrication of industrial equipment for internal use and educational purposes. No Party shall be individually entitled to use the Invention for commercial purposes without prior written agreement by the other Party.

## **ARTICLE 3 COOPERATION OF THE PARTIES**

3.1 FZÚ and INFN shall each be in charge of:

- a) Proposing the strategy to be followed for the protection of the Invention, in particular the patent or similar industrial property right strategy;
- b) Proposing in due course the countries in which the Parties should seek, and subsequently maintain, patents or similar industrial property right protection on the Invention, it being understood that proposals shall be based preferably on an assessment of the commercial potential of the Invention for corresponding markets;
- c) Considering any notification of the patent or similar industrial property right examiners and any action of the European Patent Office or any other national industrial property office or similar authority relating to the patent or similar industrial property right on the Invention, as well as to the patent or similar industrial property right application on the Invention, and agreeing in writing on the proposed response to such notifications or action.



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3.2 FZÚ, as patent or similar industrial property right manager, may make proposals on issues a, b and c above to INFN for discussion. INFN shall communicate having regard in particular to patent or similar industrial property right procedures and the time limits associated therewith.

#### **ARTICLE 4 SHARING OF PATENT OR SIMILAR INDUSTRIAL PROPERTY RIGHT COSTS**

The Parties shall share all costs resulting from the filing of patent or similar industrial property right applications and maintenance of patents or similar industrial property right on the Invention on the basis of 80 % for FZÚ and 20 % for INFN. To this effect FZÚ shall inform INFN on a regular basis of INFN's share of the costs incurred. Upon receipt of such information, INFN will issue an order to FZÚ whereupon FZÚ shall invoice INFN the corresponding share of the costs incurred. Such invoices shall be accompanied by the copies of the original invoices for the costs of filing and maintaining patents or similar industrial property rights and shall, if correct, be paid by INFN within 30 days of their receipt.

#### **ARTICLE 5 PATENT OR SIMILAR INDUSTRIAL PROPERTY RIGHT MAINTENANCE**

5.1 Notwithstanding Articles 1 and 4, each Party shall be entitled to seek and to maintain the patent or similar industrial property right protection on the Invention in any given country despite a lack of consensus of the Parties. In such event, it shall notify the other Party by registered letter and shall be entitled to seek and to maintain the patent or similar industrial property right protection on the Invention in such country in its own name. If such Party can not to seek and to maintain the patent or similar industrial property right protection on the Invention in such country in its own name in accordance with the relevant applicable laws, it shall be entitled to seek and to maintain the patent or similar industrial property right protection on the Invention in such country in both Parties' names but at its sole cost and risk, subject always to Article 2 and in such event and notwithstanding Article 1.2, such Party shall take all steps and measures necessary to seek and to maintain the corresponding patent or similar industrial property right protection on the Invention and the consequences of such action on the conclusion and conditions of licenses covering that country and on the sharing of revenue from such licenses as well as on the right of each Party to take action against infringement of the rights deriving from the patent or similar industrial property right protection on the Invention in such country, shall not be subject to Article 7 and Article 9 and shall be agreed by the Parties on a case by case basis.

5.2 In the event that either Party shall lose its interest in maintaining or seeking joint patent or similar



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industrial property right protection on the Invention in some country, it shall be entitled to assign its share of the jointly owned patent or similar industrial property right on the Invention, as well as the share of the jointly owned patent or similar industrial property right application on the Invention in such country in accordance with the conditions under Article 10 and Article 14 of this Agreement.

## **ARTICLE 6 LICENSES TO THIRD PARTIES**

6.1 In addition to the rights granted under Article 2, each Party shall be individually entitled to grant non-exclusive licenses to third parties for the use of the Invention only with prior written agreement by the other Party.

6.2 In the event that a third party requests a license with exclusivity for the Invention, each Party shall be individually entitled to grant exclusive licenses to third party for the use of the Invention only with prior written agreement by the other Party or the Parties shall agree on the terms of such license and shall both be signatories of agreements granting such license.

## **ARTICLE 7 SHARING OF REVENUE**

7.1 The term “**Net Revenue**” shall mean the revenue from lump sums and royalties received after deduction of uncovered patent or similar industrial property right costs incurred by both FZÚ and INFN. Any Net Revenue derived from agreements concluded by either Party in accordance with Article 6 shall be shared on a basis of 80 % for FZÚ and 20 % for INFN. Where both Parties, FZÚ and INFN, enter an agreement relating to the Invention with a third party, any Net Revenue shall be shared on the basis of 80 % for FZÚ and 20 % for INFN.

