

INTELLECTUAL PROPERTY RIGHTS

A. PRINCIPLES

The primary goal of the SfP Programme is to help Partner countries develop their industrial capabilities, while building a stronger science infrastructure in Partner countries.

The programme aims to assist Partner countries in their transition to a market-oriented, environmentally sound economy.

The expectation is to achieve a reasonable share of benefits among the Parties (= all participants: institutions, companies and scientists) in SfP Projects from both Partner and NATO countries, taking into account their respective contributions and their initial know-how.

The Steering Group will make every effort to ensure that the interests of the Partner countries and the individual scientists are protected.

The Steering Group will determine whether or not individual projects meet the objectives of the SfP Programme. The Steering Group will make this determination based on a project plan that must include a draft Intellectual Property Rights (IPR) agreement based on the Principles and Guidelines provided by NATO.

Taking into account recommendations by the SfP Steering Group on the draft IPR agreement, a final IPR Agreement shall be prepared and signed by all Parties. Funding of the Project will only be provided after the IPR agreement is signed by all Parties.

The IPR agreement may be re-evaluated during the project due to unforeseen circumstances, on the request of any of the Parties, to ensure that the benefit-sharing terms remain reasonable to all Parties. If necessary, this process may be mediated by NATO.

B. SAMPLE CONTENT OF IPR AGREEMENT AMONG PARTIES

INTRODUCTION

1. INTELLECTUAL PROPERTY RIGHTS
 - 1.1. Definitions
 - 1.2. Ownership and Access Rights
2. EXPLOITATION
 - 2.1. Foreground Intellectual Property
 - 2.2. Background Intellectual Property
3. INTELLECTUAL PROPERTY PROSECUTION AND ENFORCEMENT
4. INFRINGEMENT OF THIRD PARTY INTELLECTUAL PROPERTY
5. CONFIDENTIALITY
6. BREACH OF AGREEMENT
7. MEDIATION AND ARBITRATION
8. LAW
9. DECISIONS ON MAJOR ISSUES
10. GENERAL

EXAMPLE OF AN INTELLECTUAL PROPERTY RIGHTS AGREEMENT

PROJECT: (Project Title)

SfP PROJECT NUMBER: (Project number)

THIS AGREEMENT is made the _____ day of _____

BETWEEN

A (Name, Address and Nationality of the Institutions or Companies)

And

B (Name, Address and Nationality of the Institutions or Companies)

And

.....(Name, Address and Nationality of the Institutions or Companies

"A" hereinafter to be called ____, "B" hereinafter to be called ____, [....etc.] and collectively to be called the "Parties" for the purpose of the Agreement only. Any statutory or other implication from the use of the term "Party" is hereby expressly excluded.

WHEREAS

- (a) The Parties have expertise in the field of _____ and wish to undertake joint research and exploitation of results in this field.
- (b) This project will benefit from financial support through NATO's Science for Peace Programme.
- (c) NATO wishes the results of the research undertaken to be applied to the benefit of the Parties, and waives any claim to ownership of Intellectual Property Rights deriving from such research as well as any income resulting from the exploitation of said Intellectual Property Rights.

IT IS AGREED as follows:

1. INTELLECTUAL PROPERTY RIGHTS

1.1 Definitions

The following definitions apply in this Agreement:

"Intellectual Property" includes inventions (whether patentable or not), patents, patent applications, registered designs and applications thereof, copyright material including computer software, technical information and know-how.

"Foreground Intellectual Property" includes Intellectual Property arising from the research and development undertaken within this project after the date of signature of this agreement whether generated by one Party or two or more Parties jointly.

"Background Intellectual Property" includes Intellectual Property deemed to be relevant to the project and already owned by one or more of the Parties on the date of signature of this agreement.

"Project Completion Date" shall mean the date of completion of the research and development activities under this project as defined and determined by the NATO Programme Office.

1.2 Ownership and Access Rights

1.2.1. Foreground Intellectual Property shall be owned

Option A

Jointly by all the Parties regardless of who generated the Intellectual Property or engaged or employed the person or persons who made or conceived the Intellectual Property.

Or

Option B

(a) Solely by the Party who generated the Intellectual Property or engaged or employed the person or persons who made or conceived the Intellectual Property, and,

(b) Jointly by the Parties who generated the Intellectual Property or engaged or employed the person or persons who made or conceived the Intellectual Property.

1.2.2. Background Intellectual Property shall to the extent legally possible, be made freely available to all the Parties solely for the purpose and for the duration of the research and development activities of the project.

1.2.3 Participation in this project shall not itself affect any rights of any Party to Foreground Intellectual Property or Background Intellectual Property except as specifically mentioned herein.

2. EXPLOITATION

2.1 Foreground Intellectual Property

Option A in accordance with 1.2.1

All Parties shall have free use of all Foreground Intellectual Property to exploit the results by themselves.

Each Party can grant sub-licences, subject to prior approval by all Parties.

Option B in accordance with 1.2.1

The Party or Parties shall, on request, grant the other(s) a license on fair and reasonable terms, to use any Foreground Intellectual Property that is required for the exploitation of the results.

2.2 Background Intellectual Property

Each Party shall, on request, grant the other(s) a license on fair and reasonable terms, to use any Background Intellectual Property that is required for the exploitation of the Foreground Intellectual Property.

2.3 In the event that neither Party wishes to exploit the Foreground Intellectual Property, they shall not refuse to grant licences to requesting 3rd parties on fair and reasonable terms. Licensing to non-EAPC countries shall be subject to NATO approval.

