

NON-EXCLUSIVE PATENT LICENSE AGREEMENT
(hereinafter "License") No. AGMT-XXXX

BETWEEN

U.S. DEPARTMENT OF ENERGY
NATIONAL ENERGY TECHNOLOGY LABORATORY (hereinafter "NETL")

AND

PARTICIPANT

This Agreement is by and between the NETL (hereinafter "LICENSOR") and Participant (hereinafter "LICENSEE"), collectively referred to as "Parties" and individually as "Party".

ADDRESS OF LICENSEE: Insert Address

LICENSED INVENTION: U.S. Patent No. Patent No., issued Issue Date, titled Patent Title, and any patents stemming therefrom.

SCOPE OF LICENSE: Non-exclusive license for manufacture, use, sale, commercial evaluation, research in the United States of America (hereinafter "U.S.>").

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LICENSE TERM: Full term of any issued patent based on the LICENSED INVENTION.

WITNESSETH:

WHEREAS: LICENSOR is the owner of the above-identified LICENSED INVENTION.

WHEREAS: LICENSEE desires to obtain a non-exclusive license in the above-identified LICENSED INVENTION.

WHEREAS: The licensing of said LICENSED INVENTION under the terms provided herein is determined to be in the public interest and is in accordance with the regulations on Licensing of Government-Owned Inventions (37 C.F.R. 404) and DEPARTMENT OF ENERGY Patent Licensing Regulations (10 C.F.R. 781), as promulgated under the authority of Section 208 of Pub. L. 96-517 (35 U.S.C. 208), with royalties and other income received by the Federal Government to be distributed in accordance with the Stevenson Wydler Act as amended (15 U.S.C. 3710c).

NOW, THEREFORE, in consideration of the foregoing premises and of the mutual covenants and obligations hereinafter contained, and other good and valuable consideration, the Parties hereto agree as follows:

1. LICENSOR hereby grants to LICENSEE and LICENSEE hereby accepts, subject to the terms and conditions herein recited, a non-exclusive license to practice the LICENSED INVENTION as specified herein for the period of this License.
2. LICENSEE agrees to carry out the plan for [development and/or marketing, research, commercial evaluation] of the LICENSED INVENTION, as outlined in or submitted with the LICENSEE's Application for License, as may be amended from time to time with the concurrence of LICENSOR, to bring the LICENSED INVENTION to practical application within [TBD], and thereafter to continue to make the benefits of this invention reasonably accessible to the public.
3. This License may extend to subsidiaries of the LICENSEE, but it is not assignable or otherwise transferable without approval of LICENSOR in writing, except to the successor of that part of LICENSEE's business to which the LICENSED INVENTION pertains.
4. Sublicenses under this License may not be granted without the approval of LICENSOR. LICENSEE shall promptly furnish LICENSOR with a copy of any proposed sublicense, and if in a foreign language, an English text thereof. Any sublicense shall not be effective until approval is secured from LICENSOR in writing. A sublicense shall make reference to this License, including the rights retained by the Federal Government.
5. LICENSEE agrees that for use and sale in the United States any products embodying the LICENSED INVENTION or produced through the use of the LICENSED INVENTION will be manufactured substantially in the United States.
6. LICENSEE shall submit periodic written reports annually within 30 days following the anniversary date of this License, and when specifically requested by the LICENSOR, on its efforts to bring the LICENSED INVENTION to a point of practical application, to use the LICENSED INVENTION in research, to commercially evaluate the LICENSED INVENTION, with particular reference to the development and marketing plan submitted, as outlined in or submitted with the LICENSEE's Application for License, and the extent to which the LICENSEE thereafter continues to make the benefits of the invention reasonably accessible to the public.
7. ROYALTY PROVISIONS: LICENSEE agrees to pay to LICENSOR:
 - a. An initial fee of [TBD], payable within 30 days following the execution of this License.
 - b. A minimum royalty of [TBD], payable within 30 days following the anniversary date of this License, or [TBD] percent of the gross sales price of product sold commercially, i.e. for use other than by or on behalf of the Federal Government that incorporates any allowed product claims of LICENSED INVENTION or is produced by the method of any allowed method claims of LICENSED INVENTION, payable within 30 days

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following the anniversary date of this License, whichever is greater. Gross sales price shall mean actual invoiced sales price free of transfer and bank fees and free of any taxes or other deductions.

