# Patent License Agreement

This Patent License Agreement ("**Agreement**") is entered into as the \_\_\_ day of \_\_\_\_\_\_\_\_\_\_, 202\_ ("**Effective Date**"), by and between **KENT STATE UNIVERSITY**, a state university of Ohio, having a principal place of business at 800 E. Summit Street, 207 Michael Schwartz Center, Summit Street, Kent, OH 44242 as licensor (“**KSU**” or “**Licensor**”), and ***[Company]***,an \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_, having its place of business at \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_, as licensee (“**Licensee**”). KSU and Licensee may be referred to herein individually as a “**Party**” or collectively as the “**Parties**.”

**1.** Definitions.

**1.1** Patent Rights means, in each case to the extent owned and controlled by Licensor: (a) the patents and patent applications listed in **Exhibit “A”**, including the PCT and/or U.S. utility application claiming priority to such applications; (b) any patent or patent application that claims priority to and is a divisional, continuation, reissue, renewal, reexamination, substitution or extension of any patent application identified in (a); (c) any patents issuing on any patent application identified in (a) or (b), including any reissues, renewals, reexaminations, substitutions or extensions thereof; (d) any claim of a continuation-in-part application or patent (including any reissues, renewals, reexaminations, substitutions or extensions thereof) that is entitled to the priority date of, and is directed specifically to subject matter specifically described in, at least one of the patents or patent applications identified in (a), (b) or (c); (e) any foreign counterpart (including PCTs) of any patent or patent application identified in (a), (b) or (c) or of the claims identified in (d); and (f) any supplementary protection certificates, pediatric exclusivity periods, any other patent term extensions and exclusivity periods and the like of any patents and patent applications identified in (a) through (e).

**1.2** Technology means any information: (a) created prior to the Effective Date; (b) owned by KSU; (c) not infringing any pending or issued claim in the Patent Rights; and (d) necessary to practice inventions claimed in patents and/or patent applications included in the Patent Rights.

**1.3** Licensed Product means, on a country by country basis, any product or service, the making, using, selling, offering for sale, importing, exporting or performing in the country in question would (without the license grated hereunder) infringe directly, indirectly by inducement of infringement, or indirectly by contributory infringement, at least one pending valid claim (were it to have issued) or issued valid claim in that country, or any product or service that was created or developed using Technology.

**1.4** Field of Use means ***[description of field of use]***.

**1.5** Territory means ***[geographic scope of the license]***.

**1.6** Net Sales means the gross amount of all sales or leases of Licensed Products by Licensee, Affiliates, or sublicensees to any customer LESS:

(a) discounts and rebates actually granted

(b) excise and sales taxes imposed on the License Products and actually paid;

(c) import, export and custom duties imposed on the License Products and actually paid; and

(d) freight, transit and insurance charges actually paid.

**1.7** Exclusive means that subject to Articles 2 & 9, KSU will not grant further licenses under the Patent Rights in the Field of Use in the Licensed Territory. Nothing herein shall be construed as limiting KSU’s ability license the Patent Rights for commercial or noncommercial uses that are not in the Field of Use.

* 1. Sublicense Agreement means any agreement or arrangement pursuant to which Licensee (or an Affiliate or Sublicensee) grants to any third party any licensee rights or Licensee under the Agreement.
  2. Sublicenseemeans any entity to which a Sublicense Agreement has been granted under the Patent Rights. For clarity, a third party wholesaler or distributor who has no significant responsibility for marketing and promotion of the Licensed Product or Licensed Services within its distribution territory or field (i.e., the third party simply functions as a reseller), and who does not pay any consideration to Licensee or an Affiliate for such wholesale or distributor rights, shall not be deemed a Sublicensee; and the resale by such a wholesaler or distributor shall not be treated as royalty bearing Net Sales by a Sublicensee provided that a royalty is being paid by Licensee for the initial transfer to the wholesaler or distributor pursuant to Sections 2.3 and 3.5. This definition does not limit Licensee’s rights to grant or authorize sublicenses under the Agreement.

