

**SARS-CoV-2/COVID-19  
NONEXCLUSIVE PATENT LICENSE AGREEMENT**

THIS NONEXCLUSIVE PATENT LICENSE AGREEMENT (this "Agreement") is entered into by and between Lawrence Livermore National Security, LLC, a Delaware limited liability company ("LLNS"), and [Licensee's full legal name], a [jurisdiction and type of entity] ("Licensee") as of the date of execution by the last signing party ("Effective Date").

**BACKGROUND**

- A. LLNS manages, operates and conducts research and development at Lawrence Livermore National Laboratory ("LLNL"), a Federally Funded Research and Development Center, under Contract No. DE-AC52-07NA27344 with the U. S. Department of Energy ("DOE").
- B. LLNS has developed certain inventions ("Inventions") that may be relevant to the SARS-CoV-2/COVID-19 pandemic and global health emergency ("COVID-19").
- C. DOE and LLNS desire that such Inventions be made available for the purpose of researching, developing and utilizing solutions to respond to and mitigate the effects of COVID-19.

**AGREEMENT**

**1. DEFINITIONS**

- 1.1 "Licensed Method" means any process or method the practice of which, but for the license granted in this Agreement, would directly or indirectly infringe, or contribute to or induce the infringement of, any Patent Rights were they issued at the time of the infringing activity.
- 1.2 "Licensed Product" means any device, apparatus, compound, composition of matter, product-by-process, process, method, kit, system, material, algorithm, article of manufacture, or other product the manufacture, use, sale, offer for sale, or import of which, but for the license granted in this Agreement, would directly or indirectly infringe, or contribute to or induce the infringement of, any Patent Rights were they issued at the time of the infringing activity, or would require the performance of the Licensed Method.
- 1.3 "Licensed Service" means the use of any Licensed Product to provide a service.
- 1.4 "Patent Rights" means, to the extent assigned to or otherwise obtained by LLNS, the United States patents, patent applications (and resulting patents), foreign patents and patent applications (and resulting patents) listed in Exhibit A.

**2. GRANT**

- 2.1 LLNS hereby grants Licensee a nonexclusive, worldwide, royalty-free license to make, have made, use, sell, offer to sell, import, and have imported Licensed Products and Licensed Services and to practice the Licensed Method, solely within the field of identifying, diagnosing, controlling, mitigating, modeling, preventing and/or treating of negative health, economic or other outcomes related to the COVID-19.
- 2.2 LLNS does **NOT**: (a) grant any other licenses, implied or otherwise, to any rights of LLNS other than the Patent Rights, regardless of whether other rights are dominant or subordinate to the Patent Rights, or are required to exploit the Patent Rights; (b) grant the right to sublicense;

(c) commit to bring suit against third parties for infringement; or (d) agree to furnish any technology or technological information other than found in the Patent Rights or to provide any technology assistance. All rights not expressly granted to Licensee herein with respect to the Patent Rights are expressly reserved to LLNS.

- 2.3 Licensee acknowledges and agrees that the Inventions are the result of research performed at a national laboratory, that additional development will be required for commercialization of Licensed Products and Licensed Services, and that Licensee is solely responsible for any such additional development.

### **3. DILIGENCE; REPORTS**

- 3.1 Licensee will proceed diligently with research, development, manufacture, and sale or other distribution of Licensed Products and Licensed Services for the purpose stated in Section 2.1.
- 3.2 Licensee will provide to LLNS a progress report on technology development and commercialization efforts six (6) months after the Effective Date, and every six (6) months thereafter during the term of this Agreement. The report will include a statement reporting all conveyances by Licensee of Licensed Products or Licensed Services during the preceding semiannual period.

### **4. TERM AND TERMINATION**

- 4.1 This Agreement will be in effect for twelve (12) months from the Effective Date, unless (a) sooner terminated by operation of law or by either of the parties in accordance with the terms hereof, or (b) extended by mutual agreement of the parties.
- 4.2 As a condition to agreeing to an extension of the term of this Agreement beyond the initial term specified in Section 4.1, LLNS may require the addition of royalties, fees, expense reimbursement, performance obligations, and other commercial terms to be negotiated by the parties, each acting in their sole discretion.
- 4.3 LLNS may terminate this Agreement (a) upon thirty (30) days' written notice if Licensee breaches any material term or covenant of this Agreement, unless such breach is cured within such thirty (30) day period; or (b) immediately upon written notice if Licensee, directly or indirectly, commences any legal action to challenge the validity of any of the Patent Rights, to the extent that termination is not prohibited by applicable laws. Licensee may terminate this Agreement at any time upon written notice to LLNS.
- 4.4 Upon expiration or termination of this Agreement for any reason, Licensee will immediately cease all use of the Patent Rights, and all rights granted to Licensee under this Agreement shall immediately terminate and revert to LLNS except for those provisions expressly stated in Section 4.5 below to survive.
- 4.5 When this Agreement expires or is terminated for any reason, Sections 1, 4, 5, 6, 7, 9, 10, 11 and 13 will survive such expiration or termination.

