

SOFTWARE PATENT LICENSE AGREEMENT

**Regents of the University of Minnesota**

**and**

**[Insert Name of Licensee]**

TECHNOLOGY COMMERCIALIZATION

200 Oak Street, SE | Suite 280 | Minneapolis, MN 55455

OTC Agreement Number: **Insert Agreement Number**| OTC Case Number **: Insert OTC Case Number**

**SOFTWARE LICENSE AGREEMENT**

**THIS SOFTWARE LICENSE AGREEMENT** (this “Agreement”) is made as of the Effective Date by and between the Regents of the University of Minnesota, a constitutional corporation under the laws of the state of Minnesota, having a place of business at 200 Oak Street, SE, Suite 280, Minneapolis, Minnesota 55455 (the “University”), and the person identified below as Licensee identified below.

The Agreement consists of the **Business Terms**, **General Terms** and any attached and referenced exhibits or schedules.

**BUSINESS TERMS**

|  |  |  |
| --- | --- | --- |
| **1** | **LICENSEE** | Insert Name of Licensee |
| **2** | **FIELD OF USE** | Insert field(s) of use |
| **3** | **LICENSED INTELLECTUAL PROPERTY RIGHTS** |
| **3.1** | **LICENSED COPYRIGHTS** | US Copyright Registration No.  |
| **3.2** | **LICENSED PATENTS**  |

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| --- | --- | --- | --- | --- |
| Patent No. | University Case No. | Country  | Issue Date | Title |
|       |       |       |       |       |
|       |       |       |       |       |
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| **3.3** | **LICENSED PATENT APPLICATIONS** |

|  |  |  |  |  |
| --- | --- | --- | --- | --- |
| Patent Application No. | University Case No. | Country  | Application Date | Title |
|       |       |       |       |       |
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| **3.4**  | **LICENSED TECHNICAL INFORMATION** | ☐ None ☐ Yes. Description is attached as Exhibit       |
| **4** | **FEDERAL GOVERNMENT RIGHTS** | ☐ Yes☐ No |
| **5** | **SUBLICENSE RIGHTS** | YesNo |
| **6** | **PERFORMANCE MILESTONES** | Licensee shall perform the following milestones: (a) By      , Licensee will      ;  (b) By      , Licensee will      ; (c) By      , Licensee will      .Not applicable/None |
| **7** | **PAYMENTS** |
| **7.1** | **UPFRONT PAYMENT** | Licensee shall pay to University an upfront fee of $      within ten (10) days after the Effective Date. |
| **7.2** | **LICENSE MAINTENANCE FEE** | Licensee shall pay to University an annual license maintenance fee of $      within ten (10) days after the first anniversary of the Effective Date and each anniversary thereafter during the Term.  |
| **7.3**  | **IPR EXPENSES** | Licensee shall reimburse University **only** for Patent Related Expenses incurred by University **before** the Effective Date, which are $xxx.Licensee shall reimburse University for Patent Related Expenses incurred by University **both before and after** the Effective Date. Patent Related Expenses incurred prior to the Effective Date are $XXX; Licensee shall reimburse University for Patent Related Expenses incurred by University **only after** the Effective Date.Licensee is **not responsible** for reimbursing University for Patent Related Expenses.**Past Patent Related Expenses are Less Than $25,000.** Within 12 months of the Effective Date, Licensee shall reimburse University for all Patent Related Expenses incurred by University before the Effective Date, with interest on this amount to accrue at 6% after 30 days from the Effective Date. **Past Patent Related Expenses are $25,000 or Greater.** Within 12 months of the Effective Date, Licensee shall reimburse University for at least $25,000 of all Patent Related Expenses incurred by University before the Effective Date, with the balance due within 24 months of the Effective Date. Interest in the amount of 6% will accrue on the outstanding balance of Patent Related Expenses after 30 days from the Effective Date.**All Ongoing Patent Related Expenses US Patent and the international phase of the PCT process.** Licensee shall reimburse University for Patent Related Expenses for US Patent applications, US patents and the international phase of the PCT process within 30 days from receipt of invoice.**All Ongoing Patent Related Expenses Foreign.** Additionally, and without limiting Licensee’s reimbursement obligations in the previous sentence, Licensee shall pre-pay the following Patent Related Expenses with respect to international filings:1. All out-of-pocket expenses for foreign national or regional applications including the examination fee
2. All out-of-pocket expenses for EP validation
3. Exceptional expenses