2.4 In the event that none of the Parties provides proof or evidence of diligent efforts to exploit the Foreground Intellectual Property to the NATO Programme Office within a period of 3 years after the Project Completion Date, they shall not refuse to grant licences to requesting 3rd parties on fair and reasonable terms. Licensing to non-EAPC countries shall be subject to NATO approval.

3. INTELLECTUAL PROPERTY PROSECUTION AND ENFORCEMENT

- 3.1 Decisions on the protection, filing and prosecution of Foreground Intellectual Property shall be taken by the Parties.
- 3.2 Any Party shall immediately inform the other Party(ies) of any potential infringement of the Foreground Intellectual Property of which it becomes aware. The owner(s) of the Foreground Intellectual Property shall decide on any enforcement action and inform the other Party(ie)s.
- 3.3 In principle, each Party shall meet the costs of protecting its own Intellectual Property, its prosecution and enforcement. The cost sharing of joint Intellectual Property prosecution and enforcement shall be agreed by the Parties involved.

4. INFRINGEMENT OF THIRD PARTY INTELLECTUAL PROPERTY

Any Party shall immediately inform the other Party(ies) of any evidence of infringement of a Third party Intellectual Property. The Party(ies) shall inform the NATO Science for Peace Programme Office immediately when evidence of the potential infringement of Third party Intellectual Property is discovered. The Party(ies) will propose to the NATO Science for Peace Programme Office potential solutions in order to try to avoid conflict with such third party.

5. CONFIDENTIALITY

- 5.1 Each Party undertakes to keep confidential and shall not use except for the purposes of this Agreement or permitted by this Agreement:
 - (a) All information concerning the project;
 - (b) All information concerning the project it shall have obtained from any other Party(ies);
 - (c) All information concerning the business affairs of any other Party;
 - (d) The Foreground Intellectual Property of the research and development, except as required by applicable Intellectual Property prosecution procedures or under the publication provisions herein
 - (e) Any information disclosed by a Party designated as "Confidential" at the time of disclosure. This may include information on Background IP.
- 5.2 The foregoing restrictions shall not apply to information:
 - (a) Accessible to the public at the time of disclosure, or which subsequently becomes accessible through no fault of the recipient;
 - (b) In the possession of the recipient at the time of disclosure, or is received by the recipient from a third party who is not under any obligation to keep such information confidential;
 - (c) Which must be provided to or required for disclosure by national or NATO authorities.
- 5.3 Divulgence (including publication) of Foreground Intellectual Property shall only be undertaken with the agreement of the Parties. This agreement shall not be unreasonably withheld. Parties will have a period of three months to present their objection to divulgation. Thereafter, in the absence of any objection the Parties wishing to divulge may proceed. If a Party has been refused permission to publish, that Party shall be permitted to publish, without agreement of the other Parties, after one year from a request to publish.

6. BREACH OF AGREEMENT

- 6.1 If one Party breaches this Agreement and the breach is not cured within 30 days of notice of the breach from the non breaching Party(ies), the non breaching Party(ies) may terminate the rights of the breaching Party under this Agreement.
- 6.2 Upon termination pursuant to 6.1:
- (a) The non-breaching Party(ies) shall be free to exploit the Foreground Intellectual Property; and,
 - (b) Right(s) to exploit the Background Intellectual Property of the breaching Party will be granted by the breaching Party to the non-breaching Party(ies) according to 2.2.1, taking into consideration prior commitments.

7. MEDIATION AND ARBITRATION

- 7.1 Any of the Parties may initiate a mediation to assist them in resolving any issue arising from this Agreement which has not been resolved by the Parties; this mediation shall be done by a mediator nominated by the Assistant Secretary General for Scientific and Environmental Affairs.
- 7.2. If the mediation is not successful in resolving the issue, any Party may initiate an arbitration procedure as follows:
(WIPO, ICC, or other arbitration procedures to be agreed and detailed by the Parties)
- 7.3. The decision resulting from the arbitration procedure shall be binding upon the Parties.

8. LAW

This Agreement shall be governed by the laws of ___ (only one country possible!).

9. DECISIONS ON MAJOR ISSUES

- 9.1 Decisions on the following regarding the protection of Foreground Intellectual Property require unanimity of the Parties. In case of non-unanimity the mediation procedure of Article 7.1 may be initiated by any of the Parties.
- (a) Decisions upon the divulgation (including publication) of any information resulting from the project;
 - (b) Decisions upon actions to be taken, including settlements, in the event of infringement of the Foreground Intellectual Property;
 - (c) Decisions upon actions to be taken, including settlements, in the event of infringement of third party rights;
 - (d) Monitoring and decisions with respect to all Intellectual Property aspects of the project.
- 9.2 The Parties shall report on Intellectual Property issues to the NATO Programme Office.

10. GENERAL

- 10.1 Each Party undertakes to the others to take all steps that are necessary to ensure compliance with the provisions of this Agreement by its employees, agents and researchers.
- 10.2 The terms of Article 2, Article 3, Article 5 and Article 9 will survive after the Project Completion Date or the withdrawal of any Party(ies), except upon agreement by all Parties.
- 10.3 The notices referred to in this Agreement shall be considered to be effective only if communicated in writing by registered mail, or an equivalent system.

Signatures (with date) of the NPD, the PPD and all other Project-Co-Directors as well as the head of their institutions (or the person responsible for IPR matters) and the end-user(s) involved in the project.

Name and position:

Signature:

date:

NPD

Head of institution

PPD

Head of institution

Other Co-Directors

And the heads of their institutions

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End-user 1 (Director)

End-user 2 (Director)