

JOINT PATENT OWNERSHIP RIGHT AGREEMENT

No. _____/2022

entered into on _____ in _____ by and between:

University of Silesia in Katowice - state university within the meaning of the act of 20 July 2018 - The Law on Higher Education and Science (Journal of Laws, item 2022.574) with its seat: 40-007 KATOWICE ul. Bankowa 12; NIP ID tax number: 634-019-71-34, hereinafter referred to as "**The First Coproprietor**", duly represented by:

Vice-Rector for International and Domestic Cooperation - Prof. Tomasz Pietrzykowski

and

University of Ostrava, Dvořákova 7, 701 03 Ostrava, Czech Republic

Data Box ID: 37gj9fm, ID No.: 61988987, VAT No.: CZ61988987

hereinafter referred to as "**The Second Coproprietor**", duly represented by:

Rector - Prof. MUDr. Jan Lata, CSc.

hereinafter jointly referred to as "**Coproprietors**", "**Parties**" or individually as the "**Party**" or "**Coproprietor**".

PREAMBLE

In order to perform tasks within the cooperation of Parties, employees of the Parties carried out research works aiming at developing an invention referred to in §1 section 1 of this Agreement.

With regard to the above, the Parties have decided to regulate the rules of the joint right to obtain a patent, by means of entering into the following agreement:

§ 1.

1. The Parties jointly declare that the right to obtain a legal protection (i.e. patent) for the invention as a result of the co-research activity (hereinafter referred to as: "**Result**") with the working title: „**The method of synthesis 1,3-dioxolanes derivatives based on surface-modified carbon materials**” belongs jointly to the **First Coproprietor** and the **Second Coproprietor**, with shares set forth in § 3 of this agreement.
2. The Parties undertake to jointly file the **Result** for patent protection in the Patent Office of the Republic of Poland and in the Industrial Property Office of the Czech Republic as specified in § 2 and they declare their will to extend the protection of the **Result** beyond the borders of the Republic of Poland and the Czech Republic and in case the Parties decide to extend the protection, the Parties shall jointly agree in writing the territorial scope of this protection and the procedure of applying for it.

3. The researchers involved in the **Result** are: Maciej Kapkowski (creative contribution: 65%), Karolina Wieczorek (5%), Gabriela Zelenkova (18%), Tomas Zelenka (9%), Vaclav Slovak (3%).
4. Researcher Maciej Kapkowski declares that he created the **Result** in the scope of his official duties for **the First Coproprietor**.
5. Researcher Karolina Wieczorek declares that she is transferring the **Result** for use to **the First Coproprietor** along with the transfer of property rights to **the First Coproprietor**.
6. Researchers: Gabriela Zelenkova, Tomas Zelenka, Vaclav Slovak declare that they created the **Result** in the scope of their official duties for **the Second Coproprietor**.

§2.

The Parties jointly declare that the basic tasks:

1. of **the First Coproprietor** include:
 - a. preparation and submission of the complete priority application of the invention co-owned by **the Coproprietors**, with the working title „**The method of synthesis 1,3-dioxolanes derivates based on surface-modified carbon materials**” to the Patent Office of the Republic of Poland (further referred to as: UP RP), and - in case of making a decision to extend the protection - to another patent office chosen by the Parties, appearing in these Offices in this case, including: preparation of replies to decisions, notifications and other correspondence with the Patent Office, notifying the Parties on an ongoing basis about the application proceedings and its final result, and controlling and making timely administrative payments related to obtaining the patent for the invention until the day the final decision is made by the patent office resolving the procedure concerning granting the patent for the invention, and in case of granting the patent, until the end of the patent term of validity.
 - b. co-operation with the **Second Coproprietor** regarding activities related to **Result** protection and receiving the joint exclusive right in the Industrial Ownership Office of the Czech Republic.
 - c. providing the **Second Coproprietor** with a copy of application of the **Result** and priority document issued by UP RP and accompanied by Czech translation by sworn translator.
2. of **the Second Coproprietor** include:
 - a. co-operation with the **First Coproprietor** regarding all activities related to **Result** protection and receiving the joint exclusive right in the Patent Office of the Republic of Poland and, if applicable, in other countries.
 - b. preparation and submission of the complete application of the invention based on priority right from Polish application co-owned by **the Coproprietors**, with the working title „**The method of synthesis 1,3-dioxolanes derivates based on surface-modified carbon**

materials” to the Industrial Ownership Office of the Czech Republic (further referred to as: UPV ČR), appearing in this Office in this case, including: preparation of replies to decisions, notifications and other correspondence with the UPV ČR, notifying the Parties on an ongoing basis about the application proceedings and its final result, and controlling and making timely administrative payments related to obtaining the patent for the invention until the day of the final decision is made by the patent office resolving the procedure concerning granting the patent for the invention, and in case of granting the patent, until the end of patent term of validity.