### **5. USE OF NAMES, TRADENAMES AND TRADEMARKS**

Licensee will not use in advertising, publicity, press releases, products, services or other promotional activities any name, tradename, trademark, service mark, logo or other designation of DOE, the National Nuclear Security Administration, LLNS, or LLNL (including any contraction, abbreviation, or simulation

of any of the foregoing) without LLNS's prior written approval, except for statements and phrases that simply reference the fact that the Inventions were developed at LLNL or are licensed from LLNS.

## **6. REPRESENTATIONS; LIMITATION OF WARRANTIES**

- 6.1 Licensee represents that it has the lawful right to enter into and perform this Agreement.
- 6.2 THE PATENT RIGHTS ARE LICENSED TO LICENSEE "AS IS" WITH ALL FAULTS, DEFECTS AND ERRORS. NEITHER LLNS NOR THE U.S. GOVERNMENT MAKES ANY WARRANTY, EXPRESS, IMPLIED, STATUTORY OR OTHERWISE, IN CONNECTION WITH THIS AGREEMENT, THE INVENTIONS, THE LICENSE GRANTED HEREIN, OR THE PATENT RIGHTS, AND THEY EXPRESSLY DISCLAIM THE IMPLIED WARRANTIES OF MERCHANTABILITY, FITNESS FOR A PARTICULAR PURPOSE, TITLE, AND NON-INFRINGEMENT OF ANY U.S. OR FOREIGN PROPRIETARY RIGHTS.
- 6.3 THE LICENSE GRANTED HEREBY IS INTENDED SOLELY TO ASSIST WITH THE PUBLIC HEALTH AND RESPONSE TO COVID-19. LICENSEE'S ACCEPTANCE OF THE LICENSE AND ITS USE, MANUFACTURE AND SALE OF LICENSED PRODUCTS OR LICENSED SERVICES OR PRACTICE OF THE LICENSED METHOD ARE AT LICENSEE'S SOLE RISK AND EXPENSE. NEITHER LLNS NOR THE U.S. GOVERNMENT WILL HAVE ANY LIABILITY FOR THE PAYMENT OF ANY DAMAGES OF ANY KIND (INCLUDING CLAIMS ARISING OUT OF OR RELATED TO PRODUCT LIABILITY, NEGLIGENCE, FAILURE TO WARN, WARRANTY, USE OR INABILITY TO USE, REGARDLESS OF THE LEGAL THEORY ON WHICH ANY SUCH DAMAGES OR LIABILITY MAY BE BASED AND WHETHER OR NOT THEY HAVE BEEN ADVISED OF THE POSSIBILITY OF ANY SUCH DAMAGES OR LIABILITY) FOR ANY LICENSED PRODUCTS OR LICENSED SERVICES USED, MANUFACTURED OR SOLD BY LICENSEE OR ANY THIRD PARTY OR FOR ANY PRACTICE OF THE LICENSED METHOD.

## **7. PREP ACT; INDEMNIFICATION; INSURANCE**

- 7.1 Licensee will take all reasonable steps to ensure that all Licensed Products and Licensed Services sold or otherwise distributed or provided by Licensee will meet the requirements for liability immunity under the Public Readiness and Emergency Preparedness Act, 42 U.S.C. 247d-6d, et seq, and the declaration thereunder concerning COVID-19 issued by the Secretary of Health and Human Services on February 4, 2020.
- 7.2 Licensee will indemnify, hold harmless, and defend LLNS and the U.S. Government, and their respective officers, employees and agents, from and against any and all claims, suits, losses, damages, costs, attorney and other fees, and expenses resulting from, or arising out of, the performance of this Agreement or the exercise of the license granted herein. This indemnification will include, but will not be limited to, any product liability in any way arising from or related to the Patent Rights, and any claim that any Licensed Products or Licensed Services infringe upon the intellectual property rights of a third party.
- 7.3 Licensee, at its sole cost and expense, will obtain and maintain adequate insurance coverage appropriate for its activities under this Agreement, which insurance will name LLNS and the U.S. Government, and their respective members, officers, employees and agents as additional insureds. Licensee will provide evidence of such insurance coverage to LLNS upon request.

**8. ASSIGNMENT AND CHANGE OF CONTROL**

This Agreement is binding upon and will inure to the benefit of LLNS, its successors and assignees, but is personal to Licensee. Licensee may not assign any of its rights under this Agreement to any third party, including affiliates, or through a change of control of Licensee without LLNS’s prior written consent, which may be granted or withheld in LLNS’s sole discretion. A change of control means any transaction or series of related transactions (including without limitation, mergers, stock acquisitions, reorganizations and consolidations) in which the direct or indirect holders of a controlling interest in Licensee immediately before the transaction(s) cease to hold, directly or indirectly, a controlling interest in Licensee immediately after the transaction(s). Any purported assignment or change of control in violation of this paragraph is void.

