

NATIONAL INSTITUTE OF STANDARDS AND TECHNOLOGY RESEARCH LICENSE AGREEMENT

This Agreement is entered into by and between the **National Institute of Standards and Technology** (NIST), a primary operating unit of the United States Department of Commerce, having offices at 100 Bureau Drive, Gaithersburg, MD 20899-2200, and [\[Insert Name\]](#) (LICENSEE) having a place of business at [\[Insert Address\]](#).

WHEREAS, the Department of Commerce, pursuant to 35 U.S.C. 207 and 37 C.F.R. 404, is authorized to apply for, obtain and maintain patents on federally owned inventions in the United States and in foreign countries; to grant nonexclusive, partially exclusive or exclusive licenses under such federally owned patents and patent applications; and to undertake all other suitable and necessary steps to protect and administer rights to federally owned inventions; and

WHEREAS, NIST desires, in the public interest, that the subject invention be perfected, marketed and practiced so that the benefits are readily available for widest possible utilization in the shortest time possible; and

WHEREAS, LICENSEE represents that it has the facilities, personnel and expertise to expend reasonable efforts to investigate the commercial feasibility of the subject invention; and

NOW THEREFORE, in consideration of the foregoing and the mutual promises and obligations hereinafter set forth, NIST and LICENSEE, intending to be lawfully bound, agree to the following terms and conditions:

Article I. Definitions

- 1.1 **Licensed Patent Rights** shall mean the patent titled [\[Insert Patent Title\]](#), U.S. Patent [Application Serial] Number [\[Insert Patent No. or Patent Application Serial No....\]](#) (NIST Docket No. [\[Insert Number\]](#)), and all [\[Insert “patent” if it’s an application\]](#), reissues, renewals, reexamination certificates and extensions of such patent [\[or insert “patent application” if it is an application being licensed\]](#).
- 1.2 **Licensed Product(s)** shall mean a product encompassed within the scope of a claim in the Licensed Patent Rights or produced, at least in part, by a process encompassed within the scope of the Licensed Patent Rights.
- 1.3 **Licensed Process(es)** shall mean a process encompassed within the scope of a claim in the Licensed Patent Rights.
- 1.4 **Licensed Territory** shall mean the United States of America, its territories, possessions and commonwealths.
- 1.5 **Government** shall mean the Federal Government of the United States of America.
- 1.6 **Research** shall mean experimental or developmental activities. No direct financial benefit will be derived from such Research involving the Licensed Product or Licensed Process.

Article II. Grants

- 2.1 NIST hereby grants and LICENSEE accepts, subject to the terms and conditions herein, a nonexclusive, research license under the Licensed Patent Right to make and use Licensed Products and to practice the processes encompassed by the Licensed Patent Rights for Research in the Licensed Territory for the term of this Agreement.

- 2.2 This Agreement does not include any rights to make, sell, transfer or use Licensed Products or Licensed Processes for commercial purposes or in lieu of purchase as a commercial product. Also, this Agreement in no way obligates NIST to grant to LICENSEE an exclusive or nonexclusive commercialization license to Licensed Patent Rights.
- 2.3 No right or license is granted or implied to LICENSEE or any person claiming through LICENSEE under any patent or patent application other than those specifically identified herein as Licensed Patents Rights.
- 2.4 LICENSEE does not have the right to grant sublicenses to License Patent Rights.
- 2.5 LICENSEE agrees that this Agreement does not preclude NIST from licensing the Licensed Patents Rights or Licensed Product or Process to third parties for research or commercialization purposes. LICENSEE acknowledges that third parties also may be evaluating the Licensed Patent Rights for a variety of commercial purposes, and no guarantee can be made to LICENSEE that a commercialization license for any field of use would be available should LICENSEE apply for such a license. NIST will follow 37 CFR Part 404 for granting fair access to exclusive, co-exclusive or nonexclusive commercialization licenses.

Article III. Royalties

- 3.1 The License is royalty-free.

Article IV. Licensee Performance

- 4.1 LICENSEE agrees that its intentions in entering this Agreement are solely for Research involving Licensed Products and Licensed Processes. LICENSEE shall expend reasonable efforts and resources to carry out LICENSEE's research plan within a reasonable time.
- 4.2 For the use of the Licensed Patent Rights in the United States under this Agreement, LICENSEE agrees that any manufacture of the Licensed Product shall take place substantially in the United States.

