

NATIONAL INSTITUTE OF STANDARDS AND TECHNOLOGY EXCLUSIVE PATENT LICENSE AGREEMENT

This Exclusive Patent License Agreement is entered into 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, Stop 2200, Gaithersburg, MD 20899-2200, and *[NAME]* (LICENSEE), a corporation, having a place of business at *[ADDRESS]*.

WHEREAS, by assignment of rights from its employees *[and other inventors]*, NIST, on behalf of the United States Government, owns intellectual property rights claimed in any United States patent applications or patents corresponding to the assigned inventions; and

WHEREAS, NIST is authorized by 35 U.S.C. 207 and 37 C.F.R. 404 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 bring and is willing to expend reasonable efforts to bring the Invention to the point of Practical Application as defined in 37 C.F.R. 404.3(d) at an early date; and

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

ARTICLE I. Definitions

- 1.1 **Benchmarks** mean the performance milestones that are set forth in Appendix A.
- 1.2 **Commercial Development Plan** means LICENSEE'S written commercialization plan, submitted by LICENSEE in its Patent License Application (dated *MONTH, XX, YYYY*), which is incorporated herein by reference.
- 1.3 **Field of Use** shall mean the field(s) of use identified in Appendix A.
- 1.4 **First Commercial Sale** means the initial transfer by or on behalf of LICENSEE or Sublicensee of Licensed Products or the initial practice of a Licensed Process by or on behalf of LICENSEE or Sublicensee in exchange for cash or some equivalent to which value can be assigned for the purpose of determining Net Sales.
- 1.5 **Government** shall mean the Government of the United States of America.
- 1.6 **Licensed Patent Rights** shall mean:
 - (a) Patents and/or patent applications listed in Appendix A, all divisions and continuations of these applications, any patents issuing from such applications, divisions, and continuations, and any reissues, reexaminations, and extensions of all such patents;
 - (b) to the extent that any of the following contain one or more claims directed to the invention or inventions disclosed in Subpart 1.6(a), above: i) continuations-in-part of Subpart 1.6(a) above; ii) all divisions and continuations of these continuations-in-part; iii) all patents issuing from such continuations-in-part, divisions, and continuations; iv) priority patent application(s) of Subpart 1.6(a) above; and v) any reissues, reexaminations, and extensions of all such patents; and

- (c) to the extent that the any of the following contain one or more claims directed to the invention or inventions disclosed in Subpart 1.6(a): all counterpart foreign and U.S. patent applications and patents to Subparts 1.6(a) and 1.6(b), including those listed in Appendix A.

Licensed Patent Rights shall *not* include Subpart 1.6(b) or 1.6(c) above to the extent that they contain one or more claims directed to new matter which is not the subject matter disclosed in Subpart 1.6(a), above. A patent or patent application shall cease to fall within Licensed Patent Rights as defined in this Article if the application or patent expires, has been abandoned, or has been held invalid or unenforceable by a court of competent jurisdiction or an administrative agency.