Insert other payment option if applicable |
| **7.4** | **RUNNING ROYALTIES ON NET SALES REVENUES** | Licensee shall pay to University a royalty equal to      % of Net Sales Revenues as provided in Section 4.4 of the General Terms. |
| **7.5** | **ANNUAL MINIMUM RUNNING ROYALTIES** | Beginning in the calendar year in which Licensee first sells Licensed Product and for each year thereafter during the Term, Licensee shall pay to University (by January 30 of the following calendar year) a minimum royalty of $     . The annual minimum royalty is creditable against royalties owed for such year, but is not otherwise available for carryforward or carryback against royalties for other years or for other payments due under this Agreement.  |
| **7.6** | **SUBLICENSE CONSIDERATION[[1]](#footnote-1)** | Licensee shall pay to University      % of all Non-Royalty Consideration it receives from a Sublicensee within 30 days of its receipt of such payments.  |
| **7.7** | **DOCUMENT FEE** | Unless waived by University prior to the Effective Date, Licensee shall pay to University a document fee of $10,000 within ten (10) days after the Effective Date.  |
| **7.8** | **TRANSFER FEE** | Licensee shall pay to University a Transfer Fee of $   as provided in Section 14.13 of the General Terms. |
| **7.9** | **MILESTONE PAYMENTS****(Delete check boxes and corresponding language)** | Licensee shall pay to University the following amounts upon the occurrence of the corresponding milestone: (a) Upon      , Licensee shall pay to University $      ;   (b) Upon      , Licensee shall pay to University $      ; and (c) Upon      , Licensee shall pay to University $      .Not applicable/none required. |
| **7.10** | **AMENDMENT FEE** | Licensee shall pay to University an amendment fee of $5,000 within ten days after entering into a Licensee-requested amendment to this Agreement. |
| **7.11** | **EARLY TERMINATION FEE** | Licensee shall pay to University an early termination fee of $      as provided in Section 10.3(b) of the General Terms. |
| **7.12** | **EQUITY AND EQUITY HOLDER RIGHTS****(Delete if not applicable)** | On or promptly after the Effective Date, License shall(a) issue to University      % of its voting equity securities, fully diluted on terms, (b) grant University preemptive rights, and(c) grant University board observer rights.The instruments and agreements issuing securities and granting rights shall be reasonably acceptable to University.  |
| **8** | **LICENSEE’S ADDRESS FOR NOTICE** | Contact: Insert name of contact Address: Insert Name of Licensee Insert Address Line 1 Insert address Line 2 Insert city, state, and zip codePhone       Email:       |
| **9** | **LICENSEE’S CONTACT FOR PATENT PROSECUTION CONSULTATION** | Contact: Insert name of contact Address: Insert Name of Licensee Insert Address Line 1 Insert address Line 2 Insert city, state, and zip codePhone      Email:       |
| **10** | **LICENSEE’S CONTACT FOR BILLING AND FINANCE**  | Contact: Insert name of contact Address: Insert Name of Licensee Insert Address Line 1 Insert address Line 2 Insert city, state, and zip codePhone      Email:       |
| **11** | **DEADLINE FOR EXECUTION BY LICENSEE** | If University executes this Agreement first and Licensee fails to execute and return it to University within 30 days of the date of University’s signature below, then the Agreement is null and void. |

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| --- |
| **THE PARTIES HEREBY EXECUTE THIS AGREEMENT**  |
| **Regents of the University of Minnesota** | **Insert name of Licensee here** |
|  |  |
| **By:**  | **By:**  |
| **Insert name of signatory**Its: **Insert title of signatory**Technology Commercialization | **Insert name of signatory**Its: **Insert title of signatory** |
| **Date:**  | **Date:**  |
| The signatory warrants that they are authorized to execute this agreement on behalf of the Regents of the University of Minnesota. | The signatory warrants that they are authorized to execute this agreement on behalf of Licensee |

**GENERAL TERMS**

# DEFINITIONS AND INTERPRETATION

## Definitions

In this Agreement:

“**Affiliate**” means an entity that controls Licensee or a Sublicensee, as the case may be, is controlled by Licensee or a Sublicensee, or along with Licensee or a Sublicensee, is under the common control of a Third Party. An entity shall be deemed to have control of the controlled entity if it (i) owns, directly or indirectly, fifty percent (50%) or more of the outstanding voting securities of the controlled entity.

“**Change of Control**” means in one or a series of related transactions:

(a) an acquisition by a person or group of fifty percent (50%) or more of the beneficial ownership of the voting equity of Licensee,

(b) an initial public offering of a class of voting equity of Licensee, or

(c) a merger, consolidation, or acquisition of Licensee, irrespective of whether Licensee is a surviving entity.

“**Commercialize**” means to practice a Licensed Intellectual Property Right:

(a) to make, have made, use, sell, offer for sale, import, and have imported a Licensed Product,

(b) to use, execute, perform, reproduce, distribute, make derivative works based upon, and publicly display the Licensed Software, or

(c) to use Licensed Technical Information in conjunction with the acts described in parts a and b of this definition.

