QF INTELLECTUAL PROPERTY TERMS

Appendix C: Awardee is a QF Center/Department/Division

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. Project Intellectual Property Rights. All right, title and interest to all Project Intellectual Property shall be owned solely and exclusively by and vest entirely in QF according to QF Policies and Procedures. Awardee should ensure that all right, title and interest in Project Intellectual Property are retained by QF under any subcontracts, sub-awards or other third party agreements unless an exception and IP terms are provided by IPTT for the related agreement(s).

B. Sub-award Agreements. Awardee may grant Qatari Sub-awardees and Non-Qatari Sub-awardees (subject to the limitations provided in this paragraph) (1) an option to elect to jointly own Project Intellectual Property created and disclosed by the Sub-awardee under the same terms provided in Paragraph 2.F below, (2) 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 (3) an equal share of Net Revenues as provided in Paragraph 2.E below, provided that Sub-awardee agrees to be bound by the same terms and obligations as Awardee has to QF as provided herein. Awardee may only grant Non-Qatari Sub-awardees the option to elect to jointly own Project Intellectual Property if the Sub-awardee requests joint ownership and, in QF’s discretion, the waiver sufficiently justifies one of the following exceptions: (a) the Sub- 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 Sub-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 Sub-awardee is legally prohibited from assigning IP rights to QF, or (d) the Sub-awardee demonstrates other compelling circumstances that justify an exception. If an exception is granted by demonstrating other “compelling circumstances”, then Sub-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. For the avoidance of doubt, even if joint ownership is not permitted, Awardees may grant all Sub-awardees the Research License as described in item (2) in this Paragraph C and share Net Revenues to all Sub-awardees whose employees are named inventors or authors of the Project Intellectual Property as described in item (3) in this Paragraph C.

C. 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.
D. 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.

E. 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. For QF inventors, QF shall share Net Revenues according to QF IP Policies and Procedures.

F. Disclosure of Project Intellectual Property. Awardee agrees to promptly disclose all Project Intellectual Property produced by an Awardee Staff Member to QF- IP OFFICE in accordance with QF procedures. This includes properly disclosing to QF- IP OFFICE any Project Intellectual Property 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 should also identify any known actual or potential statutory bars of the invention.

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.