

University of Tennessee College of Law

Legal Scholarship Repository: A Service of the Joel A. Katz Law Library

Transactional Matter Files

Software License UTRF & iCare Draft 11-12-09

Follow this and additional works at: https://ir.law.utk.edu/transactionalmatter_files

SOFTWARE LICENSE

between

UNIVERSITY OF TENNESSEE RESEARCH FOUNDATION

and

ICARE, LLC

This Software License ("Agreement") is made effective as of the ____ day of _____, 200__ (the "Effective Date"), between the UNIVERSITY OF TENNESSEE RESEARCH FOUNDATION, a Tennessee non-profit corporation having an address at UT Conference Center, Suite 211, 600 Henley Street, Knoxville, Tennessee 37996-4122 ("UTRF"), and ICARE, LLC, a Tennessee limited liability company with its principal place of business at

(^{"Licensee"})
2450 E J Chapman Drive, Knoxville, TN 37996.

RECITALS

WHEREAS, UTRF has been assigned by the Authors the copyright rights that exist as of the Effective Date in the Licensed Software, defined below; and

WHEREAS, Licensee desires to obtain a license to the Licensed Software, and UTRF desires to grant such a license, upon the terms and conditions set forth herein,

IT IS THEREFORE AGREED between the parties as follows:

1. **DEFINITIONS.** As used in this Agreement, these terms shall have the following definitions:

1.1 "Authors" means

(Matt, Tom) Yo, Xueping [in their capacity as authors not as iCare partners]

1.2 "End User" means any third party who is granted the right to access Licensed Software for its own personal use and without the right to copy, publish, distribute, or sublicense the Licensed Software or use the Licensed Software for commercial purposes.

1.3 "Enhancement" means, with regard to the Licensed Software, any functional revision, derivative work, release, update, correction, patch, modification or "bug fix".

1.4 "Field of Use" means nursing and nursing education.

- expand "any healthcare field to include vet"

1.5 "Gross Receipts" means all amounts received by Licensee, whether in the form of rentals, license fees, sales price, or otherwise, for the right to use Licensed Software or any part thereof, including all amounts paid for installation, maintenance, service, training, and customization, but excluding sales taxes and freight delivery charges if separately enumerated on the invoice.

1.6 "Indemnified Party" shall have the meaning set forth in Section 11 hereof.

1.7 "Institutional User" means any third party who is granted the right to make the Licensed Software available to End Users on a Server owned or controlled by such third party.

1.8 "License Issue Fee" shall have the meaning set forth in Section 3.1 hereof.

1.9 "Licensed Software" means (a) the computer program(s) developed at UT and assigned to UTRF constituting the iCare Electronic Health Record software tool and related materials set forth in Appendix A; and (b) any Enhancements assigned and delivered to UTRF under Section 2.3; and (c) any Enhancements made available to Licensee under Section 2.6.; and (d) any Enhancements assigned and delivered to UTRF under Section 4.

1.10 "Server" shall mean the device on which the Software resides (designated by type, serial number, and location) and which may be accessed by an End User for the purpose of using the Licensed Software.

1.11 "Territory" means the world.

1.12 "UT" means The University of Tennessee.

2. GRANT OF LICENSE.

2.1 Subject to the provisions of this Agreement, UTRF hereby grants to Licensee an exclusive commercial license, limited to the Territory and the Field of Use, under the copyright rights to the Licensed Software:

(a) to make derivative works based on the Licensed Software; and

(b) to reproduce, sell and distribute Licensed Software in the Territory for use by End Users and Institutional Users in the Field of Use as permitted under Section 2.2 hereof.

The parties agree that subject to the rights reserved to UTRF and UT and the remaining provisions of this Agreement, the term "exclusive" as used herein, means that during the term of this Agreement, UTRF shall not grant any commercial license in the Licensed Software to a third party in the Field of Use in the Territory that would conflict with the rights granted herein to Licensee. It is understood and agreed that a third party's unauthorized practice of the Licensed Patents or Licensed Know-How shall not be, and shall not be considered a breach of this Agreement by UTRF.