“**Early Termination**” means the fee described in Section 7.11 of the Business Terms.

“**Effective Date**” means the date of the last signature on this Agreement.

**“Enforcement Litigation”** means any litigation involving the enforcement of Licensed Intellectual Property.

“**Field of Use**” means a field of use described in Section 3 of the Business Terms.

“**Licensed Copyright**” means a US or foreign copyright held by University in the Licensed Software and LIcensed Technical Information.

Prior to the Effective Date, University has not applied for registration and has not registered the copyright in the Licensed Software in the Terrority, except as noted in Section 3.2 of the Business Terms.

“**Licensed Patent**” means

(a) a patent described in Section 5.1 of the Business Terms, and

(b) a patent held by University that arose out of and claimed priority to a Licensed Patent Application.

“Licensed Patent” also means any reissues or reexaminations or post-issuance certificates of a Licensed Patent that contain one or more valid claims directed to a Licensed Intellectual Property Right.

Any claim of an unexpired Licensed Patent is presumed to be valid unless it has been held to be invalid by a final judgment of a court of competent jurisdiction or the U.S. Patent and Trademark Office or a corresponding foreign patent office, from which no appeal can be or is taken.

“**Licensed Patent Application**” means a patent application described in Section 5.2 of the Business Terms along with continuations, continuations-in-part (but only to the extent the claims are supported by a patent application pending as of the Effective Date) and divisionals of such a patent application.

“**Licensed Product**” means a product or service

(a) the making, having made, using, selling, licensing, or importing, absent the licenses granted in this Agreement, infringes, induces infringement, or contributes to infringement of a Licensed Patent or Licensed Patent Application,

(b) the use, execution, performance, reproduction, distribution, making derivative works based upon, or public display of the Licensed Software, absent the licenses granted in this Agreement, infringes, induces infringement, or contributes to infringement of a Licensed Copyright, and

(c) which uses Licensed Technical Information, including, without limitation, a product or service that was derived from, was identified or validated by, or incorporates such information.

“Licensed Product” includes a service that provides a right to access or use the Licensed Software for a fee or other payment.

“**Licensed Intellectual Property Right**” means a US and foreign intellectual property right held by University in the Licensed Software.

**“Licensed Software”** means the application described in Section 3.1 of the Business Terms along with the Licensed Technical Information and any written documentation for the application delivered by University to Licensee under this Agreement.

**“Licensed Technical Information”** means the information identified in Section 5.3 of the Business Terms.

“**Licensee**” means the entity identified in Section 1 of the Business Terms.

“**Net Sales Revenues**” means all revenues earned from the sale, lease, or other disposition of a Licensed Product to a Third Party.

“Net Sales Revenues” excludes

(a) all trade, quantity, and cash discounts actually allowed;

(b) all credits and allowances actually granted due to rejections, returns, billing errors, and retroactive price reductions;,

(c) applicable duties, and

(d) applicable excise, sales and use taxes.

“**Non-royalty Consideration**” means any consideration (except Royalty Consideration) received by Licensee from a Sublicensee under a Sublicense..

“**IPR Expenses**” means the costs and expenses (including out-of-pocket attorneys’ fees, patent agent fees and governmental fees) University incurred in filing and prosecuting a Licensed Patent Application, maintaining a Licensed Patent, and registering and maintaining a Licensed Copyright.

“**Performance Milestone**” means an act or event specified described in Section 9 of the Business Terms.

“**Royalty Consideration**” means any royalty payment received by Licensee from a Sublicensee based on the Sublicensee’s sales of Licensed Products.

“**Sublicense**” when used as a noun, means an agreement between Licensee and another person that grants the person a license under the Licensed Intellectual Property Rights, regardless of the name given to the agreement by the parties; when used as a verb, means Licensee’s act of entering into an agreement that grants another person a license under the Licensed Intellectual Property Rights, regardless of the name given to the agreement by the parties.

“**Sublicensee**” means a party to a Sublicense other than Licensee.

“**Term**” means the period commencing on the Effective Date and ending on the earlier of (i) the date a Party terminates this Agreement as provided in the General Terms or (ii) the date on which no Licensed Intellectual Property Right is pending or active anywhere in the Territory.

“**Territory**” means a country

(a) in which a LIcensed Patent Application or an application to register a Licensed Copyright is pending, or

(b) a Licensed Intellectual Property Right has been granted or registered and is active.

**“Transfer”** means:

(a) a Change of Control,

(b) granting a third party an exclusive license of all or substantially all of Licensee’s licenses under this Agreement,

(c) assigning to the third party Licensee’s rights under this Agreement,

(d) selling, leasing, or otherwise disposing to a third party of all or substantially all of Licensee’s assets,

“**Third Party**” means a person who is not an Affiliate of Licensee.

