QF INTELLECTUAL PROPERTY TERMS

Appendix B: Awardee is non-Qatari Entity

Appendix

Intellectual Property

1. Definitions

A. “QF” means Qatar Foundation for Education, Science and Community Development, a private institution for public benefit enacted under Qatar Law 21 of 2006, through its Research and Development Division.

B. “QF IP Office” means the office located within the Research Strategy and Impact Management Division of Qatar Foundation Research and Development and is responsible for the management of QF owned Intellectual Property

C. “Traditional Academic Works” means all scholarly or academic works, regardless of the medium, created independently and at the author’s initiative to support teaching and other academic purposes. Such works comprise educational, scholarly, artistic or literary works such as personal lecture notes; books, articles, academic publications; seminar papers; theses, essays, academic journal articles; course materials, notes created for the author’s own personal use, and works of fine art. This definition does not include works specifically commissioned by QF.

D. “Intellectual Property” means all tangible and intangible rights including, without limitation, all copyright, all design rights and the right to apply for a registered design or similar protection, all rights in trade-marks, trade names, business names and domain names, all patent rights and rights to inventions, R&D assets, all rights in confidential information, know-how, expertise, formulas and formulations, all database rights and all rights of whatsoever nature in computer software and data and all other similar proprietary rights, whether registered or unregistered, including any and all associated goodwill, in all parts of the world for the full term of such rights, including all renewals and extensions. For the purposes of this Appendix, “Intellectual Property” does not include Traditional Academic Works.

E. “Project Intellectual Property” means all Intellectual Property created or first reduced to practice in the course of performance of work under this Agreement.

F. “Background Intellectual Property” means all Awardee, QF, and third party Intellectual Property created and first reduced to practice prior to or outside the scope of this Agreement.

G. “Staff Member(s)” means employee(s), independent contractor(s), subcontractor(s), consultant(s), student assistant(s) and student(s).

H. “Net Revenue” means gross revenue and proceeds received by a Party in consideration of a transfer, grant of rights or a license for Project Intellectual Property, less direct expenses including costs of securing or maintaining that Project Intellectual Property.
I. “Qatari Entity” means an entity established in Qatar under a Qatari law or decree; or a commercial entity incorporated or registered in Qatar in which at least 51% of the issued share capital is owned by Qatari nationals.

J. “Non-Qatari entity” means an entity that is either: (a) not established, incorporated or registered in Qatar (foreign entities) ; or (b) established, incorporated, or registered in Qatar but having a majority (at least 51%) of issued share capital owned by non-Qatari (foreign) nationals.

K. “Co-funding” means the mechanism through which QF allows eligible research end-users to make cash or in kind contributions to co-fund the work to be performed under this agreement.

L. “Co-funder” means any entity for which research and development activity is not part of its main mission and that can benefit from Project Intellectual Property, and has contributed cash or in-kind to co-fund the work to be performed under this agreement.

2. Intellectual Property

A. Background Intellectual Property Rights. All Background Intellectual Property is the separate sole Intellectual Property of QF or Awardee and is not affected by this Agreement.

B. Project Intellectual Property Rights (without exceptions). All right, title and interest to all Project Intellectual Property shall be owned solely and exclusively by and vest entirely in QF. Awardee shall ensure that all right, title and interest in Project Intellectual Property is retained by QF under any subcontracts, sub-awards or other third party agreements unless approved by QF IP OFFICE in writing (including email). QF shall be responsible for managing the protection and exploitation of QF solely owned IP. For the avoidance of doubt, even if joint ownership is not permitted, QF will a) grant all Awardees and Sub-awardees an irrevocable, world-wide, fully-paid non-exclusive license in and to all Project Intellectual Property for educational and research and development purposes only and b) share Net Revenues to all Awardees and Sub-awardees whose employees are named inventors or authors of the Project Intellectual Property.

C. Project Intellectual Property Rights (with exceptions). Awardee shall have the option to elect to jointly own any Project Intellectual Property created and disclosed to QF if the Awardee requests joint ownership and, in QF’s discretion, the waiver sufficiently justifies one of the following exceptions: (a) the Awardee is contributing significant (30% or more of the project budget) cash or in kind to co-fund the work to be performed, (b) the Awardee has Background Intellectual Property directly related to the subject matter of the funded research that is likely to become less valuable if the applicant fails to have joint ownership interest in the Project Intellectual Property, (c) the Awardee is legally prohibited from assigning IP rights to QF, or (d) the Awardee demonstrates other compelling circumstances that justify an exception. If an exception is granted by demonstrating other “compelling circumstances”, then Awardee shall agree to jointly protect and commercialize the Project Intellectual Property in a manner that promotes the growth of Qatar’s knowledge based economy, which may be met by requiring a (i) substantial manufacturing, (ii) substantial company funded research and development, (iii) substantial business presence in Qatar from the licensee or commercial developer of the Project Intellectual Property or (iv) other QF approved criteria. Upon such election, Awardee and QF will jointly own the disclosed Project Intellectual Property (hereinafter “Jointly Owned Project Intellectual Property”).

