

INTELLECTUAL PROPERTY RIGHTS AGREEMENT

Between

THE REGENTS OF THE UNIVERSITY OF CALIFORNIA, ON BEHALF OF ITS SANTA BARBARA CAMPUS

And

THE REGENTS OF THE UNIVERSITY OF CALIFORNIA, ON BEHALF OF ITS RIVERSIDE CAMPUS

And

CALIFORNIA STATE POLYTECHNIC UNIVERSITY POMONA

This Intellectual Property Rights Agreement (“Agreement”) is by and between THE REGENTS OF THE UNIVERSITY OF CALIFORNIA, ON BEHALF OF ITS SANTA BARBARA CAMPUS, a California corporation, having an Office of Technology & Industry Alliances located at 342 Lagoon Road, Santa Barbara, California 93106-2055 (“University of California, Santa Barbara”), THE REGENTS OF THE UNIVERSITY OF CALIFORNIA, ON BEHALF OF ITS RIVERSIDE CAMPUS, a California corporation, having an Office of Technology Partnerships located at 900 University Drive, Riverside, California 92521 (“University of California, Riverside”), and the CALIFORNIA STATE POLYTECHNIC UNIVERSITY POMONA, a California Corporation, having an Office of Research, Innovation, and Economic Development, having a principal place of business at 3801 West Temple Ave., Pomona, CA 91768 (“California State Polytechnic University Pomona.”).

WHEREAS, the parties are collaborating under a cooperative agreement award received from the National Science Foundation under solicitation number NSF 23-585, BioFoundries to Enable Access to Infrastructure and Resources for Advancing Modern Biology and Biotechnology; and

WHEREAS, an Intellectual Property Rights Agreement must be developed and signed by the awardee and by subaward institutions in accordance with the terms of the cooperative agreement award;

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

Definitions:

“Intellectual Property” includes inventions (as defined in U.S. patent law) and software, together with any Materials, discoveries, developments, systems, protocols, workflows or other research results that are protectable under applicable intellectual property laws, and the intellectual property rights therein.

“Materials” means biological materials or any other physical sample provided to, or developed through the use of, ExFAB facilities, resources or support, including through ExFAB Services.

“Core Partner” means the University of California, Santa Barbara, the University of California, Riverside and/or the California State Polytechnic University Pomona.

“External Partner” means an organization who is not a Core Partner.

“In-House Research Project” means a research project or other activity conducted by one or more Core Partner(s) and designated as an In-House Research Project by the ExFAB Management Team.

“External Research Project” means a research project or other activity performed by External Users on behalf of an External User, including through ExFAB Services, that uses ExFAB facilities, resources or support and that is independent from any of the research activities of the Core Partners, except when such use is in the performance of an In-House Research Project.

“Proprietary Research” means any independent, proprietary research activities conducted by an External User or Core Partner which uses ExFAB facilities, resources or support, including through ExFAB Services, for which the User pays full cost recovery costs at the established rate. In-House Research Projects will not be considered Proprietary Research under any circumstances.

“User” means a person who uses the ExFAB BioFoundry facilities, either in person or remotely.

“ExFAB Services” means services conducted by ExFAB staff under the ExFAB recharge agreement, whether or not such services are provided at no charge to the User.

“ExFAB Cooperative Agreement” means National Science Foundation (“NSF”) Cooperative Agreement No. DBI 2400327 and any follow-on awards or cooperative agreements issued by NSF to fund the ExFAB BioFoundry.

1. In-House Research Projects. The following terms will apply to any Intellectual Property that is invented, developed or created by one or more Core Partners through the use of ExFAB facilities, resources or funding in the performance of an In-House Research Project (“In-House IP”):

- a. Inventorship and ownership of In-House IP will be determined by applicable U.S. intellectual property laws.
- b. In the event that any In-House IP is owned by more than one Core Partner, the jointly owning Core-Partners will enter into a separate written inter-institutional agreement. The lead joint-owner will be determined, among other things, by assessing which owner is in the best position to locate an appropriate licensee. The terms of the inter-institutional agreement will be consistent with the terms of the ExFAB Cooperative Agreement.
- c. The intellectual property terms incorporated in the ExFAB Cooperative Agreement, including the Bayh-Dole Act (U.S.C. Sections 200, et seq.) will apply to all In-House IP.
- d. To the extent legally permissible, each Core Partner shall grant the other Core Partners a non-exclusive royalty-free, perpetual license to use any In-House IP for research and educational purposes, including within ExFAB facilities, and to provide ExFAB Services.