“**University Indemnitees**” means University, its respective regents, officers, employees, students, agents, faculty, representatives, volunteers, and, if applicable, other institutions with whom University has entered into an inter-institutional agreement covering the Licensed Patents.

**“Year”** means a calendar year during the term of this Agreement.

## Rules of Interpretation and Convention

In this Agreement, unless the context requires otherwise:

1. headings are for convenience only and do not affect interpretation;
2. the singular includes the plural and conversely;
3. a reference to any statute, rule, regulation or policy includes any amendment, and any statute, rule, regulation or policy replacing it;
4. all computations and payments made under this Agreement shall be in United States dollars. To determine the U.S. dollar value of transactions conducted in non-United States currencies on any particular day, the parties shall use the exchange rate for that currency as reported in the Wall Street Journal in the most recently published edition prior to the date of the transaction; and
5. all notices, reports, and other documents and instruments that a party elects or is required to deliver to the other party must be in English.

# LICENSE

## Grant of License

### Subject to the terms and conditions of this Agreement, University grants to Licensee the following rights:

### an exclusive license under the Licensed Intellectual Property Rights (excluding the Licensed Technical Information) to Commercialize in the Territory and in the Field of Use; and

### a non-exclusive license to use the Licensed Technical Information to Commercialize in the Territory and in the Field of Use.

### (b) Except as provided in this section, no other rights or licenses, express or implied, are granted to Licensee.

## Retained Rights

Notwithstanding any provision of this Agreement, University retains on behalf of itself and all other non-profit research institutions, the right to practice the Licensed Intellectual Property Rights for research, teaching, and education.

**2.3** **Licensed Software - Delivery and Maintenance**

(a)University shall deliver to Licensee a copy of the source code of the Licensed Software promptly after the Effective Date.

(b)University shall not be obligated to support, maintain or correct any error or bug in the Licensed Software. Licensee shall not state or imply to any person that University has an obligation to support, maintain or correct any error or bug in the Licensed Software.

**2.4 Licensed Technical Information - Delivery and No Obligation to Supplement**

(a) University shall deliver to Licensee a copy of the Licensed Technical Information promptly after the Effective Date.

(b) University is not obligated to deliver or provide access to any information it owns possesses or controls other than the Licensed Technical Information. University is not obligated to deliver or provide access to Licensee or any other person any information (including information related to the Licensed Technical Information) generated after the Effective Date.

# SUBLICENSING

## Sublicensing

(a) Licensee may sublicense its rights under this Agreement to grant end user licenses on commercially reasonable terms.

(b) Licensee may sublicense its rights under this Agreement to grant one or more third parties a license to distribute the Licensed Software on its behalf.

(c) Licensee may otherwise sublicense its rights under this Agreement only if

 (1) the Sublicense does not contain a provision that is consistent with the terms of this Agreement,

 (2) the Sublicense by its express terms states that:

####  (i) it is subject to this Agreement;

#### (ii) the Sublicensee shall not further sublicense; and

#### (iii) it terminates upon termination of this Agreement.

## No Non-Cash Payments under a Sublicense

Licensee shall not receive from its Sublicensees anything of value for granting rights under the rights licensed hereunder in lieu of cash payments for Non-Royalty Sublicense Consideration without the prior written consent of University.

## Copy of Sublicenses and Sublicense Royalty Reports

Licensee shall submit to University within 60 days of the effective date of Sublicense a copy of each Sublicense described in Sections 3.1(b) and (c), any subsequent amendments and all copies of Sublicensee’s royalty reports.

# PAYMENT, RECORDS, AND AUDIT

## Licensee’s Payment Obligation

Licensee shall pay all amounts under Sections 7 and 10 of the Business Terms by the dates indicated therein. Licensee shall pay such amounts by wire transfer, check (payable to the “Regents of the University of Minnesota” and sent to: Regents of the University of Minnesota, NW 5960, PO Box 1450, Minneapolis, MN 55485-5960; reference agreement number on check), or any other method of payment specified by University.

## Licensee Responsible for Non-U.S. Taxes

Licensee shall pay all non-U.S. taxes related to payments made to University under this Agreement.

## Interest

All amounts due under this Agreement will bear compound interest at 6% per annum on the entire unpaid balance computed from the due date until the amount is paid.

## Security for Reimbursement of Patent-Related Expenses

University reserves the right to require Licensee to provide and maintain a reasonable advance deposit with University or some other form of security to ensure payment of Patent-Related Expenses.

## Royalty Payments/Sales Reports

Within sixty (60) days after the last day of the second and fourth calendar quarters beginning in the calendar year in which Licensee first sells a Licensed Product, Licensee shall provide to University a written report (even if there are no sales) and earned royalty payment under Section 10.4 of the Business Terms in a form acceptable to University.

