

LICENSE AGREEMENT

This License Agreement (“Agreement”), dated on this _____ day of _____, 20__ (the “Effective Date”) is entered into between _____ (“Licensee”) located at _____ and _____ (“Licensor”) located at _____, for the purpose of setting forth the exclusive terms and conditions by which the Licensor desires to grant Licensee with certain licenses as defined herein.

Definitions.

- a. **Licensed Patents** is defined as _____ U.S Patent Application[s], Serial Number[s] _____, filed _____, (ADDITIONAL APPLICATIONS) (“Applications”) and (i) all divisionals, continuations and continuation-in-part (excluding new matter and claims containing new matter) applications that claim priority to any of the Applications; (ii) any foreign application corresponding to any Application or application identified in (i); and (iii) each patent that issues or reissues from any Application or application identified in (i) and (ii) including [fill in any issued patents].
- b. **Technology** is defined as any information: (i) created prior to the Effective Date; (ii) owned by _____; (iii) not infringing any pending or issued claim in the Licensed Patents; and (iv) necessary to practice inventions claimed in patents and/or patent applications included in the Licensed Patents.
- c. **Licensed Product** is defined as any product that if manufactured, used, sold, offered for sale, or imported would constitute, but for the license granted Licensee under this Agreement, direct infringement, induced infringement and/or contributory infringement of any pending or issued claim of the Licensed Patents.
- d. **Field of Use** is defined as _____.
- e. **Territory** _____ is _____ defined _____ as _____ (geographic scope of the license).
- f. **Net Sales** is defined as the gross amount of all sales or leases of Licensed Products by Licensee, Affiliates, or sublicensees to any customer LESS:
 - i. discounts and rebates actually granted
 - ii. excise and sales taxes imposed on the License Products and actually paid;
 - iii. import, export and custom duties imposed on the License Products and actually paid; and
 - iv. freight, transit and insurance charges actually paid.
- g. **Additional** _____ **Terms:**

In consideration of the mutual obligations specified in this Contract, the parties, intending to be legally bound hereby, agree to the following:

License Grant. _____ hereby grants to Licensee a [] exclusive [] nonexclusive license under the Licensed Patents to make, have made for it, use and sell Licensed Products (in the above-defined Field of Use) in the Territory during the Term of this Agreement, and the

right to use Technology to make and have made for it the Licensed Products (in the above-defined Field of Use) in the Territory during the Term of this Agreement.

Sublicensing. Licensee has the right to grant Sublicense Agreements under the Licensed Patents and to use Technology consistent with the terms of this Agreement subject to the following:

(i) A Sublicense Agreement shall not exceed the scope and rights granted Licensee hereunder. Sublicensee must agree in writing to be bound by the applicable terms and conditions of the Agreement and shall indicate that Licensor is a third party beneficiary of the Sublicense Agreement.

(ii) Licensee shall deliver to Licensor a true, complete, and correct copy of each Sublicense Agreement granted by Licensee, Affiliate or Sublicensee, and any modification or termination thereof, within _____ days following the applicable execution, modification, or termination of such Sublicense Agreement.

(iii) Licensee shall collect and guarantee payment of all payments due, directly or indirectly, to Licensor from Sublicensees and summarize and deliver all reports due, directly or indirectly, to Licensor from Sublicensees.

(iv) All rights and licenses of Sublicensees shall terminate upon termination of the Agreement.

Reservation of Rights. _____ reserves the right to (i) use technology covered by any pending or issued claim of the Licensed Patents and/or Technology (collectively, “Licensed _____ Technology”) for _____

_____ and other related purposes.

Fees & Royalties.

Upfront Fee. Licensee shall pay to _____ a non-creditable, non-refundable upfront license royalty of \$ _____ upon execution of the Agreement.

Maintenance Fees. Beginning _____ and each _____ thereafter, Licensee will pay _____ a non-refundable maintenance fee of \$ _____/(Maintenance Fees paid by Licensee are creditable against Earned Royalty payments).

Minimum Royalty. Licensee shall pay Licensor \$ _____ every (quarter/year/ _____) as a Minimum Royalty Payment. Licensee will pay Licensor on or before the (quarterly/annual) payment deadline an additional amount equal to the difference between the Minimum Royalty Payment and the actual royalties paid to Licensor if the actual royalties paid to Licensor are less than the Minimum Royalty Payment.

Earned Royalty. Licensee shall pay an earned royalty of ___% on Net Sales of Licensed Products by Licensee and/or its Affiliates.

[] **Sublicensing Fee.** Licensee will pay Licensor ____% of all sublicense fees received by Licensee from sublicenses that are not earned royalties.

Payment.

Payments must be made to the Licensor by credit card, money order, check, or any other approved method of payment accepted by the Service Provider.

Payments must be mailed to:

Late Payments. A late charge of \$_____ per month will be added to any payments not made on time.

