

## Instructions for Ready-To-Sign Agreement

## “Cell-Based Assay for Wnt Signaling”

**STANFORD DOCKET S05-164**

1. Please insert the following information into the agreement:
  - Opening paragraph: your company’s name, primary address, and today’s date.
  - Section 12: the appropriate company contact information for Notices.
  
2. Have the appropriate officer of the company sign duplicate copies of the agreement.
  
3. Return two signed copies of the agreement with a check for the license issue royalty (\$10,000) to:

Office of Technology Licensing  
1705 El Camino Real  
Palo Alto, CA 94306-1106  
Attention: Director
  
4. OTL will sign both agreements, keep one for OTL’s records and return the other original to the address and contact noted on the agreement. If you need an invoice to pay the issue fee, OTL will generate an invoice. Once the payment for the upfront fee is received by OTL, the Biological Materials will be provided.
  
5. If you have any questions about completing the agreement, please contact (650) 723-0651. The favorable licensing royalties included in this Ready-To-Sign agreement apply only if no negotiation is required. If you would like to negotiate changes to the Ready-To-Sign agreement there will be an increase in licensing royalties of at least \$2,000 upfront and \$1,000 per year.

**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 ownership of certain Biological Materials, as defined below, that were developed in the laboratory of Dr. Roeland Nusse, a Howard Hughes Medical Institute (“HHMI”) investigator at Stanford. The Biological Materials are described in Stanford docket S05-164, entitled, “Cell-Based Assay for Wnt signaling”, and were developed in the course of Dr. Nusse’s research as an HHMI employee.

In accordance with the terms and conditions set forth herein, Licensee wishes to obtain certain rights to the Biological Materials from Stanford, and Stanford is willing to grant those rights and transfer the Biological Materials to Licensee for internal research purposes only.

**2 DEFINITIONS**

- 2.1 “Biological Material” means the materials described in Appendix A and provided to Licensee under this Agreement.
- 2.2 “HHMI Indemnitees” means HHMI and its trustees, officers, employees, and agents.
- 2.3 “Licensed Field of Use” means any use of Biological Material for internal research purposes. The Licensed Field of Use specifically excludes any use of Biological Material which requires regulatory approval, including any *in vitro* and *in vivo* diagnostic or therapeutic applications, and any *in vivo* use for whatever purpose.
- 2.4 “Licensed Territory” means the world.
- 2.5 “Stanford Indemnitees” means Stanford and Stanford Hospitals and Clinics, and their respective trustees, officers, employees, students, and agents.

**3 GRANT**

- 3.1 **Grant.** Subject to the terms and conditions of this Agreement, Stanford grants Licensee a worldwide, non-exclusive license to use the Biological Materials

in the Licensed Field of Use. Licensee will not transfer the Biological Materials to any third party without prior written consent from Stanford.

3.2 **Nonexclusivity.** The license is nonexclusive in the Licensed Field of Use beginning on the Effective Date and expiring on the 15<sup>th</sup> anniversary of the Effective Date.

3.3 **Retained Rights.** Stanford retains title to all Biological Materials.

3.4 **Specific Exclusion.** Stanford does not:

- (A) 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
- (B) agree to furnish to Licensee any technology or technological information other than the Biological Material or to provide Licensee with any assistance.

3.5 **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 ROYALTIES

5.1 **Issue Royalty.** Licensee will pay to Stanford a noncreditable, nonrefundable license issue royalty of \$10,000 upon signing this Agreement. Upon receipt of payment, Stanford will send Biological Material to Licensee.

5.2 **License Maintenance Fee.** Beginning on the first anniversary of the Effective Date and each anniversary thereafter, Licensee will pay Stanford a yearly license maintenance fee of \$10,000.

5.3 **Currency.** Licensee will make payments to Stanford in U.S. Dollars.

5.4 **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.

#### 6 EXCLUSIONS AND NEGATION OF WARRANTIES

6.1 **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:

- (A) of merchantability, of fitness for a particular purpose,
- (B) of non-infringement or
- (C) arising out of any course of dealing.

