

國立陽明交通大學  
NYCU

[Name of Technology license]  
Technology License Agreement

A: National Yang Ming Chiao Tung University(Contract No: YC-Y/C22T )  
B: \_\_\_\_\_(Professor)  
C: \_\_\_\_\_ Co., Ltd.

Contract Period: January 1, 2022 to \_\_\_\_\_, 202X

National Yang Ming Chiao Tung University (Party A)  
**Contractor:** \_\_\_\_\_ (Party B)  
\_\_\_\_\_ Co., Ltd. (Party C)

As Parties A, B, and C intend to combine the technologies, talents, and research facilities of the three parties to implement academic research and development, to jointly conduct basic research, and to benefit the domestic industry, they hereby agree, in good faith, to the following terms and conditions for mutual compliance:

**Article I Technology Sources**

This licensed technology is

- The technical results achieved by Party A (Party B as the principal investigator) under the “ \_\_\_\_\_ ” project (project number: \_\_\_\_\_) funded by the Ministry of \_\_\_\_\_, and its intellectual property rights are vested in Party A.
- The technical results developed by Party B using Party A’s resources, and its intellectual property rights are vested in Party A.

**Article II Licensed Technology Content**

1. Title of the Licensed Technology: “ \_\_\_\_\_ ”, as detailed in the Licensed Technology in Attachment 1 (hereinafter referred to as the Licensed Technology).
2. License Method:
  - Non-exclusive license, i.e., after Party A grants the license to Party C under this Agreement, Party A may implement the Licensed Technology and Party A may license the Licensed Technology to a third party.
  - Sole license, i.e., after Party A grants the license to Party C

under this Agreement, Party A may implement the Licensed Technology, but Party A may not license the Licensed Technology to a third party.

- Exclusive license, i.e. after Party A grants the license to Party C under this Agreement, Party A shall not implement the Licensed Technology, and Party A shall not license the Licensed Technology to other third parties.

3. Scope of License:

Party A grants Party C the right to implement the Licensed Technology in accordance with this Agreement. Except for Party A's prior written consent, Party C shall not sub-license this Licensed Technology to a third party for implementation.

4. License Period: This Agreement shall be valid for a period of \_\_\_\_\_ years from January 1, 2022 to \_\_\_\_\_. Party C may, within three months prior to the expiration date, submit a request in writing to Party A and Party B for an extension of the license period, and the three parties shall agree on the terms of the extension.

5. License Area: \_\_\_\_\_.

**Article III Licensed Product Development Plan**

1. Party C shall design, develop, manufacture and sell products incorporating part or all of the Licensed Technology (hereinafter referred to as the Licensed Products) in accordance with the development plan attached hereto as Attachment 2 (hereinafter referred to as the Development Plan) within [ ] months after the effective date of this Agreement.
2. Party C shall submit a report on the development of the Licensed Products with a full description of the progress of development to Party A in the year \_\_\_\_\_ after the effective date of this Agreement.

3. Party C shall ensure that it has sufficient financial resources and operational status to carry out the development plan. If Party C needs to delay or stop the development project, Party C shall notify Party A in writing and inform Party A of the reasons, and may only do so after Party A has agreed in writing, otherwise Party A may terminate this Agreement and claim for damages.

#### **Article IV Data Delivery**

Party B shall deliver the data related to the Licensed Technology to Party C within \_\_\_\_\_ days after the effective date of this Agreement and the receipt of the license fee paid by Party C.

#### **Article V Technical Guidance**

After the delivery of technical data to Party C, Party B shall provide Party C with a total of \_\_\_ hours of free technical guidance and consultation within \_\_\_ months. If the hours exceed the above, the three parties shall separately agree the time and cost.

#### **Article VI Licensing Consideration**

##### 1. License Fee

(1) The total amount of the license fee shall be NT\$ \_\_\_\_\_; business tax \_\_\_\_\_, totaling NT\$ \_\_\_\_\_, other related taxes and money transfer handling fees shall be borne by Party C.

(2) Party C shall pay to Party A the license fee as stipulated in the preceding paragraph by cash, wire transfer or demand check within 30 days after the signing of this Agreement.

##### 2. Derivative Benefit Payment

(1) Party C shall pay to Party A the derivative benefits of the Licensed Technology at \_\_\_\_\_% of the annual net sales of the Licensed Products after deducting the patent

application and maintenance fees for that year from the date of commencement of sales of the Licensed Products; Party C shall pay to Party A the derivative benefits of at least NT\$ \_\_\_\_\_ annually.

