

# DCU LICENCE EXPRESS

## NON-EXCLUSIVE PATENT LICENCE

**THIS LICENCE**, dated ..... (the “**Effective Date**”) is between Dublin City University, Glasnevin, Dublin 9 (the “**Licensor**”) and the party listed in the Schedule (the “**Licensee**”).

### BACKGROUND

The Licensee has provided a business plan to commercialise the patent or patent application which is the subject of this licence (the “**Business Plan**”). The Licensor has agreed to grant, and the Licensee has agreed to take, a licence of certain patent rights on the terms set out in this licence.

### AGREED TERMS

1. Subject to the acceptance of the Business Plan by the Licensor, the Licensor hereby grants to the Licensee a non-exclusive licence to use and exploit the patent or the patent application (as the case may be) set out and described in the Schedule (the “**Patent**”) which constitutes the only intellectual property which is covered by this Licence. The use generally and the use and exploitation of the Patent in any products (the “**Licensed Products**”) shall be limited to the territory or territories listed in the Schedule (the “**Territory**”) and no rights are granted for any other territories.
2. The Licensee agrees not to grant any rights whatsoever in the Patent or the Licensed Products (including by way of sub-licence) to any third party without the prior written consent of the Licensor. Where the Licensee wishes to sub-licence their rights under this Licence, the Licensor will, at its discretion, negotiate in good faith with the Licensee to try and achieve this.
3. The Licensee will promptly provide the Licensor with copies of all communications, relating to the Patent with any regulatory authority. The Licensee will immediately notify the Licensor in writing, giving full particulars, if it believes that any third party is about to take a legal action in relation to the validity or use of the Patent or the Licensed Products.
4. The Licensee may not seek to register the Patent anywhere outside the Territory without the prior written consent of the Licensor.
5. In respect of any legal or administrative challenge of any nature whatsoever relating to the Patent, the Licensor shall, in its absolute discretion, decide what action, if any, to take. The Licensor shall have exclusive control over, and conduct of, all claims and proceedings but may require that Licensee bear the cost of any proceedings. Where there is more than one Licensee, these costs will be equally divided.
6. The Licensee will mark all Licensed Products with the relevant patent number of the Patent and with a clear and prominent statement in a form approved by the Licensor that the Licensed Products are manufactured or supplied by the Licensee under licence from the Licensor.
7. The Licensee agrees to, at its own cost, promptly record the licence granted to it in the Irish Patents Office in accordance with section 85(1) of the Patents Act 1992 or equivalent legislation in any jurisdiction. The Licensor will provide reasonable assistance, at the Licensee's cost, to enable the Licensee to comply with this clause.
8. The Licensee will be responsible for the direct payment of all and any fees of any nature, necessary to make or maintain the valid registration of the Patent (the “**Maintenance Costs**”) at least 3 calendar months in advance of the date that any fee is due. A failure to pay any fee due under this section shall entitle the Licensor to terminate this agreement on one week's notice. The Licensor will be under no obligation to maintain the Patent (or an application for same) for the term of the Licence. Where there is more than one Licensee, the cost of paying the Maintenance Costs will be split equally between the Licensees.
9. There will be no royalty payable for the first four (4) years of this Licence which starts on the Effective Date (the “**Initial Period**”).
10. After the Initial Period, the Licensee shall pay to the Licensor a yearly royalty of 1% (the “**Royalties**”) of the Net Sales Price of each Licensed Product:
  - (a) sold or licenced by the Licensee;
  - (b) lent, leased, let on hire or sold on hire purchase by the Licensee;
  - (c) supplied by the Licensee to any person otherwise than in clause 10(a) or clause 10(b); or
  - (d) put into use by the Licensee,provided always that, in respect of any Licensed Product manufactured, used or supplied, only a single royalty shall be payable, and the royalty accrues on the date when the Licensed Product is used or supplied, the date it is supplied being the earliest of when it is invoiced, paid for, installed or delivered. For the purposes of this Licence, “**Net Sale Price**” means actual invoiced prices in an arm's length transaction, less, to the extent identified on the invoice, any costs of packing, insurance, transport, delivery, VAT and any other government taxes, duties or levies, and trade discounts and other allowances granted.
11. Where a Licensee intends to use the Patent for internal use only, the parties will agree on an appropriate annual fee or upfront payment which will be payable by the Licensee to the Licensor after the initial period, in place of the Royalty. This fee will be set out in the Schedule.
12. Royalties shall be payable under this Licence even if some part of the sale, supply or putting into use of the Licensed Products by the Licensee takes place in a territory where there is no Patent or where the Licensed Product does not fall within the scope of any Patent. In such cases, the Licensee will be responsible for the payment of any relevant withholding taxes.
13. Where the Licensee makes any legal challenge of any nature whatsoever against the Licensor in relation to the validity or enforceability of the Patent or the Licensed Products in any jurisdiction whatsoever, the value of any Royalties payable under this Agreement to the Licensor shall be multiplied by 2 (two) for remaining term of the Licence. If such a challenge is successful, the

Licensee must pay the Licensor 3 (three) times the amount of the total Royalties paid up to that point under this Licence. Where no Royalties are being paid, the Licensee shall make the above payments based on the level of the royalties projected by the Licensee in their Business Plan.

