



UFFICIO REGIONALE DI TRASFERIMENTO TECNOLOGICO

MATERIAL TRANSFER AGREEMENT

- English version -



MATERIAL TRANSFER AGREEMENT

of..... compounds and structures for non-commercial research purposes

BY AND BETWEEN

..... (name of the ADMINISTRATIVE UNIT) of the University, Tax Code/V.A.T. number, with registered office in (hereinafter, the 'PROVIDER'), represented by as (position of the authorised representative)

AND

..... (company name of the recipient) Tax Code/V.A.T. number, with registered office in (hereinafter, the 'RECIPIENT'), represented by as (position of the authorised representative) which are also referred to individually herein as the "PARTY" or collectively as the "PARTIES".

WHEREAS

(possible preliminary observations, e.g. common research interests)

a) Within the scope of the institutional research activity and under the supervision of the scientific supervisor Prof./Dott., the PROVIDER developed (hereinafter the "MATERIAL") as described in (publications or patent applications) or as further specified in Annex 1 'Description of the material';

b) The RECIPIENT is interested in obtaining samples of the MATERIAL solely for non-commercial research purposes as further described in Annex 2 'Research Project';

c) The PROVIDER is willing to provide the MATERIAL to the RECIPIENT solely for the agreed purposes and in accordance with the terms and conditions set out in the following agreement (hereinafter referred to as the 'AGREEMENT');

d) The PROVIDER approved the conclusion of the present AGREEMENT in the Council meeting of (or the Director will present this AGREEMENT for ratification by the Council at its next meeting).

NOW THEREFORE THE PARTIES AGREE AS FOLLOWS

Art. 1 Recitals and Annexes

1.1. The recitals and annexes of the AGREEMENT are an integral and substantial part of it and bind its interpretation and implementation.

Art. 2 Definitions

2.1. The words used in the upper case in the AGREEMENT shall have the meaning specified by the CONTRACT.

2.2. 'MATERIAL' refers to compounds and structures developed by the PROVIDER using substantial investments and upon which the PROVIDER retains exclusive rights. The MATERIAL shall not include modifications, or other substances created by the RECIPIENT using the MATERIAL which are not strictly modifications.

2.2. 'MODIFICATIONS' refers to the substances conceived by the RECIPIENT which contain or incorporate the MATERIAL.

2.3. 'RIGHTFUL EXCHANGE' refers to the transfer of the MATERIAL within the same company or institution or research group, included the members of different research institutes which collaborate on a defined project.

2.4. 'COMMERCIAL PURPOSES' refers to the trade, lease, license, assignment or other transfer of the MATERIAL to a party performing profit-making business. The use of the MATERIAL for COMMERCIAL PURPOSES includes also sponsored research by any party, including the RECIPIENT, to produce or manufacture the products to trade, to perform research activity aimed in the trade, lease, license, or assignment of the MATERIAL to a profit-making business or to whatever other profit-making business which requests a commercial license.

2.5. 'NON-COMMERCIAL PURPOSES' refers to the research, teaching, or other activity performed by the RECIPIENT without direct connections with commercial activities such as trade, lease, license assignment or other transfer of the MATERIAL to a profit-making business.

2.6. 'CONFIDENTIAL INFORMATION' includes, for instance, the project, information, data, knowledge, know-how, studies, research methods, procedures, formulae, ideas, drawings, technical reports, materials, processes, documents, evaluations, reports, studies, graphical representations, charts, plans, software, samples, in-vivo and in-vitro tests, lab practicum, prototypes, inventions and whatnot refers to the MATERIAL and is qualified as confidential in accordance with the following paragraph of the article herein, even if including general public domain elements.

2.7. The CONFIDENTIAL INFORMATION transmitted from one PARTY to the other in tangible form, the receipt of which shall be confirmed in writing by the receiving PARTY, shall be expressly identified as such by a stamp/watermark/indication bearing the wording 'Confidential'. CONFIDENTIAL INFORMATION transmitted in intangible form shall be identified either by the express mention of its secrecy or by written notice to the receiving PARTY to be provided by the disclosing PARTY within (.....) days after transmission in intangible form.

Art. 3 Subject matter of the AGREEMENT

3.1. The PROVIDER agrees to transfer the MATERIAL to the RECIPIENT for the sake of science with the unavoidable limit of forbidden use on human subjects.

3.2. The MATERIAL will only be used for RESEARCH PURPOSES by the RECIPIENT in its laboratory, as better specified in Annex 2.

