




EVERYTHING MATTERS

Model technology research and commercialization agreements and dispute resolution considerations

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IPAG – „Intellectual Property Agreement Guide“



- Model technology transfer agreements in German and English
 - Confidentiality agreement
 - Purchase agreement IP
 - License agreement
 - Material transfer agreement
 - Research and development cooperation agreement
 - for 1 project
 - as a frame agreement
 - Paid-for research and development agreement
- Where you can find the agreements: www.ipag.at
- Free access for the public

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IPAG – „Intellectual Property Agreement Guide“



- Project leaders
 - Austrian association of universities
 - national contact point for intellectual property (ncp.ip) in the Federal Ministry for Science and Research
 - Federal Ministry for Economy, Family and Youth
 - Federal Ministry for Transport, Innovation and Technology
 - Austria Wirtschaftsservice, an Austrian federal development and financing bank for the promotion and financing of companies
- Purpose of the project: improvement of the cooperation and fostering the knowledge transfer between science and industry
- Reflecting specifics of Universities

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IPAG – „Intellectual Property Agreement Guide“



- The homepage includes
 - the download section of the
 - relevant model agreements in 3 versions (short University version, long University version, long Industry version)
 - various contractual model clauses,
 - variants to contractual model clauses
 - enlightening comments explaining the law, state aid and cartel law limits and risks, explaining risks of University / Industry versions
 - a glossary explaining the basic terms of tech transfer
 - Frequently Asked Questions
 - General introductions for each agreement
 - Defining differentiating criteria among the different agreements
 - A checklist for each agreement

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IPAG: Jurisdiction, Applicable law



- The [exclusive] place of jurisdiction for any and all disputes arising from and in connection with this Agreement, including disputes as to its existence and disputes arising after its termination, shall be the court competent for commercial matters in _____(place). The Agreement shall be governed by Austrian law, excluding the conflict-of-law rules. Application of the United Nations Convention on Contracts for the International Sale of Goods shall be explicitly excluded.

IPAG Alternative: Arbitration



- 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 arbitration in accordance with the WIPO Expedited Arbitration Rules.
- The arbitral tribunal shall consist of a sole arbitrator. The place of arbitration shall be _____(place). The language to be used in the arbitral proceedings shall be _____(e.g. German). The dispute, controversy or claim shall be decided in accordance with the law of _____(country).

IPAG Alternative: Arbitration and Mediation



- 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 submitted to mediation in accordance with the WIPO Mediation Rules. The place of mediation shall be _____(place). The language to be used in the mediation shall be _____(e.g. German).
- If, and to the extent that, any such dispute, controversy or claim has not been settled pursuant to the mediation within 60 (sixty) 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.

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IPAG Alternative: Arbitration and Mediation



- Alternatively, if, before the expiration of the said period of 60 (sixty) 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 _____(place). The language to be used in the arbitral proceedings shall be _____(e.g. German). The dispute, controversy or claim shall be decided in accordance with the law of _____(country).

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Considerations regarding dispute clauses



- Exclusive jurisdiction of a state court
 - not sufficient to satisfy the respective needs
 - preferred for cases of purely national disputes
- cross-border technology transactions – preference for alternative dispute resolution
- The decision for alternative dispute resolution is based on the following considerations:
 - Speed: in the research and development phase the parties do not really have time to spend time and resources for solving disputes. Therefore the offer of a quick solution was extremely decisive.
 - Confidentiality: in most cases, research and development projects involve issues to be kept confidential which should not be shared with the public – also with a view to the novelty requirement for patent filings with regard to inventions made during such a project. ADR provides confidentiality.

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Considerations regarding dispute clauses



- Neutrality: neutral view on any aspects of disputes in the course of a project.
- Influence on procedure: The parties have more influence on the choice of a mediator or arbitrator and also have greater influence on the entire procedure.
- Expert knowledge: the parties have to opportunity to appoint a mediator or an arbitrator who has specific knowledge on research projects and on the subject of research as such. There is not need that a mediator or arbitrator must be lawyer or judge.
- Dispute concentration: concentration of disputes involving various jurisdictions in one proceeding which is an opportunity to avoid diverging decisions in various countries.
- Enforcement: Arbitral awards can be enforced in almost all countries of the world

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Considerations regarding dispute clauses



- Mediation clause: offers the opportunity to involve a knowledgeable mediator who understands the often quite complex relationships and issues and assists the parties to solve their disputes very quick and at reasonable cost.
- Single arbitration clause – combined arbitration / mediation clause



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THANK YOU FOR YOUR ATTENTION