2.2 Licensee may grant sublicenses only (a) to End Users to access the Licensed Software for their own personal use on a Server owned or controlled by Licensee but not to copy, publish, distribute, or sublicense the Licensed Software or use the Licensed Software for commercial purposes and (b) to Institutional Users to install the Licensed Software on a Server owned or controlled by such Institutional User and to make the Licensed Software available to End Users on such Server but not otherwise to copy, publish, distribute, or sublicense the Licensed Software or use the Licensed Software for any other commercial purposes. All sublicenses must be in writing and shall be non-exclusive. LICENSEE shall provide UTRF with a copy of each executed sublicense to an Institutional User within thirty (30) days of its execution and shall provide UTRF with a copy of each executed sublicense to an End User upon request. Any sublicense that does not conform to this Article will be voidable at UTRF's sole discretion, and shall be deemed a breach of this Agreement by Licensee giving UTRF the right to terminate under Section 8.3.

2.3 The copyright to all Enhancements created by or for Licensee is hereby assigned by Licensee to UTRF and hereby licensed by UTRF to Licensee as part of the Licensed Software. During the Term of this Agreement, Licensee shall deliver to UTRF at least once each calendar half-year a current copy of the source code and a current copy of the object code (in machine-readable form) for the Licensed Software incorporating any such Enhancements.

2.4 UTRF hereby reserves for itself and UT the perpetual, royalty-free right to practice, use, copy, distribute, ~~sell~~ and make derivative works of the Licensed Software for non-profit educational, research, and academic purposes throughout the world, including, without limitation, the right to grant licenses to End Users to access the Licensed Software for their own use on a Server owned or controlled by UTRF and/or UT. For purposes of clarity, during the term of this Agreement, neither UTRF nor UT shall have the right to grant licenses in the Licensed Software to Institutional Users. All rights in the Licensed Software not specifically granted to the Licensee are retained by UTRF.

not in competition with iCare

2.5 Licensee understands that the Licensed Software may have been developed under a funding agreement with the government of the United States of America, and, if so, that the government may have certain

UT system will have access to iCare in its original form → only UTRF has access to enhancements + updates

rights relative thereto. This Agreement is explicitly made subject to the government's rights under any such government agreement and under any applicable law or regulation. To the extent that there is a conflict between any such government agreement, law, or regulation and this Agreement, the provisions of such government agreement, law, or regulation shall prevail.

2.6 In the event that any Enhancements to the Licensed Software are developed by one or more of the Authors in the course of their employment by UT and assigned and delivered to UTRF by UT during the term of this Agreement, UTRF will make such Enhancements available to Licensee in the same form (i.e., source code and/or object code) that such Enhancements are delivered to UTRF.

3. CONSIDERATION.

3.1 Subject to all the provisions of this Section 3.1, as a license issue fee ("License Issue Fee") in consideration of the execution of this Agreement, Licensee shall, within thirty (30) days after the Effective Date, ~~6.75%~~ complete all action required to issue UTRF ten percent (10%) of Class ____ Units in Licensee ("Units") and shall provide UTRF with a Unit Certificate evidencing its ownership of such Units in writing and provide UTRF copies of Licensee's Articles of Organization, Licensee's Operating Agreement, and Licensee's Joinder Agreement evidencing UTRF's admission as a member in Licensee and as a party to said Operating Agreement.

operating agreement w/ contribution reflected

what does mean by j.a?

(a) ~~Licensee shall not maintain or create any class of equity security with superior rights or preferences with regard to distributions of profits and/or losses and/or upon liquidation and dissolution to the Units issued to UTRF, provided, however, Licensee may create a class of equity securities with superior rights or preferences to UTRF's Class B Units in connection with any equity investment in Licensee of \$1 million or more, so long as UTRF's equity interest is treated on par with the equity interests of, and UTRF is granted rights and privileges equal to, the holders of a majority of Licensee's equity interests immediately prior to such investment, except with respect to voting rights.~~

(b) Licensee represents to UTRF as follows:

(i) Licensee is validly organized and existing pursuant to applicable state law; and

(ii) Licensee has completed, or will have completed by the time UTRF's Units are issued, all necessary and appropriate company action to make UTRF a member of Licensee as set forth in this Agreement; and

(iii) UTRF's Units are, or will be by the time UTRF's Units are issued, validly issued, fully paid, and are not subject to any assessments or charges; and

(iv) Information provided, or to be provided, to UTRF pursuant to Section 5.4 is true and correct to the best of Licensee's knowledge.

