Boston University
Office of Sponsored Programs

Standard Operating Procedures: Incoming Material Transfer Agreements

I. Background and Purpose

Investigators at Boston University rely on the provision of materials owned by third parties ("Provider") in order to conduct their research. Many Providers of such research materials require that a prospective recipient ("Recipient") execute a Material Transfer Agreement ("MTA") prior to delivery. The purpose of the MTA is to set forth the parameters of Recipient’s use of the materials, and provide for certain rights and obligations on the part of both Provider and Recipient. The goal of the Contracts & Agreements group ("C&A") is to further research conducted by investigators on both campuses of Boston University ("Investigators") by facilitating the procurement of materials from third parties that require an MTA. The key elements of this process are (a) negotiating the terms of the MTA such that they comply with the preferred positions of Boston University and provide the Investigator with sufficient freedom to perform the proposed research, and (b) completing finalization of agreement terms and execution of the document in a timely fashion so that the Investigator may receive the materials as quickly as possible.

Outgoing MTAs are handled by the Office of Technology Development, and more information regarding the process can be found here: http://www.bu.edu/otd/forms/

II. Types of Agreements

- **Addgene**: Addgene is a non-profit plasmid repository that allows investigators to order plasmids online. Electronic request for such materials come to a designated representative of Boston University (currently, Jessica Rivieccio) via email. Addgene requests are reviewed internally and submitted to the Vice President, Sponsored Programs for final approval if no issues are identified. All Addgene MTAs are in the form of the UBMTA (Uniform Biological Material Transfer Agreement), which may at times include “Additional Terms.” Addgene MTAs are either approved or disapproved, and are not subject to negotiation. http://addgene.com/

- **NIH Simple Letter Agreement**: This form is used by most of the NIH branches, and requires no negotiation prior to execution. Certain non-profit entities also prefer this form. http://www.ott.nih.gov/pdfs/slaform.pdf

- **All Other MTAs**: MTAs may come to Boston University from a variety of Providers, including for-profit companies and academic and other non-profit institutions, both foreign and domestic. Typically, C&A is alerted to the necessity of the MTA by the Investigator, at which point the team gathers certain required information from such
Investigator, reviews the MTA and initiates negotiation if the original terms are not acceptable.

III. Required Documents

C&A requires a completed Material Transfer Information Sheet (http://www.bu.edu/osp/forms-and-templates/) and the Material Transfer Agreement in an editable format. The purpose of the Information Sheet is to elicit certain factual information regarding the transfer (recipient and provider contact information, name/description of material) as well as relevant information regarding the recipient scientist’s planned uses of the material, for instance whether or not they plan on making modifications of the material, and whether the material will be used in conjunction with materials obtained from other third parties. If the investigator indicates that the material is rDNA or biohazardous, they are prompted to apply for IBC approval, and C&A will ensure that such approval is in place prior to execution of the agreement (http://www.bu.edu/osp/osp-handbook/chapter-3/select-agents/). Once C&A has both an Information Sheet and an editable copy of the MTA, a member of the team will review the agreement, make any necessary or desired changes using the “Tracked Changes” function in Word, and provide the revised document directly to the appropriate individual in Provider’s tech transfer office. In certain circumstances, the C&A member will confer with the Investigator before providing comments in order to ask questions or request additional information.

IV. Negotiation of Terms

There are several key elements to a Material Transfer Agreement. The categories of provisions set forth below constitute those components of an MTA that most often require negotiation by the C&A team. Negotiation time, depending upon Provider and their location, can vary. For-profit Providers frequently utilize more complex, burdensome templates that may necessitate multiple rounds of negotiation; academic and non-profit entities often agree to use the UBMTA, which requires no negotiation, or a simpler form of MTA that is easier to finalize. The following comprises an overview of the most critical MTA terms, as well as Boston University’s preferred position for each, but is not intended to be a comprehensive listing of all terms that may be negotiated and should be used for guidance purposes only:

- **Inventions**: Boston University must own all inventions made through use of the material in the conduct of the research. For purposes of the MTA, “Inventions” should be defined as either “patentable,” “conceived and reduced to practice” or “made,” because Boston University’s intellectual property policy covers patentable discoveries only. Inventorship of Inventions should be determined in accordance with U.S. patent law, and ownership should follow inventorship. BU’s standard practice is to agree to grant Provider a non-exclusive, royalty-free license to any Inventions, solely for internal
research and teaching purposes. If requested, we will also agree to give Provider an option to negotiate an exclusive, royalty-bearing license. This is more typical in an MTA where the Provider is a for-profit company. In certain limited circumstances, Boston University may also agree to provide a “non-blocking” license to any Inventions in order to allow Provider to continue to practice their own pre-existing intellectual property.

