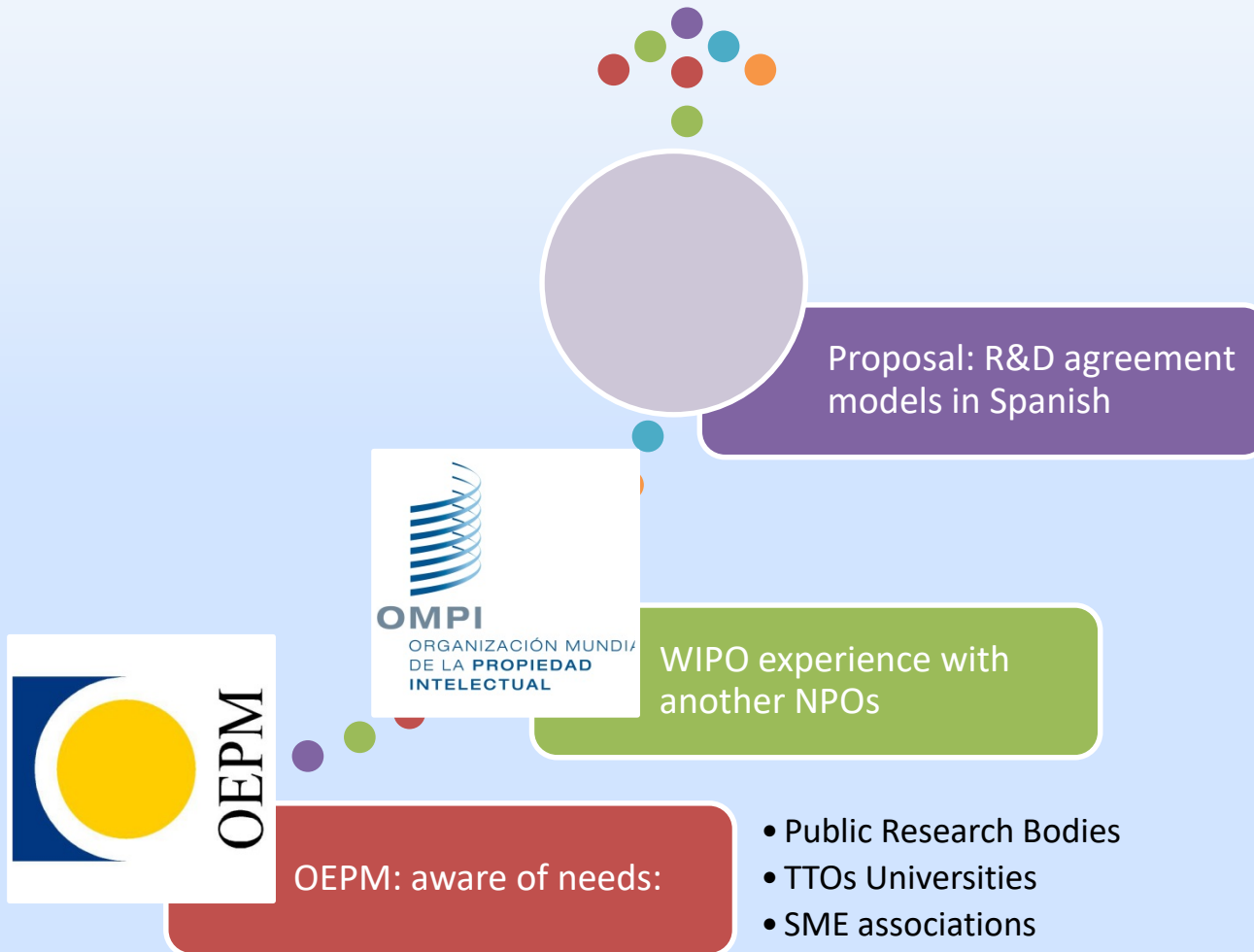


Working Group on the drafting of Transfer of Technology Agreements

Spanish Patent and Trademark Office
SCP/33

Origin of the initiative



Working Group



Working Group

Spanish National Research Council (CSIC)

- largest public institution dedicated to research in Spain and the 3rd largest in Europe
- Largest applicant for national patents
- 2 representatives from Deputy Vice Presidency of Knowledge Transfer

Licensing Executives Society- Spain and Portugal (LES)

- Professionals of licensing, transfer and management of IP
- 1 representative

Ministry of Science, Innovation and Universities

- Public Research Bodies
- Technology Transfer Offices
- 2 representatives from Fostering Innovation

