

## BIOLOGICAL MATERIAL TRANSFER AGREEMENT

For good and valuable consideration, the receipt and sufficiency of which the parties hereby acknowledge, **The Governing Council of the University of Toronto** (the “**Provider**”) of 27 King’s College Circle, Toronto, ON M5S 1A1 agrees to provide research materials to **XXXXXX** (the “**Recipient**”) of xxxxxx with a license to use biological material as described below for research use, subject to the terms and conditions set forth in this Agreement.

### 1. Definitions

(a) “**Confidential Information**” means information that a party identifies in writing at the time of transmittal as confidential, but does not include information that:

- i. is already known by the party to which it is disclosed;
- ii. is or becomes part of the public domain without breach of this Agreement;
- iii. is obtained from third parties that have no obligation to keep confidential to the parties to this Agreement;
- iv. is independently developed by the receiving party or its parent corporation or their respective subsidiaries and/or affiliates without the aid, application or use of the Confidential Information (and such independent development can be properly demonstrated by the receiving party; or,
- v. is required by law, regulation, rule, act or order of any governmental authority or agency to be disclosed by the receiving party, provided, however, that such receiving party (A) gives the disclosing party sufficient advance written notice to permit it to seek a protective order or other similar order with respect to such Confidential Information and (B) thereafter discloses only the minimum information required to be disclosed in order to comply, whether or not a protective order or other similar order is obtained by such disclosing party.

(b) “**Material**” means Original Material plus Progeny and Unmodified Derivatives.

(c) “**Modifications**” means substances created by the Recipient that contain or incorporate the Material.

(d) “**Original Material**” means **the murine gene trap embryonic stem cell line xxxx**.

(e) “**Progeny**” means an unmodified descendant from the Material, such as virus from virus, cell from cell, or organism from organism.

(f) “**Provider’s Scientist**” means **Dr William L. Stanford** of the Institute of Biomaterials and Biomedical Engineering, University of Toronto.

(g) “**Recipient’s Scientist**” means **xxxx**

(h) **“Research”** means the research conducted by the Recipient’s Scientist described in the attached Appendix “A”.

(i) **“Unmodified Derivatives”** means substances created by the Recipient that constitute an unmodified functional sub unit or an expression product of the Original Material, including subclones of unmodified cell lines, purified or fractionated subsets of the Original Material, proteins expressed by DNA/RNA supplied by Provider, monoclonal antibodies secreted by a hybridoma cell line, and subsets of the Original Material such as novel plasmids or vectors.

## **2. Material Transfer**

(a) **Use of Material.** The Provider grants a non-exclusive license to the Recipient to use the Material solely in performance of the Research. The Recipient will not use the Material in human subjects or in clinical trials involving human subjects without the Provider’s prior written permission.

(b) **Fee.** The license to use the Material is provided for a fee of US\$1000, which may serve to reimburse the Provider for its distribution costs, such fee to be payable upon receipt of the Original Material by the Recipient.

(c) **Consulting.** During the three (3) month period commencing upon receipt of the Original Material by the Recipient, the Recipient shall have the option to engage the Provider’s Scientist as a consultant for a maximum of eight (8) hours of verbal consulting services for a fee and full reimbursement of travel and accommodation costs, as may be agreed by the Recipient and the Provider’s Scientist under an independent consulting agreement, provided that the Provider’s Scientist will not be obliged to enter into such a consulting agreement.

## **3. Reports and Publications**

(a) **Reports.** The Recipient’s Scientist will inform the Provider’s Scientist, in confidence, of the results of the Research, by personal communication or by providing copies of manuscripts describing the results of the Research to the Provider’s Scientist prior to submission for publication.

(b) **Publications.** The Recipient and the Recipient’s Scientist will acknowledge the Provider as the source of the Material in any publication of Research results.

## **4. Intellectual Property**

(a) **Title to Material.** Legal title to the Material will remain with the Provider. The Provider has not filed patent applications claiming the Material or uses thereof.

(b) **No Other Rights.** Except as expressly provided in this Agreement, no rights are granted to the Recipient under any patents, patent applications, trade secrets, or other proprietary rights of the Provider. In particular, no rights are granted to use the Material or Modifications and any related patents of the Provider for profit making or commercial purposes, including sale, distribution or further transfer of the Material or Modifications for any purpose, use in manufacturing, or provision of a service to a third party in exchange for consideration.

(c) **Commercial Use.** If the Recipient wishes to use the Material or Modifications for profit-making or commercial purposes, the Recipient will, in advance of such use, negotiate in good faith with the Provider to establish the terms of a commercial license. The Provider will have no obligation to grant

such a license to the Recipient, and may grant exclusive or non-exclusive licenses to others and may continue to use the Material without restriction.

(d) **Confidential Information.** The parties may disclose Confidential Information one to another to facilitate the performance of the Research. Confidential Information will be safeguarded and not disclosed to third parties by the receiving party. The Recipient may disclose the Provider's Confidential Information to the Recipient's parent corporations, affiliates and subsidiaries only if such parent corporations, affiliates and subsidiaries agree to be bound by confidentiality and non-use provisions at least as protective of the Provider's rights as those contained in this Agreement.

