

Instructions for Applying for A License  
To the Phi-NX Cells and Vectors

1. Please provide a paragraph describing how you plan to use the cell lines and vectors for our review. Dr. Nolan approves all uses of the cell lines and vectors. Please note the license already includes restrictions on their use.
2. Opening paragraph – Please add today’s date, your company’s name and primary address.
3. Paragraph 3.2 – Please insert Effective Date and term date of 20 years from Effective Date.
4. Paragraph 6.2 – Please add appropriate dates (first anniversary of the effective date and each anniversary date thereafter).
5. Paragraph 13 – Add the appropriate contact information for Notices for your company.
6. Have the appropriate officer of the company sign duplicate copies of the agreement.
7. Return two signed copies of the agreement with a check for the license issue royalty due under paragraph 6.1 to:

Office of Technology Licensing  
1705 El Camino Real  
Palo Alto, CA 94306  
Attention: Director

If you have any questions about completing the agreement, please call (650) 723-0651.

## NONEXCLUSIVE AGREEMENT

This Agreement between THE BOARD OF TRUSTEES OF THE LELAND STANFORD JUNIOR UNIVERSITY (“Stanford”), an institution of higher education having powers under the laws of the State of California, and \_\_\_\_\_ (“Licensee”), \_\_\_\_\_ a corporation having a principal place of business at \_\_\_\_\_, is effective on the \_\_\_\_ day of \_\_\_\_\_, 20 \_\_\_\_ (“Effective Date”).

### 1 BACKGROUND

Stanford has rights to biological material known as Phi-NX Helper-free Retrovirus Producer Lines. It was developed in the laboratory of Dr. Garry Nolan, and is described in Stanford Docket S96-139. The biological material was developed in the course of research supported by SyStemix, Inc. Stanford wants to have the biological material developed and marketed as soon as possible so that resulting products may be available for public use and benefit.

### 2 DEFINITIONS

- 1.0 “Biological Material” means the Phi-NX Helper-free Retrovirus Producer Lines, Phi-NX amphi and Phi-NX eco described in Stanford Docket S96-139, as well as any vectors listed in Exhibit A.
- 2.0 “Licensed Field of Use” means any use of Biological Material for:
  - ( ) the synthesis of recombinant retrovirus and its delivery to mammalian target cells of cloned, naturally-derived cDNA inserts as a virus supernatant, where said supernatant contains solely a retrovirus containing a single species of cDNA; said retrovirus capable of transcribing and translationally expressing a single species of cDNA gene from an operon-driven promoter.
  - ( ) The delivery of retroviral cDNA libraries, prepared from mRNA derived from natural sources, in retroviral constructs wherein using said cDNA libraries and Phi-NX cells identifies cDNAs, expressed from the retroviral constructs, and signaling systems.
- 3.0 “Licensed Products” means any product in the Licensed Field of Use derived from or made using Biological Materials. This includes pharmaceuticals or drug targets that were initially identified from screening assays in the Licensed Field of Use.
- 4.0 “Stanford Indemnitees” means Stanford and Stanford Hospitals and Clinics, and their respective trustees, officers, employees, students, and agents.

### 3 GRANT

- 1.0 **Grant.** Subject to the terms and conditions of this Agreement, Stanford grants Licensee a license to the Biological Materials in the Licensed Field of Use to make, use, and sell Licensed Products.
- 2.0 **Nonexclusivity.** The license is nonexclusive in the Licensed Field of Use beginning on (Effective Date) and expiring (20 years from Effective Date).
- 3.0 **Retained Rights.** Stanford retains title to all Biological Materials.
- 4.0 **Specific Exclusion.** Stanford does not:
  - ( ) grant to Licensee any other licenses, implied or otherwise, to any patents or other rights of Stanford regardless of whether the patents or other rights are required to exploit any Biological Material; and
  - ( ) agree to furnish to Licensee any technology or technological information other than the Biological Material or to provide Licensee with any assistance.
- 5.0 **No Transfer.** Licensee is not permitted to transfer Biological Material to any third party without prior written consent from Stanford.

### 4 SUBLICENSING

Licensee may not grant sublicenses.

