

# ISTITUTO NAZIONALE DI FISICA NUCLEARE

## CONSIGLIO DIRETTIVO

### DELIBERAZIONE N. 12009

Il Consiglio Direttivo dell'Istituto Nazionale di Fisica Nucleare, riunito in Roma nei giorni 29 e 30 settembre 2011 alla presenza di n. 33 dei suoi componenti su un totale di n. 33;

- premesso che, in base all'art. 2 del proprio Statuto, l'Istituto Nazionale di Fisica Nucleare promuove, coordina ed effettua la ricerca scientifica nel campo della fisica nucleare, subnucleare, astroparticellare e delle interazioni fondamentali, nonché la ricerca e lo sviluppo tecnologico pertinenti all'attività in tali settori, prevedendo forme di sinergia con altri enti di ricerca e il mondo dell'impresa;
- visto il Contratto di licenza commerciale, approvato con deliberazione n. 9191 del 24 giugno 2005 e sottoscritto tra INFN e IBA in data 18 luglio 2005, avente ad oggetto la concessione di una licenza esclusiva per lo sfruttamento dei risultati degli sviluppi che hanno portato al dosimetro MatriXX ;
- visto il Patent Co ownership agreement, approvato con deliberazione n. 10057 del 30 marzo 2007 e sottoscritto in data 19 aprile 2007 tra INFN, IBA e il Dipartimento di Fisica Sperimentale dell'Università degli Studi di Torino (DFS), per definire i rispettivi diritti ed obblighi sulla domanda di brevetto presentata da IBA e sui conseguenti diritti di sfruttamento economico del dosimetro MatriXX;
- visto il Patent Co Ownership and Commercial License Agreement, approvato con deliberazione n. 10522 del 25 gennaio 2008 e sottoscritto in data 15 febbraio 2008 tra INFN, IBA e DFS, per definire i rispettivi diritti ed obblighi derivanti dalla brevettazione del Prodotto denominato Star Track - realizzato in collaborazione con il DFS dell'Università di Torino nell'ambito del Progetto Integrato denominato MAESTRO - e concedere ad IBA una licenza esclusiva per lo sfruttamento del trovato stesso;
- visti gli articoli 7.2 e 9.2 rispettivamente dei contratti del 18 luglio 2005 e del 15 febbraio 2008, i quali prevedono che le Parti, allo scadere di un periodo di tempo determinato, avrebbero congiuntamente stabilito l'ammontare delle royalties annuali a carico di IBA e la durata della nuova estensione del diritto di esclusività;
- vista la nota del Direttore della Sezione INFN di Torino del 7 settembre 2011, prot. N. 442, con la quale si propone l'estensione per un ulteriore quinquennio del diritto di esclusività della licenza rilasciata con i contratti suindicati dietro il pagamento di royalties quantificate in 20.000,00 euro annui;
- premesso che l'approvazione dello schema di "Commercial License Agreement"

(13-9/17)

non comporta alcun onere finanziario per l'Istituto e che l'entrata prevista per l'Istituto, pari a euro 20.000,00 annui, oltre iva, per i cinque anni di durata del Contratto, verrà accertata tra le entrate dell'Istituto con successiva deliberazione del Consiglio Direttivo;

- su proposta della Giunta Esecutiva;
- in data 30 settembre 2011 con n. 33 voti favorevoli;

#### DELIBERA

Di approvare lo schema di "Commercial License Agreement" tra l'Istituto Nazionale di Fisica Nucleare, la Ion Beam Applications S.A. e il Dipartimento di Fisica Sperimentale dell'Università degli Studi di Torino, allegato e che fa parte integrante della presente deliberazione. Il Presidente, o persona da lui delegata, è autorizzato a negoziarlo e sottoscriverlo.

## COMMERCIAL LICENSE AGREEMENT

This agreement is made by and between

**Istituto Nazionale di Fisica Nucleare** (hereafter “INFN”), a non profit organization organized under the laws of Italy, with its principal office located at Via Enrico Fermi 40, I-00044 Frascati RM, Italy (VAT IT04430461006), hereby represented by its President, Prof....., as authorized with resolution of INFN’s Board of Directors n. \_\_\_\_ in date \_\_\_\_\_, on the one part,

and

**Ion Beam Applications S.A.** (hereafter “IBA”), a corporation organized under the laws of Belgium, with its principal office located at 3 Chemin du Cyclotron, B-1348 Louvain-la-Neuve, Belgium (VAT BE428750985), hereby represented by its Managing Director and Chief Research Officer, Mr.....

and

**Dipartimento di Fisica Sperimentale dell’Università degli Studi di Torino** (hereafter “DFS”), a non profit organization organized under the law of Italy, with its principal office located at Via Giuseppe Verdi 8, I-10123 Torino TO, Italy (VAT.....), hereby represented by its Director, Prof....., as authorized with resolution of DFS Council in date \_\_\_\_\_, Estreat n. \_\_ of Minutes n. \_\_, on the other part.

