

**LICENSE AGREEMENT NUMBER xxxxxx**

**BETWEEN**

**BATTELLE MEMORIAL INSTITUTE**

**AND**

**DATE**

SAMPLE

**BUSINESS SENSITIVE**

## NON-EXCLUSIVE PATENT LICENSE

THIS AGREEMENT is made and entered into at Richland, Washington, by and between \_\_\_\_\_ having a principal place of business in XXXX, XXXX, herein called "LICENSEE", and Battelle Memorial Institute, having a place of business in Richland, Washington, herein called "BATTELLE". Each hereinafter referred to individually as "Party" and jointly as "Parties". This Agreement is effective on the date affixed hereto by the Party last signing this Agreement (the "Effective Date").

### WITNESSETH THAT:

WHEREAS, BATTELLE is an incorporated charitable trust exempt from federal income taxes under Section 501(c)(3) of the United States Internal Revenue Code; and

WHEREAS, BATTELLE operates the Pacific Northwest National Laboratory under management and operations contract DE-AC05-76RL01830; and

WHEREAS, BATTELLE has certain rights in patents relating to \_\_\_\_\_; and

WHEREAS, LICENSEE recognizes that BATTELLE owns inventions and intellectual property useful in the conduct of LICENSEE's business; and

WHEREAS, LICENSEE recognizes that its anticipated business activity may encompass the practice of technology that requires a license under patents owned or controlled by BATTELLE; and

WHEREAS, LICENSEE wishes to acquire the right to practice the inventions of such patents.

THEREFORE in consideration of the mutual covenants a contained herein and intending to be legally bound hereby, the Parties agree as follows:

### **1. DEFINITIONS**

As used herein, the following terms shall have the meanings set forth below:

- A. **AFFILIATE** or **AFFILIATES** means any entity that controls, is controlled by, or is under common control of LICENSEE where control consists of ownership of at least fifty percent (50%) of the outstanding voting securities or other ownership interest of the entity.
- B. **GROSS SALES** means any and all forms of consideration, monetary or otherwise, received by LICENSEE from the sale, lease, rental, transfer, provision or other disposition of LICENSED PRODUCTS and/or LICENSED SERVICES without deduction.
- C. **INVENTION** or **INVENTIONS** means the subject matter described in the following BATTELLE invention reports. This invention report is included herein only until such time that a patent application is filed or a PATENT is issued:
  - (i) Invention Report No. XXX (**Contractually mandated patent filing deadline date is XXX**)

\_\_\_\_\_  
\*This INVENTION arose under U.S. Government funding and is included herein only until such time that a patent application is filed or a PATENT is issued on such INVENTION, at which time such patent application or issued PATENT shall be included in the definition of the term "PATENT" set forth herein.

- D. **LICENSED FIELD 1** means and is limited to:

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- E. LICENSED FIELD 2 means and is limited to
- F. LICENSED FIELD 1 and LICENSED FIELD 2 shall collectively be known as LICENSED FIELDS when no distinction is desired.
- G. LICENSED PROCESS means any service or activity that utilizes, incorporates or practices the INVENTIONS and/or one or more claims of the PATENTS.
- H. LICENSED PRODUCT means any and all products incorporating or utilizing the INVENTIONS and/or one or more claims of the PATENTS.
- I. LICENSED SERVICES means the provision of a LICENSED PROCESS for a third party.
- J. LICENSED TERRITORY means any country in which BATTELLE has pending patent applications or issued PATENTS as set forth herein for which LICENSEE has reimbursed BATTELLE for agreed upon patenting expenses under Article 12.
- K. NET SALES means GROSS SALES less shipping charges, returns, and taxes, for the sale, lease, rental, transfer, or other disposition or provision of LICENSED PRODUCTS or LICENSED SERVICES, or the fair market value for LICENSED PRODUCTS or LICENSED SERVICES if such LICENSED PRODUCTS or LICENSED SERVICES are sold, leased, rented, transferred, or otherwise provided at less than the fair market value. For purposes of this Agreement, “fair market value” is the consideration received by LICENSEE for equivalent products or services in arms-length transactions. In the event any LICENSED PRODUCTS or LICENSED PROCESSES are sold, leased, rented, transferred or otherwise provided between LICENSEE and one of its AFFILIATES or between two of LICENSEE’s AFFILIATES, or such LICENSED PRODUCT or LICENSED PROCESS is used by LICENSEE or one of its AFFILIATES, LICENSEE shall calculate and pay royalties to BATTELLE based on the fair market value for such LICENSED PRODUCTS or LICENSED PROCESS.
- L. PATENT or PATENTS means issued patents and pending patent applications [set forth in Appendix 1] and the resulting issued patents filed on INVENTIONS, including all divisionals, continuations (not including continuations–in-part), reissues, substitutes, and extensions thereof, together with all foreign counterparts:

