

**TRADEMARK LICENCE AGREEMENT**

This Trademark Licence Agreement is made as of ..... ,...., 200...., by and between

**XY S.p.A.** a corporation organised and existing under the laws of Italy and having its legal seat at ...., ..... (hereinafter referred to as "**LICENSOR**")  
of the first part

and

**XY.....**having its legal seat at .....(hereinafter referred to as "**LICENSEE**")  
of the second part

the LICENSOR and the LICENSEE are hereinafter also individually and/or collectively called "**Party/Parties**";

**Whereas**

- LICENSOR is the exclusive owner of the following trademark: ..... (hereinafter –**if are more than one: collectively-** referred to as the "**Trademark**"), in ..... (hereinafter referred to as the "**Territory**") used in relation to a pharmaceutical preparation containing the pharmaceutical active ingredient “.....” and the excipient “.....”;

- The Trademark is registered in the Territory under No. .... in the International Class ..... and has last been renewed for a period of ..... years from .....

- LICENSOR and LICENSEE had entered into a ..... agreement, dated ..... For a period of .... (...) years commencing from ..... [**Eventually and expiring on** .....] (hereinafter referred to as the "**..... Agreement**"), for the distribution of certain products of the LICENSOR in the Territory by the LICENSEE including the pharmaceutical product containing the pharmaceutical active ingredient “.....” and the excipient “.....”;

**VERSION A:**

- LICENSOR requested and LICENSEE accepted not to sell the product(s) (**oppure to supply the preparation/product**) manufactured by LICENSOR containing the pharmaceutical active ingredient(s) “.....” and marketed in the Territory by LICENSEE under the Trademark;

- LICENSEE requested and LICENSOR accepted to use the Trademark in the Territory for a new product(s) containing the same pharmaceutical active ingredient(s)

“.....” (hereinafter –**if more than one: collectively**- referred to as “Product”) in order to ..... (*NB explain the reason of the licence*)

**VERSION B, in alternative:**

On ..... the Parties executed an amendment agreement to amend the Distribution Agreement (the “**Amendment Agreement**”). In terms of the Amendment Agreement the aforesaid pharmaceutical preparation manufactured by the LICENSOR containing the pharmaceutical active ingredient “.....” and the excipient “.....” and marketed in the Territory by the LICENSEE under the Trademark was deleted from the list of products of the LICENSOR permitted to be promoted, marketed and sold by the LICENSEE in terms of the Distribution Agreement;

In consideration of the LICENSEE executing the Amendment Agreement, the LICENSOR at the request of the LICENSEE is willing to grant an exclusive non-transferable right and permission to the LICENSEE for the use of the Trademark in the Territory for a new pharmaceutical product containing the pharmaceutical active ingredients “.....” and the excipient “.....” (hereinafter referred to as the “**Product**”) in order to manufacture and sell the Product in the Territory subject to and on the terms and conditions set forth in this Agreement.

**NOW, THEREFORE THIS AGREEMENT WITNESSETH** and in consideration of the premises and the covenants and conditions herein contained, the Parties hereby mutually agree as follows:

- 1) The LICENSOR hereby grants to the LICENSEE an exclusive (**or** non exclusive) non-transferable right and permission to use the Trademark in respect of and solely in relation to the manufacture and sale of the Product in the Territory under the terms and conditions hereby agreed by and between both Parties. **Add if it is an exclusive licence:** Notwithstanding the foregoing, the LICENSOR shall have the right to itself use directly the Trademark in the Territory.
- 2) The LICENSEE will be allowed to use the Trademark in relation to the Product in the Territory on the following terms and conditions:
  - (a) **(Eventually):** The LICENSEE shall be responsible for the maintenance of all applicable standards of material and workmanship set by the LICENSOR, in relation to the manufacture of the Product. The LICENSEE shall, in compliance with all applicable laws, manufacture and package the Product directly or by granting exclusively to \_\_\_\_\_, only the right to manufacture and package the Product on behalf of the LICENSEE, maintaining in any case the exclusive right to sell the Product in the Territory; )
  - (b) The LICENSEE undertakes to sell only a high quality level Product and shall market the Product at its choice and expenses, ensuring at all times that nothing in the marketing activities such as advertising, packaging, promotional materials, indicates or can lead the consumer into the opinion that the Product is

manufactured or marked by the LICENSOR and/or under the LICENSOR's control;

