

**Intellectual Property Agreement Relating to IRCSET /
Enterprise Partner Enterprise Partnership Scheme
Postgraduate Scholarship**

Between

Research Body Name

&

Enterprise Partner Name

This Agreement is made and entered into between:

Enterprise Partner full legal name and address

and

Research Body full legal name and address

individually a “Party” or collectively the “Parties”

WHEREAS The Irish Research Council for Science, Engineering and Technology, ENTERPRISE PARTNER NAME, the Research Body, the Scholar and the Academic Supervisor are entering into an agreement (“the Head Agreement) for the Terms and Conditions for the conduct of an Enterprise Partnership Scheme Postgraduate Scholarship by the Scholar at the Research Body;

and

WHEREAS ENTERPRISE PARTNER NAME and the Research Body wish to agree the terms for ownership and management of intellectual property arising from the Enterprise Partnership Scheme Postgraduate Scholarship (“the Scholarship”) in this Appendix to the Head Agreement;

In consideration of the agreement of the Enterprise Partner’s contribution towards the scholarship and for other good and valuable consideration, the receipt and sufficiency of which is acknowledged, IT IS HEREBY AGREED as follows:

1. Definitions:

- 1.1 “Enterprise Partner” shall mean ENTERPRISE PARTNER NAME.
- 1.2 “Field” shall mean [*FIELD OF USE AND/OR APPLICATION TO BE AGREED ON A CASE-BY-CASE BASIS*].
- 1.3 “Scholar” shall mean SCHOLAR’S NAME.
- 1.4 “The Scholarship” shall mean *the IRCSET / ENTERPRISE PARTNER NAME Enterprise Partnership Scheme Postgraduate Scholarship*.
- 1.5 “The Head Agreement” shall mean the Scholarship Terms and Conditions.
- 1.6 “Background Intellectual Property” shall mean Intellectual Property owned by or licensed to a Party prior to the date of this agreement or developed by a Party outside of the scope of this Agreement.
- 1.7 “Foreground Intellectual Property”, shall mean Intellectual Property created by a Party in the course of the Project and all rights therein.
- 1.8 “Intellectual Property” shall mean inventions, designs, specifications, information, techniques, know-how, patents, formulae, data, methods, processes, copyright, trademarks, software, materials, moral rights, database rights, confidential information or any other intellectual or industrial property right of any nature whatsoever in any part of the world (including the right to apply for the foregoing).
- 1.9 “Project”, shall mean the work described in the Schedule to the Head Agreement, and as amended from time to time subject to the prior written agreement of IRCSET, the Research Body and ENTERPRISE PARTNER NAME.
- 1.10 “Confidential Information” shall mean, in relation to a Party, all information (in whatever form communicated or recorded) belonging or relating to that Party which is disclosed to another Party or to which that other Party has access, and which (a) is expressly marked as confidential or proprietary, or (b) has been described as confidential by the Party in writing to the other Party within thirty days of

disclosure. The Parties agree that Foreground Intellectual Property constitutes Confidential Information of the Research Body.

1.11 “jointly-created” shall mean:

- (a) in respect of patentable Foreground Intellectual Property, an Irish patent agent would, following the provisions of Irish patent law, conclude that there is more than one inventor of those Foreground Intellectual Property, and that each of the Enterprise Partner and the Research Body employ (or otherwise engage) at least one of those inventors;
- (b) in respect of any copyright work, following Irish copyright law, the work was produced by the collaboration of two or more authors in which the contribution of each author is not distinct from that of the other author or authors, and that each of the Enterprise Partner and the Research Body employ (or otherwise engage) at least one these authors; and
- (c) in respect all other aspects of the Foreground Intellectual Property, the Foreground Intellectual Property has been created by the joint efforts of the Parties and no aspects of that Foreground Intellectual Property are severable or separable from each other;

2. Review of Progress:

- 2.1 The Scholar shall submit a written progress report to the The Enterprise Partner before 30 May in each academic year following commencement of the Scholarship as set out in the Head Agreement. ***[UNLESS ADDITIONAL ENTERPRISE PARTNER REPORTING REQUIREMENTS ARE AGREED]***

3. Responsibilities of the The Enterprise Partner

- 3.1 The Enterprise Partner will contribute one third of the total Scholarship amount as set out in Schedule to the Head Agreement.
- 3.2 The Enterprise Partner will appoint a research mentor to work with the Scholar and the academic supervisor as set out in the Head Agreement.
- 3.3 Where feasible the Enterprise Partner is encouraged to provide a placement period for the research Scholar at its facilities as part of this Scholarship. This will be agreed with IRCSET and the academic supervisor before the Scholarship commences.
- 3.4 The Enterprise Partner is encouraged to cover the cost of all expenses (e.g. travel and accommodation costs incurred by the scholar as a result of periods spent on placement with the Enterprise Partner. The scholar should not be out of pocket due to undertaking the placement.

