

SUBMISSION FORM  
University System/Employee Intellectual Property Joint Participation  
MUSP 407

This form is to be submitted with any Board of Regents item whereby a campus seeks the approval of an agreement with or arrangement regarding an employee pursuant to 20-25-109 MCA and Regents Policy 407.

When the submission concerns matters of trade secrets or confidential business information, or any other matter entitled to privacy under state or federal law (e.g., the federal statute known as Bayh/Dole) the submitting campus may request consideration of the submission, in whole or in part, in executive session.

The submitting campus should also provide the Commissioner a copy of the contract(s) that form the basis for the cooperative arrangement for which approval is sought. Submission of the contract does not indicate a conclusion that all or part of the contract is a public document and the question of whether it is in whole or in part protected from public disclosure will be evaluated on a case-by-case basis.

**1. Summarize the nature of the intellectual property that was developed by the employee seeking approval. Indicate the sources of funding for the research that resulted in this invention.**

This application seeks BOR 407 approval for a technology license between Montana State University ("MSU"), and Photon Biosciences, LLC. The intellectual property ("IP") involved refers to inventions created by Dr. Martin Lawrence at MSU that are licensed to Photon Biosciences, LLC. The IP developed by the employee seeking approval is "A Genetically Encoded Phosphorescent, Electron Dense Probe for Electron Microscopy and Correlative Light and Electron Microscopy (CLEM)". This genetically encoded probe derives its phosphorescent properties from the incorporation of electron dense lanthanides. This will allow the tagged protein to be observed with both light and electron microscopes, allowing tagged proteins of interest and their immediate surrounding to be imaged within a cell at single nm resolution. These ultrahigh resolution imaging abilities have broad applications in medicine and biotechnology.

**2. Name(s) of the university employee(s) involved.**

- a) Dr. Martin Lawrence
- 1.0 FTE Professor, Cryo-EM Core Facility, Chemistry and Biochemistry Department at Montana State University;
  - Inventor of MSU IP; the IP disclosure for this invention was made to tech transfer as MSU Docket ID LCM-2023-LMBP;
  - The MSU Office of Research Compliance worked with Dr. Lawrence to develop a Conflict of Interest Management Plan. The purpose of the plan is to accurately describe the potential conflicts in writing, create explicit agreements to protect against actual conflicts, and to facilitate oversight. A Plan Manager has been assigned to review the case annually and whenever major changes in circumstance occur.

**3. Name(s) of business entity(ies) involved.**

- a) Photon Biosciences, a Domestic Limited Liability Company, is based in Pullman, WA at 445 S. Grand Ave., 99206, and was registered on February 22, 2017. Photon Biosciences, LLC. is in Active status with the Washington Secretary of State.

**4. The university and employee(s) are seeking approval for (check as many as appropriate):**

- a)  The employees to be awarded equity interests in the business entity
- b)  The employees to serve as a members of the board of directors or other governing board of the business entity
- c)  The employees to accept employment from the business entity
- d)  Other. Please explain.

**5. Summarize the nature of the relationship between the university and the business entity (e.g., the entity is licensing the intellectual property from the university, the entity is co-owning the intellectual property with the university).**

Photon Biosciences, LLC. entered into a license agreement with Montana State University on June 22, 2023 for an exclusive worldwide, license, with the right to grant sublicenses under the terms specified herein, to the Licensed Technology in order to make, have made, use, export, sell, offer to sell, and import the Licensed Technology.

Contingent upon Montana Board of Regents Policy 407 approval pursuant to § 20-25-109, Montana Code Annotated, this will be an exclusive license agreement for technology developed at MSU. Should a 407 application be rejected by the BOR, this Agreement will be voided in its entirety.

**6. The proposed duration of the agreement or arrangement.**

The proposed arrangement shall remain in effect until December 31, 2043, or when the last patent for the Licensed Technology has expired or been abandoned, whichever occurs first.

**7. The conditions under which the agreement may be terminated or dissolved.**

- a) if Licensee does not make a payment due hereunder and fails to cure such non-payment within forty-five (45) days after the date of notice in writing of such non-payment by MSU;
- b) if Licensee shall become insolvent, shall make an assignment for the benefit of creditors, or shall have a petition in bankruptcy filed for or against it (in such case, termination shall be effective immediately upon MSU giving written notice to Licensee);
- c) if an examination by MSU's accountant pursuant to Section 11 shows an underreporting or underpayment by Licensee in excess of twenty percent (20%) for any twelve (12) month period;
- d) if Licensee fails to satisfy the Performance Milestones as set forth elsewhere herein; or
- e) if Licensee breaches any material term of this Agreement.

**8. Explain specifically how the University System or the State of Montana will likely benefit from the agreement or arrangement.**

- a) Technical advances in the field with public and private contributions provides both academic and economic development;
- b) Collaborative research opportunities for Montana State University and its students.

**9. Summarize the financial terms of the agreement or arrangement. Include:**

- a) **The value, nature and source of the University's contribution.**  
MSU owns the copyright for the intellectual property. MSU will own the intellectual property associated with Photon Biosciences, LLC. as described along with all derivative works and retains the right to use the technology for academic research or other not-for-profit scholarly purposes.

**b) The value and nature of the employee's contribution.**

As an MSU inventor, Dr. Lawrence will provide to MSU, its successors and assigns, for good and sufficient consideration, the receipt of which is acknowledged herein, the entire right, title and interest in and to any and all of the following that exist as of the date hereof: (a) all Intellectual Property owned and/or developed by or on behalf of Dr. Lawrence; (b) any and all Intellectual Property Rights claiming or covering such Intellectual Property, and (c) any and all causes of action that may have accrued to the undersigned in connection with such Intellectual Property and/or Intellectual Property Rights.

**c) The anticipated revenue to be generated by the project and the timeline for generating such revenue.**

The license agreement sets performance milestones for sales of the licensed technology, as well as annually due sales and marketing reports. There is no way to determine anticipated revenue at this early stage.

**d) The manner in which revenue and expenses will be shared by the parties.**

Licensee shall pay to MSU a royalty on Net Sales of Licensed Product by Licensee as follows:

- a. 1.0% of Net Sales of Licensed Technology covered by Patent Rights.
- b. 0.5% of Net Sales of Licensed Technology not covered by Patent Rights.

**e) The nature of each party's equity interest in the project. If none, so indicate.**

Dr. Lawrence does not currently own an equity interest in the company, Photon Biosciences, LLC.