

NON-COMMERCIAL RESEARCH LICENSE AGREEMENT

THIS AGREEMENT ("Agreement"), effective on the 25th day of March, 2002 (the "Effective Date"), is entered into by and between

E. I. du Pont de Nemours and Company, a Delaware corporation, having a principal place of business at 1007 Market Street, Wilmington, DE 19898 (hereinafter "DUPONT")

and

The University of Pittsburgh-Of the Commonwealth System of Higher Education, with its principal place of business at 200 Lothrop Street, Pittsburgh, PA 15213 (hereinafter "LICENSEE").

RECITALS

WHEREAS, DUPONT is exclusive licensee under U.S. Patents 4,736,866, 5,087,571 and 5,925,803 issued to Philip Leder et al., and assigned to the President and Fellows of Harvard College; and

WHEREAS, LICENSEE is desirous of obtaining the right to create and use Transgenic Animals and/or Cells covered by such patents for certain research purposes.

NOW, THEREFORE, in consideration of the above premises and the mutual covenants contained herein, the parties agree as follows:

1. DEFINITIONS

The terms in this Agreement with initial letters capitalized, whether used in the singular or the plural, shall have the meaning set forth below or, if not listed below, the meaning designated in places throughout this Agreement. LICENSEE and DUPONT are sometimes referred to herein individually as a party and collectively as the parties.

1.1 "Cells" meaning any cells or cell lines derived from Transgenic Animals covered by Licensed Patents.

1.2 "Effective Date" means the date indicated above as the effective date of this Agreement.

1.3 "Licensed Patents" means the United States and foreign patents and patent applications listed on Attachment A hereto, any continuation-in-part, continuation or divisional applications thereof, any patent granted on any aforesaid patent application, and any extension, revival, re-examination, or reissue of any of such patent, and any continuations, continuations-in-part, divisionals, reissues or extensions of any of the foregoing.

1.4 "Research Field" means use by LICENSEE for its internal non-commercial biomedical research purposes. Specifically excluded from the Research Field is the development,

manufacture, use, lease, sale (or other transfer for consideration) or importation of any product for sale (or lease or other transfer of a product for consideration) wherein the manufacture, use, sale or importation of such product would infringe a Valid Claim of the Licensed Patents, including but not limited to wherein the product is manufactured using a composition or method which would infringe a Valid Claim of the Licensed Patents. Also specifically excluded from the Research Field is the use of any Transgenic Animal or Cell to generate scientific data or information that is conveyed to a Third Party for consideration.

1.5 “Third Party” means any entity other than LICENSEE or DUPONT.

1.6 “Transgenic Animals” means any animal covered by Licensed Patents.

1.7 “Valid Claim” means a claim of an issued and unexpired patent which has not been held permanently revoked, unenforceable or invalid by a decision of a court or other governmental agency of competent jurisdiction, unappealable or unappealed within the time allowed for appeal.

2. GRANT OF RIGHTS TO LICENSEE

2.1 Grant of Research License to LICENSEE. Subject to the terms and conditions of this Agreement, DUPONT hereby grants to LICENSEE a non-transferable, non-exclusive, worldwide field of use license under the Licensed Patents, without the right to grant sublicenses, to produce, use, breed and/or crossbreed the Transgenic Animals or Cells and to use and/or culture Cells solely for use in the Research Field. The use of the Transgenic Animals or Cells outside of the Research Field is outside the scope of this Agreement and shall only be permitted under the terms of a separate written agreement between LICENSEE and DUPONT. Any use of the Transgenic Animals and/or Cells outside the Research Field without first obtaining a license from DUPONT shall be deemed a breach of this Agreement and an act of infringement of relevant patent rights of DUPONT for which DUPONT shall be entitled to whatever remedies it may have under law or at equity, including recovery of consequential damages, from LICENSEE.

2.2 The term “Research Field” set forth in Section 1.4 shall not include:

2.2.1 transfers of the Transgenic Animals and/or Cells, products derived from or resulting from the use of Transgenic Animals and/or Cells, or processes identified through the use of Transgenic Animals and/or Cells to third parties for a consideration;

2.2.2 transfers of the Transgenic Animals and/or Cells, products derived from or resulting from the use of Transgenic Animals and/or Cells, or processes identified through the use of Transgenic Animals and/or Cells to any person or entity that does not have a Research License from DUPONT; or

2.2.3 research programs which are funded by or for commercial (for profit) entities.

