Dated \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_20[●]

1. [*Full legal name of the RPO*]

and

1. [*Full legal name of the Industry Party*]

MODEL joint ownership and management AGREEMENT

**Joint Ownership and Management AGREEMENT**

**This Agreement** dated \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ 20[●] is between:

1. [●] (the “**RPO**”); [an academic institution incorporated *or* established under [statute *or* charter in Ireland],] whose [principal address *or* registered office] is at [●] and
2. [●] (the “**Industry Party**”), [a company *or* insert relevant entity type incorporated in [•] with registration number [•],] whose [principal place of business *or* registered office] is at [•].

**Background:**

1. The RPO and the Industry Party are engaged in a collaborative research project relating to [*insert description of the subject matter*] and have entered into the Collaborative Research Agreement.
2. The RPO and the Industry Party wish to agree terms for the protection and commercial exploitation of Joint IP.

**The Parties agree** as follows:

## Interpretation

* 1. *Definitions.* In this Agreement (and the background recitals above), unless the context requires otherwise or unless otherwise specified the following words shall have the following meanings:

|  |  |
| --- | --- |
| **Affiliate** | In relation to a Party, means any entity or person that Controls, is Controlled by, or is under common Control with that Party. |
| **Claims** | All demands, claims, suits or proceedings (whether criminal or civil, in contract, tort (including negligence) or otherwise). |
| **Collaborative Research Agreement** | The research agreement dated [⦁] relating to the Project entered into between the RPO and the Industry Party. |
| **Control** | Possession of the power to direct or cause the direction of the management and policies of a person whether by membership, ownership, contract or otherwise. “Controlled”, “Controls” and other cognate words and expressions shall be construed accordingly. |
| **[Exercise Notice** | Written notice from the Industry Party to the RPO that it wishes to exercise the Option.] |
| **[Fees** | The share of the direct costs for the application, prosecution and maintenance of registered intellectual property rights to be paid to the Lead Party by the other Party as set out in Schedule 2.] |
| **Insolvency Event** | The occurrence of any of the following events in respect of a Party: (i) that Party becomes insolvent or unable to pay its debts as and when they become due; (ii) an order is made or a resolution is passed for the winding up of that Party (other than voluntarily for the purpose of solvent amalgamation or reconstruction); (iii) a liquidator, examiner, receiver, receiver manager, or trustee is appointed in respect of the whole or any part of that Party’s assets or business; (iv) that Party makes any composition with its creditors; (v) that Party ceases to continue its business; or (vi) as a result of debt and/or maladministration that Party takes or suffers any similar or analogous action |
| **Joint IP** | All intellectual property (IP) that is jointly owned by the Parties according to the terms of the Collaborative Research Agreement. |
| **Lead Party** | The Party which is nominated to take the lead in filing, management and protection of the Joint IP under Clause 3.1. |
| **Licence** **Field** | [⦁] |
| **Licence Territory** | [⦁] |
| **Loss** | Includes any loss, costs, expense, fee, fine, penalty, judgment, award of damages. |
| **[Negotiation Period** | [90] days from and including the date of the Exercise Notice, being the period within which the parties must negotiate and conclude a licence.] |
| **Notice Party** | A Party in respect of whom notice of termination is issued by the other Party pursuant to Clause 7.2. |
| **[Option** | The option to negotiate a licence to the RPO interest in the Joint IP granted by the RPO to the Industry Party pursuant to Clause 4.4.] |
| **[Option Period** | [90] days from and including the date of formal notification of the creation of the Joint IP in question.] |
| **Parties** | The RPO and the Industry Party, and “**Party**” shall mean either of them. |
| **Project** | The programme of work carried out by the Parties as described in the project plan in the Collaborative Research Agreement. |

