

PATENT RIGHTS LICENCE AGREEMENT



Licensee: [insert]		CSIRO Technical Contact		CSIRO Contract Manager	
ABN: [insert]					
Notices:	Contact for notices to Licensee			Contact for notices to CSIRO	
Name:		XXX		XXX	
Address:					
Tel:		Tel:		Tel:	
Fax:		Fax:		Fax:	
Email:		Email:		Email:	

Background

- A. CSIRO offers the Licensee a under the Patent Rights on the terms set out in this Agreement.
- B. The Licensee accepts the Licence under the Patent Rights on the terms set out in this Agreement.

Details

Patent Rights	Patent Rights means all patents and patent applications claiming priority from, or sharing common priority with, International Patent Application No. PCT/AU2016/051267 (publication no. WO 2017/106916) entitled "Static Mixers for Continuous Flow Catalytic Reactors", including European Publication No. 3393643.
Term	From the Execution Date until cessation or expiry of the Patent Rights, or early termination pursuant to the provisions of this Agreement.
Annual Licence Fee	\$20,000 (excluding GST) to be paid annually in advance.

This proposal to enter into an Agreement (which will consist of this cover page, the terms overleaf and any attachments) is valid for 60 days from the date shown at the top of this cover page. To accept this proposal, please have your authorised representative sign below and return all of the pages of the Agreement to the CSIRO Contract Manager identified above.

By signing below you confirm you have read and accepted the Agreement and that you are authorised to sign on behalf of the Licensee.

CSIRO _____ by _____ on _____

Licensee _____ by _____ on _____

TERMS FOR PATENT LICENCE

1 LICENCE

- 1.1 From the Execution Date, CSIRO grants the Licensee a non-exclusive, non-transferable, world-wide licence under the Patent Rights, for the Term, subject to payment of the Annual Licence Fee and compliance with the terms of this Agreement to:
- use the Process solely to make and sell products; and;
 - make CSM Elements for the sole purpose of making and selling products.
- 1.2 For the avoidance of doubt the Licence granted under clause 1.1 excludes the right to make and sell CSM Elements.
- 1.3 The Licensee may not sublicense any of its rights under this Agreement (other than as outlined under clause 2) and any attempted sublicense in contravention of this Agreement will be null and void.
- 1.4 This Agreement commences on the Execution Date and expires at the end of the Term subject the termination provisions of this Agreement.
- 1.5 Notwithstanding anything to the contrary in this Agreement, nothing in this Agreement prevents the Licensee from exercising any rights it may have in the Licensee's jurisdiction under a statutory exemption to patent infringement for acts done for experimental purposes relating to the subject matter of a patented invention.
- 1.6 Other than expressly granted under this clause 1.1, nothing in this Agreement gives the Licensee any right, title or interest in or under the Patent Rights, the Technology or any other intellectual property. CSIRO retains all rights not expressly granted to the Licensee.

2 SUBLICENSING TO AFFILIATES

- 2.1 The Licensee may grant to its Affiliates sublicenses of the Licence granted to it under clause 1.1, provided that:
- the Licensee must promptly provide CSIRO with a copy of any sublicense agreement entered into;
 - each sublicense will be personal to the Affiliate and will not be assignable, nor will the Affiliate have the right to sublicense;
 - the acts or omissions of any Affiliate to which a sublicense is granted are considered for the purposes of this Agreement to be the acts or omissions of the Licensee; and
 - each sublicense must be capable of being terminated at CSIRO's sole discretion at the same time as the termination of this Agreement or any Licences granted under it.

3 ANNUAL LICENCE FEE

- 3.1 CSIRO will invoice the Licensee in advance the Annual Licence Fee, payable Annually.
- 3.2 The Licensee must pay CSIRO the Annual Licence Fee within 30 days of the date of CSIRO's invoice.
- 3.3 The Annual Licence Fee must be paid to CSIRO in full, without any deduction, withholding, set-off or counterclaim, including for taxes, excises or duties. If any taxes, excises or duties are imposed then: (i) the Licensee will bear and pay all deductions directly to the relevant authorities; and (ii) separately pay CSIRO enough to ensure that CSIRO receives the full amount of the Annual Licence Fee on the due date.

