

LIMITED NONEXCLUSIVE ROYALTY FREE COMMERCIAL PATENT LICENSE AGREEMENT

This limited nonexclusive commercial patent license agreement (“Agreement”) is between UT-Battelle, LLC (“Licensor”), a Tennessee non-profit limited liability company managing and operating the Oak Ridge National Laboratory under its Prime Contract No. DE-AC05-00OR22725 with the United States Department of Energy (“DOE”), an agency of the United States Government and having an address at One Bethel Valley Road, Oak Ridge, Tennessee 37831-6196, and _____ (“Licensee”), organized under the laws of the State of _____ having an address at _____, hereinafter referred to singly as the “Party” or jointly as the “Parties.”

ARTICLE 1 BACKGROUND

- 1.1 Licensor has rights in certain patents and patent applications.
- 1.2 Licensee desires, and Licensor is willing to grant, a limited exclusive commercial license under such patents and patent applications in certain fields of use.
- 1.3 This Agreement specifically includes Exhibit A, LICENSED PATENTS and Exhibit C, DEVELOPMENT AND COMMERCIALIZATION PLAN, which are attached.
- 1.4 Except as provided in ARTICLE 7, the license will run through the Term of this Agreement.

ARTICLE 2 DEFINITIONS

As used in this Agreement, the following terms have the meanings set forth below unless otherwise expressly defined in this Agreement (such definitions will be equally applicable to both the singular and plural forms of the defined terms):

- 2.1 “Dispose,” “Dispose of,” or “Disposition” means the sale, lease or other transfer of Licensed Products.

- 2.2 “Effective Date” means the date of the signature of the last Party to sign this Agreement.
- 2.3 “Field of Use” is for the purpose of alleviating the COVID-19 pandemic and minimizing the impact of the public health crisis.
- 2.4 “Government” means the Federal Government of the United States of America.
- 2.5 “Government’s License Rights” means the Government’s nonexclusive, nontransferable, irrevocable, paid-up license to practice or to have practiced for or on behalf of the United States the Licensed Patents throughout the world, pursuant to 35 USC 202(c)(4).
- 2.6 “Gross Sales” means the U.S. Dollar value of all consideration to which Licensee is entitled for the Disposition of Licensed Products by Licensee. In the event Licensee does not ultimately Dispose of Licensed Products, or Licensee Disposes of Licensed Products for less than their fair market value, the fair market value of such Licensed Products (as if there had been a Disposition to a third party) will be included in Gross Sales. In the event that Licensed Products are sold in currencies other than U.S. Dollars, Gross Sales will be calculated by Licensee in accordance with U.S. generally accepted accounting principles, consistently applied. Gross Sales in currencies other than U.S. Dollars will be converted into U.S. Dollars using the average official rate of exchange for such currencies published in the Wall Street Journal, Eastern Edition. If an exchange rate for any particular currency is not published in the Wall Street Journal, the rate of exchange to be used for such currency will be determined using average conversion rates published by the Bank of America or such conversion rates that generally are accepted in the industry.
- 2.7 “Licensed Patents” means those patents and patent applications listed in Exhibit A, LICENSED PATENTS and any patents issuing at any time from such applications and any divisionals, continuations, continuations-in-part (excluding those claims in such applications claiming new subject matter) thereof, and all reissues, reexaminations, substitutes, or extensions of any such patents. The term “Licensed Patents” does not include any patent found to be unenforceable or invalid by a final adjudication by a court of competent jurisdiction.
- 2.8 “Licensed Products” means any device, apparatus, product, compound, composition of matter, product-by-process, kit, system, material, or algorithm the manufacture, use, sale,

offer for sale, or import of which, but for the license granted to Licensee in this Agreement, would constitute infringement or contribute to the infringement of a claim of a Licensed Patent.

2.9 “Term” means, in each country of the Territory, a period of twelve (12) months from the Effective Date, , subject to a final adjudication of invalidity, unenforceability, or the extinguishment of the Licensed Patents, continuing until expiration of the last to expire Licensed Patents.

2.10 “Territory” is defined in Exhibit B.

ARTICLE 3 GRANT

3.1 Subject to the terms and conditions of this Agreement, Licensor grants to Licensee, and Licensee accepts for the Term of this Agreement, a limited nonexclusive commercial license under the Licensed Patents to make, have made, use, offer to sell, Dispose of, and import (subject to 5.1) the Licensed Products in the Field of Use. This grant specifically excludes the right to sublicense the Licensed Patents.

