**PUBLIC HEALTH SERVICE**

**START-UP EXCLUSIVE EVALUATION OPTION LICENSE AGREEMENT**

This **Agreement** is based on the model Patent License Exclusive Evaluation Agreement adopted by the U.S. Public Health Service (“**PHS**”) Technology Transfer Policy Board for use by components of the National Institutes of Health (“**NIH**”), which is an agency of the **PHS** within the Department of Health and Human Services (“**HHS**”), herein termed a Party or collectively Parties.

This Cover Page identifies the Parties to this **Agreement**:

The U.S. Department of Health and Human Services, as represented by

National Cancer Institute

an Institute or Center (hereinafter referred to as the “**IC**”) of the

**NIH**

and

[Insert Company’s official name],

hereinafter referred to as the “**Licensee**”,

having offices at [Insert Company’s address],

created and operating under the laws of [Insert State of Incorporation].

**Tax ID No.:\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_**

**L#: L-XXX-XXXX-0**

1. **BACKGROUND**
	1. By assignment of rights from **IC** employees and other inventors, **HHS**, on behalf of the **Government**, owns certain intellectual property rights in the United States or foreign patent applications and/or patents of the **Licensed Patent Rights**.
	2. The **Licensee** desires to obtain an exclusive evaluation option license to evaluate the commercial applications of the **Licensed Products** or any inventions within the scope of the **Licensed Patent Rights** within the **Licensed Field(s) of Use**.
2. **DEFINITIONS**
	1. “**Government”** means the government of the United States of America.
	2. “**Benchmarks**” mean the performance milestones that are set forth in Appendix D.
	3. “**Commercial Development Plan**” means a written commercialization plan, to be submitted to the **IC** upon **Licensee**’s exercise of the option under the terms of this **Agreement**, that describes plans for complete development and achievement of “practical application”, as defined in 35 U.S.C, § 201(f), of subject matter relevant to the **Licensed Patent Rights.**
	4. **“Commercial Evaluation Plan**” means the written evaluation plan attached as Appendix E, submitted to the **IC** by the **Licensee** that describes plans for initial development of the **Licensed Products** or **Licensed Processes** within the scope of the **Licensed Patent Rights** and the **Licensed Field(s) of Use** under the terms of this **Agreement**.
	5. “**CRADA”** means a Cooperative Research and Development Agreement.
	6. **“Commercial Purpose”** means the sale, lease, license, distribution in lieu of purchase, or any other transfer of the **Licensed Products**, excluding transfers to contractors or non-profit collaborators for internal evaluation or internal research. **Commercial Purpose** shall also include uses of the **Licensed Products** to perform contract research, to screen libraries, to produce or manufacture products for general sale, or to conduct activities that result in any direct or indirect sale, lease, license, or transfer of the **Licensed Products**.
	7. “**Effective Date**” means the date when the last party to sign has executed this **Agreement**.
	8. **“Extraordinary Expenditures**” means expenses arising from actions beyond the norms of typical preparation, filing, and prosecution of the **Licensed Patent Rights**, including, without limitation, interferences, reexaminations, reissues, oppositions, and defense.
	9. “**Licensed Patent Rights**” means PCT or U.S. patent application(s) (including provisional patent application(s)) or patents and all foreign counterparts described in Appendix A.
	10. **“Materials”** means tangible materials provided to the **Licensee** by **IC**, including all progeny, subclones and unmodified derivatives thereof**,** if applicable**,** as described in Appendix A.
	11. “**Research License**” means a nontransferable, nonexclusive license to make and to use any tangible embodiment of the **Licensed** **Patent Rights** and to practice any **Licensed Processes** included within the **Licensed** **Patent Rights** for purposes of internal research and not for a **Commercial Purpose**.
	12. “**Start-up Company”** means a companyhaving fewer than fifty (50) employees, operating for fewer than five (5) years, and having received less than five million dollars ($5,000,000) since incorporation, that is majority owned by individuals or by a company that is majority owned by individuals.
	13. “**Licensed Processes**” means processes which, in the course of being practiced, would be within the scope of one or more claims of the **Licensed Patent Rights** that have not been held unpatentable, invalid or unenforceable by an unappealed or unappealable judgment of a court of competent jurisdiction.
	14. “**Licensed Products**” means tangible materials which, in the course of manufacture, use, sale, or importation, would be within the scope of one or more claims of the **Licensed Patent Rights** that have not been held unpatentable, invalid or unenforceable by an unappealed or unappealable judgment of a court of competent jurisdiction. “**Licensed Field(s) of Use**” means the field(s) of use identified in Appendix B.
	15. “**Licensed Territory**” means the territory(ies) identified in Appendix B.
	16. “**Third Party Collaborator(s)**” means an academic and/or non-profit third party with whom **Licensee** has entered into a *bona fide* collaboration agreement (*i.e*., work under the collaboration reflects contribution from both the **Licensee** and third party) for purposes of conducting research and development activities.
	17. "**Third Party Contractor(s)**” means a third-party organization, acting with, on behalf and for the benefit of **Licensee** for consideration provided by the **Licensee** on a fee-for-service basis to conduct experiments specified by the **Licensee**.
3. The **Licensee** represents that it has the facilities, personnel, and expertise to evaluate the commercial applications of the **Licensed Products**, **Licensed Processes**, or inventions within the scope of the **Licensed Patent Rights** within the **Licensed Field(s) of Use** as outlined in the **Commercial Evaluation Plan**.
