



LICENSE AGREEMENT

BETWEEN

Company Name

AND

CORNELL UNIVERSITY

FOR

DOCKET NO. D-5062

**License for
Certified Seed Production**

'Upstate Abundance' (NY 150) Potato

This Agreement, entered into the first day of October, 2020 ("Effective Date"), by and between Cornell University ("Cornell"), as represented by the Center for Technology Licensing at Cornell University, having offices at 395 Pine Tree Road, Suite 310, Ithaca, NY 14850 ("CTL"), and _____, having physical business offices at _____ ("Licensee"), hereinafter each individually "Party" and collectively "Parties". The Parties witness that:

RECITALS

WHEREAS, the Licensed Variety (as defined below), documented in CTL Disclosure Docket D-5062, was made in the course of research at Cornell by its plant breeder, Dr. Walter S. De Jong ("Breeder") and are covered by Plant Rights; and

WHEREAS, the Breeder is employed by Cornell, and is obligated to assign all of their rights, title and interest in and to the Licensed Variety, including any Plant Rights (as defined below in 1.7) therein, to Cornell;

WHEREAS, CTL is authorized by Cornell to manage the Licensed Variety and Plant Rights therein and to grant rights thereto to third parties to advance the missions of Cornell;

WHEREAS, CORNELL has designated the New York Seed Improvement Project ("NYSIP") to assist CTL in the management and licensing of certain plant lines developed by CORNELL; and

WHEREAS, LICENSEE desires to obtain certain rights from Cornell for the use and commercialization of Licensed Variety in the Territory (as defined below in 1.5), and Cornell is willing to grant such rights upon and subject to the terms and conditions of this Agreement.

Now therefore, the Parties agree as follows:

1. DEFINITIONS

For the purposes of this Agreement, the definitions below shall have the same meaning in both their plural and singular forms.

1.1 "Affiliate" means any corporation or other business entity that is bound in writing by Licensee to the terms set forth in this Agreement and in which Licensee owns or controls, directly or indirectly, at least fifty percent (50%) of the outstanding stock or other voting rights entitled to elect directors, or in which Licensee is owned or controlled directly or indirectly by at least fifty percent (50%) of the outstanding stock or other voting rights entitled to elect directors; provided, however, that in any country where the local law does not permit foreign equity participation of at least fifty percent (50%), then an "Affiliate" includes any company in which Licensee owns or controls or is owned or controlled by, directly or indirectly, the maximum percentage of outstanding stock or voting rights permitted by local law.

- 1.2 “Field”** means the propagation of the Licensed Variety for external and internal sale for commercial production purposes.
- 1.3 “Net Sales”** means (a) the aggregate sum of all gross invoice prices of, plus the fair market value of any non-cash consideration received from, Licensed Variety sold by Licensee or its Affiliates in the Territory, less (b) the aggregate sum of the following actual and customary deductions, where applicable and separately listed: (i) cash, trade, or quantity discounts; (ii) sales, use, tariff, import/export duties or other excise taxes imposed on particular sales (except for income taxes imposed on the sales of License Variety in foreign countries); (iii) transportation charges; and (iv) credits to customers because of rejections or returns. For purposes of calculating Net Sales, a transfer to an Affiliate of a Licensed Variety under this Agreement for end use (but not resales) by Affiliate shall be treated as a sale by Licensee at the list price of Licensee for such Licensed Variety in an arms-length transaction; a transfer within the Licensee from seed production facility to commercial producing facility is considered an internal sale which shall be part of the Net Sales
- 1.4 “Licensed Variety”** means “Potato (NY150) ‘Upstate Abundance’” and any progeny, derivatives, portions, seeds, plants, vegetative parts, propagules and genetic materials derived therefrom, developed in the course of research at Cornell.
- 1.5 “Territory”** means United States of America.
- 1.6 “Term”** means the period of time beginning on the Effective Date and ending on September 30, 2021, but may be automatically renewed annually, if all obligations are met by the Licensee.
- 1.7 “Plant Rights”** means Cornell’s right in the United States Plant Variety Protection, Certificate No. 201700299.
- 1.8 “Certified Seed”** shall mean foundation and registered seed handled under procedures acceptable to the Department of Agriculture and Forestry to maintain satisfactory genetic purity and identity as defined according the standards of the official seed certification agency having jurisdiction in the area of production.