3.2 Licensee’s commercial license is subject to, and will in no way restrict, the Government’s License Rights.

3.3 Licensee’s commercial license is subject to, and will in no way restrict, the march-in rights of the Government pursuant to 35 USC 203.

3.4 Licensor retains the right to grant other nonexclusive licenses to the Licensed Patents within the Field of Use.

3.5 Licensor retains the right to grant other exclusive and nonexclusive licenses to the Licensed Patents outside the Field of Use.

3.6 Licensee acknowledges that no license is granted or implied under, and expressly agrees not to make, have made, use, offer to sell, sell, Dispose of, or import the Licensed Products outside the Field of Use. Licensee agrees that making, having made, using, offering to sell, Disposing of, and importing the Licensed Products outside the Field of Use is a breach of this Agreement and is an infringement of the Licensed Patents.

**ARTICLE 4
OBLIGATIONS**

- 4.1 In consideration for the license, Licensee agrees to comply with the provisions of this Agreement, to satisfy the requirements of the Commercialization Plan set forth in Exhibit C, DEVELOPMENT AND COMMERCIALIZATION PLAN. Satisfaction of the Commercialization Plan requirements are material to this Agreement. Licensee commits to disseminating the Licensed Products as widely and quickly as possible during the Term of this Agreement.
- 4.2 Licensee will owe no Royalties on Dispositions of Licensed Products during the Term of this Agreement.

**ARTICLE 5
CONDITIONS OF GRANT**

- 5.1 Licensee agrees that any Licensed Products for use or Disposed of in the United States will be substantially manufactured in the United States.
- 5.2 Licensee will mark all Licensed Products in accordance with the statutes of the United States (see 35 USC 287) or markings and notices as may be required by any law or regulation of any jurisdiction in the Territory or as Licensor may reasonably specify for purposes of compliance with any such law or regulation. Any such marking may indicate that Licensee has a license from Licensor. Otherwise, Licensee is prohibited from using Licensor's name, the name "Oak Ridge National Laboratory," or "ORNL" in any such marking or any advertising, promotion or commercialization of Licensed Products without written approval of Licensor.
- 5.3 The rights and licenses granted by Licensor in this Agreement are personal to Licensee and may not be assigned or otherwise transferred in whole or in part except by merger or acquisition as may be otherwise permitted by the terms of this Agreement. If Licensee merges or is otherwise acquired by another entity, including without limitation subsidiaries of Licensee, which entity acquires substantially all of Licensee's business assets that relate to this Agreement, then Licensee may assign its rights and obligations under this Agreement to the merging or acquiring entity, effective on the date the merger or acquisition becomes effective, provided that all the following requirements have been satisfied in advance of the merger or acquisition:

- 5.3.1 Licensee notifies Licensor within forty-five (45) calendar days prior to said merger or acquisition;
 - 5.3.2 Licensor approves said assignment of rights and obligations under this Agreement. Licensor's approval, which is subject to the Prime Contract and DOE policy considerations relating to technology transfer involving foreign owned or controlled companies, will not be unreasonably withheld;
 - 5.3.3 The merging or acquiring entity has agreed to comply with the terms and conditions of this Agreement; and
 - 5.3.4 If the merging or acquiring entity is subject to ownership or control by a non-U.S. entity, the Licensee has obtained DOE approval of the assignment and will comply with the DOE's foreign ownership and control justification criteria then in effect.
- 5.4 Licensee will not sell, assign, transfer, mortgage, pledge, or hypothecate its rights under this Agreement in whole or in part or delegate any of its duties or obligations under this Agreement for any reason, including as security to obtain financing, without the prior written approval of Licensor. The Parties agree that any such action by Licensee without such approval by Licensor will be an automatic, material and incurable breach of the Agreement resulting in termination of the Agreement effective as of the attempt by Licensee to carry out such action.
- 5.5 Licensee hereby agrees that, in the event Licensee, by its own actions, or the action of any of its shareholders or creditors, files or has filed against it a case under the Bankruptcy Code of 1978, as previously or hereafter amended, Licensor will be entitled to relief from the automatic stay of Section 362 of Title 11 of the U.S. Code, as amended, to pursue any rights and remedies available to it under this Agreement. Licensee hereby waives the benefits of such automatic stay and consents and agrees to raise no objection to such relief.