4. **Licensee** represents that it is a **Start-Up Company** on the **Effective Date** of this **Agreement**.
5. **GRANT OF RIGHTS**
	1. The **IC** hereby grants to the **Licensee** a start-up exclusive evaluation license, for evaluation purposes only, to make and use, *but not to sell*, the **Materials** or **Licensed Products** or inventions within the scope of the **Licensed Patent Rights** within the **Licensed Field(s) of Use** and in the **Licensed Territory,** and to practice **Licensed Processes** within the **Licensed Field(s) of Use** and in the **Licensed Territory**. The rights provided herein are provided for the evaluation of commercial applications only and not for a **Commercial Purpose**.
	2. The **Licensee** is entitled to authorize its **Third-Party Contractor(s)** to make, have made and to use, but not to sell **Materials** and **Licensed Products** on **Licensee**’s behalf solely in the **Licensed Field(s) of Use** and in the **Licensed Territory**. **Licensee** may, without prior written permission, transfer the **Materials** and **Licensed Products** to **Third Party Collaborator(s)** solely for internal research purposes within the **Licensed Field(s) of Use**. **Licensee** shall ensure that such **Third-Party Collaborator(s)**, and **Third-Party Contractor(s)** comply with the terms and obligations of this **Agreement** with respect to their use of the **Materials** and/or the **Licensed Products**.
	3. The **IC** shall grant **Licensee** an exclusive option to an exclusive license agreement, conditioned upon **Licensee**’s adherence to the **Commercial Evaluation Plan** or as modified under Paragraph 10.3 of this **Agreement**, with a field of use no broader than the **Licensed** **Field(s) of Use**. Should **Licensee** request a field of use that is broader in scope to this **Licensed Field(s) of Use**, the request must include a completed [National Institutes of Health (NIH) Application for License](https://www.ott.nih.gov/resources#LAP) (“License Application”). The **IC** shall review and consider **Licensee**’s request according to 37 C.F.R. §404.5, §404.7, and §404.8. To exercise the exclusive option, **Licensee** must submit a written notice to the **IC** one (1) month prior to the termination or expiration of this **Agreement**. The written notice must include an updated License Application and a **Commercial Development Plan** and will initiate a negotiation period that expires three (3) months after the exercise of the option. In the absence of **Licensee**’s exercise of the option to an exclusive license, the **IC** will be free to license the **Licensed Patent Rights** within or outside the **Licensed Field(s) of Use** to others. These time periods may be extended at the sole discretion of **IC** upon written request and a showing of good cause by **Licensee**. **Licensee** agrees that the continued use of the **Materials**, **Licensed Products**, or **Licensed Patent Rights** after expiration or termination of this **Agreement** will occur only pursuant to a separate license agreement. The continued use of the **Materials**, **Licensed Products**, or **Licensed Patent Rights** after expiration or termination of this **Agreement** without the exercise of the exclusive option or the execution of a separate license agreement granting such rights will be considered a material breach of this **Agreement**.
	4. For the avoidance of doubt, the **Licensed Field(s) of Use** provided in this **Agreement** is only applicable for the Start-up Exclusive Evaluation Option License.  The licensed field of use for any subsequent Exclusive Patent License Agreement shall be commensurate in scope with the **Commercial Development Plan** provided at the time of negotiation of any such license and subject to **IC’s** review and approval. The subsequent exclusive agreement shall substantially be in the form as described in the [NIH Model Exclusive Patent License Agreement](https://www.ott.nih.gov/sites/default/files/documents/docs/NIH-Patent-License-Exclusive-model-102015.docx).
6. **RESERVATION OF RIGHTS**
	1. The **IC** reserves on behalf of the **Government** an irrevocable, non-exclusive, nontransferable, royalty‑free license for the practice of all inventions licensed under the **Licensed Patent Rights** throughout the world by or on behalf of the **Government** and on behalf of any foreign government or international organization pursuant to any existing or future treaty or agreement to which the **Government** is a signatory.
	2. The **Licensee** acknowledges that the **IC** may enter into future **CRADAs** under the [Federal Technology Transfer Act of 1986](http://history.nih.gov/research/downloads/PL99-502.pdf) that relate to the subject matter of this **Agreement**. The **Licensee** agrees not to unreasonably deny requests for a **Research License** from future collaborators with the **IC** when acquiring these rights is necessary to make a **CRADA** project feasible. The **Licensee** may request an opportunity to join as a party to the proposed **CRADA**.
	3. The **IC** reserves the right to grant **Research Licenses** directly or to require the **Licensee** to grant **Research Licenses** on reasonable terms. The purpose of these **Research Licenses** is to encourage basic research, whether conducted at an academic or corporate facility. To safeguard the **Licensed Patent Rights**, however, the **IC** shall consult with the **Licensee** before granting to commercial entities a **Research License** or providing to them research samples of materials made through the **Licensed Processes**.
	4. If **Licensee** executes an exclusive or non-exclusive commercialization license after the expiration of this **Agreement**, as per in Paragraph 5.3, **Licensee** agrees that products used or sold in the United States embodying the **Licensed Products** or produced through use of the **Licensed Processes** shall be manufactured substantially in the United States, unless a written waiver is obtained in advance from the **IC**.