(c) UTRF agrees to execute and deliver a Joinder Agreement in form reasonably acceptable to counsel for UTRF containing the usual and customary investment representations as appropriate for issuance of UTRF's Units.

(d) Licensee shall provide UTRF with the documents identified in Section 3.1 when action is completed making UTRF a member of Licensee. Licensee shall annually provide UTRF with a copy of: its audited financial statements (in years Licensee does not have audited financial statements, Licensee shall provide UTRF with a copy of its unaudited financial statements, certified by an officer of Licensee); any annual report to required by the state in which Licensee is organized; any annual report to the members; and minutes of its annual members meeting; and any other information generally made available to LICENSEE's members.

(e) Licensee shall neither take nor permit any action that would have the affect of diluting UTRF's equity interest unless and until Licensee has received total bona fide equity investment in excess of \$500,000.00.

*matching right - see Harry's email
- matching investments*

(f) Beginning with the sixth (6th) anniversary of the Effective Date, Licensee shall not consent to any transfer of its equity interests, and Licensee shall not issue additional equity interests to any party, unless UTRF has had the option at the same time as part of the same transaction to transfer its proportionate share of its Units for the same consideration. UTRF shall have thirty (30) days after full notice of the details of such transaction to exercise its option to participate in the transaction.

(g) By notice in writing to Licensee, UTRF shall have the right to put its Units to Licensee during the thirty (30) day period beginning with the tenth (10th) anniversary of the Effective Date, and Licensee shall be obligated to redeem UTRF's Units. Unless the parties agree otherwise, the exercise price for this option shall be determined by appraisal by a qualified independent appraiser. Unless the parties otherwise agree, the appraiser shall be selected by two appraisers, one each designated by each party. The expense of the appraisal shall be split between Licensee and UTRF.

(h) The provisions of this Article 3.1 shall survive the termination of the Agreement, and shall continue in force and effect as long as UTRF holds Units in Licensee.

3.2 Beginning on the second (2nd) Anniversary of the Effective Date, Licensee agrees to pay UTRF non-refundable royalties ("Running Royalties") in the amount of ten percent (10%) of Gross Receipts. ~~7.5%~~ 6.5

4. [July 1st 2012] sales made on or after July 1st
DEVELOPMENT AND DILIGENCE.

4.1 Licensee shall be responsible for all aspects of the marketing of Licensed Software including, without limitation, all sales functions, promotion, delivery, invoicing and collection. Licensee will at all times use its best efforts to promote and market Licensed Software throughout the Territory in the Field of Use. ~~Word? - prob not necessary~~

4.2 In addition, Licensee will use its best efforts to meet the following milestones ("Diligence Milestones"):

(a) First Diligence Milestone: Prior to the expiration of thirty (30) days after the Effective Date, Licensee will enter into a contract with an established non-affiliated third-party software developer reasonably acceptable to UTRF ("Developer") to develop and deliver to Licensee a fully-functional beta version of the Licensed Software in both source code and object code (machine readable form) that preserves all existing functionality of the Licensed Software and includes, at a minimum, a user interface that links the user with data records on a data server, two-way exchange of data, context-sensitive response to user inputs, and user documentation. In addition, such contract must provide for ownership by UTRF of copyright in all new versions or other Enhancements of the Licensed Software made pursuant to such contract, which must be approved in advance by UTRF, such approval not to be unreasonably withheld.