ARTICLE 6
RECORDS AND REPORTS PAYMENTS

- 6.1 Licensee will provide Licensor a written report no later than thirty (30) days after the end of the Term of this Agreement containing the following:

- a. the total Gross Sales received by Licensee from the making, use, or Disposition of Licensed Products itemized by domestic and/or foreign rights;
- b. progress made towards achieving the Development and Commercialization milestones defined in Exhibit C, DEVELOPMENT AND COMMERCIALIZATION PLAN; and
- c. the occurrence of any event, other than the making, use, or Disposition of Licensed Products.

**ARTICLE 7
BREACH AND TERMINATION**

- 7.1 This Agreement may be terminated by either Party for any material breach of the Agreement by the other Party. Such termination will be effective sixty (60) days after written notice specifying the breach to the other Party. If the specified breach is cured before the effective date of termination, the Agreement will not be terminated.
- 7.2 In the event Licensee fails to satisfy the requirements of the Commercialization Plan in Exhibit C, DEVELOPMENT AND COMMERCIALIZATION PLAN, Licensors may, at its sole discretion, terminate this Agreement with respect to specified Licensed Patents.
- 7.3 In addition to termination, in the event of a material breach by Licensee, Licensors may pursue any rights and remedies available to it by law.
- 7.4 This Agreement will not be terminated for any breach that is the result of an act of God, acts or omissions of any U.S. government or agency thereof, compliance with rules, regulations, or orders of any U.S. governmental authority or any office, department, agency, or instrumentality thereof, fire, storm, flood, earthquake, accident, acts of the public enemy or terrorism, war, rebellion, insurrection, riot, sabotage, invasion, quarantine, restriction, transportation embargoes, or failures or delays in transportation.
- 7.5 Any termination of this Agreement will not impact Licensors' ownership interest, if any, in Licensee.
- 7.6 The rights and remedies granted herein, and any other rights or remedies which the Parties may have, either at law or in equity, are cumulative and not exclusive of others.

- 7.7 Neither Party will be relieved of any obligation or liability under this Agreement arising from any act or omission committed prior to the termination date. Upon termination, Licensee will execute any documents necessary to achieve the transfer to Licensor of all rights to which Licensor may be entitled under this Agreement.
- 7.8 Licensor reserves the right to terminate this Agreement immediately if:
- a. Licensee fails to notify Licensor of an acquisition as required by 5.3.1, or
 - b. Licensee contests the validity or enforceability of any Licensed Patent, or requests reexamination of any Licensed Patent.
- 7.9 Licensee will not grant to any third party any right to the Licensed Patents after termination of the license hereunder.
- 7.10 If at the time of termination Licensee is not in material breach of this Agreement, Licensee will be entitled to assemble any units of the Licensed Product for which components have been purchased or ordered and sell to any third parties any Licensed Product, including such assembled Licensed Product, remaining in its inventory, provided the total actual cost of such purchased or ordered components is over two hundred thousand U.S. dollars (\$200,000).
- 7.11 Expiration or termination of this Agreement will be without prejudice to any rights that may have accrued to the benefit of a Party prior to such expiration or termination.

ARTICLE 8 INFRINGEMENT

- 8.1 Licensee will promptly notify Licensor in writing of any suspected infringement of the Licensed Patents in the Field of Use, and each Party will inform the other within a reasonable time of receipt of any available evidence of such suspected infringement.
- 8.2 The sole right to institute a suit for infringement rests with Licensor, and Licensor will retain all the proceeds thereof.
- 8.3 Licensee agrees to cooperate with Licensor in all aspects of such infringement suit, including having any of Licensee's employees testify when requested by Licensor, and making available any records, papers, information, specimens, and the like.

- 8.4 Neither Licensee nor any affiliate of Licensee will foster or encourage any infringement of the Licensed Patents by any subsidiary or affiliate. If Licensee or any of its affiliates will engage in such conduct, Licensor will have the right to deem such conduct a material breach of this Agreement, which breach will be a basis of termination of this Agreement and of the license granted herein, pursuant to ARTICLE 7 of this Agreement.

