

# Intellectual Property Rights Joint Ownership Agreement

National Yang Ming Chiao Tung University ("Party A", Executive Unit: \_\_\_\_\_ Department/Institute, Inventor's Representative: \_\_\_\_\_ Professor) and \_\_\_\_\_ ("Party B", Executive Unit: \_\_\_\_\_, Inventor's Representative: \_\_\_\_\_) are jointly ☐ using the university's resources ☐ implementing the grant project of the Ministry of OO (Project name: "OOO", Project number: OOO) and collaborating to produce the research result " \_\_\_\_\_ " (hereinafter referred to as "the Result", "the Patent", "the Research"); for matters related to the ownership of rights, patent application, cost sharing and revenue sharing, both parties have agreed to the following terms in good faith for mutual compliance

1. Any technical data, know-how, designs, trade secrets, information, data and other intellectual property provided by either party from the commencement of the Research to the date of termination of patent maintenance, and its trade secrets, copyrights, patents, trademarks or any other intellectual property rights protected by law, shall remain the intellectual property rights of both parties, except to the extent that the third party is authorized to use them for the purposes of the Research. Any use by either party shall be authorized by mutual consent of both parties. Any dispute or liability of either party prior to the application of the Patent shall be the responsibility of each party.
2. Both parties agree to jointly own the intellectual property rights arising from the joint cooperation, and to jointly own the intellectual property rights and application rights in respect of the patent rights of the "Results" in the ratio of \_\_\_\_% for Party A and \_\_\_\_% for Party B (hereinafter referred to as the vesting of intellectual property rights). If it is necessary to apply for the registration of copyright, patent or other legal rights in any region, unless otherwise agreed, the application shall be made jointly by Party A and Party B and shall apply for registration as joint ownership in the names of both parties. In the case of patent application in Mainland China or PCT application, Party A may entrust a third party to assist in the process. The fees for application and maintenance shall be in accordance with Article 6 of this Agreement.
3. Any patents, copyrights and other intellectual property rights in any technical information and documents developed by either party after the termination of this Agreement based on the intellectual property rights arising from the Research shall be the sole property of that party and such party may independently apply for protection of the relevant intellectual property rights.
4. For research, teaching or experimental nonprofit purposes, either party may make a non-exclusive, non-sublicensable use of the Result in its own name; if it wishes to make an exclusive use, it may do so only with the written consent of the other party. Except as otherwise provided in this Agreement, either party shall obtain the prior written consent of the other party and shall be a joint party to exercise all rights of the trade secret owner, patent owner, copyright owner or other intellectual property owner under the relevant laws and regulations with respect to the Result (including, but not limited to, the right to transfer, entrust or create pledges with respect to the attributable

portion of the Result).

#### 5. Patent Application Maintenance Loss of Rights and Changes

- (1) Both parties agree that Party A shall be the lead party and Party B shall be the non-lead party. The lead party, after consulting with the non-lead party, shall have full authority to manage the patent application or maintenance process of the Patent in the Republic of China and other countries or regions where patent applications may be filed. Either Party A or B and their respective inventor's representatives shall provide necessary information to assist in the patent application or maintenance process, and the lead party shall inform the non-lead party of the patent application process and the results thereof.
- (2) The lead party shall notify the non-lead party four months prior to the payment deadline for the maintenance of the patent, and the non-lead party shall expressly indicate whether it is willing to maintain the patent within two months from the date of the notification. If the non-lead party does not expressly indicate within the deadline, the non-lead party shall be deemed to have waived the rights and benefits related to the patent, unless there are reasons that cannot be attributed to the non-lead party.
- (3) If the non-lead party considers that the country or region in which the lead party filed the patent application is insufficient and requests to file another patent application (hereinafter referred to as the supplemental application region), the lead party shall, within 30 days from the date of notification, expressly indicate whether it is willing to file or maintain the patent for the supplemental application region. If the lead party does not expressly indicate within the deadline, the lead party shall be deemed to have waived the rights and interests related to the patent, and then the non-lead party shall act as the lead party in the supplemental application region and may apply for or maintain the patent in its own name alone.
- (4) If any party fails to cooperate in the patent application, defense, maintenance procedure or cost sharing, and the other party expresses in writing to the said party its intention to continue the application or abandon the application, the said party shall expressly indicate its intention within 30 days from the date of notification.
- (5) If either party does not wish to maintain the patent (hereinafter referred to as the abandoning party) and the other party still wishes to continue to maintain the patent (hereinafter referred to as the maintaining party), the maintaining party shall bear the full cost of subsequent maintenance.