D. Sub-award Agreements. QF or Awardee may grant Qatari Sub-awardees and Non-Qatari Sub-awardees (subject to the limitations provided in this paragraph) an option to elect to jointly own Project Intellectual Property created and disclosed by the Sub-awardee(s) provided that Sub-awardee (s) agree to be bound by the same obligations and terms to QF that Awardee has to QF as provided herein. QF or
Awardee may only grant Non-Qatari Sub-awardee(s) the option to elect to jointly own Project Intellectual Property if the Sub-awardee(s) request joint ownership and, in the discretion of QF or Awardee, the waiver sufficiently justifies one of the exceptions stated in Paragraph 2C (a, b, c and d).

E. Co-funded Projects. IP ownership policy for co-funded projects shall be as follows: (i) Co-funders based inside Qatar, that have made cash or in-kind contributions of at least 30% of the budget approved by QF shall be joint owners of Project Intellectual Property (ii) Co-funders based outside Qatar will only qualify for IP joint ownership if they have made cash contributions of at least 30% of the approved budget.

F. Management of Jointly Owned Project Intellectual Property. All joint owners shall enter into an Intellectual Property Management Agreement in which terms for the protection and commercial exploitation of jointly owned Project IP will be established.

G. Revenue Sharing for Project Intellectual Property. Net Revenue shall be equally shared among all joint owners of Project Intellectual Property as well as non-joint owners whose employees are named inventors or authors of the Project Intellectual Property from which the revenue arose.

H. Disclosure of Project Intellectual Property. Awardee agrees to promptly disclose in writing all Project Intellectual Property produced by Awardee Staff Member to QF IP OFFICE with sufficient technical detail to convey a clear understanding, to the extent known at the time of the disclosure, of the nature, purpose, and operation of the Project Intellectual Property. The disclosure shall also identify any known actual or potential statutory bars of the invention. The Parties further agree to disclose to each other any subsequently known actual or potential statutory bar that occurs for an invention disclosed but for which a patent application has not been filed. All disclosures to QF of inventions shall be marked as confidential under the terms of this agreement. Awardee also agrees to provide QF a copy of all computer software in source and executable object code format in connection with the submission of any Project Intellectual Property disclosure and to allow its Staff Members who are named inventors to be interviewed by QF at a time and place convenient to the parties.

Requests for other deviations to IP terms and conditions other than as provided in this article 2 may be granted by writing (including email) to QF IP OFFICE on a case by case basis.

3. Intellectual Property Indemnity, Disclaimers and Liability

A. QF AND AWARDEE MAKE NO EXPRESS OR IMPLIED WARRANTY AS TO THE CONDITIONS OF THE RESEARCH OR ANY INTELLECTUAL PROPERTY, GENERATED INFORMATION, OR PRODUCT MADE OR DEVELOPED UNDER THIS AGREEMENT, OR THE OWNERSHIP, MERCHANTABILITY, OR FITNESS FOR A PARTICULAR PURPOSE OF THE RESEARCH OR RESULTING PRODUCT. EXCEPT AS PROVIDED SPECIFICALLY HERIN, NEITHER QF NOR AWARDEE SHALL BE LIABLE FOR SPECIAL, CONSEQUENTIAL, OR INCIDENTAL DAMAGES ATTRIBUTED TO SUCH RESEARCH OR RESULTING PRODUCT, INTELLECTUAL PROPERTY, GENERATED INFORMATION, OR PRODUCT MADE OR DEVELOPED UNDER THIS AGREEMENT.

B. To the extent legally permissible, QF and Awardee agree to hold harmless the other Party for all damages, costs, and expenses, including attorney’s fees, arising from personal injury or property damage occurring as a result of the making, using, or selling of a product, process, or service by or on behalf of the indemnifying Party, their assignees, or licensees, which was derived from the work performed under this Agreement.
C. Each Party will severally indemnify and save harmless the other Party including their respective officers, directors, employees, agents and students from and against any and all suits, claims, demands, costs, damages, expenses, losses or injuries (including death) to persons or property, including royalties and fees associated with the commercialization of Project Intellectual Property, caused by the breach, willful or negligent act or omission of the indemnifying Party and its officers, directors, employees and agents during the performance or arising out of this Appendix to the Agreement.