**Intellectual Property License Application**

UT-Battelle, LLC (UT-Battelle) is the management and operating (M&O) contractor for the Department of Energy’s (DOE’s) Oak Ridge National Laboratory (ORNL) in Oak Ridge, Tennessee.

As the M&O contractor, UT-Battelle acquires rights to intellectual property (IP) developed under its contract with DOE and negotiates IP license agreements for commercial applications. Licenses can be field of use limited non-exclusive or exclusive depending on the licensee’s strategy to maximum commercial deployment. Please note that the federal government always retains a non-exclusive license for federal government use. UT-Battelle requires substantial U.S. manufacturing for all products made and sold under IP licenses. In the case that a company cannot meet this requirement, UT-Battelle can seek a waiver from the DOE if the company can demonstrate the U.S. technical and economic benefit for this request.

Licenses include Commercialization and Development Plans that outline the licensee’s milestones, with anticipated completion dates, to bring products and services to the market and then growth of the market through commercial sales and possibly sublicensing.

Commercial licenses typically include the following financial obligations for the licensee:

1. Execution fee, due at the time of license execution;
2. A running royalty payable periodically based upon sales of products/services;
3. Annual minimum payments, which are offset by running royalties, and milestone payments; and
4. reimbursement of patenting expenses.

These fees are negotiable based on the fair market value of the technology, the degree of license rights granted, and commitments to commercialization made by the applicant.

Information provided by UT-Battelle or the applicant in this document is for discussion purposes only; it does not constitute any offer or proposal. UT-Battelle protects portions of this application as business sensitive, in accordance with the legend printed on those pages.

Please email the completed License Application to the Commercialization Manager or to UT-Battelle at parternships@ornl.gov. By completing this form and emailing it, you are stating that you have provided this information to the best of your knowledge and the statements are true and accurate. We look forward to working with you!

**SECTION 1: Company Information**

Name of your company: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Business address: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

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

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

Telephone: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Email: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Company Website: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Company Size [ ]  Small Business[[1]](#footnote-1)

[ ]  Medium Business

[ ]  Large Business[[2]](#footnote-2)

Patent Entity Status[[3]](#footnote-3) [ ]  micro entity

[ ]  small entity

[ ]  large entity

Company Structure [ ]  S-Corporation, U.S. State of incorporation \_\_\_\_\_\_\_\_\_\_\_\_\_

[ ]  C-Corporation, U.S. State of incorporation \_\_\_\_\_\_\_\_\_\_\_\_

[ ]  Limited Liability Company

[ ]  Partnership

[ ]  Sole Proprietorship

Ownership [ ]  Wholly U.S. Owned

[ ]  Foreign Owned in Whole or in Part (\_\_\_\_\_\_\_\_%)

If foreign (non-U.S.) owned in whole or in part, in what country is the parent company and any affiliates based? \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Contact Information Name \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

for Notices Title \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Telephone \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Email address \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Number of people directly employed by your company: \_\_\_\_\_\_\_\_\_\_

(Optional) Please indicate if your company is at least 50% owned by individual(s) who self-identify as members of the following groups:

[ ]  United States Veterans

[ ]  Women

[ ]  Black Americans

[ ]  Hispanic Americans

[ ]  Native Americans (Alaska Natives, Native Hawaiians, or enrolled members of a Federally or State recognized Indian Tribe)

[ ]  Asian Pacific Americans (persons with origins from Burma, Thailand, Malaysia, Indonesia, Singapore, Brunei, Japan, China (including Hong Kong), Taiwan, Laos, Cambodia (Kampuchea), Vietnam, Korea, The Philippines, U.S. Trust Territory of the Pacific Islands (Republic of Palau), Republic of the Marshall Islands, Federated States of Micronesia, the Commonwealth of the Northern Mariana Islands, Guam, Samoa, Macao, Fiji, Tonga, Kiribati, Tuvalu, or Nauru)

[ ]  Subcontinent Asian Americans (persons with origins from India, Pakistan, Bangladesh, Sri Lanka, Bhutan, the Maldives Islands or Nepal)

[ ]  Members of other groups designated from time to time by SBA. 13 CFR §124.103(b)

[ ]  Other group: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**SECTION 2:** **Disclosure of any Existing or Potential Conflicts of Interest (COI)**

1. Are any of your company’s principals[[4]](#footnote-4):

[ ]  Current or former UT-Battelle/ORNL employees?