#### 6. Patent Application and Maintenance Fee Sharing

- (1) The fees referred to are fees related to patent application and maintenance incurred from the date of the official appointment of the patent agency by Party A, and are not limited by the date of signing of this Agreement. The fees include, but are not limited to, application, correction or filing fees, license fees, annual maintenance fees, agency service fees and other related fees as required by law.
- (2) The fees shall be paid jointly by both parties in accordance with the vesting of intellectual property rights in Article 2 of this Agreement, except for the portion

of the fees to be borne by the project commissioning or funding agency as otherwise provided or agreed upon, less the fees subsidized by the National Science and Technology Council. However, if one of the parties applies for maintenance alone in the manner specified in Article 5, item (2) and (3) of this Agreement, this shall not apply.

7. Either party may seek relief from any infringement of the intellectual property rights of the parties to this Agreement, and the other party shall provide all necessary assistance. However, attorneys' fees, court costs and all other expenses incurred in connection therewith (hereinafter referred to as litigation expenses) shall be borne by the party seeking relief. If both parties seek relief, the litigation expenses shall be shared by both parties in proportion to their respective shares. Damages obtained from the right to seek relief shall be shared by both parties in proportion to their respective shares after deducting the litigation expenses incurred for such relief.
8. Both parties A and B and the inventors understand that since the inventors are actually involved in the research project on behalf of their respective parties A and B, in the event of future infringement disputes arising from the transfer or license of the patent, both parties A and B and the inventors shall be legally responsible for the resolution of such infringement disputes and provide the necessary assistance to resolve the problems. The allocation of liability for infringement damages arising from the patent license and transfer shall be separately agreed upon by Party A and Party B in the technology transfer or license agreement signed with the third party. The agreement shall set forth the following matters:
  - (1) The liability of either party shall be limited to the actual income received from the technology transfer or license.
  - (2) Either party shall only guarantee the unintentional copying of others' research, and shall not guarantee the Patent against infringement claims by third parties.
9. With respect to the "Results" and the undisclosed confidential parts of the intellectual property related to the Research, both parties A and B and their respective inventors, appointees, agents, trustees, employees or other persons under their direction and supervision shall each fulfill their obligations and responsibilities of confidentiality as good administrators in order to protect the rights and interests of all co-owners. Neither Party A nor Party B and their respective inventors, appointees, agents, trustees, employees or other persons under their direction and supervision shall deliver or divulge confidential information to a third party or make it public except for the following reasons
  - (1) When either of the parties has entered into the relevant agreement for the reason of the transfer or licensing mentioned in Article 10, and has taken appropriate confidentiality measures.
  - (2) If it is necessary for the inventor's representative of either Party A or B to publish the academic paper in domestic or overseas and inform both parties in writing 30 days prior to publication.
10. Licensing Promoting Party and Revenue Allocation
  - (1) Party A and Party B agree to let Party A take the lead in the promotion of licensing, and Party B shall not discuss the licensing conditions with third parties without

Party A's written consent. The rights or revenues derived from the license or transfer shall be allocated in accordance with the vesting of intellectual property rights in Article 2 of this Agreement, after deducting the following expenses in order:

- i. Government taxes.
  - ii. Fees payable specified by the government agency providing the research grant at the same time the grant is made.
  - iii. The patent application maintenance costs borne by either party.
- (2) In the event of Article 5, item (5), the maintaining party shall take the lead in the promotion of the license, and the maintaining party agrees to pay the maintenance fee of the patent application borne by the abandoning party and allocate a certain percentage of the revenue to the abandoning party if the revenue derived from the license or transfer is subsequently generated.

11. Contact: Notices or requests relating to this Agreement shall be delivered in writing to the following contact persons and shall be deemed to have been delivered to such party upon delivery to such contact person:

Party A Contact Person:	Title:
Tel:	Fax:
Address:	
E-Mail:	

Party B Contact Person:	Title:
Tel:	Fax:
Address:	
E-Mail:	

Party A Inventor's Representative:

Title:
Tel:
Address:
E-mail:

Party B Inventor's Representative

Title:
Tel:
Address:
E-mail:

12. Interpretation of this Agreement and Dispute Resolution

- (1) This Agreement shall be construed and applied in accordance with the laws of the Republic of China.
- (2) In the event of any legal dispute arising out of this Agreement, the parties agree that the Taiwan Hsinchu District Court shall be the court of first instance and that the laws of the Republic of China shall apply to resolve such dispute.

13. No additions, deletions or modifications to this Agreement shall be effective unless mutually agreed to in writing by both parties.

- (1) Matters agreed upon by both parties prior to the effective date of this Agreement that are not recorded in this Agreement or its attachments shall not be binding on both parties.
- (2) The attachments shall have the same effect as this Agreement, but in the event of any conflict between the two, this Agreement shall prevail.

14. This Agreement shall be effective from the date of signing. Both parties shall each keep one original copy and the inventor shall keep one carbon copy.

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## Contracting Parties:

Party: National Yang Ming Chiao Tung University

Representative: Lin, Chi-Hung

Title: President

Address: 300 No. 1001, Daxue Rd., Hsinchu City

Party B:

Representative:

Title:

Address:

Party A Inventor

Title:

Address:

Party B Inventor

Title:

Address:

Date: \_\_\_\_\_