7.2 Notwithstanding the foregoing, any costs incurred for the transfer of related know-how by the Parties’ technical groups, including but not limited to training and consultancy, shall be invoiced separately by the Party that bears such cost and shall not be considered within the definition of Net Revenue.

## **ARTICLE 8 WARRANTIES AND LIABILITY**

8.1 All steps taken by FZÚ and INFN in accordance with the present Agreement shall be on a “best



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efforts” basis and FZÚ and INFN do not accept any liability with regard thereto. No Party shall be liable to the other in case the Invention should prove not to be patentable or protectable by similar industrial property right, or in case it does not generate any Net Revenue. Neither Party shall be liable for any direct, indirect, consequential, or other damages suffered by the other Party resulting from its use of the Invention.

8.2 Neither Party shall be liable for any direct, indirect, consequential or other damages suffered by the licensees resulting from their use of the Invention. The Parties shall ensure that all license agreements they conclude with third parties under Article 6 include wording to this effect.

8.3 Each Party shall be solely responsible for the remuneration, as the case may be,  
and shall hold the other Party free and harmless  
against any claim with regard to their rights in connection with the Invention. For the  
avoidance of doubt, FZÚ declares that FBK shall be, in accordance with the Article 2 of the Agreement  
between FZÚ and FBK, solely responsible for the remuneration

## **ARTICLE 9 PATENT OR SIMILAR INDUSTRIAL PROPERTY RIGHT INFRINGEMENT**

In case either Party becomes aware of an infringement by a third party of any IPRs, it shall notify the other Party as soon as reasonably practical. Unless otherwise agreed in writing by the Parties, each Party may independently take action against infringement of the rights deriving from the patent or similar industrial property right on the Invention, however, it shall notify the other Party as soon as reasonably practical.

## **ARTICLE 10 ASSIGNMENT OF RIGHTS/DOCUMENTS**

10.1 No Party shall assign its rights and obligations under this Agreement to any third party without prior written agreement by the other Party. Assignment of any of the jointly owned patent or similar industrial property right on the Invention, as well as of any of the jointly owned patent or similar industrial property right application on the Invention, shall require the written consent of all joint owners. Failing the written consent of the other joint owners, each joint owner may only assign its share of any of the jointly owned patent or similar industrial property right on the Invention, as well as its share of any patent or similar industrial property right application on the Invention, to another joint owner; assignment to a third party may only be effected if none of the joint owners has accepted a written offer of assignment within a



period on two months of its receipt, however, such offer of assignment shall not be higher than that made to a third party. .

10.2 The Parties agree that they shall sign and execute all documents and will take all actions as shall be reasonably necessary or expedient in order to give effect to their respective obligations under this Agreement.

## **ARTICLE 11 PATENT OR SIMILAR INDUSTRIAL PROPERTY RIGHT MANAGEMENT**

In the event that FZÚ is unable or does not want to manage the patent or similar industrial property right portfolio for any reason, the appointment under Article 1 shall lapse, and INFN shall, from that date on, have full power to take all steps and transact all business necessary for filing and maintaining patents or similar industrial property right on the Invention. In such event Article 4 shall apply mutatis mutandis.

## **ARTICLE 12 BREACH OF THE AGREEMENT**

In the event of breach of this Agreement by either Party, the defaulting Party shall, from receipt by that Party of written notification by the other Party detailing the breach and requiring remedial action to be taken, no longer be entitled to conclude agreements relating to the Invention with third parties without the written authorization of the non-defaulting Party, until the breach is remedied.

## **ARTICLE 13 ENTRY INTO FORCE/TERMINATION**

This Agreement shall enter into force upon its signature by the authorized representatives of both Parties and by the publication of this Agreement through the register of the contracts in accordance with the Act No. 340/2015 Coll., on special conditions for the effectiveness of certain contracts, the publication of these contracts and register of the contracts, as amended, and shall terminate upon lapse of the last patent or similar industrial property right on the Invention. Notwithstanding termination of this Agreement, its provisions shall continue to bind the Parties in so far and for as long as may be necessary to give effect to their respective rights and obligations accrued prior to termination. Articles 2, 4, 7, 8, 9, 10, 13 and 14 shall in any event survive termination of this Agreement. Upon termination of this Agreement, the Parties shall no longer conclude agreements for the licensing of IPRs, unless otherwise agreed in writing by the Parties.



