



**Call for expressions of interest for the *acquisition of an exclusive licence right for the patent title "Detector, Three-Dimensional Direct Positron Imaging Unit, and Method to Estimate the Differential of the Radiation Dose Provided to Cancer Cells and Healthy Tissues During Hadrotherapy"***

**ART. 1 – PURPOSE**

1.1 The purpose of this Public Notice is to collect expressions of interest in the right to use, under an *exclusive licence*, the patent title "Detector, Three-Dimensional Direct Positron Imaging Unit, and Method to Estimate the Differential of the Radiation Dose Provided to Cancer Cells and Healthy Tissues During Hadrotherapy" (hereinafter referred to as "Technology").

1.2 It is hereby specified that the Technology is owned by the National Institute of Nuclear Physics and Princeton University (hereinafter referred to as the "Owners") and that, for the purposes of this Notice, an *exclusive licence* shall mean a *licence* agreement which grants the successful tenderer the right to use the Technology in a defined territorial area in return for payment of a fee, without the Owners being able to assign the licence to any other person or use the Technology for their own commercial purposes.

1.3 It is also specified that the submission of an expression of interest in the context of this Notice shall automatically entail the acceptance of the clauses of the Notice itself and, on the basis of the score obtained, shall determine the order in which the appropriate negotiations for an exclusive licence agreement shall be entered into with the Owners.

1.4 The Technology refers to a system comprising a detector and a 3D imaging unit for positrons, and a method for estimating the dose absorbed by healthy cells and tissues during Hadrotherapy treatment.

1.5 The Technology has been protected through the filing of:

- *Italian* priority application no. 102015000024439, filed on 16/06/2015;
- US Application 15/184,318 filed in 2016 and claiming priority of IT patent application

1.6 Those expressing interest will then be given the opportunity to have copies of the following supplementary documentation:

- under confidential obligation, confidential patent information;
- Scientific articles.

1.7 Interested parties may submit to the National Institute of Nuclear Physics an Expression of Interest for the acquisition of an exclusive licence right to the Technology, in accordance with the procedures detailed below.

**ART. 2 – REQUIREMENTS FOR SUBMITTING THE EXPRESSION OF INTEREST**

2.1 Expressions of interest for the acquisition of an exclusive right to licence the Technology may be submitted, in accordance with the criteria and terms set out in this Notice, by corporations, consortia of companies and other consortium entities and cooperative societies carrying on business activities in sectors related to the Technology and similar.





2.2 This Notice is not addressed to intermediary and brokerage organisations in the field of technology transfer and to entities whose interest in the acquisition of the licence of use is given by the intention to confer the Technology to so-called patent funds and portfolios, which are capable of creating dominant positions, or similar positions.

### ART. 3 – PRESENTATION

3.1 Interested parties should send their expressions of interest to:

the Istituto Nazionale di Fisica Nucleare - Servizio Trasferimento Tecnologico (National Institute of Nuclear Physics - Technology Transfer Service), under penalty of non-consideration, **within 15 (fifteen) day from the effective date of publication.**

3.2 The Expression of interest must contain the following subject: "Expression of interest in the right to use the patent title "Detector, Three-Dimensional Direct Positron Imaging Unit, and Method to Estimate the Differential of the Radiation Dose Provided to Cancer Cells and Healthy Tissues During Hadrotherapy" by means of an exclusive licence, and must be received by registered mail with return receipt or hand delivery to Central Administration - Via Enrico Fermi 54, Frascati (RM) - during the days and hours in which it is open, or by Certified Electronic Mail to the PEC address amm.ne.centrale@pec.infn.it.

3.3 The Expression of Interest, drawn up in accordance with Annex A, must contain the following elements and is to be considered a declaration in lieu of affidavit, made together with a photocopy of the undersigned's identity document, pursuant to Articles 38, 46, 47 of Presidential Decree no. 445/2000:

- Company name, registered office, tax code, VAT number, personal details of the person signing the contract, having powers of representation.
- Declaration that the company, its legal representative(s) and partner(s) are not subject to any of the obstacles laid down by current Italian anti-mafia legislation.
- Declaration by the undersigned that he/she is the legal representative of the company/entity and that he/she is empowered to bind the company.
- Declaration that the company is not in a state of liquidation, bankruptcy or arrangement with creditors.
- A description of the company's business, its markets, the products/services it offers and the reasons why it is interested in using the Technology, specifying any strategies for integrating the Technology into the company's current business and the pricing policies that will be implemented in relation to the Technology itself.