**1.10** Affiliate means, with respect to a person, organization or entity, any person, organization or entity controlling, controlled by or under common control with, such person, organization or entity.  For purposes of this definition only, “control” of another person, organization or entity will mean the possession, directly or indirectly, of the power to direct or cause the direction of the activities, management or policies of such person, organization or entity, whether through the ownership of voting securities, by contract or otherwise.  Without limiting the foregoing, control will be presumed to exist when a person, organization or entity (a) owns or directly controls fifty percent (50%) or more of the outstanding voting stock or other ownership interest of the other organization or entity or (b) possesses, directly or indirectly, the power to elect or appoint fifty percent (50%) or more of the members of the governing body of the other organization or entity.  The Parties acknowledge that in the case of certain entities organized under the laws of certain countries outside of the United States, the maximum percentage ownership permitted by law for a foreign investor may be less than fifty percent (50%) and that in such cases such lower percentage will be substituted in the preceding sentence.

**2.** License Grant.

* 1. Grant.Licensor grants to Licensee a royalty-bearing exclusive license under Patent Rights to manufacture, have manufactured, distribute, have distributed, use, offer for Sale, Sell, lease, loan and/or import Licensed Products in the Field in the Territory and to perform Licensed Services in the Field in the Territory.This grant is subject to (i) the payment by Licensee to Licensor of all consideration required under the Agreement, (ii) any rights of, or obligations to, the Government as set forth below, and (iii) rights retained by Licensor as set forth below.Licensor reserves all rights not expressly granted in the Agreement and disclaims the grant of any implied rights to Licensee.
  2. Reservation of Rights**.**

1. Research and Educational Use.Licensor retains the right on behalf of itself and all other non-profit research institutions to practice under the Patent Rights for research, teaching, clinical, patient care, and educational purposes.
2. Federal Government. Licensee acknowledges that the U.S. federal government retains a royalty-free, non-exclusive, non-transferable license to practice any government-funded invention claimed in any Patent Rights as set forth in 35 U.S. C. §§ 201-211, and the regulations promulgated thereunder, as amended, or any successor statutes or regulations.

**2.3** Sublicensing**.** Licensee has the right to grant Sublicense Agreements under the Patent Rights and to use Technology consistent with the terms of this Agreement subject to the following:

(a) A Sublicense Agreement shall not exceed the scope and rights granted Licensee hereunder. Sublicensee must agree in writing to be bound by the applicable terms and conditions of the Agreement and shall indicate that KSU is a third-party beneficiary of the Sublicense Agreement.

(b) Licensee shall deliver to KSU a true, complete, and correct copy of each Sublicense Agreement granted by Licensee, Affiliate or Sublicensee, and any modification or termination thereof, within thirty (30) days following the applicable execution, modification, or termination of such Sublicense Agreement.

(c) Licensee shall collect and guarantee payment of all payments due, directly or indirectly, to KSU from Sublicensees and summarize and deliver all reports due, directly or indirectly, to KSU from Sublicensees.

(d) All rights and licenses of Sublicensees shall terminate upon termination of the Agreement.

**2.4** Reservation of Rights**.** KSU reserves the right to (a) use technology covered by any pending or issued claim of the Patent Rights and/or Technology (collectively, “**Licensed Technology**”) for educational, research, patient care and other educationally-related purposes; (b) publish or otherwise disseminate results of scientific studies relating to the Licensed Technology; and (c) grant rights to, and transfer embodiments of, the Licensed Technology to other academic institutions or non-profit research institutions for the purposes identified in (a) and (b) above.

**3.** Fees and Royalties.

**3.1** Upfront Fee. Licensee shall pay to KSU a noncreditable, nonrefundable upfront license royalty of \_\_\_\_\_\_\_\_\_\_($00.0) upon execution of the Agreement.

**3.2** Maintenance Fees**.** Beginning \_\_\_\_\_\_\_\_\_\_ and each \_\_\_\_\_\_\_\_\_\_ thereafter, Licensee will pay KSU a nonrefundable maintenance fee of $\_\_\_\_\_\_\_\_\_\_, and such Maintenance Fees paid by Licensee are creditable against Earned Royalty payments.