## **2. LICENSE GRANT**

- A. BATTELLE hereby grants to LICENSEE, to the extent of the LICENSED FIELD and LICENSED TERRITORY, a nonexclusive commercial license to make, have made, use, import and sell LICENSED PRODUCTS and LICENSED SERVICES and practice LICENSED PROCESSES. **[Affiliates who are identified and approved may be added, in the discretion of Battelle]**
- B. All other rights not expressly granted in this Agreement are reserved by BATTELLE.
- C. This license grant is subject to any rights belonging to the United States Government, whether or not presently asserted, including but not limited to those rights set forth in 35 USC section 200 et seq.

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### **3. CONSIDERATION**

- A. In consideration for the License Grant described in Article 2, LICENSEE agrees to comply with all the provisions of this Agreement, to pay all fees, costs, and meet all other requirements set forth in this Agreement.
- B. LICENSEE shall pay to BATTELLE the nonrefundable sum of \_\_\_\_\_ United States Dollars (\$\_\_\_\_\_US) at the time of execution of this Agreement. This fee is nonrefundable, not creditable against any royalties and is not an advance on royalties.
- C. LICENSEE shall pay to BATTELLE A royalty of \_\_\_\_\_ percent (\_\_\_%) of NET SALES.
- D. No royalty shall be paid to BATTELLE for the practice of any PATENT on behalf of the U.S. Government for which the U.S. Government has a royalty-free right to use such PATENT.

### **4. MINIMUM ROYALTIES**

- A. LICENSEE shall pay to BATTELLE royalties as stated in Article 3, but in no event shall royalties for a calendar year be less than the amounts set forth in Table 1, below, during each of the calendar years indicated. LICENSEE shall pay to BATTELLE on the last day of the following January the amount (if any) required to satisfy the minimum royalty obligation for the preceding calendar year. If LICENSEE does not pay the amount (if any) required to be paid hereunder to satisfy the minimum royalty obligation, BATTELLE may, in its sole discretion, elect to terminate this Agreement or waive this obligation in whole or in part.

**Table 1.**

Calendar Year	Minimum Royalties US \$ Per Calendar Year
20XX	\$000
Each year thereafter	\$000

- B. If this Agreement expires or is terminated for any reason, except for breach of contract by BATTELLE, during any year that minimum royalties are due to BATTELLE, upon expiration or termination, LICENSEE shall immediately pay to BATTELLE the proportionate amount of minimum royalties owed to BATTELLE that represents that portion of the year elapsed prior to expiration or termination. For example, if LICENSEE terminates without breach by BATTELLE after the expiration of three (3) months of the new year, LICENSEE shall pay to BATTELLE one-fourth (1/4) of the yearly minimum royalty due for that year.

## **5. DILIGENCE**

- A. Separate from LICENSEE's obligation to pay minimum royalties set forth above, beginning in the calendar year \_\_\_\_\_, and for each calendar year thereafter. LICENSEE shall complete the following diligence requirements. In the event that LICENSEE fails to meet these diligence requirements BATTELLE may, in its sole discretion, elect to terminate this Agreement, or waive this obligation in whole or in part.
- B. Minimum Diligence Term

On or before Date	Milestone Description
X, Y, 20ZZ	SAMPLE
X, Y, 20ZZ	SAMPLE
X, Y, 20ZZ	SAMPLE

## **6. U.S. MANUFACTURING**

In order to enhance U.S. industrial competitiveness, LICENSEE shall ensure that LICENSED PRODUCTS embodying the PATENTS which are manufactured for use or sale in the United States under the license granted hereunder shall be substantially manufactured in the United States.