(b) Second Diligence Milestone: Prior to the expiration of four (4) months after the Effective Date, Licensee shall deliver to UTRF a beta version of the Licensed Software in both source code and object code (machine readable form) that meets all the criteria set forth in the First Diligence Milestone. Upon timely achievement of the Second Diligence Milestone, UTRF will pay the amount due to the Developer under the software development contract approved by UTRF, up to a maximum of Ten Thousand Dollars (\$10,000). *If paying the developer, then probably would be up to -*

(c) Third Diligence Milestone: Prior to the expiration of eight (8) months after the Effective Date, Licensee shall complete and deliver to UTRF a comprehensive business plan for the commercialization of the Licensed Software. *If payi*

(d) Fourth Diligence Milestone: Prior to the expiration of ten (10) months after the Effective Date, Licensee will have executed at least three (3) agreements with institutions for beta testing of the Licensed Software. *care then market*

(e) Fifth Diligence Milestone: Prior to the expiration of twenty-four (24) months after the Effective Date, Licensee will have entered into at least one sublicense with a non-affiliated Institutional User. *\$10,000*

(f) Sixth Diligence Milestone: On or before the date indicated below, Licensee will have cumulative Gross Receipts equal to or exceeding the indicated amount:

DATE	AMOUNT
Second anniversary of Effective Date	\$25,000
Third anniversary of Effective Date	\$50,000
Fourth anniversary of Effective Date	\$100,000

4.3 Licensee will notify UTRF in writing of the achievement of each Diligence Milestone within thirty (30) days thereafter, including sufficient information for UTRF to determine whether such Diligence Milestone has been fully accomplished, and Licensee will provide UTRF with all relevant information requested by UTRF pertaining to the achievement of each Diligence Milestone. Failure to achieve any Diligence Milestone on or before the specified date shall be a material breach of this Agreement.

4.4 Until the achievement of the Sixth Diligence Milestone, Licensee shall provide UTRF with written Development Reports summarizing Licensee's development activities since the last Development Report. ~~Licensee agrees to provide each Development Report to UTRF on or before the last day of March and the last day of September each year, and shall set forth in each Development Report sufficient detail to enable UTRF to ascertain Licensee's progress toward meeting the Diligence Milestones. UTRF reserves the right to audit Licensee's records relating to the development activities required hereunder. Such record keeping and audit procedures shall be subject to the procedures and restrictions set forth in Section 5 for auditing the financial records of Licensee.~~

4.5 Licensee agrees to and warrants that it has, or will obtain, the expertise necessary to develop the Licensed Software for license and sale to the commercial market and that it intends to do so. Licensee acknowledges that any failure by Licensee to make timely submission to UTRF of any notification under Section 4.3 or any Development Report under Section 4.4 or the providing of any false or misleading information to UTRF regarding Licensee's development activities hereunder, shall be a material breach of this Agreement.

5. ACCOUNTING; PAYMENTS.

5.1 Running Royalties shall be paid on a semi-annual basis, with such amounts due and received by UTRF on or before the thirtieth day following the end of the half-year (six-month) period ending on the last day of December and June in which such amounts were received. In other words, Running Royalties received from the first day of July through the last day of December will be due and payable on or before January 30 and Running Royalties received from the first day of January through the last day of June will be due and payable on or before July 30. shall this interest provision be construed as a grant of permission for any payment delays.

5.2 LICENSEE shall not pay royalties into any escrow or other similar account.

5.3 In the event any payments are not received by UTRF when due, LICENSEE shall (i) pay to UTRF interest on the overdue balance at the lesser of one percent (1%) per month or the maximum rate of interest allowed by law, and (ii) pay all reasonable collection costs at any time incurred by UTRF in obtaining payment of amounts past due, including reasonable attorneys fees. The payment of such interest and/or collection costs shall not foreclose UTRF from exercising any other rights it may have as a consequence of the lateness of any payment. In no event shall this provision be construed as a grant of permission for any payment delays.

5.4 All payments to UTRF shall be paid in United States dollars at its address in Knoxville, Tennessee, or at such other place as UTRF may reasonably designate consistent with the laws and regulations controlling in the

United States or any foreign country. If any currency conversion shall be required in connection with the payment of royalties hereunder, such conversion shall be made by using the exchange rate listed in the Wall Street Journal for major New York banks on the last business day of the calendar half year to which such royalty payments relate. If LICENSEE is required by law, rule or regulation to withhold taxes from the types of payment due UTRF hereunder, the parties shall (a) deduct those taxes from the amount otherwise remittable to UTRF hereunder, (b) pay such taxes to the proper taxing authority, and (c) send evidence of the obligation together with proof of payment to UTRF within thirty (30) business days following that payment.

