

UNITED STATES DEPARTMENT OF ENERGY  
ALBANY RESEARCH CENTER  
EXCLUSIVE PATENT LICENSE AGREEMENT

This Agreement made this \_\_\_\_\_ day of \_\_\_\_\_ 2004, by and between the United States of America, as represented by the United States Department of Energy, Albany Research Center (hereinafter called "LICENSOR"), and \_\_\_\_\_ (hereinafter called "LICENSEE").

ADDRESS OF LICENSEE:

LICENSED INVENTION(S):

SCOPE OF LICENSE:

LICENSE TERMINATION DATE:

WITNESSETH:

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

WHEREAS: LICENSEE desires to obtain an exclusive license in the above-identified LICENSED INVENTION(S).

WHEREAS: The licensing of said LICENSED INVENTION(S) under the terms provided herein is determined to be in the public interest and is in accordance with the policy of the regulations on licensing of government-owned inventions, 37 C.F.R. Part 404, and DEPARTMENT OF ENERGY Patent Licensing Regulations, Title 10 C.F.R. Part 781, as promulgated under the authority of Section 208 of Pub. L. 96-517 (35 U.S.C. § 208).

WHEREAS: The interests of the Federal Government and the public will best be served by the proposed license, in view of the LICENSEE'S intentions, plans, and ability to bring the invention(s) to practical application. WHEREAS: The desired practical application has not been achieved, and is not likely expeditiously to be achieved, under any nonexclusive license which has been granted, or which may be granted, on the LICENSED INVENTION(S).

WHEREAS: Exclusive licensing is a reasonable and necessary incentive to call forth the investment of risk capital and expenditures to bring the LICENSED INVENTION(S) to practical application.

WHEREAS: The proposed terms and scope of exclusivity are not greater than reasonably necessary to provide the incentive for bringing the invention(s) to practical application.

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, an exclusive license to practice the LICENSED INVENTION(S) as specified herein for the period of this license.

2. LICENSEE agrees to carry out its plan for development and/or marketing of the invention and thereafter to continue to make the benefits of the LICENSED INVENTION(S) reasonably accessible to the public.

3. The license may extend to subsidiaries of the LICENSEE, but is not assignable without approval of LICENSOR in writing, except to the successor of that part of LICENSEE'S business to which the invention(s) pertain.

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 the license, including the rights retained by the Government.

5. LICENSEE agrees that, for use and sale of the LICENSED INVENTION(S) in the United States, any products embodying the LICENSED INVENTION(S) or produced through the use of the invention(s) will be manufactured substantially in the United States.

6. LICENSEE shall submit periodic written reports, annually within 30 days of the anniversary date of this license, and when specifically requested by the LICENSOR, on its efforts to bring the LICENSED INVENTION(S) to a point of practical application, with particular reference to the development and marketing plan submitted, and the extent to which the LICENSEE thereafter continues to make the benefits of the invention(s) reasonably accessible to the public.

#### 7. ROYALTY PROVISIONS:

8. If royalty provisions are included, LICENSEE shall pay to LICENSOR, at the time of execution of the license, and within thirty (30) days after each anniversary date of the license, any royalty payments due and payable under the license. Checks shall be made payable to the U.S. Department of Energy, and forwarded to the Office of Research Development, U.S. Dept. of Energy, Albany Research Center, 1450 Queen Avenue SW, Albany, OR 97321. 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 the license, whether or not royalties are payable under the license. Such a statement shall be in writing, showing in reasonable detail the identification of licensed devices manufactured or sold in any licensed country by LICENSEE. The statement shall include the invoiced sales price of the licensed devices and the computation of the license fees due and payable. 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. The license shall be subject to the irrevocable, royalty-free right of the Government of the United States to practice and have practiced the invention(s) on behalf of the United States and on behalf of any foreign government or international organization under any existing or future treaty or agreement with the United States.