## **7. SUBLICENSING**

Licensee shall have no ability to sublicense.

## **8. REPORTS AND PAYMENTS**

- A. Not later than the last day of each January and July LICENSEE shall furnish to BATTELLE a written statement in a form provided by BATTELLE (Attachment 1) to determine the amounts due and the appropriateness of the royalties paid pursuant to Article 3 for the periods ended the last days of the preceding December and June respectively, and shall pay to BATTELLE all amounts due to BATTELLE. Such amounts are due at the dates the statements are due. If no amount is accrued during any quarterly period, a written statement to that effect shall be furnished. All written statements provided to BATTELLE by LICENSEE shall be executed by an individual having actual authority to bind LICENSEE.
- B. LICENSEE shall notify BATTELLE in each report required hereunder of a change in ownership or control of LICENSEE that includes non-U.S. interests, and including addition of one (1) or more officers, directors, or other managing entity that is not a U.S. person as defined under current U.S. laws and regulations pertaining to citizenship and legal status of persons and business corporations.

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LICENSEE shall include a description of the change, and the name and address, and any other relevant identifying information, when reporting such change. BATTELLE reserves the right to amend this Agreement in response to any such change if necessary to comply with laws, regulations and government orders then in effect or as may be required at any point in the future.

- C. Not later than the last day of each January, LICENSEE shall furnish to BATTELLE, at the address set forth in Article 25, a written progress report summarizing LICENSEE's progress towards commercializing the LICENSED PRODUCTS during the prior calendar year. Such progress report shall include the following information, where relevant: progress in the development and commercial deployment of the LICENSED PRODUCT; key business achievements; projects or transactions that resulted from, or were enabled by, the LICENSED PRODUCT; and quantitative or qualitative information that characterizes the contribution of the LICENSED PRODUCT to the U.S. economy. Such report will be provided to BATTELLE solely to enable BATTELLE to understand LICENSEE's progress towards commercializing the LICENSED PRODUCT and to assist BATTELLE in determining the contribution of the LICENSED PRODUCT in improving LICENSEE's business.
- D. Royalties earned on sales by LICENSEE in any country outside the United States shall not be reduced by LICENSEE for any taxes, fees, or other charges imposed by the government of such country on the payment of royalty income.
- E. Payments provided for in this Agreement, shall when overdue, bear interest at a rate per annum equal to 5% percent running from the time such payment is due until payment is made to BATTELLE.
- F. All payments made to BATTELLE under this Agreement are nonrefundable.
- G. All payments will be made to BATTELLE in U.S. dollars either by check or wire transfer. Upon making payment by either method, LICENSEE shall also provide a written report to BATTELLE to the address set forth in Article 25 as required in Paragraph 8A, above, along with a statement indicating that payments have been made by check, or by Electronic Funds Transfers.

- (i) If payments are made by check, please submit payment in U.S. funds to:

Battelle  
Deposit Information

- (ii) If payments are made by wire transfer, such transfers shall be in accordance with the following wire instructions; unless and until written notice is provided by BATTELLE of a change in the wire instructions. Such payments shall be made to the following account (for international transfers, use Swift Code: XXXXXXXX):

Bank Wire Transfer Information

## **9. REPRESENTATIONS, HOLD HARMLESS AND LIMITATION OF BATTELLE'S LIABILITY**

- A. This Agreement is entered into by BATTELLE in its private capacity. It is understood and agreed that the U.S. Government is not a party to this Agreement and in no manner whatsoever shall be liable for nor assume any responsibility or obligation for any claim, cost or damages arising out of or resulting from this Agreement or the subject matter licensed.
- B. (i) **Nothing in this Agreement shall be deemed to be a representation or warranty, by BATTELLE, or the U.S. Government, as to the validity of any of the PATENTS or the**