WORKING GROUP

Spanish Patent and Trademark Office

- 4 representatives

World Intellectual Property Office

- 2 representatives from Arbitration and Mediation Centre

4 models developed until date

Non Disclosure Agreement

Material Transfer Agreement

Patent/Utility Model License Agreement:

- Between Public Body and Company
- Between Private entities

Research and Development Agreement:

- Between Public Body and Company
- Between Private entities

- Spanish version
- English version
- Usage Guide

Structure of the Agreements



Structure of the Guides



Aim of the contract or agreement



Why to sign a contract or agreement of this type



Points to keep in mind when writing such a contract



Comments to the proposed contract models

Structure of the Agreements

- **Color code**

YELLOW FUND – Explanatory text to choose the option required by the contract or agreement. To delete before signing

Green color– text to choose between 2 options. Delet one of them

Red color – partes del texto a completar por las Partes.

NON DISCLOSURE AGREEMENT

BETWEEN

(Party A)

And (Party B)

[City], [Month] [day], 20(...)

Of the one part, Mr./Ms.[...], with national identity card number [...], acting on behalf of [name of the Company and/or institution], with registered office at [include address], with tax identification number [...], duly registered in the Companies Registry of [...] with number [...] and acting in his/her capacity as [...] acting with power to act on the name and on behalf of the company (hereinafter referred to as "Party A").

Of the other part, Mr./Ms.[...], with national identity card number [...], acting on behalf of [name of the Company and/or institution], with registered office at [include address], with tax identification number [...], duly registered in the Companies Registry of [...] with number [...] and acting in his/her capacity as [...] acting with power to act on the name and on behalf of the company (hereinafter referred to as "Party B").

Party A and Party B are individually referred to hereinafter as the "Party" and collectively as the "Parties".

Both Parties mutually acknowledge their legal capacity to enter into and be bound by this non disclosure agreement and to that effect they state the following:

WHEREAS

- I. Party A, through the [Institute / Center of...], and particularly through researcher [Mr./Ms. ...], conducts research in the field of [...].
- II. Party B is a company developing its activities in the field of [...].
- III. Party A and Party B have considered the mutual disclosure of certain information regarding [...] (describe the Confidential Information, without providing specific details; necessary and desirable for the purpose of (describe the purpose of the disclosure of the Confidential Information, for example: to evaluate the possibilities of a collaborative research; to enter into a Research and Development Agreement ("Collaboration Agreement"); to reach a commercial agreement; to evaluate the possibility of collaborating in a specific research project).
- IV. (Add other explanation on the reasons to enter into a Non Disclosure Agreement and showing the previous collaborations, including exchange of information, materials, R

Alternative Dispute Resolutions for IP Clause

Non Disclosure Agreement.

10. PARTIAL INVALIDITY

9.2 In the event that any provision of this Agreement is held null and void, illegal or unenforceable, the remaining provisions shall remain valid. Before declaring any provision null and void, illegal or unenforceable it shall be construed, limited or amended so that the defect is corrected.

11. TERMINATION

11.1 In addition to the cases specifically regulated by the applicable legislation in force, the Agreement shall be terminated in the following cases:

- a. By the expiration of the contractual term agreed.
- b. At any time, by mutual agreement in writing.
- c. By the breach by a Party of any of the obligations under the Agreement, as long as such breach is not remedied within a maximum period of thirty (30) days after written request for the remedy, unless such breach is irreparable or makes impossible the fulfillment of this Agreement to the complaining Party, in which case the termination may be immediate, and in any case without prejudice to any claim for damages that may correspond to either Party.

11.2 Whatever the cause of termination of the Agreement, the provision of clause SIX above shall apply.

12. APPLICABLE LAW AND JURISDICTION

CHOOSE ONLY ONE OPTION AND LEAVE ONLY ONE OPTION IN THE SIGNED AGREEMENT

Option 1:

The Agreement is a private agreement in its nature and shall be governed by the laws of Spain.

The Parties agree that any dispute, controversy or claim arising under, out of or relating to this Agreement and any subsequent amendments of this Agreement, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, shall be referred to and finally determined by mediation in accordance with the WIPO Mediation Rules. The place of mediation shall be (...), Spain. The language to be used in the mediation shall be Spanish.

If, and to the extent that, any such dispute, controversy or claim has not been settled pursuant to the mediation within 60 days of the commencement of the mediation, it shall be referred to court proceedings before the corresponding Courts of (...).

Non Disclosure Agreement.

Option 2:

The Agreement is a private agreement in its nature and shall be governed by the laws of Spain.

The Parties agree that any dispute, controversy or claim arising under, out of or relating to this Agreement and any subsequent amendments of this Agreement, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, shall be referred to and finally determined by mediation in accordance with the WIPO Mediation Rules. The place of mediation shall be (...), Spain. The language to be used in the mediation shall be Spanish.

