

LICENSE AGREEMENT

BETWEEN

LICENSEE

AND

CORNELL UNIVERSITY

FOR

CORNELL INVENTION DOCKET NO. D-3868

Titled

**“RICOCHET: LATERAL ERROR CORRECTION FOR
TIME-CRITICAL CLUSTER MULTICAST”**

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LICENSE AGREEMENT

This agreement ("Agreement") is made by and between LICENSEE (as later defined in Appendix A) and Cornell University ("Cornell") as represented by its Cornell Center for Technology Enterprise and Commercialization ("CCTEC") at 395 Pine Tree Road, Ithaca, NY 14850.

This Agreement is effective on the date of the last signature ("Effective Date").

RECITALS

WHEREAS, the inventions disclosed in Disclosure Docket No. D-3868 and titled "Ricochet: Lateral Error Correction for Time-Critical Cluster Multicast" ("Invention"), were made in the course of research at Cornell by Drs. Kenneth Birman and Mahesh Balakrishnan (hereinafter and collectively, the "Inventors") and are covered by Patent Rights as defined below;

WHEREAS, the Inventors are employees of Cornell, and they are obligated to assign all of their rights, title and interest in the Invention to the Cornell Research Foundation, Inc. ("CRF") or to Cornell and have done so;

WHEREAS, CRF has engaged CCTEC to manage Invention, in whole or in part, assigned to it and has fully authorized CCTEC to manage all rights subsisting therein and to enter into any agreement granting such rights to advance the missions of Cornell;

WHEREAS, CCTEC is the officially authorized unit at Cornell to manage Invention and to grant rights subsisting therein for Cornell and CRF;

WHEREAS, Cornell desires that the Invention be developed and utilized to the fullest possible extent so that its benefits can be enjoyed by the general public;

WHEREAS, LICENSEE desires to obtain certain rights from Cornell for commercial development, use, and sale of the Invention, and Cornell is willing to grant such rights; and

WHEREAS, LICENSEE understands that Cornell may publish or otherwise disseminate information concerning the Invention at any time and that LICENSEE is paying consideration hereunder for its access to the Invention, the associated patent rights, not continued secrecy therein.

NOW, THEREFORE, the parties agree:

ARTICLE 1. DEFINITIONS

The terms, as defined herein, shall have the same meanings in both their singular and plural forms.

- 1.1 "Affiliate" means any corporation or other business entity which is bound in writing by LICENSEE to the terms set forth in this Agreement and in which LICENSEE owns or controls, directly or indirectly, at least fifty percent (50%) of the outstanding stock or other voting rights entitled to elect directors, or in which LICENSEE is owned or controlled directly or indirectly by at least fifty percent (50%) of the outstanding stock or other voting rights entitled to elect directors; but in any country where the local law does not permit foreign equity participation of at least fifty percent (50%), then an "Affiliate" includes any company in which LICENSEE owns or controls or is owned or controlled by, directly or indirectly, the maximum percentage of outstanding stock or voting rights permitted by local law.
- 1.2 "Sublicense" means an agreement into which LICENSEE enters with a third party that is not an Affiliate for the purpose of (i) granting certain rights; (ii) granting an option to certain rights; or (iii) forbearing the exercise of any rights, granted to LICENSEE under this Agreement after Effective Date. "Sublicensee" means a third party with whom LICENSEE enters into a Sublicense.
- 1.3 "Field" means all uses of Patent Rights as defined in Article 1.6 below.
- 1.4 "Territory" means the United States of America.
- 1.5 "Term" means the period of time beginning on Effective Date and ending on the expiration date of Patent Rights.
- 1.6 "Patent Rights" means CRF's or Cornell's right in the United States Patent 7,532,621.

ARTICLE 2. GRANTS

2.1 **License.** Subject to the limitations set forth in this Agreement, Cornell hereby grants to LICENSEE, and LICENSEE hereby accepts, a license to use Patent Rights in the Field within the Territory and during the Term. The right to use Patent Rights granted herein to LICENSEE may be extended to contractors solely for the purpose of providing contract services to LICENSEE for the benefit of the LICENSEE.

The license granted herein is non-exclusive and Cornell shall have the rights to grant additional licenses to third parties to use Patent Rights.

LICENSEE may extend the rights granted above to its Affiliates provided that LICENSEE shall first provide to Cornell a written assurance from each of its Affiliates to comply with all applicable terms, conditions and obligations to Cornell.

2.2 Sublicenses. LICENSEE is expressly prohibited from granting Sublicenses of Patent Rights to any third party that is not an Affiliate of LICENSEE.

2.3 Reservation of Rights. Cornell reserves all rights to use Invention and Patent Rights and to further grant such rights to third parties.