- 1.7 **Licensed Process(es)** shall mean any processes or methods which, in the course of being practiced would be within the scope of one or more claims of the Licensed Patent Rights that have not been held unpatentable, invalid or unenforceable by an unappealed or unappealable judgment of a court of competent jurisdiction.
- 1.8 **Licensed Product(s)** shall mean any apparatus or composition encompassed within the scope of a claim in Licensed Patent Rights and shall also include a product which was manufactured, at least in part, by a process encompassed within the scope of one or more claims in Licensed Patent Rights that have not been held unpatentable, invalid or unenforceable by an unappealed or unappealable judgment of a court of competent jurisdiction
- 1.9 **Licensed Territory** shall mean the geographical area identified in Appendix A.
- 1.10 **Net Sales** mean the total gross receipts for sales of Licensed Products or practice of Licensed Processes by or on behalf of the LICENSEE and its Sublicensees as defined below, and from leasing, renting, or otherwise making Licensed Products available to others without sale or other dispositions, whether invoiced or not, less returns and allowances, packing costs, insurance costs, freight out, taxes or excise duties imposed on the transaction (if separately invoiced), and wholesaler and cash discounts in amounts customary in the trade to the extent actually granted. No deductions shall be made for commissions paid to individuals, whether they are with independent sales agencies or regularly employed by the LICENSEE or Sublicensees, and on its payroll, or for the cost of collections.
- 1.11 **Practical Application**, as defined in 37 CFR 404.3(d), means to manufacture in the case of a composition or product, to practice in the case of a process or method, or to operate in the case of a machine or system; and in each case, under such conditions as to establish that the invention is being utilized and that its benefits are to the extent permitted by law or Government regulations available to the public on reasonable terms.
- 1.12 **Proprietary Information** shall mean confidential scientific, business, or financial information, which may embody trade secrets provided by the LICENSEE to NIST in the course of this License except if such information:
 - (a) was in NIST's possession before receipt from the LICENSEE; or
 - (b) is or becomes a matter of public knowledge through no fault of NIST; or
 - (c) is received by NIST from a third party without a duty of confidentiality to LICENSEE; or
 - (d) is disclosed by the LICENSEE to a third party without a duty of confidentiality on the third party; or
 - (e) is disclosed by NIST with LICENSEE's prior written approval; or
 - (f) is independently developed by NIST without reference to information disclosed hereunder.
- 1.13 **Sublicensee** shall mean any party to a sublicense agreement with LICENSEE that is approved by NIST.

ARTICLE II. Grants

- 2.1 NIST hereby grants to LICENSEE, and LICENSEE accepts subject to the terms and conditions herein, an exclusive license, with the right to grant sublicenses, under the Licensed Patent Rights to make and have made, use and have used, and sell and have sold Licensed Products and to practice the processes encompassed by the Licensed Patent Rights, in the Licensed Territory and the Field of Use for the term of this Agreement. The license shall be exclusive for the government's undivided interest in the invention and for the Licensed Territory for the Field of Use.
- 2.2 NIST hereby grants to LICENSEE the right to extend to customers of the Licensed Product on which the royalty provided herein has been or will be paid the right to use such Licensed Product.
- 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 the Licensed Patent Rights regardless of whether such patents are dominant or subordinate to Licensed Patent Rights.
- 2.4 The Licensed Patent Rights granted to LICENSEE under this Agreement shall be subject to any pre-existing licenses in force at the time of the full execution of this Agreement.
- 2.5 NIST reserves an irrevocable, nonexclusive, nontransferable, royalty-free license for the practice of the Licensed Patent Rights throughout the world by or on behalf of the Government and on behalf of any foreign government or international organization pursuant to any existing or future treaty or agreement with the Government.

ARTICLE III. Sublicense Agreements

- 3.1 Upon prior written approval by NIST, LICENSEE may enter into sublicensing agreements with Sublicensee under the Licensed Patent Rights within the Field of Use. NIST's written approval shall be after NIST's prior review of any such sublicense agreement and shall not be unreasonably withheld.
- 3.2 Each sublicense agreement shall expressly provide that it is subject to the terms and conditions of this Agreement. Each sublicense agreement shall also provide for the conversion of Sublicensee's rights to a license agreement directly between Sublicensee and NIST, at the option of Sublicensee in the event that this Agreement is terminated under Article VIII. This conversion is subject to NIST's approval and shall be effective upon the full execution of a separate license agreement between Sublicensee and NIST.
- 3.3 LICENSEE shall provide to NIST a copy of the fully executed sublicense agreement within fifteen (15) days of its execution. To the extent allowable by law, NIST shall treat each sublicense agreement as Proprietary Information in accordance with Article 9.1.
- 3.4 NIST reserves the right to require LICENSEE to grant sublicenses to responsible applicants, on reasonable terms when necessary to fulfill health or safety needs.