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**accuracy, safety or usefulness for any purpose, of any technical information, techniques, or practices at any time made available by BATTELLE.**

(ii) Neither the U.S. Government nor BATTELLE nor any affiliated company of BATTELLE **shall have any liability whatsoever** to LICENSEE or any other person for or on account of any injury, loss, or damage, of any kind or nature sustained by, or any damage assessed or asserted against, or any other liability incurred by or imposed upon LICENSEE or any other person, arising out of or in connection with or resulting from (1) the production, use or sale of any apparatus or product, or the practice of the PATENTS by LICENSEE; (2) the use by LICENSEE of any technical information, techniques, or practices disclosed by BATTELLE; or (3) any advertising or other promotional activities by LICENSEE with respect to any of the foregoing; and

(iii) **LICENSEE shall hold the U.S. Government, BATTELLE, and any affiliated company of BATTELLE, harmless** in the event the U.S. Government, BATTELLE, or any affiliated company of BATTELLE, is held liable as a result of actions by LICENSEE as set forth in Paragraphs 9B(ii)(1), 9B(ii)(2), and 9B(ii)(3) above. This includes but is not limited to indemnification for any product liability resulting from the commercialization and utilization of the Licensed Patents by LICENSEE.

(iv) Further, LICENSEE **agrees to assume the defense** of (1) any suit brought against BATTELLE or any affiliated company of BATTELLE resulting from any action of LICENSEE undertaken under this Agreement, and (2) any action brought against LICENSEE or BATTELLE resulting from any action of LICENSEE relating to the licensed PATENTS.

(v) BATTELLE represents that it has the rights to grant all of the rights granted herein, except as to such rights as the Government of the United States of America may have or may assert.

- C. **LICENSEE understands and acknowledges that the subject matter of this Agreement has not yet been commercially demonstrated, and agrees to accept the risks incident to designing, manufacturing and operating a nascent technology.**
- D. LICENSEE acknowledges that LICENSEE has evaluated the INVENTIONS and PATENTS and deems them suitable for LICENSEE's purposes for entering into this Agreement.
- E. Nothing in this Agreement may be construed as: a warranty or representation by BATTELLE as to the validity of any of BATTELLE's rights in the PATENTS; a warranty or representation that anything made, used, sold or otherwise disposed of under any license granted in this Agreement is or will be free from infringement of any patents other than PATENTS; a grant by implication, estoppel or otherwise of any license or rights under any patents of BATTELLE other than PATENTS, regardless of whether such patents are dominate or subordinate to PATENTS; or an obligation to furnish any information not provided in PATENTS.

## **10. TERMINATION**

- A. This Agreement will terminate upon the expiration of the last to expire of the PATENTS included herein, or upon the abandonment of the last to be abandoned of any patent applications if no PATENTS have issued, or a final adjudication of invalidity of all PATENTS included herein, whichever is later, unless this Agreement is sooner terminated.
- B. LICENSEE may terminate this Agreement at any time upon sixty (60) days written notice in advance to BATTELLE. LICENSEE shall thereafter discontinue the practice and use of the licensed PATENTS.
- C. If either Party shall be in breach of any obligation hereunder, the other Party may terminate this Agreement by giving Notice of Default by personal delivery, telefax, electronic mail transmission or

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by United States mail, express mail, or courier service, with postage or fees prepaid, to the Party in breach, specifying the basis for default. Notice by personal delivery, telefax or electronic mail is deemed to have been given when delivered or transmitted. Notice sent by U.S. mail, express mail or courier service is deemed to have been given when mailed. If within sixty (60) days after the receipt of such Notice of Default, the Party in breach shall remedy the condition forming the basis for default, this Agreement shall continue in full force. If, however, the default is not cured within this sixty (60) day period, then this license shall finally terminate and LICENSEE shall be required to thereafter discontinue the practice and use of the licensed PATENTS. This sixty (60) day cure period shall not be available to LICENSEE upon a third Notice of Default during the life of this Agreement (unless otherwise provided in the Notice of Default), and this Agreement shall be finally terminated. LICENSEE understands and acknowledges that the remedy set forth herein is not available to LICENSEE if LICENSEE's default stems from a failure to meet the minimum diligence requirements of Article 5.