2. Other Research Activities by Core Partners. Any intellectual property developed in the performance of a research project conducted solely by a Core Partner that is not an In-House Research Project will be subject to the terms and conditions set forth in Section 3, below.

3. External Users

- a. The Core Partners will not assert ownership over any Intellectual Property invented, developed or created in the performance of an External Research Project (“External IP”), including projects that

incorporate ExFAB Services, but only to the extent that there is no Core Partner employee providing ExFAB Services who is a co-inventor of such External IP as determined by applicable US intellectual property law.

- b. To the extent legally permissible, External Users shall grant each Core Partner a non-exclusive royalty-free, perpetual, irrevocable license to use any External IP it develops for research and educational purposes, including within ExFAB facilities and to provide ExFAB Services.
 - c. **Proprietary Research.** External Users, as well as Core Partners, may use ExFAB facilities to conduct Proprietary Research and, in such event, the following terms will apply:
 - i. The ExFAB Core Partners will not enter into any non-disclosure agreements for, and will not accept any export-controlled data, information, or technology in connection with the Proprietary Research.
 - ii. All data and Materials, and any Intellectual Property rights thereto, provided to ExFAB by the User or generated in the performance of Proprietary Research is exempt from Section 3.b. and 5.b.
 - iii. External Partners have the sole responsibility to examine and assess whether the performance of the research in relation to the External Partner Materials and/or the use of the results thereof infringes the Intellectual Property Rights and proprietary rights belonging to a third party. If the performance of the project and/or the use of the results thereof requires that a license is obtained from a third party, the External Partner must pay any and all costs in connection with obtaining the license. The External Partner is obliged to indemnify, hold harmless and defend Core Partners against any and all expenses, costs of defense (including without limitation attorneys' fees, witness fees claims for damages, demands, actions, liabilities, judgments, fines and amounts paid in settlement) and other amounts that Core Partners becomes legally obliged to pay because of any claim(s) against it by a third party stating that Core Partners' use of the External User's proprietary materials in connection with the performance of the Services, and in accordance with this Agreement, infringes the Intellectual Property Rights and proprietary rights belonging to such third party.
 - d. **Collaborations with Core Partners.** With respect to any External IP developed in the performance of a research project performed jointly by Core Partners and External Users, ownership shall be determined in accordance with applicable United States IP laws and applicable Core Partner policies. In the event that a separate research agreement or grant exists between the parties for the contemplated research project, the terms of that research agreement or grant will govern except to the extent that such terms conflict with the ExFAB Cooperative Agreement.
4. **Equipment Improvements.** In the event that any User develops a new or improved use, protocol or workflow for any ExFAB equipment or instrumentation, or any modifications or improvements to any existing use protocol or workflow for any ExFAB equipment or instrumentation (collectively, "Equipment Improvements"), the User agrees to report the Equipment Improvement to the ExFAB lab manager in sufficient detail to allow ExFAB to replicate and practice the Equipment Improvement (but not necessarily the experimental results generated by the User through the Equipment Improvement). In the event any Intellectual Property is developed that covers the Equipment Improvement, User grants each Core Partner, and all future ExFAB users, a non-exclusive, royalty-free perpetual, irrevocable license to use such Intellectual Property in ExFAB's facilities. This clause takes precedence over any Facilities Use Agreement.

