

**UNIVERSITY OF COLORADO MATERIAL TRANSFER AGREEMENT
(Commercial)**

THIS MATERIAL TRANSFER AGREEMENT, together with its Attachments, (the “Agreement”) is made as of _____ (the “Effective Date”) by and between the Regents of the University of Colorado, a body corporate, having a principal place of business at University of Colorado, 4001 Discovery Dr., Suite 390C, UCB588, Boulder, CO 80309 (the “Colorado”) and the Institution receiving the Material, _____ (the “Recipient”).

WHEREAS, Colorado possesses certain materials as specified in **Exhibit A** attached hereto and more specifically defined herein;

WHEREAS, Recipient is conducting the specific research activities described in the Research Plan set forth in **Exhibit A** (the “Research”), at Recipient’s facilities (the “Facility”); and

WHEREAS, Colorado desires to supply, and Recipient desires to obtain, samples of the Materials solely for use by the Investigator (as defined herein) in the Research in accordance with the terms and conditions of this Agreement;

NOW THEREFORE, to protect Colorado’s proprietary interests with respect to the Materials, Colorado agrees to provide Materials to Recipient for the purposes of conducting the Research, subject to the following terms and conditions:

1. **DEFINITIONS.**

- A. “Commercial Purposes” shall mean the sale, lease, license, or other transfer of the Material or Modifications to a for-profit organization. Commercial Purposes shall also include uses of the Material 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 or Modifications to a for-profit organization. However, industrially sponsored academic research shall not be considered a use of the Material or Modifications for Commercial Purposes per se, unless any of the above conditions of this definition are met.
- B. “Materials” shall mean all material provided to Recipient, Progeny, Unmodified Derivatives and any modification to Material, if such modified Material is substantially based on or incorporates a substantial element of Original Material, or any modification which is not new or not obviously distinct from Original Material.
- C. “Modifications” shall mean substances created by Recipient that do not contain/incorporate the Material.
- D. “Progeny” shall mean unmodified descendant from the Material, such as virus from virus, cell from cell, organism from organism.
- E. “Unmodified Derivatives” shall mean substances created by Recipient which constitute an important unmodified functional sub-unit of the original Material. Examples of Unmodified Derivatives include, but shall not be limited to, subclones of unmodified cell lines, purified or

fractionated sub-sets of the original Material when those were known to Colorado, proteins expressed by RNA/DNA supplied by Colorado, DNA/RNA sequences for a protein with an activity known to or suspected by Colorado, monoclonal antibodies secreted by a hybridoma cell line, sub-sets of the Original Material such as novel plasmids or vectors.

2. **OWNERSHIP, USE AND TRANSFER.**

A. **OWNERSHIP OF MATERIAL.** Legal title to the Material shall remain with Colorado. Nothing in this Agreement grants any rights under any patents or in any know-how of Colorado nor any rights in the Material or any product or process related thereto or derived therefrom other than those rights specifically set forth herein. Except as expressly provided in this Agreement, no rights are provided to Recipient under any patents, patent applications, copyrights, trade secrets or other proprietary rights of Colorado. In particular, no rights are provided to use the Material or any related patents of Colorado for any profit-making or Commercial Purposes.

B. **USE OF MATERIAL.** Colorado will use commercially reasonable efforts to provide Recipient with the quantity of the material described in **Exhibit A**. Recipient will use the Material exclusively for the non-commercial research described in **Exhibit A** and for no other purpose. The Research will be conducted solely by or under the direction of the Investigator at Recipient's research facilities. In addition, Recipient shall only allow employees and agents under its direct control and supervision to have access to the Material. Recipient will not use the Material for testing in or treatment of human subjects. Recipient agrees to use the Material in compliance with all applicable laws, governmental regulations and guidelines. The Material will not be distributed further to third parties for any purpose without the prior written consent of Colorado.

C. **TRANSFER OF MATERIAL.**

- (1) The Investigator shall refer any request for the Material to Colorado. To the extent supplies are available, Colorado agrees to make the Material available under a materials transfer agreement to other scientists (at least those at non-profit or governmental institutions) who wish to replicate Recipient's Investigator's research.
- (2) Recipient shall have the right, without restriction, to distribute substances created by Recipient through the use of the Material only if those substances do not include the Material or Modifications that incorporate the Material. Recipient shall not attempt to reverse engineer, deconstruct or in any way determine the structure or composition of the Material.
- (3) Upon written permission from Colorado, Recipient may distribute Modifications that incorporate Material for commercial use. It is recognized by Recipient that such commercial use may require a license from Colorado and Colorado has no obligation to grant such a license. Nothing in this paragraph, however, shall prevent Recipient from granting commercial licenses under Recipient's patent rights claiming Modifications as defined herein.

