

Mountain Horticultural Crops
Research and Extension Center
455 Research Drive
Mills River, NC 28759
828.684.3562 (phone)
828.684.8715 (fax)

Instructions for Completing the Tomato Seed Production and License Agreement

1. Complete the agreement. Requests for more than one line can be listed on the same form.
2. Then, either:
 - a) If you do not require signature originals: please have it signed by an authorized individual and return a copy to NCSU via email (PDF) or via fax (919-515-3773). We will then have the agreement signed and will return a fully signed copy to you via e-mail.

OR

- b) If you prefer signature originals: please have two copies of the agreement signed by an authorized individual and send both signed originals mail or courier (your choice) to the address below. We will then have both originals signed and return one to your attention. Send both copies to:

Address for US Postal Service:

Office of Technology Transfer
Campus Box 8210
North Carolina State University
Raleigh, NC 27695-82100

Address for FedEx or Other Carrier:

Office of Technology Transfer
North Carolina State University
Corporate Research I
1021 Main Campus Drive
Raleigh, NC 27606

3. Once the agreement is fully signed, Dr. Panthee or Dr. Gardner will send the corresponding seed material.
4. For additional information on the agreement contact:
Morten Jensen
Licensing Associate
Email: mbjensen@ncsu.edu
Phone: 919.515.7199
Fax: 919.515.3773

TOMATO SEED PRODUCTION AND LICENSE AGREEMENT

Between:

Company:
Street/PO Box:
City, State, Zip
Contact Name:
Contact Email:
Phone:
Fax:

North Carolina State University
Office of Technology Transfer
Campus Box 8210
Raleigh, NC 27695-8210
Phone: 919.515.7199
Fax: 919.515.3773

THIS AGREEMENT is made and entered into as of the date of the last signature below (“Effective Date”) by and between _____, with principal offices at _____ (“Company”) and the North Carolina State University (“NCSU”), a North Carolina nonprofit educational institution with principal offices at 20 Watauga Club Drive, Raleigh, North Carolina 27695.

WHEREAS, NCSU is the owner of tomato breeding line(s) _____ (the “Line”); and

WHEREAS, Company has developed a F1 hybrid named _____ (“Hybrid”) using the Line(s) as a parent in the production of the Hybrid; and

WHEREAS, Company desires the exclusive rights to commercially produce, distribute, market, and sell seed of the Hybrid; and

WHEREAS, Company represents that it has the necessary expertise and resources to fully develop and commercialize the Hybrid.

NOW, THEREFORE, the Parties agree as follows:

1. Exclusive License. NCSU hereby grants to Company, subject to the terms and conditions herein, a worldwide, exclusive license for use of the Line(s) as a parental line for seed production of Hybrid. In addition, NCSU hereby grants to Company upon the terms and conditions hereinafter specified, a worldwide, exclusive license to produce commercial products, propagate, make, use, market, and sell seed of the Hybrid. As part of this Agreement, Company will increase and maintain seed of the Line used in production of the Hybrid. Company agrees not to transfer the Line seed stocks, plants, plant parts, or pollen to any third party without the prior written permission of NCSU. Company shall not grant sublicenses or cross-licenses to any third-party without the prior written permission of NCSU. The license and rights granted in this Agreement do not confer any rights upon Company by implication, estoppel, or otherwise as to any matters not specifically identified in this Agreement. NCSU reserves to itself the right to use the Hybrid solely for its internal research and educational purposes. NCSU retains the right to license and release the Line to other entities for development, seed production, and sales of other approved hybrids or parental combinations. Company understands and agrees that development of any additional F1 hybrids using the Line as a parent will require a separate agreement from NCSU for commercial seed production and sales of each hybrid.

2. Royalty Payments and Reports. In consideration of the rights granted by NCSU to Company, Company shall pay a royalty of ___% of the net seed sales of the Hybrid in a calendar year. Net seed sales shall mean the gross seed sales minus trade discounts, returns, and Company shipping expenditures. Company must submit reports annually to NCSU setting forth Company’s calculation of net seed sales and royalties due, and shall include a reference to the NCSU agreement number _____MA. All payments shall be in United States dollars and payable to the North Carolina Foundation Seed Producers, Inc. Payments and reports shall be sent to:

North Carolina Foundation Seed Producers, Inc.
ATTN: Director

8220 Riley Hill Rd.
Zebulon, NC 27597-8773

Royalty payments and reports for each calendar year must be received on or before the following January 31. Company must make available to NCSU upon request and during reasonable business hours its records on production and sales of Hybrid or Hybrid seed. Company shall keep for five years following the close of each calendar year during the term of this Agreement, true and complete records of its business in sufficient detail such that the amounts owed to NCSU may be verified.