2.3 Notwithstanding 2.2.3 above, LICENSEE shall have the right to transfer Transgenic Animals and/or Cells to third party non-profit institutions subject to Section 2.3.1

below. LICENSEE shall have the right to transfer Transgenic Animals and/or Cells to third party for-profit institutions subject to Section 2.3.2 below. LICENSEE shall have the right to receive Transgenic Animals and/or Cells from a Third Party subject to the terms and conditions of this Agreement. The grant set forth in Section 2.1 shall apply only to those individuals who are principal investigators in the employ of LICENSEE and identified on Schedule A hereto and to other persons in the employ of LICENSEE and working under the direction and supervision of the principal investigator(s) identified on Schedule A. LICENSEE shall have the responsibility to ensure that Schedule A reflects the identity of each principal investigator licensed hereunder. At least once per calendar quarter, LICENSEE shall prepare an updated Schedule A to reflect the principal investigators of LICENSEE conducting research under this Agreement and supply DUPONT with a copy of same. In the event LICENSEE desires that the grant apply to all principal investigators, the word "all" shall be inserted into Schedule A.

2.3.1 Transfer of Transgenic Animals and/or Cells to Non-Profit Institutions. LICENSEE may transfer Transgenic Animals and/or Cells it makes or acquires during the term of this Agreement to non-profit institutions, *provided that*:

(i) such non-profit institution has entered into a license agreement with DUPONT, as reported by DUPONT, granting rights under the Licensed Patents; or alternatively,

(ii) such transfer is subject to a written material transfer agreement between LICENSEE and the non-profit institution having the terms set forth in Attachment B hereto; and

(iii) no transfer of material produced or obtained under this Agreement shall be made for consideration.

2.3.2 Transfer of Transgenic Animals and/or Cells to For-Profit Institutions. LICENSEE may transfer Transgenic Animals and/or Cells it makes or acquires during the term of this Agreement to Third Party for-profit institutions subject to the following: (a) the for-profit institution has entered into a written license agreement with DUPONT which expressly permits the for-profit institution to receive Transgenic Animals and/or Cells from third parties subject to the payment of a transfer fee to DUPONT and (b) prior to any such transfer to the for-profit institution, LICENSEE shall have received written confirmation from DUPONT that DUPONT has received payment of the applicable transfer fee for such Transgenic Animals and/or Cells from the for-profit institution. LICENSEE shall not otherwise be permitted to transfer Transgenic Animals and/or Cells to any for-profit institutions. The transfer and use of the Transgenic Animals and/or Cells by the recipient for-profit institution shall be subject to the terms and conditions of the license agreement between the recipient for-profit institution and DUPONT.

2.4 Non-assertion. During the term of this Agreement and so long as LICENSEE has not committed any material breach with respect to any obligation hereunder, DUPONT will not assert any patent or patent application licensed hereunder against LICENSEE to prevent LICENSEE from practicing the rights granted to LICENSEE under Article 2 hereof.

2.5 No Other Licenses. No right or license is granted hereunder, except as expressly and specifically set forth herein.

3. ADDITIONAL OBLIGATIONS OF LICENSEE

3.1 DUPONT Access to Transgenic Animals and/or Cells. Upon DUPONT's written request, LICENSEE agrees to provide to DUPONT without cost reasonable quantities of any Transgenic Animals and/or Cells identified in a public disclosure that LICENSEE makes during the term of this Agreement, solely for DUPONT's internal research purposes.

3.2 Reports. As consideration for the grant of Section 2, LICENSEE shall require each principal investigator acquiring the benefit of this Research License to submit each agreement year a summary report of his/her research activities under this Agreement.

4. REPRESENTATIONS AND WARRANTIES; LIABILITY

4.1 Representations and Warranties. DUPONT represents and warrants to LICENSEE that (a) it has all requisite power and authority to enter into this Agreement and to grant the licenses granted by it hereunder, (b) execution of this Agreement has been duly authorized, and (c) this Agreement is fully binding and enforceable in accordance with its terms. LICENSEE represents and warrants to DUPONT that (a) it has all requisite power and authority to enter into this Agreement and to perform its obligations under this Agreement, (b) execution of this Agreement has been duly authorized, (c) this Agreement is fully binding and enforceable in accordance with its terms, (d) that all of its activities related to its use of the Licensed Patents pursuant to this Agreement will comply with all applicable federal, state and local laws, statutes, rules and regulations and (e) that LICENSEE will not during the term of this Agreement enter into any agreements, contracts or other arrangements that would be inconsistent with its obligations under this Agreement.

