

University of Rochester

**MATERIAL TRANSFER AGREEMENT**  
(Biological Materials)

**1. Parties to this Agreement**

Providing Scientist: \_\_\_\_\_

Providing Organization: \_\_\_\_\_

Address: \_\_\_\_\_

'PROVIDER' shall mean the Providing Organization through its employee, the Providing Scientist.

Recipient Scientist: \_\_\_\_\_

Recipient Organization: \_\_\_\_\_

Address: \_\_\_\_\_

'RECIPIENT' shall mean the Recipient Organization through its employee, the Recipient Scientist.

**2. Material(s)**

Material(s) provided:

'MATERIAL(S)' means the provided materials described above and any Progeny and Unmodified Derivatives thereof. Progeny is an unmodified descendant from the provided material, such as virus from virus, cell from cell, or organism from organism. Unmodified Derivatives are substances created by the RECIPIENT which constitute an unmodified functional subunit or product expressed by the provided material, such as subclones of unmodified cell lines, purified or fractionated subsets of the provided material, proteins expressed by DNA/RNA supplied by the PROVIDER; or monoclonal antibodies secreted by a hybridoma cell line. MATERIAL(S) shall not Include: (a) Modifications, or (b) other substances created by the Recipient through the use of the MATERIAL(S) which are not Modifications, Progeny, or Unmodified Derivatives. Modifications are materials made by the RECIPIENT which contain/incorporate the MATERIAL(S).

The MATERIAL(S), including, but not limited to, MATERIAL(S) contained or incorporated in Modifications, are the sole property of the PROVIDER and are made available as a service to the research community.

The MATERIAL(S) is provided at no cost, or with an optional transmittal fee solely to reimburse the PROVIDER for its preparation and distribution costs. If a fee is requested, it will be indicated here: **Optional.**

### **3. Research**

The RECIPIENT agrees that THE MATERIAL(S) SHALL NOT BE USED IN HUMAN SUBJECTS, IN CLINICAL RESEARCH, OR FOR DIAGNOSTIC PURPOSES INVOLVING HUMAN SUBJECTS. The PROVIDER agrees that the MATERIAL(S) were not obtained from human subjects.

The RECIPIENT agrees to use the MATERIAL(S) in compliance with all applicable statutes and regulations, including the Public Health Service and National Institutes of Health regulations and guidelines such as, for example, those relating to research involving the use of animals and/or recombinant DNA.

The RECIPIENT agrees that the MATERIAL(S) will be used solely for internal research purposes as identified in **Attachment A** ('Research') in the laboratory of the Recipient Scientist and under his/her direct supervision.

The RECIPIENT agrees that the MATERIAL(S) will not be used for any Commercial Purpose. Commercial Purpose shall mean the sale, lease, license, or other transfer of the MATERIAL(S) or Modifications to a for-profit organization. Commercial Purposes shall also include uses of the MATERIAL(S) or Modifications by any organization, including RECIPIENT, to perform contract research, to screen compound libraries, to produce or manufacture products for general sale, or to conduct research activities that result in any sale, lease, license, or transfer of the MATERIAL(S) or Modifications to a for-profit organization. However, industrially sponsored academic research shall not be considered a use of the MATERIAL(S) or Modifications for Commercial Purposes per se, unless any of the above conditions of this definition are met.

The RECIPIENT agrees that the MATERIAL(S) and Modifications (except as set forth below) will not be transferred to any third party without the PROVIDER's written consent. Nothing in this Agreement shall preclude the PROVIDER from transferring the MATERIAL(S) to other interested third parties for commercial or research purposes. The RECIPIENT shall have the right, without restriction, to distribute to third parties substances created by the RECIPIENT through the use of the MATERIAL(S) provided those substances are not Progeny or Unmodified Derivatives. The RECIPIENT may transfer Modifications to not-for-profit research

institutions under a material transfer agreement containing terms substantially similar to those contained in this Agreement.

#### **4. Publications**

The RECIPIENT agrees to provide the PROVIDER with an advanced copy of any publication resulting from the direct use of the MATERIAL(S) not less than thirty (30) days prior to the submission to a journal or any other public disclosure. At the request of the PROVIDER, RECIPIENT agrees to delay the publication for a period up to sixty (60) days from the date the publication was originally provided to PROVIDER for the filing of any relevant patent applications. In addition, RECIPIENT agrees to remove any Confidential Information of the PROVIDER.

#### **5. Data**

The RECIPIENT agrees to provide the PROVIDER with a summary of any data resulting from the use of the MATERIAL(S). The PROVIDER agrees to use the data solely for research and regulatory purposes, and not to use the data in support of a patent application without RECIPIENT'S prior knowledge and only after the RECIPIENT has reviewed the application and had the ability to assert any claims to inventorship, or for any marketing or promotional purposes without the RECIPIENT's prior written approval.

#### **6. Inventions**

Inventions shall mean any Invention(s), whether or not patentable, made by the RECIPIENT as a direct result of the use of the MATERIAL(S).

Inventorship of intellectual property generated under the terms of this Agreement through the direct use of the MATERIAL(S) will be determined according to U.S. Patent Laws. Ownership shall follow inventorship.