- D. If any report or payment due to BATTELLE is overdue for a third time, then a Notice of Termination may be sent immediately and no Notice of Default or sixty (60) day cure provision will be applicable.
- E. Within thirty (30) days of the termination of this Agreement, LICENSEE shall furnish a final report containing the information set forth in Paragraphs 8A and 8B as well as payment of any unpaid royalties to the address set forth in Article 25 even though the due dates provided in Articles 8 and 12 may not have been reached.
- F. Termination of this Agreement shall not extinguish any rights of BATTELLE or obligations of LICENSEE accrued hereunder at the time of termination; and obligations undertaken independent of the license granted under Article 2 shall survive termination to the extent necessary to permit their complete fulfillment or discharge.

## **11. LITIGATION**

- A. LICENSEE shall notify BATTELLE of any actual infringement of the PATENTS in the LICENSED FIELDS and the LICENSED TERRITORY, and shall provide BATTELLE with any evidence supporting such belief.
- B. The sole right to institute suit for infringement shall rest with BATTELLE and BATTELLE shall retain all proceeds from any recovery resulting therefrom.
- C. LICENSEE agrees to reasonably assist BATTELLE with any legal action undertaken to abate the infringement. BATTELLE agrees to reimburse LICENSEE for any reasonable out-of-pocket costs incurred by LICENSEE in providing assistance to BATTELLE.
- D. Challenges
  - (i) LICENSEE shall provide BATTELLE with at least ninety (90) days written notice to the address set forth in Article 25 before LICENSEE or any of LICENSEE's AFFILIATES, subsidiaries, joint venturers, or other similarly situated persons, entities, or organizations initiates any action or proceeding or assists any third party initiating an action or proceeding against BATTELLE seeking a declaration or ruling that any claim of the PATENTS is invalid or unenforceable or that LICENSED PRODUCTS or LICENSED PROCESSES do not infringe any claim of the PATENTS. LICENSEE shall include with its written notice to BATTELLE a copy of all relevant prior art which will form the basis for arguments and causes advanced in such action or proceeding, together with an explanation of the grounds for these arguments or causes. Failure to provide such notice shall be considered a breach of the agreement and provide grounds for automatic termination of the license.

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- (ii) Any action or proceeding filed by LICENSEE or any of LICENSEE's AFFILIATES, subsidiaries, joint venturers, or other similarly situated persons, entities, or organizations or any third party assisted thereby seeking a declaration or ruling that any claim of the PATENTS is invalid or unenforceable or that LICENSED PRODUCTS or LICENSED PROCESSES do not infringe any claim of the PATENTS shall be litigated exclusively in the U.S. District Court for the Eastern District of Washington situated in Richland, Washington, and the Parties hereby agree to submit to the exclusive jurisdiction of such court and waive any objection to venue for such purposes.

## **12. PATENTS**

- A. BATTELLE will endeavor to keep in communication with LICENSEE regarding patent matters including consulting with LICENSEE prior to making any foreign patent filings. However, BATTELLE retains the sole unfettered right and discretion to make any and all decisions regarding patenting matters. This includes the sole right to determine whether or not, and where, to file a patent application, to abandon the prosecution of any PATENT or patent application, or to discontinue the maintenance of any PATENT or patent application. This also includes the power to make any decision regarding prosecuting, reexamining, or participating in any proceeding before a patent office, domestic or foreign. All reasonable expenses incurred by BATTELLE for the activities described in this Paragraph 12A shall be reimbursed to BATTELLE by LICENSEE on a pro-rata basis within sixty (60) days of LICENSEE's receipt of notice setting forth such expenses.
- B. If LICENSEE disagrees with a patenting decision and elects not to pay its share of expenses incurred under Paragraph 12A for a particular PATENT, LICENSEE shall so notify BATTELLE in writing. Unless otherwise agreed, LICENSEE shall be obligated to reimburse BATTELLE for its share of expenses for such PATENT costs up to the date BATTELLE receives such written notification, as well as any additional costs BATTELLE may incur if it abandons such patent application or PATENT. Upon receipt of written notification by BATTELLE, LICENSEE's rights related to such PATENT in the applicable country(ies) shall be terminated, and that PATENT in those country(ies) will be removed from this Agreement.

