

Licensor - 대학교수, 대학, 연구소 및 벤처회사 vs 제약회사 Licensee 사이의 바이오신

약 후보물질 특허기술 라이선스 계약서에 포함된 sublicense 관련 계약조항 샘플



1.26 "**Sublicense**" shall mean any right granted, sublicense conferred or agreement entered into, between the Licensee and a Third Party permitting any use of the Licensed IP Rights, directly or indirectly, to make, or have made, develop, offer for sale, sell or otherwise commercialize any Licensed Product; provided, however, that a Sublicense shall exclude a bona fide agreement for the evaluation, testing, research, development on behalf of Kite or its Affiliates, or manufacturing on behalf of the Licensee or its Affiliates, or a distributor or reseller agreement, all pursuant to which no Sublicense Revenues are paid to the Licensee.

1.27 "**Sublicense Revenues**" shall mean, with respect to a Sublicense, the aggregate cash

(or cash equivalent) or stock or securities (or their equivalent) consideration received by the Licensee or its Affiliates to the extent in consideration for such Sublicense, including consideration for an option to obtain such Sublicense. Such consideration shall include without limitation any upfront, license initiation or signing fees, license maintenance fees, milestone payments, unearned portion of any minimum annual royalty payment or equity. Sublicense Revenues shall exclude [*].

3. LICENSE GRANT

3.1 **Licensed IP Rights**. Subject to Section 3.2 below, the Licensor Cabaret hereby grants to the Licensee Kite an exclusive (other than as set forth in Section 3.2 and 3.4 below) worldwide royalty bearing license (with the right to grant sublicenses through multiple tiers as set forth hereunder) under the Licensed IP Rights to research, have researched, develop , have developed, make, have made, use, offer for sale, sell, import, export, commercialize and otherwise exploit Licensed Products for use in the Field. Subject to the conditions set forth in Section 3.9 the foregoing license includes the right to grant sublicenses under the Licensed IP Rights, provided that, with respect to sublicenses granted under, Kite shall (a) grant such sublicenses only for consideration and at arm's-length transactions, and (b)

grant such sublicenses only pursuant to written agreements that contain such terms and conditions as may be required for Kite to comply with this Agreement.

3.2 **License Restrictions**. The license granted in Section 3.1 above is and shall remain at all times subject to the following restrictions (and Kite shall ensure that any of its Sublicensee's shall be subject such restrictions): (i) the Licensor Dr. Eshhar, the Regents and the Government of the United States (the "Government") reserve the right to use the Patents Rights and associated technology licensed under the Inter-Institutional Agreement last executed on June 22, 2012 ("UCSF IIA"), between Dr. Eshhar, BioSante and The Regents, and disclosed to Kite under Section 2.2.5 above, and the Inter-institutional Agreement dated 19.11.2013 ("NIH Agreement"), for educational and research purposes; (ii) nothing in this Agreement shall confer by estoppel, implication or otherwise, any license or rights under any patents of the Regents other than those patents rights detailed in the UCSF IIA, regardless of whether such patents are dominant or subordinate to the Patents Rights defined in the UCSF IIA; (iii) Kite shall not use the name or trademark or logo of the University of California or any campus thereof; in each case to the extent required by the UCSF HA; (iv) the license is subject to the provisions of 37 C.F.R. Part 401 and the rights retained by the Government under the NIH Agreement; and (v) until the last to expire of

U.S. Patent 8,211,422 issued July 3, 2012 from Patent Application 08/547,263 filed October 24, 1995 entitled "Chimeric Receptor Genes and Cells Transformed Therewith" and US Patent Application 13/281,560 filed October 26, 2011 entitled "Chimeric Receptor Genes and Cells Transformed Therewith" (hereinafter referred to as the "NIH Patent Estate") any products embodying the Licensed Patent Rights, or produced through use of the Licensed Patent Rights, shall be manufactured substantially in the United States unless a waiver is granted by the NIH; provided that NIH may waive this requirement upon Kite's written request which shall not be unreasonably denied; (vi) until the last to expire of the NIH Patent Estate, the Government shall have the irrevocable, royalty-free, paid-up right to practice and have practiced the NIH Patent Estate and Eshhar patents 5,906,936 and 7,741,465, 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; (vii) until the last to expire of the NIH Patent Estate, the NIH reserves the right to require Cabaret, or its licensees, to grant sublicenses to the patent rights to responsible applicants, on terms that are reasonable under the circumstances when necessary to fulfill health or safety needs or when necessary to meet requirements for public use specified by Federal regulations; and (viii) until the last to expire of the NTH Patent Estate, in addition to the reserved right of Section 3.2(vi),

the NIH reserves the right to require Cabaret to grant research licenses to the patent rights on reasonable terms and conditions, for the purpose of encouraging basic research, whether conducted at an academic or corporate facility.