### WHEREAS

- IBA and DFS have signed on June 12<sup>th</sup>, 2000, an Agreement (hereafter “DFS Agreement”) having as purpose the design and the realization of a pixel chamber for the measurement of therapeutical beams of photons and hadrons;
- IBA and INFN have signed on January 22<sup>th</sup>, 2001 an Agreement (hereafter “INFN Agreement”) having as purpose the design and the realization of a pixel chamber for the measurement of therapeutical beams of photons and hadrons;
- in range of the DFS Agreement and of the INFN Agreement the parties have produced a dosimeter for photon radiotherapy named MatriXX;
- INFN and IBA have signed on July 18<sup>th</sup>, 2005 a Commercial License Contract to grant an exclusive license for the exploitation of the results of the developments that led to the dosimeter MatriXX, as described in Annex 1 to the contract;
- INFN, IBA and DFS have signed on April 19<sup>th</sup>, 2007 an Agreement (hereafter “Patent co ownership agreement”) to define their respective rights and duties about the Patent and the others intellectual property rights of MatriXX;

- the Product MatriXX has obtained an international Patent protection (US20060266951 – WO20066126084);
- INFN, IBA and DFS – considering the collaboration between INFN and IBA to the Integrated Project called MAESTRO and research collaboration between IBA e DFS under which the parties have jointly designed a quality control tool for radiotherapy accelerators called StarTrack – have signed on February 15<sup>th</sup>, 2008 an Agreement (hereafter “Patent Co Ownership and Commercial License Agreement”) to define the respective rights and duties under the patent and to grant an exclusive license to IBA for the exploitation of the invention StarTrack described in Annex 1 to the Agreement;
- the Product StarTrack has obtained an European (EPO5447206.3) and International (PCT/BE2006/000085) Patent protection;
- these contracts provided that the parties after expiring of the planned time period would have jointly established the amount of annual contributions arising from the extension of the exclusive right to licenses required by IBA and the duration of the new extension of the right of exclusivity, taking account the alleged period of validity of commercial products;
- IBA, given the results arising from the commercialization of products called MatriXX and StarTrack, is interested in the temporal extension of exclusivity;
- INFN and DFS have obtained the consent of the INFN and DFS responsables of research who sign this Contract (hereafter “Contract”).

Therefore, in consideration of the mutual covenants and agreements contained herein, the parties, intending to be legally bound, hereby agree as follows:

#### Article 1

1.1 The Premises and the Annexes are integral part of this Contract.

#### Article 2

2.1 The Inventions called MatriXX and StarTrack, protected by the deposit of its Patents mentioned in the introduction, are hereby declared being owned jointly and equally by INFN, IBA and DFS.

2.2 The right to use the Patent for the product called StarTrack is granted without prejudice of the benefit of the MAESTRO PARTNERS foreseen in the MAESTRO contract. The parties will define together the rules to guarantee these rights.

2.3 IBA is committed to raising INFN and DFS from burdens related to the maintenance of such Patents, the costs incurred annually on the deadlines prescribed by law.

2.4 INFN and DFS grant to IBA an exclusive worldwide right and royalty to produce, commercialize and sell the Products according to the conditions further described in article 6

2.5 IBA grants to INFN and DFS a worldwide, non-exclusive and without royalty right to use the Products only within the limits described in art. 4.2.

#### Article 3

3.1 The present license is granted without territorial limits and for a period of time not determined as provided in the contracts in the introduction, except the loss of exclusivity right as described in art. 6.3.

#### Article 4

4.1 INFN and DFS during the exclusivity period of the Contract, as described in art. 6, does not grant any license to third parties who may have the same object or to use the products developed and described in Annexes A (MatriXX) and B (StarTrack). If DFS and INFN after the period of exclusivity will be willing to grant a nonexclusive license to third parties, that license will be subject to prior written consent of the IBA which approval may be refused only on reasonable grounds.

4.2 With regard to intellectual property rights of Authors on Products, INFN and DFS will use the results of research conducted under the joint collaboration exclusively for its own non-commercial institutional activities. Such use can be done in collaboration with public or private non-commercial corporations, national or international.

4.3 Neither party can assign or transfer this Contract without the prior approval of the other parties. IBA is authorized to grant sub-licenses to companies that are linked or belonging to its group: in this case, IBA pledges himself to give written communications to INFN and DFS.

4.4 Except as provided in subsection 4.3, IBA is not authorized to grant sub-licenses without the prior written consent of the INFN and DFS.

4.5 INFN e DFS will not guarantee the commercial exploitation of the Products. The risks arising from such commercial exploitation are exclusive to IBA.

#### Article 5

5.1 It is not subject to the terms of the present Contract the know-how different from what is described in Annexes A (MatriXX) and B (StarTrack) coming from improvements or upgrades of the research activity performed independently by INFN, IBA and DFS during or after the end of the activities described the agreements referred to in the introduction. The parties defer to successive agreements the legal and economical regulation for improvements that will be done together.