ARTICLE IV. Royalties, Payments and Records

- 4.1 **License Issue Royalty.** LICENSEE shall pay to NIST a one-time, noncreditable, nonrefundable license issue royalty fee of *[initial fee]* due within sixty (60) days from the full execution of this Agreement.
- 4.2 **Minimum Royalty.** LICENSEE shall pay to NIST a non-refundable minimum royalty fee in accordance with the schedule in Appendix A. The minimum royalty fee for a calendar year may be credited against any royalties due for Net Sales made in that calendar year.
- 4.3 **Royalty on Net Sales.** LICENSEE shall pay to NIST a royalty fee, as stated in Appendix A, on all Net Sales by or on behalf of LICENSEE or Sublicensee. Royalty fees shall not be paid on items that LICENSEE or Sublicensees sold directly to agencies of the Government or sold for known end use by the Government.

- 4.4 No multiple royalties shall be payable because any Licensed Products or Licensed Processes are covered by more than one of the Licensed Patent Rights.
- 4.5 On sales of Licensed Products by LICENSEE to SUBLICENSEES or on sales made in other than an arm's length transaction, the value of the Net Sales attributed under this Article IV to such a transaction shall be that which would have been received in an arm's-length transaction, based on sales of like quantity and quality products on or about the time of such transaction.
- 4.6 **Filing, Prosecution and Maintenance Costs.** In addition to the royalties due under Article 3.1, LICENSEE shall pay the ordinary and usual costs to NIST of obtaining and maintaining any Licensed Patent Rights. These costs shall be invoiced and paid separately from any other amounts due under the LICENSE. LICENSEE shall pay NIST such amounts within thirty (30) days of receiving NIST's written request for reimbursement of such an expense. Should LICENSEE decline to assume such responsibility, NIST may modify or terminate this Agreement in accordance with the provisions of Article VIII below. Before any commitment to expend substantial funds for an extraordinary and unusual procedure for obtaining and maintaining any Licensed Patent Rights, including but not limited to reissue, term-extension, reexamination, interference, opposition and nullity but not including infringement or counterclaims thereto, NIST shall notify LICENSEE of such extraordinary and unusual procedure and the estimated cost thereof and request LICENSEE to assume responsibility for such cost. Should LICENSEE decline to assume such responsibility, NIST may modify or terminate this Agreement in accordance with the provisions of Article VIII below.
- 4.7 **Payments.**
- 4.7.1 **Check Payments.** All payments due NIST under this Article IV shall be payable in United States dollars made payable to "NIST/Patent Licensing." All checks and bank drafts shall be drawn on a United States bank account and sent to the address provided in Article 9.11. If payments are overdue, late charges will be applied as required by the Department of Treasury. Conversion of foreign currency to United States dollars for such payments shall be made at the conversion rate published in the Wall Street Journal on the date payment is made provided however payments made after the due date shall use the conversion rate published in the Wall Street Journal either as of the last date for timely payment or as of the date payment is actually made, whichever is greater. Any and all loss of exchange, value, taxes or other expenses incurred in the transfer or conversion of other currency to United States dollars shall be paid entirely by LICENSEE.
- 4.7.2 **Electronic Payments.** LICENSEE may submit the royalty fees owed as provided under this Article by electronic funds transfer (EFT) through the Automated Clearing House (ACH) through the U.S. Treasury website at <https://www.pay.gov>. If payment is made by EFT, LICENSEE shall locate "Commerce: National Institute of Standards and Technology (NIST)" in the Agency List provided on the website, and using NIST's Miscellaneous Payment Form, LICENSEE shall indicate that the purpose for payment is "Royalty" and shall include in the License Number in the "Comments" field.
- 4.8 LICENSEE agrees to keep accurate and correct records of Licensed Products made, used, sold, or imported and Licensed Processes practiced under this Agreement appropriate to determine the amount of royalties due NIST. Such records shall be retained for at least five (5) years following a given reporting period and shall be available during normal business hours for inspection at the expense of NIST by an accountant or other designated auditor selected by NIST and/or by the Office of the Inspector General for the sole purpose of verifying reports and payments hereunder. The accountant or auditor shall only disclose to NIST, NIST's accountant or other designated auditor, and/or the Office of the Inspector General information relating to the accuracy of reports and payments made under this Agreement. If an inspection shows an underreporting or underpayment in excess of five percent (5%) for any twelve (12) month period, LICENSEE shall reimburse NIST for the cost of the inspection at the time LICENSEE pays the unreported royalties. All payments required under this Article shall be due within thirty (30) days of the date NIST provides LICENSEE notice of the payment due as a result of an underreporting or underpayment.
- 4.9 LICENSEE shall pay all necessary expenses for its commercialization of Licensed Products and such expenses shall not be deducted from any payments due NIST as provided herein.

