

*JFD gr. v. State*

*File*

LICENSE AGREEMENT

THIS LICENSE AGREEMENT entered into this 31<sup>st</sup> day of May, 1962, by and between the UNIVERSITY OF ILLINOIS FOUNDATION, a non-profit corporation organized and existing under and by virtue of the laws of the State of Illinois, hereinafter referred to as "LICENSOR," and JFD ELECTRONICS CORPORATION, a corporation organized and existing under and by virtue of the laws of the State of New York, hereinafter referred to as "LICENSEE."

WITNESSETH:

WHEREAS, LICENSOR is the owner of the entire right, title and interest in and to Letters Patent of the United States as follows:

- 2,958,081, dated October 25, 1960 -  
J. D. Dyson - entitled "Unidirectional Broadband Antennas,"
- 2,985,879, dated May 23, 1961 -  
R. H. DuHamel - entitled "Frequency Independent Antennas,"
- 3,011,168, dated November 28, 1961 -  
D. E. Isbell - entitled "Frequency Independent Unidirectional Antennas,"

as well as U. S. applications for Letters Patent of the United States, Serial No. 26,589, filed May 3, 1960 by D. E. Isbell entitled "Frequency Independent Unidirectional Antennas," Serial No. 59,671, filed September 30, 1960 by P. E. Mayes and R. L. Carrel entitled "Frequency Inde-

pendent Unidirectional Antennas," Serial No. 79,432, filed December 29, 1960 by J. D. Dyson and P. E. Mayes entitled "Circularly Polarized Omnidirectional Antenna." and Serial No.

as well as the invention set forth and described in and by each of the aforesaid Letters Patent of the United States and applications for Letters Patent of the United States; and

WHEREAS, LICENSOR holds the sole right to grant the license right herein granted and agreed to be granted; and

WHEREAS, LICENSEE is desirous of securing, for the term of years hereinafter set forth, an exclusive license to manufacture, use or sell, or to have made for its use or sale, apparatus of the type described and claimed in and by each of the aforesaid Letters Patent of the United States and applications for Letters Patent of the United States as the same is therein disclosed and set forth.

NOW, THEREFORE, in consideration of the foregoing and the mutual terms and conditions of this License Agreement and other good and valuable consideration, the receipt and sufficiency of all of which is hereby duly acknowledged, the parties hereto agree as follows:

1. LICENSOR hereby grants and agrees to grant to LICENSEE an exclusive non-transferable right and license in the United States to make, use or sell or have made for its use or sale any invention described in any of the afore-

mentioned Letters Patent as well as the aforesaid applica-  
tions for Letters Patent, the components so manufactured,  
used or sold being referred to hereafter as "Licensed  
Articles." Said exclusive license shall extend for the  
term of \_\_\_\_\_ from the date of  
allowance of one or more claims in either application  
Serial No. \_\_\_\_\_ For Serial No. \_\_\_\_\_ which cover and  
define LICENSEE's manufactured Licensed Articles. There-  
after, LICENSOR shall have the right to grant other licenses  
in the Licensed Articles, but in such event shall give at  
least ninety (90) days' notice thereof to LICENSEE, and  
LICENSEE's royalties, hereinafter provided, shall be no

*Royalties*

\_\_\_\_\_ herein provided  
shall hereafter not be in effect. The license granted  
hereunder shall extend also to any continuation, division,  
or continuation-in-part of any of said applications for  
Letters Patent and to any reissues of any of the licensed  
patents.

2. All Licensed Articles manufactured and sold  
by LICENSEE under the terms of this License Agreement shall  
carry such reasonable notice as LICENSOR shall from time  
to time request in writing and which shall comply with the  
provisions of Title 35 United States Code, Section 287.