7. **ROYALTIES AND REIMBURSEMENTS**

7.1 In consideration of the grant in Paragraph 5.1, the **Licensee** agrees to pay the **IC** a non-creditable, non-refundable, license issue royalty as set forth in Appendix Cwithin sixty (60) days of the **Effective Date** of this **Agreement**, and a second non-creditable, non-refundable, patent reimbursement royalty on the one-year anniversary of the **Effective Date** of this **Agreement**. These royalties shall be paid in U.S. dollars in accordance with the payment schedule listed in Appendix C. For conversion of foreign currency to U.S. dollars, the conversion rate shall be the New York foreign exchange rate quoted in *The Wall Street Journal* on the day that the payment is due. Any loss of exchange, value, taxes, or other expenses incurred in the transfer or conversion to U.S. dollars shall be paid entirely by the **Licensee**.

7.2 As described below in Paragraph 8.2, when the **IC** has approved **Licensee**’s request for additional patent filings or additional prosecution actions beyond those taken by the **IC**, the **Licensee** shall be wholly responsible to the law firm employed by the **IC** for direct payment of all expenses resulting from such approved requests. In this event, the **IC** and not the **Licensee** shall be the client of the law firm, and the **Licensee** acknowledges that the **IC** will not provide privileged attorney-client communications or work product to the **Licensee**.

1. **PATENT FILING, PROSECUTION, AND MAINTENANCE**

8.1 Except as otherwise provided in this Article 8, the **IC** agrees to take responsibility for the prosecution and maintenance of the patent applications or patents listed in Appendix A, which are the **Licensed Patent Rights** on the **Effective Date** of this **Agreement**.If the **IC** anticipates the possibility of any **Extraordinary Expenditures**, the **IC** will send prior written notice to **Licensee**, and the **IC** will not be required to incur such **Extraordinary Expenditures**. At the **IC**’s sole option, the **IC** may elect to abandon the patent rights associated with such **Extraordinary Expenditures**. In such event, the **Licensee** may request that the **IC** incur such **Extraordinary Expenditures** at the **Licensee’s** expense, which shall require approval by **IC**. In addition, the **Licensee** may request further prosecution actions beyond those taken by the **IC**. Such actions shall be at the sole expense of the **Licensee** and shall require approval by the **IC**.

8.2The **IC** will not be required to prepare, file, prosecute, or maintain additional patents or patent applications outside of those listed in Appendix A.The **Licensee** may request filing of future, related patent applications beyond those listed in Appendix A, which shall require approval by **IC** and will not be unreasonably denied without cause. However, in this event, the **Licensee** shall render direct payment for all related expenses resulting from **Licensee’s** requests in the manner described above in Paragraph 7.2.