**3.3** Minimum Royalty**.** Licensee shall pay KSU \_\_\_\_\_\_\_\_($00.0) every ***[quarter/year/\_\_\_]*** as a Minimum Royalty Payment. Licensee will pay KSU on or before the ***[quarterly/annual]*** payment deadline an additional amount equal to the difference between the Minimum Royalty Payment and the actual royalties paid to KSU if the actual royalties paid to KSU are less than the Minimum Royalty Payment.

**3.4** Earned Royalty**.** Licensee shall pay an earned royalty of [ \_\_ ]% on Net Sales of Licensed Products by Licensee and/or its Affiliates.

**3.5** Sublicensing Fee**.** Licensee will pay KSU [ \_\_ ]% of all sublicense fees received by Licensee from sublicenses that are not earned royalties.

**4.** Payment.

**4.1** Quarterly Royalty Reports. Beginning with the first sale of a Licensed Product, Licensee will submit to KSU a written report and an earned royalty payment within thirty (30) days after the end of each quarter (March 31, June 30, September 30, December 31). License shall submit this report even if it makes no sales of the Licensed Product during the reporting period. This report shall include the following:

(a) Quantity of sales of Licensed Products segregated by product;

(b) Net Sales segregated by product;

(c) Itemized deductions permitted by Section 1.6(a)-(d) segregated by product; and

(d) The applicable royalty rate.

**4.2** Records. Licensee shall keep, and shall require its Affiliates and Sublicensees to keep, accurate and correct records of all Licensed Products manufactured, used, and sold, and Sublicense fees received under this Agreement for at least five (5) years from end of the quarter the record documents.

**4.3** Audit. KSU has, at its sole discretion, the right to audit Licensee’s records to verify payments made by Licensee under the Agreement. KSU may use a designated representative to conduct an audit under this provision. KSU shall pay for any such audit provided that Licensee shall pay the audit costs if the audit reveals an underreporting of earned royalties due KSU of five percent (5%) or more for the period being audited.

**4.4** Payment. All payments to KSU will be made in U.S. dollars by check or ACH credit transfer (Licensee to pay all ACH fees) payable to Kent State University. ACH information:

Account Name: Kent State University

Account Number: 4116429595

Routing Number: 041000124

Financial Institution: PNC Bank, N.A.

**4.5** Late Payments**.** Amounts past due under this Agreement will accrue a late charge of 0.75% per month from the due date until paid.

**5.** Milestones. Licensee agrees to use commercially reasonable and diligent efforts to develop, manufacture and sell Licensed Product(s) and develop markets for Licensed Product(s). Licensee shall complete the Milestones set forth in Exhibit “B” hereto on or before the deadlines set therein. KSU shall have sole discretion to determine if Licensee has satisfied a Milestone.

**6.** Reporting. Beginning ***[six (6) months after] [on the final day of the quarter including]*** the Effective Date and ending on the date of the first commercial sale of a Licensed Product in the Territory, Licensee shall provide to KSU a report detailing Licensee’s progress for the preceding ***[six (6) months] [quarter]*** to bring the Licensed Products to market including: (a) efforts to obtain necessary government approvals; (b) summary of work completed; (c) summary of work in progress; (d) summary of progress on milestones; (e) scheduled plan for next ***[six (6) months] [quarter]***; (f) marketing plans for introduction of Licensed Products (if applicable); and (g) summary of resources, including resources (dollar value) spent during reporting period and resources (dollar value) available as of report date.