3. **INVENTIONS.**

- A. **TANGIBLE PROPERTY.** Ownership of tangible property between Colorado and Recipient is defined in **Exhibit A.**
- B. **DISCLOSURE.** Recipient will promptly and fully disclose in writing to Colorado any and all Inventions (as defined herein), know-how and other rights (whether or not protectable under state, federal, or foreign intellectual property laws) related to the Material or its use, or developed using the Material, which are conceived and/or reduced to practice by Recipient, alone or jointly with others, in the course of its research (the "Inventions"). Recipient shall be free to file patent applications claiming Inventions made through the use of the Material but agrees to notify Colorado in advance of such filing if it files patent applications claiming Modifications that incorporate or use the Material in any way.
- C. **INVENTORSHIP.** Inventorship shall be determined according to U.S. patent law.
- D. **JOINT INVENTIONS.** Any patent applications necessary to protect the proprietary positions of the parties in any Inventions made jointly by Colorado and Recipient shall be prepared, filed and prosecuted by Colorado, jointly in its and Recipient's names, with expenses shared equally by the parties. If Colorado elects not to prepare, file, prosecute or maintain an application or patent arising from any joint Invention, Colorado shall promptly notify Recipient, and Recipient shall have the right to prepare, file, prosecute and maintain such applications or patents, in Recipient's and Colorado's names, and at Recipient's expense. Subject only to Recipient's grant of an option to Colorado under Section 4, each of Colorado and Recipient's shall have the right to license, transfer and/or sell its rights in such joint inventions without the consent of the other.
- E. **RECIPIENT'S SOLE INVENTIONS.** Any patent applications necessary to protect the proprietary positions of the parties in any Inventions made solely by Recipient shall be prepared, filed and prosecuted by Recipient, solely in Recipient's name, with the expenses paid by Recipient. If Recipient elects not to prepare, file, prosecute or maintain an application or patent arising from any sole Inventions, Recipient shall promptly notify Colorado, and Colorado shall have the right to prepare, file, prosecute and maintain such applications or patents, in Recipient's name and at Colorado's expense. In return for Colorado's support of patent prosecution and maintenance, the parties agree to good faith negotiation regarding Colorado's share of any and all consideration received under any licenses resulting from such patentable subject matter.
- F. **PATENT COOPERATION.** Each party shall provide the other party with copies of all substantive communications from all patent offices regarding applications or patents on any joint Inventions and Recipient's sole Inventions promptly after the receipt thereof. Each party shall provide the other party with copies of all proposed substantive communications to such patent offices regarding applications or patents on any such Inventions in sufficient time before the due date in order to enable the other party an opportunity to comment on the content thereof. Each party shall make available to the other party or its authorized attorneys, agents, or representatives, such of its employees whom the other party in its reasonable judgment deems necessary in order to assist it in obtaining patent protection for such Inventions. Each party shall sign or use its best efforts to have signed all legal documents necessary to file and prosecute patent applications or to obtain or maintain patents at no cost to the other party.
- G. **REIMBURSEMENT OF PATENT EXPENSES.** In the event Colorado exercises its option and executes an exclusive license to Recipient's interest in an Invention under Section 4 herein,

Colorado shall reimburse Recipient for its reasonable patent expenses related to such Invention and thereafter, the prosecution and maintenance of such patent applications and patents shall be as provided in the license agreement.

4. **COMMERCIAL USE.**

COMMERCIAL LICENSE TO MATERIAL. If Recipient desires to use the Material for profit-making or commercial purposes, Recipient agrees, in advance of such use, to negotiate in good faith with Colorado to establish the terms of a commercial license. It is understood by Recipient that Colorado shall have no obligations to grant such a license to Recipient, and may grant exclusive or non-exclusive commercial licenses to others. In consideration of Colorado's supporting those costs and supplying the Material, Recipient hereby grants Colorado a ninety (90) day period (after the filing of a US patent application claiming the Invention or Modification or after the supply of a sample of the Modification if no patent application is to be filed) to negotiate the terms of a worldwide commercial license. Such a license shall include a reasonable royalty based on the respective parties' contributions and relevant industry standards and, subject to Colorado's policies, shall include such terms as are typical in licenses of similar technology from non-profit organizations to for-profit organizations.

5. **PRE-EXISTING RIGHTS.**

The provision of the Material to Recipient shall not alter any preexisting right to the Material. If Colorado has granted any rights to a third party (other than the customary rights granted to the federal government or other non-profit organizations) that would affect Recipient, those rights are listed in **Exhibit B.**

6. **RISKS.**

Colorado shall inform Recipient of any toxicity, health risks, etc. associated with the Material that are reasonably known to Colorado. Recipient's Investigator shall inform Colorado of any toxicity, health risks, etc. discovered through the use of the Material.

7. **WARRANTIES.**

Any Material delivered pursuant to this Agreement is understood to be experimental in nature, and will be used with prudence and appropriate caution, since not all of its characteristics are known. COLORADO MAKES NO REPRESENTATIONS AND EXTENDS NO WARRANTIES, EITHER EXPRESS OR IMPLIED. THE MATERIAL IS PROVIDED WITHOUT WARRANTY OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE OR ANY OTHER WARRANTY, EXPRESS OR IMPLIED OR THAT THE USE OF THE BIOLOGICAL MATERIALS WILL NOT INFRINGE ANY PATENT, COPYRIGHT, TRADEMARK, OR ANY OTHER PROPRIETARY RIGHT.

