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Office of Technology Licensing
and Industry Relations


UNIVERSITY OF PUERTO AT MAYAGÜEZ
RESEARCH & DEVELOPMENT CENTER
Intellectual Property & Technology Transfer Office

MATERIAL TRANSFER AGREEMENT

THIS AGREEMENT is made and effective this 20th day of March, 2013 (the "Effective Date") between the University of Puerto Rico at Mayagüez, with offices at 259 Blvd. Alfonso Valdés, Mayagüez, Puerto Rico 00682, represented by its -Chancellor, Dr. Jorge Rivera Santos, (hereinafter "UPRM") and The Research Foundation for State University of New York, a nonprofit, educational corporation existing under the laws of the State of New York with an office located at the Office of Technology Licensing & Industry Relations, N5002 Melville Library, Stony Brook, New York 11794-3369 represented by its Assistance Director Sean Boykevisch (hereinafter "RECIPIENT").


RECIPIENT is interested in obtaining certain research material(s) which is (are) property of the University of Puerto Rico (UPR). The research material described below shall be provided to the RECIPIENT for scientific research purposes only, upon completion and receipt of this Agreement.

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1. **RESEARCH MATERIAL(S).** The following research material(s) have been developed by Dr. Elsie I. Parés-Matos at UPRM. The material is described as:



(1) Approximately 110 frozen/formalin fixed tumor and normal samples of human colon and gastric tissues and (2) the collected data based on participants responses about a food frequency questionnaire submitted to them as part of the study.

The above described original research material includes any fragments, subunits, progeny, products, genetic material, subsets, derivatives, or modification thereof, and unmodified derivatives ("Biological Materials"), as well as any related confidential information provided by UPRM, shall hereinafter be referred to as the "MATERIAL".


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2. **DESCRIPTION OF PLANNED RESEARCH.** RECIPIENT shall use MATERIALS provided under this Agreement for non-commercial research purposes only, which is (are):


(1) isolate the miRNA and determine the level of gene expression and/or activation in these primary human colon and gastric adenomas; (2) estimate nutrient doses that may effect the dietary nutrients in an *in vivo* animal model of colon cancer using cells derived from different Hispanic and non-Hispanic groups from Puerto Rico and the United States. The tissue will be used to evaluate differences in epigenetic and genetic profiles between racial/ethnic groups.

and which shall hereinafter be referred to as the "RESEARCH".


3. **PURPOSE OF TRANSFER AND RESTRICTIONS.** UPRM will permit the use of the

MATERIAL solely for the purposes of the RESEARCH at the RECIPIENT's institutional facilities, and only under the direction and supervision of the RECIPIENT's principal investigator, **Dr. Jennie L. Williams**. However, before providing the MATERIAL to RECIPIENT's principal investigator, UPRM requires agreement by RECIPIENT that:

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- 3.1 RECIPIENT will use the MATERIAL with caution and prudence in any experimental work.
 - 3.2 RECIPIENT will not use the MATERIAL on any human subjects.
 - 3.3 RECIPIENT will not use the MATERIAL for commercial purposes, or in research or consulting for a for-profit entity under which that entity obtains rights to research results, without the prior written consent of UPRM.
 - 3.4 RECIPIENT agrees not to transfer the MATERIAL to anyone who is not employed at RECIPIENT's facilities without the prior written consent of UPRM.
 - 3.5 RECIPIENT agrees to the limitations on use of the MATERIAL. No other right or license to the MATERIAL is granted or implied as a result of the transfer of the MATERIAL to RECIPIENT.
 - 3.6 If RECIPIENT's use of the MATERIAL results in an invention, RECIPIENT shall disclose such invention to UPR and agrees not to commercialize, sell, license, or otherwise transfer property rights in the invention without the prior written consent of UPR.
 - 3.7 RECIPIENT will not attempt to reverse engineer, deconstruct or in any way determine the structure or composition of the MATERIAL.



4. **CONFIDENTIAL INFORMATION.** For the purposes of this Agreement, "CONFIDENTIAL INFORMATION" shall refer to all information related to the MATERIAL. CONFIDENTIAL INFORMATION may also include "TRADE SECRETS" which is identified as CONFIDENTIAL INFORMATION that is commercially valuable and secret in that it is not generally known in the industry in the areas in which it is utilized.