- (c) **Eventually:** The minimum quality standard is set forth in Annex A; **In alternative** Technical requirements for the manufacture and packaging of the Product shall be in accordance with the LICENSOR's minimum quality standards as set forth in Annex A to this Agreement or as may be notified by the LICENSOR to the LICENSEE from time to time. The LICENSEE agrees to comply with all requirements and instructions, that the LICENSOR may prescribe, relating to the manufacture and packaging of the Product and techniques for analysis thereof. The LICENSEE further agrees to procure all materials necessary for the manufacture of the Product (including but not limited to raw materials and supplies) in accordance with the quality parameters, if any, notified by the LICENSOR;
- (d) The LICENSEE undertakes to manufacture the Product, directly or through ....., and/or to sell the Product of a high quality, in accordance with all applicable laws and rules in force in the Territory and on the terms and conditions that do not jeopardise the image of LICENSOR's Trademark.

Any breach of this Clause 2 shall constitute a material breach of this Agreement and shall give the LICENSOR the right to immediately terminate this Agreement and consequent upon such termination the LICENSEE shall immediately cease to use the Trademark and shall forthwith return to the LICENSOR all materials in its possession relating to the Trademark.

**(Eventual Clauses:**

...) The LICENSEE shall submit to the LICENSOR, if the LICENSOR so desires, the designs and samples of all packaging materials and all advertising and promotional materials bearing the Trademark for the approval of the LICENSOR prior to its use

...) If the LICENSOR so desires, the LICENSEE shall allow the LICENSOR or its authorised representatives at all reasonable times to enter the facilities, works, warehouses, or offices of the LICENSEE and of ..... to inspect materials, methods and standards in use in relation to the manufacture, packaging and storing of the Product and to ensure compliance by the LICENSEE of the terms and conditions of this Agreement.

3) The LICENSEE shall supply samples of the Product and packaging materials to the LICENSOR upon request from the LICENSOR.

4) The LICENSEE agrees that it will not knowingly sell or distribute the Product under the Trademark to any person who intends, or is likely, to sell or distribute or to make or authorise the use of or resale of the same in contravention of this Agreement or the applicable laws.

5) The LICENSEE agrees that it shall not use the Trademark other than in the manner provided herein. The LICENSEE expressly acknowledges and agrees that it is not

licensed by this Agreement to use the Trademark in any country or territory whatsoever, except in the Territory, or to sell or distribute or market the Product under the Trademark outside the Territory. All rights with respect to the Trademark not herein specifically granted to the LICENSEE are reserved by the LICENSOR.

6) The LICENSEE shall sell the Product in the Territory to its own customers at its own risk and liability. Therefore, the LICENSEE agrees to indemnify and hold the LICENSOR its officers, directors and employees free and harmless against any claims made by anyone in connection with the manufacture, promotion, use and sale of the Product and the use of the Trademark in the Territory.

7) The expenses for the marketing of the Product in the Territory (e.g. promotional and advertising materials or activities) shall be borne by the LICENSEE.

8) Unless terminated earlier in accordance with the provisions hereof, this Agreement shall be effective for a period of two (2) years commencing from the date first above written and, consequently, shall automatically terminate on ....., 200.....

**Opzionale** The Parties, at least four (4) months prior to such expiry, shall meet in order to discuss in good faith the opportunity of prolonging the period of validity of the Agreement (**eventually**: at new terms and conditions).

***In alternative***

Unless terminated earlier in accordance with the provisions hereof, this Agreement shall be effective for a period of one (1) year commencing from the date first above written and shall be renewable for a further period of one (1) year, except where either Party terminates this Agreement with a three (3) months prior written notice to the other Party.

9) Any Party shall be entitled at its option, to immediately terminate this Agreement on the happening of any of the following events:

- if the other Party is adjudged bankrupt, goes into liquidation or controlled administration or other bankruptcy proceedings, other than for the purpose of amalgamation or reconstruction, without prejudice to rights arising from any antecedent breach of any of the terms and conditions hereof;
- if the other Party breaches any one of the clauses of this Agreement and fails to remedy such breach within thirty (30) days from the date of receipt of a registered letter from such Party calling upon the other Party to remedy such breach.

