

## **NONEXCLUSIVE RESEARCH AND DEVELOPMENT PATENT LICENSE AND OPTION AGREEMENT**

This nonexclusive research and development 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 \_\_\_\_\_, a \_\_\_\_\_ (list state) (list type of organization, e.g., Corporation, LLC, Partnership, etc.) having an address at \_\_\_\_\_ (“Licensee”), 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, an limited nonexclusive research and development license under such patents and patent applications for the purpose of research and development in anticipation of future business opportunities.
- 1.3 Licensee further desires, and Licensor is willing to grant, an option to negotiate an nonexclusive Field of Use commercial license under such patents and patent applications.
- 1.4 This Agreement specifically includes Exhibit A, LICENSED PATENTS, Exhibit B, CONSIDERATION, and Exhibit C, RESEARCH & DEVELOPMENT PLAN, which are attached.
- 1.5 Except as provided in ARTICLE 5, 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 “Combination Product(s)” will mean a composition containing at least one (1) Licensed Product in a mixture or combination with at least one (1) mineral, vitamin and/or other nutrient other than a Licensed Product. For the avoidance of doubt, Combination Products do not include a composition whose components (excluding inactive ingredients, excipients and coating compositions) consist solely of Licensed Products.
- 2.2 “Dispose,” “Dispose of,” or “Disposition” means the sale, lease, or any other transfer of Licensed Products including use in one or more Combination Products.
- 2.3 “Effective Date” means the date of the signature of the last Party to sign this Agreement.
- 2.4 “Field of Use” is defined in Exhibit B, CONSIDERATION.
- 2.5 “Government” means the Federal Government of the United States of America including any agency thereof.
- 2.6 “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).
- 2.7 “Licensed Patents” means those patent(s) and patent application(s) listed in Exhibit A, LICENSED PATENTS, and any patents issuing at any time from such application(s) and any divisional(s), continuation(s), continuation(s)-in-part (excluding those claims in such application(s) claiming new subject matter) thereof, all reissues, reexaminations, substitutes, or extensions of any such patent(s). 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

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Agreement, would constitute infringement or contribute to the infringement of a claim of a Licensed Patent. Licensed Products also includes any services that infringe a claim of a Licensed Patent (“Licensed Services”).

- 2.9 “Patent Costs” means the verifiable costs related to the preparation, filing, prosecution, issuance, and maintenance of Licensed Patents.
- 2.10 “Potential Actions” means any contract, patent, or other intellectual property dispute between Licensor, Licensee, or their affiliates or Sublicensees filed with a court or administrative agency prior to or after the Term or expiration of the Agreement in connection with the Parties development and commercialization of technologies covered by the Licensed Patents.
- 2.11 “Term” means, in each country of the Territory, the period of time starting on the Effective Date, subject to a final adjudication of invalidity, unenforceability, or the extinguishment of the Licensed Patents, continuing until six (6) months from Effective Date.
- 2.12 “Territory” is defined in Exhibit B, CONSIDERATION.

### **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 non-commercial research and development license under the Licensed Patents to make and use the Licensed Products in the Field of Use. This grant specifically excludes the right to sublicense the Licensed Patents.
- 3.2 Licensee’s research and development license is subject to, and will in no way restrict, the Government’s License Rights.
- 3.3 Licensor retains the right to grant (i) other nonexclusive research and development licenses to academics, researcher institutions, and nonprofits within the Field of Use or (ii) nonexclusive commercial or research and development licenses to the Licensed Patents within the Field of Use.

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- 3.4 Licensors retain the right to grant (i) other exclusive or nonexclusive research and development licenses to the Licensed Patents outside the Field of Use and (ii) exclusive or nonexclusive commercial licenses to the Licensed Patents outside the Field of Use.
- 3.5 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 or Licensed Services outside the Field of Use.
- 3.6 During the Term, Licensee has the option to negotiate, for reasonable compensation, a nonexclusive commercial license under the Licensed Patents to make, have made, use, offer to sell, sell, and Dispose of (subject to the conditions of that commercial license) the Licensed Products or Licensed Services in the Field of Use. The commercial license will include the requirements that Licensee shall agree that any Licensed Products or any products embodying or produced through the use of any Licensed Patent will be substantially manufactured in the United States unless the Licensee can show to the satisfaction of DOE that it is not commercially feasible and DOE grants written approval of a waiver to this requirement. In the event DOE were to agree to foreign manufacture, there will be a requirement that the U.S. Government's support of the technology be recognized in some appropriate manner, e.g., alternative binding commitments to provide an overall net benefit to the U.S. economy. In the event that the Licensee or other such entity receiving rights in the Licensed Patents undergoes a change in ownership amounting to a controlling interest, in the commercial license, the Licensee or other such entity receiving rights will ensure continual compliance with the requirements of this requirement and will inform Licensors, in writing, of the change in ownership within six (6) months of the change. In the commercial license, the Licensors and any approved successor assignee will convey to DOE, upon written request from DOE, title to any LICENSED PATENTS, upon a breach of this requirement.