### 5 GOVERNMENT RIGHTS

This Agreement is subject to Title 35 Sections 200-204 of the United States Code. Among other things, these provisions provide the United States Government with nonexclusive rights in the Licensed Patent. Licensee will ensure all obligations of these provisions are met.

### 6 ROYALTIES

- 1.0 **Issue Royalty.** Licensee will pay to Stanford a noncreditable, nonrefundable license issue royalty of \$35,000.00 upon signing this Agreement. Upon receipt of payment, Stanford will send Biological Material to Licensee.
- 2.0 **License Maintenance Fee.** Beginning \_\_\_\_\_ and each \_\_\_\_\_ thereafter, Licensee will pay Stanford a yearly license maintenance fee of \$10,000.00.
- 3.0 Licensee will make royalty payments to Stanford in U.S. Dollars.

- 4.0 **Non-U.S. Taxes.** Licensees will pay all non-U.S. taxes related to royalty payments. These payments are not deductible from any payments due to Stanford.
- 5.0 **Interest.** Any payments not made when due will bear interest at the lower of  
(a) the Prime Rate published in the Wall Street Journal plus 200 basis points  
or (b) the maximum rate permitted by law.

## 7 EXCLUSIONS AND NEGATION OF WARRANTIES

- 1.0 **Negation of Warranties.** Stanford provides Licensee the rights granted in this Agreement AS IS and WITH ALL FAULTS. Stanford makes no representations and extends no warranties of any kind, either express or implied. Among other things, Stanford disclaims any express or implied warranty:
- ( ) of merchantability, of fitness for a particular purpose,
  - ( ) of non-infringement or
  - ( ) arising out of any course of dealing.
- 2.0 **No Representation of Biological Materials.** Licensee also acknowledges that Stanford does not represent or warrant that the exploitation of Biological Material will be successful.

## 8 INDEMNITY

- 1.0 **Indemnification.** Licensee will indemnify, hold harmless, and defend all Stanford Indemnitees against any claim of any kind arising out of or related to the exercise of any rights granted Licensee under this Agreement or the breach of this Agreement by Licensee.
- 2.0 **No Indirect Liability.** Stanford is not liable for any special, consequential, lost profit, expectation, punitive or other indirect damages in connection with any claim arising out of or related to this Agreement, whether grounded in tort (including negligence), strict liability, contract, or otherwise.
- 3.0 **Workers' Compensation.** Licensee will comply with all statutory workers' compensation and employers' liability requirements for activities performed under this Agreement.
- 4.0 **Insurance.** During the term of this Agreement, Licensee will maintain Comprehensive General Liability Insurance, including Product Liability Insurance, with a reputable and financially secure insurance carrier to cover the activities of Licensee and its sublicensees. The insurance will provide minimum limits of liability of \$5,000,000 and will include all Stanford

Indemnitees as additional insureds. Insurance must cover claims incurred, discovered, manifested, or made during or after the expiration of this Agreement and must be placed with carriers with ratings of at least A- as rated by A.M. Best. Within 15 days of the Effective Date of this Agreement, Licensee will furnish a Certificate of Insurance evidencing primary coverage and additional insured requirements. Licensee will provide to Stanford 30 days prior written notice of cancellation or material change to this insurance coverage. Licensee will advise Stanford in writing that it maintains excess liability coverage (following form) over primary insurance for at least the minimum limits set forth above. All insurance of Licensee will be primary coverage; insurance of Stanford and Stanford Hospitals and Clinics will be excess and noncontributory.

## **9 STANFORD NAMES AND MARKS**

Licensee will not identify Stanford in any promotional statement, or otherwise use the name of any Stanford faculty member, employee, or student, or any trademark, service mark, trade name, or symbol of Stanford or Stanford Hospitals and Clinics, including the Stanford name, unless Licensee has received Stanford's prior written consent. Permission may be withheld at Stanford's sole discretion.

## **10 TERMINATION**

### **1.0 Termination by Licensee.**

- ( ) Licensee may terminate this Agreement by giving Stanford written notice at least 30 days in advance of the effective date of termination selected by Licensee.
- ( ) As of the effective date of termination, Licensee will:
  - (0) cease use and sale of any Licensed Products; and
  - (0) return to Stanford or destroy all Biological Material.