2. GRANT OF RIGHTS

- 2.1 License.** Cornell hereby grants to Licensee a non-exclusive license to produce, label, sell, and market Certified Seed of Licensed Variety under Plant Rights in the Field in the Territory. Production of Certified Seed of Licensed Variety is restricted to Licensee and or Licensee’s contract growers who are contractually obligated under the terms and conditions of this Agreement.
- 2.2** Unauthorized propagation of the Licensed Variety is prohibited. Licensee is prohibited from producing, labeling, marketing, or transferring seed of the Licensed Variety for propagation purposes to any third party inside or outside of the Territory without prior written permission of CTL. Licensee may transfer seed of the Licensed Variety to another holder of a valid license for the Licensed Variety only with prior written approval of CTL or its designee, NYSIP.
- 2.3 Reservation of Rights.** Cornell reserves all rights to use Licensed Variety and Plant Rights and to further grant such rights to third parties.

3. CONSIDERATION

3.1 Licensee shall pay to CTL a royalty rate of either:

- (a) three percent (3%) of Net Sales of Licensed Variety Certified Seed and the generations related to Certified Seed that can be covered by certification as allowed by law sold by Licensees based in New York State; or
- (b) four percent (4%) of Net Sales of Licensed Variety Certified Seed and the generations related to Certified Seed that can be covered by certification as allowed by law sold by Licensees based outside of New York State and within the Territory;

Cornell reserves the right to adjust the royalty rates after one full growing seasons notice.

3.2 **Performance and Diligence.** Licensee shall have reasonable practices to insure the quality and reputation of the Licensed Variety: a) Licensed Variety may be sold only as Certified Seed (or equivalent); b) Licensees must include a notice when listing in catalogs that the Licensed Variety is protected under applicable certificate number or equivalent; c) Licensee will implement and monitor quality assurance standards as detailed in 6.1 and 6.2 for all contract growers authorized for commercial use of Licensed Variety; d) All production of seed of the Licensed Variety that fails to meet Seed Certification Standards as detailed in 6.1 and 6.2 GOVERNMENT MATTERS AND QUALITY ASSURANCE shall be used or marketed only for food or animal feed purposes, and no royalty shall be owed on such sales provided that, on an annual basis, the amount of seed sold for such purposes does not exceed 20% of the total production by Licensee.

4. REPORTS, RECORDS AND PAYMENTS

4.1 (a) **Production Reports,** shall be due annually on or before October 1st for activities including commercialization and certification efforts related to the Licensed Variety during the prior 12 month period beginning upon October 1st and ending September 30th. Please include the status of the Licensed Variety e.g. Nuclear = “N”; Generation = “G”, G1, G2, G3...; Field Year = “FY”, FY1, FY2, FY3...; Certified “C”; Foundation = “F”; or the terms used by your local certification agency for seed potatoes relating to specific criteria to disease tolerances and other requirements, increasing inventory efforts, etc.

(b) **Royalty Reports.** Licensee shall submit to Cornell a Royalty Report annually on or before October 1st for the sales of Licensed Variety during the prior 12 month period beginning October 1st and ending on September 30th of that year. Licensee may use the Royalty Report provided in Exhibit A.

4.2 **Records & Audits.** Licensee shall keep accurate and correct records of (1) all the Licensed Variety maintained; and (2) the quantity of Licensed Variety produced and sold under this Agreement. Such records shall be retained by Licensee for at least five (5) years following a given reporting period. Upon request, LICENSEE shall make its books and records available for auditing by CTL or NYSIP or another designated agent for the purpose of verifying the amount of royalties due. Licensee hereby consents to release of certification records by NYSIP or other certification agency to CTL for the purposes of verification of royalties due.