**9. NOTICES**

Any notices required to be given under this Agreement must be in writing and will be deemed to have been properly given and to be effective upon actual receipt by the recipient when personally delivered or sent via first class mail, overnight courier or email. Notices will be sent to the parties at the addresses below, or to other addresses designated in writing by the parties:

If to Licensee:

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

Attention:

Email:

If to LLNS (all correspondence and reports):

Lawrence Livermore National Laboratory  
Innovation and Partnerships Office  
P.O. Box 808, L-795  
7000 East Avenue, L-795  
Livermore, CA 94550  
Attention: Director, Innovation and Partnerships Office  
Email: ipo-royalties@llnl.gov

**10. COMPLIANCE WITH LAWS**

Licensee will comply with all applicable: (a) U.S. and foreign laws and regulations with respect to the registration, manufacture, marketing or other distribution of drugs or medical devices; (b) U.S. and foreign laws with respect to the transfer of Licensed Products and related technical data and the provision of Licensed Services to foreign countries, including, without limitation, the International Traffic in Arms Regulations (ITAR), the Export Administration Regulations (EAR), and any sanctions and/or anti-boycott rules or regulations; and (c) international, national, state, regional, and local laws and regulations in performing its obligations hereunder and in its use, manufacture, sale, or import of any Licensed Product or Licensed Services.

**11. DISPUTE RESOLUTION; GOVERNING LAW AND VENUE**

- 11.1 Except where LLNS is entitled under this Agreement to seek immediate legal or equitable relief, LLNS and Licensee will utilize good faith efforts to promptly resolve any disputes arising from this Agreement, using the assistance of the LLNS Technology Partnership Ombudsman if they deem appropriate. In the event the parties fail to resolve a dispute within a reasonable period of time, then either party may commence proceedings in the courts specified below.
- 11.2 This Agreement will be governed by the laws of the State of California, excluding its choice of law rules. Any legal action related to this Agreement will be conducted in the state courts sitting in Alameda County, California, or in the federal courts sitting in the Northern District of California.

**12. PATENT MARKING**

Licensee will mark, in accordance with the applicable patent marking statute, all Licensed Products, and their containers, which are made, used, sold or otherwise transferred to a third party, under the terms of this Agreement.

**13. MISCELLANEOUS**

13.1 No amendment or modification of this Agreement will be binding on the parties unless made in a writing executed by duly authorized representatives of the parties. No waiver by either party of any breach or default of any of the covenants or terms of this Agreement will be deemed a waiver as to any prior, subsequent or similar breach or default.

13.2 This Agreement, with the attached exhibit, contains all of the terms and conditions agreed upon by the parties relating to the subject matter of this Agreement and supersedes all prior agreements, negotiations, correspondence, undertakings and communications of the parties, whether oral or written, respecting that subject matter.

13.3 If any provision of this Agreement is determined by a court of competent jurisdiction to be invalid, illegal, or unenforceable in any respect, the invalidity, illegality, or unenforceability will not affect any other provisions hereof, and this Agreement will be construed as if such invalid or illegal or unenforceable provisions had never been part of this Agreement.

13.4 The relationship between the parties is that of independent contractors and nothing in this Agreement is intended to or will establish any partnership, joint venture, employment, franchise, agency or other form of relationship between the parties. Neither party will have, or represent to any third party that it has, any power or authority to bind the other party or incur any obligations on the other party's behalf.

13.5 This Agreement may be executed in counterparts, including by facsimile or email attachment.

IN WITNESS WHEREOF, LLNS and Licensee have executed this Agreement by their respective authorized representatives on the dates set forth below.

**[LICENSEE'S FULL LEGAL NAME]**

**LAWRENCE LIVERMORE NATIONAL SECURITY, LLC**

By: \_\_\_\_\_  
(Signature)

By: \_\_\_\_\_  
(Signature)

Name: \_\_\_\_\_

Name: Richard A. Rankin

Title: \_\_\_\_\_

Title: Director, Innovation and Partnerships

Date signed: \_\_\_\_\_

Date signed: \_\_\_\_\_

**EXHIBIT A – PATENT RIGHTS****United States Patents:**

Invention Disclosure Number	Patent Number	Title	Issue Date

**United States Patent Applications:**

Invention Disclosure Number	Patent Application Number	Title	Filing Date

**Provisional Patent Applications:**

Invention Disclosure Number	Provisional Patent Application No.	Title	Filing Date

**Foreign Patents:**

Invention Disclosure Number	Foreign Patent Number	Title	Issue Date

**Foreign Patent Applications:**

Invention Disclosure Number	International Serial Number	Title	Filing Date