4.2 Liability. LICENSEE shall bear all risk and responsibility and liability for all of its activities in exercising its rights under this Agreement and shall hold DUPONT and its affiliates and parent companies harmless against any and all claims, demands, losses, costs, expenses (including attorney fees), damages and judgments whatsoever, arising out of or resulting from acts or omissions of LICENSEE in connection with the exercise of its rights under this Agreement. DUPONT shall not be liable to LICENSEE because of the infringement of any patent rights of any third party by LICENSEE in practicing the rights granted hereunder.

5. TERM AND TERMINATION.

5.1 Term. This Agreement, unless terminated earlier, shall remain in full force and effect on a country-by-country basis until the expiration of the last to expire of any Valid Claim included in the Licensed Patents in such country.

5.2 Termination by DUPONT. DUPONT shall have the right to terminate this Agreement, at DUPONT's sole discretion, upon sixty (60) days written notice to LICENSEE in the event that any material provision or stipulation of this Agreement shall have been breached by LICENSEE and in the event that LICENSEE shall have failed to remedy such breach within such sixty (60)

day period. Any notice served by DUPONT pursuant to this Section 5.2 shall specify the nature of the breach and the required remedy by LICENSEE.

5.3 Termination by LICENSEE. Subject to Section 5.4, LICENSEE shall have the right to terminate the license granted hereunder upon written notice to DUPONT.

5.4 Effect of Termination.

5.4.1 Upon termination or expiration of this Agreement for any reason, all rights and licensed granted to LICENSEE hereunder shall terminate.

5.4.2 Survival. The termination of this Agreement shall not affect any rights or obligations of either party that have accrued or matured prior to termination and which are intended by the parties to survive termination. Upon termination of this Agreement, LICENSEE shall immediately cease use of Transgenic Animals and/or Cells and shall dispose of Transgenic Animals and/or Cells produced under the agreement in accordance with DUPONT's written instructions and at LICENSEE's cost.

6. OTHER PROVISIONS

6.1 Assignment. This Agreement may not be assigned or otherwise transferred by LICENSEE without the prior written consent of DUPONT. DUPONT may, without LICENSEE's consent, assign all or any portion of its rights and obligations hereunder in connection with the transfer of the Licensed Patents to a third party assignee or successor in interest, provided that such assignee or successor in interest agrees to be bound by the terms of this Agreement.

6.2 Applicable Law; Jurisdiction. This Agreement is acknowledged to have been made in and shall be construed in accordance with the laws of the Commonwealth of Pennsylvania, without regard to conflict of laws principals which would dictate the application of the law of a different jurisdiction; *provided, that*, all questions concerning the construction or effect of patent applications and patents shall be decided in accordance with the laws of the country in which the particular patent application or patent concerned has been filed or granted, as the case may be.

6.3 Notices. 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 facsimile on such date, with paper copy being sent by certified first class mail, postage prepaid, or by next day express delivery service, addressed to it at its address below (or such address as it shall designated by written notice given to the other party).

If to DUPONT:

Associate Director, Commercial Development
DuPont Intellectual Assets Business
E. I. du Pont de Nemours and Company
Chestnut Run Plaza 708/180
P. O. Box 80708
Wilmington, DE 19880-0708
302.999-4108/4149 FAX

If to LICENSEE:

University of Pittsburgh
Office of Research
139 University Place
350 Thackeray Hall
Pittsburgh, PA 15260-6830

6.4 Relationship of the Parties. It is expressly agreed that the relationship between LICENSEE and DUPONT shall not constitute a partnership, joint venture or agency. Neither LICENSEE nor DUPONT shall have the authority to make any statements, representations or commitments of any kind, or to take any action, which shall be binding on the other, without the prior consent of the other party to do so.

6.5 Severability. In performing this Agreement, the parties shall comply with all applicable laws. Wherever there is any conflict between any provision of this Agreement and any law, the law shall prevail, but in such event the affected provision of this Agreement shall be limited or eliminated only to the extent necessary, and the remainder of this Agreement shall remain in full force and effect. In the event the terms of this Agreement are materially altered as a result of the foregoing, the parties shall re-negotiate in good faith the terms of this Agreement to resolve any inequities.

6.6 Counterparts. This Agreement may be executed in counterparts with the same effect as if both parties had signed the same document. All such counterparts shall be deemed an original, shall be construed together and shall constitute one and the same instrument.

