



Delibera n. 24/2014, Verbale CdA n. 05/14

Oggetto: approvazione dell'accordo di gestione congiunta di brevetto tra l'INAF e l'INTA – Instituto Nacional de Técnica Aeroespacial “Esteban Terradas” di Madrid.

IL CONSIGLIO DI AMMINISTRAZIONE

- VISTO** il Decreto Legislativo 4 giugno 2003, n. 138 di riordino dell'Istituto Nazionale di Astrofisica, pubblicato nella G.U. del 19 giugno 2003, n. 140;
- VISTO** il Decreto Legislativo 31 dicembre 2009, n. 213 di riordino degli enti di ricerca in attuazione dell'articolo 1 della legge 27 settembre 2007, n. 165;
- VISTO** lo Statuto dell'INAF, entrato in vigore il 1° maggio 2011;
- VISTO** il Disciplinare di Organizzazione e Funzionamento dell'Istituto Nazionale di Astrofisica, approvato con propria deliberazione n. 44/2012 del 21 giugno 2012, entrato in vigore il 23 luglio 2012 e successivamente modificato con proprie deliberazioni n. 84/2013 del 19 dicembre 2013 e n. 07/2014 del 19 febbraio 2014;
- VISTO** il Regolamento sull'amministrazione, sulla contabilità e sull'attività contrattuale dell'INAF, pubblicato sul S.O. n. 185 alla G.U. Serie Generale n. 300 del 23 dicembre 2004;
- VISTA** la propria deliberazione n. n. 81/2013 del 19 dicembre 2013 di approvazione del bilancio di previsione dell'INAF relativo all'esercizio finanziario 2014;
- VISTO** il decreto legislativo 10 febbraio 2005, n. 30 “Codice della proprietà industriale, a norma dell'art. 15 della Legge 12 dicembre 2002, n. 273”;
- VISTO** il Regolamento INAF sui diritti di proprietà industriale acquisibili mediante brevettazione e sui diritti derivanti dalle opere d'ingegno, pubblicato sulla Gazzetta Ufficiale n. 189 del 16 agosto 2006;
- CONSIDERATO** che l'INAF e l'INTA – Instituto Nacional de Técnica Aeroespacial “Esteban Terradas” di Madrid hanno congiuntamente svolto una ricerca, dal titolo “*Achromatic Liquid Cristal Variable Retarder*”, che ha condotto ad un invenzione passibile di brevettazione;
- MESSO IN RILIEVO** che, a seguito di detti risultati, l'INAF e l'INTA hanno convenuto di depositare congiuntamente una domanda di brevetto a tutela dell'invenzione;
- VISTA** la nota del Responsabile dell'Unità Centrale IV della Direzione Scientifica – Politiche Industriali, Innovazione e Trasferimento Tecnologico, prot. n. 1962 dell'8 maggio u.s., con la quale il dott. Corrado Perna ha trasmesso il testo dell'accordo per la gestione congiunta del brevetto;
- PRESA VISIONE** del testo dell'accordo;

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TENUTO CONTO	che, ai sensi dell'art. 4 del succitato accordo, tutti i costi relativi al deposito, all'estensione ed al mantenimento in vita del brevetto saranno sostenuti in parti uguali dalle parti;
ACCERTATO	che le suddette spese, quantificabili solo a valle dell'avvenuto deposito del brevetto, troveranno copertura sul CRA 1.05.05.11 "SIT e relazioni industriali (ref. G. Vettolani)", capitolo 1.05.07 "Deposito, mantenimento e tutela dei brevetti", centro di costo 0.04.04 "USC IV – Politiche Industriali, innovazione e trasferimento tecnologico" del bilancio di previsione dell'INAF per l'esercizio finanziario 2014;
RIAFFERMATO	che, ai sensi dell'art. 2, comma 1, lett. d) del proprio Statuto, l'INAF promuove la valorizzazione dei risultati della ricerca svolta o coordinata dalla propria rete scientifica ai fini produttivi e sociali anche mediante il trasferimento tecnologico;
ACQUISITO	il parere favorevole del Direttore Scientifico;
RAVVISATA	l'alta valenza scientifica dell'accordo in questione che, alla luce dei fini istituzionali dell'INAF, è da ritenersi meritevole di approvazione;

DELIBERA

con voto unanime dei presenti, espresso nei modi di legge:

- di approvare, nel testo allegato alla presente deliberazione in modo da formarne parte integrante e sostanziale, lo schema di accordo di gestione congiunta di brevetto tra l'INAF e l'INTA – Instituto Nacional de Técnica Aeroespacial "Esteban Terradas" di Madrid;
- di conferire al Presidente mandato alla sottoscrizione dell'accordo in questione.