5.5 If an examination of records provided under Article 6.9 of this Agreement reveals a payment shortage, LICENSEE shall promptly pay UTRF the amount of the shortage and the interest accrued on the shortage at the rate set forth in Article 6.4 of this Agreement, and if the shortage is greater than 5% of the total amount due under any one royalty payment, LICENSEE shall also promptly reimburse UTRF for the reasonable cost of examination.

5.6 LICENSEE's failure to pay any undisputed amounts owed to UTRF shall constitute an event of default and UTRF shall have the option to terminate this Agreement in accordance with the terms and provisions of Article 8.3 of this Agreement.

5.7 Receipt or acceptance by UTRF of any payment or report under this Agreement shall not prevent UTRF from subsequently challenging the validity or accuracy of such payment or report.

5.8 A full accounting showing how any Running Royalties have been calculated shall be submitted to UTRF on the earlier of the date of each payment is due or the date such payment is made. Such accounting shall be on a per-country and product line, version or trade name basis. In the event no payment is owed to UTRF, a statement setting forth that fact shall be supplied to UTRF.

6. WARRANTIES; NEGATION OF WARRANTIES.

6.1 UTRF Warranties.

(a) UTRF warrants that it owns title to all of the copyright rights licensed hereunder or otherwise has the right to grant the licenses granted under this Agreement. However, NOTHING IN THIS AGREEMENT SHALL BE CONSTRUED AS:

(i) A WARRANTY OR REPRESENTATION BY UTRF AS TO THE VALIDITY OR THE SCOPE OF PROTECTION OF THE COPYRIGHT ON THE LICENSED SOFTWARE;

(ii) A WARRANTY OR REPRESENTATION THAT THE MANUFACTURE, USE, SALE, IMPORT, COPYING, DISTRIBUTION, OR PUBLICATION OF THE LICENSED SOFTWARE IS OR WILL BE FREE FROM INFRINGEMENT OF THE PATENT OR COPYRIGHT RIGHTS OF THIRD PARTIES;

(iii) AN OBLIGATION TO BRING OR PROSECUTE ACTIONS OR SUITS AGAINST THIRD PARTIES FOR INFRINGEMENT; OR

(iv) AN OBLIGATION TO FURNISH TECHNICAL INFORMATION, DOCUMENTATION, OR KNOW-HOW OTHER THAN (x) THE SOURCE CODE OF THE LICENSED SOFTWARE AND THE DOCUMENTATION, IF ANY, LISTED ON APPENDIX A AS OF THE EFFECTIVE DATE AND (y) ENHANCEMENTS AS REQUIRED BY SECTION 2.6; OR

(v) AN OBLIGATION TO FURNISH ANY SERVICES OR PROVIDE ERROR CORRECTION OR ANY OTHER SUPPORT WHATSOEVER.

(b) OTHER THAN THE SPECIFIC WARRANTY IN THE FIRST SENTENCE OF SECTION 6.1(a), UTRF MAKES NO REPRESENTATIONS AND EXTENDS NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED, INCLUDING WITHOUT LIMITATION MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE.

6.2 Licensee Warranties. Licensee warrants that:

(a) it has the power to enter into this Agreement;

(b) it will take no action that would negatively affect the enforceability of the copyright rights of UTRF in the Licensed Software;

(c) ~~it will require an effective copyright notice~~ to appear printed on all media, displayed as a part of the user interface during execution, and in the program code, if possible, of all copies of the Licensed Software; and

(d) it will consider all source code of the Licensed Software delivered to or developed by or for Licensee to be trade secret information. Licensee will not permit disclosure of the source code to any person other than employees of Licensee and shall take all reasonable measures to maintain the confidentiality of the source code including at least the same measures that Licensee takes to protect its own trade secrets.