## **13. RECORDS**

- A. LICENSEE shall keep accurate records of all operations affecting LICENSEE's duties and obligations hereunder, including but not limited to payment of royalties and fees, and shall permit BATTELLE or its duly authorized agent to inspect all such records and to make copies of or extracts from such records during regular business hours throughout the term of this Agreement and for a period of not less than three (3) years thereafter. BATTELLE shall bear its costs to conduct such audit; provided, however, LICENSEE shall reimburse BATTELLE for BATTELLE's and/or its duly authorized agent's actual costs to conduct the audit if as part of the audit it is deemed that LICENSEE has failed to perform its material obligations under this Agreement (including its underreporting of NET SALES and earned royalties in a reporting period by ten percent (10%) or more).
- B. If such audit shows an underreporting or underpayment in excess of ten percent (10%) in a reporting period, then LICENSEE shall pay the cost of such audit, as well as any other additional sum that would have been payable to BATTELLE had LICENSEE reported correctly, plus interest on said sum at the rate set forth and owing in accordance with Paragraph 8D.

#### **14. ASSIGNABILITY**

- A. Upon written consent of BATTELLE, such consent not to be unreasonably withheld, LICENSEE may assign its rights under this Agreement in connection with a merger or consolidation or to a third party purchaser of all or substantially all of the assets of LICENSEE relative to the rights granted hereunder. BATTELLE may assign its rights hereunder.
- B. In the event of any assignment of this Agreement, LICENSEE shall pay to BATTELLE, at the address set forth in Article 25, a nonrefundable assignment fee of X Thousand United States Dollars (\$X0,000 US).

#### **15. REFORM**

- A. The Parties agree that if any part, term, or provision of this Agreement shall be found illegal or in conflict with any valid controlling law, the validity of the remaining provisions shall not be affected thereby.
- B. In the event the legality of any provision of this Agreement is brought into question because of a decision by a court of competent jurisdiction of any country in which this Agreement applies, BATTELLE, by written notice to LICENSEE, may revise the provision in question or may delete it entirely so as to comply with the decision of said court.

#### **16. NO ENDORSEMENT; USE OF BATTELLE'S NAME; USE OF PNNL**

BATTELLE does not endorse products or services. Therefore, LICENSEE agrees that unless required by law, or unless otherwise agreed in advance in writing by BATTELLE, LICENSEE will not use or imply the name "BATTELLE", or any affiliated company of BATTELLE, or "Pacific Northwest National Laboratory", or "PNNL", or associated trademarks, or other trade dress, or use BATTELLE or PNNL reports, for advertising, promotional purposes, raising of capital, recommending investments, or in any way that implies endorsement by BATTELLE or PNNL. However, LICENSEE may publicly disclose the fact that an agreement has been entered into with BATTELLE, including the name of BATTELLE. LICENSEE may disclose in a factual manner that is accurate and not misleading, material facts pertaining to the nature of this Agreement to the extent such disclosure complies with or is required by applicable U.S. Federal and state securities and other laws or the rules and regulations of any public stock exchange, provided that such disclosure does not, in whole or in part, imply any endorsement by BATTELLE or PNNL. LICENSEE further agrees to indemnify and hold BATTELLE, its directors, officers, agents and employees harmless for any damage, loss, claim or suit arising from or relating to LICENSEE's use of the BATTELLE name.