**7**. Term and Termination.

* 1. Unless earlier terminated as provided herein, the term of the Agreement will commence on the Effective Date and continue until the last date of expiration or termination of the Patent Rights.
  2. Licensee, at its option, may terminate the Agreement by providing Licensor written notice of intent to terminate, which such termination effective will be 90 days following receipt of such notice by Licensor.
  3. Licensor, at its option, may immediately terminate the Agreement, or any part of Patent Rights, or any part of Field, or any part of Territory, or the exclusive nature of the license grant, upon delivery of written notice to Licensee of Licensor’s decision to terminate, if any of the following occur:
     1. Licensee becomes in arrears in any payments due under the Agreement, and Licensee fails to make the required payment within 30 days after delivery of written notice from Licensor; or
     2. Licensee is in breach of any non-payment provision of the Agreement, and does not cure such breach within 60 days after delivery of written notice from Licensor; or
     3. Licensor delivers notice to Licensee of three or more actual breaches of the Agreement in any 12-month period, even in the event that Licensee cures such breaches in the allowed period; or
     4. Licensee or its Affiliate or Sublicensee initiates any proceeding or action to challenge the validity, enforceability, or scope of one or more of the Patent Rights, or assist a third party in pursuing such a proceeding or action.
  4. The Agreement will terminate:
     1. Immediately without the necessity of any action being taken by Licensor or Licensee, (i) if Licensee becomes bankrupt or insolvent, or (ii) Licensee’s Board of Directors elects to liquidate its assets or dissolve its business, or (iii) Licensee ceases its business operations, or (iv) Licensee makes an assignment for the benefit of creditors or (v) if the business or assets of Licensee are otherwise placed in the hands of a receiver, assignee or trustee, whether by voluntary act of Licensee or otherwise; or
     2. At any time by mutual written agreement between Licensee and Licensor.
  5. If the Agreement is terminated for any reason:
     1. All rights and licenses of Sublicensees shall terminate upon termination of the Agreement; provided however, if the Sublicense Agreement is for all of the Field for all of the Territory, and the Sublicensee is in good standing and agrees in writing to assume all of the obligations of Licensee and provides Licensor with written notice thereof within 30 days after termination of the Agreement, then such Sublicense Agreement shall survive; and
     2. Licensee shall cease making, having made, distributing, having distributed, using, selling, offering to sell, leasing, loaning and importing any Licensed Products and performing Licensed Services by the effective date of termination; and
     3. Licensee shall tender payment of all accrued royalties and other payments due to Licensor as of the effective date of termination; and
     4. Nothing in the Agreement will be construed to release either Party from any obligation that matured prior to the effective date of termination; and
     5. The provisions of Sections 8.3 (Infringement of the Patent Rights), 10 (Warranties and Disclaimers), 11 (Risk), 13 (Use of Name), 14 (Notices), and 15.4 (Confidentiality) will survive any termination or expiration of the Agreement. In addition, the provisions of Sections 3 (Fees and Royalties), 6 (Reporting), 4 (Payment, Records and Audits), and 8.1(a) (Patent Expenses) shall survive with respect to all activities and payment obligations accruing prior to the termination or expiration of the Agreement.

**7.6** Surviving Provisions. The following Sections shall survive the termination of this Agreement:

(a) Section 15.4 (Confidentiality)

(b) Section 11.1 (Indemnification)

The following Sections and Articles shall survive termination with respect to any activities and payment obligations accruing prior to termination or expiration of the Agreement:

(d) Article 3 (Fees and Royalties)

(e) Section 4.3 (Audit, Reporting)

(f) Article 6 (Reporting)

**8.** Patent Matters.

**8.1** Patent Prosecution.

(a) Patent Expenses. Upon execution of this Agreement, Licensee shall reimburse KSU for all documented expenses KSU has incurred relating to the preparation, filing, prosecution and maintenance of the Patent Rights. Thereafter, Licensee will reimburse KSU for all documented expenses KSU has incurred relating to the preparation, filing, prosecution and maintenance of the Patent Rights for so long as, and in such countries as, the Agreement remains in effect. All payments due pursuant to Section 8.1(a) shall be made within thirty (30) days of receipt of KSU’s invoice and are subject to Sections 4.4 and 4.5 above.

(b) KSU shall diligently prosecute applications included in the Patent Rights using outside counsel of its choice. KSU shall provide Licensee with copies of all relevant documentation relating to such prosecution and Licensee shall keep this documentation Confidential. Outside counsel shall take instructions only from KSU.

(c) Licensee may elect to cease paying patent prosecution costs for certain patent applications. In the event of such an election, ***[the rights granted Licensee in Section 2.1 shall become nonexclusive] [the patent application and patent issued therefrom shall no longer be included in the Patent Rights and Licensee shall have no further rights thereto] [OTHER OPTIONS]***.

**8.2** Patent Marking**.** Licensee shall, and shall cause its Affiliates and Sublicensees to, mark the License Products sold or otherwise disposed of (1) with all applicable patent numbers; and (2) in accordance with the patent laws and practice of the country in which the Licensed Products are shipped, sold or otherwise disposed of.