Moreover, the LICENSOR has the right to immediately terminate this Agreement, if the use of the Trademark by the LICENSEE in relation to the Product constitutes an infringement of the rights or trademarks of any third party in the Territory. In such an event, the LICENSEE shall have no right to any reimbursement and/or liquidated damages against the LICENSOR. In such case, the LICENSEE shall have no right to any reimbursement and/or liquidated damages.

***In case the use of the trademark is granted without royalties payment, add also the following clause:***

This Agreement shall be automatically terminated upon the termination of the Distribution Agreement for whatsoever reason.

10) For granting the use of the Trademark the LICENSEE shall pay the LICENSOR, as royalties, the following rate of .....(..) on net sales of the Product within ninety (90) days after the end of each six months period, starting from the date of .....

Payments shall be transferred to the account of the LICENSOR or its nominee, at the Bank indicated by the LICENSOR or as the LICENSOR may otherwise instruct in writing from time to time.

It is agreed and understood that if the total amount of royalties to be paid in any six months period is lower than the following amount ..... (MINIMUM ROYALTY), the LICENSEE, in making the payments indicated in this Article, will increase the amounts effectively accrued so to reach the MINIMUM ROYALTY.

***Version A: between parties using euro currency:***

All payments shall be always made exclusively in EUR currency.

***Version B: if the parties agree to pay with a currency different from euro:***

It is agreed and understood that, subject to the LICENSOR's discretionary faculty, any and all remittance due in force of the present Agreement, can be made in EUR currency, calculated at the official exchange rate for the ***(inset the name of the agreed currency)***.

***Alternative clause:***

The LICENSEE shall not be required to pay any royalty to the LICENSOR for the exclusive non-transferable right and permission to use the Trademark in relation to the manufacture and sale of the Product in the Territory for the term of this Agreement granted by the LICENSOR to the LICENSEE in terms of this Agreement.

11) The LICENSOR shall maintain the registration of the Trademark in the Territory in its name and at its costs and shall take all steps including renewing the registration to keep it valid.

12) The LICENSEE acknowledges and accept the validity of the Trademark and further acknowledges that the LICENSOR has the exclusive proprietary ownership of said Trademark.

The LICENSEE shall not at any time do or cause to be done any act or thing, directly or indirectly, contesting or in any way impairing any part of the LICENSOR's rights in or to the Trademark and the goodwill symbolised thereby. The LICENSEE undertakes not to jeopardise the LICENSOR's rights in the Trademark by improper use of the Trademark.

13)The LICENSEE represents and warrants that it cannot derive any rights of its own from this Agreement. ***(eventually: The LICENSEE agrees that it will not in any manner represent that it has any ownership interest in or to the Trademark or to any registrations or applications for registration thereof. The LICENSEE hereby expressly waives any future rights or claims accruing or arising in the Trademark in favour of the LICENSEE***

by use thereof in any manner or form whatsoever. The LICENSEE shall not register or attempt to register the Trademark in its own name or that of any other person or entity unless specifically authorised in writing by the LICENSEE to do so. )

14) The LICENSEE shall not perform any act, which may cause direct or indirect violation, damage or discredit of the Trademark, nor register any name which could be confusingly similar to the Trademark or any other trademarks, trade names, or designs owned by the LICENSOR. In addition, the LICENSEE shall not use on or in connection with any goods any trade mark so nearly resembling the Trademark as to be likely to cause deception or confusion.

15) The LICENSEE shall promptly inform the LICENSOR of any imitations, infringements, suspected infringements or violation of rights in relation to the Trademark by third parties which may come to the LICENSEE's attention and upon such information the LICENSOR, at its sole discretion, shall decide whether and which actions shall be taken. The LICENSEE shall give the LICENSOR its full co-operation and assistance in the defence of its rights in relation to the Trademark. Any expenses incurred for legal proceedings in the defence of its rights in relation to the Trademark shall be borne by the LICENSOR.

In case the LICENSOR evaluates too expensive the defence of the Trademark, the LICENSEE, upon request, can be entitled by the LICENSOR to defend the Trademark at its own name and costs.