8.3 Each party shall promptly inform the other as to all matters that come to its attention that may affect the preparation, filing, prosecution, or maintenance of the **Licensed Patent Rights** and any related patent applications or patents. The **IC** shall consult with the **Licensee** on the prosecution and maintenance of the **Licensed Patent Rights**, and permit **Licensee** to provide comments and suggestions with respect to the preparation, filing, prosecution, and maintenance of **Licensed Patent Rights** and related patent applications or patents, which shall be considered by the **IC**. The **IC** shall furnish copies of relevant patent‑related documents to the **Licensee** upon request.

9. **MATERIALS**

9.1 If **IC** **Materials** are provided under this **Agreement**, they shall be specified in Appendix A. Following receipt and verification of payment of the license issue royalty, as required by Paragraph 7.1 of this **Agreement**, **IC** shall provide the **Licensee** with samples of the **Materials**, as available, and to replace the **Materials**, as available, in the event of their unintentional destruction. For the avoidance of doubt, **IC** shall provide **Materials** to the **Licensee** solely at the **Licensee’s** expense as specified in Appendix G.

9.2 The **Licensee** agrees to retain control over any **Materials** if provided, and the **Licensed Products**, and not to distribute them to third parties, except **Third Party Contractor(s)** or **Third-Party Collaborator(s)** as provided in Paragraph 5.2 without the prior written consent of the **IC**.

10 **LICENSEE PERFORMANCE**

10.1 A **Commercial Evaluation Plan** for this **Agreement** is provided in Appendix E. Based on this **Commercial Evaluation Plan**, performance **Benchmarks** are determined as specified in Appendix D**.**

10.2 The **Licensee** agrees to use reasonable commercial efforts to develop the **Licensed Products** and the **Licensed Processes**. The phrase “reasonable commercial efforts” for the purposes of this and subsequent Paragraphs shall include adherence to the **Commercial Evaluation Plan** in Appendix E and performance of the **Benchmarks** by the requisite deadlines in Appendix D.

10.3 If the **Licensee** is in default in the performance of any material obligation under this **Agreement**, including but not limited to, adherence to the **Commercial Evaluation Plan** in Appendix E and/or performance of the **Benchmarks** by the requisite deadlines in Appendix D, **Licensee** shall provide the **IC** with written notice within thirty (30) days of the default. Upon written approval that shall not be unreasonably withheld by the **IC**, the **Licensee** may be permitted to remedy the default within sixty (60) days after the date of written notice. The **IC** may terminate this **Agreement** by written notice if the **Licensee** has not reasonably remedied the default within ninety (90) days after the date of **Licensee**’s default.

10.4 The **Licensee** is encouraged to publish the results of its research projects using the **Licensed Patent Rights**, **Licensed Processes**, **Licensed Products** or the **Materials**. In all oral presentations or written publications concerning the **Licensed Patent Rights**, **Licensed Processes**, **Licensed Products** or the **Materials**, the **Licensee** shall acknowledge the contribution by the named inventors of the **Licensed Patent Rights**, **Licensed Processes**, **Licensed Products** or the **Materials**, unless requested otherwise by the **IC** or the named inventors.

11. **REPORTS ON PROGRESS, BENCHMARKS, COMMERCIAL DEVELOPMENT PLAN**

11.1 The **Licensee** shall provide written annual reports outlining results of its evaluation of the **Licensed Patent Rights**, the **Licensed Products**, **Materials**, and/or the **Licensed Processes** provided by this **Agreement** at the following times:

1. by no later than thirty (30) days prior to the end of the first anniversary of the **Effective Date** of this **Agreement**; and
2. withinthirty (30) days following the second anniversary of the **Effective Date** of this **Agreement**, or termination of this **Agreement**, whichever occurs earlier.

These reports shall describe **Licensee’s** efforts and progress in adhering to the **Commercial Evaluation Plan** for each of the **Licensed Field(s) of Use**. These reports shall also identify all **Third-Party Collaborator(s)** and **Third-Party Contractor(s)** who have received **Materials** or **Licensed Products** under this **Agreement**. The **Licensee** shall submit the report to the **IC** at the Mailing Address for **Agreement** notices indicated on the Signature Page.