- c. TBD of any sublicense revenue received from sublicensing of the LICENSED INVENTION due within 30 days following the receipt of such sublicense revenue by LICENSEE.

8. LICENSEE shall pay to LICENSOR any royalty payments due and payable under this License. Checks shall be made payable to the U.S. Department of Energy and forwarded to:

U.S. Dept. of Energy
National Energy Technology Laboratory
Accounting
MS 921-227
626 Cochrans Mill Road
Pittsburgh, PA 15236-0940

LICENSEE shall keep true books of account containing an accurate record of all data necessary for the computation of any royalty fees payable under this License, and shall render to LICENSOR annually, within thirty days of the anniversary date of this License, an accurate statement of performance under this License, whether or not royalties are payable under this License. Such a statement shall be in writing, showing in reasonable detail the identification of licensed products incorporating any part of the LICENSED INVENTION sold by LICENSEE. LICENSEE shall from time to time permit the LICENSOR, by its authorized representative, to examine the books of account of LICENSEE to such an extent as may be reasonably necessary for LICENSOR to determine the accuracy of any such statement.

9. LICENSEE shall promptly report to LICENSOR any change in mailing address, name, or company affiliation during the period of this License, and LICENSEE shall promptly report discontinuance of making the benefits of the LICENSED INVENTION reasonably accessible to the public.
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12. LICENSEE shall indemnify and hold harmless LICENSOR from any and all losses, damages, costs and expenses that result from or arise in connection with (i) LICENSEE's use of the LICENSED INVENTION or LICENSEE's use or sale of products, processes or services incorporating or made by use of the LICENSED INVENTION, or (ii) third party claims based on the actions or omissions of LICENSEE.
13. Nothing contained in this License shall be interpreted to give to LICENSEE any rights with respect to any invention other than the LICENSED INVENTION.
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15. This License may be terminated by LICENSOR in whole or in part, (a) if LICENSOR determines that LICENSEE is not executing the plan submitted with its Application for License, and that LICENSEE has not otherwise demonstrated to the satisfaction of LICENSOR that it has taken, or can be expected to take within the time period specified in paragraph 2, effective steps to achieve practical application of the invention and to continue thereafter to make the benefits of the invention reasonably accessible to the public, (b) for failure to make any payments or periodic reports required by this License, (c) for willfully making a false statement or willful omission of a material fact in the Application for License which resulted in this License or in any required report, (d) for substantial breach of any covenant or agreement contained herein, or (e) if LICENSOR determines that such action is necessary to meet requirements for public use as specified by Federal regulations issued after the date of this License, and such requirements are not reasonably satisfied by the LICENSEE.
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17. The points of contact for the LICENSEE and LICENSOR are as follows:

LICENSOR

Technical Contact:

Name

Department of Energy
626 Cochran's Mill Road
P.O. Box 10940
Pittsburgh, PA 15236-0940
Phone: 412.386.XXXX
Email: EMAIL

Commented [S4]: Optional, use only if license is for a provisional or non-provisional patent application.

OR

Department of Energy
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OR

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LICENSEE

Technical Contact:

Name
Address
Phone:
Email:

Administrative Contact:

Name
Address
Phone:
Email:

Any communications shall be deemed made if mailed by postage prepaid first-class U.S. Mail addressed to the point of contact of the receiving Party as of the day of receipt of such communication by the addressee or on the date given if by verified facsimile or on the date given by if by electronic mail.

18. LICENSEE has a right to appeal, in accordance with procedures specified in 10 CFR 781, any decision concerning the modification or termination, in whole or in part, of this License.
19. LICENSEE may terminate this License, after the first or any subsequent anniversary date of this License, upon not less than sixty (60) days prior written notice to the LICENSOR. Paragraphs 10, 11, and 12 shall survive any termination.
20. This License may be signed in one or more counterparts, each of which shall be deemed an original, and all of which taken together shall be deemed one and the same instrument.
21. This License is effective on the date affixed hereto by the Party last signing this License.

FOR Department of Energy:

FOR Participant:

BY: _____
Sean I. Plasynski, Ph.D.
Director (Acting), NETL

BY: _____
NAME
TITLE

DATE: _____

DATE: _____