## No Refund

All amounts paid to University (and, if applicable, all equity issued to University under Section 10.1 of the Business Terms) are non-refundable.

## Termination Report

Licensee shall pay to University all amounts due under this Agreement and submit to University a written report to include contact information for Sublicensees within 90 days after the Agreement terminates. Licensee will continue to submit royalty payments and reports after the license terminates, until all Licensed Products made or imported under the Agreement have been sold.

## Accounting

Licensee shall maintain (and shall cause each Sublicensee to maintain) records showing manufacture, importation, sale, use, and provision of a Licensed Product for 5 years from the date of sale of that Licensed Product. Records will include information in sufficient detail to enable University or its representative to determine the royalties owed under this Agreement. Upon request by University, Licensee shall deliver to University or its representative, copies of all documents and materials (including electronic records) reasonably relevant to Licensee’s and Sublicensee’s performance of this Agreement, including, without limitation, copies of all Sublicenses.

## Audit

Licensee shall allow (and shall cause each Sublicensee to allow) University or its designee to examine Licensee’s records to verify payments made by Licensee under this Agreement. In connection with such audit, Licensee shall provide (and shall cause each Sublicensee to provide) commodious space at no cost to conduct the audit.

## Paying for Audit

University will pay for any audit done under Section 4.9 of the General Terms. But if the audit reveals an underreporting of royalties due University of 5% or more for the period being audited, Licensee shall pay the audit costs.

## Royalty if Licensee Challenges the Licensed Patent

If Licensee brings an action seeking to invalidate a Licensed Patent, Licensee will pay royalties to University at the rate of two times the royalty rate specified in Section 10.4 of the Business Terms during the pendency of such action. Moreover, should the outcome of such action determine that any claim of a patent challenged by Licensee is both valid and infringed by a Licensed Product, Licensee will pay royalties at the rate of three times the royalty rate specified in Section 10.4 of the Business Terms.

# GOVERNMENT RIGHTS AND REGULATIONS

## Bayh-Dole Requirements

***[Applicable only if Section 6 of the Business Terms is checked, “Yes.”]***

This Agreement is subject to Title 35, Sections 200-204 of the United States Code. Among other things, these provisions provide the United States Government with nonexclusive rights in the Licensed Patent and Licensed Software. They also impose the obligation that any Licensed Products sold or produced in the United States be “manufactured substantially in the United States.” Licensee shall ensure all obligations of these provisions are met.

## Compliance with Laws

Licensee shall ensure that the manufacture, use, sale, or transfer of a Licensed Product complies with all applicable laws and regulations.

## Export Controls and Sanctions

## The parties shall comply with export controls and sanctions statutes and regulations, including the Export Administration Regulations (EAR, 15 C.F.R. pts. 730-774), the International Traffic in Arms Regulations (22 C.F.R. pts. 120-130), and the Foreign Assets Control Regulations (31 C.F.R. pts. 500-599), to the extent such statutes and regulations are applicable to the parties’ activities. Licensee shall not use Licensed Product, Licensed Technical Information, or any derivative commodity, software, or technology thereof contrary to the requirements in Part 744 of the EAR, Control Policy: End-Use and End-User Based (15 C.F.R. pt. 744).

## Cooperation with Governmental Requests

Licensee shall comply upon reasonable notice from University with all governmental requests relevant to the Licensed Intellectual Property directed to either University or Licensee and provide all information and assistance necessary to comply with governmental requests.

## Patent Marking

Licensee and each Sublicensee shall mark all Licensed Products in a manner consistent with their current patent marking practices for their own products provided appropriate notice is given in accordance with 35 USC 287 or other relevant statutes. Where marking is to be performed but the Licensed Product cannot be marked, the patent notice shall be placed on associated tags, labels, packaging, or accompanying documentation either electronic or paper as appropriate.

# IPR PROSECUTION, REGISTRATION AND MAINTENANCE

## IPR Prosecution, Registration and Maintenance

University has the sole right to control the preparation, filing, prosecution, registration and maintenance of the Licensed Intellectual Property Rights. In no event shall Licensee file a patent application or apply to register the copyright in a Licensed Intellectual Property Right.

To facilitate consultation with Licensee, University will use commercially reasonable efforts to:

1. keep Licensee reasonably informed as to the filing, prosecution, and maintenance of the Licensed Patents;
2. furnish to Licensee copies of material documents relevant to such filing, prosecution and maintenance; and
3. allow Licensee a reasonable opportunity to comment on material documents filed with any patent office with respect to the Licensed Patents prior to filing.

