

Licensing Agreement Template

National University of Sciences and Technology

And

Agreement No: 01

Date of Signature: _____, 20xx

THIS LICENSING AGREEMENT (hereinafter referred to as the “**Agreement**”) is made by and between National University of Sciences and Technology, a national university established under the National University of Science and Technology Act, 1997 (Act No. XX of 1997) having its registered office at CIE, RIC Secretariat, NUST Main Campus, Islamabad, Pakistan (hereinafter referred to as “**Licensor** “),

And

_____ with principal offices at
_____ (hereinafter referred to as
“**Licensee**”).

WITNESSETH:

WHEREAS, Licensor is the owner of all right, title, and interest in Patent Nos.

_____ (which patents are hereinafter collectively referred to as the “**Licensed Patents**”);

WHEREAS, Licensee is in the business of making and selling_____, and desires to obtain a_____license to make, use, and sell products and to practice the inventions covered by the Licensed Patents;

WHEREAS, Licensor and Licensee desire to enter into a license agreement covering the Licensed Patents; and

WHEREAS, Licensor has the right to grant a license to Licensee under the Licensed Patents and is willing to do so on the terms and conditions recited in this Agreement.

NOW, THEREFORE, in consideration of the preceding and the mutual covenants recited below, and for other good and valuable consideration, receipt and sufficiency of which is hereby acknowledged, the parties agree as follows:

1. DEFINITIONS

1.1 Licensed Patents. “Licensed Patents” as used in this Agreement shall mean the_____, collectively, and any patent issued in the future from any reissue, reexamination, divisional, continuation, and/or continuation-in-part of the Licensed Patents, including any foreign counterpart thereof.

1.2 Territory. “Territory” as used in this Agreement shall mean Pakistan and its territories and possessions.

1.3 Effective Date. “Effective Date” shall mean___,

1.4 Term. “Term” as used in this Agreement shall mean the period beginning on the Effective Date and ending with the expiration of the last to expire of the Licensed Patents or the termination of this Agreement, whichever occurs first. This Agreement shall, if not terminated sooner, terminate at the end of the Term.

- 1.5 Licensed Product.** “Licensed Product” as used in this Agreement shall mean certain__made, used, imported, sold, or offered for sale by Licensee, including, but not limited to:_____.
- 1.6 Past Products.** “Past Products” as used in this Agreement shall mean the Licensed Products made or sold by Licensee before the Effective Date of this Agreement.
- 1.7 Royalty (ies).** shall mean revenues received in the form of cash (or any other mutually agreed upon form) from the Licensee as a result of licensing and using, selling, making or having made the Licensed Product.
- 1.8 Exclusive License** shall mean a license whereby the Licensee’s rights are sole and entire and operate to exclude all others except as otherwise expressly provided herein.

2. LICENSE

2.1 License Grant. Subject to the terms and conditions of this Agreement and the due performance by Licensee of Licensee’s obligations under this Agreement and in reliance on Licensee’s representations and warranties set forth in this Agreement, Licensor hereby grants to Licensee a personal, exclusive, nonexclusive, nontransferable limited license under the Licensed Patents for the Term in the Territory to make, use, import, offer to sell and sell Licensed Products and Past Products, with no right to sublicense. This license shall not extend to any third party, subsidiary, division, or any entity acquired after the Effective Date.

2.2 Basis. The foregoing license is granted solely under the Licensed Patents. No license under any other patents or intellectual property of Licensor is granted, either expressly or by implication.

2.3 Marking. During the Term of this Agreement, Licensee shall affix to Licensed Products a statement in substantially the form: “Patent Nos._____.” The Licensee shall provide Licensor with the samples of its Licensed Products evidencing proper marking as required hereunder. From time to time, and within a reasonable time after written notice from Licensor, Licensor shall have the right to inspect Licensee’s Licensed Products to determine if Licensee is marking in accordance with this paragraph.

3. PAYMENTS

3.1 Running Royalty.

3.1.1 Royalty Payment. For the rights granted in this Agreement, and subject to Paragraphs 3.2 and 3.3 herein below, Licensee shall pay Licensor a royalty of___ percent of (_ %) of Licensee’s selling price for each Licensed Product manufactured, used, or sold by Licensee in the Territory or imported by Licensee into the Territory.

