

University of South Florida
Pre-Approved Material Transfer Agreement
Based upon the UBMTA

This Agreement effective this _____ day of _____, 20____, is between The University of South Florida Board of Trustees, a public body corporate (hereinafter referred to as "PROVIDER"), with offices at 4202 East Fowler Avenue, Tampa, Florida 33620 and _____ ("RECIPIENT") and _____ ("RECIPIENT SCIENTIST"). Subject to the terms of this Agreement, Dr. _____ ("PROVIDING SCIENTIST") at the University of South Florida agrees to provide ORIGINAL MATERIAL (as described herein) for use solely in the specific research study hereinafter described:

_____.

I. Definitions:

1. ORIGINAL MATERIAL: The description of the material being transferred is as follows:

_____.
ORIGINAL MATERIAL also includes any know-how related to the material being transferred.
2. MATERIAL: ORIGINAL MATERIAL, PROGENY, and UNMODIFIED DERIVATIVES. The MATERIAL shall not include: (a) MODIFICATIONS, or (b) OTHER SUBSTANCES.
3. PROGENY: Unmodified descendant from the MATERIAL, such as virus from virus, cell from cell, or organism from organism.
4. UNMODIFIED DERIVATIVES: Substances created by the RECIPIENT, which constitute an unmodified functional subunit or product, expressed by the ORIGINAL MATERIAL. Some examples include: subclones of unmodified cell lines, purified or fractionated subsets of the ORIGINAL MATERIAL, proteins expressed by DNA/RNA supplied by the PROVIDER, or monoclonal antibodies secreted by a hybridoma cell line.
5. MODIFICATIONS: Substances that are not ORIGINAL MATERIAL, PROGENY OR UNMODIFIED DERIVATIVES created by the RECIPIENT which contain/incorporate the MATERIAL.
6. OTHER SUBSTANCES: Substances created by the RECIPIENT through the use of the MATERIAL which are not MODIFICATIONS, ORIGINAL MATERIAL, PROGENY, or UNMODIFIED DERIVATIVES
7. COMMERCIAL PURPOSES: 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.

8. **NONPROFIT ORGANIZATION(S):** A university or other institution of higher education or an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1954 (26 U.S.C. 501(c)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 U.S.C. 501(a)) or any nonprofit scientific or educational organization qualified under a state nonprofit organization statute. As used herein, the term also includes government agencies.

II. Terms and Conditions of this Agreement

1. The PROVIDER retains ownership of the MATERIAL, including any MATERIAL contained or incorporated in MODIFICATIONS or OTHER SUBSTANCES. The PROVIDER also retains any and all rights, including but not limited to patent rights, trademarks, and other proprietary rights, in and to the MATERIAL.
2. The RECIPIENT retains ownership of: (a) MODIFICATIONS (except that, the PROVIDER retains ownership rights to the MATERIAL included therein), and (b) OTHER SUBSTANCES. If either 2 (a) or 2 (b) results from the collaborative efforts of the PROVIDER and the RECIPIENT, joint ownership shall be negotiated in good faith.
3. The RECIPIENT and the RECIPIENT SCIENTIST agree that the MATERIAL:
 - (a) will be used solely in the specific research study herein described;
 - (b) is to be used solely for teaching and academic research purposes;
 - (c) will not be used in human subjects, in clinical trials, or for diagnostic purposes involving human subjects without the written consent of the PROVIDER;
 - (d) is to be used only at the RECIPIENT organization and only in the RECIPIENT SCIENTIST's laboratory under the direction of the RECIPIENT SCIENTIST or others working under his/her direct supervision; and
 - (e) will not be transferred to anyone else within the RECIPIENT organization or to anyone else outside of the RECIPIENT organization without the prior written consent of the PROVIDER.
4. The RECIPIENT and the RECIPIENT SCIENTIST agree to refer to the PROVIDER any request for the MATERIAL from anyone other than those persons working under the RECIPIENT SCIENTIST's direct supervision or any other uses of MATERIAL than herein described. To the extent supplies are available, the PROVIDER or the PROVIDER SCIENTIST agrees to make the MATERIAL available, under a separate agreement to other scientists at NONPROFIT ORGANIZATION(S) who wish to replicate the RECIPIENT SCIENTIST's research; provided that such other scientists (i) agree to be bound by the same or substantially the same terms of this agreement, (ii) reimburse the PROVIDER for any costs relating to the preparation and distribution of the MATERIAL. For clarity, Provider, in its discretion, may under a separate agreement, make MATERIAL available for other uses not covered by this Agreement.
5.
 - (a) The RECIPIENT and/or the RECIPIENT SCIENTIST shall have the right, without restriction, to distribute OTHER SUBSTANCES, unless such OTHER SUBSTANCES are subject to joint ownership and any Agreement related to the joint ownership prevents such distribution.
 - (b) Under a separate agreement at least as protective of the PROVIDER's rights as this Agreement, the RECIPIENT may distribute MODIFICATIONS to NONPROFIT ORGANIZATION(S) for research and teaching purposes, provided that RECIPIENT give