**8.3** Infringement Of The Patent Rights.

(a) Licensee will promptly inform KSU of any suspected infringement of a Licensed Patent by a third party.

(b) In any suit for patent infringement of a Licensed Patent brought against a third party, the KSU and Licensee shall cooperate fully. At the request of the party bringing the suit, the other party will permit, with reasonable notice, reasonable access to all relevant personnel, records, papers, information, samples, specimens, etc., during regular business hours.

(c) Licensee must obtain permission from KSU and the Ohio Attorney General to name KSU as a party in action for patent infringement of a Licensed Patent brought against a third party. Permission from KSU shall not be unreasonably withheld, provided that KSU shall have reasonable prior input with respect to choice of counsel on any matter where counsel represents KSU, and such counsel agrees to follow all required procedures of the Ohio Attorney General regarding retention of outside counsel for state entities.

**8.4** Challenging The Patent Rights.

(a) In the event that Licensee or its Sublicensee(s), during the Term of this Agreement, contest the validity or unenforceability of any Patent Rights or whether there is infringement of the Patent Rights (collectively, “Patent Challenge”), Licensee agrees, and shall require its Sublicensees to agree, to pay to KSU all royalties due under the Agreement during the period of the Patent Challenge. Such amounts shall be paid directly to KSU as specified in Section 4.4 and not into any escrow or other account.

(b) In the event that a Patent Challenge brought by Licensee is successful, Licensee shall have no right to recoup any royalties paid prior to the conclusion of the Patent Challenge. The parties agree that a Patent Challenge is concluded when a court of competent jurisdiction enters final judgment or when a national patent office enters a final determination (in the U.S., a determination that is appealable to the Board of Patent Appeals and Interferences).

(c) In the event of a Patent Challenge brought by Licensee, Licensee will pay the reasonable attorney fees and costs of KSU in such action if the challenged Licensed Patent(s) is/are not found invalid, unenforceable or not infringed by a United States District Court or national patent office including the U.S.P.T.O.

**9.** Government Laws and Regulations.

**9.1** Government Approvals.Licensee is responsible, at Licensee’s expense, for obtaining all necessary government approvals for the development, production, distribution, sale and use of any Licensed Product.

**9.2** Government Registration. If this Agreement or any associated transaction is required by the law of any nation to be either approved or registered with any governmental agency, Licensee shall assume all legal obligations to do so at Licensee’s expense.

* 1. Export Control.Licensee represents and warrants that it will comply with all applicable local, state, federal and international laws governing export of the Licensed Products including, but not limited to, the Export Administration Regulations, the International Traffic in Arms Regulations and the various economic sanctions regulations administered by the U.S. Department of Treasury (collectively, “Export Laws”). Licensee warrants and covenants that it will not, directly or indirectly, export nor re-export the Licensed Products (including any associated products, items, articles, computer software, media, services, technical data and other information) in violation of applicable Export Laws. Licensee shall require its Sublicensees to agree to terms substantially similar to the terms of this Article requiring that Sublicensees comply with all applicable Export Laws.

**9.4** Government Rights**.** This Agreement is subject to Title 35 Sections 200-204 of the United States Code. Among other things, these provisions may provide the United States Government with nonexclusive rights in the Patent Rights. Licensee will ensure all obligations of these provisions are met.

**10.** Warranties and Disclaimers.

**10.1** KSU Representations and Warranties.Except for the rights, if any, of the Government as set forth in Section 9.4, KSU represents and warrants to Licensee that to the knowledge of KSU’s Office of Technology Commercialization:

(a) KSU is the owner of the entire right, title and interest in and to the Patent Rights;

(b) KSU has the sole right to file Applications within the definition of Patent Rights;

(c) KSU has the right to grant licenses hereunder, and

(d) KSU has not knowingly granted and will not knowingly grant licenses or other rights to the Patent Rights that are in conflict with the terms and conditions in the Agreement.