ARTICLE 3. CONSIDERATION

3.1 Fees and Royalties. The parties hereto understand that the fees and royalties payable by LICENSEE to Cornell under this Agreement are partial consideration for the license granted herein to LICENSEE under Patent Rights.

(a) LICENSEE shall pay Cornell a one-time, license fee of Five Thousand US Dollars (US\$5,000), within thirty (30) days after the Effective Date.

(b) The fee payment specified in Paragraph 3.1(a) shall be paid by LICENSEE pursuant to Paragraph 4.3 and shall be delivered by LICENSEE to Cornell as noted in Paragraph 10.1.

3.2 [This paragraph is intentionally left blank.]

3.3 Due Diligence. LICENSEE shall obtain all necessary governmental approvals for the manufacture, use and sale of products using Patent Rights.

ARTICLE 4. REPORTS, RECORDS AND PAYMENTS

4.1 Reports. LICENSEE shall report to Cornell the product name and trade name of each Licensed Product sold by LICENSEE or its Affiliates that uses Patent Rights within thirty (30) days such product is first sold in the market in each country.

4.2 [This paragraph is intentionally left blank.]

4.3 Payments.

(a) All fees due Cornell shall be paid in United States dollars and all checks shall be made payable to "Cornell University", referencing Cornell's taxpayer identification number, 15-0532082, and sent to Cornell according to Paragraph 10.1 (Correspondence).

(b) [This paragraph is intentionally left blank.]

(c) Late Payments. In the event fee payments are not received by Cornell when due, LICENSEE shall pay to Cornell interest charges at a rate of ten percent (10%) per year. Such interest shall be calculated from the date payment was due until actually received by Cornell.

ARTICLE 5. PATENT MATTERS

5.1 [This paragraph is intentionally left blank.]

5.2 Patent Infringement.

(a) If LICENSEE learns of any substantial infringement of Patent Rights, LICENSEE shall so inform Cornell and provide Cornell with reasonable evidence of the infringement. LICENSEE shall not notify a third party of the infringement of Patent Rights without the consent of Cornell.

(b) LICENSEE may request Cornell to take legal action against such third party for the infringement of Patent Rights in the Field and within the Territory. Such request shall be made in writing and shall include reasonable evidence of such infringement and damages to LICENSEE.

(c) All recoveries from actions brought pursuant to Paragraph 5.2(b) shall belong to Cornell.

(d) LICENSEE shall cooperate with Cornell in litigation proceedings at the expense of Cornell. Litigation shall be controlled by Cornell.

5.3 Patent Marking. LICENSEE shall mark all Licensed Products made, used or sold under the terms of this Agreement, or their containers, in accordance with the applicable patent marking laws.

ARTICLE 6. GOVERNMENTAL MATTERS

6.1 Governmental Approval or Registration. If this Agreement or any associated transaction is required by the law of any nation to be either approved or registered with any governmental agency, LICENSEE shall assume all legal obligations to do so. LICENSEE shall notify Cornell if it becomes aware that this Agreement is subject to a United States or foreign government reporting or approval requirement. LICENSEE shall make all necessary filings and pay all costs including fees, penalties, and all other out-of-pocket costs associated with such reporting or approval process.

6.2 Export Control Laws. LICENSEE shall observe all applicable United States and foreign laws with respect to the transfer of Licensed Products and related technical data

to foreign countries, including, without limitation, the International Traffic in Arms Regulations and the Export Administration Regulations.

ARTICLE 7. TERMINATION OF THE AGREEMENT

7.1 Termination by Cornell.

(a) If LICENSEE fails to perform or violates any term of this Agreement, then Cornell may give written notice of default ("Notice of Default") to LICENSEE. If LICENSEE fails to cure the default within thirty (30) days of the Notice of Default, Cornell may terminate this Agreement and the license granted herein by a second written notice ("Notice of Termination") to LICENSEE. If a Notice of Termination is sent to LICENSEE, this Agreement shall automatically terminate on the effective date of that notice. Termination shall not relieve LICENSEE of its obligation to pay any fees owed at the time of termination and shall not impair any accrued right of Cornell.

(b) This Agreement will terminate immediately, without the obligation to provide written notices as set forth in Paragraph 7.1(a), if LICENSEE files a claim including in any way the assertion that any portion of CRF's or Cornell's Patent Rights is invalid or unenforceable where the filing is by the LICENSEE, a third party on behalf of the LICENSEE, or a third party at the written urging of the LICENSEE.

7.2 Termination by LICENSEE.

(a) LICENSEE shall have the right at any time and for any reason to terminate this Agreement upon a ninety (90)-day written notice to Cornell. Said notice shall state LICENSEE's reason for terminating this Agreement.