[ ]  Current or former UT-Battelle/ORNL consultants?

[ ]  Current or former DOE employees?

 If the answer to any of the above questions is “yes,” please explain (including the individuals’ name(s) and position(s) and the dates of UT-Battelle/ORNL employment):

1. Is there any plan for a current or former ORNL/UT-Battelle employee(s) to have a role in the company or developing the technology?

[ ]  Yes

[ ]  No

 If the answer to the above question is “yes,” please explain (including the individuals’ name(s) and position(s)):

1. Is your company affiliated with UT-Battelle, Battelle Memorial Institute, and/or University of Tennessee?

[ ]  Yes

[ ]  No

If the answer to the above question is “yes,” please explain the nature of the affiliation.

1. Are you aware of any other Conflicts of Interest (COIs), Personal COI or Organization COI, between your company and ORNL, UT-Battelle, Battelle Memorial Institute, and/or University of Tennessee, with respect to entering into a licensing agreement?

[ ]  Yes

[ ]  No

If the answer to the above question is “yes,” please explain the nature of the affiliation.

**SECTION 3:** **UT-Battelle Intellectual Property (IP)/Opportunities**

1. Please describe the UT-Battelle intellectual property your company desires to license.

 U.S. Patent or Application Number

 UT-Battelle Invention Disclosure Number

 Copyright Number

1. How did your company learn of the availability for license of this intellectual property?
2. Has your company been involved in any previous technology transfer activities with UT-Battelle?

[ ]  Cooperative Research and Development Agreement (CRADA)

[ ]  Strategic Partnership Project (SPP)

[ ]  Technical Assistance Program

[ ]  User Agreement for one of ORNL’s User Facilities

[ ]  Other IP License

[ ]  Other technology transfer activity, please describe \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

1. Please describe how your commercialization plan will enhance U.S. Industrial Competitiveness[[5]](#footnote-5). Provided below are some efforts for your consideration (you can select more than one).

[ ]  Direct or indirect investment in U.S.-based plant or equipment

[ ]  Creation of U.S. jobs, Enhancement of domestic skills base

[ ]  Further development of the technology

[ ]  Positive impact on the U.S. balance of payments (licensed products/services)

[ ]  Other \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**SECTION 4: Development Plan of the Technology and Intellectual Property.**

**Please provide your company’s development and commercialization plan for this technology and intellectual property. Please choose one of the two options in this section depending on the type of License Agreement you are interested in:**

* **Option 1: SECTION 4a pertains to a Research and Development License with an option to a Commercial License, or**
* **Option 2: Section 4b is for a Commercial License with the right to manufacture, offer to sell, and sell products that embody the licensed intellectual property (“Licensed Products”).**

**Option 1: SECTION 4a**

**Commercialization and Development Plan for a Research and Development License**

1. Please provide the license and option term you are requesting. \_\_\_\_ months
2. Based on your knowledge at this time, please provide at least three performance milestones that you expect to achieve during the term of the license. Examples are provided in the table below.

|  |  |  |
| --- | --- | --- |
|  | **Milestone** | **Due Date** |
| 1 | Expected first prototype of licensed product. |  |
| 2 | TBD |  |
| 3 | TBD |  |
| 4 | Written updated business plan for a commercial license application. |  |

**Option 2: SECTION 4b**

**Commercialization and Development Plan for a Commercial License**

1. The license will require any products to be substantially manufactured in the United States.[[6]](#footnote-6) Please provide information on the location(s) of your company’s manufacturing or production facilities for this commercialization effort.

