

LICENSE AGREEMENT

Between
UNIVERSITY OF FLORIDA RESEARCH FOUNDATION

And

This Agreement is made effective the ____ day of _____, 2____, (the “Effective Date”) by and between the University of Florida Research Foundation, Inc. (hereinafter called “UFRF”), a nonstock, nonprofit Florida corporation, and _____ (hereinafter called “Licensee”), a corporation organized and existing under the laws of _____;

WITNESSETH:

WHEREAS, the Florida Department of Transportation (hereinafter referred to as “FDOT”), an agency of the State of Florida that conducts highway and transportation research; and

WHEREAS, University of Florida has an agreement with the Texas A&M University System (TAMUS) that gives UFRF the right to sublicense TAMUS’ “Low Profile Concrete Road Barrier;” and “Safety End Barrier for Concrete Road Barriers” and

WHEREAS UFRF Research has led to new designs for highway and traffic safety, including technology described as a “Portable Roadway Barriers” and

WHEREAS, FDOT and UFRF desire that the technology be made available for the public benefit; and

WHEREAS, LICENSEE has represented that it desires to obtain a license to University of Florida and Texas A&M University System technology described in the referenced U.S. Patents in order to construct road barriers or otherwise make available such technology to the citizens of the United States.

NOW, THEREFORE, in consideration of the mutual covenants and premises contained herein, the sufficiency of which is hereby acknowledged, the parties hereto agree as follows:

ARTICLE I - DEFINITIONS

1.01.1 PATENT RIGHTS” shall mean:

University of Florida, United States Patent Application No. 10/341,144 “Portable Roadway Barriers” dated 1/13/2003; **and**

Texas A&M University System, United States Patent No. 5, 156,485, issued October 20, 1992, entitled “Low Profile Concrete Road Barrier;” and U.S. Patent No. 5,295,757, issued March 22, 1994, entitled, “Safety End Barrier for Concrete Road Barriers;” and any reissue, extension or revival thereof..

1.02 "LICENSED PRODUCT” shall mean any product which is within, in whole or in part, the scope of a valid claim of PATENT RIGHTS.

1.03 “EFFECTIVE DATE” shall mean the date this Agreement is executed by both parties hereto.

ARTICLE II - GRANT

2.01 Grant. Subject to the limitations enumerated in paragraph 2.02, UFRF hereby grants to LICENSEE a nonexclusive license and right under the PATENT RIGHTS to make, have made, use, and sell LICENSED PRODUCT to the end of the term of this Agreement as prescribed in paragraph 4.01. It is understood that LICENSEE shall have the full right to lease, sell or otherwise transfer the LICENSED PRODUCT to any third party with no additional requirements for payment to UFRF other than the Royalty set forth in paragraph 3.01 below.

2.02 No Sublicensing Privileges. LICENSEE may not grant sublicenses to PATENT RIGHTS to other parties under the grant made hereinabove by UFRF. Notwithstanding, it is understood that LICENSEE may contract with a contract manufacturer under the “have made” provisions of the grant in paragraph 2.01, to manufacture LICENSED PRODUCT for the sole benefit of LICENSEE under the auspices of a purchase order or similar contracting instrument.

ARTICLE III - CONSIDERATION AND PAYMENTS

3.01 Consideration. In consideration for the license grant made by UFRF in paragraph 2.01, LICENSEE shall pay to UFRF:

(a) A License Fee in the amount of One Thousand Dollars (\$1,000), such fee to be paid to UFRF no later than Ten (10) Days following the EFFECTIVE DATE.

(b) A Royalty of an amount equal to Two Dollars (\$2.00) per linear foot of LICENSED PRODUCT made or manufactured by LICENSEE, or by a contract manufacturer of LICENSEE for LICENSEE’s use or benefit under the provisions of paragraph 2.02.

- 3.02 When Royalty payments are due. Payments of the Royalty stipulated in paragraph 3.01(b) shall be made to UFRF shall be paid in quarterly installments on March 31, June 30, September 30, and December 31 for the quarter ending on each of those dates.
- 3.03 A certified full accounting statement showing how any amounts payable to UFRF under Section 3.02 have been calculated shall be submitted to UFRF on the date of each such payment. Such accounting shall be on a per-country and product line, model or trade name basis and shall be summarized on the form shown in the Appendix of this Agreement. In the event no payment is owed to UFRF, a statement demonstrating that fact shall be supplied to UFRF.
- 3.04 Inspection of books and records. At its own expense, UFRF may annually inspect LICENSEE's books and records as needed to determine consideration payable to UFRF hereunder. LICENSEE shall maintain such books and records for at least three (3) years following the dates of the underlying transactions. Any such inspections shall be in confidence and conducted during ordinary business hours, and UFRF will provide LICENSEE prior notice of two (2) weeks before making such inspections. UFRF may employ a Certified Public Accountant for this purpose.
- 3.05 Interest charges. Overdue payments shall bear interest until payment at a rate of one and one-half percent per month, or the highest amount allowed by applicable law, whichever is lower. The payment of such interest shall not foreclose UFRF from exercising any other rights it may have as a consequence of the lateness of any payment.