(b) Any termination under Paragraph 7.2(a) shall not relieve LICENSEE of any obligation or liability accrued under this Agreement prior to termination or rescind any payment made to Cornell or action by LICENSEE prior to the time termination becomes effective. Termination shall not affect in any manner any rights of Cornell or CRF arising under this Agreement prior to termination.

7.3 Survival on Termination. The following Paragraphs and Articles shall survive the termination of this Agreement:

- (a) Article 4 (REPORTS, RECORDS AND PAYMENTS);
- (b) Paragraph 7.4 (Disposition of Licensed Products on Hand);
- (c) Paragraph 8.2 (Indemnification);
- (d) Article 9 (USE OF NAMES AND TRADEMARKS);

- (e) Paragraph 10.5 (Failure to Perform).

7.4 Disposition of Licensed Products on Hand. Upon termination of this Agreement, LICENSEE may dispose of all previously made or partially made Licensed Product within a period of one hundred and twenty (120) days of the effective date of such termination provided that the sale of such Licensed Product by LICENSEE, its Sublicensees, or Affiliates shall be subject to the terms of this Agreement, including but not limited to the rendering of reports and payment of royalties required under this Agreement.

ARTICLE 8. LIMITED WARRANTY AND INDEMNIFICATION

8.1 Limited Warranty.

- (a) Cornell warrants that it has the lawful right to grant this license.
- (b) The license granted herein is provided “AS IS” and without WARRANTY OF MERCHANTABILITY or WARRANTY OF FITNESS FOR A PARTICULAR PURPOSE or any other warranty, express or implied. Cornell makes no representation or warranty that the Licensed Product, Licensed Method or the use of Patent Rights will not infringe any other patent or other proprietary rights.
- (c) In no event shall Cornell or CRF be liable for any incidental, special or consequential damages resulting from exercise of the license granted herein or the use of the Invention, Licensed Product, and Licensed Method.
- (d) Nothing in this Agreement shall be construed as:
 - (i) a warranty or representation by Cornell or CRF as to the validity or scope of any Patent Rights;
 - (ii) a warranty or representation that anything made, used, sold or otherwise disposed of under any license granted in this Agreement is or shall be free from infringement of patents of third parties;
 - (iii) an obligation to bring or prosecute actions or suits against third parties for patent infringement except as provided in Paragraph 5.2 hereof;
 - (iv) conferring by implication, estoppel or otherwise any license or rights under any patents of CRF or Cornell other than Patent Rights as defined in this Agreement, regardless of whether those patents are dominant or subordinate to Patent Rights; or
 - (v) an obligation to furnish any know-how not provided in Patent Rights.

8.2 Indemnification.

(a) LICENSEE shall indemnify, hold harmless and defend CRF, Cornell, its officers, employees, and agents; the sponsors of the research that led to the Invention; and the Inventors of the patents and patent applications in Patent Rights and their employers against any and all claims, suits, losses, damage, costs, fees, and expenses resulting from or arising out of exercise of this license or any Sublicense. This indemnification shall include, but not be limited to, any product liability.

(b) LICENSEE, at its sole cost and expense, shall sufficiently insure its activities in connection with the work under this Agreement and obtain, keep in force and maintain insurance or an equivalent program of self insurance.

(c) Cornell shall notify LICENSEE in writing of any claim or suit brought against CRF or Cornell in respect of which Cornell intends to invoke the provisions of this Article. LICENSEE shall keep Cornell informed on a current basis of its defense of any claims under this Article.

ARTICLE 9. USE OF NAMES AND TRADEMARKS

9.1 Nothing contained in this Agreement confers any right to use in advertising, publicity, or other promotional activities any name, trade name, trademark, or other designation of either party hereto (including contraction, abbreviation or simulation of any of the foregoing). Unless required by law, the use by LICENSEE of the name, "Cornell University" or "Cornell Research Foundation" is prohibited, without the express written consent of Cornell.

9.2 Cornell may disclose to the Inventors the terms and conditions of this Agreement upon their request. If such disclosure is made, Cornell shall request the Inventors not disclose such terms and conditions to others.

9.3 Cornell may acknowledge the existence of this Agreement and the extent of the grant in Article 2 to third parties, but Cornell shall not disclose the financial terms of this Agreement to third parties, except where CRF or Cornell is required by law or the order of a court of competent jurisdiction to do so.

9.4 LICENSEE may acknowledge or make press releases regarding the existence of this Agreement and the extent of the grant in Article 2 but LICENSEE should not disclosed the financial terms of this Agreement except where LICENSEE is required by law or the order of a court of competent jurisdiction to do so. To the extent LICENSEE makes any forward-looking statement in its press releases, LICENSEE shall receive prior consent of Cornell which shall not be unreasonably withheld.