- 4.10 Except as provided in Article 1.10 hereof, and as may be provided in any treaty between the Government and a foreign government, any tax on any payment due to NIST under this Article IV in any country in which such payment accrued shall be paid by LICENSEE without deduction from the amount owed to NIST.

ARTICLE V. Reports on Progress, Benchmarks, Sales, and Payments

- 5.1 Prior to signing this Agreement, LICENSEE has provided to NIST the LICENSEE's Commercial Development Plan, under which LICENSEE intends to bring the subject matter of the Licensed Patent Rights to the point of Practical Application. This Commercial Development Plan is hereby incorporated by reference into this Agreement. Benchmarks are based on the Commercial Development Plan and are listed in Appendix A.
- 5.2 LICENSEE shall provide written annual reports ("Progress Report") on its product development progress or efforts to commercialize under the Commercial Development Plan for each of the licensed Fields of Use by **March 1st** of each calendar year. These Progress Reports shall include, but not be limited to: progress on research and development, status of applications for regulatory approvals (if any), manufacturing, sublicensing, marketing, importing, and sales during the preceding calendar year, as well as plans for the present calendar year. If reported progress differs from that projected in the Commercial Development Plan and Benchmarks, LICENSEE shall explain in the Progress Report the reasons for such differences. Also in the Progress Report, LICENSEE may propose amendments to the Commercial Development Plan, acceptance of which by NIST will be by written notice. LICENSEE also agrees to provide any additional information reasonably required by NIST to evaluate LICENSEE's and Sublicensee's performance under this Agreement.
- 5.3 LICENSEE shall report to NIST the dates of achieving Benchmarks specified in Appendix A and the date of the First Commercial Sale in each country in the Licensed Territory within thirty (30) days of such occurrences.
- 5.4 LICENSEE may request to amend the Benchmarks at any time. NIST may approve LICENSEE'S request if such request is supported by a showing by LICENSEE of diligence in its performance under the Commercial Development Plan and toward bringing the Licensed Products to the point of Practical Application. Once NIST provide written notice of its approval to LICENSEE's request, the extension to the Benchmark schedule shall be made by amendment. LICENSEE shall amend the Commercial Development Plan and Benchmarks at the request of NIST to address any Licensed Fields of Use not specifically addressed in the plan originally submitted. Any amendment to the Benchmarks shall be made in accordance with Article 8.9.
- 5.5 LICENSEE shall submit to NIST on **March 1st** of each calendar year a report setting forth for the preceding calendar year the amount of the Licensed Products sold or Licensed Processes practiced by or on behalf of LICENSEE in each country within the Licensed Territory, the Net Sales, and the amount of royalty accordingly due ("Royalty Report"). With each Royalty Report, LICENSEE shall submit payment of the royalty fees in accordance with Article IV. If no royalties are due to NIST for any reporting period, the Royalty Report shall so state. The Royalty Report shall be certified as correct by an authorized officer of LICENSEE and shall include a detailed listing of all deductions made under Article 1.10 to determine Net Sales to determine royalties due.
- 5.6 LICENSEE shall forward to NIST on **March 1st** of each calendar year a copy of any such reports that were received by LICENSEE from its Sublicensees for the preceding year and that are pertinent to LICENSEE's Progress Report and Royalty Report.
- 5.7 To the extent permitted by law, NIST shall treat all plans and reports required by this Article and marked "confidential" by LICENSEE as commercial and financial information obtained from a person and as privileged and confidential and not subject to disclosure under section 552 of Title 5 of the United States Code, the Freedom of Information Act (FOIA), except as required by Article 9.2. Any proposed disclosure of such records by NIST under FOIA shall be subject to the pre-disclosure notification requirements of 15 CFR Part 4.