ARTICLE IV - EXPIRATION AND TERMINATION

- 4.01 Expiration. This Agreement, unless sooner terminated as provided herein, shall remain in effect for a period of Five (5) Years following the EFFECTIVE DATE. The Agreement may be renewed upon the mutual consent of both parties.
- 4.02 Termination by Licensee. LICENSEE may terminate this Agreement by providing written notice to UFRF at least thirty (30) days before the termination is to take effect.
- 4.03 Termination by UFRF. If LICENSEE at anytime defaults in the timely payment of any monies due UFRF or materially breaches this Agreement, UFRF shall give LICENSEE written notice of the breach. LICENSEE shall have a period of thirty (30) days from receipt of the notice to cure the breach. If LICENSEE does not cure the breach within this period, UFRF may terminate this Agreement by giving written notice of its election to do so.
- 4.04 Licensee's financial condition. If LICENSEE: (a) ceases to carry on its business, (b) becomes "insolvent" (as such term is defined in the United States Bankruptcy Code), (c) fails to pay its debts in the ordinary course of business under conditions indicating insolvency, or (d) voluntarily seeks, consents to or acquiesces in the benefits of any bankruptcy or similar debtor-relief laws, then UFRF may terminate this Agreement without prejudice to any other remedy to which UFRF may be entitled at law or in equity

or elsewhere under this Agreement, by giving written notice of termination to LICENSEE.

- 4.05 Return of rights. Should this Agreement be terminated under paragraphs 4.02, 4.03, or 4.04 above, any and all rights, licenses and claims hereunder shall be returned by LICENSEE to UFRF.
- 4.06 Matters Surviving Expiration or Termination. All accrued obligations and claims, including obligations for payment of Royalties and claims or causes of action for breach of this Agreement, shall survive termination of this Agreement.

ARTICLE V - INDEMNIFICATION AND LIABILITY

- 5.01 Licensee shall, at all times during the term of this Agreement and thereafter, indemnify, defend and hold UFRF, the Florida Board of Governors, the University of Florida Board of Trustees, the University of Florida, and each of their directors, officers, employees, and agents, and the inventors of the Licensed Patents, regardless of whether such inventors are employed by the University of Florida at the time of the claim, harmless against all claims and expenses, including legal expenses and reasonable attorneys fees, whether arising from a third party claim or resulting from UFRF's enforcing this indemnification clause against Licensee, arising out of the death of or injury to any person or persons or out of any damage to property and against any other claim, proceeding, demand, expense and liability of any kind whatsoever (other than patent infringement claims) resulting from the production, manufacture, sale, use, lease, consumption, marketing, or advertisement of Licensed Products or Licensed Process(es) or arising from any right or obligation of Licensee hereunder. Notwithstanding the above, UFRF at all times reserves the right to retain counsel of its own to defend UFRF's, the Florida Board of Governors', the University of Florida Board of Trustees', the University of Florida's, and the inventor's interests.
- 5.02 Licensee warrants that it now maintains and will continue to maintain liability insurance coverage appropriate to the risk involved in producing, manufacturing, selling, marketing, using, leasing, consuming, or advertising the products subject to this Agreement and that such insurance coverage lists UFRF, the Florida Board of Governors, the University of Florida Board of Trustees, the University of Florida, the Texas A&M University System and its Regents, and the inventors of the Licensed Patents as additional insureds. Within thirty (30) days after the execution of this Agreement and thereafter annually between January 1 and January 31 of each year, Licensee will present evidence to UFRF that the coverage is being maintained with UFRF, the University of Florida, and its inventors listed as additional insureds. In addition, Licensee shall provide UFRF with at least thirty (30) days prior written notice of any change in or cancellation of the insurance coverage.
- 5.03 Licensee shall at all times during the term of this Agreement and thereafter indemnify, defend, and hold harmless the Texas A&M University System, its Regents, officers, employees, inventors in System patent rights, and affiliates against any claim proceeding,

demand, liability or expense (including legal expenses and reasonable attorney's fees) which relates to any action brought by a third party alleging infringement of a United States Patent or patent issued by a country other than the United States as a result of the activities of UFRF or Licensee under this Agreement.