7. RECORDKEEPING.

7.1 Licensee shall keep books and records sufficient to verify the accuracy and completeness of Licensee's accounting referred to above, including without limitation, inventory, purchase and invoice records relating to the Licensed Software or their manufacture. Such books and records shall be preserved for a period not less than six (6) years after they are created during and after the term of this Agreement.

7.2 Licensee shall take all steps necessary so that UTRF may within thirty (30) days of its request review and copy all the books and records at a single United States location to verify the accuracy of Licensee's accounting. Such review may be performed by any staff member of UTRF as well as by any attorney or registered CPA designated by UTRF, upon reasonable notice and during regular business hours.

7.3 If a royalty payment deficiency is determined, Licensee shall pay the royalty deficiency outstanding within thirty (30) days of receiving written notice thereof, plus interest on outstanding amounts as described in Section 3.

8. TERM AND TERMINATION.

8.1 Subject to early termination by Licensee under Section 8.2 or by UTRF under Section 8.3, the term of this license shall begin on the Effective Date of this Agreement and continue until the date that is twenty (20) years after the Effective Date of this Agreement, at which time it shall terminate.

8.2 Licensee may terminate this Agreement at any time by giving at least ninety (90) days written and unambiguous notice of such termination to UTRF. Such a notice shall be accompanied by a statement of the reasons for termination.

8.3 If Licensee at any time defaults in the timely payment of any monies due to UTRF or the timely submission to UTRF of any Development Report, or commits any other breach or default of any other covenant herein

contained, and Licensee fails to remedy any such breach or default within thirty (30) days after written notice thereof by UTRF, UTRF may, at its option, terminate this Agreement by giving notice of termination to Licensee. UTRF at its option may also terminate this Agreement upon notice to Licensee if the payment of Running Royalties under Section 3, once begun, falls below Twelve Thousand Five Hundred Dollars (\$12,500) for more than four (4) half-year periods as set out in Section 5.1.

8.4 Upon the termination of this Agreement, Licensee shall remain obligated to provide an accounting for and to pay Running Royalties earned up to the date of the termination. Termination of this Agreement shall not terminate any sublicense granted to an End User or an Institutional User; however, any royalties due from such End User after termination of this Agreement shall be paid directly to UTRF.

9. ASSIGNMENT.

9.1 This Agreement may not be transferred to assigned by Licensee in whole or in part without the prior written consent of UTRF.

10. PROTECTION; ENFORCEMENT.

10.1 Until the expiration of forty-eight (48) months after the Effective Date, UTRF will be responsible at its own expense for copyright registration of the Licensed Software in the United States, limited to the version of the Licensed Software in existence as of the Effective Date as described in Appendix A and one (1) beta version delivered to UTRF by Licensee in both source code and object code (machine readable form) that meets all the criteria set forth in the First Diligence Milestone and the Second Diligence Milestone. Thereafter, copyright registration for the Licensed Software in the Territory shall be the responsibility of the Licensee and at the Licensee's expense.

10.2 In the event of any infringement of any rights granted to Licensee hereunder, Licensee shall have, after consultation with UTRF, the first option to bring any action for such infringement on behalf of itself and UTRF, and UTRF shall cooperate fully with Licensee in such action. Licensee agrees to reimburse UTRF for ordinary and necessary out-of-pocket expenses incurred by UTRF in connection with such cooperation. In the event Licensee elects to bring such action, Licensee shall bear the expenses of the action. Recoveries or reimbursements from such action shall first be applied to reimburse UTRF for its actual costs not previously reimbursed by Licensee and to reimburse Licensee for its actual costs sustained in connection with such action. Any remaining recoveries or reimbursements shall be shared equally by Licensee and UTRF. If Licensee declines to bring any such action, Licensee shall promptly so notify UTRF, and UTRF may proceed and shall bear all expenses of the action, and shall be entitled to retain all proceeds of such action. Licensee shall cooperate fully with UTRF at UTRF's request, and UTRF agrees to reimburse Licensee for ordinary and necessary out-of-pocket expenses incurred by Licensee in connection with such cooperation.