Existing U.S. manufacturing site(s): \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

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

Planned U.S. manufacturing site(s): \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

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

Non-U.S. site(s): \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

1. Briefly describe the licensed product(s) and/or service(s) in which your company proposes to use the licensed technology and/or develop from the licensed technology:
2. With respect to the licensed product(s) and/or service(s) your company would commercialize based on this technology, what are the competitive products already in the marketplace?

What advantages/benefits does the licensed product(s)/service(s) have over these current solutions (i.e., competitive advantages: faster, cheaper, stronger, unfilled need, etc.)?

1. Based on your business plan, please propose development and commercialization milestones that you expect to achieve. Examples are provided in the table below.

|  |  |  |
| --- | --- | --- |
|  | **Milestone** | **Due Date** |
| 1 | First prototype of the Licensed Product built and tested. |  |
| 2 | Completion of first pilot study of the Licensed Product. |  |
| 3 | First commercial sale of a Licensed Product/Service. |  |
| 4 | Gross Sales of Licensed Product above $XXXXX |  |
| 5 | Please provide. |  |

1. Please provide an estimate for the anticipated total investment, in both dollars and FTE of effort, during each of the next 5 years. How will these investments be funded?
2. Please provide an estimate for each of the first 5 future years in which you expect to have positive revenues for your commercialization of licensed product(s)/services(s):
	1. The size and expected share you will address of the total U.S. and worldwide COMMERCIAL markets
	2. The anticipated market price (per unit) of the licensed product(s)/service(s)
	3. The annual gross sales
	4. The net margins(s) BEFORE payment of royalties to UT-Battelle

If your commercialization plan indicates that revenues will not be generated within one year of the license execution, please indicate how many years of no revenues are anticipated, as well as the regulatory/investment/ product development milestones you must meet during the pre-revenue period in order to get to the revenue-generation stage with this technology.

1. Please attach (1) your company’s business plan for commercializing this technology; and (2) *pro forma* financial statements showing at least the first five years of positive revenues (if positive revenues are to be preceded by one or more years of zero or negative revenues, include sufficient years of data to show 5 years of positive revenues) resulting sales of licensed product(s)/ service(s) based on the technology to be licensed. Please be sure to limit your projections to COMMERCIAL SALES ONLY (do not include sales to the U.S. Federal Government).
2. In addition to the information provided elsewhere in this document, what are the characteristics and assets of your company that make it uniquely suited to bring this technology to market successfully?

**SECTION 5: Licensing Terms**

1. List the members of your Management Team for the commercialization of the technology. This may include officers/directors, managers, scientific/business advisors, etc. (Please include their role, citizenship, expertise, and qualifications.)

|  |  |  |  |
| --- | --- | --- | --- |
| **Name** | **Role/Title** | **Citizenship** | **Expertise and Qualifications** |
|  |  |  |  |
|  |  |  |  |
|  |  |  |  |
|  |  |  |  |
|  |  |  |  |

1. What type of license do you seek?

[ ]  Non-exclusive

[ ]  Exclusive

[ ]  Exclusive with the right to Sublicense

If you wish exclusive rights, please provide the basis for this need. Keep in mind that exclusive rights may not be available for some technologies.

1. How does your company intend to use this technology? Please provide a description of any field(s) of use that you are interested in.
2. Please select below the territories your company is interested in licensing (U.S. rights only, or both U.S. rights and foreign rights? (Keep in mind that foreign rights may not be available on some technologies)

 [ ]  U.S. Rights

 [ ]  U.S. Rights and Foreign Rights

If you selected Foreign Rights in the question above, please list the foreign jurisdictions you would like to include in your license rights?