11.2 The **Licensee**’s annual written reports shall include, but not be limited to, a description of the following that occurred during the preceding calendar year:

1. status of [*specific information related to Benchmark I as provided in Appendix D*];
2. status of [*specific information related to Benchmark II as provided in Appendix D*];
3. status of [*specific information related to Benchmark III as provided in Appendix D*]*;*
4. [*etc.*]

11.3 The **Licensee** agrees to provide sufficiently detailed information in these reports to allow the **IC** to reasonably evaluate **Licensee's** performance and its reasonable commercial efforts, as defined in Paragraph 10.2, required under this **Agreement**. If requested, the **Licensee** agrees to provide any additional information reasonably required by the **IC** to evaluate the **Licensee's** performance and its reasonable commercial efforts. The **IC** encourages these reports to include information on any of the **Licensee**'s public service activities that relate to the **Licensed Patent Rights.**

11.4 All plans and reports required by this Article 11 and marked “confidential” by the **Licensee** shall, to the extent permitted by law, be treated by the **NIH** as commercial and financial information obtained from a person and as privileged and confidential, and any proposed disclosure of these records by the **IC** under the Freedom of Information Act (FOIA), [5 U.S.C. §552](http://frwebgate.access.gpo.gov/cgi-bin/usc.cgi?ACTION=RETRIEVE&FILE=$$xa$$busc5.wais&start=187300&SIZE=125455&TYPE=TEXT) shall be subject to the predisclosure notification requirements of [45 C.F.R. §5.65(d).](http://edocket.access.gpo.gov/cfr_2002/octqtr/45cfr5.65.htm)

12. **TERM, TERMINATION, AND MODIFICATION OF RIGHTS**

12.1 This **Agreement** shall become effective as of the **Effective Date** unless the provisions of Paragraph 22 are not fulfilled and shall expire twenty-four (24) months from its **Effective Date**. Within sixty (60) days of the termination or expiration of this **Agreement**, unless an **IC** Exclusive or Non-exclusive Commercial Patent License has been executed for the **Licensed Patent Rights** in the **Licensed Field(s) of Use**,as stipulated in Paragraph 5.3 of this **Agreement**, the **Licensee** shall return all **Materials** and **Licensed Products** to the **IC** or provide the **IC** with written certification of their destruction. The **Licensee** further agrees that it shall be responsible for the destruction of any remaining **Materials** and **Licensed** **Products** from the **Third Party Collaborator(s)** and **Third Party Contractor(s)** to the **Licensee**, and the **Licensee** shall obtain written certification from the **Third Party Collaborator(s)** and **Third Party Contractor(s)** that any remaining **Materials** or **Licensed Products** in their possession have been destroyed and to provide **IC** with a copy of said written notification within sixty (60) days of the termination or expiration of this **Agreement**.

12.2 The **IC** reserves the right according to [35 U.S.C. §209(d)(3)](http://frwebgate.access.gpo.gov/cgi-bin/usc.cgi?ACTION=RETRIEVE&FILE=$$xa$$busc35.wais&start=560691&SIZE=6621&TYPE=TEXT) to terminate or modify this **Agreement** if it determines that this action is necessary to meet the requirements for public use specified by federal regulations issued after the date of the license and these requirements are not reasonably satisfied by the **Licensee**.

12.3 The **IC** shall specifically have the right to terminate or modify this **Agreement**, at its sole option, if the **IC** determines that the **Licensee**:

1. has not adhered to the **Commercial Evaluation Plan** in Appendix E, as may be amended by mutual agreement of the parties;
2. has not performed or has not exercised reasonable commercial efforts towards performance of the **Benchmarks** by the requisite deadlines specified in Appendix D, as may be modified under Paragraph 10.3;
3. has willfully made a false statement or willfully omitted a material fact in the license application or in any report required by this **Agreement**;
4. has committed a material breach of a covenant or agreement contained in this **Agreement**; or
5. cannot reasonably satisfy unmet health and safety needs.

12.4 Within thirty (30) days of receipt of written notice of the **IC**’s unilateral decision to modify or terminate this **Agreement**, the **Licensee** may, consistent with the provisions of [37 C.F.R. §404.11](http://ecfr.gpoaccess.gov/cgi/t/text/text-idx?c=ecfr&sid=b297ad6fa0fdbb0d78921540c692200c&rgn=div8&view=text&node=37:1.0.4.13.2.0.177.11&idno=37), appeal the decision by written submission to the designated **IC** official or designee. The decision of the designated **IC** official or designee shall be the final agency decision. The **Licensee** may thereafter exercise all administrative or judicial remedies that may be accessible.