3. LICENSEE agrees to make the following pay-  
ments to LICENSOR:

*Royalties*

The percentage royalty rate shall be computed upon the net selling price of such Licensed Articles made, used or sold by LICENSEE or made by others for its use or sale. Such royalty, however, shall be payable only upon sale of the article except in those cases in which the article is consumed by or for LICENSEE without sale. In such cases, royalties shall be computed at the normal selling price of the device. Licensed Articles made during the life of a licensed patent covering the same, but not sold until the expiration of said patent, shall be subject to royalty. In the event of cancellation of this Agreement, LICENSEE shall make a report of Licensed Articles on hand and shall pay the appropriate royalties with respect thereto. If

*Royalties*

So long as this license is exclusive, LICENSEE shall pay

*royalties*

## Royalties

4. LICENSEE may cancel this Agreement at any time upon ninety (90) days' notice in writing to LICENSOR. Termination of this Agreement pursuant to this or any other paragraph shall not relieve LICENSEE of the obligation to pay accrued royalties.

5. After termination of this Agreement LICENSEE shall not be subject to any estoppel by reason of its having been a LICENSEE.

6. LICENSEE agrees that it will render to LICENSOR with each such royalty payment, a report showing the period for which said payment is made, and the net sales upon which the royalty payment is computed. LICENSEE agrees to keep accurate accounts in sufficient detail to enable the royalties payable hereunder to be determined, and LICENSEE further agrees to permit a Certified Public Accountant selected by LICENSOR and acceptable to LICENSEE to inspect such records at reasonable times during regular business hours for the sole purpose of verifying the accuracy of the reports submitted and payments made under this License Agreement, subject to the condition that

LICENSOR shall give written notice to LICENSEE, within six (6) months following the receipt by LICENSOR of each such quarterly report and royalty payment concerning which verification is desired, and LICENSOR, through its designated Certified Public Accountant, shall proceed promptly with the inspection of said records.

7. Royalties at rates specified in paragraph 3 hereof shall be due and payable quarterly on or before the sixtieth (60th) day following the first day of each of the months of January, April, July and October for the corresponding preceding quarterly period. LICENSEE shall furnish LICENSOR, with each royalty payment, a written statement setting forth the net sales value of the Licensed Articles sold by LICENSEE during the preceding quarterly period and the amount of royalty due and payable to LICENSOR under the terms of this License Agreement, as provided by paragraph 3 hereof.

*Royalties*

8. LICENSEE may grant sublicenses hereunder providing the license payments due LICENSOR are no less

than those provided herein. In such event LICENSEE shall be responsible for royalty payments by its sublicensees. Any granted sublicenses shall terminate concurrently with this License. LICENSEE shall pay over to LICENSOR as royalty payments computed at the rates specified in subparagraphs b and c of paragraph 2 computed upon the same basis as if LICENSEE had manufactured the Licensed Article.

9. LICENSOR may cancel this Agreement upon default of LICENSEE by giving ninety (90) days' notice to do so, and unless LICENSEE cures the default complained of during such ninety (90) day period; but no such termination shall affect the obligation of LICENSEE to pay royalties or other obligations accrued before the effective date of such notice.

10. LICENSEE shall not use, publish or circulate any advertising matter or literature (other than the foregoing patent marking statement of paragraph 2 hereof upon its Licensed Articles and labels used therewith) containing a reference to the University of Illinois or to the University of Illinois Foundation except with the prior written authorization of LICENSOR as to such reference. Such written authorization may be obtained from the Executive Director of the University of Illinois Foundation, which authorization will not be unreasonably withheld.

11. LICENSOR does not warrant the validity of any Letters Patent of the United States herein licensed

and agreed to be licensed as issued upon the application for Letters Patent of the United States hereinabove identified, or any Letters Patent of the United States resulting from the filing of any divisional, reissue or continuation application thereof, nor does LICENSOR accept any liability with respect to enforcement of the said licensed Letters Patent of the United States, as herein provided, against third party infringers or any liability with respect to defending LICENSEE against infringement of any United States or foreign Letters Patent which may at any time be asserted against LICENSEE. LICENSOR agrees to hold one-half (1/2) of the royalties received in a fund to be employed for protection and enforcement of the licensed patents against infringers, such accumulation to be made until such fund reaches ten thousand dollars (\$10,000.00) and thereafter for a period of five (5) years from the date hereof or until no substantial infringement exists, whichever date shall be later. At the end of the aforesaid period, LICENSOR may at its discretion disburse said fund into its own account. In the event that LICENSOR does not reasonably enforce said Letters Patent, LICENSEE shall have the right, if it desires and at its own expense, to institute and prosecute claims against third parties for infringement and may apply one-half (1/2) of royalties to apply against the expense of the same, and may retain any recoveries therein.



