**NONEXCLUSIVE EVALUATION** **LICENSE AGREEMENT**

This License Agreement (“AGREEMENT”) is entered into between the U.S Geological Survey (USGS), an agency of the United States, with its headquarters in Reston, VA, hereinafter referred to as LICENSOR, and \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_, a corporation / limited liability company/ business organization with its principal place of business at\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_, hereinafter referred to as LICENSEE. LICENSOR and LICENSEE are each considered a PARTY to the specified AGREEMENT. The license is effective on the date of execution, hereinafter referred to as the “EFFECTIVE DATE,” signified by the last signing PARTY and payment of the one-time licensing fee.

Under the authority of 15 U.S.C § 3701 et seq. and 35 U.S.C. § 200 et seq., the U.S. Department of Commerce has issued Licensing Regulations (37 CFR Part 404) specifying the terms and conditions upon which licenses may be granted for inventions; and LICENSOR owns invention Title or U.S. Patent Application for \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_; and, LICENSEE, in consideration of the grant of a license, will pay a one-time licensing fee and will limit evaluation for specific applications so as to enable licensee to determine whether further licensing for commercial purposes is desired; and thus, the granting of such license to LICENSEE will therefore be in the public interest;

Now, therefore, the LICENSOR and LICENSEE agree as set forth below:

1. Definitions

“LICENSE TERM” shall mean the period of time starting with the EFFECTIVE DATE and ending with the last day that this AGREEMENT is indicated in effect.

“LICENSED AREA” shall mean \_United States.

“LICENSED FIELD(S) of USE” shall mean \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_.

“LICENSED INVENTION(S)” shall mean the process and products defined by invention or patents, and claims of the LICENSED PATENT(S) and as may be further limited by ARTICLE 2.

“LICENSED PATENT(S)” shall mean Patent No(s). Patent Application for\_\_\_\_\_\_\_\_\_\_\_.

“MATERIAL,” with respect to a particular matter, shall mean that the matter is shown to affect adversely (a) the rights and benefits of the other PARTY under this AGREEMENT; or (b) the ability of the other PARTY to perform its obligations hereunder; and, in either case, to such a degree that a reasonable person in the management of his or her own affairs would be more likely than not to decline to enter into this AGREEMENT in view of the matter in question.

“METHOD(S)” shall mean any process or method to use or practice; excluding instances for which this AGREEMENT would infringe, contribute to, or induce the infringement of the LICENSED PATENT.

“PERSON” shall mean a natural person; a corporation (for profit or not-for-profit); an association; a partnership (general or limited); a joint venture; a trust; a government or political department, subdivision, or agency; or any other entity.

“PURPOSE” shall mean evaluation of the LICENSED INVENTION(S) for use in the LICENSED FIELD(S) OF USE. PURPOSE excludes sale and offer for sale of the LICENSED INVENTION(S) to others except as allowed by this agreement or given by written approval by USGS. Licensor grants Licensee the limited permission to\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_.

Any use of the LICENSED INVENTION(S) for other than evaluation purposes, such as for commercial or industrial use or sale, shall be made only pursuant to the terms of a commercialization license. Any such commercialization license shall be subject to 37 CFR Part 404, and there is no guarantee by LICENSOR that the LICENSED INVENTION(S) will be available for such licensing or that LICENSOR will grant such license.

“SUBLICENSE” shall mean any PERSON who has the right, granted by the LICENSEE, to make or use methods or products disclosed under the LICENSED INVENTION.

1. License Grant
   1. LICENSOR hereby grants to LICENSEE a terminable, fee-bearing, nonexclusive license to \_\_\_\_\_\_\_\_\_\_\_ pursuant to the LICENSED INVENTION, as limited to the, LICENSED AREA and the LICENSED FIELD(S) OF USE and PURPOSE, as defined in ARTICLE 1.
   2. Notwithstanding anything to the contrary in this AGREEMENT, LICENSEE shall take the license granted in this ARTICLE 2 subject to any outstanding licenses or other rights in third parties under agreements executed by LICENSOR before the license EFFECTIVE DATE.
   3. LICENSOR reserves an irrevocable, royalty-free right to practice and have practiced the LICENSED INVENTION, and any other inventions as provided in Section 2.2, throughout the world by or on behalf of the Government of the United States and on behalf of any foreign government pursuant to any existing or future treaty or agreement with the United States.
   4. This AGREEMENT does not grant any rights to practice any enhancements or modifications to the LICENSED INVENTION(S) beyond the termination or expiration of this AGREEMENT. Any such enhancements and modifications shall be subject to LICENSOR’s rights in the LICENSED INVENTION(S).
2. Sublicenses
   1. LICENSEE may not grant any SUBLICENSES under this AGREEMENT.
3. Term of License
   1. Unless either PARTY terminates this AGREEMENT in accordance with ARTICLE 14 at an earlier date, the license granted in ARTICLE 2 will automatically terminate without notice to the LICENSEE {Enter term\_\_\_\_\_\_\_\_\_\_\_\_\_} after the EFFECTIVE DATE, except as may be expressly provided otherwise herein or agreed to in writing by LICENSOR.
4. Option

6.1 LICENSOR grants to LICENSEE an exclusive option during term of this license to negotiate a license to make, have made, use, market, sell, one or more inventions in the Field under the Patent Rights (“Option”).

6.2 License shall be granted where LICENSEE satisfies all USGS and federal licensing requirements, and the Parties reach mutually acceptable terms. Upon starting negotiations, LICENSOR will make a good faith effort for {insert term\_\_\_\_\_\_\_\_\_\_} days to reach acceptable terms. During the term of this Agreement, LICENSOR shall not offer these rights to any third party.

1. Payment
   1. In consideration of the license and option granted in ARTICLE 2 and 6, LICENSEE shall remit to LICENSOR a nonrefundable, one-time licensing fee in the amount of \_\_\_\_\_\_\_\_\_\_\_\_\_\_upon the execution of this AGREEMENT by LICENSEE.
   2. The fee shall be denominated in United States dollars and made payable to the U.S Geological Survey in the form of a check. The check should be payable to USGS and sent to the LICENSOR Point of Contact identified in Article 11.
2. Reports
   1. LICENSEE shall submit to LICENSOR the final report within thirty (30) calendar days after the termination of this AGREEMENT.
   2. The report shall include a certification by an officer of LICENSEE stating that the LICENSEE is complying with the terms and conditions of this AGREEMENT and the following information:
3. A narrative description of LICENSEE’s activities under this agreement.
4. Copies of all publications incorporating information developed under this AGREEMENT.
5. Serial number, filing date and title of all patent applications covering inventions arising from evaluation of the LICENSED INVENTION(S) under this AGREEMENT.
6. A list of the geographic locations at which the LICENSED INVENTION is being made and/or used.
7. Use of the USGS Name
   1. Except as required by ARTICLE 9, LICENSEE may use the name of LICENSOR, or the acronym “USGS,” only in truthful statements concerning its relationship with LICENSOR. The letters ‘USGS’ may be used in such truthful statements only if they are:
8. Used in their normal typed or printed form;
9. The same size, color, and intensity as the rest of the words in a sentence;
10. Not used in their stylized version as they appear in any USGS logotype, trademark or insignia; and
11. Not used to indicate that USGS endorses the LICENSEE’s products, methods, etc.
12. Disclaimer of Warranties and Representations
    1. LICENSOR makes no representations or warranties, express, implied, or statutory, as to any matter whatsoever.
    2. All representations and warranties, express, implied, or statutory, including but not limited to implied warranties of merchantability and fitness for a particular purpose are excluded hereunder.
    3. Nothing in this AGREEMENT shall be construed as:
13. A warranty or representation by LICENSOR as to the validity or scope of any LICENSED PATENT;
14. Ability to supply material to practice the Licensed Invention; or
15. A warranty or representation that anything made or used under any license granted in this AGREEMENT is or will be free from infringement of any type, including patent infringement, copyright infringement, and trademark infringement; or
16. A requirement that LICENSOR shall file any patent application, secure any patent, or maintain any patent in force, other than the LICENSED PATENT; or
17. An obligation to bring or prosecute actions or suits against third parties for infringement; or
18. An obligation to furnish any manufacturing or technical information; or, if any such information is supplied, a warranty or representation that such information is accurate; or
19. Conferring a right to use in advertising, publicity or otherwise the name of any inventor of the LICENSED INVENTION or the USGS name, seal, trademark, insignia, logotype or any other adaptation without the prior written consent of LICENSOR (except as otherwise provided in ARTICLE 7); or
20. Granting by implication or estoppel, or otherwise, any licenses or other rights under any patent of LICENSOR or any other entity including a natural person in the United States or any foreign country; or
21. Granting by implication, estoppel, or otherwise, any licenses or rights under patents or patent applications of LICENSOR other than the LICENSED INVENTION, regardless of whether such other patents or patent applications are dominant, subordinate, or an improvement to the invention or inventions as claimed, of the LICENSED PATENT, nor to other applications that did not claim the invention.
22. Conferring upon any person or entity:
    1. Any immunity from or defenses under the antitrust laws; or,
    2. Any immunity from a charge of patent misuse; or,
    3. Any immunity from the operation of Federal, State, or other law.
23. Risk Allocation and Indemnification
    1. LICENSOR makes no representation, extends no warranties of any kind, either express or implied, and assumes no responsibility whatsoever with respect to use or other disposition by LICENSEE or its transferees or other transferees of devices incorporating or made by the use of:
24. The LICENSED INVENTION; or,
25. Information, if any, furnished under this AGREEMENT.
    1. LICENSEE shall indemnify LICENSOR, its officers and employees, and hold them harmless against all liabilities, demands, damages, expenses, or losses including, but not limited to, attorney’s fees, court costs, and the like, arising:
26. Out of the use by LICENSEE or its transferees of the LICENSED INVENTION or information furnished under this AGREEMENT; or,
27. Out of any use or other disposition by LICENSEE or its transferees of devices, processes, or compositions, made by use of such inventions or information.
    1. It shall be the sole responsibility of the LICENSEE to ensure that any and all embodiments of the LICENSED INVENTION are safe under all circumstances.
    2. Neither PARTY will be liable to the other PARTY (nor to any third party claiming rights derived from the other PARTY’s rights) for incidental, consequential, special, punitive, or exemplary damages of any kind, including lost profits, loss of business, or other economic damage, and further including injury to property, as a result of breach of any warranty or other term of this AGREEMENT, regardless of whether the PARTY liable or allegedly liable was advised, had reason to know, or in fact knew of the possibility thereof. This provision is independent of, severable from, and to be enforced independently of any other enforceable or unenforceable provision of this AGREEMENT, other than as provided in Sections 9.1 and 9.2, or other than for infringement of one PARTY’s intellectual property rights by another PARTY, (including any engagement in licensable activities by licenses beyond the scope of the license provided by this AGREEMENT).
28. Notices
    1. Any notice or payment required to be given will be deemed to have been properly given and to be effective on the date of delivery if delivered in person, or submitted electronically by fax or email to the POC given in ARTICLE 11; or on the fifth business day after it was mailed if mailed by either first-class certified U.S. mail or commercial courier traceable mail to the respective addresses in ARTICLE 11.
29. Points of Contact

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| --- | --- | --- | --- |
| LICENSOR: | USGS | LICENSEE: |  |
| Name: | James Mitchell | Name: |  |
| Title: | Patent Licensing Manager | Title: |  |
| Address: | 1201 Sunrise Valley Dr.  MS 153 | Address: |  |
|  | Reston, VA20192 |  |  |
| Telephone: | 703-648-4344 | Telephone: |  |
| Email: | jmmitchell@usgs.gov | Email: |  |

1. Patent Validity
   1. If, in any proceeding in which the validity, infringement, or priority of invention of any claim of the LICENSED PATENT to LICENSEE is in issue, the final judgment shall be followed.
2. Dispute or Breach
   1. All disputes concerning the interpretation or application of this AGREEMENT shall be discussed mutually between the PARTIES. Any disputes that are not disposed of by mutual agreement shall be decided by the USGS, or designee, who shall reduce the decision to writing and mail or otherwise deliver a copy thereof to LICENSEE. LICENSEE may respond to such notice of a dispute decision in accordance with the procedures set forth in ARTICLE 14.
   2. In the event of a breach that entails either a violation, non-performance, or misrepresentation of any provision of this AGREEMENT, the non-breaching PARTY shall give the breaching PARTY notice of the breach. This notice of the breach will signify the start of the cure period. This notice must describe the breach and state that the breaching PARTY has thirty (30) calendar days after notice of the breach to cure the breach or show cause why the AGREEMENT should not be terminated unless the breach is one for which no cure period is required as set forth in 13.4.
   3. The breaching PARTY will be deemed to have cured such breach if within the cure period it takes steps reasonably adequate to alleviate any damage to the non-breaching PARTY resulting from the breach and to prevent a similar future breach.
   4. No cure period is required, except as may be otherwise provided in this AGREEMENT, if:
3. This AGREEMENT sets forth specific deadline dates for the obligation allegedly breached; or
4. This AGREEMENT otherwise states that no cure period is required in connection with the termination in question.
5. Termination or Modification
   1. The PARTIES may terminate or modify this AGREEMENT by mutual consent upon such terms as they may agree in writing.
   2. LICENSEE may prospectively terminate this AGREEMENT by written notice which will become effective upon thirty (30) calendar days of the receipt of notice by the LICENSOR in accordance with Section 10.1.
   3. This AGREEMENT may be terminated by LICENSOR, in whole or in part, if:
6. LICENSEE fails to pay the license fee or submit reports as provided by ARTICLES 5 and 6.
7. LICENSOR determines that such action is necessary to meet the requirements for public use specified by Federal regulations issued after the date of the license and such requirements are not reasonably satisfied by LICENSEE.
8. The LICENSEE has willfully made a false statement of or willfully omitted a MATERIAL fact in the license application or in any report required by the license agreement.
9. The LICENSEE has been found by a court of competent jurisdiction to have violated the Federal antitrust laws in connection with its performance under the license agreement.
10. LICENSEE commits a breach of a covenant contained in this AGREEMENT.
11. LICENSEE becomes insolvent or has ceased to pay debts including license fees.
    1. Before modifying or terminating a license, other than by mutual agreement, the LICENSOR shall furnish the LICENSEE of record a written notice of intention to modify or terminate the license, and the LICENSEE shall be allowed thirty (30) calendar days after such notice to remedy any breach of the license or show cause why the license shall not be modified or terminated unless the breach is one for which no cure period is required as set forth in 13.4.
    2. All fees and reports due up to and including the date of termination of this AGREEMENT are due within thirty (30) calendar days of the date of termination. As such, the following rights and obligations survive any termination to the extent necessary to permit their complete fulfillment or discharge:
12. LICENSEE’S obligation to supply a final report as specified in Section 6.4 of this AGREEMENT; and,
13. LICENSOR’S right to receive or recover and LICENSEE’S obligation to pay fees accrued at the time of any termination.
14. Assignment
    1. LICENSEE may not assign or transfer this AGREEMENT, and any purported assignment or transfer shall be null and void and a breach of this AGREEMENT.
15. Disclosure of Information
    1. LICENSEE agrees to use, disclose, or reproduce the information pertaining to any part of this AGREEMENT or any information related to the technology underlying this AGREEMENT only for the intended PURPOSE.
    2. The LICENSEE shall not release any information to anyone outside the LICENSEE’s or LICENSOR’S respective organization, regardless of medium (e.g., film, tape, document), unless—
16. The undersigned representative of the LICENSOR has given prior written approval; or,
17. The information is otherwise in the public domain before the date of release.
    1. Requests for approval under Article 16.2(a) shall identify the specific information to be released, the medium to be used, and the purpose for the release. The LICENSEE shall submit its request to the undersigned representative of the LICENSOR at least thirty (30) business days before the proposed date for release in accordance with ARTICLE 10.
18. Governing Law
    1. This AGREEMENT will be interpreted and enforced in accordance with United States federal law.
19. Entire Agreement
    1. Except as may be expressly provided otherwise herein, this AGREEMENT constitutes the entire agreement between the PARTIES concerning the subject matter thereof. No prior or contemporaneous representations, inducements, promises, or agreements, oral or otherwise, between the PARTIES with reference thereto will be of any force or effect. This AGREEMENT may only be modified by written agreement of the PARTIES.
20. Counterparts
    1. This AGREEMENT may be executed in separate counterparts, each of which so executed and delivered shall constitute an original, but all such counterparts shall together constitute one and the same instrument. The parties stipulate that a photostatic copy of an executed original will be admissible in evidence for all purposes in any proceeding as between the parties.
21. Acceptance
    1. In witness whereof, each PARTY has caused this AGREEMENT to be executed by its duly authorized representative(s):

|  |  |  |  |
| --- | --- | --- | --- |
| LICENSOR: | | LICENSEE: | |
| U. S Geological Survey | | Company name | |
| By: |  | By: |  |
|  | Katherine M Mculloch |  | Typed name |
|  | Associate Director for Administration |  | Title |
| Date: |  | Date: |  |