RECIPIENT hereby grants to PROVIDER a first option to negotiate a royalty-bearing exclusive or non-exclusive license to make, use, and sell any Inventions. Any exclusive license for Inventions will be subject to (i) rights retained by the United States government in accordance with P.L. 96-517, as amended by P.L. 98-620, and RECIPIENT's obligations regarding the *NIH Guidelines for Obtaining and Disseminating Biomedical Research Resources*, when research is funded by the U.S. government, including, but not limited to, the obligation to ensure that research tools will be available to the academic research community on reasonable terms, and (ii) the retained right of the PROVIDER to make, have made, provide and use for the PROVIDER's internal purposes.

## **7. Confidential Information**

Confidential Information shall mean proprietary and confidential information of the PROVIDER which is related to the MATERIAL(S) and is provided to the RECIPIENT and indicated as confidential or proprietary at the time of disclosure.

Confidential Information shall not Include information which:

- a) was in RECIPIENT'S possession prior to receipt from PROVIDER;
- b) was in the public domain at the time of receipt from PROVIDER;
- c) becomes part of the public domain through no fault of the RECIPIENT;
- d) was lawfully received by the RECIPIENT from a third party having a right to disclose it to RECIPIENT;
- e) is subsequently and independently developed by employees of the RECIPIENT who had no knowledge of the Confidential information disclosed; or
- f) is required by law to be disclosed.

The RECIPIENT agrees that Confidential Information shall be used solely for the purposes of performing research with the MATERIAL(S) and that the Confidential information will not be disclosed to anyone except those employees of RECIPIENT working under the direct supervision of the Recipient Scientist who have a need to know for the purposes of the research utilizing the MATERIAL(S) and who are bound by the terms of this agreement as an employee of the RECIPIENT.

RECIPIENT's obligations with respect to Confidential Information as set forth in this Paragraph shall remain in effect for a period of five (5) years following the Effective Date of this Agreement.

## **8. Miscellaneous**

The MATERIAL(S) are understood to be experimental in nature and may have hazardous properties. THE PROVIDER MAKES NO REPRESENTATIONS AND EXTENDS NO WARRANTIES OF ANY KIND, EITHER EXPRESSED OR IMPLIED. THERE ARE NO EXPRESS OR IMPLIED WARRANTIES OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE, OR THAT THE USE OF THE MATERIAL(S) WILL NOT INFRINGE ANY PATENT, COPYRIGHT, TRADEMARK, OR OTHER PROPRIETARY RIGHTS.

The RECIPIENT acknowledges that the MATERIAL(S) are or may be the subject of a patent application. Except as provided in this agreement, no express or implied licenses or other rights are provided to the RECIPIENT under any patents, patent applications, trade secrets or other proprietary rights of the PROVIDER, including any altered forms of the MATERIAL(S) made by the PROVIDER. In particular, no express or implied licenses or other rights are

provided to use the MATERIAL(S), MODIFICATIONS, or any related patents of the PROVIDER for COMMERCIAL PURPOSES.

Except to the extent prohibited by law, the RECIPIENT assumes all liability for damages which may arise from its use, storage or disposal of the MATERIAL(S). The PROVIDER (including, but not limited to, its directors, trustees, officers, employees, students, and agents as applicable) will not be liable to the RECIPIENT for any loss, claim or demand made by the RECIPIENT, or made against the RECIPIENT by any other party, due to or arising from the use of the MATERIAL(S) by the RECIPIENT, except to the extent permitted by law when caused by the gross negligence or willful misconduct of the PROVIDER.

RECIPIENT is solely responsible for compliance with all foreign and domestic, federal, state and local statutes, ordinances and regulations applicable to use of the biological material.

Neither party shall use the name of the other or any contraction or derivative thereof or the name(s) of the other party's faculty members, employees, or students, as applicable, in any advertising, promotional, sales literature, or fundraising documents without prior written consent from the other party.

This Agreement is governed by and construed in accordance with the laws of the State of New York, USA.

**OPTIONAL CLAUSE:**

This Agreement shall terminate either (a) upon the date the Research is completed, or (b) \_\_\_\_\_ **(termination date to be inserted)** \_\_\_\_\_, whichever date is earlier. Upon completion, RECIPIENT shall notify the PROVIDER and return or destroy any remaining MATERIAL(S).

The parties to this Agreement, the RECIPIENT and the PROVIDER, hereby indicate their agreement to the terms of this Agreement by affixing the signature below of an appropriate representative or officer who is specifically authorized to execute documents of this type. The "Effective Date" of this Agreement shall be the date that the last party hereto signs this Agreement.

RECIPIENT ORGANIZATIONPROVIDER ORGANIZATION

By:

By:

Name:

Name:

Title:

Title:

Date:

Date:

The Recipient Scientist and Providing Scientist, by affixing their signatures below, acknowledge that they have read, understood and agree to comply with the terms of this Agreement.

RECIPIENT SCIENTISTPROVIDING SCIENTIST

By:

By:

Name:

Name:

Title:

Title:

Date:

Date:

## **Attachment A Research**

Please insert a description of the planned research to be conducted using the MATERIAL(S).