

LICENSE AGREEMENT

NATIONAL AERONAUTICS AND SPACE ADMINISTRATION

AND

INSERT COMPANY

EVALUATION LICENSE AGREEMENT

LICENSE COMMENCEMENT DATE:

SAMPLE

EVALUATION LICENSE AGREEMENT

PREAMBLE

This Evaluation License Agreement ("AGREEMENT") is entered into between the National Aeronautics and Space Administration (NASA), an agency of the United States, hereinafter referred to as LICENSOR, having its headquarters in Washington, D.C., and _____, a corporation of the State of _____, having its principal place of business at _____, hereinafter referred to as LICENSEE, as of the date of execution of the last PARTY hereto.

WITNESSETH:

WHEREAS, under the authority of 35 U.S.C. § 200 et seq., the U.S. Department of Commerce has issued Patent Licensing Regulations (37 CFR Part 404.5(a)(1)) specifying the terms and conditions upon which evaluation licenses may be granted for inventions assigned to LICENSOR; and

WHEREAS, LICENSOR is the assignee of U.S. Patent No. _____ for an invention entitled "_____", which issued on _____; and,

WHEREAS, LICENSEE desires to evaluate the invention embodied in U. S. Patent No. _____ for specific commercial applications; and

WHEREAS, LICENSOR has determined that the granting of this Evaluation License to LICENSEE, limited to evaluation for specific commercial applications is in the public interest, that its invention be perfected and practiced so that the benefits are readily available for widest possible utilization in the shortest time possible; and

WHEREAS, LICENSEE represents that it has the facilities, personnel and expertise to expend reasonable efforts to investigate the commercial feasibility of the subject invention;

NOW, THEREFORE, in accordance with said Patent Licensing Regulations, and in consideration of the foregoing and of the terms hereinafter contained in this AGREEMENT, the LICENSOR and LICENSEE agree as set forth below:

ARTICLE I

Definitions

"PARTY" shall mean a party to this AGREEMENT.

GOVERNMENT" shall mean the Federal Government of the United States as represented herein by the National Aeronautics and Space Administration (NASA).

"LICENSE COMMENCEMENT DATE" shall mean the date that the last PARTY has executed this AGREEMENT.

"LICENSE EXPIRATION DATE" shall mean the last day that this AGREEMENT is in effect. This AGREEMENT has a LICENSE EXPIRATION DATE OF _____.

"LICENSED AREA" shall mean the United States of America, its territories, and its possessions.

"LICENSED FIELD(S) OF USE" shall mean _____.

"LICENSE TERM" shall mean the period of time starting with the LICENSE COMMENCEMENT DATE and ending with the LICENSE EXPIRATION DATE.

"LICENSED PATENT(S)" shall mean United States Patent No. _____ and shall include any corresponding reissue patents and modifications of said LICENSED PATENT by means of certificates of correction or reexamination certificates.

"LICENSED PATENT APPLICATION(S)" shall mean U.S. Patent Application Serial No(s)._____, filed on _____ and shall include any corresponding continuation or divisional patent application(s).

"LICENSED INVENTION(S)" shall mean the invention(s) defined by the claims of the LICENSED PATENT, and as may be further limited by ARTICLE II.

"PURPOSE" shall mean evaluation of the LICENSED INVENTION(S) for use in the LICENSED FIELD(S) OF USE. PURPOSE excludes the sale and offer for sale of the LICENSED INVENTION(S). Any use of the LICENSED INVENTION(S) other than evaluation purposes, such as for commercial or industrial use or sale, shall only be made

pursuant to the terms of a separate commercialization license. [Any such commercialization license shall be subject to NASA licensing regulations, 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 a license.]

ARTICLE II

LICENSE GRANT

2.1 LICENSOR hereby grants to LICENSEE, subject to the terms and conditions herein, a nonexclusive, fee-bearing evaluation license to make, have made, and use the LICENSED INVENTION(S) as limited to the LICENSED AREA and as limited to the LICENSED FIELD(S) OF USE and PURPOSE, as defined in ARTICLE I.

2.2 LICENSOR, upon request, will use reasonable efforts to grant LICENSEE, in accordance with 37 CFR Part 404, a license to practice any inventions assigned to LICENSOR, without which license or licenses, the practice of LICENSED INVENTION(S) under this AGREEMENT would result in infringement. The grant of said license or licenses shall be limited, however, to the extent necessary to practice the LICENSED INVENTION(S) under this AGREEMENT. There will be no such grant where said inventions are licensed exclusively.

2.3 This AGREEMENT may not be assigned, sublicensed, or otherwise transferred by LICENSEE without the prior written consent of LICENSOR.

2.4 LICENSEE agrees that its intentions in entering this AGREEMENT are solely to determine the commercial feasibility of LICENSED INVENTION(S). LICENSEE shall expend reasonable efforts and resources to investigate the commercial feasibility of LICENSED INVENTION(S)

2.5 This AGREEMENT does not grant any rights to practice any enhancements or modifications to the LICENSED(S) beyond the termination or expiration of this AGREEMENT; i.e., any such enhancements and modifications shall be subject to LICENSOR'S rights in the LICENSED INVENTION(S); and LICENSOR expressly reserves all rights not expressly granted to LICENSEE in this AGREEMENT

ARTICLE III

ROYALTY AND PAYMENT

3.1 In consideration of the license granted in ARTICLE II, LICENSEE shall remit to LICENSOR a nonrefundable license fee in the amount of \$_____ upon the execution of this AGREEMENT by LICENSEE. The license fee shall be paid by check, denominated in United States dollars, and made payable to the National Aeronautics and Space Administration. The check shall be mailed to LICENSOR at the address set forth in ARTICLE XII of this AGREEMENT. LICENSOR's acceptance of such fee does not eliminate LICENSOR's right to contest the accuracy of such payment in the future.

3.2 The failure to timely pay the license fee may result in the fee being submitted to LICENSOR's Accounts Receivable Department for collection. LICENSOR shall assess interest, penalties, and administrative costs in accordance with the Federal Claims Collections Standards, 31 C.F.R. §§ 900-904, on all payments due LICENSOR which are not timely paid by LICENSEE. In addition to these charges, LICENSOR is authorized to charge to LICENSEE the costs of collection and any associated reasonable attorney fees.

ARTICLE IV

TERM OF LICENSE

4.1 Unless either PARTY terminates this License AGREEMENT as set forth herebelow, this AGREEMENT shall be effective on the LICENSE COMMENCEMENT DATE and remain in effect until the LICENSE EXPIRATION DATE of _____, whereupon the license AGREEMENT shall expire automatically without notice to LICENSEE.

4.2 LICENSOR and LICENSEE each have the right to terminate this AGREEMENT upon 30 days notice in writing to the other PARTY.

4.3 Upon termination or expiration of this AGREEMENT for any reason all rights and licenses granted to LICENSEE hereunder shall automatically terminate.

4.4 The termination or expiration of this AGREEMENT shall not affect any rights or obligations of either party that have matured prior to the termination or expiration and which are intended by the parties to survive the termination or expiration.

ARTICLE V

USE OF THE NASA NAME

5.1 LICENSEE may use the name of LICENSOR, or the acronym "NASA," only in truthful statements concerning its relationship with LICENSOR. The letters 'NASA' may be used in such truthful statements only if they are:

- (a) used in their normal typed or printed form;
- (b) the same size, color, and intensity as the rest of the words in a sentence;
- (c) not used in their stylized version as they appear in the NASA logotype or NASA insignia; and
- (d) not used to indicate that NASA endorses the LICENSEE's products, processes, etc.

5.2 Uses of the letters 'NASA', other than specified in Section 5.1, shall require the express written approval of LICENSOR. Approval by LICENSOR shall be based on applicable law (i.e., 42 U.S.C. §§ 2459b, 2472(a), and 2473(c)(1); and 14 CFR § 1221.100 et seq.) and NASA policy governing the use of the letters 'NASA' and the words 'National Aeronautics and Space Administration' and shall not be unreasonably withheld.

ARTICLE VI

DISCLAIMER OF WARRANTIES

6.1 LICENSOR MAKES NO REPRESENTATIONS OR WARRANTIES, EXPRESS, IMPLIED, OR STATUTORY, AS TO ANY MATTER WHATSOEVER.

6.2 ALL REPRESENTATIONS AND WARRANTIES, EXPRESS, IMPLIED, OR STATUTORY, INCLUDING BUT NOT LIMITED TO THE IMPLIED WARRANTIES OF MERCHANTABILITY AND FITNESS FOR A PARTICULAR PURPOSE ARE EXCLUDED HEREUNDER.

ARTICLE VII

RISK ALLOCATION AND INDEMNIFICATION

7.1 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 of devices incorporating or made by the use of (a) the LICENSED INVENTION(S) or (b) information, if any, furnished under this AGREEMENT.

7.2 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 (a) out of the use by LICENSEE or its transferees of the LICENSED INVENTION(S) or information furnished under this AGREEMENT, or (b) out of any, use, or other disposition by LICENSEE or its transferees of devices, processes, or compositions, made by use of such inventions (including software) or information.

7.3 It shall be the sole responsibility of the LICENSEE to ensure that any and all embodiments of the LICENSED INVENTION(S) are safe under all circumstances.

7.4 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 7.1 and 7.2, 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), 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.

ARTICLE VIII

POINTS OF CONTACT

8.1 The following PERSONS are designated as the points of contact for their respective PARTY and are responsible for keeping this information current by providing updated information as warranted. These points of contact are the principal representatives of the PARTIES involved in the performance of this AGREEMENT.

LICENSOR

LICENSEE

Name: _____

Name: _____

Title: _____

Title: _____

Address: _____

Address: _____

Telephone No.: _____

Telephone No.: _____

Email: _____

Email: _____

ARTICLE IX

REPORT

9.1 LICENSEE agrees to submit in confidence a FINAL REPORT to LICENSOR within thirty (30) days of termination or expiration of this AGREEMENT outlining in general its use and practice of LICENSED INVENTION(S), including, but not limited to, the results of any commercial feasibility studies.

ARTICLE X

GOVERNING LAW

10.1 This AGREEMENT will be interpreted and enforced in accordance with United States federal law.

ARTICLE XI

ENTIRE AGREEMENT

11.1 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.

ARTICLE XII

COUNTERPARTS

12.1 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.

ARTICLE XIII

ACCEPTANCE

13.1 In witness whereof, each PARTY has caused this AGREEMENT to be executed by its duly authorized representatives:

LICENSOR:

LICENSEE:

National Aeronautics and
Space Administration

Company Name

By: _____

By: _____

Typed Name
Title

Typed Name
Title

Date

Date

SAMPLE