## Licensee Assistance and Contact

At University’s request, Licensee shall provide all information and assistance to University in the filing and prosecution of all Licensed Patents. In furtherance of the foregoing, Licensee designates the person identified in Section 12 of the Business Terms to respond to University’s request for consultation and cooperation on a pending matter within five business days or sooner as may be required under the circumstances. If Licensee’s contact fails to respond in such time period, University, exercising its own judgment and discretion, may respond to the matter as it deems appropriate.

## IPR Expenses

Within 30 days after receiving an invoice from University, Licensee shall reimburse University for IPR Expenses unless otherwise provided in this Agreement.

# COMMERCIALIZATION

## Diligence

Licensee shall use commercially reasonable efforts to Commercialize, including without limitation to maximize sales, leases and other disposition of Licensed Products.

## Performance Milestones

Licensee shall perform, or shall cause to happen or be performed, as the case may be, all the performance milestones described in Section 9 of the Business Terms.

## Commercialization Reports

By March 1 of each year, Licensee will deliver to University a written report describing in reasonable detail the actions it and its Sublicensee took in the preceding calendar year to Commercialize. Each report shall also include descriptions of work completed, key scientific discoveries, summary of work-in-progress, market plans for introduction of Licensed Product, and significant corporate transactions involving Licensee and its plans and actions to Commercialize. Licensee will specifically describe how each Licensed Product is related to each Licensed Intellectual Property Right.

# INFRINGEMENT

## Notification to University

Licensee shall notify University if it believes a third party is infringing a Licensed Patent and provide University with all credible evidence that is has to support this belief.

## Good Faith Negotiations with University Prior to Commencing Infringement Action

Prior to commencing any action to enforce a Licensed Patent, Licensee shall enter into good faith negotiations with University on the desirability of bringing suit, the parties to the action, the selection of counsel, and such other matters. University may not be named (nor is Licensee authorized to name University) as a party in any such action without its prior written consent.

## Enforcement Litigation

Settlement of any Enforcement Litigation requires the written consent of the University. Further, any recovery in any Enforcement Litigation in excess of any unrecovered litigations costs and fees will be shared with University as follows:

1. any payments for past or future sales will be deemed Net Sales Revenues and Licensee shall pay University royalties on such payment at the rate specified in Section 10.4 of the Business Terms; and
2. all other amounts recovered will be deemed Sublicense Consideration and Licensee shall pay University royalties on such amounts at the rate specified in Section 10.6 of the Business Terms.

## Infringement by Licensee

If any suit, action or proceeding is brought or commenced against Licensee alleging the infringement of a patent or other intellectual property right owned by a Third Party by reason of the manufacture, use or sale of Licensed Products, Licensee shall give University prompt notice thereof. If the validity of a Licensed Patent is questioned in such suit, action or proceeding, Licensee shall have no right to make any settlement or compromise which affects the scope, validity, enforceability or otherwise a Licensed Patent without University’s prior written approval.

# UNIVERSITY NAME AND MARKS

## No Use of University Name or Marks

No provision of this Agreement grants Licensee or Sublicensee any right or license to use the name, logo, or any marks owned by or associated with University or the names, or identities of any member of the faculty, staff, or student body of University. Licensee shall not use and shall not permit a Sublicensee to use any such logos, marks, names, or identities without University’s prior written approval.

# TERMINATION

## University’s Right to Terminate for Breach

University may terminate this Agreement if Licensee:

1. is delinquent on any report or payment;
2. misses a milestone under Section 9 of the Business Terms;
3. is in breach of any material provision of this Agreement; or
4. provides any materially false report.

## Licensee’s Right to Remedy Breach

Termination under Section 10.1 of the General Terms takes effect (without any further action by University) 30 days after written notice by University to Licensee of any default under Section 10.1 of the General Terms, unless within that 30-day period Licensee:

1. remedies the default and notifies University of the same; and
2. pays to University an administrative fee of $10,000.

## Licensee’s Right to Terminate

Licensee may terminate this Agreement:

1. if University is in default of any material provision of this Agreement and fails to remedy the default within 30 days of Licensee’s written notice; or
2. for convenience (“Early Termination”) by delivering to University a written notice of termination at least 60 days prior to the date of termination and upon payment of the Early Termination Fee as described in Section 10.10 of the Business Terms, if applicable.

## Effect of Termination.

Upon Termination:

1. The grant of rights under Section 2.1 of the General Terms terminates. Licensee may, however, sell or dispose of Licensed Products manufactured prior to termination for one year thereafter, provided that Licensee continue to pay royalties on the sale of Licensed Products; and
2. Provided Sublicensee delivers to University within 30 days after the date of termination of this Agreement a written request to take a direct license under the Licensed Intellectual Property Rights and Sublicensee had performed when due all of its obligations under the Sublicense, University shall grant the Sublicensee such a license on financial and diligence terms substantially similar to such terms in the Sublicense and on other mutually agreed upon terms.