4.3 Payments. All royalty-bearing sales of the Licensed Variety made by Licensee shall be reported and paid by October 1st following the Term of the Agreement with respect to seed sales from the previous crop year (see Exhibit A for an example report). In the event royalty payments are not received by CTL when due, Licensee shall pay to CTL interest charges at a rate of ten percent (10%) per year. Such interest shall be calculated from the date payment was due until actually received by CTL.

5. [THIS SECTION IS INTENTIONALLY LEFT BLANK.]

6. GOVERNMENTAL MATTERS & QUALITY ASSURANCE

6.1 All seed production of the Licensed Variety in the Field will be inspected according to the standards of NYSIP or another official seed certification agency having jurisdiction in the area of production, and all production of the Licensed Variety which is sold for seed must be approved as Certified Seed by an official seed certification agency and be labeled with a certified class seed tag or other indicia of official certification.

6.2 LICENSEE shall label all bags and containers of Certified Seed of the Licensed Variety with the words “Unauthorized Propagation Prohibited – U.S. Protected Variety – 1994 PVPA”.

7. TERMINATION OF AGREEMENT

7.1 Upon termination by either Party or expiration of this Agreement, Licensee’s authorization to produce, label, and market Certified Seed of the Licensed Variety shall cease. However, any obligation of Licensee to pay CORNELL royalties or fees shall survive the termination or expiration of this Agreement.

7.2 If CTL or NYSIP determine that Licensee is in breach of any term or condition of this Agreement, CTL shall so notify Licensee in writing. Upon receipt of such notification, Licensee shall have thirty (30) days to cure said breach to the satisfaction of CTL.

8. LIMITED WARRANTY AND INDEMNIFICATION

8.1 Limited Warranty.

- (a) Cornell warrants that it is the owner of the Licensed Variety it delivers to Licensee.
- (b) ALL LICENSED VARIETY ARE PROVIDED “AS IS” AND WITHOUT WARRANTY OF MERCHANTABILITY OR WARRANTY OF FITNESS FOR A PARTICULAR PURPOSE OR ANY OTHER WARRANTY, EXPRESS OR IMPLIED. Cornell has no knowledge that the use of the Licensed Variety will infringe any proprietary right of third parties and makes no, and expressly disclaims any and all, representations or warranties that the Licensed Variety will not infringe any proprietary right of third parties.
- (c) In no event shall Cornell be liable for any incidental, special or consequential damages resulting from the use of the Licensed Variety.

- (d) Nothing in this Agreement shall be construed as:
 - (i) a warranty or representation that anything made, used, sold or otherwise disposed of under this Agreement is or shall be free from infringement of rights of third parties;
 - (ii) an obligation to bring or prosecute actions or suits against third parties;
 - (iii) conferring by implication, estoppel or otherwise any rights to plants other than the limited permission to use the Licensed Variety as provided under this Agreement as defined in this Agreement, regardless of the parentage or lineage of those plants; or
 - (iv) an obligation to furnish any know-how related to the Licensed Variety.

8.2 Indemnification.

- (a) Licensee shall indemnify, hold harmless and defend New York State Agricultural Experiment Station, Cornell, their officers, employees, and agents, and the sponsors of the research that led to the development of the Licensed Variety against any and all claims, suits, losses, damage, costs, fees, and expenses resulting from or arising out of exercise of this Agreement. This indemnification shall include, but not be limited to, any product liability with respect to the sale and use of Licensed Variety.
- (b) Licensee, at its sole cost and expense, shall insure its activities in connection with the work under this Agreement and obtain, keep in force, and maintain an adequate insurance or an equivalent program of self-insurance.
- (c) Licensee shall, upon request, furnish Cornell a written record of its insurance specifying the coverage amount. If Licensee self-insures, Licensee shall so state and also provide Cornell a copy of its latest official annual report or tax report.
- (d) Cornell shall notify Licensee in writing of any claim or suit brought against Cornell in respect of which Cornell intends to invoke the provisions of this Section. Licensee shall keep Cornell informed on a current basis of its defense of any claims under this Section.