3.3. Due to the execution of the AGREEMENT, the RECIPIENT undertakes to perform the payment of the consideration outlined in Art. 9 of the AGREEMENT and take delivery of the MATERIAL whereof Annex 1. The RECIPIENT agrees to receive the MATERIAL and to comply with all rules, regulations, guidelines and recommendations in force, promulgated by international and national organisms and applicable to the MATERIAL.

Art. 4. Obligations of the RECIPIENT

4.1. The MATERIAL will not be further distributed to third parties without the PROVIDER's written consent. The RECIPIENT shall refer any request regarding the MATERIAL to the PROVIDER. The PROVIDER shall not refuse its consent without a reason (e.g. out of stock MATERIAL) for the RIGHTFUL EXCHANGE and for the transfer to a third party not involved in a profit-making business. Third parties shall first conclude a prearranged agreement with the PROVIDER, analogous hereto.

4.2. The RECIPIENT commits so that in the laboratory the access to the MATERIAL will be restricted only to qualified personnel and capable of handling it with safety. Furthermore, the RECIPIENT adopts every necessary measure, taking into account the specific features of the MATERIAL, and appropriate precautions both to minimize any harmful event that may occur to personnel and to things as well as to safeguard the MATERIAL in the event of theft or improper use.

4.3. The RECIPIENT assumes the obligation to keep the books, registers and other laboratory documents in order to provide any reasonable detail concerning the MATERIAL to the

PROVIDER and to allow the verification of the fulfilment of obligations deriving from the AGREEMENT. Moreover, the RECIPIENT will consent that such books, registers and other laboratory documents shall be inspected and verified by one or more experts appointed and paid by the PROVIDER.

Art. 5. Intellectual Property

Joint ownership option

5.1. PARTIES agree that all rights, titles and interests in or arising out of any inventions, know-how, materials, substances and other results conceived or generated by RECIPIENT (whether being protected by intellectual property rights or not) and related to the MATERIAL or its use will vest equally with PROVIDER and RECIPIENT.

5.2. PARTIES agree to negotiate a joint ownership agreement which shall specify the rights and obligations of each PARTY related to the use, exploitation and protection of the joint inventions.

5.3. The RECIPIENT retains exclusive ownership of: (a) MODIFICATIONS, yet the PROVIDER retains ownership rights to the MATERIAL included therein, and (b) substances created through the use of the MATERIAL or MODIFICATIONS. If either (a) or (b) result from the collaborative efforts of the PROVIDER and the RECIPIENT, joint ownership may be negotiated. Under a separate implementing letter to this AGREEMENT (or under a protective agreement at least as protective of the PROVIDER's rights as the current AGREEMENT), the RECIPIENT may distribute MODIFICATIONS to no-profit organizations for NON-COMMERCIAL PURPOSES only.

ALTERNATIVELY RECIPIENT's ownership option

5.1. All intellectual property rights and all data, results, and outcomes deriving from the use of the MATERIAL are property of the RECIPIENT pursuant to the limits and exceptions expressly provided by the article hereto.

5.2. The PROVIDER will retain exclusive rights of the original MATERIAL in case included in the results deriving from RECIPIENT's research activity.

5.3. The RECIPIENT shall be entitled the right to patent the inventions (MODIFICATIONS included) conceived through the use of the MATERIAL but shall inform the PROVIDER, confidentially, of the patent claims regarding the MODIFICATIONS, mode of production or the use of the MATERIAL.

5.4. If the RECIPIENT files a patent concerning an invention directly deriving from the use of the MATERIAL, said RECIPIENT shall grant the PROVIDER a royalty free, non-exclusive license for all applicable Countries, allowing the transfer, sublicense, own internal research activity and teaching and permitting to continue to distribute the MATERIAL to third parties.

5.5. In the event the RECIPIENT intends to exploit or to use the MATERIAL or the MODIFICATIONS for COMMERCIAL PURPOSES shall send a formal request to the PROVIDER in order to obtain, at the discretion of the latter, a license upon payment to use the MATERIAL or the MODIFICATIONS, in accordance with the purposes and the terms which will be established.

Art. 6. Publications

6.1. The RECIPIENT is entitled the right to publish the results concerning the activities performed on the MATERIAL provided the PROVIDER will be cited as the source of the MATERIAL in any publications reporting use of it, but for the PROVIDER's different request. If the result derived from the experiments is suitable for publication, the manuscript should be jointly prepared by both PARTIES based on mutual agreement.