* 1. *Construction.* In this Agreement, unless the context requires otherwise:
		1. the headings are used for convenience only and shall not affect its interpretation;
		2. references to persons shall include incorporated and unincorporated persons; references to the singular include the plural and vice versa; and references to either gender include the other and the neuter;
		3. references to Clauses mean clauses of this Agreement;
		4. references in this Agreement to termination shall include termination by expiry;
		5. where the word “including” is used it shall be understood as meaning “including without limitation”;
		6. time shall be construed by reference to time in Ireland;
		7. ‘this Agreement’ mean the Clauses of, and the Schedules to, this Agreement, all of which shall be read as one document; and
		8. ‘business day’ shall be construed as a reference to a day (other than a Saturday or Sunday) on which the banks are generally open for business in Ireland.
	2. If any ambiguity or question of intent or interpretation arises, this Agreement shall be construed as if drafted jointly by the parties and no presumption or burden of proof shall arise favouring or disfavouring any Party by virtue of the authorship of any of the provisions of this Agreement.

## Ownership

The Parties agree that all right and title to, and interest in the Joint IP shall be beneficially owned jointly by the Parties as tenants in common in equal shares. Schedule 1 sets out a list of Joint IP in existence at the date of this Agreement. Any Joint IP created after the date of this Agreement may be added to Schedule 1 by way of an addendum in writing signed by both parties.

## Patent filings and management

**[Start of Alternative A –** *Equal sharing of costs*

* 1. *Lead Party:* The [RPO][Industry Party] (the “**Lead Party**”) shall be responsible for the preparation, filing and prosecution of any applications for patents, designs or other registered rights in respect of the Joint IP, and in which countries of the world such application(s) are to be filed. The Lead Party shall consult with the other Party in good faith regarding the filing, prosecution and maintenance of any such applications or granted rights. This consultation shall be carried out in good time to allow the other Party sufficient time to consider and respond, and for any requests to be delivered to the Lead Party in sufficient time to allow the Lead Party to implement the request. The final decision on the actions to be taken will rest with the Lead Party.
	2. *Costs:*
		1. All direct costs relating to any such applications and granted patents or other registered rights (including filing, prosecution, and renewal fees) shall be borne by the Parties equally.
		2. The Lead Party shall provide the other Party with invoices for the Fees due to the Lead Party in accordance with the payment schedule set out in Schedule 2.
		3. The other Party shall pay all valid invoices in accordance with the provisions of Schedule 2. Interest shall be automatically applied in the event of late payment in accordance with the provisions of Schedule 2.
		4. All amounts stated are to be paid in Euro.
	3. *Step in rights:* If one Party does not wish to continue to bear its share of the costs of filing and maintenance of a patent or other registered right in any jurisdiction or territory or the Lead Party becomes the subject of an Insolvency Event, then the other Party shall have the right to file, maintain, and prosecute such protection at its own expense and shall have full control over such filing, maintenance and prosecution, even though the title to any issuing patent will be joint. The ownership interest of the Party who does not contribute to any such expenses shall remain unaffected.

**End of Alternative A]**

**[Start of Alternative B –** *One Party pays all costs*

* 1. *Lead Party:* The [RPO][Industry Party] (the “**Lead Party**”) shall be responsible for the preparation, filing and prosecution of any applications for patents, designs or other registered rights in respect of the Joint IP, and in which countries of the world such application(s) are to be filed.
	2. *Costs:* The Lead Party shall pay all costs relating to any such applications and granted patents or other registered rights (including filing, prosecution, and renewal fees).
	3. *Step in rights:* If the Lead Party does not wish to continue to bear the costs of filing and maintenance of a patent or other registered right in any jurisdiction or territory or the Lead Party becomes the subject of an Insolvency Event, then the other Party shall have the right to file, maintain, and prosecute such protection at its own expense and shall have full control over such filing, maintenance and prosecution, even though the title to any issuing patent will be joint. The ownership interest of the Lead Party in such rights shall remain unaffected.

