

Part 5

Intellectual Property Rights Agreement

BETWEEN:

INTERNATIONAL DEVELOPMENT AND RESEARCH CENTRE

AND

(collectively, the “Parties”)

WHEREAS the Parties entered into the Agreement, pursuant to which the Centre will, subject to the terms and conditions therein, fund the Recipient to undertake certain research;

AND WHEREAS the Recipient undertook, pursuant to the Agreement, to discharge certain obligations in Sections A10.1.2 and A10.1.4 thereof;

NOW THEREFORE in consideration of the payment of sums by the Centre to the Recipient pursuant to the Agreement and other good and valuable consideration the receipt and sufficiency of which is hereby acknowledged by the Parties, the Parties have entered into this Intellectual Property Rights Agreement, pursuant to the aforementioned Sections of the Agreement, and hereby agree as follows.

D1. DEFINITIONS

All defined terms shall have the meaning ascribed to them in the Agreement, except for the following terms which, for the purpose of this Intellectual Property Rights Agreement, have the meanings set forth below:

“*IPR Agreement*” means this Intellectual Property Rights Agreement with Respect to Intellectual Property Rights entered into between the Parties.

“*Background Intellectual Property Rights*” means Intellectual Property Rights of either or both Parties in respect of intellectual property developed before or independent of the Agreement or the Project.

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“Centre” means the International Development Research Centre.

“Intellectual Property Rights” means any intellectual property or industrial property rights anywhere in the world, including but not limited to all patents, patent applications, patent rights, utility model rights, copyrights, utility models, trade secrets and confidential information, trade-mark rights, database rights, rights in computer programs and software rights, industrial design and other design rights, mask work and semi-conductor design rights and all other proprietary rights, which may subsist anywhere in the world, whether registered or unregistered, and all applications for registration of any of the foregoing, and all rights to file any such applications, and all registrations or patents issuing or reissuing there from.

“License Revenue” means the actual royalties, fees, payments, equity securities and other sums received in consideration of licenses or other rights granted to, or things of value delivered to, third parties in connection with the Project Intellectual Property Rights.

“Agreement” means the Grant Agreement funding agreement entered into between the Parties hereto with respect to the Project.

“Patent Expenses” means all out-of-pocket expenses, as evidenced by actual invoices, incurred in searching, preparing, filing, prosecuting and maintaining patents and/or patent applications, whether domestic or foreign, including all divisions and continuations of these applications, all patents issuing from such applications, divisions and continuations, and any reissues, reexaminations, and extensions.

“Project” means the research project entitled _____, described in the Agreement, to be carried out by the Recipient with funding support, pursuant to the Agreement, from the Centre.

“Project Invention(s)” means all inventions, designs, works, computer programs, software, discoveries, improvements, technologies, trade secrets, know how, processes, formulas, algorithms, production methods and technical data arising from or connected with the Project.

“Project Intellectual Property Rights” means all Intellectual Property Rights relating to anything authored, conceived, modified, developed, invented or designed in the course of, or which otherwise arises from or which otherwise is connected with, the Project including without limitation: (a) all Project Outputs and (b) all tangible materials such as the software, drawings, designs, prototypes, plans, work papers, schematic diagrams, circuit board layouts, algorithms, patterns, models, specifications, prototypes, and related documentation, and (c) all those Intellectual Property Rights which otherwise arise from or are connected with the Project; the foregoing specifically includes all inventions, discoveries, technology, trade secrets, know how, processes, formulas, production methods, techniques, and technical data arising from or connected with the Project.

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“Project Outputs” means any and all research-related outputs, and results of the Project, and publications and reports produced in relation to the Project, submitted or delivered by the Recipient to the Centre in any form now existing or hereafter invented.

“Recipient” means _____.

D2. APPLICABILITY OF IPR AGREEMENT

This IPR Agreement shall form part of, and be read with, the Agreement, regardless of whether the IPR Agreement is signed concurrent with, or following, the Agreement.

D2.1. Background Intellectual Property

The Parties agree that any existing Background Intellectual Property of the Centre and the Recipient are their separate property, respectively, and are not affected by this IPR Agreement.

D2.2. Related Agreements

Any licenses, contracts, subcontracts, sublicenses or arrangements of any type with regard to the Project, shall contain appropriate provisions to implement, and to ensure consistency and adherence with, the provisions of this IPR Agreement and ensure that the Centre and the Recipient obtain and retain such rights granted herein in all future resulting research, development, or commercialization work.

D3. PATENTS AND RELATED INTELLECTUAL PROPERTY PROTECTION

D3.1. Patent Application(s) by Recipient

D3.1.1. Timing

Within 90 days of notifying the Centre of a Project Invention, the Recipient shall inform the Centre of its decision of whether to file application(s) for a patent in Canada, the United States and/or any other country and/or take any other action to obtain other intellectual property protection for the Project Intellectual Property Rights. The first of such patent application(s) shall be filed within 180 days of the Recipient notifying the Centre of the Project Invention.