6.2. The RECIPIENT may publish or otherwise publicly disclose the results of the RESEARCH PROJECT, but if the PROVIDER has given CONFIDENTIAL INFORMATION to the RECIPIENT, such a public disclosure may occur only after the PROVIDER has had thirty (30) days to review the proposed disclosure to determine if it includes any CONFIDENTIAL INFORMATION that may also be protected by intellectual property rights.

6.3. The RECIPIENT agrees to provide at no cost other than the reimbursement of reasonable packaging and delivery expenses, to the PROVIDER, upon this latter one's request, a reasonable amount of published MATERIAL generated directly by the RECIPIENT in the research activity performed using the MATERIAL. Such MATERIAL shall be used by the PROVIDER for its internal use, not-for-profit research activity and teaching.

Art. 7. Waiver

7.1 The MATERIAL delivered pursuant to this AGREEMENT is understood to be experimental in nature and may have hazardous properties. If applicable, the RECIPIENT agrees that the MATERIAL classified as a biological agent in Group 2 or superior (in accordance with applicable EU and national legislation) constitutes known pathogens and that other MATERIAL might be, under specific conditions, considered pathogenic.

7.2. The RECIPIENT agrees that the packaging, delivery, and any other activity performed in its own laboratory shall comply with any applicable law, regulation, recommendation and guidelines.

7.3. The RECIPIENT assumes all liability for claims for damages against it by third parties which may arise from the use, storage or disposal of the MATERIAL except that, to the extent permitted by law, the PROVIDER shall be liable to the RECIPIENT for damages caused by its gross negligence or willful misconduct.

7.4. The PROVIDER makes no representation or warranty of any kind, either expressed or implied, nor assumes any responsibility or warranty regarding merchantability or fitness of the MATERIAL for a particular purpose, or that the use of the MATERIAL will not infringe any patent, copyright, trademark, or other third parties' proprietary rights.

7.5. The PROVIDER shall not be liable towards the RECIPIENT for any damages resulting, emerging, incidental, indirect or as a result of the implementation of any kind of fines deriving from the performance of the AGREEMENT or due to undertaking activities concerning the MATERIAL also if the PROVIDER has been informed of the possibility of those damages or outcomes.

7.6. The only remedy against the PROVIDER or its collaborators in case of potential contractual and extra-contractual damages will be the replacement of the MATERIAL.

Art. 8. Confidentiality

8.1. During the duration of the AGREEMENT and for
(.....) years following the end of the AGREEMENT, the RECIPIENT shall maintain, all over the world, confidentiality regarding CONFIDENTIAL INFORMATION which shall not be disclosed to third parties, divulged or disseminated by any way or mean without the PROVIDER's prior written consent. Furthermore, the RECIPIENT commits to use the CONFIDENTIAL INFORMATION solely for the purpose of the Research project as in Annex 2, with the exclusion of any other purpose, and only for the time necessary. In any case the RECIPIENT commits to use and to protect the CONFIDENTIAL INFORMATION with the utmost diligence and to employ all security measures adopted to use and protect its own confidential information of the same nature.

8.2. The RECIPIENT commits as well to limit the dissemination of CONFIDENTIAL INFORMATION solely to the personnel strictly necessary inside its own organization for the purposes referred to in section c) of the recitals to the extent of the nature of their assignment (so called 'need-to-know' principle) and, in any case, provided that such personnel is bound in writing to the

AGREEMENT and without prejudice to the responsibility of the RECIPIENT for confidentiality breaches by its informed personnel. The RECIPIENT shall communicate to the PROVIDER the names of all the personnel exposed to the CONFIDENTIAL INFORMATION.

8.3. CONFIDENTIAL INFORMATION does not include information for which it can be proved that:

- the information was in the public domain at the time of transmission or subsequently fell in the public domain without violating this AGREEMENT;
- the information was available to the recipient PARTY before the closing of the AGREEMENT, or is later developed independently by the recipient PARTY or disclosed to it by third parties who [apparently] have the right to do so;
- a statute, court decision or administrative act compels to disclose provided that the PARTY involved notifies the other PARTY before the disclosure so that the PARTIES consult each other and agree on the timing and content of any disclosure limited to the requirements of the relevant law, court decision or administrative act.