- (2) “Net Sales” means the total sales of the Licensed Products less the net sales returns and discounts. If Party C uses the Licensed Products as the subject of a swap, gift, lease or loan, such Licensed Products shall be deemed to have been sold and the unit price of such Licensed Products, if not invoiced, shall be determined by the higher of the market price of such products or the price of the most recent invoice.
- (3) Party C shall report to Party A in writing within 30 days after the end of each year the net sales of the Licensed Products for that year, the amount of sublicense fee (if any) and other information for calculating the derivative benefits due, and shall pay such amount to Party A by cash, money transfer or demand check within 30 days after Party A confirms the amount of derivative benefits.
- (4) Party A may assign business-related personnel and its accounting personnel, or appoint an accountant to visit Party C’s principal premises to check the production and sales records and revenue amounts of the Licensed Products, and Party C shall unconditionally cooperate in doing so. Party C shall retain the production and sales records of the Licensed Products and the records of sublicense fee until three years after the expiration of the License Period for Party A’s inspection in accordance with this Article. Party A’s receipt of the derivative benefits reported by Party C shall not affect Party A’s right to subsequently check the accuracy of the written

report. If Party C underreports the derivative benefits, Party C shall not only pay the difference and interest, but also compensate Party A for the damages incurred and bear the costs incurred by Party A in performing the audit.

3. Even if this Agreement is terminated or cancelled, the license fee and derivative benefit received by Party A shall not be refunded; any unpaid license fee and derivative benefit incurred shall still be paid by Party C.

#### **Article VII Ownership of Intellectual Property Rights**

1. All intellectual property rights in the Licensed Technology shall be owned solely by Party A. Except as otherwise provided in this Agreement, Party A may assign, trust, license, encumber or otherwise dispose of the Licensed Technology.
2. The intellectual property of any derivative products or technologies developed by Party C based on the Licensed Technology (hereinafter referred to as Derivative Inventions) shall vest in Party C, provided that Party C shall notify Party A and Party B upon completion of such Derivative Inventions and agree to make them available to Party A and Party B without compensation. Before Party C discloses the Derivative Invention, Party A and Party B shall not arbitrarily disclose or deliver it to any third party or make it known to any third party. If the Derivative Invention infringes on the intellectual property rights of any third party, Party C shall be fully liable and shall compensate Party A and Party B for all losses incurred as a result.

#### **Article VIII Patent Application and Maintenance**

1. During the term of this Agreement, the patent application and maintenance of the Licensed Technology shall be carried out at the request of Party C as follows:
  - (1) Party C shall be responsible for the relevant patent

application and maintenance procedures (hereinafter collectively referred to as patent-related procedures), and the costs of such patent-related procedures shall be borne by Party C, including but not limited to the service of appointing a firm to act as agent for patent-related procedures, such as searching, drafting, filing, defending, obtaining a license, and paying annual fees, etc.

- (2) Party A and Party B shall cooperate with Party C in the necessary procedures for patent-related procedures, and the patent application right and patent right shall still be vested in Party A.
- (3) Party C shall report to Party A on a regular basis on the patent-related procedures by itself or by the appointed agency.
- (4) If Party C fails to follow the patent-related procedures in accordance with this Agreement or for other reasons attributable to Party C, resulting in the failure to obtain the rights of the patent application related to the Licensed Technology or impairing the validity of the patent related to the Licensed Technology, Party C shall be liable for a punitive compensation of \_\_\_\_\_. If Party A and Party B suffer any damage as a result, Party C shall also compensate for such damage.

2. If the patent application and maintenance of the Licensed Technology is based on Party A's decision, the patent-related procedures shall be conducted by Party A, but the cost of such patent-related procedures shall be borne by Party C during the term of this Agreement.

## **Article IX Warranties and Disclaimers**

1. The Licensed Technology is delivered to Party C in the

completed state at the time of signing this Agreement. Party A and Party B warrant that the Licensed Technology is self-developed and not intentionally copied or counterfeited, but do not warrant the patentability, validity, applicability, non-infringement, assertion of rights to third parties, commercialization, or the possibility of achieving other specific purposes of the Licensed Technology.

2. If Party C needs to obtain a license from a third party to implement the Licensed Technology or to manufacture the Licensed Products, Party C shall be responsible for obtaining its own license. If Party C is subject to infringement claims or lawsuits by third parties as a result of the implementation of the Licensed Technology, Party C shall be responsible for all such claims or lawsuits, except in the case of breach of the foregoing warranty by Party A or Party B. However, Party A and Party B shall provide Party C with the necessary assistance.
3. Party C shall design, develop, manufacture and sell the Licensed Products in compliance with relevant laws and regulations. Party C shall be responsible for the product liability of the Licensed Products and shall protect Party A and Party B from any damages arising from the aforesaid product liability.