5. Materials.

- a. Materials will be managed by the Core Partners' standard Material Transfer Agreements (MTAs) or an appropriate ExFAB recharge agreement or mechanism. ExFAB reserves the right to restrict the Materials received to certain biosafety levels (BSL) as defined by the US Centers for Disease Control.
- b. Upon acceptance of an ExFAB proposal, Users will be required to sign a Memorandum of Understanding (MOU) agreeing to deposit a sample of any Material with ExFAB, together with any sequencing, phenotyping, metabolomic or other data on the Material, and any analysis of that data, that was generated through the use of ExFAB facilities, resources or support ("Library Materials"). The Library Materials will be listed in ExFAB's online database. ExFAB may use, and authorize others to use, all Library Materials for research and educational purposes. ExFAB will keep the Library Materials for at least one (1) year, after which ExFAB may, at its sole discretion, facilitate deposit of the Library Materials in a third-party depository such as Addgene or American Type Culture Collection (ATCC). The minimum access provided through the third-party depositories will be for research and academic purposes. With respect to any data to be deposited with the Materials, ExFAB reserves the right to require Users to preserve, and provide public access to, such data at their own institutions and at their own cost, providing a link to the data to ExFAB for posting on its website.

To balance knowledge sharing as required under the ExFAB Cooperative Agreement and a User's ability to publish the results of their ExFAB research activities, ExFAB will embargo public access to the Materials and related data for up to two (2) years upon the written request of the User who created the Materials and/or related data. The Materials and/or related data will be made accessible at the earliest of either publication of the Materials or data by the User, or the end of the embargo period. If the Material, the data or analyses of the data are made publicly available in any format by the User or any collaborator of the User during the embargo period, the embargo will be automatically terminated.

Nothing in this ExFAB Intellectual Property Agreement shall be deemed to supersede the intellectual property and/or technology transfer policies of any Core Partner. In the event of a conflict between this policy and such policies, the Core Partner's policy shall control.

6. **Term.** This Agreement is effective as of the date of last signature and shall terminate automatically upon the termination of the ExFAB Cooperative Agreement.
7. **Amendments.** No agreements, modifications, or waivers to this Agreement shall be valid unless in writing and signed by authorized representatives of all parties.

8. Miscellaneous

- a. Not a Partnership or Joint Venture. The parties, by this Agreement, do not intend to create a partnership, principal/agent, master/servant, or joint venture relationship and nothing in this Agreement shall be construed as creating such a relationship between the parties.
- b. Severability. If any term or provision of this Agreement shall be held to be invalid or illegal, such term or provision shall not affect the validity or enforceability of the remaining terms and provisions of this Agreement.

- c. **Recitals & Headings.** The recitals herein constitute an integral part of the Agreement reached and are to be considered as such. However, the captions and headings contained in this Agreement have been inserted for reference and convenience only and in no way define, limit, or describe the text of this Agreement or the intent of any provision.
- d. **No Waiver.** The waiver by any party of a breach or default of any provision of this Agreement shall not constitute a waiver of any succeeding breach, nor shall any delay or omission on the part of any party to exercise any right that it has under this Agreement operate as a waiver of such right, unless the terms of this Agreement set forth a specific time limit for the exercise thereof.

9. Entire Agreement. This Agreement constitutes the entire agreement and understanding between the parties and supersedes all previous agreements and understandings on the subject matter of this Agreement, if any. This Agreement may be executed in counterparts. Electronically scanned signatures shall have the same effect as original signatures.

**THE REGENTS OF THE UNIVERSITY
OF CALIFORNIA, ON BEHALF OF ITS
SANTA BARBARA CAMPUS**


Signed by:

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Signature

Kevin Stewart
Associate Director, Industry Contracts

11/7/2024
Date


**THE REGENTS OF THE UNIVERSITY
OF CALIFORNIA, ON BEHALF OF ITS
RIVERSIDE CAMPUS**

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B0B2990ECC5B429...
Signature

Brian Suh
Senior Executive Director, Technology
Partnerships

11/1/2024
Date

CALIFORNIA STATE POLYTECHNIC UNIVERSITY POMONA

Signed by:

DD6B21F23522435...
Signature

Craig LaMunyon
Associate Vice President
Office of Research, Innovation, & Economic Development

11/2/2024
Date