1. Please provide an estimate of the share of the anticipated U.S. and worldwide markets for the licensed product(s)/service(s) your company expects to capture for the first 5 years in which you expect positive revenues from commercialization of this technology:

|  |  |  |
| --- | --- | --- |
| **Year** | **Country** | **% Share** |
| 1 |  |  |
| 2 |  |  |
| 3 |  |  |
| 4 |  |  |
| 5 |  |  |

1. Please describe the licensed product(s)/service(s) you expect to commercialize and how will the IP be incorporated into or facilitate them.
2. Please provide an estimate of your company’s gross sales of the licensed product(s), service(s), and/or process(es) for each of the first 5 future years in which you expect to have positive revenues from commercialization of this technology:

|  |  |  |  |  |
| --- | --- | --- | --- | --- |
| **Year of Sales** | **Number of Units** | **Revenue (US$)** | **Lowest projection** | **Highest projection** |
| 1 |  |  |  |  |
| 2 |  |  |  |  |
| 3 |  |  |  |  |
| 4 |  |  |  |  |
| 5 |  |  |  |  |

1. What is the anticipated gross margin of the licensed product(s)/service(s) derived from the licensed technology (BEFORE payment of royalties to UT-Battelle) for the first 5 years you expect to have positive revenues from commercialization of this technology?

|  |  |  |  |
| --- | --- | --- | --- |
| **Year of Sales** | **Cost of Goods Sold** | **End User Price** | **Gross Margin** |
| 1 |  |   |   |
| 2 |  |   |   |
| 3 |  |   |   |
| 4 |  |   |   |
| 5 |  |  |  |

1. Based on your knowledge of the market in this technology area, please provide the following suggested financial terms for the license.

|  |  |
| --- | --- |
| **Fee** | **Amount** |
| License Execution Fee (may also include an equity stake in an incorporated company) |  |
| Royalty Rate for sale of licensed products/services |  |
| Minimum annual fee (which are offset by running royalties annual payments after first sale).  |  |
| Milestone payment(s) |  |
| Additional Consideration |  |

Please also provide the basis for your calculation of (1) a reasonable initial license fee; and (2) a reasonable royalty rate on sales. (Appropriate things for this basis may include your business plan for commercializing this technology; and/or *pro forma* financial statements showing at least the first five years of revenues resulting from licensed product(s)/service(s).)

1. Most technologies available for license from UT-Battelle are at a relatively early stage of development. Does your company anticipate the need for technical assistance from the Oak Ridge National Laboratory either in the form of consulting services from its employees or research at the Laboratory sponsored by your company?
2. Who is the primary person within your company for our licensing discussions?

Name \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Title \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Phone number\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Email-address \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Does this person have signature authority for license agreements?

[ ]  Yes

[ ]  No. If No, who will be the signatory on any license agreement that may result from these discussions? \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**Company Certification**

**I certify that the information provided in the entire License Application is complete and the statements are true and accurate to the best of my knowledge.**

**\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_**

Signature

**\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_**

Name

*Thank you for taking the time to complete this application, and for your interest in commercialization of UT-Battelle’s intellectual property.*

1. Small Business as defined at Section 2 of Public Law No. 85-536 (15 U.S.C. 632) and implementing regulations of the Small Business Administration. [↑](#footnote-ref-1)
2. An example of a Large Business is a Fortune 500 company. [↑](#footnote-ref-2)
3. USPTO entity definitions. <https://www.uspto.gov/blog/director/entry/ensuring-the-validity-of-micro> [↑](#footnote-ref-3)
4. Per the definition included in FAR 52.203-13. "principal” means an officer, director, owner, partner, or a person having primary management or supervisory responsibilities within a business entity (e.g., general manager; plant manager; head of a division or business segment; and similar positions). [↑](#footnote-ref-4)
5. In the interest in enhancing U.S. Industrial Competitiveness, UT-Battelle shall give preference in licensing in such a manner as to enhance the accrual of economic and technological benefits to the U.S. domestic economy. <https://www.energy.gov/gc/us-manufacturing> [↑](#footnote-ref-5)
6. DOE Declaration of Exceptional Circumstances under the Bayh-Dole Act to further promote domestic manufacture of DOE science and energy technologies. <https://www.energy.gov/gc/articles/department-energy-determination-exceptional-circumstances-under-bayh-dole-act-further> [↑](#footnote-ref-6)