ARTICLE VI. Patent Filing and Enforcement

- 6.1 NIST agrees to take the lead, but to consult with the LICENSEE, in the preparation, filing and prosecution of any and all patent applications or patents included in the Licensed Patent Rights and Licensed Territory and shall furnish copies of relevant patent-related documents to LICENSEE.
- 6.2 NIST and LICENSEE shall notify each other promptly in writing of any facts which they believe may affect the validity, scope or enforceability of the Licensed Patent Rights.
- 6.3 NIST and LICENSEE shall notify each other promptly in writing of any infringement or possible infringement of the Licensed Patent Rights of which either Party becomes aware. The parties shall reasonably cooperate in determining if substantial infringement exists and, if so, in attempting to eliminate that substantial infringement.
- 6.4 LICENSEE is empowered pursuant to this Agreement and the provisions of Chapter 29 of Title 35, United States Code or other statutes to: (a) bring suit in its own name, at its own expense, and on its own behalf for infringement of presumably valid claims in the Licensed Patent Rights; (b) in any such suit by LICENSEE, to enjoin infringement and to collect for its use, damages, profits and awards of whatever nature recoverable for such infringement; and (c) settle any claim or suit for infringement of the Licensed Patent Rights provided, however, that NIST and appropriate Government authorities shall have the first right to take such actions. If LICENSEE desires to initiate a suit for patent infringement, LICENSEE shall notify NIST in writing. If NIST does not notify LICENSEE of its intent to pursue legal action within ninety (90) days, LICENSEE will be free to initiate suit. LICENSEE may request the Government to initiate or join in any such suit if necessary to avoid dismissal of the suit. However, LICENSEE shall take no action to compel the Government either to initiate or to join in any such suit for patent infringement. Should the Government be made a party to any such suit, LICENSEE shall reimburse the Government for any costs, expenses, or fees which the Government incurs as a result of such motion or other action, including any and all costs incurred by the Government in opposing any such motion or other action. LICENSEE shall promptly provide NIST with a copy of all documents which it files in such suit or which it files in any related legal or quasi legal proceeding, including settlement negotiations, or which LICENSEE receives from the adverse party or parties. NIST and appropriate Government authorities shall have a continuing right to intervene in such suit.
- 6.5 In the event that a declaratory judgment action alleging invalidity or non-infringement of any of the Licensed Patent Rights shall be brought against LICENSEE or raised by way of counterclaim or affirmative defense in an infringement suit brought by LICENSEE under Article 6.4, pursuant to this Agreement and the provisions of Chapter 29 of Title 35, United States Code or other statutes, LICENSEE may: a) defend the suit in its own name, at its own expense, and on its own behalf for presumably valid claims in the Licensed Patent Rights; b) in any such suit, ultimately to enjoin infringement and to collect for its use, damages, profits, and awards of whatever nature recoverable for such infringement; and c) settle any claim or suit for declaratory judgment involving the Licensed Patent Rights-provided, however, that NIST and appropriate Government authorities shall have the first right to take such actions and shall have a continuing right to intervene in such suit. If NIST does not notify LICENSEE of its intent to respond to the legal action within a reasonable time, LICENSEE will be free to do so. LICENSEE shall take no action to compel the Government either to initiate or to join in any such declaratory judgment action. LICENSEE may request the Government to initiate or to join any such suit if necessary to avoid dismissal of the suit. Should the Government be made a party to any such suit by motion or any other action of LICENSEE, LICENSEE shall reimburse the Government for any costs, expenses, or fees which the Government incurs as a result of such motion or other action. If LICENSEE elects not to defend against such declaratory judgment action, NIST, at its option, may do so at its own expense. In all cases, LICENSEE agrees to keep NIST reasonably apprised of the status and progress of any litigation.
- 6.6 In any action under Articles 6.4 or 6.5, the expenses including costs, fees, attorney fees, and disbursements, shall be paid by LICENSEE. The value of any recovery made by LICENSEE through court judgment or settlement shall be treated as Net Sales and subject to earned royalties.
- 6.7 NIST shall cooperate fully with LICENSEE in connection with any action under Articles 6.4 or 6.5. NIST agrees promptly to provide access to all necessary documents and to render reasonable assistance in response to a request by LICENSEE.

