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** Columbia University

*College of Physicians*

 *and Surgeons*

**Material Transfer Agreement**

FOR THE TRANSFER OF NYSCF/COLUMBIA MATERIALS

FOR NON-PROFIT RESEARCH PURPOSES

This Material Transfer Agreement (“Agreement”) is entered into on \_\_\_\_\_\_\_\_\_\_\_\_, 201\_ (*“*Effective Date*”*) between **New York Stem Cell Foundation, Inc.**, a 501(c)(3) organization having its principal place of business at 1995 Broadway, Suite 600, New York, NY 10023 (“NYSCF”), and **The Trustees of Columbia University in the City of New York**, a non-profit corporation organized and existing under the laws of the State of New York (***“Columbia”***), collectively ***“NYSCF/Columbia”*** and [**insert name of recipient institution**] \_\_\_\_\_\_\_\_\_\_\_\_, having its principal place of business at [insert Recipient’s address] \_\_\_\_\_\_\_\_\_\_\_\_\_(“Recipient”); each a “Party” and together the “Parties.”

Whereas, NYSCF/Columbia have developed and owns certain materials and information, and rights relating to such materials and information; and

Whereas, Recipient, specifically the Recipient Scientist(s) named below, wishes to obtain, and NYSCF/Columbia are willing to provide, such materials for internal research use on the terms and conditions set forth in this Agreement;

Now, therefore, the Parties agree as follows:

1. **Definitions.**
	1. **“Material”** shall mean Original Material, Progeny, and Unmodified Derivatives.
	2. **“Progeny”** shall mean unmodified descendant(s) from the Material, such as virus from virus, cell from cell, or organism from organism.
	3. **“Unmodified Derivatives”** shall mean substances created or obtained by the Recipient which constitute an unmodified functional subunit or product expressed by the Original Material or Progeny. Unmodified Derivatives include, without limitation, subclones of unmodified cell lines, purified or fractionated subsets of the Original Material or Progeny, proteins expressed from DNA/RNA, and monoclonal antibodies secreted by a hybridoma cell line.
	4. **“Modifications”** shall mean substances created by the Recipient which contain or incorporate Original Material, Progeny, or Unmodified Derivatives.
	5. **“Commercial Purposes”** shall mean the sale, lease, license, or transfer of Material or Modifications for profit or to a for-profit entity. Commercial Purposes shall also include uses of Material or Modifications by any person or entity 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 Material or Modifications to a for-profit organization. For clarity, use of Material or Modifications in industrially-sponsored research performed by a Non-Profit Entity in such entity's own laboratories shall not be considered use for Commercial Purposes.
	6. **“Recipient Scientist”** shall mean Dr. [insert name]\_\_\_\_\_\_\_\_\_(email \_\_\_\_\_\_) an employee of the Recipient.
	7. **“Original Material”** shall meanthe material provided by NYSCF/Columbia to the Recipient as described in Attachment A.
	8. **“Research Project”** shall mean the statement of work described in Attachment B.
2. **Ownership.**
	1. **Material.** NYSCF/Columbia retains ownership of Material, including any Material contained or incorporated in Modifications.
	2. **Modifications.** The Recipient retains ownership of (i) Modifications (except that NYSCF/Columbia retains ownership of Material contained or incorporated therein); and (ii) those substances created through the use of Material or Modifications, but which are not Progeny, Unmodified Derivatives, or Modifications (i.e., do not contain the Original Material, Progeny, Unmodified Derivatives); provided, however, that if any Modification or substance (as defined in (ii)) results from the collaborative efforts of NYSCF/Columbia and Recipient, the Parties shall jointly own such Modification or substance. The rights and obligations of the Parties relating to the joint ownership of any such Modification or substance shall be negotiated in good faith and agreed in writing between the Parties.
3. **Use and Transfer of Material and Modifications.**

Recipient agrees:

* 1. to use Material solely for the Research Project and to use Modifications solely for internal teaching and non-profit research purposes;
	2. to use Material and Modifications in accordance with any applicable Institutional Review Board (IRB) approval or patient consent forms provided by NYSCF/Columbia hereunder, and to obtain IRB approval, if and as appropriate for Recipient’s use of Material and Modifications.
	3. not to useMaterial or Modifications for Commercial Purposes, including selling or transferring Material or Modifications to a for-profit organization or using Material or Modifications in screening on behalf of or at the request of a for-profit organization;
	4. not to use Material or Modifications in human subjects, in clinical trials, or for diagnostic purposes involving human subjects;
	5. that Material will be used at Recipient’s facilities under the direction of the Recipient Scientist;
	6. that Material will not be used or accessed by any person within the Recipient organization, other than the Recipient Scientist and persons working under the Recipient Scientist’s direct supervision, without the prior written consent of NYSCF/Columbia;
	7. not to transfer Material to any third party, except to the extent that Material is incorporated in any Modification and the transfer of such Modification is in compliance with Section 4.(b) below; and
	8. to disclose to NYSCF/Columbia in writing a description of any Modification created by the Recipient promptly after creation of such Modification.
1. **Third Party Requests for Material and Modifications.**
	1. **Material.** Recipient agrees to refer to NYSCF/Columbia any request for Material from anyone other than those persons working under the Recipient Scientist’s direct supervision. To the extent supplies are available, NYSCF/Columbia agrees to make Material available to any scientist employed by a non-profit, academic or government organization who wishes to replicate the Recipient Scientist’s research; provided that Material is transferred to such requesting scientist pursuant to a separate written agreement between NYSCF/Columbia and the non-profit, academic or government organization that employs the requesting scientist.
	2. **Modifications.** Recipient may transfer Modifications to a third party non-profit, academic or government organization for internal teaching and non-profit research purposes only, provided that any such transfer shall be made under a separate written agreement among Recipient, NYSCF/Columbia and the third party, which shall contain terms and conditions at least as protective of NYSCF/Columbia’s rights in Material, and at least as restrictive on suchthird party’s use and transfer of Modifications, as the terms and conditions of this Agreement.
	3. **Commercialization.** Recipient shall not provide Material or Modifications to any third party (including, without limitation, any non-profit, academic or government organization) for Commercial Purposes without the prior written consent of NYSCF/Columbia. The Recipient acknowledges and agrees that use or transfer of Modifications for Commercial Purposes will require a commercial license from NYSCF/Columbia under its ownership interest and intellectual property rights in the Material incorporated in such Modifications, and NYSCF/Columbia has no obligation to grant any such commercial license, nor is any such license granted or implied in this Agreement. Recipient has the right to grant commercial licenses under Recipient’s intellectual property rights in such Modifications (or methods of manufacture or use of such Modifications), provided, however, that Recipient (i) notifies NYSCF/Columbia of Recipient’s intent to license its intellectual property rights and the identity of the proposed licensee, and (ii) seeks approval of such license from NYSCF/Columbia, such approval not to be unreasonably withheld. Any such commercial license shall include an express acknowledgment by the licensee that the intellectual property rights licensed to such licensee exclude any license or other right under NYSCF/Columbia’s or any third party’s intellectual property rights in Material incorporated in Modifications, or methods of manufacture or use of such Material.
2. **Commercial Use.** If Recipient desires to use Material for Commercial Purposes, Recipient may request a commercial license from NYSCF/Columbia, which commercial license would only be granted pursuant to a separate written commercial license agreement between NYSCF/Columbia and Recipient. Recipient acknowledges that NYSCF/Columbia shall have no obligation to grant any such commercial license to, or enter into any commercial license agreement with, Recipient.
3. **No Implied License.** Recipient acknowledges that Material is or may be the subject of a patent application or issued patent or other proprietary right of NYSCF/Columbia. Except for the rights expressly granted by NYSCF/Columbia 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 NYSCF/Columbia, including, without limitation, any altered forms of Material made by NYSCF/Columbia. No express or implied licenses or other rights are provided to use Material, Modifications, or any related rights of NYSCF/Columbia for Commercial Purposes.
4. **NYSCF/Columbia’s Retained Rights.** NYSCF/Columbia shall have the right to use Modificationsand substances created through Recipient’s use of Material or Modifications, for internal research and teaching purposes. The Parties agree to enter a separate material transfer agreement to cover NYSCF/Columbia’s use of Modifications and substances created through Recipient’s use of Material or Modifications. Recipient and the Recipient Scientist acknowledge that NYSCF/Columbia shall at all times be free to transfer Material to third parties for any purpose, to grant exclusive or non-exclusive commercial licenses to third parties, or to sell, assign or otherwise dispose of any or all of NYSCF/Columbia’s rights in Material to any third party(ies), subject to the rights expressly granted to Recipient under this Agreement.
5. **Patent Filing.** Recipient is free to file patent application(s) claiming inventions made by Recipient through the use of Material but agrees to notify NYSCF/Columbia in advance of filing any patent applications claiming Modifications or methods of manufacture or uses of Material. If advance notice of such filings is not possible or practical, then Recipient shall notify NYSCF/Columbia promptly upon filing any such patent application. Upon NYSCF/Columbia’s written request made within ninety (90) days after receipt of notice of filing of any such patent application, Recipient agrees to grant to NYSCF/Columbia a non-exclusive, royalty-free, fully-paid license under such patent application and associated patent rights for research use only.
6. **Confidentiality.** All information that is transferred between NYSCF/Columbia and Recipient under this Agreement is subject to the following:

The Parties will use reasonable endeavors to ensure that all information deemed confidential under this Agreement is clearly designated by the providing Party as ‘confidential,’ ‘proprietary’ or other similar designation, or if communicated orally, is confirmed in writing by the providing Party as being confidential within sixty (60) days after initial oral disclosure. A Party receiving confidential information under this Agreement agrees to maintain the confidential information in confidence under at least a reasonable standard of care for a period of five (5) years from the termination of this Agreement.

 For the purposes of this Agreement, confidential information will not include any information that:

* + 1. has been published or otherwise publicly available at the time of disclosure to the receiving Party; was in the possession of or was readily available to the receiving Party without being subject to a confidentiality obligation from another source prior to the disclosure;
		2. has become publicly known, by publication or otherwise, not due to any unauthorized act of the receiving Party;
		3. the receiving Party can demonstrate it developed independently, or acquired without reference to, or reliance upon, such confidential information; or
		4. is required to be disclosed by law, regulation, or court order.
1. **Disclaimer.** The Recipient acknowledges that Material is experimental in nature and may have hazardous or other unpredictable and unknown properties, that it is to be used with caution, and that it is not to be used for testing in or treatment of humans. NYSCF/COLUMBIA MAKES NO REPRESENTATIONS AND EXTENDS NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED. THERE ARE NO EXPRESS OR IMPLIED WARRANTIES OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE, OR THAT THE USE OF MATERIAL WILL NOT INFRINGE ANY PATENT, COPYRIGHT, TRADEMARK, OR OTHER PROPRIETARY RIGHTS OF ANY THIRD PARTY.
2. **Limitation of Liability.** Except to the extent prohibited by law, Recipient assumes all liability for damages which may arise from Recipient’s use, storage or disposal of Material, Modifications, and any other substance created through the use of Material or Modifications. NYSCF/Columbia will not be liable to Recipient for any loss, claim or demand made by Recipient, or made against Recipient by any third party, due to or arising from Recipient’s use of Material, Modifications, or any other substance created through the use of Material or Modifications, except to the extent permitted by law when caused by the gross negligence or willful misconduct of NYSCF/Columbia. No indemnification for any loss, claim, damage, or liability is intended or provided by either Party under this Agreement.
3. **Publication.** This Agreement shall not be interpreted to prevent or delay publication of research findings resulting from Recipient’s use of Material or Modifications. Recipient shall provide a copy of any such manuscript, abstract, poster, presentation or other form of publication to NYSCF/Columbia at least sixty (60) days prior to publication in order to allow NYSCF/Columbia an opportunity to request removal of confidential information or to protect proprietary information or intellectual property that might be disclosed by the publication. Recipient agrees to provide appropriate acknowledgment of NYSCF and Columbia University as the source of Material in all such publications, unless otherwise requested by NYSCF/Columbia.
4. **Compliance.** Recipient agrees to use and handle Material and Modifications in compliance with all applicable statutes and regulations, including, without limitation, Public Health service and National Institutes of Health regulations and guidelines, and any Institutional Review Board (IRB) approvals or patient consent forms provided by NYSCF/Columbia hereunder or otherwise required for Recipient’s use of Material or Modifications.
5. **Termination.** This Agreement will become effective on the Effective Date and will remain in effect for as long as Recipient has possession of Material or Modifications, or until terminated by either Party upon sixty (60) days written notice to the other Party, whichever is the earlier. Upon termination of this Agreement for any reason, any unused Material will either be destroyed in compliance with all applicable statutes and regulations or will be returned to NYSCF/Columbia, as requested by NYSCF/Columbia, and, at the Recipient’s election, Recipient will either destroy Modifications or remain bound by the terms of this Agreement as they apply to Modifications.