Roma, 23 maggio 2014

Il Segretario



Il Presidente



**PATENT JOINT OWNERSHIP AGREEMENT BETWEEN ISTITUTO
NAZIONALE DI ASTROFISICA AND INSTITUTO NACIONAL DE TÉCNICA
AEROESPACIAL “ESTEBAN TERRADAS”**

Torrejón de Ardoz, the of 2013

ASSEMBLED

On the one hand, Instituto Nacional de Técnica Aeroespacial “Esteban Terradas” (hereinafter, INTA), represented by Mr. Ignacio Azqueta Ortiz, as General Director, a position for which he was designated by Royal Decree 939/2013 of 29 November 2013, with address at Carretera de Ajalvir, Km 4,5, Torrejón de Ardoz, 28850 Madrid, pursuant to article 12 of INTA’s Statutes, approved by Royal Decree 88/2001 of 2 February, modified by Royal Decree 343/2010, of 19 March, and by Royal Decree 1656/2012, of 7 December.

And, on the other hand, Istituto Nazionale di Astrofisica (hereinafter, INAF), represented by the President, Professor Giovanni Fabrizio Bignami .

The Parties acknowledge their respective capacity, power and authority to enter into this Agreement, and to this effect,

SET FORTH

- 1. That INTA, a Public Research Body, pursuant to Law 14/2011 of 1 June, is an independent Body, attached to the Defence Ministry, through the Defence State Secretariat, pursuant to the provisions of article 43.1.a) of Law 6/1997 of 14 April on the Organisation and Functioning of the General State Administration, specialised in aerospace research and technological development, whose functions are those stated in article 3.2 of its Statutes, approved by Royal Decree 88/2001 of 2 February, modified by Royal Decree 343/2010, of 19 March, and by Royal Decree 1656/2012, of 7 December.*
- 2. That INAG, a Public Research Body, pursuant to Law Decree 138/2003, is an independent Body, attached to Ministry of Education and Research, specialised in aerospace research and technological development, whose functions astronomy, astrophysics and space sciences*
- 3. That the Parties have carried out a collaboration in the frame of the European Space Agency (ESA) Project entitled “.....”, resulting in a technology which may be protected by means of a patent..*

4. That, as set out, both Parties, based on the powers attributed to them in their respective rules of functioning, shall sign this Joint Ownership Agreement, based on the following

CLAUSES

FIRST OBJECT

The object of the present agreement is to regulate the patent rights of the Parties in relation to the result of the joint research, entitled "Achromatic Liquid Cristal Variable Retarder", (hereinafter the invention).

SECOND JOINT OWNERSHIP OF THE PARTIES AND PATENT PROTECTION

The Parties will be joint and equal owners of the invention and the patent rights and obligations (50% each).

The Parties will each use their best efforts to assure that joint inventors fully cooperate in the preparation, filing, prosecution and maintenance of patent rights.

INTA will, after consultation and agreement from INAF:

- file the European patent application;
- prosecute the patent application resulting from said filing until the granting of the corresponding patent, or abandon said application when advisable;
- maintain the patent and its validations by paying the annual fees;
- keep INAF informed of the details of the filing, the prosecution and the maintenance of the Intellectual Property Rights.

THIRD EXTENSION OF THE PATENT

The extension of the patent to other countries will be agreed upon by the Parties, respecting the conditions contained in this Agreement concerning participation in general expenses of the patent and ownership of patent rights and obligations.

In case one Party decides not to follow the extension, it will inform without delay the other, in order to allow it to proceed with the extension in those countries where the other Party decided not to extend the priority application. In that case, said extension shall be done under the sole name of the interested Party and at its own expense and the other Party undertakes to assign, free of charge, its share of co-ownership to the interested Party.

FOURTH EXPENSES DERIVED FROM THE PATENT

Unless otherwise agreed upon between the Parties, the expenses covering the filing, prosecuting and maintaining of the patent shall be shared equally between both Parties.

INTA will select the IPR Agent for the filing, prosecution or maintaining of the titles. INTA will then notify to INAF the choice and then invoice INAF its corresponding amount (50% each) for every action the Agent has to execute, previously agreed between the Parties.