12.5 The **Licensee** shall have a unilateral right to terminate this **Agreement** or any licenses in any country or territory by giving the **IC** sixty (60) days written notice to that effect.

12.6 Within thirty (30) days of expiration or termination of this **Agreement** under this Article 12, a final written report shall be submitted by the **Licensee** in accordance with Paragraph 11.1. The **Licensee** may not be granted additional **IC** licenses if this final reporting requirement is not fulfilled. Any royalty payments, including those incurred but not yet paid, and those related to patent expenses, due to the **IC** shall become immediately due and payable upon termination or expiration.

13. NO WARRANTIES, EXPRESS OR IMPLIED, ARE OFFERED AS TO THE FITNESS FOR ANY PURPOSE OF ANY **MATERIALS** PROVIDED OR THE **LICENSED PRODUCTS** PROVIDED TO THE **LICENSEE** UNDER THIS **AGREEMENT**, OR THAT THE **LICENSED PATENT RIGHTS** MAY BE EXPLOITED WITHOUT INFRINGING OTHER PATENT RIGHTS. The **Licensee** accepts license rights to the **Licensed Patent Rights**, the **Licensed Products**, the **Licensed Processes**, and the **Materials** “as is”, and the **IC** does not offer any guarantee of any kind.

14. The **Licensee** agrees to indemnify and hold harmless the **IC** and the **Government** from any claims, costs, damages, or losses that may arise from the practice of the **Licensed Patent Rights**, using the **Licensed Products** or the **Materials**, or practicing the **Licensed Processes**.

15. Nothing relating to the grant of a license, nor the grant itself, shall be construed to confer upon any person any immunity from or defenses under the antitrust laws or from a charge of patent misuse, and the acquisition and use of rights pursuant to [37 C.F.R. Part 404](http://ecfr.gpoaccess.gov/cgi/t/text/text-idx?c=ecfr&sid=229e70f008a519adf064927ea7b66fae&rgn=div5&view=text&node=37:1.0.4.13.2&idno=37) shall not be immunized from the operation of state or Federal law by reason of the source of the grant.

16. Neither party shall have any obligation to take any action regarding an infringement of **Licensed Patent Rights** by a third party.

17. This **Agreement** shall be construed in accordance with U.S. Federal law, as interpreted and applied by the U.S. Federal courts in the District of Columbia. Federal law and regulations shall preempt any conflicting or inconsistent provisions in this **Agreement**. The **Licensee** agrees to be subject to the jurisdiction of U.S. courts.

18. This **Agreement** constitutes the entire understanding of the **IC** and the **Licensee** and supersedes all prior agreements and understandings with respect to the **Licensed Patent Rights**, the **Materials**, the **Licensed Products**, and the **Licensed Processes**.

19. The provisions of this **Agreement** are severable, and if any provision of this **Agreement** shall be determined to be invalid or unenforceable under any controlling body of law, the invalidity or unenforceability of any provision of this **Agreement**, shall not in any way affect the validity or enforceability of the remaining provisions of this **Agreement**.

20. This **Agreement** shall not be assigned or otherwise transferred (including any transfer by legal process or by operation of law, and any transfer in bankruptcy or insolvency, or in any other compulsory procedure or order of court) without the prior written consent of the **IC**.

21. Paragraphs 10.4, 11, 12.4, 12.6, 13, 14, 16, and 21 of this **Agreement** shall survive termination of this **Agreement**.

22. The terms and conditions of this **Agreement** shall, at the **IC’s** sole option, be considered by the **IC** to be withdrawnfrom the **Licensee’s** consideration and the terms and conditions of this **Agreement**,and the **Agreement** itself to be null and void,unless this **Agreement** is executedby the **Licensee** and a copy of the fully executed **Agreement** is received by the **IC** within sixty (60) days from the date of the **IC’s** signature found at the Signature Page.

**NCI START-UP EXCLUSIVE EVALUATION OPTION LICENSE AGREEMENT**

**SIGNATURE PAGE**

For the **IC**:

\_\_\_\_\_\_\_\_\_\_\_\_ **DRAFT** \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Richard U. Rodriguez Date

Associate Director

Technology Transfer Center

National Cancer Institute

National Institute of Health

Mailing Address or E-mail Address for **Agreement** notices and reports:

Chief, Monitoring & Enforcement Branch

Office of Technology Transfer

National Institutes of Health

6011 Executive Boulevard, Suite 325

Rockville, Maryland 20852-3804 U.S.A.