- 3.4 The Licensee must treat all information about the Annual Licence Fee as confidential to CSIRO and not disclose it to any third party.
- 3.5 The Licensee is responsible for obtaining all necessary import licenses or permits and for paying any customs or import duties or taxes on such importation.
- 3.6 All international conventions that might import contractual terms into this Agreement are excluded, including the United Nations Convention on Contracts for the International Sale of Goods.
- 3.7 For GST purposes all invoices or receipts issued by CSIRO are tax invoices.
- 3.8 Goods and services supplied to Australian residents or for use in Australia are subject to tax under the GST law. If the Licensee operates in Australia, then GST will be applied to the Annual Licence Fee.
- 3.9 If the Licensee is not an Australian resident, goods or services supplied to the Licensee under this Agreement will be treated as GST-free supplies under the GST law in reliance on the Licensee's assurances that the Licensee:
- is a non-resident for Australian income tax purposes;
 - is not registered or required to be registered for GST purposes in Australia; and
 - requires the goods and services solely for use in its business or operations outside of Australia.
- 3.10 If goods or services supplied to the Licensee representing to CSIRO that it operates outside Australia are subsequently classified as taxable because any of its assurances are incorrect, the Licensee must reimburse CSIRO on demand for the GST payable (including any interest, fine, penalty or other amount imposed upon CSIRO for failing to collect the GST).

4 ACKNOWLEDGEMENT & DISCLAIMER

- 4.1 The Licensee acknowledges that:
- the Patent Rights may expire or cease to be in force during the Term (including for the reason that a patent application comprised in the Patent Rights does not obtain grant);
 - the Patent Rights and the Technology may have inherent defects or deficiencies;
 - any use of the Technology is solely at the Licensee's own risk;
 - CSIRO does not represent or warrant that the use of the Technology will not infringe any third party's rights; and
 - the Licensee has not relied on any representations or warranties about the Patent Rights or the Technology except as expressly provided in this Agreement.

5 LIMITATION OF LIABILITY

- 5.1 This Agreement does not exclude or limit any guarantee, condition, warranty, right or liability implied into it by law (including the *Competition and Consumer Act 2010*), the exclusion of which would contravene the law or cause this agreement to be void ("non-excludable consumer warranties"). This Agreement is at all times to be read subject to such non-excludable warranties.

- 5.2 To the maximum extent lawfully permitted, CSIRO excludes any and all liability to the Licensee for any loss, liability or expense (including any loss of data, information, revenue, profit or business opportunity or for any damage to goodwill or reputation which is suffered by the Licensee) arising out of or in connection with:
- (a) the Licensee's use of the Technology;
 - (b) any unauthorised use of the Technology including by any third party; or
 - (c) any defect in the Patent Rights or the Technology.

6 INDEMNITY

The Licensee indemnifies CSIRO against and releases CSIRO from all claims, demands, suits, liability, loss or expense arising directly or indirectly from:

- (a) the Licensee's use of the Technology; and
- (b) any breach of this Agreement by the Licensee.

7 TERMINATION

- 7.1 Either party may terminate this Agreement by giving written notice to the other Party's Representative if:
- (a) the Patent Rights expire or cease to be in force during the Term; or
 - (b) there is a breach of this Agreement and that breach is not remedied within 30 days after written notice is received.
- 7.2 Notwithstanding clause 7.1, CSIRO may terminate this Agreement by giving written notice to the Licensee's Party's Representative, with termination taking effect from the date of the breach:
- (a) if the Licensee breaches the Agreement which in CSIRO's reasonable opinion cannot be remedied; or;
 - (b) if the Licensee uses the Technology outside the scope of the licence authorised under clause 1; or
 - (c) the Annual Licence Fee is not paid within 30 days on 3 or more occasions.