ARTICLE 9 REPRESENTATIONS AND WARRANTIES

- 9.1 Licensee represents and warrants that it will not export any technical information (or the direct product thereof) or tangible items furnished to Licensee, either directly or indirectly by Licensor in the grant of license to the Licensed Patents, from the United States of America, directly or indirectly without first complying with all requirements of the Export Administration Regulations, including the requirement for obtaining any export license, if applicable.
- 9.2 Licensee will indemnify, defend and hold harmless Licensor, DOE, their respective members, officers, directors, agents, employees, and persons acting on their behalf, (“Indemnitees”) from liability involving the violation of such export regulations, either directly or indirectly, by Licensee.
- 9.3 Licensee acknowledges it may be subject to criminal liability under U.S. laws for Licensee’s failure to obtain any required export license.
- 9.4 Licensee agrees to indemnify and hold harmless Indemnitees from and against any and all liabilities, penalties, fines, forfeitures, claims, demands, causes of action, damages, and costs and expenses (including the costs of defense, prosecution and/or settlement, including, but not limited to, attorney’s fees), caused by, arising out of or related to, in whole or in part, Licensee’s exercise of rights under this Agreement or any other action or inaction relating to Licensed Patents or Licensed Products, including, but not limited to, claims or demands of product liability, personal injury, death, damage to property or violation of any laws or regulations, except for those arising from Licensor’s gross negligence.

9.5 Nothing in this Agreement will be deemed to be a representation or warranty by Licensor or the U.S. Government of the validity of the Licensed Patents or the accuracy, safety, or usefulness for any purpose, of any technical information made available by Licensor.

**ARTICLE 10
DISCLAIMERS**

10.1 NEITHER LICENSOR, DOE, NOR PERSONS ACTING ON THEIR BEHALF WILL BE RESPONSIBLE FOR ANY INJURY TO OR DEATH OF PERSONS OR OTHER LIVING THINGS OR DAMAGE TO OR DESTRUCTION OF PROPERTY OR FOR ANY OTHER LOSS, DAMAGE, OR INJURY OF ANY KIND WHATSOEVER RESULTING FROM LICENSOR'S GRANT OF LICENSE TO LICENSEE UNDER THIS AGREEMENT.

10.2 ALL LICENSED PATENTS, INFORMATION, MATERIALS OR SERVICES FURNISHED UNDER OR WITH THIS AGREEMENT ("DELIVERABLES") ARE PROVIDED ON AN "AS IS" BASIS. NEITHER LICENSOR, DOE, NOR PERSONS ACTING ON THEIR BEHALF MAKE ANY REPRESENTATIONS, OR EXTEND ANY WARRANTIES, EITHER EXPRESS OR IMPLIED: (a) WITH RESPECT TO THE VALIDITY OF THE LICENSED PATENTS; (b) WITH RESPECT TO THE MERCHANTABILITY, ACCURACY, COMPLETENESS, FITNESS FOR USE OR USEFULNESS OF ANY DELIVERABLES; (c) THAT THE USE OF ANY SUCH DELIVERABLES WILL NOT INFRINGE PRIVATELY OWNED RIGHTS; (d) THAT THE DELIVERABLES WILL NOT RESULT IN INJURY OR DAMAGE WHEN USED FOR ANY PURPOSE; (e) THAT THE DELIVERABLES WILL ACCOMPLISH THE INTENDED RESULTS OR ARE SAFE FOR ANY PURPOSE, INCLUDING THE INTENDED OR PARTICULAR PURPOSE; OR (f) WITH RESPECT TO USE, OR DISPOSITION BY LICENSEE OR ITS VENDEES OR OTHER TRANSFEREES OF LICENSED PRODUCTS INCORPORATING OR MADE BY USE OF (1) INVENTIONS LICENSED UNDER THIS AGREEMENT OR (2) INFORMATION, IF ANY, FURNISHED UNDER THE AGREEMENT. FURTHERMORE, LICENSOR AND DOE HEREBY SPECIFICALLY DISCLAIM ANY AND ALL WARRANTIES, EXPRESS OR IMPLIED, FOR ANY

LICENSED PRODUCTS RESULTING FROM LICENSOR’S GRANT OF LICENSE HEREUNDER. IT IS AGREED THAT NEITHER LICENSOR NOR DOE WILL BE LIABLE FOR CONSEQUENTIAL, SPECIAL, OR INCIDENTAL DAMAGES IN ANY EVENT. LICENSEE WILL MAKE NO WARRANTY, EXPRESS OR IMPLIED, ON BEHALF OF LICENSOR OR THE DOE.