#### **17. WAIVER AND ALTERATION**

- A. The waiver of a breach hereunder may be effected only by a writing signed by the waiving Party and shall not constitute a waiver of any other breach.
- B. A provision of this Agreement may be altered only by a writing signed by both Parties, except as provided in Article 15, above.
- C. (i) To amend this Agreement in a manner that alters any of BATTELLE's rights or LICENSEE's duties under this Agreement, LICENSEE shall provide BATTELLE with a written request to amend this Agreement at least thirty (30) calendar days before BATTELLE's rights or LICENSEE's duties accrue. LICENSEE's request shall: (1) specifically identify the clauses to be amended; (2) identify

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the requested amendments; and (3) provide BATTELLE with documentary evidence that the requested amendments are in BATTELLE's and LICENSEE's best interests.

(ii) If BATTELLE determines that any or all of LICENSEE's requested amendments are in the Parties' best interests, then the Parties shall initiate good faith negotiations to address the amendments consistent with BATTELLE's determination. Such negotiations shall conclude within ninety (90) days after the date BATTELLE actually receives LICENSEE's request to amend the Agreement as set forth above in Paragraph 17C (i) (the "Renegotiation Period"). The Parties shall enter into these negotiations with the understanding that they may not reach mutually acceptable terms within the Renegotiation Period. BATTELLE's rights shall continue to accrue and LICENSEE's obligations shall remain in force during the Renegotiation Period.

(iii) If BATTELLE and LICENSEE agree to mutually acceptable terms during the Renegotiation Period, then such renegotiated terms shall be reflected in a formal amendment of this Agreement executed by both BATTELLE and LICENSEE and shall apply to any of BATTELLE's rights or LICENSEE's obligations that accrue during the Renegotiation Period or at any time thereafter during the remaining term of this Agreement.

(iv) If BATTELLE and LICENSEE do not agree to mutually acceptable terms during the Renegotiation Period then BATTELLE may enforce the original terms and conditions of this Agreement or rely upon other remedies as permitted by the terms of this Agreement.

- D. LICENSEE acknowledges that BATTELLE, by virtue of its status as an incorporated charitable trust exempt from federal income taxes under Section 501(c)(3) of the Internal Revenue Code, cannot renegotiate any terms of this Agreement in a manner which may create an impermissible private benefit or private inurement.

### **18. MARKING**

LICENSEE shall place in a conspicuous location on any LICENSED PRODUCT made or sold under any PATENT coming with this Agreement, a patent notice in accordance with the laws concerning the marking of patented articles. However, in no event shall LICENSEE mark any LICENSED PRODUCT made or sold under this Agreement with an expired licensed PATENT.

### **19. IMPLEMENTATION**

Each Party shall execute any instruments necessary to implement the provisions of this Agreement.

### **20. CONSTRUCTION**

This Agreement shall be construed in accordance with the laws of the State of Washington of The United States of America and in the English language, and any action brought to enforce any provision or obligation hereunder shall be brought in a court of competent jurisdiction in the State of Washington.

### **21. EXPORTATION OF TECHNICAL INFORMATION**

LICENSEE represents and warrants that it shall not export from The United States of America directly or indirectly, any technical information (or the direct product thereof) furnished to

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LICENSEE either directly or indirectly by BATTELLE, without first complying with all requirements of the Export Administration Regulations, including the requirement for obtaining any export license, if applicable. LICENSEE agrees to indemnify, defend and hold harmless BATTELLE, its officers, agents and employees from all liability involving the violation of such export regulations, either directly or indirectly, by LICENSEE.