12. If any licensed claim is held invalid by the final decision of a court or appropriate tribunal, LICENSEE shall not be required to pay royalties hereunder with respect to the subject matter of that claim unless and until the final decision of another appropriate court finds such claim patentable.

13. In the event of breach of this License Agreement by either party hereto, the party not in default may at its election terminate the same by ninety (90) days' written notice to such effect served upon the other party, the notice to briefly set forth the breach or default relied upon to effect termination. In the event the party in default makes full restitution for the breach or default relied upon within said ninety (90) day period, then this License Agreement shall continue in full force and effect.

14. It is agreed that the rights herein granted and agreed to be granted and the obligations and liabilities here imposed and incurred shall apply with equal force and effect to any wholly owned subsidiary now or hereafter directly owned or controlled by LICENSEE and that the acts done by or on behalf of such subsidiary shall, for the purpose of this Agreement, be deemed to be the acts done by the LICENSEE, as the party directly owning or controlling such subsidiary, but nothing contained herein shall be construed as granting to any subsidiary

any rights or advantages which shall continue after such subsidiary has ceased to be a subsidiary, or has ceased to be directly or indirectly owned or controlled by LICENSEE as herein contemplated. In the event of a sale between LICENSEE or any subsidiary of LICENSEE and a corporation acting otherwise than at arms length, the net selling price shall be computed with respect to the first uncontrolled sale to a person who is acting at arms length.

15. It is further agreed that if LICENSEE becomes bankrupt or insolvent or enters into any composition with creditors, or invokes the provisions of any bankruptcy or insolvency statute, or any law for the relief of debtors now in force or hereafter enacted, this License Agreement and the licenses and rights here granted to LICENSEE shall forthwith terminate and cease.

16. It is further understood and agreed that this License Agreement is not assignable by LICENSEE without the written consent of LICENSOR and that LICENSEE cannot release itself from the obligations hereunder by any assignment or transfer of any hereunder licensed United States Letters Patent or any applications for Letters Patent of the United States, and that, subject to the limitations hereinbefore set forth, this License Agreement, the benefits thereof and the obligations and liabilities imposed thereby shall extend to the successors in business of each of the parties hereto.

17. In the event that this License Agreement is terminated prior to the expiration date of any Letters Patent of the United States under which a right and license is herein granted, LICENSOR agrees that LICENSEE shall have the right to sell or otherwise dispose of, within a period of one (1) year, any stock of Licensed Articles on hand as of the date of termination subject to the payment to LICENSOR of royalty as provided in paragraph 3 hereof.

18. Notices called for hereunder shall be deemed properly given if duly sent by United States first-class mail and addressed, in the case of LICENSOR, to the University of Illinois Foundation, Illini Union Building, Urbana, Illinois, and in the case of LICENSEE, to JFD Electronics Corporation, 6101 Sixteenth Avenue, Brooklyn 4, New York.

19. This Agreement is considered to have been executed and delivered within the State of Illinois and it is the intention of the parties that it shall be construed and interpreted in the light of the laws of the State of Illinois and the patent laws of the United States of America, whichever shall be applicable under the circumstances.

IN WITNESS WHEREOF, each of the parties hereto has caused this document to be executed by its duly authorized officers and with full authorization of its

managing Board of Governors or Board of Directors, as the case may be, and its corporate seal to be affixed hereon on the day, month and year first above written.

UNIVERSITY OF ILLINOIS FOUNDATION

By *J. F. Thomas*  
President

Attest:

*James C. ...*  
Secretary

JFD ELECTRONICS CORPORATION

By *Edward F. ...*  
Vice President

Attest:

*Edward F. ...*  
Secretary

*Albert Finckel*  
PRESIDENT.

*Proven to before me this 1 day of June 1964*  
*Seymour W. Geller*

SEYMOUR W. GELLER  
Notary Public, State of New York  
No. 24-1309350  
Qualified in Kings County  
Commission Expires March 30, 1963