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- 4.1 RECIPIENT agrees to hold CONFIDENTIAL INFORMATION in confidence and utilize all reasonable efforts to avoid unauthorized use, disclosure, publication, or dissemination of CONFIDENTIAL INFORMATION for a period of five (5) years from the effective date of this Agreement except in the case of any CONFIDENTIAL INFORMATION identified by UPR as TRADE SECRETS.
 - 4.2 The term of confidentiality with respect to TRADE SECRETS received by RECIPIENT shall be perpetual.
 - 4.3 RECIPIENT shall protect CONFIDENTIAL INFORMATION with the same degree of care as it applies to protect its own confidential information. RECIPIENT shall have no obligation of confidentiality with respect to CONFIDENTIAL INFORMATION, which: (a) at the time of its receipt is generally available in the public domain, or thereafter becomes available to the public through no act or omission of the RECIPIENT; (b) was independently known or developed by RECIPIENT prior to receipt thereof from PROVIDER, as shown by prior, legally competent, written records of RECIPIENT; (c) is made available to RECIPIENT as a matter of lawful right by a third party without breach of any nondisclosure obligation and without restriction on disclosure; (d) is required to be disclosed by law, court order, or regulation; or (e) is authorized for disclosure in writing by UPRM.

5. **INDEMNITY.** RECIPIENT will bear all risk to RECIPIENT Principal Investigator and assumes all liability for damages that may arise from RECIPIENT's use, storage or disposal of the MATERIAL. UPRM will not be liable to RECIPIENT for any loss, claim or demand


made by RECIPIENT, or made against RECIPIENT by any other party, due to or arising from the use of the MATERIAL by RECIPIENT..

6. **REPORTS.** At least once per year, no later than the anniversary date of this Agreement, RECIPIENT shall provide to UPRM a summary report of research results obtained through use of the MATERIAL. Further, within three (3) months of the conclusion of the RESEARCH, RECIPIENT shall provide to UPR, or the parties may collaboratively prepare, a final report that describes the research results obtained through the use of the MATERIAL, and further indicates the disposition of the MATERIAL.


7. **REPRESENTATIONS AND WARRANTIES.** MATERIAL HEREUNDER PROVIDED IS EXPERIMENTAL IN NATURE. THEREFORE, IT IS PROVIDED WITHOUT ANY WARRANTIES, EITHER EXPRESS OR IMPLIED, INCLUDING, WITHOUT LIMITATION, WARRANTIES OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR USE OR PURPOSE. UPRM MAKES NO REPRESENTATION AND PROVIDES NO WARRANTIES OF ANY KIND, AND MOREOVER DOES WARRANTS THAT THE USE OF THE MATERIAL WILL NOT INFRINGE ANY PATENT, COPYRIGHT, TRADEMARK, OR OTHER PROPIETARY RIGHT.



8. **PUBLICATIONS.** Any manuscripts or publications prepared by RECIPIENT relating to the MATERIAL shall be provided to UPRM prior to submission for publication for review and comment.. RECIPIENT agrees to provide appropriate acknowledgment of the source of the MATERIAL in all publications and the UPRM s Researcher will be given credit in such publications, as scientifically appropriate.



9. **COMPLIANCE.** RECIPIENT expressly agrees that its use of the MATERIAL shall be in compliance with all applicable local, state, and federal procedures, rules, regulations, and laws.



This Agreement shall be subject to all applicable government export and import laws and regulations. The parties agree to comply and reasonably assist the other party, upon request by that party, in complying with all applicable government export and import laws and regulations. The parties acknowledge that they may not directly or indirectly export, re-export, distribute or transfer any technology, information or materials of any value to any nation, individual or entity that is prohibited or restricted by the International Traffic in Arms Regulation (ITAR), the Export Administration Regulations (EAR), the Office of Foreign Assets Controls (OFAC), the United States Department of State's State Sponsors of Terrorism, or by any other United States government agency without first obtaining the appropriate license.

UPRM hereby confirms that the CONFIDENTIAL INFORMATION and MATERIAL it discloses does not contain export controlled technology or technical data identified on any US export control list, including but not limited to the Commerce Control List (CCL) at 15 CFR 774 and the US Munitions List (USML) at 22 CFR 121. In the event UPRM intends to provide RECIPIENT with export controlled information, or material UPRM will inform Recipient's Export Controls Administration in writing thirty (30) days prior to the release of export controlled technology or technical data. URPM hereby agrees not to provide any export controlled information to RECIPIENT without the written agreement of RECIPIENT'S Export Controls Administrator.

10. **ASSIGNMENT.** This Agreement may not be assigned or otherwise transferred by RECIPIENT without the prior written consent of UPRM.


11. **TERM.** The term of this Agreement shall be one (1) year from the Effective Date. Upon the

one-year anniversary of the Effective Date, this Agreement shall automatically terminate (the "Termination Date") in accordance with Paragraph 12 below, unless extended by the mutual, written agreement of the parties.