written notification to PROVIDER prior to distribution. Any such distribution without prior written notification to PROVIDER shall be in breach of this Agreement and RECIPIENT rights to use the MATERIALS shall cease immediately.

- (c) Without written consent from the PROVIDER, the RECIPIENT and the RECIPIENT SCIENTIST may NOT use or provide MODIFICATIONS for COMMERCIAL PURPOSES. It is recognized by the RECIPIENT that such COMMERCIAL PURPOSES may require a commercial license from the PROVIDER and the PROVIDER has no obligation to grant a commercial license to its ownership interest in the MATERIAL incorporated in the MODIFICATIONS. Nothing in this paragraph, however, shall prevent the RECIPIENT from granting commercial licenses under the RECIPIENT's other intellectual property rights (e.g. patent rights) claiming such MODIFICATIONS, or methods of their manufacture or their use.

6. The RECIPIENT acknowledges that the MATERIAL is or may be the subject of one or more patent applications or patents. Except as provided in this Agreement, no express or implied licenses or other rights are provided to the RECIPIENT under any patents, patent applications, trademarks, trade secrets or other proprietary rights of the PROVIDER, including any such rights to MATERIAL, MODIFICATIONS or OTHER SUBSTANCES made by the PROVIDER, which may be covered by any such patents, patent applications, trademarks, trade secrets or other proprietary rights. In particular, no express or implied licenses or other rights are provided to use the MATERIAL, MODIFICATIONS, or any related patents of the PROVIDER for COMMERCIAL PURPOSES.
7. If the RECIPIENT desires to use or license the MATERIAL or MODIFICATIONS for COMMERCIAL PURPOSES, the RECIPIENT agrees, in advance of such use, to negotiate in good faith with the PROVIDER to establish the terms of a commercial license. It is understood by the RECIPIENT that the PROVIDER shall have no obligation to grant such a license to the RECIPIENT, and may grant exclusive or non-exclusive commercial licenses to others, or sell or assign all or part of the rights in the MATERIAL to any third party(ies), subject to any pre-existing rights held by others and obligations to the Federal Government.
8. The RECIPIENT is free to file patent application(s) claiming inventions made solely by the RECIPIENT, RECIPIENT SCIENTIST or others working under his/her direct supervision, through the use of the MATERIAL but agrees to notify the PROVIDER upon filing a patent application claiming MODIFICATIONS or OTHER SUBSTANCES or method(s) of manufacture or use(s) of the MODIFICATIONS or OTHER SUBSTANCES. RECIPIENT shall consult with PROVIDER as soon as practical in the event that a joint invention respecting MODIFICATIONS or OTHER SUBSTANCES is made by RECIPIENT and PROVIDER, and the parties shall discuss in good faith the details respecting filing, prosecution and commercial licensing of such joint invention. Inventorship of inventions shall be determined according to US Patent Laws.
9. Any MATERIAL delivered pursuant to this Agreement is 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 REPRESENTATIONS OR WARRANTIES THAT THE USE OF THE MATERIAL WILL NOT INFRINGE ANY PATENT, COPYRIGHT, TRADEMARK, OR OTHER PROPRIETARY RIGHTS.
10. 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, MODIFICATIONS or OTHER SUBSTANCES. The PROVIDER 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, MODIFICATIONS or OTHER SUBSTANCES by the RECIPIENT or third parties to whom the RECIPIENT has distributed MODIFICATIONS or

OTHER SUBSTANCES, except to the extent permitted by law when caused by the gross negligence or willful misconduct of the PROVIDER.