Termination of this Agreement will not relieve either Party of any obligation accruing prior to termination. The following Sections of this Agreement shall survive any termination of this Agreement: 6, 7, 8, 9, 10, 11, 12, 14 and 15; and, additionally, Sections 2, 3, 4 and 13 as applied to any Modifications retained by Recipient after termination.

1. **Use of Name.** Except to the extent provided in Section 12 (Publication), Recipient shall not use NYSCF’s or Columbia’s name, logo, symbol, trademarks or service marks, or any abbreviation or variant thereof, in any publication, press release, or any advertisement or similar material used to promote or sell products or services, without the prior written consent of NYSCF/Columbia.
2. **Notices.** All notices required hereunder shall be given in writing and sent by mail postage prepaid, certified or registered mail, return receipt requested, or sent by a nationally recognized express courier service, or hand-delivered or sent via electronic transfer to the following recipients:

If to NYSCF:

 Director, Scientific Programs

 New York Stem Cell Foundation, Inc.

 1995 Broadway, Suite 600

 New York, New York 10023

 If to Columbia University:

 TechVentures@columbia.edu

 The Trustees of Columbia University In the City Of New York

 Columbia Technology Ventures

 80 Claremont Avenue, Suite 4F,

 Mail Code 9606

 New York, NY 10027-5712

If to Recipient: [insert name/address of Recipient’s recipient for notices]

 \_\_\_\_\_\_\_\_\_\_\_\_\_

\_\_\_\_\_\_\_\_\_\_\_\_

\_\_\_\_\_\_\_\_\_\_

Notices shall be effective upon receipt. A Party may change its recipient for notices listed above by written notice to the other Party.

1. **Governing Law.** This Agreement shall be construed in accordance with the laws of the State of New York, without regard to conflicts of laws provisions available in such jurisdiction.
2. **Independent Contractors.** The Parties shall perform their obligations under this Agreement as independent contractors and nothing contained in this Agreement shall be construed to be inconsistent with such relationship or status.
3. **Entire Agreement and Severability.** This Agreement (including the attachments hereto) contains the final, complete and exclusive agreement of the Parties relative to the subject matter hereof and supersedes all prior and contemporaneous understandings and agreements relating to said subject matter. This Agreement may not be amended or supplemented except by a written instrument signed by both Parties. No waiver of any provision of this Agreement or of any of a Party’s rights hereunder shall be effective unless in writing and signed by the waiving Party. If any provision of this Agreement shall be declared invalid, illegal or unenforceable, such provision shall be severed and all remaining provisions shall continue in full force and effect.
4. **Assignment.** The Recipient shall not have the right to assign this Agreement without NYSCF/Columbia’s prior written consent.
5. **Counterparts.** This Agreement may be executed in any number of counterparts, each of which, when executed, shall be deemed to be an original and all of which together shall constitute one and the same instrument.

**IN WITNESS WHEREOF**, the Parties have, by duly authorized persons, executed this Agreement, as of the Effective Date.

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| --- | --- |
| **New York Stem Cell Foundation, Inc.** | **RECIPIENT** |
| By: Name: Title: | By: Name: Title:  |

**The Trustees of Columbia University**

By:

Name:

Title: (TT#\_\_\_\_\_\_\_\_\_)

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

**Certification of Recipient Scientist:** I have read and understood the terms and conditions of this Agreement as they apply to my receipt and handling of Materials.

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Signature of Recipient Scientist Date

Dr \_\_\_\_\_\_ \_\_\_\_\_\_\_(email: \_\_\_\_\_\_\_\_\_\_\_\_\_\_)

ATTACHMENT A

**Original Materials**

[Insert a description of the Original Materials transferred by NYSCF/Columbia to Recipient, including any accompanying information as appropriate]

Material:

ATTACHMENT B

**Research Project**

[Insert brief description of the Research Project]