Records. Licensee will keep and will require its Affiliates and Sublicensees to keep, accurate and correct records of all Licensed Products manufactured, used, and sold, and Sublicense fees received under this Agreement for at least _____ years from the end of the quarter the record documents.

Other:

Duration. Unless terminated earlier as provided herein, the term of the Agreement will commence on the Effective Date and continue until the latest date of expiration of an issued Licensed Patent, if applicable.

Termination. This Agreement may be terminated at any time by mutual agreement by the Parties.

This Agreement shall be effective on the date hereof and shall continue until terminated by either party upon ____ business days written notice.

Licensor may terminate this agreement if Licensee is (i) delinquent on payments or in any required report, (ii) is not making commercially reasonable efforts to commercialize Licensed Products, if applicable, (iii) is a breach of any provision of this Agreement, and (iii) provides a false report.

Termination under this provision shall take effect ____ days after written notice by _____ unless the Licensee cures the identified issue on or prior to the final day of that ____ day period.

Bankruptcy. The Agreement shall automatically terminate if the Licensee files for bankruptcy.

Marking. Prior to the issuance of any Licensed Patent, Licensee will mark all Licensed Products with the words "Patent Pending." Upon issuance of any Licensed Patent, Licensee will mark all Licensed Products with the number of any issued Licensed Patent in accordance with each country's patent marking laws including Title 35 of the U.S. Code.

Notice. All notices or requests required or contemplated by this Agreement shall be in writing and such notice shall be delivered as follows:

(a) if from the Licensor to the Licensee shall be hand-delivered or mailed to:

or such other address as the Licensor shall specify in a written notice to the Licensee

(b) if from the Licensee to the Licensor, shall be hand-delivered or mailed to:

or such other address as the Licensee shall specify in a written notice to the Licensor.

Licensor Representations and Warranties. Except for the rights, if any, of the Government

as set forth in this Agreement, _____ represents and warrants to Licensee that to the knowledge of _____ designated office for technology commercialization:

- (i) _____ is the owner of the entire right, title and interest in and to the Licensed Patents;
- (ii) _____ has the sole right to file Applications within the definition of Licensed Patents;
- (iii) _____ has the right to grant licenses hereunder, and
- (iv) _____ has not knowingly granted and will not knowingly grant licenses or other rights to the Licensed Patents that are in conflict with the terms and conditions in the Agreement.

Licensor's DISCLAIMER OF WARRANTIES. EXCEPT AS SPECIFICALLY SET FORTH IN THIS AGREEMENT, THE LICENSEE UNDERSTANDS AND AGREES THAT _____ MAKES NO REPRESENTATIONS OR WARRANTIES OF ANY KIND, EXPRESS OR IMPLIED, INCLUDING, WITHOUT LIMITATION, AS TO THE LICENSED PRODUCTS OR LICENSED SERVICES, OR AS TO THE OPERABILITY OR FITNESS FOR ANY USE OR PARTICULAR PURPOSE, MERCHANTABILITY, SAFETY, EFFICACY, APPROVABILITY BY REGULATORY AUTHORITIES, TIME AND COST OF DEVELOPMENT, PATENTABILITY, NON-INFRINGEMENT, AND/OR BREADTH OF PATENT RIGHTS. _____ MAKES NO REPRESENTATION AS TO WHETHER ANY CLAIM OR PATENT WITHIN PATENT RIGHTS IS VALID, OR AS TO WHETHER THERE ARE ANY PATENTS NOW HELD, OR WHICH WILL BE HELD, BY OTHERS OR BY _____ THAT MIGHT BE REQUIRED FOR USE OF PATENT RIGHTS IN FIELD OF USE. NOTHING IN THE AGREEMENT WILL BE CONSTRUED AS CONFERRING BY IMPLICATION, ESTOPPEL, OR OTHERWISE, ANY LICENSE OR RIGHTS TO ANY PATENTS OR TECHNOLOGY OF _____ OTHER THAN THE PATENT RIGHTS, WHETHER SUCH PATENTS ARE DOMINANT OR SUBORDINATE

TO THE PATENT RIGHTS, OR THE TECHNOLOGY RIGHTS SPECIFICALLY DESCRIBED HEREIN.

Licensee's Representations and Warranties. Licensee represents and warrants that it has full corporate power and authority to enter into this Agreement, this Agreement constitutes the binding legal obligation of the Licensee, and execution and performance of this Agreement by Licensee will not violate or conflict with any other agreement to which Licensee is a party or by which it is bound or with any law, rule or regulation applicable to Licensee.

Indemnification. Licensee agrees to indemnify, hold harmless and defend _____, and its trustees officers, employees, students and agents ("Indemnitees") against any and all claims, suits, losses, damage, costs, fees and expenses resulting from or arising out of (1) the exercise of any rights granted Licensee under Agreement; (2) the breach of this Agreement by Licensee; (3) the exercise of any rights granted under a sublicense pursuant to the Agreement; or (4) the breach of any sublicense granted pursuant to the Agreement. This indemnification shall include, without limitation, any product liability claim.

