

**ACADEMIC MATERIAL TRANSFER AGREEMENT**

This academic material transfer agreement (this “**Agreement**”) dated and made effective \_\_\_\_\_ (the “**Effective Date**”), is between \_\_\_\_\_ (“**Recipient**”), on behalf of \_\_\_\_\_ (“**Recipient Scientist**”), located at \_\_\_\_\_, and the Wisconsin Alumni Research Foundation (“**WARF**”), a Wisconsin nonprofit, nonstock corporation located at 614 Walnut Street, Madison, Wisconsin 53726.

The materials identified below (the “**Original Materials**”), have resulted from the research efforts of \_\_\_\_\_, a professor at the University of Wisconsin-Madison (“**University**”), working either alone or together with other researchers at the University (\_\_\_\_\_ and the other researchers, either alone or together, are referred to as “**University Researchers**”). WARF, as the designated patent management organization for the University, holds, or may hold, a proprietary interest relating to the Original Materials by assignment. The Original Materials are identified as follows:

**Technology Title:** \_\_\_\_\_  
 \_\_\_\_\_

**WARF Ref:** \_\_\_\_\_

**I. Definitions.** The following definitions shall apply in this Agreement:

“**Material**” shall mean Original Materials, Progeny, and Unmodified Derivatives. Material shall not include (a) Modifications, or (b) other substances created by Recipient Scientist through the use of the Material which are not Modifications, Progeny, or Unmodified Derivatives.

“**Progeny**” shall mean unmodified descendants from the Material, such as virus from virus, cell from cell, or organism from organism.

“**Unmodified Derivatives**” shall mean substances created by Recipient which constitute an unmodified functional sub-unit or product expressed by the Original Materials. Some examples include: subclones of unmodified cell lines, purified or fractionated subsets of the Original Materials, proteins expressed by DNA/RNA supplied by University Researchers, or monoclonal antibodies secreted by a hybridoma cell line.

“**Modifications**” shall mean substances created by Recipient Scientist that contain or incorporate the Material, whether in whole or in part.

“**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.

“**Nonprofit Organization**” shall mean 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.** It is WARF's understanding that the University Researchers may provide to Recipient Scientist samples of the Original Materials. Transferee agrees to receive the Original Materials subject to the following obligations and provisions:

1. WARF retains ownership of the Material, including any Material contained or incorporated in Modifications.

2. Recipient retains ownership of: (a) Modifications (except that, WARF retains ownership rights to the Material included therein), and (b) those substances created through the use of the Material or Modifications, but which are not Progeny, Unmodified Derivatives or Modifications (i.e., do not contain the Original Materials, Progeny, Unmodified Derivatives). If either 2(a) or 2(b) result from the collaborative efforts of WARF and Recipient, joint ownership may be negotiated.

3. Recipient and Recipient Scientist agree that the Material:

- (a) is to be used solely for teaching and academic research purposes as described in Exhibit A attached hereto;
- (b) will not be used in human subjects, in clinical trials, or for diagnostic purposes involving human subjects without the written consent of WARF;
- (c) is to be used in compliance with any and all applicable governmental rules and regulations relating to the handling or use of such Material;
- (d) is to be used only at the Recipient organization and only in Recipient Scientist's laboratory under the direction of Recipient Scientist or others working under Recipient Scientist's direct supervision;
- (e) will be retained in Recipient and Recipient Scientist's secure possession;
- (f) will not be manufactured by or for Recipient or Recipient Scientist for Commercial Purposes; and
- (g) will not be transferred except as provided herein.

4. Recipient and Recipient Scientist agree to refer to WARF's Materials Licensing Manager any request for the Material from anyone other than those persons working under Recipient Scientist's direct supervision. To the extent supplies are available, WARF will request University Researchers to provide Material, under a separate Material Transfer Agreement, to other scientists (at least those at Nonprofit Organizations) who wish to replicate the Recipient Scientist's research, provided that such other scientists reimburse the University for any costs relating to the preparation and distribution of the Material.

5. The Recipient and Recipient Scientist may:

- (a) distribute substances created by the Recipient Scientist through the use of the Original Material only if those substances are not Progeny, Unmodified Derivatives, or Modifications; and
- (b) only under a separate agreement having terms at least as protective of WARF's rights as contained herein, distribute Modifications to Nonprofit Organizations for research and teaching purposes.

Without written consent from WARF, neither the Recipient nor the Recipient Scientist may provide Modifications for Commercial Purposes. It is recognized by the Recipient that such Commercial

Purposes may require a commercial license from WARF and WARF 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 intellectual property rights claiming such Modifications, or methods of their manufacture or their use.

7. Recipient acknowledges that the Material is 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 Recipient under any patents, patent applications, trade secrets or other proprietary rights of WARF, including any altered forms of the Material made by WARF. In particular, no express or implied licenses or other rights are provided to use the Material, Modifications, or any related patents of WARF for Commercial Purposes.