- c. co-operation with the **First Coproprietor** regarding activities related to **Result** protection and receiving the joint exclusive right in the Industrial Ownership Office of the Czech Republic,
- d. providing the **First Coproprietor** with a copy of application of the **Result** filled at the Industrial Ownership Office of the Czech Republic and accompanied by Polish translation.

§ 3.

The shares of parties in the right to obtain the patent are as follows:

- 1) **the First Coproprietor** - 70%,
- 2) **the Second Coproprietor** - 30%.

§ 4.

1. The costs related to the performance of activities related to the protection of the invention in Poland and administrative charges for the **Result** in the Patent Office of the Republic of Poland will be borne solely by **the First Coproprietor**.
2. The costs related to the performance of activities related to the protection of the invention in Czech Republic and administrative charges for the **Result** in the Industrial Ownership Office of the Czech Republic will be borne solely by **the Second Coproprietor**.
3. The costs related to the performance of activities related to the protection of the invention beyond the borders of Poland and Czech Republic shall be determined by the Parties at the moment the decision about extension of protection and the scope of such protection is made.

§ 5.

The Parties undertake to:

1. jointly cooperate in the performance of tasks aiming at protection and commercialization (particularly by means of industrial implementation) of the **Result**,

2. participate in costs related to tasks aiming at commercialization of the **Result** proportionally to the share set forth in §3 of the Agreement, whereas performing tasks incurring costs must be beforehand accepted by the other Parties of the Agreement.
3. mutual handing over any correspondence, both in traditional and electronic way, related to the **Result** referred to in §1 of the Agreement.

§ 6.

1. The Party which bore the costs of the performance of the task agreed beforehand with other Parties shall issue VAT invoices or debit notes to other Parties for the amounts corresponding to the share of other Parties in the joint right according to § 3.
2. The payment of invoices or notes referred to in section 1 shall take place within 30 days from the moment they are received.
3. The delays in the payment of invoices or notes referred to in section 2 are subject to contractual interest will be charged for each day of delay in the amount of 15% of the value of a given transaction per annum. Interest will be calculated according to the formula: (amount in arrears x number of days of delay x interest rate, i.e. 15%) / 365 days.

§ 7.

1. The purpose of the Parties shall be the industrial implementation of the **Result** or another form of commercialization of the **Result**, whereas all decisions in this regard shall be mutually agreed and require written consent of the Parties.
2. Following the decision of the Parties regarding commercialization of the **Result** by means of granting a license for it, the choice of the licensee and negotiating the license agreement with the licensee shall be made mutually by the **Coproprietors**.
3. The license agreement referred to in section 2 shall be **entered into** with the licensee mutually by **the First Coproprietor and the Second Coproprietor**, however this agreement shall provide that the licensee shall make license fees to the account of **the First Coproprietor**.

§8.

1. The accounting of the benefits, including license fees, resulting from successful commercialization of the **Result** shall be performed by **the First Coproprietor**.
2. The benefits referred to in section 1 shall be divided between the Parties accordingly to their share set forth in § 3 of the Agreement, each Party shall pay their respective researchers of the **Result** the remuneration in the amount pursuant to internal regulations in force at each of the Parties of the Agreement, however each Party shall pay the remuneration of their benefit share only to researchers of the **Result** employed therein.

3. **The First Coproprietor** shall transfer the share of the benefits due to **the Second Coproprietor** within 30 days from the date of receiving VAT invoices or debit notes from **the Second Coproprietor**. The basis for the issuance of invoices or debit notes shall be written information referred to in section 4.
4. The **First Coproprietor** shall notify **the Second Coproprietor** about the amounts received constituting the benefits from the commercialization of the **Result** and their division, within 30 days these amounts are transferred to their bank account.
5. In case **the First Coproprietor** delays with the payment of the remittance referred to in section 3, **the Second Coproprietor** shall be entitled to charge them with contractual interest for each day of delay in the amount of 15% of the value of a given transaction per annum. Interest will be calculated according to the formula: (amount in arrears x number of days of delay x interest rate, i.e. 15%) / 365 days.