**10.2** KSU’s DISCLAIMER OF WARRANTIES**.** NOTHING CONTAINED HEREIN SHALL BE DEEMED TO BE A WARRANTY BY LICENSOR THAT IT CAN OR WILL BE ABLE TO OBTAIN PATENTS ON PATENT APPLICATIONS INCLUDED IN THE PATENT RIGHTS, OR THAT ANY OF THE PATENT RIGHTS WILL AFFORD ADEQUATE OR COMMERCIALLY WORTHWHILE PROTECTION.  LICENSOR MAKES NO WARRANTIES WHATSOEVER AS TO THE COMMERCIAL OR SCIENTIFIC VALUE OF THE PATENT RIGHTS OR LICENSOR TECHNOLOGY. LICENSOR MAKES NO REPRESENTATION THAT THE PRACTICE OF THE PATENT RIGHTS OR USE OF THE LICENSOR TECHNOLOGY OR THE DEVELOPMENT, MANUFACTURE, USE, SALE OR IMPORTATION OF ANY LICENSED PRODUCT OR THE PRACTICE OF ANY LICENSED PRODUCT, OR ANY ELEMENT THEREOF, WILL NOT INFRINGE ANY PATENT OR PROPRIETARY RIGHTS.  EXCEPT AS OTHERWISE EXPRESSLY PROVIDED IN THIS AGREEMENT, NEITHER PARTY MAKES ANY WARRANTY WITH RESPECT TO ANY TECHNOLOGY, PATENTS, GOODS, SERVICES, RIGHTS OR OTHER SUBJECT MATTER OF THIS AGREEMENT AND EACH PARTY HEREBY DISCLAIMS WARRANTIES OF MERCHANTABILITY, FITNESS FOR A PARTICULAR PURPOSE AND NONINFRINGEMENT WITH RESPECT TO ANY AND ALL OF THE FOREGOING.

**10.3** Licensee’s Representations and Warranties**.** Licensee represents and warrants that it has full corporate power and authority to enter into this Agreement, this Agreement constitutes the binding legal obligation of the Licensee, and execution and performance of this Agreement by Licensee will not violate or conflict with any other agreement to which Licensee is a party or by which it is bound or with any law, rule or regulation applicable to Licensee.

**11.** Risk.

**11.1** Indemnification**.** Licensee agrees to indemnify, hold harmless and defend KSU and its trustees officers, employees, students and agents (“**Indemnitees**”) against any and all claims, suits, losses, damage, costs, fees and expenses resulting from or arising out of (1) the exercise of any rights granted Licensee under Agreement; (2) the breach of this Agreement by Licensee; (3) the exercise of any rights granted under a sublicense pursuant to the Agreement; or (4) the breach of any sublicense granted pursuant to the Agreement. This indemnification shall include, without limitation, any product liability claim.