ARTICLE VII. LICENSEE Performance

- 7.1 LICENSEE shall use its best efforts to bring the Licensed Products and Licensed Processes to Practical Application. "Best efforts" for the purposes of this Article shall include adherence to the Commercial Development Plan and achievement of the Benchmarks. The efforts of a SUBLICENSEE shall be considered the efforts of LICENSEE.
- 7.2 After bringing Licensed Products to the point of Practical Application in the United States, LICENSEE agrees to keep Licensed Products reasonably accessible to the public in the United States during the term of this Agreement.
- 7.3 LICENSEE agrees that all Licensed Products sold or otherwise disposed of in the United States by LICENSEE and Sublicensees will be manufactured substantially in the United States.

ARTICLE VIII. Duration, Modification and Termination

- 8.1 This Agreement is effective when signed by all parties ("Effective Date") and shall extend to the expiration of the last to expire of the Licensed Patent Rights, unless sooner terminated as provided for under this Article.
- 8.2 At any time upon ninety (90) days prior written notice, LICENSEE may unilaterally terminate this Agreement.
- 8.3 LICENSEE and NIST may mutually agree to modify or terminate this Agreement at any time.
- 8.4 Subject to the provisions of Articles 8.5, 8.6, 8.7, and 8.8, NIST may unilaterally terminate, in whole or in part, or may unilaterally modify this Agreement if NIST determines any of the following:
 - 8.4.1 LICENSEE commits a substantial breach of any promise, covenant or obligation or it fails to meet the obligations set forth in this Agreement, including but not limited to the requirement for U.S. manufacturing pursuant to Article 7.3; or
 - 8.4.2 LICENSEE is not executing the Commercial Development Plan submitted with its request for a license and the LICENSEE cannot otherwise demonstrate to NIST's satisfaction that the LICENSEE has taken, or can be expected to take within a reasonable time, effective steps to achieve Practical Application of the Licensed Products or Licensed Processes; or
 - 8.4.3 Action is necessary to meet requirements for public use specified by Federal regulations issued after the date of the license and such requirements are not reasonably satisfied by the LICENSEE; or
 - 8.4.4 LICENSEE cannot reasonably satisfy unmet health and safety needs; or
 - 8.4.5 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; or
 - 8.4.6 LICENSEE is adjudged 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
 - 8.4.7 LICENSEE is held by a court of competent jurisdiction to have misused any Licensed Patent Rights, including but not limited to violations of Federal antitrust laws in connection with its performance under this Agreement.
- 8.5 In making the determination of whether this License should be terminated under Article 8.4, NIST will take into account the normal course of such commercial development programs conducted with sound and reasonable business practices and judgment and the Progress Reports submitted by LICENSEE under Article V.

