

NON-NEGOTIABLE NON-EXCLUSIVE INDUSTRY LICENSE AGREEMENT FOR MSK CELL
LINES FOR RESEARCH USE ONLY

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This non-exclusive license agreement (hereinafter referred to as "Agreement") is effective on the date of the last to subscribe below (hereinafter referred to as "Effective Date"), and is entered by and between **MEMORIAL SLOAN KETTERING CANCER CENTER, SLOAN KETTERING INSTITUTE FOR CANCER RESEARCH and MEMORIAL HOSPITAL FOR CANCER AND ALLIED DISEASES** (hereinafter referred to as "MSK"), a New York state not-for-profit corporation with principal offices at 1275 York Avenue, New York, New York 10065, and _____, a for-profit corporation with principal offices located at _____ (hereinafter referred to as "LICENSEE").

WITNESSETH

WHEREAS, MSK is the owner of MATERIAL, as defined below; and

WHEREAS, LICENSEE desires to use MATERIAL, as defined below; and

WHEREAS, MSK desires to have the MATERIAL utilized in the public interest and is willing to grant a license to its interest thereunder and to provide such MATERIAL to LICENSEE; and

WHEREAS, LICENSEE desires to obtain said license.

NOW, THEREFORE, in consideration of the premises and the mutual covenants contained herein and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties intending to be legally bound hereto agree as follows:

ARTICLE I – PREAMBLE AND RECITALS

The foregoing preamble and recitals are hereby incorporated and made a part of this Agreement.

ARTICLE II – DEFINITIONS

For the purpose of this Agreement, the following words and phrases shall have the following meanings:

- 2.1 "Affiliate" shall mean any person, firm, corporation or other entity controlling, controlled by, or under common control with a party hereto. The term "control" wherever used throughout this Agreement shall mean ownership, directly or indirectly, of more than fifty percent (50%) of the ownership interest.
- 2.2 "MATERIAL" shall mean the cell line(s) LICENSEE selected in Section 3.1, developed by MSK, together with any unmodified derivatives, parts, products, progeny and purified or fractionated subsets.
- 2.3 "CRO" shall mean a contract research organization that provides research services to LICENSEE on a fee-for-service contract basis and has no interest in the results of these research services for its own purposes.

- 2.4 “Modifications” shall mean any substances created by LICENSEE which contain or incorporate the MATERIAL.
- 2.5 “Field of Use” shall mean the use of the MATERIAL or Modifications as a research reagent for internal research only. Specifically *excluded* from the Field of Use are i) any therapeutic, prophylactic or diagnostic uses either for human or veterinary applications; ii) any use which requires regulatory approval; or iii) any sale of or incorporation of the MATERIAL or Modifications into a commercial product or service for sale.

ARTICLE III – GRANT

- 3.1 Cell Lines:
- SK-MEL-16 (Human Melanoma Cell Line)
 - SK-MEL-23 (Human Melanoma Cell Line)
 - SK-MEL-37 (Human Melanoma Cell Line)
 - SK-MEL-246 (Human Melanoma Cell Line)

MSK hereby grants to LICENSEE, and LICENSEE hereby accepts, a nonexclusive, non-transferable, worldwide right and license, without the right to sublicense, to use the MATERIAL and Modifications in the Field of Use, to _____
[insert a brief description of the intended use of the cells], for a period of [choose one]

- One (1) year
- Five (5) years
- Ten (10) years

from the Effective Date , unless this Agreement is extended or terminated before that time according to the terms hereof, and subject to the rights reserved or observed in this Article III (hereinafter “Term”).

Expressly *excluded* from the license is the right to:

- i) sublicense;
- ii) file patent applications claiming the MATERIAL or Modifications or uses of the MATERIAL or Modifications;
- iii) use the MATERIAL or Modifications for sale, manufacture for sale, or use in the manufacture of another product or service for sale; and
- iv) distribute MATERIAL or Modifications to a third party, except when said third party is an Affiliate of LICENSEE or CRO as specified in Section 3.3

- 3.2 Notwithstanding any other provisions of this Agreement, it is agreed that MSK and its Affiliates shall retain the right to transfer, use and distribute the MATERIAL for any purpose. All rights reserved to MSK and its Affiliates, third parties, and to the United States Government and others under 35 USC 200-212, as amended, shall remain and shall in no way be affected by this Agreement.

3.3 Name of CRO _____

Notwithstanding any other provisions of this Agreement, it is understood that LICENSEE may transfer the MATERIAL and Modifications to a CRO to conduct research on behalf of LICENSEE provided, however, said CRO shall use the MATERIAL and Modifications under terms and conditions at least as restrictive as those set forth in this Agreement. Furthermore, LICENSEE is obligated to verify that any MATERIAL and Modifications transferred to a CRO is destroyed upon completion of LICENSEE's research.