ARTICLE 10. MISCELLANEOUS PROVISIONS

10.1 **Correspondence.** Any notice, invoice or payment required to be given to either party under this Agreement shall be deemed to have been properly given and effective:

- (a) on the date of delivery if delivered in person;
- (b) on the date of successful transmission if sent by facsimile,
- (c) one (1) day after the successful transmission in pdf file format if sent by electronic mail using the Internet; or
- (d) five (5) days after mailing if mailed by first-class or certified mail, postage paid, to the respective addresses given below, or to such other address as is designated by written notice given to the other party.

If sent to LICENSEE:

Name and address as shown in Appendix A

If sent to Cornell:

For all correspondence *except payments* -

Cornell Center for Technology Enterprise and Commercialization
Attention: Executive Director
395 Pine Tree Road, Suite 310
Ithaca, NY 14850
FAX: 607-254-5454
TEL: 607-254-5236
EMAIL: cctec-contracts@cornell.edu

For all payments -

If sent by mail:

Cornell Center for Technology Enterprise and Commercialization
PO Box 6899
Ithaca, NY 14850-6899

If remitted by electronic payments via ACH or Fed Wire:

Receiving bank name:	Tompkins Trust Co.
Bank account no.:	01101007353
Bank routing (ABA) no.:	021302648
Bank account name:	Cornell Research Foundation
Bank ACH format code:	Not required
Bank address:	P.O. 460, Ithaca, NY 14850
Additional information:	Reference D-3868
	Agreement No.: <to be filled in by Cornell>
	Department contact: Lewis Goodwin

A FAX copy of the transaction receipt shall be sent to Associate Director for Finance and Operations at: 607-254-5454. LICENSEE is responsible for all bank charges of wire transfer of funds for payments. The bank charges shall not be deducted from total amount due to Cornell.

10.2 [This paragraph is intentionally left blank.]

10.3 **Assignability.** This Agreement may be assigned by Cornell, but is personal to LICENSEE and assignable by LICENSEE only with the written consent of Cornell.

10.4 **No Waiver.** No waiver by either party of any breach or default of any covenant or agreement set forth in this Agreement shall be deemed a waiver as to any subsequent and/or similar breach or default.

10.5 **Failure to Perform.** In the event of a failure of performance due under this Agreement and if it becomes necessary for either party to undertake legal action against the other on account thereof, then the prevailing party shall be entitled to reasonable attorney's fees in addition to costs and necessary disbursements.

10.6 **Governing Laws.** THIS AGREEMENT SHALL BE INTERPRETED AND CONSTRUED IN ACCORDANCE WITH THE LAWS OF THE STATE OF NEW YORK, but the scope and validity of any patent or patent application shall be governed by the applicable laws of the country of the patent or patent application.

10.7 **Force Majeure.** A party to this Agreement may be excused from any performance required herein if such performance is rendered impossible or unfeasible due to any catastrophe or other major event beyond its reasonable control, including, without limitation, war, riot, and insurrection; laws, proclamations, edicts, ordinances, or regulations; strikes, lockouts, or other serious labor disputes; and floods, fires, explosions, or other natural disasters. When such events have abated, the non-performing party's obligations herein shall resume.

10.8 **Headings.** The headings of the several sections are inserted for convenience of reference only and are not intended to be a part of or to affect the meaning or interpretation of this Agreement.

10.9 **Entire Agreement.** This Agreement embodies the entire understanding of the parties and supersedes all previous communications, representations or understandings, either oral or written, between the parties relating to the subject matter hereof.

10.10 **Amendments.** No amendment or modification of this Agreement shall be valid or binding on the parties unless made in writing and signed on behalf of each party.

10.11 **Severability.** In the event that any of the provisions contained in this Agreement is held to be invalid, illegal, or unenforceable in any respect, such invalidity, illegality or unenforceability shall not affect any other provisions of this Agreement, and this Agreement shall be construed as if the invalid, illegal, or unenforceable provisions had never been contained in it.

IN WITNESS WHEREOF, both Cornell and LICENSEE have executed this Agreement, in duplicate originals, by their respective and duly authorized officers on the day and year written.

LICENSEE:

CORNELL UNIVERSITY:

By: _____
(Signature of an authorized officer)

By: _____
(Signature of an authorized officer)

Name: _____

Alan S. Paau, M.B.A, Ph.D.

Title: _____

Vice Provost for Technology Transfer
and Economic Development

Date: _____

Date: _____

APPENDIX A.

LICENSEE

COMPANY NAME: _____

ATTENTION: _____

COMPANY ADDRESS: _____

TELEPHONE: _____

FAX: _____

EMAIL: _____