10. LICENSOR reserves the right to require LICENSEE to grant sublicenses to responsible applicants, on reasonable terms, when necessary to fulfill health or safety needs.

11. 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 his making the benefits of this LICENSED INVENTION(S) reasonably accessible to the public.

12. LICENSOR makes no warranty or representation as to the validity of any licensed patent(s) or patent application(s) or that the exercise of this license will not result in the infringement of any patent(s), nor shall LICENSOR assume any liability whatsoever resulting from the exercise of this license.

13. LICENSOR makes no representations, extends no warranties of any kind, either express or implied, and assumes no responsibilities whatever with respect to manufacture, use, sale, or other disposition by LICENSEE, or its vendees or transferees, of products incorporating or made by use of LICENSED INVENTION(S).

14. The grant of this license or anything related thereto shall not be construed to confer on any person any immunity from or defenses under the antitrust laws or from a charge of patent misuse, and the acquisition and use of rights pursuant to this license shall not be immunized from the operation of State or Federal law by reason of the source of the grant.

15. Nothing contained in this license shall be interpreted to give to LICENSEE any rights with respect to any invention(s) other than the LICENSED INVENTION(S).

16. If the license involves application(s) for Letters Patent, LICENSOR makes no representation or warranty that Letters Patent will issue on such patent application(s).

17. This license may be terminated by LICENSOR in whole or in part, (a) if DOE determines that LICENSEE is not executing the plan submitted with its request for license, and that LICENSEE has not otherwise demonstrated to the satisfaction of DOE that it has taken, or can be expected to take within a reasonable time, effective steps to achieve practical application of the invention(s) and to continue thereafter to make the benefits of the invention(s) 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 license application which resulted in this license or in any required report, (d) for substantial breach of any covenant or agreement contained herein, or (e) if DOE determines that such action is necessary to meet requirements for public use as specified by Federal regulations issued after the date of the license, and such requirements are not reasonably satisfied by the LICENSEE.

18. Before modifying or terminating this license for any cause, LICENSOR shall furnish LICENSEE, and to any sublicensee of record, a written notice of LICENSOR'S intention to modify or terminate the license, with reasons therefor, and LICENSEE shall be allowed thirty (30) days from the date of the mailing of such notice to remedy any breach of any term or

condition referred to in the notice, or to show cause why the license should not be modified or terminated.

19. It shall be sufficient giving of any notice or other communication in writing by a Party to this license to the other Party, if the Party desiring to give such notice or other communication shall deposit a copy of such notice or communication in the Post Office for transmission by registered or certified mail in an envelope properly addressed to the address set forth herein, or at such other address furnished as specified herein. The date of such notice or other communication shall be construed to be the date on which said copy was deposited in the Post Office in an envelope properly addressed and mailed, as aforesaid. The Post Office receipt showing the deposit of such envelope and the date of such deposit shall be prima facie evidence of these facts.

20. LICENSEE has a right to appeal, in accordance with procedures specified in 10 C.F.R. 781, any decision concerning the modification or termination, in whole or in part, of this license.

21. 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.

22. LICENSEE shall have the right to sue, at its own expense, infringers of the patent(s) licensed hereunder. LICENSEE agrees to notify LICENSOR at the instigation of any such litigation, and to keep LICENSOR informed of its progress. LICENSEE may join LICENSOR, upon LICENSOR'S consent, as a Party complainant in such suit, but without expense to LICENSOR, and LICENSEE shall pay all costs that may be rendered against LICENSOR in such suit. LICENSOR shall also have an absolute right to intervene in any such suit at its own expense.

IN WITNESS WHEREOF, the Parties have executed this Agreement as of the date and year first written above.

U.S. DEPARTMENT OF ENERGY:  
BY:

LICENSEE:  
BY:

\_\_\_\_\_  
George J. Dooley, III  
Research Director  
Albany Research Center

\_\_\_\_\_  
Name  
Title

WITNESS:

WITNESS:

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