* 1. Insurance. Beginning at the time any Licensed Product is being commercially distributed or sold (other than for the purpose of obtaining regulatory approvals) by Licensee, or by an Affiliate, Sublicensee or agent of Licensee, Licensee shall, at its sole cost and expense, procure and maintain commercial general liability insurance in amounts not less than $5,000,000 per incident and $5,000,000 annual aggregate and naming the Indemnitees as additional insureds. During clinical trials of any such Licensed Product, Licensee shall, at its sole cost and expense, procure and maintain commercial general liability insurance in such equal or lesser amount as Licensor shall require, naming the Indemnitees as additional insureds. Such commercial general liability insurance shall provide: (a) product liability coverage and (b) broad form contractual liability coverage for Licensee's indemnification obligations under this Agreement.
  2. If Licensee elects to self-insure all or part of the limits described above in Section 9.2.1 (including deductibles or retentions that are in excess of $250,000 annual aggregate) such self-insurance program must be acceptable to Licensor and Licensor's insurer in their sole discretion. The minimum amounts of insurance coverage required shall not be construed to create a limit of Licensee's liability with respect to its indemnification obligations under this Agreement.
  3. Licensee shall provide Licensor with written evidence of such insurance upon request of Licensor. Licensee shall provide Licensor with written notice at least fifteen (15) days prior to the cancellation, non-renewal or material change in such insurance. If Licensee does not obtain replacement insurance providing comparable coverage within such fifteen (15) day period, Licensor shall have the right to terminate this Agreement effective at the end of such fifteen (15) day period without notice or any additional waiting periods.
  4. Licensee shall maintain such commercial general liability insurance beyond the expiration or termination of this Agreement during: (a) the period that any Licensed Product is being commercially distributed or sold by Licensee, or an Affiliate, Sublicensee or agent of Licensee; and (b) a reasonable period after the period referred to in (a) above which in no event shall be less than fifteen (15) years.
  5. Limitation of Liability**.** IN NO EVENT SHALL LICENSOR, ITS INVENTORS, OFFICERS, EMPLOYEES, STUDENTS, AGENTS OR AFFILIATED ENTERPRISES, BE LIABLE FOR ANY INDIRECT, SPECIAL, CONSEQUENTIAL, INCIDENTAL, EXEMPLARY, OR PUNITIVE DAMAGES (INCLUDING, WITHOUT LIMITATION, DAMAGES FOR LOSS OF PROFITS OR REVENUE) ARISING OUT OF OR IN CONNECTION WITH THE AGREEMENT OR ITS SUBJECT MATTER, REGARDLESS OF WHETHER ANY SUCH PARTY KNOWS OR SHOULD KNOW OF THE POSSIBILITY OF SUCH DAMAGES. OTHER THAN FOR CLAIMS AGAINST LICENSEE FOR INDEMNIFICATION (SECTION 11.1) OR FOR MISUSE OR MISAPPROPRIATION OR INFRINGEMENT OF LICENSOR’S INTELLECTUAL PROPERTY RIGHTS, LICENSEE WILL NOT BE LIABLE TO LICENSOR FOR ANY INDIRECT, SPECIAL, CONSEQUENTIAL OR PUNITIVE DAMAGES (INCLUDING, WITHOUT LIMITATION, DAMAGES FOR LOSS OF PROFITS OR REVENUE) ARISING OUT OF OR IN CONNECTION WITH THE AGREEMENT OR ITS SUBJECT MATTER, REGARDLESS OF WHETHER LICENSEE KNOWS OR SHOULD HAVE KNOWN OF THE POSSIBILITY OF SUCH DAMAGES.

**12.** Assignment. This Agreement may not be assigned by Licensee without the prior written consent of KSU; provided that Licensee may assign this agreement to any purchaser or transferee of all or substantially all of Licensee’s business upon prior written notice to KSU.

**13.** Use of Name. Licensee shall not use the name, trademarks or other marks of Licensor without the advance written consent of Licensor. Licensor may use Licensee’s name for annual reports, brochures, website and internal reports without prior consent. Neither Party will be restricted from disclosing the existence of this Agreement or the identity of the Parties or otherwise disclosing information as required by law.

**14.** Notices. All notices under this Agreement are deemed fully given when written, addressed and sent as follows:

(a) All notices to Licensee are mailed to:

\_\_\_\_\_\_\_

\_\_\_\_\_\_\_

(b) All general notices and payments to KSU are mailed to:

Office of Research and Sponsored Programs

207 Schwartz Center

800 E. Summit Street

Kent, OH 44242-0001

Attn: Office of Technology Commercialization

(c) All reports are e-mailed or mailed to:

[inventions\_otc@kent.edu](mailto:inventions_otc@kent.edu)

**15.** General Provisions.

**15.1** Governing Law**.** This Agreement shall be governed by and interpreted in accordance with the laws of the State of Ohio, except that questions affecting the construction and effect of any patent will be determined by the law of the country in which the patent was granted. Any action, suit or other proceeding arising under or relating to this Agreement shall be brought in a court of competent jurisdiction in the State of Ohio. Licensee waives any objection to the agreed-upon venue required by this provision.

* 1. Sovereign Immunity**.** Nothing in the Agreement shall be deemed or treated as any waiver of KSU’s sovereign immunity.
  2. Severability**.** If any provision of this Agreement is or becomes invalid or is ruled invalid by any court of competent jurisdiction or is deemed unenforceable then: (a) the remainder of the Agreement will remain binding upon the Parties; (b) any ambiguities created by the invalidity or unenforceability of a provision shall be construed to effectuate the original business purpose intent of the Parties to the extent possible; and (c) the Parties hereto shall negotiate in good faith a valid, legal and enforceable substitute provision that most nearly reflects the original business purpose intent of the Parties.