4. Confidentiality

- 4.1 Each Party (a “Receiving Party”) shall treat as confidential any Confidential Information disclosed or made available to it by the other (the “Disclosing party”).
- 4.2 Each Receiving Party undertakes to disclose the other’s Confidential Information only to those of its officers, employees, agents and students to whom and to the extent to which such disclosure is necessary for the purpose of carrying out the Project, and provided said individuals have been made aware of the confidentiality obligations in this Clause.4.
- 4.3 Clauses 4.1 and 4.2 shall not apply to any information that:
 - is or becomes publicly known without any breach of this Agreement or any other undertaking on the part of the Receiving Party to keep it confidential
 - is known to the Receiving Party before its receipt from the Disclosing Party without any obligation of confidentiality to the Disclosing Party

- is lawfully in the possession of the Receiving Party prior to its receipt from the Disclosing Party as shown by receiving Party's written records without any restrictions on its disclosure
 - has been lawfully disclosed to the Receiving Party by a third party which did not acquire the same under an obligation of confidentiality from or through the Disclosing Party, as shown by the Receiving Party's written records
 - has been independently developed by the Receiving Party without reference to the information disclosed by Disclosing Party
 - is approved for release in writing by an authorised representative of the Disclosing Party; or
 - is by law or by any court or order of any governmental or regulatory authority required to be disclosed, to the extent of the relevant disclosure requirement.
- 4.4 If a Party is required by law to disclose any Confidential Information, it shall (to the extent its is permitted to lawfully do so) provide notice to the other Party prior to making such disclosure, so as to allow time to undertake legal or other action, to prevent such disclosure or otherwise obtain confidential treatment of such disclosure.
- 4.5 Each Party shall ensure that its respective employees, agents and registered students (as the case may be) who participate in the Project shall comply with the obligations of confidentiality as though they were parties to this Agreement.

5. Intellectual Property

- 5.1 The Parties may choose to introduce Background Intellectual Property to the Project. No Background Intellectual Property may be introduced to the Project by any Party without the prior written approval of the other Party. Background Intellectual Property shall be treated as Confidential Information for the purposes of clause 4.
- 5.2 Subject to existing contractual obligations, each Party hereby grants the other Party a royalty-free, non-exclusive licence to use its introduced Background Intellectual Property for the purpose of and to the extent needed or necessary for carrying out the Project, but for no other purpose.
- 5.3 Nothing in this Agreement grants either party any right to the other Party's Background Intellectual Property, except the rights expressly granted in this Agreement.
- 5.4 In the event that
- (a) any particular Foreground Intellectual Property has been developed using any Background Intellectual Property introduced by a Party in accordance with this Agreement; and
 - (b) that Background Intellectual Property is necessary to commercially exploit the Foreground Intellectual Property in question,

then the introducer of such Background Intellectual Property shall grant to the commercialising Party an option to negotiate a royalty-bearing, non-exclusive licence to use the introducing Party's Background Intellectual Property but only to the extent necessary to commercialise the Foreground Intellectual Property, and only in conjunction with and as an integral component of the Foreground Intellectual Property, in the Field, on fair, equitable and non-discriminatory commercial terms and subject to agreement on all licence terms and subject to the owning Party being contractually free to do so SAVE THAT this obligation shall not apply in respect of any Background Intellectual Property which the introducing party has identified, prior to its introduction to the Project, as not being available for commercialisation. The foregoing option shall continue for the same period as the Option Period specified at Clause 5.8 in respect of each piece of Foreground Intellectual Property, shall be on the same terms as the option in respect of Foreground intellectual Property set out at Clause 5.8 hereto, and shall be implemented in accordance with Clauses 5.8 and 5.9 hereto.