**End of Alternative B]**

* 1. *Joint applications:* It is agreed that any such applications shall be registered in the joint names of the RPO and the Industry Party.
	2. *Provision of information:* The Lead Party shall keep all patent notices, applications and correspondence filed in connection with any such applications and shall provide copies of such documents to the other Party on reasonable request.
	3. *Assistance:* Each Party shall give the other Party all assistance reasonably necessary in respect of the filing, prosecution and maintenance of any registered rights in respect of the Joint IP.
	4. *Enforcement:* Each Party shall inform the other Party promptly of any infringement or suspected or threatened infringement of the Joint IP of which it becomes aware, and the Parties shall promptly consult with each other in good faith with a view to reaching agreement on the action to be taken in respect of the infringement in question, with due regard to the terms of any agreements covering the licensing of the Joint IP or any part of it to third parties. If a Party elects not to participate in any litigation action against any third party then that Party shall have no obligation to share the costs related to such actions, but shall also have no rights to share in any recovery.

## Commercial exploitation

* 1. *Exploitation:* Except as provided in this Agreement, each Party shall be entitled to use and to exploit the Joint IP as it sees fit (including for teaching and research, both internally and with third parties), and to grant non-exclusive licences (including the right to sub-licence) to its rights in the Joint IP without obtaining any consent from, paying compensation to, or otherwise accounting to the other Party.
	2. *Retention of exploitation rights in the event of non-payment of costs:* For the avoidance of doubt, any Party which does not contribute to the costs of filing and maintenance of any registered right shall nevertheless retain its rights to own and exploit the Joint IP under Clause 4.1.
	3. *Assignment of Joint IP*:
		1. Except as expressly provided in the remainder of this Clause 4.3, neither Party may assign, mortgage, charge or otherwise transfer any or all of its rights in any Joint IP without the prior written agreement of the other Party.
		2. Each Party shall procure that before it transfers or assigns its share in any Joint IP to any person (other than to the other Party) such person shall enter into an agreement with the other Party substantially in the form of this Agreement.
		3. Subject to its compliance with Clause 4.3(b), each Party may assign ownership of its share of any Joint IP:
			1. to an Affiliate without the prior agreement of the other Party; and
			2. to a third party (not being an Affiliate) provided that it gives the other Party not less than [30] days’ prior notice in writing.
	4. [*Grant of option:* In consideration of the payment of €10 to the RPO by the Industry Party (the receipt and sufficiency of which the RPO acknowledges), the RPO grants to the Industry Party an exclusive option during the Option Period to elect to negotiate an exclusive licence in the Licence Field in the Licence Territory to the RPO interest in the Joint IP. Any such licence shall:
		1. be on fair and reasonable commercial terms;and
		2. be concluded by way of a separate licence.
	5. *Procedure for the exercise of Options:*
		1. If the Industry Party wishes to exercise an Option, it shall give an Exercise Notice to the RPO prior to the expiry of the Option Period. No Option may be exercised more than once in respect of the same IP.
		2. Upon receipt of an Exercise Notice, the Parties acting reasonably shall promptly enter into negotiations in good faith with a view to the conclusion of a licence agreement in respect of the RPO interest in the Joint IP during the Negotiation Period.
		3. If the Industry Party does not exercise its Option during the applicable Option Period or the Parties are unable to agree the terms of a licence agreement within the Negotiation Period that Option shall lapse.]
	6. *Research use:* Notwithstanding the grant of any licence to the RPO’s interest in any Joint IP pursuant to this Clause 4, the RPO shall have a non-exclusive, irrevocable, perpetual, royalty-free right to use that Joint IP for internal teaching and research.

## Indemnity

Each Party (the “**Indemnifying** **Party**”) shall indemnify and keep indemnified the other Party on demand from and against any and all Losses arising out of or in connection with any third party Claims in relation to any use or exploitation of any Joint IP by any of the Indemnifying Party or its licensees.

## Duration

This Agreement shall, subject to early termination in accordance with Clause 7, continue in full force and effect in respect of each item of Joint IP from the date of signature until the later of:

* + 1. in the case of any registered IP right granted in respect of any Joint IP, the expiry of that registered right; or
		2. [10] years from and including the date of signature of this Agreement by both parties.