- **Publication**: The ability to publish the results of his or her research is of paramount importance to the Investigator. The MTA must retain this right on his/her behalf. Providers often request that Recipient agree to remove any Confidential Information of Provider from a proposed publication, but Boston University will push back strongly on this request, and try to carve out "any Confidential Information that is required to make for a meaningful scientific publication." Another alternative is to consult with the Investigator to determine what particular information they anticipate needing to include in the publication, and specifying in the MTA that Provider may not request removal of such information.

- **Modifications**: As an NIH-funded institution whose mission is, in part, to foster research and scientific advancement, it is critical that Investigators retain the right to transfer modifications of the material they receive to other academic and non-profit institutions for research and teaching purposes. This may be done under an agreement “at least as protective of Provider’s rights” as the original MTA, or may, if Provider insists, be done only with Provider’s prior consent, “which shall not be unreasonably withheld.” If Provider does not wish to allow Investigator to transfer modifications, it must be conclusively determined that either (a) Investigator will not be making modifications or (b) there is an overriding reason to accept this atypical restriction.

- **Indemnification**: Boston University will agree to indemnify Provider of losses/claims resulting directly from its use, storage and handling of the material, except to the extent such loss/claim is caused by the gross negligence or reckless or willful misconduct of Provider. BU will not indemnify for losses/claims resulting “in connection with this Agreement” (overly vague), or for breaches of the Agreement.

- **Results**: If Investigator is providing the results of his or her research to Provider, such results should be held in strict confidence by Provider until the earlier of (a) one year following conclusion of the research and (b) such time as Investigator has published those results. Furthermore, for-profit Providers should indemnify Boston University for any use of those Results due to the fact that they may be used by Provider in connection with commercial activities, including provision of goods and services to the public.

- **Confidential Information**: If the MTA contains terms relating to confidentiality, the first step is to confirm with the Investigator that they expect to receive confidential information. Often, this is simply part of Provider’s template and is not relevant to the transfer at hand. If necessary, Boston University will agree to include such a provision,
but it must be time-limited (three years preferred; seven years maximum), must include a “reasonable efforts” standard of care, and must include certain standard carve-outs to the obligation of confidentiality. Employees and agents of Boston University may be “informed of” the obligations set forth in the agreement, but will not agree to them individually. Boston University may agree to be responsible for compliance by such individuals with the terms of the confidentiality section, and any breach thereof. It is strongly preferred that confidential information be clearly marked as such or, if disclosed orally, followed up by a written summary thereof within 30 days. The materials themselves must never be included in the definition of Confidential Information, because to do so would contradict our right to publish.

- **Use of Name**: Provider and Recipient should each agree not to use the name, logo, trademark or other identifying characteristics of the other party for fundraising or advertising or other publicity purposes.

In every MTA, certain practices and formalities should be adhered to:

- **Follow-up**: If Provider has not responded within one (1) week of receiving BU’s requested revisions to an MTA, a follow-up email should be sent to Provider and Investigator should be alerted to the delay.

- **Signatories**: The MTA should be signed on behalf of Trustees of Boston University, and not the Investigator as an individual. It is strongly preferred that Investigators sign only as “Read and Acknowledged.”

- **Choice of Law/Jurisdiction**: Massachusetts is preferred. Delaware or New York is acceptable. Choice of venue is more important than choice of law, and if the parties cannot agree, the MTA may remain silent or provide that the choice of law and venue will be the jurisdiction of choice (specified) of the party against whom a claim is brought.

- **Signatures**: Boston University does not require original signatures, but foreign entities and some for-profit companies do, in which case BU will comply with this request.

### V. Signature Process; Filing

Once an MTA is finalized and ready for signature, it is presented first to the Investigator, if his or her signature is required, and then to Michael Collins, Assistant Vice President, Sponsored Programs. When all required signatures have been obtained, a pdf or original copy(ies) (as specified by Provider) are sent to Provider, along with a request to return a fully executed copy of the MTA to the appropriate C&A member and arrange for transfer of the materials to the Investigator at Provider’s earliest convenience. After receipt of a fully executed agreement, it is scanned and added to the appropriate database and a copy is
emailed to the Investigator and any other appropriate persons in his or her lab. This email is generated by the C&A member who negotiated the agreement, and calls attention to certain material provisions of the MTA with which the Investigator must comply. A copy of this email, along with the fully executed MTA, should be placed in the file, and the folder with all relevant documentation will be filed in the designated MTA filing cabinet.