8. **LIABILITY.**

To the extent permitted by applicable law, Recipient assumes all liability for damages that may arise from its use, storage or disposal of the Material. Colorado shall not be liable to 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, storage or handling of the Material by Recipient, except to the extent caused by the gross negligence or willful misconduct of the Colorado. Recipient agrees to indemnify Colorado for liability, loss, or damage they may suffer as a result of claims, demands, costs or judgments against Colorado arising out of the activities to be carried out pursuant to this Agreement.

9. **PUBLICATION.**

This Agreement shall not be interpreted to prevent or delay publication of research resulting from the use of the Material or Modifications. Recipient shall have the right to publish and disclose the results of the Research. In order to balance this right with the Colorado's proprietary interests, Recipient shall submit any proposed disclosure or publication to Colorado for its review at least thirty (30) days prior to the earlier of the date of submission to any journal for review or the date of publication or disclosure. Colorado shall complete its review within thirty (30) days of receipt of the submitted documents. Colorado may require that Recipient delete from its documents any reference to the Colorado's confidential information. If, during the thirty (30) day review period, Colorado notifies Recipient that it desires to file a patent application on any Inventions disclosed in the documents, Recipient will defer publication/disclosure for up to sixty (60) additional days from the date of submission of the document to permit Colorado to prepare and file a patent application. Recipient's Investigator agrees to provide copies of research results related to the Material and appropriate acknowledgment of Colorado as the source of the Material in all publications.

10. **TERM AND TERMINATION.**

- A. This Agreement shall terminate on the earliest of the following dates:
- (1) when the Material becomes generally available from third parties, for example, through reagent catalogs or from a public repository, or
 - (2) on completion of Recipient's current research with the Material, or
 - (3) on thirty (30) days written notice by either party to the other, or
 - (4) one year from the last signature date.
- B. If termination should occur as a result of 10 (a) (1), Recipient shall be bound to the Colorado by the least restrictive terms applicable to Material obtained from the then-available sources.
- C. Upon termination of this Agreement, Recipient shall discontinue its use of the Material and shall, upon direction of Colorado, return or destroy any remaining Material. Recipient shall also either destroy Modifications or remain bound by the terms of this Agreement as they apply to Modifications.
- D. In the event Colorado terminates this Agreement for its convenience, Colorado will defer the effective date of termination for a period of up to one (1) year, upon request from Recipient to complete research in progress.
- E. Sections 3 (INVENTIONS), 4 (COMMERCIAL USE), 7 (WARRANTIES), 8 (LIABILITY), 9 (PUBLICATION), AND 12 (CONFIDENTIALITY) shall survive termination.

11. **REIMBURSEMENT.**

The Material is provided with for a fee, which is solely to reimburse Colorado for its production and distribution costs. The amount of the fee is _____ U.S. dollars (\$), due contemporaneously upon execution of this Agreement. At the request of the Colorado, Recipient shall provide its courier name and account number to Colorado in advance of distribution of Material. Courier Name: _____, Billing account number: _____.

12. **CONFIDENTIALITY.**

Recipient agrees to use reasonable efforts (which shall be at least as great as the efforts to maintain the

confidentiality of its own confidential information) to maintain the Material and information in confidence, and to use the same only in accordance with this Agreement. Such obligation of confidentiality shall not apply to information which Recipient can demonstrate:

- A. was at the time of disclosure in the public domain;
- B. has come into the public domain after disclosure through no fault of Recipient or its employees or agents;
- C. was known to Recipient or its employees prior to disclosure thereof by Colorado;
- D. was lawfully disclosed to Recipient without prior obligation of confidence by a third party which was not under an obligation of confidence to Recipient with respect thereto; or
- E. is required to be disclosed by law, government regulation or court order, and is disclosed only to the extent it satisfies that requirement.

13. **ASSIGNMENT AND ENTIRE AGREEMENT.**

This Agreement is not assignable, whether by operation of law or otherwise, and sets forth the entire agreement and understanding of the parties and cannot be changed or amended except by written agreement executed by both parties.

The authorized signatures below verify agreement between the parties:

COLORADO: _____
David N. Allen, Ph.D.
Assistant Vice President, Technology Transfer Office
University of Colorado
4001 Discovery Dr., Suite 390C
UCB 588
Boulder, CO 80309-0588 USA

COLORADO'S SCIENTIST: _____
Printed Name/Title

RECIPIENT: _____
Authorized Official Printed Name/Title
Address

RECIPIENT'S INVESTIGATOR: _____

EXHIBIT A

Materials, Contact Information and Research Plan

Materials:

Amount of Materials to Be Provided:

Facilities Address:

Investigator:

Name: _____

Title: _____

Address: _____

Phone: _____

Fax: _____

Email: _____

Account Number of FedEx or DHL: _____

Research Plan:

Title:

Aims:

Research Plan:

Anticipated Research Completion Date:

_____, 200__

EXHIBIT B

COLORADO describes any preexisting obligations that COLORADO has to third parties (other than the federal government or non-profit foundations) that would affect RECIPIENT.