8. Recipient and Recipient Scientist agree that any information received from WARF or the University Researchers relating to the Original Materials, which is marked confidential (the "Confidential Information") will not be used by Recipient or Recipient Scientist or its employees or agents as the basis for any patent application disclosing or claiming any of the same without WARF's written consent, which consent shall not be unreasonably withheld. Except as may be authorized in advance in writing by WARF, Recipient and Recipient Scientist agree to preserve the confidential status of the Confidential Information, following procedures with regard thereto at least as stringent as it follows with respect to their own proprietary information. These confidentiality obligations shall not apply to any information that:

- (a) was known to Recipient Scientist prior to the receipt of the information or that is developed independently of the information;
- (b) becomes known to the public not as a result of any action or inaction by Recipient or Recipient Scientist;
- (c) Recipient Scientist acquires from a third party who has the right to disclose to Recipient Scientist;
- (d) five years have elapsed from the later of the date of this Agreement or the disclosure of the information to Recipient Scientist; or
- (e) is required to be disclosed by law, governmental rule or regulation or order of a court of competent jurisdiction.

9. Recipient Scientist acknowledges that the Original Materials provided by WARF or UW Researchers are experimental in nature, may have hazardous properties, and are supplied to Recipient Scientist WITHOUT ANY WARRANTIES, EXPRESS OR IMPLIED, INCLUDING ANY WARRANTY OF TITLE, MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE OR ANY WARRANTIES REGARDING INFRINGEMENT OF THIRD PARTY RIGHTS. Recipient and Recipient Scientist agree to rely solely upon their own opinion of the Original Materials with regard to their safety and suitability for any purpose.

10. Except to the extent prohibited by law, Recipient assumes all liability for damages which may arise from Recipient's and/or Recipient Scientist's use, storage or disposal of the Material. Neither WARF, University Researchers, nor University and their employees or agents will be liable to Recipient or Recipient Scientist for any loss, claim or demand made by Recipient or Recipient Scientist, or made against Recipient or Recipient Scientist by any other party, due to or arising from the use, storage or handling of the Material by Recipient or Recipient Scientist, except to the extent permitted by law when caused by the gross negligence or willful misconduct of WARF or University Researchers.

11. Recipient Scientist understands that the University Researchers, WARF or the University may charge Recipient a transfer fee for shipping the Original Materials. Such fee, if any, is intended to reimburse the University Researchers, WARF and/or the University with respect to the preparation and transfer of the Original Materials. Despite the payment of any such fee, the transfer of the Original Materials shall not be construed as a sale of the Original Materials.

12. Recipient Scientist agrees to communicate to WARF all publications and/or research results made public by Recipient Scientist based on Recipient Scientist's research using the Material. In addition, Recipient Scientist agrees that any reports, publications, or other disclosure of results obtained with the Material will acknowledge the University Researchers and the University as the source of the Original Materials.

13. This Agreement is governed by the laws of Wisconsin. This Agreement may not be assigned or transferred without prior written consent of the non-assigning party. This Agreement is a material transfer agreement and not a joint research agreement. This Agreement constitutes a complete statement of all of the arrangements between the parties as of the Effective Date with respect to subject matter contained herein, and supersedes all prior agreements and understandings between them with respect thereto. Neither party shall claim any amendment from any provisions of this Agreement by mutual agreement, acknowledgment, or otherwise, unless such mutual agreement is in writing, signed by both parties and specifically states that it is an amendment to this Agreement.

16. This Agreement will terminate 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 Recipient Scientist's current research with the Material (as described in Exhibit A); or
- (c) on thirty (30) days written notice by either party to the other; provided that:
  - (i) if termination should occur under 16(a) or 16(b) above, Recipient/Recipient Scientist shall be bound to WARF by the least restrictive terms applicable to the Material obtained from the then-available sources; or
  - (ii) if termination should occur under 16(c) above, Recipient/Recipient Scientist will discontinue use of the Material and will, upon direction of WARF, return or destroy any remaining Material. Recipient, at its discretion, will also either destroy the Modifications or remain bound by the terms of this Agreement as they apply to Modifications; or
  - (iii) in the event WARF terminates this Agreement under 16(c) above other than for breach of this Agreement or for cause such as an imminent health risk or patent infringement, WARF will defer the effective date of termination for a period of up to one year, upon request by Recipient, to permit completion of Recipient Scientist's research in progress. 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 WARF, return or destroy any remaining Material. Recipient, at its discretion, will also either destroy the Modifications or remain bound by the terms of this Agreement as they apply to Modifications.

17. Paragraphs 5, 9, 10 and 17 of this Agreement shall survive termination.

18. This Agreement may be executed in one or more counterparts. Each duplicate and counterpart shall be equally admissible in evidence, and each shall fully bind each party who has executed it.

The parties have indicated their acceptance of the terms of this Agreement by the signatures set forth below on the dates indicated. The persons signing below represent that they have the authority to execute this Agreement on behalf of the party for whom they have signed.

**WISCONSIN ALUMNI RESEARCH FOUNDATION**

By: \_\_\_\_\_  
Craig J. Christianson, Director of Licensing

Date: \_\_\_\_\_

**RECIPIENT**

By: \_\_\_\_\_  
Signature of Authorized Organization Official

Date: \_\_\_\_\_

**RECIPIENT SCIENTIST**

Read and understood:

By: \_\_\_\_\_  
Signature of Recipient Scientist

Date: \_\_\_\_\_

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

Shipping Address if different from above: \_\_\_\_\_  
\_\_\_\_\_

Telephone Number: \_\_\_\_\_ E-mail Address: \_\_\_\_\_

**Exhibit A**

Research Description (please limit to 250 words or less)