(e) **Inventions.** If the Research results in an invention or Modification related directly to the Material that the Recipient may wish to commercially exploit, the Recipient's Scientist will promptly disclose the invention or Modification to the Recipient's intellectual property office, disclosing the Provider's role as supplier of the Material used as well as the role, if any, of any of the Provider's employees in creating the invention or Modification. Inventorship for such invention or Modification will be determined according to United States patent law. The Recipient, in co-operation with the Recipient's Scientist, will promptly supply the Provider with a copy of the disclosure and/or a sample of the Modification, which the Provider will hold in confidence and use only for the Provider's evaluation purposes for a period of five (5) years from the date of disclosure to the Provider.

(f) **License.** If the Recipient desires to use or licence 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 licence 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.

## 5. **Term and Termination**

(a) **Term and Termination.** This Agreement will enter into force as of the last date of execution below and will terminate on the earliest of the following dates:

- i. when the Material becomes generally available from third parties;
- ii. on completion of the Research; or,
- iii. on thirty (30) days written notice by either party to the other party.

(b) **Effect of Termination.** If termination occurs under paragraph 5(a)(i), the Recipient will be bound to the Provider by the least restrictive terms applicable to Material obtained from the then available sources. Except as provided in article 5(c) below, on termination of this Agreement under paragraphs 5(a)(ii) or (iii), the Recipient will discontinue its use of the Material and will, upon the Provider's direction, return or destroy any remaining Material.

(c) **Deferred Termination.** If termination occurs under paragraph 5(a)(iii) other than for breach of this Agreement or with cause such as imminent health risk or patent infringement, the Provider will, upon the Recipient's request, defer the effective date of termination for a period of up to one year to permit completion of research in progress.

## 6. Limitation of Liability

(a) **No Warranty.** The Material is experimental in nature and may have hazardous properties. THE PROVIDER MAKES NO REPRESENTATIONS AND EXTENDS NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED. THERE ARE NO EXPRESS OR IMPLIED WARRANTIES, TERMS OR CONDITIONS OF MERCHANTABILITY OR FITNESS FOR ANY PURPOSE, OR THAT THE USE OF THE MATERIAL WILL NOT INFRINGE ANY PATENT, COPYRIGHT, TRADEMARK, OR OTHER PROPRIETARY RIGHTS.

(b) **Indemnity.** The Recipient will defend and hold Provider, its directors, officers, employees, agents, and students harmless against all claims, proceedings, demands, and liabilities of any kind whatsoever, including legal expenses and reasonable attorney's fees, arising out of the Recipient's use, handling, storage, or disposition of the Material or arising from the breach of any obligation of the Recipient or the Recipient's Scientist hereunder.

(c) **Limitation of Liability.** In no event will the Provider be liable to the Recipient for any loss, claim, demand, or liability of any kind whatsoever, made by the Recipient, or made against the Recipient by any other party, due to or arising from the use of the Material by the Recipient, the Recipient's Scientist, or any other personnel under the Recipient's control, except to the extent caused by the gross negligence or wilful misconduct of the Provider.

## 7. Miscellaneous

(a) **Compliance with Laws.** The Recipient and the Recipient's Scientist will use the Material in compliance with all laws, governmental regulations and guidelines, including National Institutes of Health guidelines and any regulations or guidelines pertaining to research with animals or recombinant DNA, that may be applicable to the Material.

(b) **Notices.** Any notices any payments under this Agreement will be sent to the parties at the following addresses:

i. to the Provider and the Provider's Scientist:

Intellectual Property & Contracts Office  
University of Toronto  
27 King's College Circle  
Toronto, ON M5S 1A1 CANADA

Dr. William L. Stanford, Ph.D.  
Institute of Biomaterials & Biomedical Eng.  
University of Toronto  
164 College Street. Rm 407  
Toronto, ON M5S 3G9 CANADA

ii. to the Recipient and the Recipient's Scientist:

(c) **No Assignment.** The Recipient shall not assign any or all of its rights and obligations under this Agreement without the Provider's prior written consent, which may not be unreasonably withheld.

(d) **Successors.** This Agreement will bind and enure to the benefit of the parties and their respective heirs, successors and permitted assigns.

(e) **Entire Agreement.** This Agreement is the entire agreement of the parties and no change or modification will be valid unless it is in writing and signed by all parties.

(f) **Governing Law.** This Agreement shall be governed by and construed in accordance with the laws of Canada and the laws of the Province of Ontario applicable therein.

(g) **Headings.** Paragraph headings in this Agreement are for purposes of convenience only and will not be used in the interpretation of this Agreement.

In witness whereof the parties agree to be bound by the terms and conditions of this Agreement.

**THE GOVERNING COUNCIL OF  
THE UNIVERSITY OF TORONTO**

XXXX

\_\_\_\_\_  
Name:  
Title:  
Date:

\_\_\_\_\_  
Name:  
Title:  
Date:

**Provider's Scientist:**

**Recipient's Scientist:**

\_\_\_\_\_  
Name: Dr. William L. Stanford  
Date:

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

SPECIMEN

**APPENDIX "A"**

**Description of the Research**

SPECIMEN