3.1.2 Termination of Royalty on Invalidity or Unenforceability.

The royalty payments shall terminate if all of the Licensed Patents are held invalid or unenforceable. A Licensed Patent shall be deemed invalid or unenforceable under this Agreement if a court or tribunal of competent jurisdiction makes such a determination, and the determination becomes final in that it is not further reviewable through appeal or exhaustion of all permissible petitions or applications for rehearing or review.

3.2 Accrual. A running royalty as to a unit of Licensed Product shall accrue on the day the unit is shipped or invoiced to a Licensee customer, whichever occurs first.

3.3 Payment. All royalty payments to Licensor shall be made quarterly by Licensee, with the first quarter being defined as January 1 through March 31, the second quarter as April 1 through June 30, the third quarter as July 1 through September 30, and the fourth quarter as October 1 through December 31. Payment of royalties shall be made to Licensor not later than the thirtieth (30th) day (the “Due Date”) after the end of the period to which the payment relates. Each royalty payment as defined herein above shall be subject to and be no less than a minimum royalty of Pakistani Rupees. ___ Per quarter.

3.4 Accounting Statements. Licensee shall provide Licensor with a statement of royalties due Licensor under this Agreement quarterly (as that term is defined in Paragraph 3.3) on or before the Due Date, setting forth the amount due to Licensor for the period and, in reasonable detail, the factual basis for calculating the amount.

3.5 Interest. Subject to the limits imposed by any applicable usury law, interest shall accrue on payments made more than ten (10) days after they are due at the rate of _ percent (_ %) per annum, compounded daily, from the due date until paid.

3.6 Books and Records and Audit. Licensee shall keep full, complete, and accurate books of account and records covering all transactions relating to this Agreement. Licensee shall preserve such books and records for a period of three (3) years after the Due Date to which the material relates. Acceptance by Licensor of an accounting statement or payment hereunder will not preclude Licensor from challenging or questioning the accuracy thereof. During the Term and for a period of one (1) year thereafter, Licensor may, upon reasonable notice in writing to Licensee, cause an independent audit to be made of the books and records of Licensee in order to verify the statements rendered under this Agreement, and prompt adjustment shall be made by the proper party to compensate for any errors

disclosed by the audit. The audit shall be conducted only by an independent accountant during regular business hours and in a reasonable manner so as not to interfere with normal business activities. Audits shall be made hereunder no more frequently than annually. Before any audit may be conducted, the auditor must represent that the auditor's fee will in no manner be determined by the results of the audit and must agree to maintain the confidentiality of all confidential material to which the auditor is given access. Licensor will bear all expenses and fees of the audit, but if the audit reveals an underpayment for any quarter of more than __(%), Licensee shall pay all such expenses and fees. Licensee shall provide samples of any new _____, and/or a complete written description thereof, sufficient to enable Licensor to determine whether such product is covered by any of the claims of any of the Licensed Patents.

3.7 Confidentiality. Licensor and Licensee **acknowledge** that the amount of Licensee's payments actually made to Licensor under this Agreement are confidential and proprietary information relating to this Agreement and the business of Licensor and Licensee. Accordingly, the parties agree that each of them shall keep that information confidential and shall not disclose it, or permit it to be disclosed, to any third party (other than to agents or representatives who need to know such information). Licensor shall have the right, however, to disclose that Licensor and Licensee have entered into this Agreement, the royalty rate(s) set forth in this Agreement, that Licensee is paying for Past Products, and that Licensee has consented to the validity, enforceability, and infringement of the Licensed Patents.

4. **INDEMNIFICATION**

4.1 Licensee Indemnification. Licensee shall at all times during the term of this Agreement and thereafter indemnify, defend, and hold Licensor, its 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 out of any damage to property, or resulting from the production, manufacture, sale, use, lease, or advertisement of Licensed Products or Past Products or arising from any obligation of Licensee under this Agreement.

4.2 Licensor Indemnification. Licensor shall at all times during the term of this Agreement and thereafter indemnify, defend, and hold Licensee, its 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 any breach of any representation, warranty, or covenant expressly made by Licensor in this Agreement.