14. Where the Patent is found to be invalid or to breach the intellectual property rights of any third party, no Royalties shall be repayable to the Licensor to the Licensee subject always to clause 13.
15. Nothing in this Licence shall prevent the Licensor from using the Patent (and anything deriving from the Patent) for educational, research or academic purposes.
16. At the end of each year in the Initial Period of the Licence, the Licensee shall provide the Licensor with a written report setting out the ways in which it is using the Patent or the Licenced Products and outlining the impact that they are having. After the Initial Term, the Licensee shall provide such written reports within 90 days of a written request of the Licensor.
17. The Licensee shall ensure that the Licensed Products are safe for the use for which they were intended and obtain at its own expense all licences, permits and consents necessary for the provision of the Licensed Products.
18. Nothing in this agreement shall constitute any representation or warranty that the Patent is valid or relevant to the Licensed Products; that the Patent (if a patent application) shall proceed to grant or, if granted, shall be valid or that the exercise by the Licensee of rights granted under this agreement will not infringe the rights of any person. Any terms implied by sections 12, 13, 14 or 15 of the Sale of Goods Act 1893 (as amended) or otherwise are, to the fullest extent permitted by law, excluded and the Licensee hereby agrees to waive any rights under those sections.
19. To the fullest extent permitted by law, the Licensor shall not be liable to the Licensee for any costs, expenses, loss or damage (whether direct, indirect or consequential and whether economic or other) arising from the Licensee's exercise of the rights licensed to it under this agreement.
20. The Licensor makes no warranties regarding the technologies described or claims made in the Patents and expressly disclaims any warranties, express or implied arising at common law under statute or otherwise, regarding such technologies and any liability for damage or loss howsoever caused by such technologies or Patents. The Licensor shall not be liable for any loss caused to the Licensee by the exploitation of such technologies or Patents howsoever caused and howsoever arising. It is the responsibility of the Licensee to carry out their own investigations as to the suitability and efficacy of the Patents.
21. The Licensee shall indemnify the Licensor against all liabilities, costs, expenses, damages or losses (including any direct or indirect consequential losses, loss of profit, loss of reputation and all interest, penalties and legal and other professional costs and expenses) suffered or incurred by the Licensor arising out of or in connection with the Licensee's exercise of its rights licensed under this agreement or any breach by the Licensee of the terms of this agreement, including any product liability claim relating to Licensed Products manufactured, supplied or put into use by the Licensee which use the Patent.
22. The Licensee will defend and indemnify the Licensor against all losses, liabilities, lawsuits, claims, expenses (including reasonable legal fees), costs, and judgments arising out of any third party allegation of personal injury or property damages arising from the design, manufacture, use, licensing or sale by the Licensee of products which utilise or incorporate the Patent or the technologies described in the Patent.
23. The indemnity above shall apply whether or not the Licensor has been negligent or at fault. Nothing in this Licence shall have the effect of excluding or limiting any liability for death or personal injury caused by negligence or for fraud. In no case shall the Licensor's total liability under this agreement exceed the value of the Royalties which have been paid in the previous year.
24. The Licensee shall not, nor directly or indirectly assist any other person to do or omit to do anything to diminish the rights of the Licensor in the Patent or impair any registration of the Patent.
25. The Licensee acknowledges and agrees that the exercise of the Licence granted to the Licensee under this Licence is subject to all applicable laws, enactments, regulations and other similar instruments and the Licensee understands and agrees that it shall at all times be solely liable and responsible for such due observance and performance.
26. The Licensee shall not without the prior written consent of the Licensor assign, transfer, novate, sub-license, mortgage, charge or deal in any other manner with any of its rights or obligations under this Licence.
27. The Licensor may at any time and without the consent of the Licensee assign, transfer, novate, sub-license, mortgage, charge or deal in any other manner with any or all of its rights or obligations under this Licence.
28. The Licensee shall on request from the Licensor execute any agreements or other instruments (including any supplement or amendment to this agreement) which may be required in order to give effect to or perfect any assignment, transfer, mortgage, charge or other dealing referred to above.
29. This Licence shall come into force on the Effective Date and shall remain in force until the expiry of the Patent (or where there is no possibility of any applications in the Patent proceeding to grant). Notwithstanding the above, the Licensor shall have the right to terminate this Licence on giving the Licensee not less than 4 months' written notice of termination where the Licensee is not utilising the Patent in the manner proposed in the Business Plan. The Licence may also be terminated where the Licensee breaches a term of the Licence and does not remedy such breach within 30 days.
30. This Licence and any dispute or claim arising out of or in connection with it or its subject matter or formation (including non-contractual disputes or claims) shall be governed by and construed in accordance with the laws of Ireland. The parties may attempt to resolve any dispute or claim arising out of this Licence by arbitration. In the event that the parties agree resolve a dispute by arbitration, the UNCITRAL Rules shall apply and the place of arbitration shall be Dublin, Ireland.

**Schedule**

**The Patent/Patent Application**

**The Licensee:**.....

**Address:** .....

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**Primary Contact Point:**.....

<b>Publication No.</b>	<b>Application No.</b>	<b>Date Filed</b>	<b>Date Granted</b>	<b>Title</b>

Territories (as per clause 1 of the Licence)	
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**Where the Patent/Patent Application is for internal use only:**

Annual fee payable in accordance with clause 11 of the Licence	
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**or**

Upfront Payment payable in accordance with clause 11 of the Licence	
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