## Termination

* 1. *Cessation of ownership*. This Agreement shall automatically cease to bind the Parties in respect of any item of Joint IP upon either Party ceasing to hold any legal ownership interest in that Joint IP in accordance with this Agreement.
	2. *Early termination.* Without prejudice to any other rights or remedies, a Party may terminate this Agreement, at any time, on written notice to the Notice Party if the Notice Party is in material breach of its obligations under this Agreement and, where the breach is capable of remedy within thirty (30) days, the Notice Party has not remedied the breach within thirty (30) days of receiving written notice which specifies the breach and requires the breach to be remedied.
	3. *Survival of obligations.* On termination or expiration of this Agreement for any reason, all rights and duties of the Parties with regard to each other shall cease except for rights and remedies which may have accrued prior to termination or expiration and any rights and/or obligations which expressly or by implication are intended to commence, survive or continue in effect on or after termination or expiration.

## Dispute Resolution

* 1. *Internal escalation.* The Parties shall make every reasonable effort to resolve all issues fairly by negotiation.All disputes which arise between the Parties in connection with this Agreement shall be discussed initially between the project managers for the Project. If the dispute remains it shall be referred to [•] in the case of the RPO, and to [•] in the case of the Industry Party in an attempt to resolve the issue in good faith.
	2. *Mediation.* In the event that the dispute has not been settled within sixty (60) days, it shall be submitted for mediation by a mediator or other appropriate independent third party expert agreed by the Parties or, in default of agreement, appointed by the Centre for Dispute Resolution in Dublin. The cost of any such mediator or expert shall be borne equally by the Parties.
	3. *Injunctive relief*. For the avoidance of doubt, however, nothing in this Clause 8 shall prevent or delay a Party from applying to a court of competent jurisdiction for the purposes of seeking injunctive relief provided that there is no delay in the prosecution of that application.

## General

* 1. *Amendments.* This Agreement may only be amended in writing signed by duly authorised representatives of the Parties.
	2. *Independent contractors.* The relationship of the RPO to the Industry Party shall be that of independent contractor. This Agreement is not intended to, and does not, create any contract of employment or other legal relationship between the Parties.
	3. *Entire agreement.* This Agreement and the Collaborative Research Agreement set out the entire agreement between the Parties relating to the ownership, use, protection of and rights of the Parties in the Joint IP and supersedes all prior oral or written agreements, arrangements or understandings between them relating to such subject matter. This Agreement and the Collaborative Research Agreement shall be construed as being mutually explanatory of one another; however, in the event of a conflict, the terms of this Agreement shall prevail.
	4. *Notices.* All notices given by either Party to the other pursuant to this Agreement shall be in writing and may be delivered by pre-paid post, registered courier or by hand to:

|  |  |  |
| --- | --- | --- |
|  | Industry Party Contact: | RPO Contact: |
| Name | [●] | [●] |
| Title | [●] | [●] |
| Address | [●] | [●] |

Any such notice, if so given, shall be deemed to have been served:

* + 1. if sent by hand, when delivered;
		2. if sent by post or courier, one business day after posting.
	1. *Further action.* Each Party agrees to execute, acknowledge and deliver such further instruments, and do all further similar acts, as may be necessary or appropriate to carry out the purposes and intent of this Agreement.
	2. *Severability*. If the whole or any part of a provision of this Agreement is or becomes illegal, invalid or unenforceable under the law of any jurisdiction, that shall not affect the legality, validity or enforceability under the law of that jurisdiction of the remainder of the provision in question or any other provision of this Agreement and the legality, validity or enforceability under the law of any other jurisdiction of that or any other provision of this Agreement.
	3. *Costs*. Each Party shall pay its own costs in connection with or incidental to the preparation, negotiation and execution of this Agreement.
	4. *Counterparts* *and Signatures.* This Agreement may be executed in counterparts all of which taken together shall constitute one single agreement between the Parties. Transmission of an executed counterpart of this Agreement by fax or e-mail (in PDF, JPEG or other agreed format) shall take effect as delivery of an executed counterpart of this Agreement. If either method of delivery is adopted, without prejudice to the validity of the agreement thus made, each Party shall provide the others with the original of such counterpart as soon as reasonably possible thereafter.
	5. *Announcements.* Neither Party shall make any press or other public announcement concerning any aspect of this Agreement, or make any use of the name of the other Party in connection with or in consequence of this Agreement, without the prior written consent of the other Party.
	6. *Law and jurisdiction.* This Agreement and any non-contractual obligations arising out of or in connection with this Agreement shall be governed by and construed in accordance with the laws of Ireland and each Party agrees to submit to the exclusive jurisdiction of the courts of Ireland.
	7. *Binding on Successors*. This Agreement and all of its provisions shall be binding upon and inure to the benefit of the Parties and their respective heirs, executors, administrators, successors and permitted assigns.
	8. *Assignment*. Save as expressly provided in this Agreement, neither Party may assign, mortgage, charge or otherwise transfer any or all of its rights and obligations under this Agreement without the prior written agreement of the other Party save that a Party may assign or transfers its rights and obligations under this Agreement to an Affiliate.

**Agreed by the parties through their authorised signatories:**

|  |  |
| --- | --- |
| **SIGNED** For and on behalf of | **SIGNED** For and on behalf of |
| *[Insert full legal name of the RPO]* | *[Insert full legal name of the Industry Party]* |
| \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_Signed | \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_Signed |
|  |  |
| \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_Name | \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_Name |
|  |  |
| \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_Title | \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_Title |
| \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_Date | \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_Date |
|  |  |

# Schedule 1

**Joint IP**

The Collaborative Research Agreement will have described the type of intellectual property that may be jointly owned if it is generated jointly between both Parties during the Project. This schedule should reflect that agreement, and list the specific items of IP that are covered by this JOMA.

[*List each specific item of Joint IP that has been generated during the project and is to be covered by the JOMA*]

# Schedule 2

**Payment Schedule**

|  |  |
| --- | --- |
| **Invoicing** | The Lead Party shall issue an invoice to the other Party for 50% of any direct costs relating to any applications for patents, designs or other registered rights and granted patents or other registered rights (including filing, prosecution, and renewal fees). Such invoices shall only be issued after the costs have been incurred by the Lead Party. |
| **RPO’s contact details for invoices** | [●] |
| **Industry Party’s contact details for invoices** | [●] |
| **Payment Terms** | [30] days net. Payment shall be [by way of bank transfer.] |
| **Interest on Late Payment** | Interest shall be automatically applied if payment has not been received within [forty five (45)] days of receipt of a valid invoice. Interest shall be calculated on a daily basis using an interest rate equal to the European Central Bank main refinancing rate (as at 1 January and 1 July in each year) plus [8] percentage points. |
| **Payment details for Lead Party** | **Bank account name:** [●]**Bank account number:** [●]**Bank sort code:** [●]**Reference:** [●] |
| **Industry VAT Number** | [●] |
| **RPO VAT Number** | [●] |

# Annex 1

**Alternative Definitions for insertion in Clause 1.1 where Joint IP is not provided for in the Collaborative Research Agreement**

|  |  |
| --- | --- |
| Joint IP | Any patentable invention or copyright generated by the Personnel of both the RPO Party and the Industry Party during the course of the Project. A person shall be taken to participate in the generation of: (i) a patentable invention, only if he is considered the, or an, inventor of that invention under Irish patent law as it stands on the date on which the invention is made; and (ii) copyright, only if he is the, or an, author of the work in question for the purposes of Irish copyright law as it stands on the date on which the work is generated, and the term 'generated' includes a reference to the expressions 'discovered', 'conceived', 'first reduced to practice', 'created', and 'developed', and terms cognate with the term 'generated' shall be understood accordingly. |
| Personnel | The officers, directors, employees, contractors, researchers of registered students of a Party and those of its Affiliates. |