## **22. DISCLAIMER**

**NEITHER BATTELLE, THE UNITED STATES DEPARTMENT OF ENERGY (DOE), NOR PERSONS ACTING ON THEIR BEHALF MAKE ANY WARRANTY, EXPRESS OR IMPLIED: (1) WITH RESPECT TO THE MERCHANTABILITY, ACCURACY, COMPLETENESS OR USEFULNESS OF ANY SERVICES, MATERIALS, LICENSED PATENTS, INVENTIONS OR INFORMATION FURNISHED HEREUNDER; (2) THAT THE USE OF ANY SUCH SERVICES, MATERIALS, LICENSED PATENTS, OR INFORMATION WILL NOT INFRINGE PRIVATELY OWNED RIGHTS; (3) THAT THE SERVICES, MATERIALS, LICENSED PATENTS, OR INFORMATION FURNISHED HEREUNDER WILL NOT RESULT IN INJURY OR DAMAGE WHEN USED FOR ANY PURPOSE; OR (4) THAT THE SERVICES, MATERIALS OR INFORMATION FURNISHED HEREUNDER WILL ACCOMPLISH THE INTENDED RESULTS OR ARE SAFE FOR ANY PURPOSE, INCLUDING THE INTENDED OR PARTICULAR PURPOSE. FURTHERMORE, BATTELLE AND THE DOE HEREBY SPECIFICALLY DISCLAIM ANY AND ALL WARRANTIES, EXPRESS OR IMPLIED, FOR ANY PRODUCTS MANUFACTURED, USED OR SOLD BY LICENSEE, THEIR AFFILIATES, ASSIGNS OR SUBLICENSEES. NEITHER BATTELLE NOR THE DOE SHALL BE LIABLE FOR CONSEQUENTIAL, SPECIAL, OR INCIDENTAL DAMAGES IN ANY EVENT.**

## **23. NO PRESUMPTION**

No provision of this Agreement shall be interpreted for or against any Party to this Agreement on the basis that that Party was the drafting Party of the provision and no presumption or burden of proof shall arise disfavoring or favoring any Party by virtue of the authorship of any of the provisions of this Agreement.

## **24. ENTIRE UNDERSTANDING**

This Agreement represents the entire understanding between the Parties, and supersedes all other agreements, express or implied, between the Parties concerning the subject matter of this Agreement. Specifically, no future representations made by BATTELLE staff shall be effective to alter any provision herein unless such representation shall be made in writing by an authorized representative of BATTELLE having the power to do so.

## **25. ADDRESSES**

For the purpose of all written communications between the Parties, their addresses shall be:

Company Name  
Attention \_\_\_\_\_  
Street Address

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City, State, Zipcode  
Telephone:  
Fax:  
Email:

Battelle Memorial Institute  
Technology Deployment and Outreach  
Attention PNNL Compliance Office  
P.O. Box 999, Mailstop K1-71  
902 Battelle Blvd.  
Richland, WA 99352  
Telephone: (509) 375-2075  
Fax: (509) 372-4589  
Email: [complianceoffice@pnnl.gov](mailto:complianceoffice@pnnl.gov)

or any other addresses of which either Party shall notify the other Party in writing.

**26. EXPIRATION**

The offer to execute this Agreement shall expire if this Agreement is not signed by both Parties and returned to BATTELLE on or before \_\_\_\_\_.

IN WITNESS WHEREOF, each of the Parties hereto has caused this Agreement to be executed in duplicate originals by its duly authorized officers or representatives.

**BATTELLE MEMORIAL INSTITUTE**

BY _____	BY _____
PRINTED _____	PRINTED _____
NAME _____	NAME _____
TITLE _____	TITLE _____
DATE _____	DATE _____

ATTACHMENT 1

**ROYALTY REPORT TO BATTELLE**

From: \_\_\_\_\_  
(Company Name and License Agreement No.)

Reporting Period:

From \_\_\_\_\_ To \_\_\_\_\_ (6 Month Period Ending, June 30, and December 31, to be Reported by the Following July 31 and January 31 respectively).

From \_\_\_\_\_ To \_\_\_\_\_ (6 Month Period Ending, June 30, and December 31, to be Reported by the Following July 31 and January 31 respectively).

Article 3, CONSIDERATION

(i) GROSS SALES OF LICENSED PRODUCTS	\$ _____	X x
Amount of Royalties Owed	\$ _____	
(ii) GROSS SALES of LICENSED SERVICES	\$ _____	X x
Amount of Royalties Owed	\$ _____	
Total Royalties Due	\$ _____	

Signed by: \_\_\_\_\_

Printed Name: \_\_\_\_\_

Date: \_\_\_\_\_

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

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

