

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 U.S.A. .

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 policy of 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 Government to be distributed in accordance with the Stevenson Wydler 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.

3. This License may extend to subsidiaries of the LICENSEE, but it not assignable or otherwise transferable without approval of LICENSOR in writing, except to the successor of that part of LICENSEE's business to which the LICENSED INVENTION pertains.
4. Sublicenses under this license may not be granted without the approval of LICENSOR. LICENSEE shall promptly furnish LICENSOR with a copy of any proposed sublicense, and if in a foreign language, an English text thereof. Any sublicense shall not be effective until approval is secured from LICENSOR in writing. A sublicense shall make reference to this License, including the rights retained by the Government.
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. LICENSEE agrees to pay to LICENSOR 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 U.S. 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.
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

LICENSEE shall keep true books of account containing an accurate record of all data necessary for the computation of any royalty fees payable under this License, and shall render to LICENSOR annually, within thirty days of the anniversary date of this License, an accurate statement of performance under this License, whether or not royalties are payable under this License. Such a statement shall be in writing, showing in reasonable detail the identification of licensed products incorporating any part of the LICENSED INVENTION sold by LICENSEE. LICENSEE shall from time to time permit the LICENSOR, by its authorized representative, to examine the books of account of LICENSEE to such an extent as may be reasonably necessary for LICENSOR to determine the accuracy of any such statement.

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

LICENSOR:

Technical Contact:

Department of Energy
3610 Collins Ferry Rd
P.O. Box 880
Morgantown, WV 26507-0880
Phone:
Email:

Administrative Contact:

Jessica Sosenko
Department of Energy
626 Cochrans Mill Road
P.O. Box 10940
Pittsburgh, PA 15236-0940
Phone: 412.386.7417
Email:
jessica.sosenko@netl.doe.gov

LICENSEE:

Technical Contact:

[INSERT NAME]
[ADDRESS]
[PHONE]
[EMAIL]

Administrative Contact:

[INSERT 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.

18. LICENSEE has a right to appeal, in accordance with procedures specified in 10 CFR 781, any decision concerning the modification or termination, in whole or in part, of this License.

- 19. LICENSEE may terminate this License, after the first or any subsequent anniversary date of this License, upon not less than sixty (60) days prior written notice to the LICENSOR. Paragraphs 10, 11, and 12 shall survive any termination.
- 20. This License may be signed in one or more counterparts, each of which shall be deemed an original, and all of which taken together shall be deemed one and the same instrument.
- 21. This License is effective on the date affixed hereto by the Party last signing this License.

DEPARTMENT OF ENERGY,
NATIONAL ENERGY TECHNOLOGY LABORATORY: LICENSEE:

By: _____

By: _____

Title: Director, NETL

Title: _____

Date: _____

Date: _____