D3.1.2. Patent Expenses

All Patent Expenses for all patent application(s) for the Project Intellectual Property Rights filed by Recipient shall be borne by the Recipient. Funds remitted by the Centre to the Recipient under the Agreement shall not be used for Patent Expenses.

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D3.1.3. Notification

Recipient shall keep the Centre advised as to all developments with respect to patent application(s) and shall promptly, upon request from the Centre, supply copies of all papers received and filed in connection with the prosecution.

D3.1.4. Discontinuance of Prosecution

If the Recipient elects to discontinue financial support of any patent prosecution in respect of Project Intellectual Property Rights, in any country, the Centre shall be free to continue prosecution at the Centre's expense.

D3.2. Patent Application(s) by Centre

D3.2.1. Timing

In the event the Recipient does not exercise its right under Section D3.1 within the time period specified therein, the Centre may at its own discretion file application(s) for a patent for the Project Intellectual Property Rights and/or may take any other action to obtain other intellectual property protection for the Project Intellectual Property Rights anywhere in the world where the Recipient declines to do so. The first of such patent application(s) is to be filed within 180 days of the conclusion of the period referenced in Section D3.1.1.

D3.2.2. Patent Expenses

All Patent Expenses for all patent application(s) for the Project Intellectual Property Rights filed by the Centre shall be borne by the Centre.

D3.2.3. Notification

The Centre shall keep the Recipient advised as to all developments with respect to patent application(s) and shall promptly, upon request from the Recipient, supply copies of all papers received and filed in connection with the prosecution.

D3.3. Assignment of Project Intellectual Property Rights to Centre

Whenever the Centre exercises its rights under Sections D3.1.4 or D3.2, the Recipient shall, and hereby agrees to, irrevocably transfer and assign (or shall otherwise cause the irrevocable transfer and assignment of) all right, title and interest, in and to the corresponding Project Invention and related Project Intellectual Property Rights in any such country.

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D3.4. Execution of Assignments

Upon the request of the Centre, the Recipient shall execute any and all documents or other instruments and take all other actions, necessary or convenient to evidence, perfect or confirm the assignment of rights to the Centre pursuant to Section D3.3, including obtaining the assignment of any Project Intellectual Property Rights that may be held by contractors, subcontractors, collaborating institutions and all of their respective employees that may be involved with the Project.

D3.5. Confidentiality

Each party agrees that it will not publicly disclose any information concerning a Project Invention and will allow the review of any proposed patent applications to be conducted in a confidential manner, until the first of any patent applications in respect of a Project Invention is filed, or until both Centre and Recipient elect not to file a patent application under Section D3.1 or Section D3.2. The Parties, when exchanging documents and information between each other, shall mark as "CONFIDENTIAL" all materials covered by this Section D3.5.

D4. PATENT LICENSING AND REVENUE SHARING

D4.1. License to Centre

The Recipient hereby grants, and agrees it will grant as the Project Inventions and the Project Intellectual Property Rights arise, to the Centre a non-exclusive, perpetual, irrevocable, fully paid up, royalty free, transferable, worldwide right and license, with the right to sublicense, to make, use, import, produce, lease, reproduce, modify, install, run, display, Project Inventions and the Project Intellectual Property Rights for research purposes only.

D4.2. Licenses to End Users in Developing World

Upon the filing of patent application(s) by the Recipient under Section D3.1, the Centre shall inform the Recipient of all countries in the developing world ("Developing World Countries") where rights and licenses to the Project Invention and related Project Intellectual Property Rights must be made available to end users on reasonable terms and conditions which promote affordable and widespread access to the Project Invention and related Project Intellectual Property Rights in such identified Developing World Countries. Recipient shall develop, in good faith, the terms of such end user licenses, which end user licenses shall be subject to the approval of the Centre. Recipient shall have the unrestricted right to commercialize the Project Inventions and the Project Intellectual Property Rights on any terms it sees fit in countries outside of Developing World Countries, subject to making effective the aforesaid rights and licenses to end users in the Developing World Countries.

D4.3. License Revenue

Any license revenue shall accrue to the Party acting as licensor in any given instance.

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D5. RELATED OBLIGATIONS OF RECIPIENT

D5.1. Compliance with Applicable Laws

When the Recipient exercises rights and ownership in Project Inventions and Project Intellectual Property Rights, the Recipient shall be solely responsible for ensuring compliance with all applicable laws, including but not limited to applicable export control and packaging and labeling laws.

In witness thereof, the Recipient accepts the terms and conditions of this Agreement.

Signed on behalf of **insert full name of Recipient**

Date

Signatory's name in block letters

Signatory's title

Signed on behalf of the International
Development Research Centre

Date

Signatory's name in block letters

Grant Officer
Signatory's title