### **2.0 Termination by Stanford.**

- ( ) Stanford may also terminate this Agreement if Licensee:
  - (0) is delinquent on any payment; or
  - (0) is in breach of any provision.
- ( ) Termination under this Section 10.2 will take effect 30 days after written notice by Stanford unless Licensee remedies the problem in that 30-day period.
- ( ) As of the effective date of termination, Licensee will:
  - (0) cease use of Biological Material and sale of any Licensed

Products; and

(0) return to Stanford or destroy all Biological Material.

3.0 **Surviving Provisions.** Surviving any termination or expiration are:

- ( ) any claim of Licensee or Stanford, accrued or to accrue, because of any breach or default by the other party; and
- ( ) the provisions of Articles 7, 8, and 9, and any other provision that by its nature is intended to survive.

**11 ASSIGNMENT**

This agreement may not be assigned.

**12 ARBITRATION**

Any dispute between the parties regarding any payments made or due under this Agreement will be settled by arbitration in accordance with the JAMS Arbitration Rules and Procedures. There parties are not obligated to settle any other dispute that may arise under this Agreement by arbitration.

**13 NOTICES**

All notices under this Agreement are deemed fully given when written, addressed, and sent as follows:

All general notices to Licensee are mailed to:

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

All financial invoices to Licensee (i.e., accounting contact) are e-mailed to:

\_\_\_\_\_

\_\_\_\_\_

All general notices to Stanford are e-mailed or mailed to:

Office of Technology Licensing  
1705 El Camino Real  
Palo Alto, CA 94306-1106  
[info@otlmail.Stanford.edu](mailto:info@otlmail.Stanford.edu)

All payments to Stanford are mailed to:

Stanford University  
Office of Technology Licensing  
Department #44439  
P.O. Box 44000  
San Francisco, CA 94144-4439

All progress reports to Stanford are e-mailed or mailed to:

Office of Technology Licensing  
1705 El Camino Real  
Palo Alto, CA 94306-1106  
[info@otlmail.Stanford.edu](mailto:info@otlmail.Stanford.edu)

Either party may change its address with written notice to the other party.

## 14 MISCELLANEOUS

- 1.0 **Waiver.** No term of this Agreement can be waived except by the written consent of the party waiving compliance.
- 2.0 **Choice of Law.** This Agreement and any dispute arising under it is governed by the laws of the State of California, United States of America, applicable to agreements negotiated, executed, and performed within California.
- 3.0 **Exclusive Forum.** The state and federal courts having jurisdiction over Stanford, California, United States of America, provide the exclusive forum for any court action between the parties relating to this Agreement. Licensee submits to the jurisdiction of such courts, and waives any claim that such a court lacks jurisdiction over Licensee or constitutes an inconvenient or improper forum.
- 4.0 **Headings.** No headings in this Agreement affect its interpretation.

5.0 **Electronic Copy.** The parties to this document agree that a copy of the original signature (including an electronic copy) may be used for any and all purposes for which the original signature may have been used. The parties further waive any right to challenge the admissibility or authenticity of this document in a court of law based solely on the absence of an original signature.

The parties execute this Agreement in duplicate originals by their duly authorized officers or representatives.

THE BOARD OF TRUSTEES OF THE LELAND  
STANFORD JUNIOR UNIVERSITY

Signature \_\_\_\_\_  
Name \_\_\_\_\_  
Title \_\_\_\_\_  
Date \_\_\_\_\_

LICENSEE

Signature \_\_\_\_\_  
Name \_\_\_\_\_  
Title \_\_\_\_\_  
Date \_\_\_\_\_



**EXHIBIT A****VECTORS ASSOCIATED WITH THE STANFORD DOCKET S96-139**

- 1.) MFDG-lacZ A high titer lacZ expressing construct. Used as positive control for infection of cells.
- 2.) pBabeMN-lacZ A high titer lac-Z expressing cloning construct. Useful for subcloning in cDNAs and cDNA libraries. Has a polylinker.
- 3.) pBabeMN-IRESneo A polylinker vector with IRES-neo co-selection (G418 drug).
- 4.) pBabeMN-IRESblasto A polylinker vector with IRES-blasto co-selection (blastocidin drug).