§ 9.

In case one of the Parties expresses the wish to dispose of its share in the right to the patent for the invention, the other party has the right of pre-emption within 6 months from the day of the declaration of the wish to dispose of this right by the Party, whereas the Party disposing of the shares is obliged to immediately notify the UP RP or UPV ČR about the purchaser of these shares.

§ 10.

Each Party:

1. undertakes not to make available to third parties, without the written consent of the other Party, any materials or information regarding the **Result**, at least until the moment effective legal protection of the **Result** is ensured.
2. is entitled, without consent of the other Party, to take legal action against anyone who committed a breach to/from the patent to the **Result**.

§ 11.

At the moment the patent for the **Result** is granted by the Polish Patent Office or UPV ČR, this Agreement hereby becomes the joint patent ownership right agreement.

§ 12.

Any amendments or additions to this Agreement shall be made in writing, otherwise shall be null and void.

§13.

Each of the Coproprietors is entitled to terminate this agreement in writing at any time, subject to two months' notice period, which is equivalent to the waiver of all and any rights to the benefit of other **Coproprietors**. The declaration about termination of this Agreement shall be made in writing, otherwise shall be null and void. The party terminating the Agreement is obliged to provide other **Coproprietors** with the files of the **Result** (originals or photocopies certified for compliance with originals).

§14.

1. The entitlements and obligations related to the right to jointly achieved solutions, constituting patentable modification of the invention shall be regulated by the **Coproprietors** in separate agreements.
2. The Agreement shall come to an end on the day the decision of the Patent Office about refusal to grant the patent for the invention or invalidity of the patent becomes final and binding.

§15.

1. The Parties agree that for the purposes of this Agreement the term of **Trade secret** shall include all information owned by the **Coproprietor**, in particular about knowledge, know-how (including patent data), financial, trade, technical, operational, public relations data, as well as tests, analyses, studies and plans concerning University of Ostrava, University of Silesia as well as their students, employees, clients and partners, as well as all other excluding those, which at the moment of disclosing or making available to **Coproprietors** are explicitly defined as information not covered by the Trade secret.
2. The Parties undertake to comply with the regulations of the Act of 16 April 1993 on combating unfair competition (*Journal of Laws 2022, item 1233*) with regard to maintaining the Trade secret of the other Party, and in particular to maintain confidential information included in the Trade secret which was entrusted to them by the other Party or received in connection with the execution of the Agreement, to process the entrusted information exclusively for the purpose in which it was entrusted to them, its protection against unauthorized access or loss and not transferring it and not disclosing such information to any third party without explicit prior consent of the other Party, expressed in writing.
3. The **Coproprietor** shall bear liability for the infringement on the rights of third parties, including for disclosing information received during the execution of the Agreement, only in case of exclusive fault of the **Coproprietor**.

4. The **Coproprietor** undertakes to maintain confidential all information received directly or indirectly during the Agreement and after its termination, unless this information is generally accessible.

§16.

1. Any and all disputes arising between the Parties shall be settled by court and law according to Regulation (EC) No 593/2008 Of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations (Rome I).

§17.

The issues not covered by this Agreement shall be governed as appropriate by:

1. the Act from 30 June 2000 Industrial Property Law,
2. the Act of 23 April 1964 Civil Code,
3. Act No. 89/2012 Coll., Civil Code, as amended,
4. Act No. 121/2000 on Copyright and Rights Related to Copyright and on Amendment to Certain Acts (the Copyright Act), as amended,
5. Act No. 527/1990 Coll., on inventions and rationalisation proposals, as amended.

§18.

The Agreement has been drawn up in two (2) identical copies, one for each Party.

The First

ds.

Universi

Prof. Tomáš Štokovský,
Vice-Rector for International
and Domestic Cooperation

PR
veřejnosti
Krajské

Štokovský
owice

The Second Coproprietor:

University of Ostrava

Prof. MUDr. Jan Lata, CSc.
Rector



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