- 8.6 Prior to any modification or termination of this Agreement, NIST shall furnish LICENSEE a written notice of intention to modify or terminate the Agreement. 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.
- 8.7 If NIST terminates this Agreement, LICENSEE shall have a reasonable time in which to sell all Licensed Products in production or in inventory.
- 8.8 Upon termination of this Agreement or its modification removing any Licensed Patent Rights, LICENSEE shall immediately submit to NIST a Progress Report and a Royalty Report for the terminated or modified Licensed Patent Rights. Within thirty (30) days of such termination or modification, LICENSEE shall submit payment of sums due to NIST pursuant to Article IV for the terminated or modified Licensed Patent Rights. Notwithstanding the obligation under this Article, the rights and obligations of the parties hereto concerning the terminated or modified Licensed Patent Rights included in such modification or termination shall cease as of the effective date of such modification or termination.
- 8.9 Any modification or mutual agreement to terminate this License will be effective only when set forth in writing and signed by the authorized official(s) of each Party.

ARTICLE IX. General

- 9.1 LICENSEE shall place a Proprietary Information notice on all information, which the LICENSEE asserts is proprietary and delivers to NIST under this Agreement. If the Proprietary Information is in writing it shall be marked "confidential". If the Proprietary Information is not in writing, LICENSEE shall provide NIST with a written memorandum summarizing and designating such information as confidential within thirty (30) days of the disclosure. NIST agrees that any information designated Proprietary shall be used only for the purposes described herein. However, NIST may object to the designation of information as Proprietary Information and may decline to accept such information. Except where NIST is legally obligated to release information pursuant to the Freedom of Information Act (5 U.S.C. 552), or other requirement of law, Proprietary Information shall not be disclosed or otherwise made available in any form to any other person, firm, corporation, partnership, association, or other entity without the prior written consent of LICENSEE. NIST agrees to use its best efforts to maintain the confidentiality of Proprietary Information. NIST will promptly notify the LICENSEE of requests for LICENSEE's Proprietary Information. The LICENSEE agrees that NIST is not liable for the disclosure of information designated as Proprietary which, after notice to and consultation with the LICENSEE, NIST determines may not lawfully be withheld or which a court of competent jurisdiction requires to be disclosed.
- 9.2 These provisions are consistent with and do not supersede, conflict with, or otherwise alter the employee obligations, rights, or liabilities created by existing statute or Executive order relating to (1) classified information, (2) communications to Congress, (3) the reporting to an Inspector General of a violation of any law, rule, or regulation, or mismanagement, a gross waste of funds, an abuse of authority, or a substantial and specific danger to public health or safety, or (4) any other whistleblower protection. The definitions, requirements, obligations, rights, sanctions, and liabilities created by controlling Executive orders and statutory provisions are incorporated into this Agreement and are controlling.
- 9.3 NIST represents and warrants that NIST has the authority to grant licenses under the Licensed Patent Rights. 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 FOR ANY PARTICULAR PURPOSE OR ANY OTHER WARRANTY, EXPRESSED OR IMPLIED. NIST DOES NOT REPRESENT THAT IT WILL COMMENCE LEGAL ACTIONS AGAINST THIRD PARTIES INFRINGING THE LICENSED PATENT RIGHTS.
- 9.4 LICENSEE shall indemnify and hold NIST, its employees, students, fellows, agents, and consultants harmless from and against all liability, demands, damages, expenses, and losses, including but not limited to death,

personal injury, illness, or property damage in connection with or arising out of: a) the use by or on behalf of LICENSEE, Sublicensees, directors, employees, or parties of any Licensed Patent Rights; or b) the design, manufacture, distribution, or use of any Licensed Products, Licensed Processes or materials by LICENSEE, or other products or processes developed in connection with or arising out of the Licensed Patent Rights. LICENSEE agrees to maintain a liability insurance program consistent with sound business practice.