E-mail: LicenseNotices\_Reports@mail.nih.gov

For the **Licensee** (upon information and belief, the undersigned expressly certifies or affirms that the contents of any statements of the **Licensee** made or referred to in this document are truthful and accurate):

by:

\_\_\_\_\_\_\_\_\_\_\_\_ **DRAFT** \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Signature of Authorized Official Date

Printed Name

Title

1. Official and Mailing Address for **Agreement** notices:

Name

Title

Mailing Address

Email Address:

Phone:

Fax:

1. Official and Mailing Address for Financial notices (the **Licensee’s** contact person for royalty payments)

Name

Title

Mailing Address:

Email Address:

Phone:

Fax:

Any false or misleading statements made, presented, or submitted to the **Government**, including any relevant omissions, under this **Agreement** and during the course of negotiation of this **Agreement** are subject to all applicable civil and criminal statutes including Federal statutes [31 U.S.C. §§3801-3812](http://frwebgate.access.gpo.gov/cgi-bin/usc.cgi?ACTION=BROWSE&TITLE=31USCSIII&PDFS=YES) (civil liability) and [18 U.S.C. §1001](http://frwebgate.access.gpo.gov/cgi-bin/usc.cgi?ACTION=RETRIEVE&FILE=$$xa$$busc18.wais&start=1925859&SIZE=10370&TYPE=TEXT) (criminal liability including fine(s) or imprisonment).

APPENDIX A – Patent(s) or Patent Application(s) and Materials

**Patent(s) or Patent Application(s):**

**Materials:**

APPENDIX B – Licensed Field(s) of Use and Territory

1. **Licensed Field(s) of Use:**
2. **Licensed Territory:**
	1. the United States, its territories, commonwealths and possessions; and
	2. [Any other countries in the **Licensed Territory**, if any]

APPENDIX C – Royalties

**Royalties:**

1. The **Licensee** agrees to pay to the **IC** a non-creditable, non-refundable license issue royalty according to the following schedule:
	1. Five thousand US dollars ($5,000.00 USD) within sixty (60) days of the **Effective Date** of this **Agreement.**
2. The **Licensee** agrees to pay to the **IC** a non-creditable, non-refundable patent reimbursement royalty according to the following schedule:
	1. Five thousand US dollars ($5,000.00 USD) on the one-year anniversary of the **Effective Date** of this **Agreement.**

APPENDIX D – Benchmarks and Performance

The **Licensee** agrees to the following **Benchmarks** for its performance under this **Agreement** and, within thirty (30) days of achieving a **Benchmark**, shall notify the **IC** that the **Benchmark** has been achieved.

1. [include initiation date and/or completion date]

APPENDIX E – Commercial EVALUATION Plan

Appendix F – Royalty Payment Options

New Payment Options Effective March 2018

**The License Number MUST appear on payments, reports and correspondence**.

**Credit and Debit Card Payments:** Credit and debit card payments can be submitted for amounts up to $24,999. Submit your payment through the U.S. Treasury web site located at: [**https://www.pay.gov/public/form/start/28680443**](https://www.pay.gov/public/form/start/28680443)**.**

**Automated Clearing House (ACH) for payments through U.S. banks only**

The **IC** encourages its licensees to submit electronic funds transfer payments through the Automated Clearing House (ACH). Submit your ACH payment through the U.S. Treasury web site located at: <https://www.pay.gov/public/form/startJ28680443>. Please note that the IC "only" accepts ACH payments through this U.S. Treasury web site.

**Electronic Funds Wire Transfers:** The following account information is provided for wire payments. In order to process payment via Electronic Funds Wire Transfer sender MUST supply the following information within the transmission:

Drawn on a **U.S. bank account** via FEDWIRE:

Please provide the following instructions to your Financial Institution for the remittance of Fedwire payments to the **NIH ROYALTY FUND**.

