

## Smlouva o vypořádání závazků

uzavřená dle § 1746, odst. 2 zákona č. 89/2012 Sb., občanský zákoník, v platném znění, mezi těmito smluvními stranami:

### *Objednatelem*

Výzkumný ústav veterinárního lékařství, v. v. i.

Hudcova 296/70

621 00 Brno

Česká republika

IC: 00027162, DIČ: CZ00027162

a

### *Dodavatelem*

Mendelova univerzita v Brně

Zemědělská 1665/1

613 00 Brno

Česká republika

IC: 62156489, DIČ: CZ62156489

## **Popis skutkového stavu**

1. Smluvní strany uzavřely dne 3. 12. 2021 smlouvu Joint Ownership Agreement, no. VUVeL 4708/2021, jejímž předmětem byl nákup materiálu/služby: Joint Ownership Agreement.
2. Strana objednatele je povinným subjektem pro zveřejňování v registru smluv dle smlouvy uvedené v ustanovení odst. 1. tohoto článku a má povinnost uzavřenou smlouvu zveřejnit postupem podle zákona č. 340/2015 Sb., zákon o registru smluv, ve znění pozdějších předpisů.
3. Obě smluvní strany shodně konstatují, že do okamžiku sjednání této smlouvy nedošlo k uveřejnění smlouvy uvedené v odst. 1 tohoto článku v registru smluv, a že jsou si vědomy právních následků s tím spojených.
4. V zájmu úpravy vzájemných práv a povinností vyplývajících z původně sjednané smlouvy, s ohledem na skutečnost, že obě strany jednaly s vědomím závaznosti uzavřené smlouvy a v souladu s jejím obsahem plnily, co si vzájemně ujednaly, a ve snaze napravit stav vzniklý v důsledku neuveřejnění smlouvy v registru smluv, sjednávají smluvní strany tuto novou smlouvu ve znění, jak je dále uvedeno.

## **II.**

### **Práva a závazky smluvních stran**

1. Smluvní strany si tímto ujednáním vzájemně stvrzují, že obsah vzájemných práv a povinností, který touto smlouvou nově sjednávají, je zcela a beze zbytku vyjádřen textem původně sjednané

smlouvy<sup>10</sup>, která tvoří pro tyto účely přílohu této smlouvy. Lhůty se rovněž řídí původně sjednanou smlouvou a počítají se od uplynutí 31 dnů od data jejího uzavření.

2. Smluvní strany prohlašují, že veškerá vzájemně poskytnutá plnění na základě původně sjednané smlouvy považují za plnění dle této smlouvy a že v souvislosti se vzájemně poskytnutým plněním nebudou vzájemně vznášet vůči druhé smluvní straně nároky z titulu bezdůvodného obohacení.
3. Smluvní strany prohlašují, že veškerá budoucí plnění z této smlouvy, která mají být od okamžiku jejího uveřejnění v registru smluv plněna v souladu s obsahem vzájemných závazků vyjádřeným v příloze této smlouvy, budou splněna podle sjednaných podmínek.
4. Smluvní strana, která je povinným subjektem pro zveřejňování v registru smluv dle smlouvy uvedené v čl. I. odst. 1 této smlouvy, se tímto zavazuje druhé smluvní straně k neprodlenému zveřejnění této smlouvy a její kompletní přílohy v registru smluv v souladu s ustanovením § 5 zákona o registru smluv.

### **III.**

#### **Závěrečná ustanovení**

1. Tato smlouva o vypořádání závazků nabývá účinnosti dnem uveřejnění v registru smluv.
2. Pokud je smlouva o vypořádání závazků podepisována v listinné podobě, je zpracována ve dvou stejnopisech, každý s hodnotou originálu, přičemž každá ze smluvních stran obdrží jeden stejnopis. Pokud je smlouva podepisována elektronicky, je zpracována v jednom originále.

Příloha č. 1 – Smlouva č. Joint Ownership Agreement, no. VUVeL 4708/2021.