If, and to the extent that, any such dispute, controversy or claim has not been settled pursuant to the mediation within 90 days of the commencement of the mediation, it shall, upon the filing of a Request for Arbitration by either party, be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules. Alternatively, if, before the expiration of the said period of 90 days, either party fails to participate or to continue to participate in the mediation, the dispute, controversy or claim shall, upon the filing of a Request for Arbitration by the other party, be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules. The arbitral tribunal shall consist of a sole arbitrator. The place of arbitration shall be (...), Spain. The language to be used in the arbitral proceedings shall be Spanish. The dispute, controversy or claim referred to arbitration shall be decided in accordance with the law of Spain.

Option 3:

The Agreement is a private agreement in its nature and shall be governed by the laws of Spain.

The Parties agree that any dispute, controversy or claim arising under, out of or relating to this Agreement and any subsequent amendments of this Agreement, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, shall be referred to court proceedings before the corresponding Courts of (...).

13. ENTIRE AGREEMENT

13.1 The Agreement, including all its annexes, shall be considered as the whole Agreement between the Parties and supersedes all other agreements or communications, written or oral, concluded between the Parties prior to the execution of the Agreement in relation to the purpose contemplated herein. The Agreement shall only be amended by virtue of written document signed by the Parties authorized representatives. The non-exercise of a right or power, whether before the courts or in any other means, does not imply waiver of such rights or powers hereinafter.

Usage Guide

Esta guía ha sido diseñada para mostrar la importancia de los acuerdos de confidencialidad, así como para ayudar a las partes en la elaboración y firma de los mismos, a partir del modelo de acuerdo que se pone a su disposición junto con la guía.

Esta guía tiene como objeto los acuerdos que quieren crear una obligación de confidencialidad entre las partes, una obligación recíproca. No obstante, las obligaciones de confidencialidad pueden ser parte de diversos contratos.

Esta guía se compone de los siguientes apartados:

1.- ¿Por qué firmar un Acuerdo de Confidencialidad?

2.- Puntos a tener en cuenta al redactar un Acuerdo de Confidencialidad.

3.- Comentarios al modelo de Acuerdo de

Models accessible free of charge in www.oepm.es



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Contract Templates

Within the system for protecting the results of all R&D&i processes using Patents or Utility Models, Technology Transfer plays a very important role.

Technology Transfer is usually aimed at obtaining a commercial return on the knowledge and results of the R&D&i, establishing contractual relationships that take into account the special characteristics of the knowledge transfer because, once said knowledge is transferred, it is very difficult to go back.

This means that the transmitter of the information or knowledge needs to take every precaution to prevent complicated situations from arising in the future and, consequently, contracts that regulate Technology Transfer need to be drawn up very carefully to take into account all possible legal and economic consequences.


In this context and given the fact that universities, public research bodies and small and medium enterprises in Spain need this type of contract template, a working group has been created, which is coordinated by the Spanish Patent and Trademark Office and responsible for developing templates for different types of contracts

This working group is made up of representatives from the Higher Council for Scientific Research (CSIC), LES Spain and Portugal (LES), the Ministry of Economy, Industry and Competitiveness, the Spanish Patent and Trademark Office (SPTO) and the World Intellectual Property Organisation (WIPO).

The first templates to be completed are the "Confidentiality Agreement" and the "Agreement to Transfer Material", with their corresponding usage guides and with versions in Spanish and English. Others will follow shortly that will aim to cover all aspects of Technology Transfer.

The institutions that have helped to produce these templates are in no way liable for any use made of them. It is recommended that anyone wishing to use these contract templates also seeks specialist legal advice with regard to the definitive wording or adaptation of the contract.

Agreement	Usage guide	Spanish version	English version
Confidentiality	Download (v.23.09.2016)	Download (v.23.09.2016)	Download (v.23.09.2016)
Transferring Material	Download (v.23.09.2016)	Download (v.23.09.2016)	Download (v.23.09.2016)
License (Public-Company Entity)	Download (v.24.09.2017)	Download (v.23.09.2016)	Download (v.23.09.2016)
License (Company-Company)	Download (v.24.09.2017)	Download (v.28.12.2016)	Download (v.23.09.2016)
Research and Development	Download (v.19.04.2018)	Download (v.19.04.2018)	Download (v.19.04.2018)



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	ES	EN
Confidentiality	9860	3146
Transferring Material	5063	1937
License (Public-Company)	2508	1188
License (Company-Company)	3612	1763
Research and Development	668	221



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**THANK YOU VERY MUCH FOR YOUR
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