5.2 IBA engages to inform INFN and DFS of any change, modification or updating of Products not covered by article 5.1.

#### Article 6

6.1 IBA engages to annually pay to INFN and DFS, for a period of five years from July 19<sup>th</sup>, 2010, and independently from the actual sales of the Products, at INFN the total sum of € 20.000 (twenty thousand Euro, taxes excluded), and at DFS the total sum of € 20.000 (twenty thousand Euro, taxes excluded) as royalties. The payments will take place at the end of each year (July 19<sup>th</sup>, 2011 for the period 2010-2011, July 19<sup>th</sup>, 2012 for the period 2011-2012, July 19<sup>th</sup>, 2013 for the period 2012-2013, July 19<sup>th</sup>, 2014 for the period 2013-2014 and so on, till July 19<sup>th</sup>, 2015 for the period 2014-2015).

6.2 By the deadline for the expiration of this Contract, the parties will jointly decide the amount of the annual contribution arising from the extension of exclusive rights provided by the license of IBA and the length of the extension of exclusive rights, taking into account of the alleged period of validity of the commercial Products.

6.3 If the Parties fail to reach an agreement as required by article 6.2, each party will acquire a non-exclusive and no burden right of exploitation of the Products. In this case, the grant of a non-exclusive sublicense to any third party shall be communicated to the other party.

#### Article 7

7.1 As long as royalties remain due under this Contract, INFN and DFS, within twenty days from each annual expiry of this Contract, will issue an invoice for the amount of the royalties due by IBA for the coming year, which IBA will pay within the successive 30 days from the date of reception through bank transfer:

- for INFN:  
Unicredit S.p.A., Filiale di Frascati INFN n. 31213, Via Enrico Fermi n. 40, 00044 Frascati (RM) Italy  
IBAN: IT22Q0200839105000401277684, BIC SWIFT: UNCRITM1385
- for DFS:  
Banca Intesa San Paolo, I-10100 Torino (TO) Italy  
IBAN: IT15T0306901118100000395284, BIC: BCITITMM, SWIFT: BCITITMMB77.

#### Article 8

8.1 All the possible burdens related to the conclusion of this Contract are due by IBA.

#### Article 9

9.1 IBA will mention in a visible place on the Products or on its supporting documentation the fact that the each Product has been “developed in collaboration with *INFN and University of Torino – Italy*”

#### Article 10

10.1 IBA will be the sole responsible of the damages eventually caused by the construction, commercialization and use of the Products. IBA pledges himself not to involve INFN and DFS and keep INFN and DFS not liable to any request, action or claim for damage coming from third parties.

#### Article 11

11.1 INFN and DFS declare not to have knowledge of Patents that cover the Products, without guarantee that such Patents do not exist.

11.2 IBA will take all reasonable actions, also legal proceedings, in case of counterfeit of the Products, giving information to INFN and DFS, which will have a right to take part in the trial.

#### Article 12

12.1 IBA will bear the exclusive responsibility to obtain, prior to production or sale of any Product, at its own expense, any administrative authorization required for marketing of products in the countries where they are sold.

#### Article 13

13.1 The Contract will be rescinded in the event IBA violates article 9 and if such breach notified to IBA has not been appropriately remedied within the 30 days following the notification of the breach.

#### Article 14

14.1 In case of advanced withdrawal from the Contract by INFN and DFS due to IBA's breach of article 13, IBA will not commercialize any more the Products and engages to pay to INFN and DFS half of the royalties due for the remaining period of the Contract.

#### Article 15

15.1 Any communication between the three Parties will be done in written form (postal mail or e-mail) to:

for INFN

Dott. Giacomo Cuttone c/o Laboratori Nazionali del Sud INFN, Via S. Sofia n. 64, 95123 - Catania  
e-mail: [cuttone@lns.infn.it](mailto:cuttone@lns.infn.it);

Dott. Giuseppe Battistoni c/o Sezione di Milano INFN, Via Caloria n. 16, 20133 - Milano  
e-mail: [giuseppe.battistoni@mi.infn.it](mailto:giuseppe.battistoni@mi.infn.it)

for IBA

.....

for DFS

Roberto CIRIO [roberto.cirio@unito.it](mailto:roberto.cirio@unito.it)

#### Article 16

16.1 For matters not specifically provided in this Contract, the parties refer to contract of 18.7.2005 and 15.2.2008. No addition or amendment to this Contract shall be valid unless made in writing.

Art. 17

17.1 This Contract is governed by the Belgian law

Article 18

18.1 Any dispute arising from the interpretation or performance of this Contract shall be amicably settled by the legal representative of the Parties. In case of no solution, it will be settled by the Court of Brussels

.....

Chief Research Officer and Managing Director

date

for INFN

.....

President

date

for DFS

.....

Director

date