### ART. 4 – TECHNICAL INFORMATION MEETING





4.1 Interested parties may request an adversarial technical information meeting at the offices of the Central Administration - Via Enrico Fermi 54, Frascati (RM) , in order to acquire further information preparatory to participation in this notice.

4.2 The meeting may not involve the transfer of information considered confidential by the Owner.

4.3 The meeting can be arranged by sending an e-mail to amm.ne.centrale@pec.infn.it. The request must be made no later than 10 days before the deadline for submitting the expression of interest.

#### **ART. 5 – EVALUATION CRITERIA**

5.1 The expressions of interest received in the context of this notice shall be evaluated on the basis of the technically and economically most advantageous offer and shall provide for the conclusion of a licence agreement to be negotiated between the parties.

The criteria will be assessed on the basis of this breakdown:

- Technical criteria (maximum 70 points)
- Economic criteria (maximum 30 points)

#### Technical Criteria

Criterion 1 (0 to 70 points) Industrial exploitation of the patent includes an assessment of the proposed strategy for the development and exploitation of the patent and of the "reputational" type elements. This assessment will include:

- a. the definition of the choices of innovation and technological enhancement according to the exploitation of the patent within the products and/or services; this refers to any development, prototyping, industrialisation, production and marketing activity using the patent;
- b. documented technical expertise in the field of medical imaging techniques, with particular reference to the PET procedure, for which the patent is most advantageously applied;
- c. commitment to collaborative development with public research bodies in compliance with the provisions of the European Union Communication (2014/C 198/01) "Framework for State aid for Research and Development and Innovation"; in particular, commitment to the sharing of intellectual property rights accrued in the execution of collaborations; the presentation of a proposal for a collaborative research agreement, to be conducted together with the Owners, on topics related to Technology will be positively evaluated.
- d. Reputational / social responsibility elements related to the use of the patent in industrial processes and products;
- e. The definition of the sector/field of application of the patent of interest;
- f. An assessment of the consistency of the Technology with the company's current activity and proposed business model.

#### Economic Criteria

Criterion 2 (0 to 20 points): Fee (fixed amount) to be paid in total within 2 years from the conclusion of the licence agreement and which will have as its "minimum base" the payment of the total amount of





the patenting costs incurred. The "minimum base" amounts, at the date of publication of this notice, to EUR 12'500,00 (twelve and half thousand euro).

Criterion 3 (from 0 to 10 points) Consideration (variable amount - royalties) at the conclusion of the licensing contract which will consist of an annual royalty proposal to be applied to the turnover generated by the commercialisation of the patent (the % of royalties and the duration of the contract will be assessed).

5.2 In the event of a tie, preference shall be given to the fact that the tenderers have a registered office or operational headquarters or undertake to open an operational headquarters in Italy, dedicated to the collaborative activity referred to in point c. within 120 days of the date of notification of the award of the contract.

5.3 In the event of equal points, the Owners will ask the interested parties to submit an improved offer. If the improved offers are also of equal evaluation, the Owners shall proceed by drawing lots to identify the competitor with whom to commence negotiations.

5.4 It is specified that the following shall be borne by the *licensee* all the expenses for the management and maintenance of the Technology in the various States designated and constituting the territorial scope of reference for the exclusivity of the licence, from the date of the signing of the exclusive licence agreement and for the entire duration thereof.

#### **ART. 6 – QUESTIONS AND CLARIFICATIONS**

6.1 Questions of a technical-procedural nature, on the content, method and on the Notice and documentation, must be received by e-mail at [amm.ne.centrale@pec.infn.it](mailto:amm.ne.centrale@pec.infn.it) by no later than 10 days before the deadline for submitting the expressions of interest.

6.2 No reply will be guaranteed to questions received after the deadline.

6.3 The questions must be formulated exclusively in Italian.

#### **ART. 7 – SINGLE PERSON IN CHARGE OF THE PROCEDURE**

7.1 The person in charge of the procedure is Ilaria Giammarioli, Head of the Technology Transfer Service - Research Services Directorate - tel. +39 06/94032488 - email [ilaria.giammarioli@Inf.infn.it](mailto:ilaria.giammarioli@Inf.infn.it).

The General Director

Nando Minnella

ags