9. RESTRICTION ON USE OF NAME AND CONFIDENTIALITY

9.1 Use of Name. Nothing contained in this Agreement confers any right to use in advertising, publicity, or other promotional activities any name, trade name, trademark, or other designation of either Party hereto (including contraction, abbreviation or simulation of any of the foregoing) except for the statement “*All or part of the genetics of this Licensed Variety were developed at and provided by Cornell University.*” Unless required by law, the use by Licensee of the name, “Cornell University” or “New York State Agricultural Experiment Station” in any other manner without the express written consent of Cornell or the New York State Agricultural Experiment Station is prohibited.

9.2 Confidential Information shall mean any non-public information disclosed by Cornell to Licensee prior to or during the Term, including information relating to finances, the Licensed Variety, or other subject matter, whether or not such information is marked “Confidential”.

10. MISCELLANEOUS PROVISIONS

10.1 Correspondence. Any notice, invoice or payment required to be given to either Party under this Agreement shall be deemed to have been properly given and effective:

- (a) on the date of delivery if delivered in person;
- (b) on the date of successful transmission if sent by facsimile,
- (c) one (1) day after the successful transmission in pdf file format if sent by electronic mail using the Internet; or
- (d) five (5) days after mailing if mailed by first-class or certified mail, postage paid, to the respective addresses given below or to such other address as is designated by written notice given to the other Party.

If sent to Licensee:

Company Name: _____
Address: _____
Attention: _____
Tel: _____
Fax: _____
Email: _____

If sent to Cornell:

For all correspondence *except payments*
Center for Technology Licensing at Cornell University
Attention: Executive Director
395 Pine Tree Road, Suite 310
Ithaca, NY 14850
FAX: 607-254-5454
TEL: 607-254-4698
EMAIL: ctl-contracts@cornell.edu

For all payments –

If sent by mail:

Center for Technology Licensing at Cornell University
PO Box 6899
Ithaca, NY 14851-6899

If remitted by electronic payments via ACH or Fed Wire:

Receiving bank name: Tompkins Trust Co.
Bank account no.: 0111000065
Bank routing (ABA) no.: 021302648
SWIFT code: TMPKUS33
Bank account name: Cornell University
Bank ACH format code: Not required
Bank address: P.O. 460, Ithaca, NY 14850
Additional information: Reference D-5062
Agreement No.: <to be assigned>

An email copy of the transaction receipt shall be sent to ctl-contracts@cornell.edu. Licensee is responsible for all bank charges of wire transfer of funds for payments. The bank charges shall not be deducted from the total amount due to Cornell.

10.2 [This paragraph is intentionally left blank.]

10.3 Assignability. This Agreement may be assigned by Cornell, but is personal to Licensee and assignable by Licensee only with the written consent of Cornell.

10.4 No Waiver. No waiver by either Party of any breach or default of any covenant or agreement set forth in this Agreement shall be deemed a waiver as to any subsequent and/or similar breach or default.

10.5 Failure to Perform. In the event of a failure of performance due under this Agreement and if it becomes necessary for either Party to undertake legal action against the other on account thereof, then the prevailing Party in such action shall be entitled to reasonable attorney's fees, in addition to costs and necessary disbursements.

10.6 Governing Law. THIS AGREEMENT SHALL BE INTERPRETED AND CONSTRUED IN ACCORDANCE WITH THE LAWS OF THE STATE OF NEW YORK, without giving effect to its choice of law principles, provided that the United Nations Convention on Contracts for the International Sale of Goods shall not apply.

The Parties agree to the exclusive jurisdiction of the federal or state courts of New York, United States, and of any competent court of appeal, as regards any current or future dispute involving this Agreement.

10.7 Force Majeure. A party to this Agreement may be excused from any performance required herein if such performance is rendered impossible or unfeasible due to any catastrophe or other major event beyond its reasonable control, including, without limitation, war, riot, and insurrection; laws, proclamations, edicts, ordinances, or regulations; strikes, lockouts, or other serious labor disputes; and floods, fires, explosions, or other natural disasters. When such events have abated, the non-performing party's obligations herein shall resume.