## Sections of the Agreement Surviving Termination.

Surviving any termination or expiration are:

1. Licensee's payment obligations for payments accrued prior to termination; and
2. the provisions of Sections 4.7, 8, 9, 11,12, 13, 14.1, 14.3, 14.4 14.8, and 14.9 of the General Terms, and any other provision that by its nature is intended to survive.

# INDEMNIFICATION AND INSURANCE

## Indemnification

Licensee shall indemnify, hold harmless, and defend all University Indemnitees against any claim of any kind arising out of or related to the exercise of any rights granted Licensee under this Agreement or Licensee’s breach of any provision of this Agreement.

## Insurance

Licensee warrants that it now maintains and will continue to maintain liability insurance coverage appropriate to the risk involved in marketing and selling Licensed Products subject to this Agreement and that the insurance coverage lists University of Minnesota as an additional insured. Upon University’s request, Licensee shall present evidence to University that this coverage is being maintained.

# DISCLAIMER OF WARRANTIES

## Warranties

University warrants that to the best of its actual knowledge as of the date of execution of this Agreement it has the right to grant the licenses to the Licensed Intellectual Property contained in this Agreement.

## Disclaimer of all Other Warranties

UNIVERSITY GRANTS THE RIGHTS IN THIS AGREEMENT AS IS AND WITH ALL FAULTS.

UNIVERSITY MAKES NO REPRESENTATIONS AND EXTENDS NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED CONCERNING THE LICENSED INTELLECTUAL PROPERTY RIGHTS OR THE LICENSED SOFTWARE.

UNIVERSITY EXPRESSLY DISCLAIMS THE IMPLIED WARRANTIES OF MERCHANTABILITY, FITNESS OF PURPOSE AND NON-INFRINGEMENT CONCERNING THE LICENSED INTELLECTUAL PROPERTY RIGHTS OR THE LICENSED SOFTWARE .

UNIVERSITY FURTHER EXPRESSLY DISCLAIMS ANY WARRANTIES CONCERNING AND MAKES NO REPRESENTATIONS:

1. that a Licensed Patent Application will be allowed or granted or that a patent will issue from a Licensed Patent Application;
2. that a Licensed Copyright will be registered;
3. concerning the validity, enforceability, interpretation of claims or scope of a Licensed Intellectual Property Right;
4. that the exercise of the rights or licenses granted to Licensee or a Sublicensee under this Agreement do or will not infringe or violate a third party’s intellectual property rights; or
5. that the exploitation of Licensed Intellectual Property Rights will be successful.

**ALL LICENSED INTELLECTUAL PROPERTY RIGHTS ARE PROVIDED "AS IS" AND UNIVERSITY HEREBY DISCLAIMS ALL WARRANTIES, WHETHER EXPRESS, IMPLIED, STATUTORY OR OTHER, AND UNIVERSITY SPECIFICALLY DISCLAIMS ALL IMPLIED WARRANTIES OF MERCHANTABILITY, FITNESS FOR A PARTICULAR PURPOSE, TITLE AND NON-INFRINGEMENT, AND ALL WARRANTIES ARISING FROM COURSE OF DEALING, USAGE OR TRADE PRACTICE. WITHOUT LIMITING THE FOREGOING, UNIVERSITY MAKES NO WARRANTY OF ANY KIND THAT THE LICENSED INTELLECTUAL PROPERTY RIGHTS, OR ANY PRODUCTS OR RESULTS OF THE USE THEREOF, WILL MEET LICENSEE'S OR ANY OTHER PERSON'S REQUIREMENTS, OPERATE WITHOUT INTERRUPTION, ACHIEVE ANY INTENDED RESULT, BE COMPATIBLE OR WORK WITH ANY SOFTWARE, SYSTEM OR OTHER SERVICES, OR BE SECURE, ACCURATE, COMPLETE, FREE OF HARMFUL CODE OR ERROR-FREE.**

# LIMITATION ON TYPE AND AMOUNT DAMAGES

## Limitation on Type of Damages

University is not liable for any special, reliance, expectancy, consequential, lost profits, loss of business opportunity, expectation, punitive or other indirect damages in connection with any claim arising out of or related to this Agreement.

## Limitation on Amount of Damages.

In no event shall University’s liability to Licensee exceed the payments made to University by Licensee during the 6 months prior to the event that gave rise to the claim.

# MISCELLANEOUS

## Choice of Law and Jurisdiction

(a) The internal laws of the state of Minnesota, without giving effect to its conflict of laws principles, govern the validity, construction, and enforceability of this Agreement.