10.3 Nothing in this Agreement will be construed as

- a. an obligation of the Licensor to bring or prosecute actions or suits against third parties for infringement (except to the extent and in the circumstances stated in ARTICLE 8); or
- b. an obligation of the Licensor to furnish any manufacturing or technical information or technical assistance, or
- c. conferring a right to use in advertising, publicity, or otherwise any trademark or name of Licensor (except to the extent stated in 5.2); or
- d. granting by implication, estoppel, or otherwise, any licenses or rights under patents of Licensor other than Licensed Patents, regardless of whether such other patents are dominant of or subordinate to any Licensed Patents.

**ARTICLE 11
GENERAL**

11.1 All notices and reports will be addressed to the Parties as follows:

If to Licensor:

Accounting Administration, Technology Transfer
UT-Battelle, LLC
One Bethel Valley Road
Oak Ridge, Tennessee 37831-6196

Facsimile: (865) 574-4150
Phone: (865) 241-2353
Email: collinssm1@ornl.gov

If to Licensee:

Facsimile: _____
Phone: _____
Email: _____

- 11.2 Any notice, report or any other communication required to be given will be in writing and delivered either: (a) personally, (b) by express, registered or certified first-class mail, or (c) by commercial courier.
- 11.3 The failure of either Party to enforce a provision of this Agreement or to exercise any right or remedy will not be a waiver of such provision or of such rights or remedies or the right of the Parties thereafter to enforce each and every provision, right or remedy.
- 11.4 This Agreement may be amended or modified only by a written instrument signed by both Parties.
- 11.5 The determination by a court of competent jurisdiction that any part, term, or provision of this Agreement is illegal or unenforceable, will not affect the validity of the remaining provisions of this Agreement.
- 11.6 Licensor may assign this Agreement and all rights, duties and obligations hereunder, to DOE or a successor contractor to Licensor, as may be required under its Prime Contract with DOE.
- 11.7 This Agreement will be construed according to the laws of the State of Tennessee and the United States of America and in the English language. Any action brought to enforce any provision or obligation hereunder will be brought in the Federal District Court for the Eastern District of Tennessee. However, if jurisdiction is not found in Federal Court, actions will be brought in Tennessee in Knox, Roane, or Anderson County Court.
- 11.8 This Agreement is solely for the benefit of the Parties, represents the entire and integrated agreement between the Parties, and supersedes all prior negotiations, representations, and agreements, either written or oral. This Agreement, and each and every provision thereof, is for the exclusive benefit of Licensor and Licensee and not for the benefit of any third party, except to the extent expressly provided in the Agreement.
- 11.9 This Agreement may be signed in counterparts, each of which will be deemed to be an original, but all of which, taken together, will constitute one and the same instrument.

IN WITNESS WHEREOF, each of the Parties hereto has caused this Agreement to be executed in duplicate originals by its duly authorized officers or representatives.

UT-BATTELLE, LLC

By: _____

Name: Michael J Paulus

Title: Director, Technology Transfer

Date: _____

LICENSEE

By: _____

Name: _____

Title: _____

Date: _____

EXHIBIT A: LICENSED PATENTS

Invention Disclosure No.	Country	Title	Inventors	IP Owner	Ser. No./Pat. No.	Filing/Issue Date
				UT-Battelle		
				UT-Battelle		
				UT-Battelle		

Licensee certifies that it is a _____ entity as defined in 37 CFR 1.27.

INITIALS

UT-Battelle: _____

Date: _____

Licensee: _____

Date: _____

EXHIBIT B: DEVELOPMENT AND COMMERCIALIZATION PLAN

Licensee agrees to invest in the development of technology and market for Licensed Products by committing Licensee's resources, at a minimum, to the following requirements:

Deliverable	Due Date
Written Report on the efforts during the Term of the Agreement for Licensee commitment to disseminating the Licensed Products as widely and quickly as possible.	Six (6) months after the Effective Date
Written Report that provides an update on the development of a Licensed Product and any Gross Sales for the Disposition of the Licensed Product.	Twelve (12) months after the Effective Date

NOTICE

This Exhibit contains commercial information that is BUSINESS SENSITIVE and the Parties hereby agree not to use or disclose this Exhibit to any third party without the advance written approval of the other Party, except: (1) to those necessary to enable the Parties to perform under this Agreement; (2) as may be required by the UT-Battelle Prime Contract with the DOE under the same restrictions as set forth herein; or (3) in event of breach of any provision of this Agreement by either Party, to those deemed necessary by the non-breaching Party to enforce the non-breaching Party's rights under the Agreement.

INITIALS

UT-Battelle: _____

Date: _____

Licensee: _____

Date: _____