FIFTH EXPLOITATION OF THE INVENTION

a) Independent use

Each Party has full right to use the patent for its own institutional purpose both of research and education, as well as outreach (publishing, seminars, workshops, conferences, etc.) without prior consent of the other Party; this must not damage in any case neither patent safeguard actions nor technology transfer to third Parties aiming to valorisation and economic exploitation of patent.

Each Party has the full right to use the patent for commercial purposes on a royalty-free basis without prior consent of the other Party.

b) Patent valorisation: patent licensing to third Parties

The Parties intend the patents will be diligently commercialized and developed in the interest and benefit of the Parties. For this purpose the Parties will engage to promote all necessary negotiations aiming to economic exploitation of patents, as well as exclusive or non-exclusive exploitation license of the invention.

Licenses for patent exploitation shall be jointly granted by the Parties. The share of benefits shall be specified in the license agreement or in an exploitation agreement to be signed between the Parties.

SIXTH NOTIFICATIONS

Any notice required by this Agreement shall be personally delivered or sent by registered mail or facsimile to the appropriate address indicated below or to such other address as a Party may have advised to the other Party in writing:

*INTA: Technology Transfer Office Director
Instituto Nacional de Técnica Aeroespacial
Ctra. Ajalvir, Km 4.*

28045, Torrejón de Ardoz, Madrid
Spain

Phone: +34 91 520 1992
gomezsj@inta.es

INAF: Head of the National Division of Business and Innovation
Scientific Directorate
Istituto Nazionale di Astrofisica
Viale del Parco Mellini, 84
I - 00136 Rome
Italy

Phone: +39 0635533314
Email: rapporti.industria@inaf.it

SEVENTH CONFIDENTIAL INFORMATION

The Parties will retain in confidence, and will not disclose to a third party without the written consent of the other Party the scientific or technical information belonging to the other Party, and to which it may have access during the development of the invention.

The Parties shall use the information received exclusively for the purposes for which it has been revealed.

The provisions of the foregoing paragraphs shall not apply in the following cases:

- a) When the information received is or becomes of public knowledge.*
- b) When the receiving Party had previous knowledge of the information received.*
- c) When the information has been developed, independently and in good faith, by employees of the receiving Party who have not had access to the information supplied by the other Party.*
- d) When the information has been received from a third party who had a right to reveal it.*
- e) When the information has to be disclosed by reason of a governmental or judicial order or applicable law. In such case, the Party having received such an order or being subject to such applicable law shall inform the disclosing Party of its obligation to disclose confidential information, if possible prior to such disclosure.*

- f) *When the information is disseminated or used under express agreement from the proprietary Party.*

Each Party shall accord to the Confidential Information at least the same degree of care and confidence with which it treats its own similar information of like nature and make its best efforts to assure the confidentiality of the Confidential Information in accordance with this Agreement.

The data and reports obtained during the collaboration of the Parties in obtaining the invention, together with the final results, will be confidential in nature and will be disclosed only to personal who are connected with the same.

EIGHTH PUBLICATIONS

In the event of publication or disclosure by either of the Parties, express mention shall always be made of the inventors and express reference will be made to this Agreement.

This clause shall survive the termination of this Agreement.

The disclosure of any information related to the invention will be postponed until the filing of the patent application before the corresponding authority.

NINTH TERM AND TERMINATION

This Agreement shall come into force upon its signature until the full end of the term or terms for which patent rights have not expired, or the date of termination of the last license agreement for the invention, whichever is longer.

Either Party may, upon reasonable written notice to the other Party, renounce the rights and obligations to any particular patent application within a national jurisdiction, derived from the present Agreement.

The other Party may acquire such rights and obligations in which event, it will own all right, title and interest in that patent application or patent within such national jurisdiction and the Party renouncing will execute any assignments necessary to transfer full title to the other.

ELEVENTH RESOLUTION OF CONTROVERSIES

The contentious matters that may arise among the Parties as a consequence of the execution of the Agreement should be resolved by mutual agreement.

In the absence of any agreement, competency in these matters corresponds to the jurisprudence relating to jurisdiction under administrative law.

In witness thereof, the representatives of the Parties sign the present Agreement, in duplicate, and to one sole effect, in the place and on the date indicated at the beginning of this document.

INTA

INAF

Ignacio Azqueta Ortiz
General Director

Giovanni Fabrizio Bignami
President