(b) A suit, claim, or other action to enforce this Agreement may be brought only in the state courts of Hennepin County, Minnesota. Licensee hereby submits to the jurisdiction of that court and waives any objections it may have to that court asserting jurisdiction over Licensee or its assets and property and to venue in that jurisdiction.

## Amendment and Waiver

(a) The Agreement may be amended from time to time only by a written instrument signed by the Parties.

(b) No term or provision of this Agreement may be waived, and no breach excused unless such waiver or consent is in writing and signed by the Party claimed to have waived or consented. No waiver of a breach is to be deemed a waiver of a different or subsequent breach

## Data Practices Act

The Parties acknowledge that University is subject to the terms and provisions of the Minnesota Government Data Practices Act, Minnesota Statutes §13.01 et seq. (the “Act”), and that the Act requires, with certain exceptions, University to permit the public to inspect and copy any information that University collects, creates, receives, maintains, or disseminates, including the existence of and the terms of this Agreement.

## Confidentiality

To the extent permitted by law, including as provided in the Act, University shall hold in confidence and disclose only to University employees, agents and contractors who need to know:

1. the reports described in Sections 3.2, 4.5, 7.3 of the General Terms;
2. the documents provided under Section 10.10 of the Business Terms; and
3. the records inspected in accordance with Sections 4.8 and 4.9 of the General Terms. No provision of this Agreement is to be construed to further prohibit, limit, or condition University’s right to use and disclose any information in connection with enforcing this Agreement, in court or elsewhere.

## Assignment

Licensee shall not and does not have the power or authority to assign its rights under this Agreement without University’s prior written consent.

## Consent and Approvals

All consents or approvals required under this Agreement must be in writing.

## Entire Agreement

The Parties intend this Agreement (including all attachments, exhibits, and amendments hereto) to be the final and binding expression of their contract and agreement and the complete and exclusive statement of the terms thereof. The Agreement cancels, supersedes, and revokes all prior negotiations, representations and agreements among the Parties, whether oral or written, relating to the subject matter of this Agreement. No representations or statements of any kind made by either party, which are not expressly stated herein, will be binding on such Party.

## Enforceability

If a court of competent jurisdiction adjudges a provision of this Agreement to be unenforceable, invalid, or void, such determination is not to be construed as impairing the enforceability of any of the remaining provisions hereof and such provisions will remain in full force and effect.

## No Third-Party Beneficiaries

No provision of this Agreement, express or implied, is intended to confer upon any person other than the Parties any rights, remedies, obligations, or liabilities hereunder. No Sublicensee may enforce or seek damages under this Agreement.

## Relationship of Parties

In entering into, and performing their duties under this Agreement, the Parties are acting as independent contractors and independent employers. No provision of this Agreement creates or is to be construed as creating a partnership, joint venture, or agency relationship between the Parties. No Party has the authority to act for or bind the other Party in any respect.

## Notices

In order to be effective, all notices, requests, and other communications that a Party is required or elects to deliver must be in writing and must be delivered personally, or by facsimile or electronic mail (provided such delivery is confirmed), or by a recognized overnight courier service or by United States mail, first-class, certified or registered, postage prepaid, return receipt requested, to the other Party at its address set forth below or to such other address as such Party may designate by notice given under this Section:

If to University: University of Minnesota

Technology Commercialization

200 Oak Street, SE

Suite 280

Minneapolis, MN 55455

Fax: 612.624.6554

E-mail: otcagree@umn.edu

 For notices sent University of Minnesota

 under Section 8, Office of the General Counsel

 with a copy to: Attn: Director, Transactional Law Services

360 McNamara Alumni Center

200 Oak Street S.E.

Minneapolis, MN 55455-2006

Facsimile No.: 612.626.9624

Email: contracts@mail.ogc.umn.edu

If to Licensee: As indicated in Section 11 of the Business Terms.

## Security Interest

Licensee shall not and shall not have the authority to grant or permit any person to assert or perfect a security interest in Licensee’s rights under this Agreement.

## Transfer

Licensee shall have the right to consummate a Transfer only if:

(a) Licensee delivered to University written notice of the planned Transfer, including all pertinent information describing the parties and the terms of the Transfer that affect Licensee’s obligations under this Agreement contact information,

(b) except for a Change of Control, the transferee must agree in writing to University to be bound by this Agreement, and

 (c) Licensee paid the Transfer Fee (or cause it to be paid) to University within ten (10) days of the closing date of the Transfer.

## Execution in Counterparts

This Agreement may be executed in counterparts and by facsimile or electronic transmission.

1. If Sublicensee Royalty Consideration is part of the transaction, use Pre-Approved Clause # <> in Provisions Library Document. [↑](#footnote-ref-1)