#### **Article X Liability for Infringement**

1. In the event that Party C implements the Licensed Technology and is subject to any claim of infringement or litigation by others, Party C shall immediately notify Party A and Party B in writing and Party A and Party B shall assist Party C in the necessary defensive procedures.
2. Unless otherwise agreed in this Agreement, if the Licensed Technology is infringed or threatened to be infringed by others, Party C shall immediately notify Party A and Party B in writing, and shall fully assist Party A and Party B in taking necessary



actions or legal procedures to ensure the common rights and interests of the three parties.

3. Party C shall bear all costs incurred by Party A and Party B in assisting Party C to carry out defense procedures or to exercise its rights in accordance with the preceding two provisions. Party C shall pay the aforementioned expenses in full within fifteen (15) days after the receipt of the notice of request for payment by Party A and Party B.

#### **Article XI Restrictions on Use**

1. Except with the prior written consent of Party A and Party B, Party C shall not use names, logos, emblems, trademarks and other symbols identical to, similar to or recognizable to Party A, Party B or any of Party A's affiliates in the commercial promotion of the Licensed Technology or Licensed Products (including but not limited to advertisements, product/investment descriptions, etc.). Party C shall also ensure that its employees, affiliates, distributors, agents, outsourced vendors, other vendors and employees of such vendors shall comply with this Agreement. Any violation shall be deemed to be a breach of this Agreement by Party C.
2. If this Licensed Technology has been applied for but not yet granted a patent, Party C agrees to clearly mark the words "Patent Pending" on the Licensed Product or its packaging container, and to clearly mark the patent certificate number after the Licensed Technology is granted a patent.
3. Party C shall comply with the government's "Regulations Governing Export and Import Of Strategic High-tech Commodities" and other export control laws and regulations in exporting the Licensed Products.
4. If Party C wishes to implement the Licensed Technology in

Mainland China, it shall apply for permission from the Investment Commission, MOEA in accordance with the relevant provisions of the “Regulations Governing Permission for Investment or Technical Cooperation in the Mainland Area” and notify Party A accordingly.

5. If Party C intends to assert its rights to a third party with the Licensed Technology, it shall first obtain the written consent of both Party A and Party B.
6. Party C understands and agrees that the Licensed Technology is the result of research and development produced by Party B upon receipt of government subsidies from Party A. In accordance with Article 16 of the “Government Scientific and Technological Research and Development Results Ownership and Utilization Regulation”, if any of the circumstances listed in the Article are found, the competent government agency may request Party A to authorize a third party to implement the Licensed Technology or, if necessary, to nationalize the Licensed Technology. Party C agrees to release Party A and Party B from all responsibilities in the aforementioned circumstances, and the price received by Party A shall not be returned to Party C. However, if the aforementioned circumstances can be attributed to Party C, Party C shall be responsible for improvement, and if Party A suffers damages as a result, Party C shall be liable for compensation. Party A may terminate this Agreement immediately upon notification by the government authorities that the Licensed Technology will be nationalized.

## **Article XII Duty of Confidentiality**

Party C shall keep the undisclosed part of the Licensed Technology (hereinafter referred to as the Confidential Information) strictly confidential, and shall exercise due care

and diligence to keep the Licensed Technology information and other related information known or held by Party C as a result of this Agreement. Party C shall not disclose or deliver the Confidential Information to any third party (including Party C's affiliates) or make it known to any third party without the written consent of Party A and Party B. Party C shall ensure that any third party who has access to the Confidential Information shall be under the same obligation of confidentiality, and any breach of this provision by such third party shall be deemed a breach of agreement by Party C. If Party C breaches the confidentiality obligations of this Agreement, Party C shall compensate Party A and Party B for their losses. Party C shall also be responsible for the confidentiality of this Agreement even if this Agreement is terminated, cancelled or the license period expires.

#### **Article XIII Liability for Breach of Agreement**

1. If Party C fails to pay the license consideration within the deadline as stipulated in Article 6 of this Agreement, Party C shall pay late default interest at 5% per annum of the total amount due and payable for each day overdue. If the payment is not made within one month, Party A may terminate this Agreement.
2. In addition to the foregoing, either party shall be liable to the other party for any breach of this Agreement for reasons attributable to itself; provided, however, that Party A's total liability shall be limited to the actual amount of the license consideration received by Party A from Party C under this Agreement at the time of the occurrence of the cause of liability.