11. This Agreement is not assignable without the prior written consent of PROVIDER.
12. This Agreement shall not be interpreted to prevent or delay publication of research findings resulting from the use of the MATERIAL, MODIFICATIONS, or OTHER SUBSTANCES. The RECIPIENT SCIENTIST agrees to provide appropriate acknowledgement of the source of the MATERIAL in all publications.
13. The RECIPIENT agrees to use the MATERIAL in compliance with all applicable statutes and regulations, including Public Health Service, Food and Drug Administration, Environmental Protection Agency, United States Department of Agriculture, and National Institutes of Health regulations and guidelines such as, for example, those relating to research involving the use of animals or recombinant DNA.
14. Subject to paragraph 15, this Agreement shall expire one (1) year after its date of execution or on the earliest of the following dates: (a) when the MATERIAL becomes generally available from third parties, for example, through reagent catalogs or public depositories or (b) on completion of the RECIPIENT's specific research study described herein or (c) on thirty (30) days written notice by either party to the other, provided that:
 - (i) if termination should occur under 14(a), the RECIPIENT shall continue to be bound to the PROVIDER by the least restrictive terms applicable to the MATERIAL obtained from the then-available resources; and
 - (ii) if termination should occur under 14(b) above, the RECIPIENT will discontinue its use of the MATERIAL and will, upon direction of the PROVIDER, return or destroy any remaining MATERIAL. The RECIPIENT, at its discretion, will also either destroy the MODIFICATIONS or remain bound by the terms of this agreement as they apply to MODIFICATIONS; and
 - (iii) in the event the PROVIDER terminates this Agreement under 14(c) other than for breach of this Agreement or for cause such as an imminent health risk or patent infringement, the PROVIDER will defer the effective date of termination for a period of up to one year, upon request from the RECIPIENT, to permit completion of research in progress that is part of the specific research study described herein. Upon the effective date of termination, or if requested, the deferred effective date of termination, RECIPIENT will discontinue its use of the MATERIAL and will, upon direction of the PROVIDER, return or destroy any remaining MATERIAL. The RECIPIENT, at its discretion, will also either destroy the MODIFICATIONS or remain bound by the terms of this agreement as they apply to MODIFICATIONS.
15. PROVIDER shall have the right to terminate this Agreement at any time if RECIPIENT, RECIPIENT SCIENTIST or others working under his/her direct supervision breaches any of the terms, covenants or conditions of this Agreement. Upon such termination, RECIPIENT shall immediately return any remaining MATERIAL to the PROVIDER.
16. The provisions of this Agreement are severable. In the event any provision of this Agreement is determined to be invalid or unenforceable, such invalidity or unenforceability shall not affect the validity or enforceability of the remaining provisions hereof and the provision shall be reformed to be enforceable and reflect as closely as possible the intent of the original provision.
17. Any waiver of compliance with the terms of this Agreement must be in writing, and any waiver in one instance shall not be deemed a waiver in any future instance.
18. This Agreement is the complete and exclusive statement of the understanding between the parties regarding the subject matter herein, and it supersedes all prior or contemporaneous

communications or Agreements regarding the subject matter herein. This Agreement may be amended only by a writing signed by both the PROVIDER and the RECIPIENT.

19. Paragraphs 6, 9, and 10 of this Agreement shall survive termination.
20. The MATERIAL is provided at no cost other than a transmittal fee solely to reimburse the PROVIDER for its preparation and distribution costs.

[Remainder of Page Left Blank]

III . Agreed to and Accepted by:

PROVIDING SCIENTIST:

Name: _____ Organization: University of South Florida
Board of Trustees
College of _____
Title: _____ Address: _____
Signature: _____ Date: _____

PROVIDER:

Authorized Official: Michele Tyrpak, J.D. Organization: University of South Florida Board of
Trustees, a public body corporate
Title: Associate Director, Technology Transfer Office Address: 3802
Spectrum Boulevard, Suite 100
Tampa, Florida 33612
Signature: _____ Date: _____

RECIPIENT SCIENTIST:

Name: _____ Organization: _____
Title: _____ Address: _____

Shipping Address for Materials: _____

Signature: _____ Date: _____

RECIPIENT:

Authorized Official: _____ Organization: _____
Title: _____ Address: _____
Signature: _____ Date: _____