8 DISPUTE RESOLUTION

- 8.1 Any Dispute must be dealt with in accordance with this clause.
- 8.2 The party claiming that there is a Dispute must notify the other Party's Representative in writing and give details of that Dispute to the other Party's Representative.
- 8.3 If the Dispute is not resolved within 90 days from the date that the written notice of the Dispute is received, then the Dispute must be submitted to mediation in accordance with, and subject to, the Institute of Arbitrators and Mediators Australia Mediation (**IAMA**) Rules.
- 8.4 The mediation will take place in Victoria, Australia, if the Licensee has an office in Australia. If the Licensee's operations are wholly outside of Australia the mediation will take place in Singapore and will be administered by an equivalent institute to the IAMA, or a body chosen by CSIRO.
- 8.5 If the Dispute cannot be resolved within 90 days (unless this period is extended by mutual agreement in writing) from the date it is submitted for mediation, then neither party is bound to continue mediation.
- 8.6 CSIRO may, if required, disclose any information regarding the mediation to its responsible government Minister, House of Parliament or a Committee of Parliament.
- 8.7 This clause does not prevent any party from seeking urgent injunctive or similar interim relief from a Court.

9 GENERAL

- 9.1 Each party warrants that this Agreement has been signed by an officer who has authority to sign this Agreement on behalf of the party.
- 9.2 This Agreement may only be varied or assigned if the parties agree in writing. This Agreement records our entire agreement and supersedes all earlier agreements and representations that may have been made by CSIRO to the Licensee regarding the Technology or the Patent Rights.
- 9.3 The terms of this Agreement override any contrary terms contained in any confirmation, letter, term sheet or other documentation issued by CSIRO to the Licensee or exchanged between CSIRO and the Licensee.
- 9.4 This Agreement is governed by the law applicable to the State of Victoria, Australia.
- 9.5 If any term of this Agreement is prohibited, void or unenforceable under any applicable law, it will be severed to the extent necessary to make this Agreement valid and enforceable. The severance of a term will not affect the validity or enforceability of the remaining terms of this Agreement.
- 9.6 The Licensee must not use CSIRO's name, acronym, logo or trade marks in any way without CSIRO's express written permission.
- 9.7 Clauses 5, 6, 9.4 and 9.5 survive termination or expiry of this Agreement.

10 INTERPRETATION

In this Agreement capitalised terms not defined in this clause have the meaning given to them in the Details;

- (a) **Affiliate** means any corporation, partnership, or other entity Controlling, Controlled by or under common Control with the Assignee;
- (b) **Agreement** means this Licence Agreement which consists of the Details and the terms;
- (c) **Annually** means each 12-month period over the Term which commences on the Execution Date and continues each anniversary from the Execution Date until the earlier of:
 - (i) expiry or cessation of the Patent Rights; or
 - (ii) termination of this Agreement.
- (d) **Annual Licence Fee** means the Annual fee stated in the Details;
- (e) **Control** of a corporation, partnership or other entity means:
 - i. direct or indirect beneficial ownership of 50% or more of its voting power, or 50% or more of the interest in its income; or
 - ii. the power to appoint the majority of its directors; or
 - iii. the power otherwise to direct its business activities.
- (f) **CSIRO** means the Commonwealth Scientific and Industrial Research Organisation ABN 41 687 119 230, having its principal address at Clunies Ross Street, Black Mountain, Australian Capital Territory;
- (g) **CSM Element** means a catalytic static mixer element described, claimed or otherwise disclosed (other than as prior art) in the International Patent Application No. PCT/AU2016/051267 (publication no. WO 2017/106916) entitled "Static Mixers for Continuous Flow Catalytic Reactors".

- (h) **Details** means the table titled "Details" one page 1 of this Agreement;
- (i) **Dispute** means any dispute, controversy or claim arising out of or in connection with this agreement, including its existence, breach, validity or termination;
- (j) **Execution Date** means the day on which the last party to sign the Agreement signs.
- (k) **Party's Representative** means the nominated person for each party for notices, specified in the Details;
- (l) **Patent Rights** means those defined in the Details;
- (m) **Process** means a process for synthesising a product in a reactor containing a CSM Element.
- (n) **Technology** means the subject matter described, claimed or otherwise disclosed, other than as prior art, in International Patent Application No. PCT/AU2016/051267 (publication no. WO 2017/106916).