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Za objednatele

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Za dodavatele

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<sup>10</sup> V případě jakýchkoli změn smlouvy na veřejnou zakázku musí být tyto změny v souladu s § 222 zákona č. 134/2016, o zadávání veřejných zakázek, jinak by mohl být postup zadavatele považován za přestupek dle § 268 tohoto zákona.

VUVEL 4708/2021

## JOINT OWNERSHIP AGREEMENT

This Agreement (AGREEMENT) is between **Mendel University in Brno** ("MENDELU"), an institution having a place at Zemědělská 1665/1, 613 00 Brno, Czech Republic, IN 62156489, represented by prof. Ing. Danuše Nerudová, Ph.D., rector

and

**Veterinary Research Institute, Brno** ("VRI"), public research institution registered in the Register of public research institutions, address: Hudcova 296/70, 621 00 Brno, IN 00027162, represented by MVDr. Martin Faldyna, director

(altogether referred to as the "PARTIES")

## RECITALS

[REDACTED]

[REDACTED]

VRI INVENTORS and MENDELU INVENTORS (collectively, JOINT INVENTORS) created the INVENTION; therefore, INVENTION is jointly owned by VRI and MENDELU.

The PARTIES desire to jointly exploit the INVENTION.

NOW, THEREFORE, in consideration of the mutual covenants and premises herein contained, the PARTIES agree as follows:

### 1. EFFECTIVE DATE

This AGREEMENT is effective as of the day of its disclosure in the Register of contracts according to Czech legislation, Act No. 340/2015 Coll. (EFFECTIVE DATE).

### 2. DEFINITIONS

2.1 INVENTION means all discoveries, know-how, information, and inventions in the PATENT APPLICATION created by INVENTORS and further described in attached as Exhibit 1.

2.2 INVENTOR means person, who contribute the ingenuity necessary to create an invention under the patent law.

2.3 JOINT INVENTORS means, however, possible for an invention to be the work of two or more inventors, sometimes referred to as co-inventors.

2.4 LICENSE REVENUE means the transfer of value from third parties to the PARTIES in consideration of granted licenses or other rights to the INVENTION, which may include, but are not limited to actual royalties, fees, payments, equity securities and other sums.

2.5 PATENT EXPENSES means all out-of-pocket expenses, as evidenced by actual invoices that incurred in searching, preparing, filing prosecuting, defending, and maintaining INVENTION.

2.6 PATENT RIGHTS means the PARTIES' respective rights in discoveries, know-how, information and inventions covered in patents and/or patent applications, whether domestic or foreign, which identify JOINT INVENTORS as inventors and which relate to the INVENTION, and any patent application(s) claiming the benefit of priority thereof including all divisions and continuations of these applications, all patents issuing from such applications, divisions and continuations, and any reissues, reexaminations, and extensions of all such patents to the extent that JOINT INVENTORS are named as inventors thereon.

### **3. BACKGROUND INFORMATION**

3.1. The PARTIES have entered into a FRAMEWORK COLLABORATION AGREEMENT to build mutual international collaboration with the Ref. No: VUVeL 2713/2020.

3.2 The PARTIES jointly declare, that within the collaboration under this AGREEMENT the various information, data, documents, materials, technology, know-how or technical information, proprietary tools such as computer programs, algorithms, databases, methods, techniques, processes, technical solutions as well as materials, samples, compounds or ideas, in the same or related domains as the collaboration, which are owned, authorized to use, held under license, or otherwise controlled by the PARTIES prior to this AGREEMENT or which are generated during the course but outside the scope of the collaboration (hereinafter referred to as the "BACKGROUND INFORMATION"), may be used for free by the PARTIES solely for the purpose of collaboration under this AGREEMENT only for the duration of this AGREEMENT and only with the written consent of the PARTY which owns the specific BACKGROUND INFORMATION.