- 9.5 This Agreement shall not be assigned by LICENSEE to any party without the prior written consent of NIST. In no event shall LICENSEE assign or transfer this Agreement to a party not incorporated under or not governed by the laws of the United States of America.
- 9.6 LICENSEE acknowledges that it is subject to and agrees to abide by the United States laws and regulations (including but not limited to the Export Administration Act of 1979, and Arms Export Control Act) controlling the export of technical data, computer software, laboratory prototypes, biological material, and other commodities. The transfer of such items may require a license from the appropriate agency of the Government or written assurances by LICENSEE that it shall not export such items to certain foreign countries without prior approval of such agency. NIST neither represents that a license may be required, nor represents that if required, it shall be issued.
- 9.7 The Parties shall make every reasonable effort to resolve amicably any dispute concerning a question of fact arising under this Agreement. Any disputes not settled amicably between the Parties concerning a question of fact arising under this Agreement shall be decided by a designated NIST official, who shall reduce his or her decision to writing and mail or otherwise furnish a copy thereof to LICENSEE. The written decision of the designated NIST official to modify or terminate this Agreement to resolve the dispute shall be final and conclusive unless LICENSEE mails or otherwise furnishes to Office of Chief Counsel for NIST a written appeal within thirty (30) days of LICENSEE's receipt of the written decision. Pending final decision of a dispute hereunder, LICENSEE shall proceed diligently with the performance of its obligations under this Agreement.
- 9.8 The interpretation and application of the provisions of this Agreement shall be governed by the Federal laws of the United States as interpreted and applied by the Federal courts in the District of Columbia.
- 9.9 To the extent permitted or required by statute, LICENSEE and Sublicensees shall identify Licensed Products with the marking "Licensed under U.S. Patent [Patent Number(s)]" completed with the appropriate patent number(s). Where appropriate, LICENSEE, Affiliates and Sublicensees shall also mark Licensed Product(s) with a foreign patent notice in compliance with the laws of the countries in which the United States Department of Commerce owns the corresponding non-U.S. patents.
- 9.10 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 advertising or any promotional activity without the prior written approval of NIST.
- 9.11 Written notices required to be given under this Agreement shall be considered duly given on the date mailed if mailed by first class mail, postage prepaid and addressed as follows or such other address as either party may request in writing.

For written notices, royalty payments and reports to NIST:

National Institute of Standards and Technology
Attn: License Administrator
Technology Partnerships Office
100 Bureau Drive, MS 2200
Gaithersburg, MD 20899
E-mail: ipp@nist.gov

For written notices to LICENSEE:

Name
Title
Address
City, State Zip Code

9.12 This Agreement constitutes the entire understanding and supersedes all prior agreements and understandings between the Parties with respect to the subject matter hereof.

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

FOR *[NAME]*

Signature

Date

Name:
Title:

FOR THE NATIONAL INSTITUTE OF STANDARDS AND TECHNOLOGY

Henry Wixon
Chief Counsel for NIST

Date

[NAME]
Director, *[OU NAME]*

Date

Paul Zielinski
Director, Technology Partnerships Office

Date

APPENDIX A

I. Licensed Patent Rights/Patent Applications:

U.S. Patent [or Application] Number:

Title:

NIST Docket Number:

II. Licensed Territory: Licensed Territory is the United States of America, its territories, possessions and commonwealths.

III. Field of Use:

IV. Performance Benchmarks: The LICENSEE will adhere to the following Benchmarks (with number of months indicating months from the Effective Date of this Agreement) unless otherwise agreed upon by the parties and by written amendment to this Agreement. Pursuant to Article 5.3, LICENSEE shall notify NIST that the Benchmark has been achieved by written notice to the contact provided in Article 9.11 of this Agreement.

Date	Benchmark

V. Royalties Fee:

The Licensee shall pay the following minimum royalty fees in accordance with Article IV.

Calendar Year	Minimum Royalty Fee	Due Date
2015		
2016		
2017		
2018		

The Licensee shall pay royalty fees of ---- percent (----%) of all Net Sales worldwide.