3. Intellectual Property. NCSU shall retain all its intellectual and other proprietary rights, interest, and title to the Line(s) and the Hybrid. Company may not, without a specific, written, and signed agreement with NCSU, use the Line or any information pertaining to the Line to seek or obtain patent protection or plant variety rights or any other intellectual property protection for this genotype, either within the United States of America or any other country, and may not authorize a third party to do so. Company agrees to protect the Line covered by this Agreement from unauthorized propagation, distribution, and use. NCSU shall always be named as the owner of the Line and co-owner of the Hybrid in any and all legal documents. If required, Company agrees to bear all expenses for patent protection or Plant Variety Protection Certificate application for the Hybrid. If applicable, Company shall apply for and obtain protection in any country outside the United States where the Hybrid is to be sold. Company shall be responsible for the preparation and submission of all required documents as needed to obtain intellectual property protection in the various jurisdictions. NCSU shall provide reasonable assistance to Company, as required for the preparation and submission of such documents. Company shall provide to NCSU copies of all intellectual property protection applications and all issued certificates of protection. If during the term of this Agreement Company generates any improvement or discovery which improves the Line or the Hybrid it shall notify NCSU immediately and the Parties shall meet to discuss the ownership and intellectual property protection of such improvement or discovery, and if appropriate, the Territory and Countries in which such intellectual property protection should be sought. Company and its employees and agents shall not use NCSU's name, any adaptation thereof, any NCSU logotype, trademark, service mark or slogan or the name, mark or logotype of any NCSU employee, representative or organization in any way without the prior written consent of NCSU.

4. Indemnification. Company must indemnify, defend and hold NCSU, its trustees, officers, employees and affiliates, harmless against all claims and expenses, including legal expenses and reasonable attorneys' fees, arising out of the death or injury to any person or persons or out of any damage to property and against any other claim, proceeding, demand, expense and liability of any kind whatsoever resulting from (a) possession of the Line and (b) from utilization of the Line in any way.

5. Confidentiality. In addition to the plant materials described herein, NCSU may provide confidential business or technical information relating to the plant materials. Company shall not disclose written information marked "Confidential" or "Proprietary" to any third party nor use such Confidential Information for any purpose other than that given above without written permission from the other party. Company shall use the same degree of care to protect Confidential Information received under this Agreement as it uses to protect its own information of a similar nature, but in any event not less than reasonable care under the circumstances. Confidential Information shall not include any information that: (a) is already known or available to the public at the time of its disclosure; (b) is or becomes publicly known through no wrongful act by the parties; (c) is independently developed by the parties without reference to the work product or confidential information of the parties; (d) that is approved for release by written authorization by the Parties; (e) is learned through a third party entitled to disclose such information; or (f) is required to be disclosed by operation of law or court order.

6. Compliance with Applicable Law. Company shall be responsible for complying with, and adhering to, all applicable laws and regulations relating to the import/export of the Line, growing of the Line, Hybrid and its progeny, the disposition of fruit product or other plant material produced therefrom, and any other of its activities under this Agreement. All expenses necessary and incurred in connection with complying with the applicable laws and regulations shall be the responsibility of Company.

7. Duration and Termination. This Agreement is effective for five (5) years from the date of signing, and is renewable thereafter for five-year terms subject to mutual consent. Either party may terminate this Agreement at any time by giving at least sixty (60) days written notice to the other party. If Company materially breaches any of its obligations under this Agreement, NCSU may terminate this Agreement immediately upon giving written notice

to Company. Upon termination, Company must stop seed production, but may sell seeds in its possession at the time of termination, subject to the Royalty terms of this Agreement. Company's obligations to make payments pursuant to the Royalty provisions shall cease upon the payment of any royalties due at the time of termination or subsequent to termination as allowed in the preceding sentence.

8. Integration. This Agreement and its attachments embody the entire understanding of the Parties with respect to the matters herein, and supersede all previous communications, either oral or written. This Agreement may be amended only by mutual written agreement.

9. No Assignment. This Agreement may not be assigned by Company without the prior written permission of NCSU.

10. Governing law. This Agreement is to be governed by and construed under the law of the State of North Carolina, without regard to its conflict of law rules.

11. Successors. This Agreement shall inure to the benefit of NCSU, its respective successors and assigns, and shall be binding on Company and its respective successors, assigns, heirs, administrators and personal representatives.

In witness hereof, the parties have caused this Agreement to be executed by their authorized representatives as of the Effective Date.

AGREEMENT APPROVAL:

FOR: _____, **COMPANY**

BY: _____

NAME: _____

TITLE: _____

DATE: _____

FOR: **NORTH CAROLINA STATE UNIVERSITY
OFFICE OF TECHNOLOGY TRANSFER**

BY: _____

NAME: _____

TITLE: _____

DATE: _____