3.4 **No implied licenses are set forth herein.** Except for those licenses expressly granted hereunder in the Field, Cabaret does not grant to Kite any other licenses, either within or without the Field. Kite specifically understands and agrees that except as explicitly set forth herein, Cabaret reserves all rights under the Licensed IP Rights to make, have made, use, sell, offer for sale, import, export, distribute and otherwise exploit products incorporating the Licensed IP Rights outside the Field. Without derogating from the generality in Section 3.2 above, Dr. Eshhar and Cabaret reserve the right to use all Licensed IP Rights licensed hereunder for educational and noncommercial research purposes in any and all fields.

3.5 **In-Licenses.** The Licensor Cabaret shall timely pay in full all amounts required to be paid by Cabaret, and timely perform in full all obligations required to be performed by Cabaret, under all In-Licenses. Cabaret promptly shall provide the Licensee Kite with copies of all notices and other deliveries received under the In-Licenses. Without the prior express

written consent of Kite, Cabaret shall not (and shall take no action or make no omission to) modify or waive any provision of any In-License that could impair the value of the licenses to Kite herein, or to terminate or have terminated any In-License. If any In-License is terminated for any reason, Cabaret shall make all reasonable efforts to ensure that the Licensor thereunder shall grant a direct license under the Licensed IP Rights thereunder to Kite containing terms and conditions no less favorable to Kite than the terms (including the payment terms) of such In-License, and Kite shall have the right to offset all payments thereunder against any amounts owing to Cabaret hereunder.

3.6 **Availability of the Licensed IP Rights.** The Licensor Cabaret shall provide the Licensee Kite with a copy of all information available to Cabaret relating to the Licensed IP Rights or Licensed Products.

3.7 **Technical Assistance.** Cabaret and Dr. Eshhar shall provide such technical assistance to Kite as Kite reasonably requests regarding the Licensed IP Rights. Kite shall pay to Cabaret and Dr. Eshhar their documented reasonable out-of-pocket costs of providing such technical assistance.

3.8 **Right of First Offer.** In the event that Cabaret proposes to enter into an agreement with any Third Party for the grant to any Third Party of any license, immunity, right or interest of any type whatsoever in or under the Licensed Patent Rights outside the Field, Cabaret shall as soon as practicable notify Kite of such intention (the "Company Notice"), and the Licensee Kite shall have the right, to be exercised by notice to Cabaret to express its interest to negotiate with Cabaret regarding receipt of such license within a period of [*] after the date of the Company Notice (such period, the "Negotiation Period"). During the Negotiation Period, Kite will notify Cabaret within [*] of its interest to negotiate with Cabaret, and in such event Cabaret shall negotiate in good faith with Kite regarding receipt of such license. To the extent that Kite notified Cabaret of its interest to negotiate with Cabaret, as set forth above, prior to the expiration of the Negotiation Period, Cabaret shall not enter into any definitive binding agreement of any kind with a Third Party in relation to such license (other than relating to access to information).

3.9 **Sublicenses.** The Licensee Kite shall be entitled to grant Sublicenses, provided, however, that all Sublicenses shall be subject to the following conditions:

3.9.1 The Licensee Kite shall execute a written sublicense with each Sublicensee, which mirrors the restrictive terms hereof and shall provide Cabaret with a copy of each such written sublicense within [*] of execution (and all amendments and modifications thereto within [*] of execution). Kite shall report pursuant to the terms of this Agreement Net Sales of the Licensed Product by all Sublicensees and

3.9.2 The Licensee Kite shall use reasonable efforts to add to the Sublicense agreement a clause stating that, in case of a default of payment due by Kite of royalties owing on Net Sales by a Sublicensee, which is not cured within [*] after notice in accordance with this Agreement, then upon the written request of Cabaret, such Sublicensee will make future royalty payments and furnish the reports and documents that are required to be paid or furnished by Kite pursuant to this Agreement with respect to Net Sales by such Sublicensee directly to Cabaret.

3.9.3 The Licensee Kite shall, and by this Agreement herewith does, agree to cause its Sublicensees to assume and agree to perform all of the relevant covenants and obligations

of Kite to Cabaret contained in this Agreement as fully and to the same extent as if its Sublicensees were Kite hereunder and guarantees Cabaret that its Sublicensees shall abide by each and every applicable provision of this Agreement.

4.5 **Sublicense Fees**. Subject to the terms and conditions of this Agreement, with respect to each Sublicense with respect to a Licensed Product, Kite shall pay to Cabaret sublicense fees equal to the applicable percentage set forth below of the Sublicense Revenue therefrom (based on the effective date of such Sublicense) (“Sublicense Fees”):

Notwithstanding the foregoing, with respect to any Sublicense Fees paid to Cabaret on account of Sublicense Revenues received by Kite from a Sublicensee in connection with the achievement of any technical, development, regulatory through commercial launch milestone event for a Licensed Product, Kite shall deduct from such Sublicense Fees the milestone payments made by Kite to Cabaret pursuant to Section 4.5 above with respect to the same Licensed Product.

국제계약, 영문계약, 계약분쟁, 지체상금, 손해배상, 민형사소송, Claim, License, R&D 제휴계약

T. 02-591-0657 E. kkh@kasanlaw.com H. www.kasanlaw.com