11. INDEMNIFICATION; INSURANCE.

11.1 Licensee shall, at all times during the term of this Agreement and thereafter, indemnify, defend and hold harmless the Authors and UTRF, UT, and their respective employees, students, directors, trustees, and agents (each an "Indemnified Party") against all claims and expenses, including legal expenses and reasonable attorneys fees, 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 arising out of or resulting from the marketing, development, production, manufacture, sale, use, sublicense, copying, publishing or advertisement of Licensed Software or arising from any right or obligation of Licensee hereunder. Notwithstanding the above, the Indemnified Parties shall each have the right to retain counsel of their own to defend their respective interests. Licensee shall not enter into any settlement (i) without the prior approval of UTRF, which shall not be unreasonably withheld, if such settlement affects the rights of UTRF hereunder; or (ii) without the prior approval of the Indemnified Party(ies), which shall not be unreasonably withheld, if such settlement contains an admission of fault or wrongdoing on the part of such Indemnified Party(ies);

11.2 Licensee warrants that at all times during the term of this Agreement, it will maintain liability insurance coverage appropriate to the risk involved in commercializing Licensed Software hereunder and that such insurance coverage lists UTRF, UT, and the Authors as additional insureds and requires at least thirty (30) days prior

**remember - capacities are different/separate*
What is usual and customary or policy of the type that and customary for the type of business and size of business. necessary to cover
care LLC indemnifies UTRF, and Authors (in capacity as authors)
insurance coverage appropriate to the risk involved in commercializing Licensed Software hereunder and that such insurance coverage lists UTRF, UT, and the Authors as additional insureds and requires at least thirty (30) days prior
particular

written notice to UTRF of any change in or cancellation of the insurance coverage. Within sixty (60) days after the execution of this Agreement and thereafter annually between January 1 and January 31 of each year, Licensee will present evidence to UTRF that the coverage is being maintained with UTRF, UT, and the Authors listed as additional insureds.

12. USE OF NAMES.

Licensee shall not use UTRF's name, UT's name, or the name of any of the Authors without the prior written approval of the entity or person whose name is being used. *which shall not be unreasonably withheld*

13. MISCELLANEOUS.

Get written approval
what form to take?
13.1 This Agreement shall be construed in accordance with the internal laws of the State of Tennessee. If any provisions of this Agreement are or shall come into conflict with the law or regulations of any jurisdiction or any governmental entity having jurisdiction over the parties or this Agreement, those provisions shall be deemed automatically deleted, if such deletion is allowed by relevant law, and the remaining terms and conditions of this Agreement shall remain in full force and effect. If such a deletion is not so allowed or if such a deletion leaves terms thereby made clearly illogical or inappropriate in effect, the parties agree to substitute new terms as similar in effect to the present terms of this Agreement as may be allowed under the applicable laws and regulations. The parties hereto are independent contractors and not joint venturers or partners.

13.2 The parties shall attempt in good faith to resolve any claims, disputes, and controversies that may arise under, out of, or in connection with this Agreement quickly, amicably and voluntarily. Except for the right of either party to apply to a court of competent jurisdiction for a temporary restraining order, a preliminary injunction, or other equitable relief to preserve the status quo or to prevent irreparable harm, any and all claims, disputes or controversies arising under, out of, or in connection with this Agreement that the parties do not resolve voluntarily, shall be resolved upon thirty (30) days written notice of either party to the other by final and binding arbitration in Knoxville, Tennessee under the Commercial Arbitration Rules of the American Arbitration Association then in effect. The arbitrator(s) shall have no power to add to, subtract from or modify any of the terms or conditions of this Agreement, nor to award punitive damages. The prevailing party in any such arbitration shall, in addition to recovering reasonable out-of-pocket costs of the arbitration, be entitled to an award of reasonable attorneys fees incurred in connection with the arbitration, with any action necessary to perfect the arbitration award as a judgment, and for any collection action required to secure payment of any arbitration award. Any award rendered in such arbitration may be entered and enforced by either party in either the courts of the State of Tennessee or in the United States District Court for the Eastern District of Tennessee, to whose jurisdiction for such purposes UTRF and Licensee each hereby irrevocably consents and submits, or in any other United States court having jurisdiction.

