

U.S. DEPARTMENT OF ENERGY
NATIONAL ENERGY TECHNOLOGY LABORATORY
NON-EXCLUSIVE PATENT LICENSE AGREEMENT

This Agreement is by and between the United States Department of Energy, represented by the National Energy Technology Laboratory (hereinafter called "LICENSOR"), and [Participant] (hereinafter called "LICENSEE"), collectively referred to as "Parties" and individually as "Party".

ADDRESS OF LICENSEE: [Insert Address]

LICENSED INVENTION: U.S. Patent No. [Patent No.], issued [Issue Date], titled [Patent Title], and any patents stemming therefrom.

SCOPE OF LICENSE: Non-exclusive license for [manufacture, use, sale, commercial evaluation, research] in the United States of America (United States).

LICENSE TERM: Full term of any issued patent based on the LICENSED INVENTION.

WITNESSETH:

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

WHEREAS: LICENSEE desires to obtain a non-exclusive license in the above-identified LICENSED INVENTION.

WHEREAS: The licensing of said LICENSED INVENTION under the terms provided herein is determined to be in the public interest and is in accordance with the regulations on Licensing of Government-Owned Inventions (37 C.F.R. 404) and DEPARTMENT OF ENERGY Patent Licensing Regulations (10 C.F.R. 781), as promulgated under the authority of Section 208 of Pub. L. 96-517 (35 U.S.C. 208), with royalties and other income received by the Federal Government to be distributed in accordance with the Stevenson Wylder Act as amended (15 U.S.C. 3710c).

NOW, THEREFORE, in consideration of the foregoing premises and of the mutual covenants and obligations hereinafter contained, and other good and valuable consideration, the Parties hereto agree as follows:

1. LICENSOR hereby grants to LICENSEE and LICENSEE hereby accepts, subject to the terms and conditions herein recited, a non-exclusive license to practice the LICENSED INVENTION as specified herein for the period of this License.
2. LICENSEE agrees to carry out the plan for [development and/or marketing, research, commercial evaluation] of the LICENSED INVENTION, as outlined in or submitted with the LICENSEE's Application for License, as may be amended from time to time with the

concurrence of LICENSOR, to bring the LICENSED INVENTION to practical application within [TBD], and thereafter to continue to make the benefits of this invention reasonably accessible to the public.

Comment [S1]: Take this part out if research or commercial evaluation license

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5. LICENSEE agrees that for use and sale in the United States any products embodying the LICENSED INVENTION or produced through the use of the LICENSED INVENTION will be manufactured substantially in the United States.
6. LICENSEE shall submit periodic written reports annually within 30 days following the anniversary date of this License, and when specifically requested by the LICENSOR, on its efforts [to bring the LICENSED INVENTION to a point of practical application, to use the LICENSED INVENTION in research, to commercially evaluate the LICENSED INVENTION], with particular reference to the development and marketing plan submitted, as outlined in or submitted with the LICENSEE's Application for License, and the extent to which the LICENSEE thereafter continues to make the benefits of the invention reasonably accessible to the public.
7. ROYALTY PROVISIONS: LICENSEE agrees to pay to LICENSOR:
 - a. An initial fee of [TBD], payable within 30 days following the execution of this License.
 - b. A minimum royalty of [TBD], payable within 30 days following the anniversary date of this License, or [TBD] percent of the gross sales price of product sold commercially, i.e. for use other than by or on behalf of the Federal Government that incorporates any allowed product claims of LICENSED INVENTION or is produced by the method of any allowed method claims of LICENSED INVENTION, payable within 30 days following the anniversary date of this License, whichever is greater. Gross sales price shall mean actual invoiced sales price free of transfer and bank fees and free of any taxes or other deductions.
 - c. [TBD] of any sublicense revenue received from sublicensing of the LICENSED INVENTION due within 30 days following the receipt of such sublicense revenue by LICENSEE.

8. LICENSEE shall pay to LICENSOR any royalty payments due and payable under this License.

Checks shall be made payable to the U.S. Department of Energy and forwarded to:

U.S. Dept. of Energy
National Energy Technology Laboratory
Finance Division
MS 921-227
626 Cochrans Mill Road
Pittsburgh, PA 15236-0940

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Comment [S2]: NOTE: NETL cannot indemnify Licensee.

14. LICENSOR makes no representation or warranty that Letters Patent will issue on such patent application(s).

Comment [S3]: Take out if does not apply

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17. The points of contact for the LICENSEE and LICENSOR are as follows:

LICENSOR:

Technical Contact:

Name

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Administrative Contact:

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LICENSEE:

Technical Contact:

Name

Address

Phone:

Email:

Administrative Contact:

Name

Address

Phone:

Email:

Any communications shall be deemed made if mailed by postage prepaid first class U.S. Mail addressed to the point of contact of the receiving Party as of the day of receipt of such communication by the addressee or on the date given if by verified facsimile or on the date given by if by electronic mail.

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DEPARTMENT OF ENERGY,

NATIONAL ENERGY TECHNOLOGY LABORATORY: LICENSEE:

By: _____

Grace M. Bochenek, Ph.D.

Title: Director

Date: _____

By: _____

Title: _____

Date: _____

Non-exclusive License: AGMT-XXXX