Article V. Duration and Termination

- 5.1 This Agreement shall be effective for two (2) years commencing on the date of last signature of the Parties ("Effective Date").
- 5.2 This Agreement may be modified or terminated by NIST subject to the provisions of Paragraph 5.3 below, if it is determined that:
 - (a) LICENSEE fails to meet the obligations set forth in Article IV above;
 - (b) LICENSEE has willfully made a material false statement or willfully omitted a material fact in the license application or in any report required by this Agreement
 - (c) LICENSEE commits a substantial breach of any promise, covenant or obligation contained in this Agreement;
 - (d) LICENSEE is adjudged a bankrupt, files a petition for bankruptcy or has its assets placed in the hands of a receiver or makes any assignment or other accommodation for the benefit of creditors; or
 - (e) LICENSEE is held by a court of competent jurisdiction without taking a further appeal to have misused any Licensed Patent Rights.

- 5.3 Prior to any modification or termination of this Agreement, NIST shall furnish LICENSEE a written notice of intention to modify or terminate; and LICENSEE shall be allowed thirty (30) days after the date of such notice to remedy any breach or default of any promise, covenant or obligation of this Agreement or to show cause why this Agreement should not be modified or terminated.
- 5.4 At any time upon thirty (30) days prior written notice, LICENSEE may terminate this Agreement.
- 5.5 LICENSEE and NIST may mutually agree to modify or terminate this Agreement at any time. Such modification will be effective only when set forth in writing and signed by the authorized official(s) of each Party.
- 5.6 Within sixty (60) days following NIST's written request, LICENSEE shall provide NIST with all non-confidential technical data generated involving Licensed Patent Rights between the Effective Date and the termination or expiration of the Agreement. NIST shall be free to disclose such non-confidential data to any third party.

Article VI. General

- 6.1 NIST does not warrant the patentability or validity of the Licensed Patent Rights and makes no representations whatsoever with regard to the scope of the Licensed Patent Rights or that such Licensed Patent Rights may be exploited without infringing other patents. NIST FURTHER DOES NOT WARRANT THE MERCHANTABILITY OR FITNESS OF THE LICENSED PRODUCT(S) OR LICENSED PROCESS(ES) FOR ANY PARTICULAR PURPOSE OR ANY OTHER WARRANTY, EXPRESS OR IMPLIED. LICENSEE shall indemnify and hold harmless the Government from any claims, costs, damages or loss that may arise from the use of the Licensed Product(s) or Licensed Process(es).
- 6.2 This Agreement may not be transferred to any party. This Agreement shall not be assigned by LICENSEE except with the prior written consent of NIST, or except as part of a sale or transfer of substantially the entire business of LICENSEE relating to operations which concern this Agreement.
- 6.3 The name of the Government employee inventor(s), the name of any agency or department of the Government or any adaptation of the above shall not be used in any promotional activity without prior written approval from NIST.
- 6.4 The interpretation and application of the provisions of this Agreement shall be governed by the laws of the United States as interpreted and applied by the Federal courts in the District of Columbia.
- 6.5 Written notices required to be given under this Agreement shall be considered duly given on the date received as electronic mail, or the date mailed if mailed by first class mail, postage prepaid and addressed as follows:

If to NIST: NIST Technology Partnerships Office
 ATTN: License Administrator
 100 Bureau Drive, MS 2200
 Gaithersburg, MD 20899

If to LICENSEE: [Address]

or such other address as either party may request in writing.

6.6 This Agreement constitutes the entire understanding and supersedes all prior agreements and understandings between the parties with respect to the subject matter hereof or information relating thereto except for any non-disclosure agreement relating to the claims of the Licensed Patent Rights which non-disclosure agreement, if any, is incorporated herein by reference, and neither party shall be obligated by any condition, promise or representation other than those expressly stated herein or as may be subsequently agreed to by the parties hereto in writing.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed by their duly authorized representatives.

FOR LICENSEE

_____ [Template] _____ Date _____
Name: _____
Title: _____

FOR NATIONAL INSTITUTE OF STANDARDS AND TECHNOLOGY

_____ [Template] _____ Date _____
Henry N. Wixon
Chief Counsel for NIST

_____ [Template] _____ Date _____
[Director Name]
Director, NIST Laboratory

_____ [Template] _____ Date _____
Paul R. Zielinski
Director, Technology Partnerships Office