ARTICLE IV – PAYMENTS

4.1 For the rights, privileges and licenses granted hereunder, LICENSEE shall pay to MSK, in the manner hereinafter provided, until this Agreement terminates as hereinafter provided, the one-time, non-creditable, non-refundable, non-discountable license issue fee specified hereinafter, due upon the Effective Date and payable within thirty (30) days of receipt of an invoice from MSK for such sum.

A). If no high-throughput screening:
A license fee of:

- Two Thousand Five Hundred dollars (\$2,500) per cell line for a one (1) year term
- Five Thousand dollars (\$5,000) per cell line for a five (5) year term
- Seven Thousand Five Hundred dollars (\$7,500) per cell line for a ten (10) year term

B). If used for high-throughput screening only, excluding any other use:
A one-time license fee, covering the term selected under 3.1, per cell line of:

- Ten Thousand dollars (\$10,000)

C). If used for high-throughput screening as well as internal research:
License fees shall consist per cell line of the sum of A). and B).

4.2 All payments shall be made in United States currency to MSK, or to the account of MSK at such other bank, including any foreign country, as MSK may reasonably designate by notice to LICENSEE, but not in any other currency, without deduction or exchange, collection or other charges.

4.3 All invoices shall reference PO# _____, LICENSEE and shall be sent to:

All payments shall be made by remittance to Memorial Sloan Kettering Cancer Center (Tax Payer ID 13-1924236). Payment shall show, "**Payment, Contract SK _____**" (note: SK # provided by MSK) on the check stub, shall include the applicable invoice, and shall be sent to:

Memorial Sloan Kettering Cancer Center
PO Box 29035
New York, New York 10087

- 4.4 LICENSEE is responsible for obtaining the MATERIAL from the Jedd Wolchok Laboratory. In addition to the license fee set forth in Section 4.1, LICENSEE shall pay the Wolchok Laboratory a "Material Acquisition Fee" of \$750 per vial as reimbursement for preparation costs of the MATERIAL, as well as applicable shipping fees. The Material Acquisition Fee and shipping fees shall be paid to:

Memorial Sloan Kettering Cancer Center

ARTICLE V – OPTION TO RENEW

LICENSEE may, at its option, extend the Term of this Agreement by providing written notification to MSK prior to the termination of this Agreement and by remitting a renewal fee of One Thousand U.S. dollars (\$1,000) per cell line, for each additional year that LICENSEE wishes to extend the Term.

ARTICLE VI – INDEMNIFICATION AND PRODUCT LIABILITY

- 6.1 LICENSEE shall at all times during the Term of this Agreement and thereafter, indemnify, defend and hold MSK, its Affiliates, trustees, Board of Managers, officers, employees, agents, and contractors, harmless 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 resulting from the development, production, manufacture or use of the MATERIAL or Modifications, or arising from any obligation of LICENSEE hereunder, except to the extent that such liability or claims arise from the gross negligence or willful misconduct of MSK.
- 6.2 For the Term of this Agreement, upon the commencement of use of any MATERIAL or Modification, LICENSEE shall obtain and carry in full force and effect liability insurance. The nature and extent of the insurance coverage shall be commensurate with usual and customary industry practices, as determined by LICENSEE's good faith assessment.
- 6.3 It is understood that MSK is subject to United States laws and regulations controlling the export of technical data, computer software, laboratory prototypes and other commodities (including the Arms Export Control Act, as amended and the Export Administration Act of 1979), and that its obligations hereunder are contingent on compliance with applicable United States export laws and regulations. The transfer of certain technical data and commodities may require a license from the cognizant agency of the United States Government and/or written assurances by LICENSEE that LICENSEE shall not export data or commodities to certain foreign countries

without prior approval of such agency. MSK neither represents that a license shall not be required nor that, if required, it shall be issued.

- 6.4 Except as otherwise expressly set forth in this Agreement, MSK MAKES NO REPRESENTATIONS AND EXTENDS NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED, INCLUDING BUT NOT LIMITED TO WARRANTIES OF MERCHANTABILITY, FITNESS FOR A PARTICULAR PURPOSE, OR THAT ANY USE OF THE MATERIAL WILL NOT INFRINGE ON ANY PATENT, COPYRIGHT, TRADEMARK, OR OTHER PROPRIETARY RIGHTS.

ARTICLE VII – PUBLICITY AND NON-USE OF NAMES

- 7.1 Except as required by law, neither MSK nor LICENSEE shall release any information, publicity, news release or other public announcement or publication regarding the terms of this Agreement or performance hereunder without the prior written approval of the other party.
- 7.2 Neither party shall use the name of the other party, nor any of its employees, nor any adaptation thereof, in any advertising, marketing, promotional or commercial literature without prior written consent obtained from the other party in each case, except as may be required by law.
- 7.3 Notwithstanding the above, in the event LICENSEE publishes the results of its research with the MATERIALS or Modifications, relevant MSK employees and the source of the MATERIAL shall be acknowledged in accordance with academic standards.