**6.2 No Representation.** Licensee also acknowledges that Stanford does not represent or warrant that the exploitation of Biological Material will be successful.

## **7 INDEMNITY**

### **7.1 Indemnification.**

(A) 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.

(B) HHMI Indemnitees will be indemnified, defended by counsel acceptable to HHMI, and held harmless by Licensee from and against any claim, liability, cost, expense, damage, deficiency, loss, or obligation, of any kind or nature (including, without limitation, reasonable attorneys' fees and other costs and expenses of defense) (collectively, "Claims"), based upon, arising out of, or otherwise relating to this Agreement, including without limitation any cause of action relating to product liability. The previous sentence will not apply to any Claim that is determined with finality by a court of competent jurisdiction to result solely from the gross negligence or willful misconduct of an HHMI Indemnitee.

**7.2 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.

**7.3 Workers' Compensation.** Licensee will comply with all statutory workers' compensation and employers' liability requirements for activities performed under this Agreement.

**7.4 Insurance.** During the term of this Agreement, Licensee will maintain Comprehensive General Liability Insurance, with a reputable and financially secure insurance carrier to cover the activities of Licensee. The insurance will provide minimum limits of liability of \$1,000,000 and will include all Stanford Indemnitees and HHMI 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 the Stanford Indemnitees and the HHMI Indemnitees will be excess and noncontributory.

## **8 NAMES AND MARKS**

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

## **9 TERMINATION**

**9.1 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. Licensee will cease use of Biological Material as of the effective date of termination. Licensee will destroy the Biological Material by the effective date of termination and provide written confirmation to Stanford of the said destruction.

**9.2 Termination by Stanford.**

(A) Stanford may also terminate this Agreement if Licensee:

- (1) is delinquent on any report or payment; or
- (2) is in breach of any provision.

(B) Termination under this Section 9.2 will take effect 30 days after written notice by Stanford unless Licensee remedies the problem in that 30-day period.

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

- (A) Licensee's obligation to pay royalties accrued or accruable;
- (B) any claim of Licensee or Stanford, accrued or to accrue, because of any breach or default by the other party; and
- (C) the provisions of Articles 6, 7, 8, and 13.4, and any other provision that by its nature is intended to survive.

**10 ASSIGNMENT**

This agreement may not be assigned.

**11 ARBITRATION**

**Dispute Resolution by Arbitration.** Apart from any controversy or claim pertaining to HHMI’s rights under Article 7 or otherwise under this Agreement, any dispute between the parties regarding any payments made or due under this Agreement will be settled by arbitration in accordance with the Licensing Agreement Arbitration Rules of the American Arbitration Association. The parties are not obligated to settle any other dispute that may arise under this Agreement by arbitration.

**12 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

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

### 13 MISCELLANEOUS

- 13.1 **Waiver.** No term of this Agreement can be waived except by the written consent of the party waiving compliance.
- 13.2 **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.
- 13.3 **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.
- 13.4 **Third Party Beneficiary.** HHMI is not a party to this Agreement and has no liability to any licensee or user of any technology covered by this Agreement, but HHMI is an intended third-party beneficiary of this Agreement and certain of its provisions are for the benefit of HHMI and are enforceable by HHMI in its own name.
- 13.5 **Headings.** No headings in this Agreement affect its interpretation.
- 13.6 **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 \_\_\_\_\_



**APPENDIX A**

Cells that stably express a luciferase reporter construct, driven by the TCF transcription factor including, the following cell lines: (1) Mouse L cells stably expressing a Wnt reporter, responding to Wnt3a protein over a 500 fold dynamic range; (2) Human 293 cells, stably expressing a Wnt reporter, responding to Wnt3a protein over a 100 fold dynamic range; and (3) Drosophila S2 cells, stably expressing a Wnt reporter and the Frizzled1 receptor, responding to Wingless protein over a 300 fold dynamic range.