5. **TERMINATION**

5.1 Termination by Licensor. In addition to all other remedies Licensor may have, Licensor may terminate this Agreement and the licenses granted in this Agreement in the event that:

- a. Licensee defaults in its payment to Licensor and such default continues unremedied for a period of thirty (30) days after the Effective Date of this Agreement;
- b. Licensee fails to perform any material obligation, warranty, duty, or responsibility or is in default with respect to any term or condition undertaken by Licensee hereunder, and such failure or default continues unremedied for a period of thirty (30) days after written notice thereof to Licensee by Licensor;

- c. Licensee is liquidated or dissolved;
- d. Any assignment is made of Licensee's business for the benefit of creditors;
- e. Licensee liquidates a substantial portion of its business or engages in a distress sale of substantially all of its assets;
- f. A receiver, or similar officer, is appointed to take charge of a substantial part of Licensee's assets;
- g. Licensee is unable to pay its debts as they mature; or
- h. Any petition in bankruptcy is filed by or against Licensee that remains undischarged for sixty (60) days.

5.2 Termination by Licensee. If all the Licensed Patents are determined to be invalid or unenforceable by any court or tribunal of competent jurisdiction, and the determination becomes final in that it is not further reviewable through appeal or exhaustion of all permissible petitions or applications for rehearing or review, Licensee may terminate this Agreement at will and shall have no further obligations hereunder.

5.3 Effect of Termination. After the termination of this Agreement, Licensee shall have no rights under the Licensed Patents.

5.4 No Discharge on Termination. No termination of this Agreement for any reason shall relieve or discharge either Licensor or Licensee from any duty, obligation, or liability that was accrued as of the date of the termination (including, without limitation, the obligation to indemnify or to pay any amounts owing as of the date of termination).

6. REPRESENTATIONS AND WARRANTIES OF LICENSOR

6.1 Right to Grant License. Licensor represents and warrants that Licensor has the right and authority to grant the licenses granted to Licensee in this Agreement and that this Agreement and the licenses granted in this Agreement do not and will not conflict with the terms of any agreement to which Licensor is a party.

6.2 Disclaimers. Except as otherwise expressly set forth in this Agreement, Licensor, its directors, officers, employees, and agents make no representations and extend no warranties of any kind, either express or implied. In particular, and without limitation, nothing in this Agreement shall be construed as:

- a. A warranty or representation by Licensor as to the validity or scope of the Licensed Patents;
- b. A warranty or representation by Licensor that anything made, used, sold, or otherwise disposed of under any license granted in this Agreement is or will be free from infringement of patents of third parties;
- c. An obligation on the part of Licensor to bring or prosecute actions against third parties for infringement of the Licensed Patents or other proprietary rights;
- d. An obligation on the part of Licensor to furnish any manufacturing or technical information;
- e. The granting by implication, estoppel, or otherwise of any licenses or rights under patents other than the Licensed Patents; or
- f. The assumption by Licensor of any responsibilities whatever with respect to use, sale, or other disposition by Licensee or its vendees or transferees of Licensed Products.

6.3 Limitation of Liability. In no event shall Licensor, its 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 Licensor shall be advised, shall have other reason to know, or in fact shall know of the possibility.

7. REPRESENTATIONS AND WARRANTIES OF LICENSEE

Licensee represents and warrants that Licensee has the right and authority to enter into this Agreement and that this Agreement and the exercise of the licenses granted hereunder does not and will not conflict with the terms of any agreement to which Licensee is a party. Except as otherwise expressly set forth in this Agreement, Licensee, its directors, officers, employees, and agents make no representations and extend no warranties of any kind, either express or implied. In particular, and without limitation, nothing in this Agreement shall be construed as an obligation on the part of Licensee to furnish any manufacturing or technical information.

8. RELATIONSHIP OF THE PARTIES

Nothing in this Agreement will be construed to constitute the parties as partners or joint ventures or constitute either party as agent of the other, nor will any similar relationship be deemed to exist between them. Neither party shall hold itself out contrary to the terms of this paragraph, and neither party shall become liable by reason of any representation, act, or omission of the other contrary to the provisions of this paragraph. This Agreement is not for the benefit of any third party and shall not be deemed to give any right or remedy to any such party, whether referred to in this Agreement or not.

9. ASSIGNMENT

9.1 No Assignment. This Agreement, the rights granted to Licensee, and the duties and obligations of Licensee are all personal to Licensee, and Licensee agrees not to sell, assign, transfer, mortgage, pledge, or hypothecate any such rights in whole or in part, or delegate any of its duties or obligations under this Agreement without the prior written consent of Licensor, which shall not be unreasonably withheld. In the context of this provision, “assignment” shall include the transfer of substantially all of the assets of Licensee, or of a majority interest in the voting stock of Licensee, or the merger, consolidation, or reorganization of Licensee with one or more third parties.