3.3 In connection with the previous par. 3.1 of this Article, the BACKGROUND INFORMATION shall be considered:

- any material used as active ingredient in formulations, including all other excipients, any parts or subunits, descendants, progeny, mutants, mutations or other derivatives thereof, as owned by MENDELU (hereinafter referred to as the "MENDELU MATERIAL");

- any material used for construction of pharmaceutical formulations intended for therapeutic application, including all other excipients, any parts or subunits, descendants, progeny, mutants, mutations or other derivatives thereof, as owned by VRI (hereinafter referred to as the "VRI MATERIAL").

#### **4. WARRANTY: SUPERIOR-RIGHTS**

4.1 As of the Effective Date, the PARTIES, to the best of their knowledge, are under no obligation to anyone, other than JOINT INVENTORS with respect to INVENTION and PATENT RIGHTS.

#### **5. PATENT PROSECUTION AND PROTECTION**

5.1 The PARTIES are the owners of the INVENTION in the following proportions:

- VRI 60%
- MENDELU 40%.

5.2 The PARTIES agreed that the outside counsel for patent filing will be HARBER IP, s.r.o., IN: 06735932, address: Dukelských hrdinů 567/52, Holešovice, 170 00 Praha 7.

5.3 The PARTIES will each use their best efforts to ensure that JOINT INVENTORS fully cooperate in the preparation, filing, prosecution and maintenance of PATENT RIGHTS.

5.4 The PARTIES agreed that VRI would take the lead in filing, management and protection of the JOINT INVENTION. VRI is responsible for preparing the PATENT APPLICATION in cooperation with MENDELU and will provide MENDELU the documents and cooperation necessary for MENDELU to do so. VRI will be responsible for filing, prosecuting, defending, and maintaining PATENT RIGHTS made in the name of both PARTIES according to ownership proportions in par. 5.1 and will consult with and keep MENDELU fully informed of the status of PATENT RIGHTS. VRI will copy MENDELU on all patent related communications, including, but not limited to, patent applications, office actions, and responses.

5.4 The PARTIES each have the right to review and comment upon the wording of specifications, claims, and responses to office actions prior to their submission to the appropriate patent office. PATENT RIGHTS will not be abandoned without the prior written consent of both PARTIES. The PARTIES will be provided with sufficient time to review and comment on any proposed action or filings, but in any event no less than ten working days in advance of filing deadlines unless necessary to prevent a patent discontinuation.

5.5 MENDELU may, upon written notice to the VRI, discontinue the payment of PATENT EXPENSES associated with any particular patent application or patent within any national jurisdiction. In turn, VRI may continue to pay PATENT EXPENSES and in so doing will own all rights, title and interest to that patent application or patent within that given national jurisdiction. MENDELU will have no further rights in and to that particular patent application or patent within that given national jurisdiction and will need to execute relevant assignments necessary to transfer the relevant full title to the VRI. This paragraph applies similarly in the event the VRI discontinues the payment of PATENT EXPENSES.

#### **6. LICENSING**

6.1 The PARTIES agreed that the INVENTION will be commercialized under separate LICENSE AGREEMENT, which will be concluded between the PARTIES and a selected THIRD PARTY. The PARTIES agreed that VRI will take the lead in negotiations in good faith with the selected THIRD PARTY for licensing. The final decision will be recorded in the final LICENSE AGREEMENT between the PARTIES and the THIRD PARTY.

## **7. EXPENSES, PAYMENTS AND REPORTS**

7.1 The PARTIES will pay all expenses with respect to prepare the proposal of PATENT APPLICATION and its filing, as invoiced by HARBER IP Ltd., and PATENT EXPENSES will be paid in proportion to percentage ownership share.

7.2 The PARTIES agreed that the LICENSE REVENUE will be shared and paid in proportion to the percentage ownership share in accordance with the LICENSE AGREEMENT as defined in 6.1.

## **8. TERM AND TERMINATION**

8.1 The term of this AGREEMENT is from the EFFECTIVE DATE until the PATENT RIGHTS expire, or until the last license or sublicense agreement for INVENTION is terminated, pursuant to Section 7.2.