6.7 Entire Agreement. This Agreement, including the Attachments hereto, constitutes the entire agreement between the parties with respect to the subject matter hereof, and supersedes any and all oral and/or written communications or understandings relating to the subject matter hereof. No modification or amendment, by waiver or otherwise, to this Agreement shall be effective unless in writing and signed by an authorized representative of each party.

IN WITNESS WHEREOF, the parties have caused their duly authorized officers to execute and deliver this License Agreement as of the Effective Date.

E. I. DU PONT DE NEMOURS AND COMPANY

By: R. G. Hirsch

Printed Name: R. G. HIRSCH

Title: MANAGING DIRECTOR

LICENSEE'S NAME:

THE UNIVERSITY OF PITTSBURGH- OF THE COMMONWEALTH SYSTEM
OF HIGHER EDUCATION

By: Michael M. Crouch

Printed Name: _____

Title: Michael M. Crouch, Director
Office of Research

Rev: 7/00

Attachment A

| <u>Country</u> | <u>Patent No.</u> | <u>Issue Date</u> | <u>Expiration Date</u> |
|----------------|-------------------|-------------------|------------------------|
| USA | 4736866A | 4/12/88 | April 12, 2005 |
| Austria | 76102E | 5/15/92 | May 15, 2010 |
| German | 3586020C0 | 6/17/92 | June 24, 2005 |
| Europe | 169672B1 | 5/13/92 | January 29, 2006 |
| Japan | 5048093B4 | 7/20/93 | April 25, 2005 |
| USA | 5087571 | 2/11/92 | February 11, 2009 |
| USA | 5925803 | 7/20/99 | July 20, 2016 |

ATTACHMENT B

Material Transfer Agreement
between LICENSEE and Third Party Academic Institutions

[Name of LICENSEE] ("Institution") is willing to provide Material (defined below) to _____ ("Investigator") of _____ ("Recipient Institution") (hereinafter collectively "Recipient") solely for the internal academic research purposes as described below, under the following terms.

1. Upon execution of this agreement, Institution shall provide to Investigator samples of Transgenic Animals and/or Cells. "Material" as used herein means [specify Material], and any cell line or progeny derived directly or indirectly therefrom.

2. The Material is covered by the claims of the Licensed Patents, which are assigned to E. I. du Pont de Nemours and Company.

3. Recipient may use the Material solely for its internal non-commercial biomedical research purposes. Recipient shall not use the Material in the development, manufacture, use, lease, sale (or other transfer for consideration) or importation of any product for sale (or lease or other transfer of a product for consideration) wherein the manufacture, use, sale or importation of such product would infringe the Licensed Patents, including but not limited to wherein the product is manufactured using a composition or method which would infringe the Licensed Patents. Recipient shall not use the Material to generate scientific data or information that is conveyed to a third party for consideration.

4. The Material, and any progeny or derivatives derived directly or indirectly therefrom, may not be transferred by the Recipient to any third parties.

5. With respect to any questions regarding license rights under the Licensed Patents, Recipient should contact:

Associate Director, Commercial Development
E. I. du Pont de Nemours and Company
Chestnut Run Plaza 708/180
P. O. Box 80708
Wilmington, DE 19880-0708
302.999-4108/4149 FAX

6. Recipient agrees that any person utilizing the Material within Recipient Institution will be advised of and shall be subject to the conditions of this Agreement.

The parties agree to the foregoing and have caused this Agreement to be executed by their duly authorized representatives.

[LICENSEE NAME]

By: Michael M. Crouch

Printed Name: Michael M. Crouch, Director
Office of Research

Title: _____

Date: 3-28-02

[NAME OF RECIPIENT INSTITUTION]

By: Michael M. Crouch
(Signature of Authorized Representative
of Recipient)

Printed Name: Michael M. Crouch, Director
Office of Research

Title: _____

Date: 3-28-02

By: Albert B. DeLor
(Signature of Investigator)

ALBERT B. DELEOR
(Printed Name)

Date: 3/28/02

Schedule A

| | |
|---|---|
| Printed Name: <u>ALBERT B. DE LEO</u> Title: <u>PROFESSOR</u> Signature: <u><i>Albert B. De Leo</i></u> | Printed Name: _____ Title: _____ Signature: _____ |
| Printed Name: _____ Title: _____ Signature: _____ | Printed Name: _____ Title: _____ Signature: _____ |
| Printed Name: _____ Title: _____ Signature: _____ | Printed Name: _____ Title: _____ Signature: _____ |
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