**15.4** Confidentiality.All information exchanged by the parties and all information furnished by KSU to Licensee and by Licensee to KSU shall be regarded by the recipient as confidential. Each party covenants and agrees to take all reasonable care to ensure that all such information, either in written, printed, oral or other form, shall be kept strictly confidential or shall not be disclosed to any third party without prior notice to and written approval of the party originally disclosing the information. This section shall not apply to any information which (a) was independently obtained from a third Party; (b) is shown by documentation to have already been known to the Party receiving the disclosure; (c) is disclosed in a patent or published literature; (d) is or becomes generally available to the industry or public without fault of the recipient; (e) has been disclosed to others without restriction as to its use or disclosure; (f) is shown by documentation to have been developed by personnel of the recipient who had no knowledge of the disclosed information; or (g) is disclosed pursuant to any law or judicial or governmental requirement or order, provided that receiving Party gives disclosing Party sufficient prior notice in order to contest such requirement or order. If a valid Ohio Public Records request is made, Licensee shall be notified prior to the release of any confidential information. This provision shall survive cancellation or termination of this Agreement. Each party shall restrict disclosure of Confidential Information solely to its employees and consultants (collectively, “Representatives”) who have a need to know the same in furtherance of the purposes of this Agreement and who are legally or contractually restricted from disclosing the Confidential Information under terms at least as restrictive as those stated herein; advise such employees and consultants of their obligations under this agreement; and indemnify the disclosing party for any damages arising from any breach of those obligations. Each party shall use such Confidential Information only for the purposes expressly contemplated by this Agreement and not in any manner which might be competitive with the disclosing party’s business operations.

Each party receiving Confidential Information hereunder agrees that its obligations contained herein are necessary and reasonable in order to protect the other party and its business and the receiving party of any Confidential Information expressly agrees that monetary damages would be inadequate to compensate the disclosing party for any breach by the receiving party of its covenants and agreements set forth herein. Accordingly, both parties agree and acknowledge that any such violation or threatened violations will cause irreparable injury to the party disclosing the Confidential Information and that, in addition to any other remedies that may be available, in law, in equity or otherwise, the disclosing party shall be entitled to obtain injunctive relief against the breach, threatened breach of this Agreement or the continuation of any such breach by the receiving party, without the necessity of posting a bond or proving actual damages.

**15.5** Amendment.No amendment or modification of the terms of this Agreement will be binding on either Party unless reduced to writing and signed by an authorized officer of the Parties to be bound.

**15.6** Further Assurances**.** Each party to this Agreement promptly will execute and deliver such further instruments and agreements and do such further acts and things as may be reasonably requested in writing by any other party hereto that may be necessary or desirable in order to effect fully the purposes of this Agreement.

**15.7** Successors, Assigns and Beneficiaries**.** This Agreement shall be binding on the parties hereto and their respective successors and assigns. This Agreement shall inure to the benefit of KSU and Licensee and their respective successors and assigns and all subsequent holders of Indebtedness.

* 1. Waiver**.** Neither Party shall be deemed to have waived any of its rights under this Agreement unless the waiver is in writing and signed by such Party. No delay or omission on the part of a Party in enforcing or exercising any right hereunder shall operate as a waiver thereof. A waiver of any right pursuant to this provisions shall not be deemed a waiver of any other right hereunder.
  2. Counterparts.The Parties may execute this Agreement in multiple counterparts, each of which shall be deemed an original, but all of which taken together shall constitute one and the same instrument. Transmission by facsimile or email of an executed counterpart of this Agreement shall be deemed to constitute due and sufficient delivery of such counterpart.
  3. Entire Agreement**.** This Agreement constitutes the entire agreement between the Parties regarding the subject matter hereof, and supersedes and terminates all prior written or verbal agreements, representations and understandings relative to such matters.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed as of the date and year last written below.

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| --- | --- | --- | --- |
| KENT STATE UNIVERSITY | | *[COMPANY]* | |
| By: |  | By: |  |
| Printed name: |  | Printed name: |  |
| Title: | Vice President for Research | Title: |  |
| Date: |  | Date: |  |

|  |  |
| --- | --- |
| *Reviewed as to legal form and sufficiency for KSU:* | |
| *By:* |  |
| *Title:* | *Associate University Counsel* |
| *Date:* |  |