13.3 LICENSEE hereby gives written assurance (a) that it will comply with all United States export control laws and regulations, including without limitation all Export Administration Regulations of the United States Department of Commerce, (b) that it will require written assurance of such compliance from each Sublicensee, (c) that it bears sole responsibility for its own violation of such laws and regulations, and (d) that it will indemnify, defend, and hold UT and UTRF and the Indemnified Parties harmless in accordance with Section ____ for the consequences of any such violation by itself of any Sublicensee.

13.4 A facsimile of this Agreement shall be deemed a binding original; if faxed, the Party faxing the Agreement shall then provide a complete and signed original hard copy to the other Party by regular mail within three (3) business days.

13.5 The headings and recitals contained in this Agreement are for reference purposes only and shall not affect in any way the meaning or interpretation of this Agreement.

14. **NOTICES.** Any payment, notice or other communication required or permitted hereunder (hereinafter "notice") shall be in writing and shall be hand-delivered, sent by overnight courier, mailed by certified United States

mail, return receipt requested, or sent by email or facsimile, to the address(es) given below or to such other address(es) as the parties may hereafter specify in writing. Notice shall be deemed given and received five (5) days after being deposited with the U.S. Postal Service certified mail (postage prepaid and return receipt requested), or if notice is hand-delivered or sent by overnight courier, upon the date of actual delivery, or if sent by facsimile or email, upon the date the recipient Party acknowledges receipt in writing, by email or otherwise. An email notice shall be given concurrently to up to three email addresses provided by the recipient party and the first acknowledgment of receipt from the recipient party shall establish the date on which such notice is given.

UTRF:

If notice is given by means other than email, to:

University of Tennessee Research Foundation
UT Conference Center, Suite 211
600 Henley Street
Knoxville, TN 37996-4122
USA
Attn: President

With copy to:

John A. Hopkins, Ph.D., P.E.
UT Conference Center, Suite 211
600 Henley Street
Knoxville, TN 37996-4122
USA

If notice is given by email, to:

jhop@utk.edu
jlsnider@utk.edu

LICENSEE:

If notice is given by means other than email, to:

15. INTEGRATION.

15.1 The Parties hereto acknowledge that this Agreement sets forth the entire Agreement and understanding of the Parties hereto as to the subject matter hereof, and shall not be subject to any change or modification except by the execution of a written instrument subscribed to by the Parties hereto.

15.2 The provisions of this Agreement are severable, and in the event that any provisions of this Agreement shall be determined to be invalid or unenforceable under any controlling body of the law, such invalidity or unenforceability shall not in any way affect the validity or enforceability of the remaining provisions hereof.

15.3 The failure of either Party to assert a right hereunder or to insist upon compliance with any term or condition of this Agreement shall not constitute a waiver of that right or excuse a similar subsequent failure to perform any such term or condition by the other Party.

IN WITNESS WHEREOF, the parties hereto have duly executed this Agreement on the dates indicated below.

UNIVERSITY OF TENNESSEE RESEARCH FOUNDATION ("UTRF")

By: _____

Date _____

Name: John A. Hopkins

Title: Vice President

ICARE, LLC ("Licensee")

By: _____

Date _____

Name: _____

Title: _____

APPENDIX A
to
EXCLUSIVE SOFTWARE LICENSE
between
UNIVERSITY OF TENNESSEE RESEARCH FOUNDATION
and
QMS, INC.

LICENSED SOFTWARE

APPENDIX B
to
EXCLUSIVE SOFTWARE LICENSE
between
UNIVERSITY OF TENNESSEE RESEARCH FOUNDATION
and
QMS, INC.

MILESTONES

Licensee will meet the following milestones (each a "Diligence Milestone") according to the schedule set forth below:

- A. On or before _____, Licensee shall _____ ("Diligence Milestone A").
- B. ("Diligence Milestone B").
- C. ("Diligence Milestone C").