8.2. The PARTIES shall be entitled to terminate the AGREEMENT by unanimous consent. Each PARTY shall be entitled to withdraw from this AGREEMENT in case the other PARTY substantially breaches its obligations under this AGREEMENT despite having been demonstrably notified of such fact and not having remedied such contravention of its obligations.

8.3 Nothing herein will be construed to release either PARTY of any obligation matured prior to the effective date of termination.

## **9. INFRINGEMENT**

9.1 If either PARTY becomes aware of potential infringement of any PATENT RIGHTS, then that PARTY will notify the other PARTY as soon as possible and the PARTIES agree to discuss and determine how best to end such infringement.

## **10. CONFIDENTIAL INFORMATION**

10.1 Each PARTY'S obligation of confidence hereunder will be fulfilled by using at least same degree of care with the other PARTY'S confidential information it uses to protect its own confidential information.

10.2 Notwithstanding the provisions of Section 9.1, the PARTIES will be free to: (i) publish information relating to INVENTION and/or PATENT RIGHTS in scientific journals and (ii) maintain INVENTION and make it available to the nonprofit research community solely for non-commercial research with the prior written consent of the other PARTY.

10.3 Nothing herein will preclude PARTIES from making reports or disclosures as required by any organizations, which provided funding that resulted in the creation of all or a part of INVENTION and/or PATENT RIGHTS or other state institutions.

## **11. GENERAL**

11.1 No agreements altering or supplementing the terms hereof may be made except by a written document signed by both PARTIES.

11.2 The PARTIES note and make it undisputable that according to Czech legislation, Act No. 340/2015 Coll., to have the Agreement become valid and effective, it must be disclosed in the Register of contracts. Therefore, the PARTIES have agreed this Agreement becomes valid on the date of its signature by the Parties and effective as of the day of its disclosure in the Register of contracts pursuant to the previous sentence. VRI shall file this Agreement at the aforementioned Register immediately after the last signature. The PARTIES are obliged to determine and highlight those provisions, which constitute their trade secret and thus will be exempt from the obligation of public disclosure. If a Party does not determine and highlight such provisions, the PARTY responsible for filing the Agreement to the Register shall take no responsibility for any harm or damage incurred.

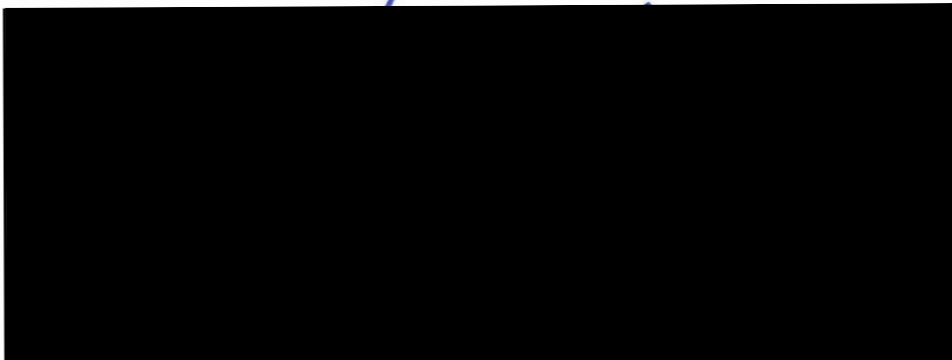
11.3 Any notice required by this AGREEMENT must be given by certified mail, return receipt requested, or by data box addressed to the other PARTY.

11.4 Both PARTIES agree to comply with all applicable national, state and local laws and regulations in connection with their activities pursuant to this AGREEMENT.

11.5 Failure of a PARTY to enforce a right under this AGREEMENT will not act as a waiver of that right or the ability to later assert that right relative to the particular situation involved.

11.6 If any part of this AGREEMENT is for any reason found to be unenforceable, then all other parts nevertheless remain enforceable.

IN WITNESS WHEREOF, the PARTIES hereto have caused their duly authorized representatives to execute this AGREEMENT.



**EXHIBIT 1**

Ginsenosides for treatment of chronic hepatitis B virus infections