9.2 Binding on Successors. This Agreement will inure to the benefit of and be binding upon Licensor, its successors, and assigns.

10. DISPUTE RESOLUTION

10.1 Arbitration of Royalty Disputes.

a. All disputes arising between the parties in connection with this Licensing Agreement and carrying out of the obligations covenanted hereunder, shall be initially settled amicably between the licensor and licensee and in case no settlement of disputes(s) is resolved then it shall be referred and settled through Pro-Rector (RIC) arbitration, or mutual arbitration, under the provision of the Arbitration Act, 1940 and the venue of arbitration will be ___ and the decision will be final.

b. The power of the arbitrators shall be limited to resolving the specific issues stated by determining the royalties Licensee owes or should receive credit for, if any, under this Agreement. The power of the arbitrators shall not extend to any other matters.

11. LIMITATIONS OF RIGHTS AND AUTHORITY

11.1 Limitation of Rights. No right or title whatsoever in the Licensed Patents is granted by Licensor to Licensee, or shall be taken or assumed by Licensee, except as is specifically set forth in this Agreement.

11.2 Limitation of Authority. Neither party shall, in any respect whatsoever, be taken to be the agent or representative of the other party, and neither party shall have any authority to assume any obligation for the other party, or to commit the other party in any way.

12. MISCELLANEOUS

12.1 Computation of Time. The time in which any act provided in this Agreement is to be done shall be computed by excluding the first day and including the last day, unless the last day is a Saturday, Sunday, or legal holiday, and then it shall also be

excluded.

12.2 Notices. All notices given in connection with this Agreement shall be in writing and shall be deemed given upon actual receipt by the addressee. Notices shall be personally delivered or sent by telex or facsimile (with prompt confirmation by registered or certified air mail, postage prepaid) or by registered or certified air mail, postage prepaid, addressed to the party to be notified at the following address, or at such other address as the party may designate by notice:

Licensor: _____

Attention: _____ Phone: _____ Facsimile: _____

Licensee: _____

Attention: _____ Phone: _____ Facsimile: _____

12.3 Survival. The provisions of this Agreement relating to payment obligations, confidentiality, indemnification, remedies, and arbitration shall survive the expiration or termination of this Agreement.

12.4 Severability. If any provision of this Agreement is declared by a court of competent jurisdiction to be invalid, illegal, unenforceable, or void, then both parties shall be relieved of all obligations arising under such provision, but only to the extent that such provision is invalid, illegal, unenforceable, or void. If the remainder of this Agreement is capable of substantial performance, then each provision not so affected shall be enforced to the extent permitted by law.

12.5 Waiver and Modification. No modification of any of the terms of this Agreement will be valid unless in writing and signed by both parties. No waiver by either party of a breach of this Agreement will be deemed a waiver by such party of any subsequent breach.

12.6 Headings. The headings in this Agreement are for reference only and shall not

in any way control the meaning or interpretation of this Agreement.

12.7 Interpretation. No provision of this Agreement is to be interpreted for or against any party because that party or its attorney drafted the provision.

12.8 Governing Law. This Agreement shall be construed, governed, interpreted, and applied in accordance with the laws of the Islamic Republic of Pakistan.

12.9 No Other Agreement. The parties each represent that in entering into this Agreement, they rely on no promise, inducement, or other agreement not expressly contained in this Agreement; that they have read this Agreement and discussed it thoroughly with their respective legal counsel; that they understand all of the provisions of this Agreement and intend to be bound by them; and that they enter into this Agreement voluntarily.

12.10 Entire Agreement. This Agreement constitutes the complete and exclusive statement of the terms and conditions between the parties, which supersedes and merges all prior proposals, understandings and all other agreements, oral and written, between the parties relating to the subject of this Agreement.

12.11 Counterparts. This Agreement may be executed in counterparts, which taken together shall constitute one document.

IN WITNESS WHEREOF, the parties have executed this Agreement by their duly authorized representatives.

For and on behalf of [Licensor]

By: _____

Title: _____

DATE : _____

For and on behalf of [Licensee]

By: _____

Title: _____

DATE : _____