Insurance. Prior to any Licensed Product being used or sold (including for the purpose of obtaining Regulatory Approval), and prior to any Licensed Service being performed by Licensee, an Affiliate, or by a Sublicensee, Licensee shall, at its sole cost and expense, procure and maintain comprehensive general liability insurance, including product liability insurance, that (a) provides minimum limits of liability of at least \$ _____ and (b) includes all Indemnitees as additional insureds. Upon request by Licensor, Licensee shall provide Licensor with written evidence of such insurance. Additionally, Licensee shall provide Licensor with written notice of at least sixty ____ days prior to Licensee canceling, not renewing, or materially changing such insurance.

Limitation of Liability. IN NO EVENT SHALL _____, INVENTORS, OFFICERS, EMPLOYEES, STUDENTS, TRUSTEES, AGENTS OR AFFILIATED ENTERPRISES, BE LIABLE FOR ANY INDIRECT, SPECIAL, CONSEQUENTIAL, INCIDENTAL, EXEMPLARY, OR PUNITIVE DAMAGES (INCLUDING, WITHOUT LIMITATION, DAMAGES FOR LOSS OF PROFITS OR REVENUE) ARISING OUT OF OR IN CONNECTION WITH THE AGREEMENT OR ITS SUBJECT MATTER, REGARDLESS OF WHETHER ANY SUCH PARTY KNOWS OR SHOULD KNOW OF THE POSSIBILITY OF SUCH DAMAGES.

Dispute Resolution. Parties to this Agreement shall first attempt to settle any dispute through good-faith negotiation. If the dispute cannot be settled between the parties via negotiation, either party may initiate mediation or binding arbitration in the State of _____.

If the parties do not wish to mediate or arbitrate the dispute and litigation is necessary, this Agreement will be interpreted based on the laws of the State of _____, without regard to the conflict of law provisions of such state. The Parties agree the dispute will be resolved in a court of competent jurisdiction in the State of _____.

Governing Law. This Agreement shall be governed in all respects by the laws of the State of _____ without regard to the conflict of law provisions of such state. This Agreement shall be binding upon the successors and assigns of the respective parties.

Legal Fees. Should a dispute between the named Parties arise that lead to legal action, the prevailing Party shall be entitled to any reasonable legal fees, including, but not limited to attorneys' fees.

Further Assurances. Upon a party's reasonable request, the other party shall, at its sole cost and expense, execute and deliver all such further documents and instruments, and take all such further acts, necessary to give full effect to this Agreement.

No Assignment. This Agreement shall be binding upon the undersigned and their respective heirs, representatives, successors and permitted assigns. This Agreement may not be assigned by either party without the prior written consent of the other party.

Severability. If any term or provision of this Agreement is invalid, illegal, or unenforceable in any jurisdiction, such invalidity, illegality, or unenforceability shall not affect any other term or provision of this Agreement or invalidate or render unenforceable such term or provision in any other jurisdiction.

No Waiver. No waiver of or failure to act upon any of the provisions of this Agreement or any right or remedy arising under this Agreement shall be deemed or shall constitute a waiver of any other provisions, rights or remedies (whether similar or dissimilar).

Amendment. This Agreement may be amended only by a writing signed by all of the Parties hereto.

Counterparts. This Agreement may be executed in counterparts, each of which shall be deemed an original, but all of which together shall be deemed to be one and the same agreement. A signed copy of this Agreement delivered by facsimile, email, or other means of electronic transmission shall be deemed to have the same legal effect as delivery of an original signed copy of this Agreement.

Electronic Signatures. This Agreement and related documents entered into in connection with this Agreement are signed when a party's signature is delivered electronically, and these signatures must be treated in all respects as having the same force and effect as original signatures.

Captions for Convenience. All captions herein are for convenience or reference only and do not constitute part of this Agreement and shall not be deemed to limit or otherwise affect any of the provisions hereof.

Entire Agreement. This Agreement constitutes the sole and entire agreement of the Parties regarding the subject matter contained herein, and supersedes all prior and contemporaneous understandings, agreements, representations, and warranties, both written and oral, regarding such subject matter. This Agreement may only be amended, modified, or supplemented by an agreement in writing signed by each Party hereto.

[Signatures on Following Page]

IN WITNESS WHEREOF, the undersigned have executed this License Agreement effective as of the _____ day of _____, 20__ (the "*Effective Date*").

Dated: _____

Dated: _____

Licensor's Signature

Licensee's Signature

Licensor's Printed Name or Entity

Licensee's Printed Name or Entity

Licensor's Contact Information:

Licensee's Contact Information:

Address: _____

Address: _____

Phone Number: _____

Phone Number: _____

Email Address: _____

Email Address: _____