#### **Article XIV Termination of Agreement**

1. Except as otherwise provided in this Agreement, either party may terminate this Agreement immediately in writing to the other party upon the occurrence of any of the following events:

- (1) If the other party is in breach of this Agreement and has not remedied the breach within thirty (30) days after the receipt of the notice requiring remedy;
  - (2) If the other party reorganizes, claims or is claimed to reorganize;
  - (3) If the other party dissolves, resolves to dissolve, or is ordered or adjudicated to dissolve;
  - (4) If the other party merges or resolves to merge with a third party;
  - (5) If the other party becomes bankrupt, claims or is declared bankrupt;
  - (6) If the other party's major assets are seized and the other party is unable to pay its debts, or if there are sufficient facts to prove that there is a risk of occurrence of such events in this subparagraph.
2. Party C shall immediately stop using the Licensed Technology upon termination, cancellation or expiration of the term of this Agreement and return the technical data obtained from Party A and Party B within one month or destroy them by itself and issue a letter of destruction.
  3. Party C shall not manufacture or sell the Licensed Products on its own or on behalf of others after the termination, cancellation or expiration of this Agreement. However, if Party C has specific facts to prove that the Licensed Products were manufactured before the termination, cancellation or expiration of this Agreement, the Licensed Products may continue to be sold until they are sold out, but Party C shall still pay the derivative benefits to Party A in accordance with Article 6 of this Agreement.
  4. The termination, cancellation or expiration of the term of this

Agreement shall not affect the obligations of Party A, Party B and Party C arising out of this Agreement that have not been fulfilled or the obligations that have been breached by each Party.

**Article XV Prohibition of Assignment**

1. All rights and obligations of Party C under this Agreement shall not be assigned or sublicensed to any third party (including affiliates) without Party A's written consent. If Party C violates this Agreement, Party A may terminate this Agreement without prior notice and request Party C to bear the liability for damages.
2. If Party C intends to establish another company to be responsible for the development of the Licensed Technology in the future, Party C shall notify Party A in writing 30 days in advance, and only after Party A agrees to sublicense or sign another license agreement, may transfer the relevant technical data to such company for use.

**Article XVI Amendment of Agreement**

This Agreement may be amended and supplemented in writing by agreement of the three parties and shall be attached to this Agreement in writing signed by the three parties as part of this Agreement and shall supersede the original provisions as amended and supplemented.

**Article XVII Governing Law and Dispute Resolution**

1. This Agreement shall be construed and governed by the laws of the Republic of China. The three parties agree to resolve any doubt or dispute arising out of this Agreement or this Agreement in good faith.
2. In the event of any dispute arising out of this Agreement, the parties agree that the [Taiwan Hsinchu District Court / Taiwan Shilin District Court] shall be the exclusive courts of first instance.

**Article XVIII Contact Method**

1. Notices or requests relating to this Agreement shall be served in writing on the following places and persons (hereinafter referred to as the “Contact Person”) and shall be deemed to have been served on such party upon delivery to such Contact Person:

Party A Contact Person:

Tel:

Address:

E-Mail:

Party B Contact Person:

Title:

Tel:

Address:

E-Mail:

Party C Contact Person:

Title:

Tel:

Fax:

Address:

E-Mail:

2. If there is a change in the Contact Person or contact information of any of the three parties, the other two parties shall be notified in writing and informed of the update.

**Article XIX Other**

1. The headings of this Agreement and each Article are for convenience only and shall not be construed to limit or affect the meaning of their contents.
2. If any provision of this Agreement is held to be invalid by law, the other provisions shall continue to be valid.
3. The attachments are considered part of this Agreement, but in case of conflict with this Agreement, this Agreement shall take precedence.

4. The original of this Agreement shall be executed in triplicate, and each party A, B and C shall keep one original copy each.

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Confidential

**Contractors:**

**Party A:** National Yang Ming Chiao Tung University (Seal)

Representative: Lin Qi-Hong (Signature)

Title: President

Address: No. 1001, Daxue Rd., East Dist., Hsinchu City 30010

GUI Number: 87557573

**Party B:** (Signature)

Title: Professor of Department of \_\_\_\_\_, NYCU

Address:

**Party C:** (Seal)

Representative: (Signature)

Title:

Address:

GUI Number:

Date: \_\_\_\_\_, 2022



# Appendix 1 Content of the Licensed Technology

## 1. Description of the Licensed Technology:

Intellectual property type:

- Know-how;
- Patent right
  - Taiwan : Application/certificate number:
  - U.S.A. : Application/certificate number:
  - China : Application/certificate number:
  - PCT : Application/certificate number:
- Copyright ( Program  Software)
- Other: \_\_\_\_\_

Summary of licensed technical content:

Confidential

## Appendix 2      Development Plan

Technology Development Timeline	Time Schedule 1	Estimated Time to Achieve
	Time Schedule 2	Estimated Time to Achieve
	Time Schedule 3	Estimated Time to Achieve
	Time Schedule 4	Estimated Time to Achieve
	Time Schedule 5	Estimated Time to Achieve
	Time Schedule 6	Estimated Time to Achieve
Expected Production Items		
Product Launch Time	It is expected that the products developed using this technology will be available in ____ years.	
Future Market Analysis		
Future Marketing Strategy		
Future Cost and Price Analysis		
Evaluation of Investment Opportunity and Amount		