12. **TERMINATION.** Either party may terminate this Agreement prior to the Termination Date, or any extensions thereof, with or without cause upon thirty (30) days written notice. All of the MATERIAL must be either returned to UPR at the address set forth in Paragraph 13 below or destroyed before the date of termination. At its sole, written discretion UPR may permit RECIPIENT to retain possession of some or all of the MATERIAL. All obligations of the parties hereunder shall cease upon termination of this Agreement, except that the provisions set forth in Paragraphs 3, 4, 5, 6, 7, and 8 shall survive.
13. **NOTICES.** Notice with respect to this Agreement shall be sent via U.S. Postal Service certified return receipt or registered mail or via reputable commercial courier (Federal Express, UPS, DHL, etc.) and shall be deemed duly given and made on the earlier of the date of actual receipt or five (5) days after being mailed postage prepaid, and shall be addressed as follows, provided that either party may by written notice designate a substitute address from time to time:



TO UPRM:



Department/Division:
Intellectual Property & Tech. Transfer Office



Address:
University of Puerto Rico - Mayagüez
R & D Center
Call Box 9000
Mayagüez, PR 00681-9000

Attn: Elvia M. Camayd, LL.M. in IP
Phone: 787.832.4040 x. 5256, 5880
Fax: 787.831.2060
Email: elvia.camayd@upr.edu

TO RECIPIENT:

Department/Division:

Address:
Office of Technology Licensing and Industry
Relations
N5002 Melville Library
Stony Brook, NY 11794-3369

Attn: Adam M. DeRosa, Ph.D.
Phone: 631-632-6955
Fax: 631-632-1505
Email: Adam.DeRosa@stonybrook.edu

With Copy to:
Email: jennie.williams@sbumed.org; elsie.pares@upr.edu

14. **MODIFICATION.** This Agreement is the entire agreement between the parties. No change, modification, alteration, waiver, amendment, or addition shall be valid unless in writing and signed by each of the parties hereto.
15. **FACSIMILE COPIES.** Any facsimile transmission of this Agreement that is signed by a duly authorized representative of each party is legally binding and enforceable; however, the parties agree to make every reasonable effort to execute and exchange duplicate originals.
16. By signing this agreement, the parties agree to the above conditions and clearly understand that no other right or license to the MATERIAL is granted or implied as a result of the transfer of the MATERIAL. Recipients should sign both originals of this and return them to UPRM. When the agreement has been fully executed by both parties, one signed original will be returned and UPRM will arrange with the UPRM Researcher to have the Materials

transferred.

IN WITNESS WHEREOF, the parties have caused this Agreement to be executed by their duly authorized representatives.

AUTHORIZED REPRESENTATIVE
(Recipient Institution)

The Research Foundation for SUNY

Read and Under Stood by: **RECIPIENT**
PRINCIPAL INVESTIGATOR

Sean Boykevisch, Ph.D., Assistant Director

Print Name



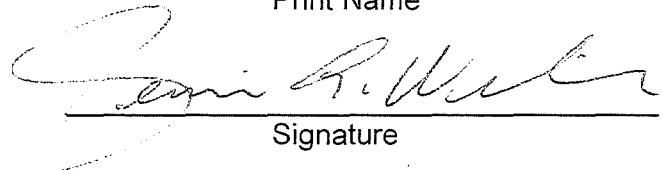
Signature

5/1/13

Date

Jennie L. Williams, Ph.D.

Print Name



Signature

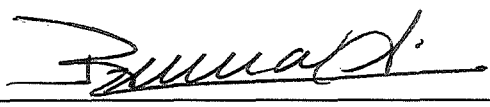
6/25/2013

Date

AUTHORIZED REPRESENTATIVE
(University of Puerto Rico at Mayagüez)

Jorge Rivera-Santos, Ph.D

Print Name



Signature

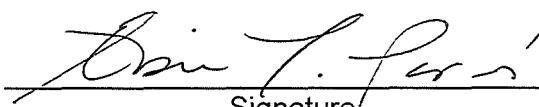
April 25, 2013 

Date

UPRM RESEARCHER

Elsie I. Parés-Matos, Ph.D.

Print Name

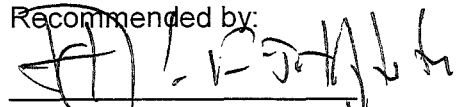


Signature

20/03/2013

Date

Recommended by:



Walter Silva Araya
Director
R&D Center
UPRM