10.8 Headings. The headings of the several sections are inserted for convenience of reference only and are not intended to be a part of or to affect the meaning or interpretation of this Agreement.

10.9 Entire Agreement. This Agreement embodies the entire understanding of the Parties and supersedes all previous communications, representations or understandings, either oral or written, between the Parties relating to the subject matter hereof.

10.10 Amendments. No amendment or modification of this Agreement shall be valid or binding on the Parties unless made in writing and signed on behalf of each Party.

NYSIP

10.11 Severability. In the event that any provision contained in this Agreement is held to be invalid, illegal, or unenforceable in any respect, such invalidity, illegality or unenforceability shall not affect any other provisions of this Agreement, and this Agreement shall be construed as if the invalid, illegal, or unenforceable provision had never been contained in it.

IN WITNESS WHEREOF, both Cornell and Licensee have executed this Agreement, in duplicate originals, by their respective and duly authorized officers on the day and year written.

LICENSEE: _____

CORNELL UNIVERSITY:

By: _____
[Authorized Signature]

By: _____
[Authorized Signature]

Print: _____

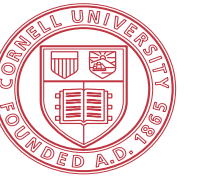
Print: Alice Li, Ph.D.

Title: _____

Title: Executive Director, CTL

Date: _____

Date: _____



Company Name	CTL Agreement No.	Your Reference No.
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Reporting Period (mm/dd/yyyy)
 From ____ / ____ / ____ Through ____ / ____ / ____

		Sales Inside New York State					Sales Outside of New York State					Annual Sales		
		(A)	(B)	(C)	(D)	(E)	(F)	(G)	(H)					
Licensed Line/Variety CTL Docket No./Contract No.	Do you wish to continue licensing this material? Y/N*	# Plant Units Sold if applicable	Sale Price Per Unit	Seed Sales (\$) if applicable	Royalty Rate	Total (\$) Royalty Due (AxC) and/or (BxC)	# Plant Units Sold if applicable	Sale Price Per Unit	Seed Sales (\$) if applicable	Royalty Rate	Total (\$) Royalty Due (ExG) and/or (FxG)	Total Plant Units Sold (A+E)	Total Seed Sales (B+F)	Total Due for this Line/Variety (D+H)
SAMPLE														
OTHER VARIETIES/DOCKETS														
Total Payment Enclosed														

* If you answer No, a Termination Notice will follow within a few weeks of receipt of this report.

During this time have any of the following occurred:	Description (Additional attachments may be included, if space is limited)
Type(s) and number(s) of Derived Varieties developed, discovered or isolated during the applicable License Year	
Sublicenses granted and the name and address of each Sublicensee. Please submit copies of sublicenses, if required in agreement.	
Register of trees planted of the Licensed Variety, including the address and owner of orchards in which the trees were planted, number and types of trees planted, and total hectares planted	
Detailed description of progress in growing and commercializing the Licensed Product	
Research and development results and expenditures related to the Licensed Variety and Licensed Products in the applicable License Year	
Countries in which Licensee has one or more pending or granted registrations on National List(s) for commercial activities with respect to Licensed Products	
Detailed description of the promotion and marketing efforts made to maximize sales of Licensed Products in the Territory during the applicable License Year	
Issues encountered in commercializing the Licensed Products	

SAMPLE

REQUIRED FOR POTATO VARIETIES ONLY PRODUCTION REPORT - activities and efforts related to the Licensed Variety. Please include the status of the Licensed Variety e.g. Nuclear = "N"; Generation = "G", G1, G2, G3...; Field Year = "FY", FY1, FY2, FY3...; Certified "C"; Foundation = "F"; or the terms used by your local certification agency for seed potatoes relating to specific criteria to disease tolerances and other requirements, increasing inventory efforts, etc. (Additional attachments may be included, if space is limited)

Report Prepared & Approved By	
Name (Please Print)	Email
Signature	Date (mm/dd/yyyy) _____ / _____ / _____