#### **ARTICLE 4 CONSIDERATION AND FINANCIAL OBLIGATIONS**

- 4.1 In consideration for the license during the Term, Licensee agrees to comply with all the provisions of this Agreement and to pay to Licensors a fixed fee ("License Fee") at the

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time and in the amount specified in Exhibit B, CONSIDERATION, which will be nonrefundable.

- 4.2 All payments will be made to Licensor in U.S. dollars by ACH transfer in accordance with the following ACH instructions, unless and until written notice is provided by Licensor of a change in the ACH instructions:

|                             |                  |
|-----------------------------|------------------|
| Bank Name:                  | Truist           |
| ABA Routing Transit Number: | 021052053        |
| Account Name:               | UT-Battelle, LLC |
| Account Number:             | 62640765         |
| Type of Account:            | Checking         |

- 4.3 In the event that Licensee fails to make any payment due to Licensor within the time period prescribed for such payment under this Agreement, then the unpaid or overdue amount will bear interest at the rate of one and one-half percent (1.5%) per month from the date when payment was due until payment in full, with interest, is made. In addition, Licensee agrees to reimburse Licensor for any costs or expenses, including attorney's fees, incurred by Licensor in collection of such overdue payments.

## **ARTICLE 5 BREACH AND TERMINATION**

- 5.1 This Agreement will automatically terminate at the end of the Term unless earlier terminated herein.
- 5.2 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.
- 5.3 In the event Licensee either (a) fails to pay the License Fee or (b) fails to satisfy the requirements of the Commercialization Plan in Exhibit C, DEVELOPMENT AND COMMERCIALIZATION PLAN, Licensor may, at its sole discretion, terminate this Agreement with respect to specified Licensed Patents. There will be no reduction in any of the payments due from Licensee.

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- 5.4 In addition to termination, in the event of a material breach by Licensee, Licensor may pursue any rights and remedies available to it by law.
- 5.5 This Agreement will not be terminated for any breach that is the result of an act of God, acts or omissions of the U.S. government or any 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.
- 5.6 Any termination of this Agreement will not impact Licensor's ownership interest, if any, in Licensee.
- 5.7 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.
- 5.8 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.
- 5.9 Licensee may terminate this Agreement for any reason if Licensee provides Licensor with sixty (60) calendar days prior notice of its intent to terminate and pays Licensor all Patent Costs owed at the time of termination, if applicable, and all other fees.
- 5.10 This Agreement will terminate automatically if Licensee contests the validity or enforceability of any Licensed Patent or requests reexamination of any Licensed Patent.
- 5.11 The Parties agree that Licensee will not sell, assign, transfer, mortgage, pledge, or hypothecate its rights under this Agreement or its rights 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 and 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.

- 5.12 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. Notwithstanding anything to the contrary, ARTICLES 4, 5, and 8 will survive termination and expiration of this Agreement.

## **ARTICLE 6 REPRESENTATIONS AND WARRANTIES**

- 6.1 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.
- 6.2 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.
- 6.3 Licensee acknowledges it may be subject to criminal liability under U.S. laws for Licensee’s failure to obtain any required export license.
- 6.4 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.
- 6.5 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 7  
DISCLAIMERS**

- 7.1 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.**
- 7.2 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.**

- 7.3 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; or
  - b. an obligation of the Licensor to defend the Licensed Patents during any post-grant proceeding or reexamination; or
  - c. an obligation of the Licensor to furnish any manufacturing or technical information or technical assistance, or
  - d. conferring a right to use in advertising, publicity, or otherwise any trademark or name of Licensor; or
  - e. 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; or
  - f. an obligation of Licensor to file patent applications or fully prosecute or maintain any active patents or patent applications identified in Exhibit A, or to provide any further communication about these activities with Licensee.