- 5.5 Foreground Intellectual Property created by the Scholar and/or the Research Body shall be owned by the Research Body.
- 5.6 Foreground Intellectual Property jointly created by the Scholar and/or the Research Body on the one hand and the Enterprise Partner on the other shall be owned by the Research Body. **[UNLESS AGREED OTHERWISE ON A PROJECT-BY-PROJECT BASIS]**
- 5.7 The Research Party shall grant to the Enterprise Partner a non-exclusive worldwide, royalty-free licence (but with no right to sublicense) to use the Foreground Intellectual Property for research purposes.
- 5.8 The Research Body grants to the Enterprise Partner a first option to negotiate **[TO BE AGREED ON A PROJECT-BY-PROJECT BASIS: [an exclusive][a non-exclusive]]**, licence to commercially exploit any Foreground Intellectual Property owned by the Research Body in the Field, on fair, equitable and non-discriminatory commercial terms (“the Option”). With respect to each piece of Foreground Intellectual Property, the Option shall commence on the date on which the Research Body notifies the Enterprise Partner in writing that the Foreground Intellectual Property in question is available for licensing, and shall continue for a period of six months from that date (“the Option Period”). The Research Body may, at its discretion, agree to extend the period of any Option, subject to the Enterprise Partner agreeing to pay any patent and other related costs which may fall due during the period of the Option in respect of the Foreground Intellectual Property in question.
- 5.9 The Enterprise Partner and the Research Body agree to negotiate in good faith during the Option Period, terms for such a licence taking account of the Enterprise Partner’s contributions in support of the Project and including fair and equitable compensation to the Research Body. If the parties are unable to agree the terms of a licence during the Option Period, the Enterprise Partner’s right to negotiate a licence to the Research Body’s Foreground Intellectual Property shall expire.
- 5.10 The Party owning Foreground Intellectual Property may take such steps or do such things as it considers reasonably necessary or desirable to protect such Foreground Intellectual Property from unauthorised use by third parties. Where patent applications are to be made for the Foreground Intellectual Property, such applications shall be made in the name of the Party in which the Foreground Intellectual Property is vested and the cost of such applications shall be borne by that Party. Nothing in this Agreement shall be construed as obligating an owning party to prosecute, assert or maintain any patents comprised in its Foreground Intellectual Property. Subject to any terms agreed in a subsequent licence agreement, each Party shall (at the cost of the requesting Party) provide reasonable assistance to the other Party in applying for patents and in defending all intellectual property claims made by third parties in respect of the Foreground Intellectual Property.
- 5.11 Each Party acknowledges that:-
- (a) the Project is of an experimental nature, and, as is the case in any research project, the results of the Project cannot be guaranteed; and
 - (b) any Background Intellectual Property and any Foreground Intellectual Property licensed pursuant to this Agreement are being licensed on an “as is” basis, without warranty or representation (including as to merchantability, fitness for a particular purpose, accuracy, efficacy, completeness, capabilities or safety, or any other warranties or representations whether express or implied), and all warranties and representations with respect to the Background Intellectual Property and the Foreground Intellectual Property are hereby excluded to the fullest extent permissible by law (including any warranty that the use of any Background Intellectual Property and/or Foreground Intellectual Property does not infringe the Intellectual Property of any third party); and
 - (c) neither the Research Body, the Student, nor the Research Body’s employees, servants or agents shall have any liability, whether in contract, tort, statute or otherwise in connection with any licence by the Research Body of any Background Intellectual Property or any Foreground Intellectual Property or any subsequent use thereof.
- 5.12 Each Party (an “**Indemnifying Party**”) agrees to indemnify and hold the other Party (the “**Indemnified Party**”) harmless against all costs, claims, liabilities, losses, actions, expenses, demands and/or damages suffered or incurred by the Indemnified Party in relation to the use by the Indemnifying Party or any of its employee agents or contractors of the Indemnified Party’s Background Intellectual Property or Foreground Intellectual Property.

5.13 Neither Party shall be liable to the other in contract, tort or otherwise for any indirect or consequential losses howsoever caused, arising out of or in connection with the Project.

6. Publication

6.1 The Parties recognise the IRCSET Policy relating to the placement of research publications in Open Access Repositories as set out in the Head Contract. The Research Body and its authorised personnel (including the Scholar) shall be entitled to make oral, written or other public disclosures of the results of the Project and the Foreground Intellectual Property, including but not limited to:

- making presentations at seminars, symposia, professional meetings; and
- publishing in journals, theses or dissertations, or otherwise of their own choosing, methods and results in accordance with normal academic practice;

provided that the Enterprise Party is notified, and furnished with a copy of the publication concerned, at least thirty (30) days in advance of making the proposed publication. While approval of the Enterprise Partner to proceed with publication will not be required, such publications shall not reveal Confidential Information of the Enterprise Partner.

7. General

7.1 Save as expressly provided in this Agreement, there are no conditions, warranties, or other terms binding on any Party with respect to the actions contemplated by this Agreement, and any condition, warranty or other term in this regard which might otherwise be implied or incorporated into this Agreement, whether by statute, common law or otherwise are hereby excluded to the fullest extent permitted by law.

8. Term and termination

8.1 This Agreement shall commence on the commencement of the Head Agreement, and shall continue until the earlier of:-

- (a) six months after termination of the Scholarship, or
- (b) six months after completion of the Project.

8.2 On termination or expiry of this Agreement for whatever reason all rights and obligations of the Parties under this Agreement, and all terms of the Agreement, shall automatically terminate except for:-

- (a) any obligations and/or rights of action which may have accrued prior to termination;
- (b) any obligations and/or rights of any Party which otherwise relate to or may arise at any future time from any breach or non-observance of obligations under this Agreement which arose prior to the date of termination or expiry;
- (c) Clauses 4 and 6 of this Agreement shall continue to be binding on the Parties for a period of six months after the date of such termination or expiry; and
- (d) the following Clauses shall continue to be binding on the parties Clauses 5.5, 5.6-5.13 inclusive, 5.14.

9. Governing Law

9.1 This Agreement shall be governed and construed in accordance with the laws of Ireland and shall be subject to the jurisdiction of the Irish Courts.

**Signed by and on behalf of
The Research Body**

Name:

Signature:

Title:

Date:

**Signed by and on behalf of
the Enterprise Partner**

Name:

Signature:

Title:

Date:

Agreed and acknowledged by the Scholar

Name:

Signature:

Title:

Date:

**Agreed and acknowledged by the Academic
Supervisor / Mentor**

Name:

Signature:

Title:

Date: