

AUBURN UNIVERSITY
OFFICE OF INNOVATION ADVANCEMENT AND COMMERCIALIZATION
“Ready To Sign” non-exclusive licensing program

Instructions for Execution

1. Save this license agreement file to your hard drive.
2. Complete all underlined/blank sections of the agreement, including the date, your company's information in the preamble and Article 12, and signatory information. Be sure to select what patents you wish to include in the agreement by initialing in the appropriate places in the Appendix. The agreement file is in interactive PDF format and can be completed electronically if desired.
3. If submitting electronically, have the appropriate officer/signatory authority of your company sign the agreement and initial the patents of interest in the Appendix. This can be done:
 - a.) by secure digital signatures on the signature line and in the Appendix followed by email submission, or
 - b.) by printing one copy, manually signing/initialing, and then submitting by fax or email.
4. If submitting by mail, print and send two copies of the license agreement. Be sure required company information is provided, and then have the appropriate officer/signatory authority of your company sign both copies and initial the patents of interest in the Appendix.
5. Send the partially executed agreement(s) to:

Electronically: iac@auburn.edu

By Fax: 334-844-5963
ATTN: Associate Director for Commercialization

By Mail: Send two original signed copies to:
Associate Director for Commercialization
Office of Innovation Advancement and Commercialization
Auburn University
570 Devall Drive, Suite 102
Auburn, AL 36832

6. Auburn IAC will return a fully executed agreement along with an invoice.



NON-EXCLUSIVE LICENSE AGREEMENT

between

AUBURN UNIVERSITY

and

This Agreement is made and entered into this ___ day of _____, 20___, by and between AUBURN UNIVERSITY, a university duly established and organized under the laws of the State of Alabama, and with offices located at Office of Innovation Advancement and Commercialization, 570 Devall Drive, Suite 102, Auburn, Alabama, 36832 (“AUBURN”), and

a corporation duly organized under the laws of _____ and having its principal office at _____
(hereinafter referred to as “COMPANY”).

WITNESSETH

WHEREAS, AUBURN is the owner of certain PATENT RIGHTS (as later defined herein) and has the right to grant licenses under said PATENT RIGHTS;

WHEREAS, AUBURN is committed to policy that ideas or creative works produced at AUBURN should be used for the greatest possible public benefit; and accordingly believes that every reasonable incentive should be provided for the prompt introduction of such ideas into public use, all in a manner consistent with the public interest; and

WHEREAS, COMPANY is desirous of obtaining a non-exclusive license in order to practice the above referenced invention covered by patent rights in the United States, and to manufacture, use and sell in the commercial market the products made in accordance therewith; and

WHEREAS, AUBURN is desirous of granting such a license to COMPANY in accordance with the terms of this Agreement.

NOW, THEREFORE, in consideration of the premises and the mutual covenants contained herein, the parties hereto agree as follows:

ARTICLE 1 - DEFINITIONS

For the purposes of this Agreement, the following words and phrases shall have the following meanings:

“EFFECTIVE DATE” means the date upon which AUBURN executes this Agreement.

“FIELD OF USE” means all fields except specifically excluding neurological and olfactory applications.

“LICENSEE” means COMPANY, but also includes a related company of COMPANY, the voting stock of which is directly or indirectly at least fifty percent (50%) owned or controlled by COMPANY, an organization which directly or indirectly controls more than fifty percent (50%) of the voting stock of COMPANY and an organization, the majority ownership of which is directly or indirectly common to the ownership of COMPANY.

“LICENSE YEAR” means a twelve (12) month period commencing on the EFFECTIVE DATE or on the anniversary of the EFFECTIVE DATE.

“LICENSED PRODUCT” means any product and/or process or part thereof which:

- (a) is covered in whole or in part by an issued, unexpired claim or a pending claim contained in the PATENT RIGHTS in the country in which any such product or part thereof is made, used or sold; or
- (b) is manufactured by using a process or is employed to practice a process which is covered in whole or in part by an issued, unexpired claim or a pending claim contained in the PATENT RIGHTS in the country in which any LICENSED PROCESS is used or in which such product or part thereof is used or sold.

“LICENSED PROCESS” means any process that is covered in whole or in part by an issued, unexpired claim or a pending claim contained in the PATENT RIGHTS.

“NP” means the number of active patents that fall under the PATENT RIGHTS.

“PATENT RIGHTS” shall mean all of the following AUBURN intellectual property:

- (a) the United States patents listed in Appendix A that are initialed by both LICENSEE and AUBURN;
- (b) any reissues or reexaminations of United States patents described in (a) above.

“TERRITORY” means worldwide.

ARTICLE 2 - GRANT

2.1 Effective upon the full execution of this Agreement and the payment by LICENSEE to AUBURN of the License Issue Fee, AUBURN hereby grants to LICENSEE, subject to the terms and conditions of this Agreement, the non-exclusive right and license for the FIELD OF USE to practice under the PATENT RIGHTS to make, have made, use, lease, sell, and import LICENSED PRODUCTS and to practice the LICENSED PROCESSES in the TERRITORY, until the end of the term for which the PATENT RIGHTS are granted unless this Agreement shall be sooner terminated according to the terms hereof.

2.2 This Agreement, unless terminated earlier as hereinafter provided, shall terminate on the expiration of the last of the patents licensed hereunder on a country-by-country basis, whereupon the non-exclusive license granted hereunder shall be fully paid and LICENSEE shall be free to develop, make, have made, use, sell and have sold LICENSED PRODUCTS or to utilize LICENSED PROCESSES for the FIELD OF USE without further duties or responsibilities to AUBURN.

2.3 The license granted hereunder shall not be construed to confer any rights upon LICENSEE by implication, estoppel or otherwise as to any technology not specifically set forth under the PATENT RIGHTS.

ARTICLE 3 – ROYALTY FEES

3.1 For the rights, privileges and license granted hereunder, LICENSEE shall pay royalty fees to AUBURN in the manner hereinafter provided to the end of the term of the PATENT RIGHTS or until this Agreement shall be terminated:

LICENSEE shall pay License Fees due on the first day of the First LICENSE YEAR and every LICENSE YEAR thereafter equal to \$7,000 for the first active patent selected in Appendix A, plus \$4,000 for each additional active patent selected in Appendix A, as represented by the formula:

$$\text{License Fee} = \$7,000 + (\text{NP} - 1) \times \$4,000$$

provided that the value of NP for a given LICENSE YEAR will be determined on the first day of said LICENSE YEAR. Further, if a patent under the PATENT RIGHTS expires in a given LICENSE YEAR, then the License Fee due for the given LICENSE YEAR for the given patent may be prorated based on the number of days remaining before said patent expiration.

3.2 All payments due hereunder shall be paid in full, without deduction of wire transfer fees, taxes or other fees which may be imposed by any government and which shall be paid by LICENSEE.

3.3 All payments due hereunder shall be paid in United States dollars and sent to AUBURN according to Article 12. If such payments are not received by AUBURN when due, LICENSEE shall pay to AUBURN interest charges at a rate of ten percent (10%) per year. Such interest shall be calculated from the date payment was due until actually received by AUBURN.

ARTICLE 4 - PATENT PROSECUTION

AUBURN shall maintain the PATENT RIGHTS during the term of this Agreement. The maintenance of all PATENT RIGHTS shall be the primary responsibility of AUBURN. The foregoing notwithstanding, AUBURN shall have no obligation to pursue, undertake or defend a re-examination or other post-issuance prosecution regarding the PATENT RIGHTS.

ARTICLE 5 - INFRINGEMENT

5.1 LICENSEE shall inform AUBURN promptly in writing of any alleged infringement of the PATENT RIGHTS by a third party of which LICENSEE becomes aware and of any available evidence thereof.

5.2 In any infringement suit AUBURN may institute to enforce the PATENT RIGHTS pursuant to this Agreement, LICENSEE shall, at the request and expense of AUBURN, cooperate in all respects and, to the extent possible, have its employees testify when requested and make available relevant records, papers, information, samples, specimens, and the like.

ARTICLE 6 - PRODUCT LIABILITY

6.1 LICENSEE shall at all times during the term of this Agreement and thereafter, indemnify, defend and hold AUBURN, its trustees, directors, officers, employees and affiliates, harmless against all claims, proceedings, demands and liabilities of any kind whatsoever, including legal expenses and reasonable attorneys' fees, arising out of the death of or injury to any person or persons or out of any damage to property, or resulting from the production, manufacture, sale, use, lease, consumption or advertisement of the LICENSED PRODUCT(s) and/or LICENSED PROCESS(es) or arising from any obligation of LICENSEE hereunder, excepting only claims that the PATENT RIGHTS infringe third party intellectual property.

6.2 Beginning at the time when any LICENSED PRODUCTS are being distributed or sold (including for the purpose of obtaining regulatory approvals), LICENSEE shall, at its sole cost and expense, procure and maintain commercial general liability insurance that will provide (i) product liability coverage; (ii) broad form contractual liability coverage for LICENSEE's indemnification under this Agreement; and (iii) coverage for litigation costs. LICENSEE shall provide AUBURN with written evidence of such insurance upon AUBURN's written request.

6.3 EXCEPT AS OTHERWISE EXPRESSLY SET FORTH IN THIS AGREEMENT, AUBURN, ITS TRUSTEES, DIRECTORS, OFFICERS, EMPLOYEES, AND AFFILIATES MAKE NO REPRESENTATIONS AND EXTEND NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED, INCLUDING BUT NOT LIMITED TO WARRANTIES OF MERCHANTABILITY, FITNESS FOR A PARTICULAR PURPOSE, VALIDITY OF PATENT RIGHTS CLAIMS, ISSUED OR PENDING, AND THE ABSENCE OF LATENT OR OTHER DEFECTS, WHETHER OR NOT DISCOVERABLE. NOTHING IN THIS AGREEMENT SHALL BE CONSTRUED AS A REPRESENTATION MADE OR WARRANTY GIVEN BY AUBURN THAT THE PRACTICE BY

LICENSEE OF THE LICENSE GRANTED HEREUNDER SHALL NOT INFRINGE THE PATENT, COPYRIGHT, TRADEMARK OR OTHER INTELLECTUAL PROPERTY RIGHTS OF ANY THIRD PARTY. IN NO EVENT SHALL EITHER PARTY, ITS TRUSTEES, DIRECTORS, OFFICERS, EMPLOYEES AND AFFILIATES BE LIABLE FOR INCIDENTAL OR CONSEQUENTIAL DAMAGES OF ANY KIND, INCLUDING ECONOMIC DAMAGE OR INJURY TO PROPERTY AND LOST PROFITS, REGARDLESS OF WHETHER SUCH PARTY SHALL BE ADVISED, SHALL HAVE OTHER REASON TO KNOW, OR IN FACT SHALL KNOW OF THE POSSIBILITY.

ARTICLE 7 - EXPORT CONTROLS

It is understood that AUBURN is subject to United States laws and regulations controlling the export of technical data, computer software, laboratory prototypes and other commodities (including the Arms Export Control Act, as amended and the Export Administration Act of 1979), and that its obligations hereunder are contingent on compliance with applicable United States export laws and regulations. The transfer of certain technical data and commodities may require a license from the cognizant agency of the United States Government and/or written assurances by LICENSEE that LICENSEE shall not export data or commodities to certain foreign countries without prior approval of such agency. AUBURN neither represents that a license shall not be required nor that, if required, it shall be issued.

ARTICLE 8 - NON-USE OF NAMES

LICENSEE shall obtain the prior written approval of AUBURN, or the inventors listed on the PATENT RIGHTS, prior to making use of their names for any commercial purpose, except as required by law. As an exception to the foregoing, both LICENSEE and AUBURN shall have the right to disclose the existence of this Agreement; however, neither LICENSEE nor AUBURN shall disclose any terms and conditions of this Agreement without the other party's consent, except as required by law.

ARTICLE 9 - ASSIGNMENT

This Agreement may be assigned by mutual written agreement of LICENSEE and AUBURN.

ARTICLE 10 - DISPUTE RESOLUTION

Except for the right of either party to apply to a court of competent jurisdiction for a temporary restraining order, a preliminary injunction, or other equitable relief to preserve the status quo or prevent irreparable harm, any and all claims, disputes or controversies arising under, out of, or in connection with the Agreement, including any dispute relating to patent validity or infringement, which the parties shall be unable to resolve within sixty (60) days shall be mediated in good faith. Such good faith mediation will take place in the State of Alabama, with neither party having obligations to continue such mediation beyond ninety (90) days from the above mentioned sixty (60) day resolution period.

Notwithstanding the foregoing, nothing in this Article shall be construed to waive any rights or timely performance of any obligations existing under this Agreement.

ARTICLE 11 - TERMINATION

11.1 If LICENSEE shall cease to carry on its business, this Agreement shall terminate upon written notice by AUBURN. Further, this Agreement shall terminate automatically if LICENSEE becomes bankrupt or insolvent and/or if the business of LICENSEE is placed in the hands of a receiver, assignee, or trustee, whether by voluntary act of LICENSEE or otherwise.

11.2 If LICENSEE fails to perform or violates any term of this Agreement then AUBURN may give written notice of default ("Notice of Default") to LICENSEE. If LICENSEE fails to cure the default within thirty (30) days of the Notice of Default, AUBURN may terminate this Agreement and the license granted herein by a second written notice ("Notice of Termination") to LICENSEE. If a Notice of Termination is sent to LICENSEE, this Agreement shall automatically terminate on the effective date of that notice. Termination shall not relieve LICENSEE of its obligation to pay any fees owed at the time of termination and shall not impair any accrued right of AUBURN.

11.3 LICENSEE shall have the right to terminate this Agreement at any time and for any reason upon ninety (90) days' written notice to AUBURN, and upon payment of all amounts due AUBURN through the effective date of the termination.

11.4 Upon termination of this Agreement for any reason, nothing herein shall be construed to release either party from any obligation that matured prior to the effective date of such termination; and Articles 1, 6, 7, 8, 11.4 and 13 shall survive any such termination. LICENSEE may, however, for a period of one hundred and twenty (120) days after the effective date of such termination, sell all LICENSED PRODUCTS, and complete LICENSED PRODUCTS in the process of manufacture at the time of such termination and sell the same, provided that LICENSEE shall make the payments to AUBURN as required by Article 3 of this Agreement.

ARTICLE 12 – PAYMENTS, NOTICES AND OTHER COMMUNICATIONS

Any payment, notice or other communication pursuant to this Agreement shall be sufficiently made or given on the date of mailing if sent to such party by certified first class mail, postage prepaid, addressed to it at its address below or as it shall designate by written notice given to the other party:

In the case of AUBURN:

Director
Office of Innovation Advancement
and Commercialization
Auburn University
570 Devall Drive, Suite 102
Auburn, AL, 36832, USA

In the case of LICENSEE:

Title: _____
Company: _____
Address 1: _____
Address 2: _____
City, State, Zip: _____

ARTICLE 13 - MISCELLANEOUS PROVISIONS

13.1 This Agreement shall be construed, governed, interpreted and applied in accordance with and under the jurisdiction of the laws of the State of Alabama, U.S.A., notwithstanding the

residence or principal place of business of any party, the place where this Agreement may be executed by any party or the provisions of any jurisdiction's conflict-of-laws principles, provided that questions affecting the scope and validity of any patent shall be determined by the law of the country in which the patent was granted.

13.2 The parties hereto acknowledge that this Agreement sets forth the entire agreement and understanding of the parties hereto as to the subject matter hereof, and all prior representations and warranties have been merged into this document and are thus superseded in totality by this Agreement. This Agreement shall not be subject to any change or modification except by the execution of a written instrument subscribed to by the parties hereto.

13.3 The provisions of this Agreement are severable, and in the event that any provisions of this Agreement shall be determined to be invalid or unenforceable under any controlling body of the law, such invalidity or unenforceability shall not in any way affect the validity or enforceability of the remaining provisions hereof.

13.4 LICENSEE agrees to mark the LICENSED PRODUCTS sold in the United States with all applicable United States patent numbers. All LICENSED PRODUCTS shipped to or sold in other countries shall be marked in such a manner as to conform with the patent laws and practice of the country of manufacture or sale.

13.5 The failure of either party to assert a right hereunder or to insist upon compliance with any term or condition of this Agreement shall not constitute a waiver of that right or excuse a similar subsequent failure to perform any such term or condition by the other party.

IN WITNESS WHEREOF, the parties have duly executed this Agreement the day and year set forth below.

COMPANY

AUBURN UNIVERSITY

By: _____
Name: _____
Title: _____
Date: _____

By: _____
Name: John M. Mason
Title: Vice President for Research
and Economic Development
Date: _____

APPENDIX A

LICENSEE initials	AUBURN initials	US Patent Number	US Patent Title	Issue Date
		7,138,255	Method of Isolation and Self-Assembly of Small Protein Particles from Blood and Other Biological Materials	11/21/2006
		7,871,772	Methods for detecting misfolded proteins in biological samples	1/18/2011
		7,872,108	Processes for isolating proteon nucleation centers (PNCs) from a biological sample obtained from an animal	1/18/2011
		8,298,793	Methods for isolating proteons from plasma samples	10/30/2012