| Fedwire Field Tag | Fedwire Field Name | Required Information |
| --- | --- | --- |
|  |
| {1510} | Type/Subtype | **1000** |
| {2000} | Amount | *(enter payment amount)* |
| {3400} | Receiver ABA routing number\* | **021030004** |
| {3400} | Receiver ABA short name | **TREAS NYC** |
| {3600} | Business Function Code | **CTR** (*or CTP*) |
| {4200} | Beneficiary Identifier (account number) | *(enter 12 digit gateway account #)***875080031006** |
| {4200} | Beneficiary Name | *(enter agency name associated with the Beneficiary Identifier)***DHHS / NIH (75080031)** |
| {5000} | Originator | *(enter the name of the originator of the payment)***COMPANY NAME** |
| {6000} | Originator to Beneficiary Information – Line 1 | *(enter information to identify the purpose of the payment)***ROYALTY** |
| {6000} | Originator to Beneficiary Information – Line 2 | *(enter information to identify the purpose of the payment)***LICENSE NUMBER** |
| {6000} | Originator to Beneficiary Information – Line 3 | *(enter information to identify the purpose of the payment)****INVOICE NUMBER*** |
| {6000} | Originator to Beneficiary Information – Line 4 | *(enter information to identify the purpose of the payment)* |
| Notes: \*The financial institution address for Treasury’s routing number is 33 Liberty Street, New York, NY 10045. |

**Agency Contacts**: Office of Technology Transfer (OTT) (301) 496-7057 OTT-Royalties@mail.nih.gov

Drawn on a **foreign bank account** via FEDWIRE:

The following instructions pertain to the Fedwire Network. Deposits made in US Dollars (USD).

Should your remitter utilize a correspondent US domestic bank in transferring electronic funds, the following Fedwire instructions are applicable.

| Fedwire Field Tag | Fedwire Field Name | Required Information |
| --- | --- | --- |
|  |
| {1510} | Type/Subtype | **1000** |
| {2000} | Amount | *(enter payment amount)* |
| {3100} | Sender Bank ABA routing number | *(enter the US correspondent bank’s ABA routing number)* |
| {3400} | Receiver ABA routing number\* | **021030004** |
| {3400} | Receiver ABA short name | **TREAS NYC** |
| {3600} | Business Function Code | **CTR** (*or CTP*) |
| {4200} | Beneficiary Identifier (account number)\*\* | *(enter 12 digit gateway account #)***875080031006** |
| {4200} | Beneficiary Name | *(enter agency name associated with the Beneficiary Identifier)***DHHS / NIH (75080031)** |
| {5000} | Originator | *(enter the name of the originator of the payment)***COMPANY’S NAME** |
| {6000} | Originator to Beneficiary Information – Line 1 | *(enter information to identify the purpose of the payment)***ROYALTY** |
| {6000} | Originator to Beneficiary Information – Line 2 | *(enter information to identify the purpose of the payment)***LICENSE NUMBER** |
| {6000} | Originator to Beneficiary Information – Line 3 | *(enter information to identify the purpose of the payment)****INVOICE NUMBER*** |
| {6000} | Originator to Beneficiary Information – Line 4 | *(enter information to identify the purpose of the payment)* |
| Notes:  \*The financial institution address for Treasury’s routing number is 33 Liberty Street, New York, NY 10045.\*\*Anything other than the 12 digit gateway account # will cause the Fedwire to be returned – **SWIFT CODE: FRNYUS33** |

**Agency Contacts**:

Office of Technology Transfer (OTT) (301) 496-7057 OTT-Royalties@mail.nih.gov

**Checks**

All checks should be made payable to “NIH Patent Licensing”

Checks drawn on a **U.S. bank account** and sent by US Postal Service should be sent directly to the following address:

National Institutes of Health

P.O. Box 979071

St. Louis, MO 63197-9000

Checks drawn on a U.S. bank account and sent by **overnight or courier** should be sent to the following address:

US Bank

Government Lockbox SL-MO-C2GL

1005 Convention Plaza

St. Louis, MO 63101

Phone: 314-418-4087

Checks drawn on a **foreign bank account** should be sent directly to the following address:

National Institutes of Health

Office of Technology Transfer

License Compliance and Administration

Royalty Administration

6011 Executive Boulevard

Suite 325, MSC 7660

Rockville, Maryland 20852

APPENDIX G – SHIPPING INFORMATION

**The Licensee’s Shipping Contact: information or questions regarding shipping should be directed to the** **Licensee’s Shipping Contact at:**

Shipping Contact’s Name Title

Phone: () Fax: () E-mail:

**Shipping Address: Name & Address to which Materials should be shipped (please be specific):**

Company Name & Department

Address:

The **Licensee’s** shipping carrier and account number to be used for shipping purposes:

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