16) The relationship of the LICENSOR and the LICENSEE shall at all times be deemed to be of independent contractors. By virtue of this Agreement, neither Party shall be deemed to be the other Party's partner, joint venturer, legal representative or agent and therefore the LICENSOR and the LICENSEE shall have no power, express or implied, to legally represent the other or any authority to enter into contracts on each other's behalf. Furthermore, nothing in this Agreement shall be construed as qualifying LICENSEE's salesmen and collaborators as LICENSOR's employees or agents.

17) By signing this Agreement, the Parties give their mutual authorisation to let their own data be inserted in their respective database for the administrative, technical and accounting management of the Agreement itself. The Parties also allow each other to supply said data to third parties, to extent that such communication may be necessary for the fulfilment of the rights and obligations related to the execution of this Agreement.

The Parties also confirm as well to have been informed about their own rights in accordance with Art. 7 of the Italian D.Lgs No. 196 dated 30 June 2003 on the protection of the personal data, and particularly on the rights to ask the updating, correction or cancellation of them

18) This Agreement is governed, construed and interpreted in accordance with the substantive law of Switzerland.

The Parties will attempt to amicably settle any disputes which may arise in connection with this Agreement.

If a dispute between the Parties arising out of this Agreement cannot be settled by them through negotiations in good faith, such dispute shall be finally settled by a Panel of three (3) Arbitrators in Geneva (Switzerland) under the Rules of the International Chamber of Commerce. Each Party will appoint one (1) Arbitrator and the third Arbitrator, acting as a Chairman, shall be appointed by the two arbitrators so appointed or, in case of their disagreement, according to said Rules.

The language to be used shall be English.

The award to be rendered shall be final and conclusive and binding upon all the Parties. The Parties hereby exercise the right granted to them by Article 192 of the Swiss International Private law and waive their rights to file an appeal against the arbitral award pursuant to Article 190 of the Swiss Private International Law.

19) Neither Party shall be liable for a failure or delay in performance of any of the obligations hereunder due to force majeure such as wars, insurrections, strikes, acts of God, Governmental actions, controls or regulations, national emergency, or many other contingency beyond the control of such Party.

The Party affected by force majeure shall inform the other Party immediately.

The Party whose performance of obligations has been delayed by force majeure shall use its best efforts to overcome the effect of the force majeure as soon as possible. If the failure on the delay is longer then sixty (60) days, the other Party has the right to early terminate this Agreement.

20) The premises (**eventually**: and the Annex A) are an integrant part of this Agreement. This Agreement constitutes the entire agreement between the Parties and cancels and supersedes every and all previous agreement between the Parties concerning the right and permission to use the Trademark (**optional** with the only exception of .....).

21) All notices requests, demands, and other communication related to this Agreement shall be in writing and shall be deemed to have been duly given if personally delivered or sent by telefax and confirmed by registered letter to the following addresses:

if intended to the LICENSOR:

XY s.p.a.  
*Kind attention Mr.* .....  
.....,n.....  
.....  
.....  
Telefax: .....

if intended to the LICENSEE:

.....  
.....  
.....

.....

.....

Telefax:

or to the other addresses that each Party shall previously communicate in the future to the other Party in writing. Notices shall be effective when received at the address then in effect.

22) If one or more of the provisions hereof shall be void, invalid, illegal or unenforceable in any respect under any applicable law or decision, the validity, legality and enforceability of the remaining provisions herein contained shall not be affected or impaired in any way. Each Party shall, in any such event, execute such additional documents as the other Party may reasonably request in order to give valid, legal and enforceable effect to any provision hereof which is determined to be invalid, illegal or unenforceable.

23) No waiver by the LICENSOR of any breach or a series of breaches of this Agreement shall constitute a waiver of any subsequent breach or waiver of the terms and conditions of this Agreement.

24) This Agreement shall not be transferred or assigned, either totally or in part, by the LICENSEE, to any third party, without the prior written consent of the LICENSOR.

**IN WITNESS WHEREOF**, the Parties have caused this Agreement to be duly executed in two originals as of the date first above written.

**by LICENSEE**

**by XY**

\_\_\_\_\_

\_\_\_\_\_

Dr.....,

.....



Annex A  
To the Trademark Licence Agreement  
XY/.....  
made as of .....

Minimum quality standard  
(point 2)