ARTICLE VIII –TERMINATION

- 8.1 MSK may terminate this Agreement if LICENSEE becomes insolvent or, a petition in bankruptcy is filed against LICENSEE and is consented to, acquiesced in or remains undismissed for ninety (90) days; or makes a general assignment for the benefit of creditors, or a receiver is appointed for LICENSEE, and LICENSEE does not return to solvency before the expiration of a thirty (30) day period.
- 8.2 Should LICENSEE fail to pay MSK fees due and payable hereunder for more than thirty (30) days, MSK shall have the right to terminate this Agreement on thirty (30) days written notice, unless LICENSEE pays MSK within the thirty (30) day period all such fees due and payable. Upon the expiration of the thirty (30) day period, if LICENSEE has not paid all such license fees and interest due and payable, the rights, privileges and license granted hereunder shall terminate immediately. The payment shall accrue interest beginning the tenth day following the due date, calculated at the annual rate of the sum of: a) two percent (2%) plus (b) the prime interest rate quoted by the Wall Street Journal on the date said payment is due.
- 8.3 Upon any breach of this Agreement by LICENSEE, other than those occurrences set out in Sections 8.1 and 8.2, which shall always take precedence in that order over any breach or default referred to in this Section 8.3, MSK shall have the right to terminate this Agreement and the rights, privileges and license granted hereunder by thirty (30) days' notice to LICENSEE. Such termination shall become effective unless LICENSEE cures any such breach prior to the expiration of the thirty (30) day period.

- 8.4 LICENSEE shall be entitled to terminate this Agreement upon thirty (30) days advance written notice to MSK, in the event of MSK's material breach of any of the provisions of this Agreement, if such breach is not cured (if capable of being cured) within this thirty (30) day period.
- 8.5 Upon termination of this Agreement for any reason, all rights granted herein shall cease and revert to MSK for the sole benefit of MSK and nothing herein shall be construed to release either party from any obligation that matured prior to the effective date of such termination, including the obligation to remit any and all fees accrued prior to such termination. LICENSEE must return to MSK or, at MSK's written request, destroy all MATERIAL and Modifications.
- 8.6 Other than any claim arising from LICENSEE's failure to pay license fees due under this contract, any controversy or bona fide disputed claim arising between the parties to this Agreement, which dispute cannot be resolved by mutual agreement, shall by the election of either party, be resolved by submission to dispute resolution before a fact-finding mediation body composed of one or more experts in the field, selected by mutual agreement within thirty (30) days of written request by either party. Said dispute resolution shall be held in New York at such place as mutually agreed upon in writing by the parties. The fact-finding body shall determine who shall bear the cost of said resolution. In the event that the parties cannot mutually agree within said thirty (30) days on the dispute resolution body, the parties shall apply the procedural rules of a mutually agreeable forum.
- 8.7 Articles VI, VII, X and this Section 8.8 of this Agreement shall survive termination.

ARTICLE IX – NOTICES AND OTHER COMMUNICATIONS

Any notice or other communication pursuant to this Agreement shall be sufficiently made or given on the date of mailing if sent to such party by certified first class mail, postage prepaid, addressed to it at its address below or as it shall designate by written notice given to the other party:

In the case of MSK:

Memorial Sloan Kettering Cancer Center
Attention: Yashodhara Dash, MBBS, PhD
Senior Director, Technology Management and Commercialization

With a copy to:

Attention: Shilpi Banerjee, PhD, JD
Chief Intellectual Property Counsel & Associate General Counsel
rtmotdcontracts@mskcc.org

If by mail: 1275 York Avenue, Box 524
New York, N.Y. 10065

If by courier: Office of Technology Development
600 3rd Avenue 16th Floor
New York, N.Y. 10016

In the case of LICENSEE:

Attention: _____

ARTICLE X - MISCELLANEOUS PROVISIONS

- 10.1 This Agreement shall be construed, governed, interpreted and applied in accordance with the laws of the State of New York, U.S.A.
- 10.2 This Agreement may not be assigned by LICENSEE without prior written consent from MSK; provided, however, that LICENSEE may transfer or assign this Agreement without the prior written consent of MSK, to an Affiliate of LICENSEE or in connection with a merger, consolidation, or a sale or transfer of all or substantially all of the assets to which the purpose of this Agreement relates.
- 10.3 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.
- 10.4 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.
- 10.5 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.
- 10.6 This Agreement may be executed in any number of counterparts and each of such counterparts shall for all purposes be an original and all such counterparts shall together constitute but one and the same agreement.

[SIGNATURE PAGE TO FOLLOW]

IN WITNESS WHEREOF, the parties have hereunto set their hands and seals and duly executed this Agreement the day and year set forth below.

**MEMORIAL SLOAN KETTERING CANCER
CENTER**

By: _____

By: _____

Name:

Name: Gregory S. Raskin, M.D.

Title:

Title: Vice President,
Technology Development

Date: _____

Date: _____