- 5.04 Licensee shall at all times during the term of this Agreement and thereafter indemnify, defend and hold harmless the Texas A&M University System, its Regents, officers, employees, inventors in System patent rights, and affiliates, against any claim, proceeding, demand, liability, or expense (including legal expenses and reasonable attorney's fees) which relates to injury to persons or to property, or against any other claim, proceeding, demand, expense and liability of any kind whatsoever resulting from the production, manufacture, sale, use, lease or consumption or advertisement of Licensed Products or arising from any obligation of UFRF or Licensee under this Agreement.
- 5.05 UFRF warrants that it is the owner of the Licensed Patents or otherwise has the right to grant the licenses granted to Licensee in this Agreement. However, nothing in this Agreement shall be construed as:
- 5.05.1 a warranty or representation by UFRF as to the validity or scope of any right included in the Licensed Patents;
 - 5.05.2 a warranty or representation that anything made, used, sold or otherwise disposed of under the license granted in this Agreement will or will not infringe patents of third parties;
 - 5.05.3 an obligation to bring or prosecute actions or suits against third parties for infringement of Licensed Patents;
 - 5.05.4 an obligation to furnish any know-how not provided in Licensed Patents or any services other than those specified in this Agreement; or
 - 5.05.5 a warranty or representation by UFRF that it will not grant licenses to others to make, use or sell products not covered by the claims of the Licensed Patents which may be similar and/or compete with products made or sold by Licensee.
- 5.06 EXCEPT AS OTHERWISE EXPRESSLY SET FORTH IN THIS AGREEMENT, UFRF AND TAMUS 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, AND VALIDITY OF PATENT RIGHTS CLAIMS, ISSUED OR PENDING. UFRF AND TAMUS ASSUME NO RESPONSIBILITIES WHATSOEVER WITH RESPECT TO USE, SALE, OR OTHER DISPOSITION BY LICENSEE, OR THEIR VENDEES OR OTHER TRANSFEREES OF PRODUCT INCORPORATING OR MADE BY USE OF INVENTIONS LICENSED UNDER THIS AGREEMENT.

ARTICLE VI - NOTICES

6.01 Notices. Payments, notices, reports or other communications required by this Agreement shall be sufficiently made or given if mailed by certified First Class United States mail, postage pre-paid, addressed to the address stated below, or to the last address specified in writing by the intended recipient.

(a) If to UFRF: Office of Technology Licensing
University of Florida Research Foundation
PO Box 115500
Gainesville, Florida 32611-5500
Attention: Director

(b) If to LICENSEE:

ARTICLE VII - MISCELLANEOUS PROVISIONS

7.01 Non-Use of Names. LICENSEE shall not use the name of The University of Florida, UFRF, The Texas A&M University System (TAMUS), nor of any of their employees or components, nor any adaptation thereof, in any advertising, promotional or sales literature without the prior written consent obtained from UFRF and TAMUS in each case, with the exception that LICENSEE may state that it is licensed by UFRF and TAMUS as to PATENT RIGHTS.

7.02 Product Marking. LICENSEE shall mark all LICENSED PRODUCTS with the following notation: "Patented Product: US Patent Nos. 5,156,485; 5,295,757 and Patent Pending". The method of marking LICENSED PRODUCT shall be at the discretion of LICENSEE, as long as such marking is permanently affixed or imprinted upon LICENSED PRODUCTS.

7.03 Assignment of this Agreement. This Agreement, with the rights and privileges it creates, is assignable only with the written consent of both parties.

7.04 Execution and modification. This Agreement will become binding only when signed by both parties. It may be modified or amended only by a writing signed by the parties.

7.05 Entire Agreement. This Agreement contains the entire understanding of the parties with respect to the PATENT RIGHTS and supersedes all other written and oral agreements between the parties with respect to the PATENT RIGHTS.

- 7.06 Governing Law. This Agreement shall be construed under the laws of Florida.
- 7.07 Headings. Headings appear solely for convenience of reference. Such headings are not part of this Agreement and shall not be used to construe it.
- 7.08 Provisions. If any provision or provisions of this Agreement shall be held to be invalid, illegal, or unenforceable, the validity, legality and enforceability of the remaining provisions shall not in any way be affected or impaired thereby.

IN WITNESS WHEREOF, the parties have caused this Agreement to become effective as of the date last executed below by a signatory to this Agreement.

UNIVERSITY OF FLORIDA RESEARCH FOUNDATION, INC.

_____ Date: _____, 2004
David L. Day
Director, Office of Technology Transfer

LICENSEE

By: _____ Date: _____, 2004

Name and Office: _____

UFRF Royalty Report

Licensee: _____ Agreement No.: _____

Inventor: _____ P#: P _____

Period Covered: From: / / Through: / /

Prepared By _____ Date: _____

Approved By: _____ Date: _____

If license covers several major product lines, please prepare a separate report for each line. Then combine all product lines into a summary report.

Report Type: **Single Product Line Report:** _____

Multiproduct Summary Report. Page 1 of _____ Pages

Product Line Detail. Line: _____ Tradename: _____ Page: _____

Report Currency: **U. S. Dollars** **Other** _____

Country	Gross	* Less:	Net	Royalty	Period Royalty Amount	
	Sales	Allowances	Sales	Rate	This Year	Last Year
U.S.A.						
Canada						
Europe:						
Japan						
Other:						

TOTAL:

Total Royalty: _____ Conversion Rate: _____ Royalty in U.S. Dollars: \$ _____

The following royalty forecast is non-binding and for UFRF's internal planning purposes only:

Royalty Forecast Under This Agreement: Next Quarter: _____ Q2: _____ Q3: _____ Q4: _____

* On a separate page, please indicate the reasons for returns or other adjustments if significant. Also note any unusual occurrences that affected royalty amounts during this period. To assist UFRF's forecasting, please comment on any significant expected trends in sales volume.