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## **ARTICLE 14 GOVERNING LAW/DISPUTE RESOLUTION**

14.1 Unless otherwise provided herein or unless otherwise agreed by the Parties, this Agreement and any and all legal relations arising from this Agreement, as well as areas not explicitly regulated hereby, shall be governed by the laws and regulations of the Czech Republic.

14.2 Any and all disputes arising in connection herewith shall be resolved by the Parties by negotiations. In cases where a dispute cannot be resolved by negotiation, it shall be finally settled under the Rules of Arbitration and Conciliation of the International Arbitral Centre of the Austrian Federal Economic Chamber in Vienna (hereinafter referred to as the “**Vienna Rules**”) by one or three arbitrators appointed in accordance with the said Vienna Rules (hereinafter referred to as the “**Arbitration**”). The venue of the Arbitration shall be Vienna in Austria and the language of the Arbitration shall be English.

## **ARTICLE 15 ENTIRE AGREEMENT/AMENDMENTS**

This Agreement cancels and replaces any previous agreement with regard to the Invention between FZÚ and INFN and constitutes the sole agreement between the Parties. Any amendment to this Agreement shall be made in writing, signed by the authorised representatives of both Parties and, if required by the Act No. 340/2015 Coll. , on special conditions for the effectiveness of certain contracts, the publication of these contracts and register of the contracts, as amended, published through the register of the contracts in accordance with the Act No. 340/2015 Coll., on special conditions for the effectiveness of certain contracts, the publication of these contracts and register of the contracts, as amended . The Parties agree that the FZÚ shall ensure the publication of such amendment through the register of the contracts.

## **ARTICLE 16 SEVERABILITY**

Should any provision hereunder be or become invalid, ineffective, putative or unenforceable, it shall not cause the remainder of provisions hereunder invalid, ineffective, putative or unenforceable. In such a case the Parties undertake to clarify such provision without undue delay pursuant to Section 553 Paragraph 2 of the Act No. 89/2012 Coll., Civil Code, as amended, or to substitute such provision by a new, valid, effective and enforceable provision, whose subject will be best correspond to the subject of the original provision.



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Should this Agreement lack any provision, which would be required or justified to duly define the rights and obligations of the Parties, the Parties undertake to make every effort to add such provision herein without undue delay.

## **ARTICLE 17 CORRESPONDENCE**

All correspondence concerning this Agreement shall bear the reference to this Agreement and shall be addressed to:

- a) For FZÚ: Fyzikální ústav AV ČR, v. v. i., Na Slovance 1999/2, 182 21 Praha 8, Czech Republic
- b) For INFN: Istituto Nazionale di Fisica Nucleare - Servizio Trasferimento Tecnologico- Via Enrico Fermi, 40 00044 Frascati (Rome) Italy

## **ARTICLE 18 PUBLICATION THROUGH THE REGISTER OF THE CONTRACT**

18.1 The Parties expressly agree to publish this Agreement as a whole, including all its annexes and data on the Parties, definition of the subject matter of this Agreement, price or value of the subject matter of this Agreement and the date of its conclusion, through the register of the contracts in accordance with the Act No. 340/2015 Coll., on special conditions for the effectiveness of certain contracts, the publication of these contracts and register of the contracts, as amended.

18.2 The Parties further agree that the FZÚ shall ensure the publication of this Agreement through the register of the contracts.

## **ARTICLE 19 COUNTERPARTS**

This Agreement is drawn up in English language in four counterparts, each having force of original. Each Party, FZÚ and INFN, shall receive two counterparts.



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**ARTICLE 20 ANNEXES**

Annex 1 - European patent application number EP16178280 forms an integral and substantial part of this Agreement.

**On behalf of Fyzikální ústav AV ČR, v. v. i. :**

**On behalf of Istituto Nazionale di Fisica  
Nucleare:**

In ..... On ..... In ..... On .....

.....  
RNDr. Michael Prouza, Ph.D.  
Director

.....  
Dr. Bruno Quarta  
Director General



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