Art. 9. Packaging costs and delivery

9.1. The MATERIAL is provided at no cost, except for the reimbursement of preparation and distribution costs incurred by the PROVIDER and established in Euro

ALTERNATIVELY

9.1 The RECIPIENT commits to pay to the PROVIDER the shipping cost and potential applicable taxes (for instance VAT) in accordance with the law. Payment is due immediately after receipt of the invoice and shall be done without bank transfer fees on the PROVIDER's banking account referred to in the invoice.

9.2. The PROVIDER ships the MATERIAL in compliance with applicable national and international safety regulations. After the MATERIAL has been handed over to the carrier, its loss or destruction shall be borne by the RECIPIENT.

9.3. The RECIPIENT shall be responsible for ensuring all authorizations necessary to receive the order. The proof of such authorizations shall be supplied, upon request, to the PROVIDER.

Art. 10. Duration and return obligations

10.1. This AGREEMENT is concluded for an indefinite period of time. Either PARTY may terminate this AGREEMENT at any time and for any reason upon ninety (90) calendar days prior to written notice. Such termination shall not affect any obligations by either PARTY

incurred up to the date of termination, nor shall it affect the ability of the RECIPIENT to complete any research use of MATERIAL transferred hereunder.

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10.1. This AGREEMENT enters into force from the date of conclusion and will terminate on the earliest of the following dates: (a) when the MATERIAL becomes generally available from third parties, for example, through reagent catalogues or public depositories or (b) on completion of the RECIPIENT's current research with the MATERIAL, or (c) on thirty (30) days written notice by either party to the other, or (d) on the date specified in an implementing letter, provided that: (i) if termination should occur under Art. 10(a), the RECIPIENT shall 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 Art. 10(b) or 10(d) 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 for breach of contract or for other good 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.

10.2. Upon the effective date of termination of the AGREEMENT, or if requested, the deferred effective date of termination, 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 own discretion, will also either destroy the MODIFICATIONS or remain bound by the terms of this agreement regarding the MODIFICATIONS.

Art. 11 Applicable law and submission clause

11.1. The AGREEMENT and all relationships between the PROVIDER and the RECIPIENT shall be subject to the Italian law and all disputes arising among the PARTIES concerning this AGREEMENT, shall fall under the exclusive competence of the Court of (in alternative shall be submitted to an arbitrator appointed by mutual agreement or, failing that, by the President of the Tribunal of).

Art. 12 Final provisions

12.1. No agreement or arrangement modifying, derogating from or extending the AGREEMENT shall be binding on any PARTY unless made in writing, expressly referring to the AGREEMENT and signed by the PARTIES and their respective duly authorised representatives.

12.2. If any provision of the AGREEMENT is held invalid, void or unenforceable, such defect shall not affect the remaining provisions of the AGREEMENT. The PARTIES shall be released from their rights and obligations under the conditions declared void, invalid or unenforceable to the extent such rights and obligations are directly affected by such defect. In such cases, the PARTIES shall negotiate in good faith the replacement of the invalid or void provisions by valid and effective ones following the PARTIES' intention.

12.3. In case one PARTY tolerates a behaviour of the other PARTY that may constitute a breach of the provisions of the AGREEMENT, this shall not constitute a tacit waiver of the rights deriving from the breached provisions or of the right to require the fulfilment even partially of the terms and conditions set out in the AGREEMENT, nor prevent the exercise of any other right or right of the PARTY under the AGREEMENT.

12.4. Neither PARTY may assign the AGREEMENT without the prior written agreement of the other PARTY.

PROVIDER: Professore

PROVIDER'S INSTITUTION: Università degli Studi di

Address: Department of, Viale

Place, date

PROVIDER'S signature

RECIPIENT:

RECIPIENT'S INSTITUTION:

Address:

Place, date

RECIPIENT'S signature

Pursuant to Art. 1341, second paragraph of the Italian Civil Code, the following articles are specifically approved: Art. 3 (Subject matter of the AGREEMENT), Art. 4 (Obligations of the RECIPIENT), Art. 5 (Intellectual Property), Art. 7 (Waiver), Art. 10 (Duration), Art. 11 (Applicable law and submission clause).

Place, date

PROVIDER'S signature

Place, date

RECIPIENT'S signature

Annexes:

- a. Description of the material (cfr. Recital a))
- b. Research Project (cfr. Recital b));
- c. Any other Annexe.



URTT | UFFICIO REGIONALE DI TRASFERIMENTO TECNOLOGICO

Via Luigi Carlo Farini, 8 – 50121

Firenze

urtt@regione.toscana.it