**ARTICLE 8  
GENERAL**

8.1 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: LicenseAdmin@ornl.gov

If to Licensee:

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

Facsimile: (XXX) XXX-XXXX  
Phone: (XXX) XXX-XXXX  
Email: email address

- 8.2 All stock certificates, if any, will be sent to the address for notices.
- 8.3 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; (c) email according to Section 8.1; or (d) by commercial courier.
- 8.4 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.
- 8.5 This Agreement may be amended or modified only by a written instrument signed by both Parties. Notwithstanding any provision herein, the express terms of the Agreement control and cannot be modified or waived or changed by later conduct including usage and trade, course of dealing or conduct, and/or course of performance. This provision cannot be rescinded or varied by oral agreement between the Licensee and Licensor.
- 8.6 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.
- 8.7 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.
- 8.8 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. The Parties agree that all Potential Actions arising under U.S. law relating to patent infringement, invalidity, contract, or arising out of or under this Agreement filed during the Term or within six (6) years after termination or expiration of the Agreement will be filed in the United States District Court of the Eastern District of Tennessee and that neither Party will contest personal jurisdiction or venue in the Eastern District of Tennessee and neither Party will seek to transfer the Potential Actions on the ground of *forum non conveniens*. If jurisdiction is not found in the United States District Court for the Eastern District of Tennessee, for any reason, all Potential Actions will be brought in Tennessee in Knoxville, Roane, or Anderson

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County Court, and neither Party will contest personal jurisdiction or venue, and neither Party will seek to transfer the Potential Actions on the ground of *forum non conveniens*.

- 8.9 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.
- 8.10 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.

**ARTICLE 9  
OFFER**

The offer to execute this Agreement will expire if this Agreement is not signed by Licensee and returned to Licensor on or before \_\_\_\_\_.

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

UT-BATTELLE, LLC

By: \_\_\_\_\_

Name: Jennifer T Caldwell

Title: Director, Technology Transfer

Date: \_\_\_\_\_

**LICENSEE**

By: \_\_\_\_\_

Name: [Insert here]

Title: [Insert here]

Date: \_\_\_\_\_

## EXHIBIT A: LICENSED PATENTS

| Docket No. | Country | Title | Inventors | IP Owner(s) | Ser. No./Pat. No. | Filing/Issue Date |
|------------|---------|-------|-----------|-------------|-------------------|-------------------|
|            |         |       |           |             |                   |                   |

Licensee certifies that it is a \_\_\_\_\_ entity as defined by the United States Patent and Trademark Office.

INITIALS

UT-Battelle: \_\_\_\_\_

Date: \_\_\_\_\_

Licensee: \_\_\_\_\_

Date: \_\_\_\_\_

## EXHIBIT B: CONSIDERATION

**Non-exclusivity:** Non-exclusive commercial license for the Licensed Patents in the Field of Use.

**Field of Use:** TBD

**Term:** A period of XXXXX (XX) months from the Effective Date.

**Territory:** The United States of America and any country in which Licensed Patents have been filed.

**License Fees:** Licensee with pay Licensor the following fee:

| Licensee Fee                | Due Date                                      |
|-----------------------------|---|
| _____ U.S. Dollars (US\$XX) | Within thirty (30) days of the Effective Date |

**Patent Reimbursement:** Licensee will reimburse Licensor of all patent costs incurred for all Licensed Patents during the Term of this Agreement.

### NOTICE

This Exhibit contains financial and 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. This provision will survive termination of or the expiration of the Agreement.

INITIALS

UT-Battelle: \_\_\_\_\_

Date: \_\_\_\_\_

Licensee: \_\_\_\_\_

Date: \_\_\_\_\_

## **EXHIBIT C: 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:

| <b>Milestone Examples</b>   | <b>Due Date</b>                   |
|---|-----------------------------------|
| Licensee will have a prototype/pilot study of the Licensed Product with performance of _____. | XX months from the Effective Date |
| Licensee to deliver an updated business plan for the commercialization of Licensed Products.  | XX months from the Effective Date |

### NOTICE

This Exhibit contains financial and 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. This provision will survive termination of or the expiration of the Agreement.

INITIALS

UT-Battelle: \_\_\_\_\_

Date: \_\_\_\_\_

Licensee: \_\_\_\_\_

Date: \_\_\_\_\_