

DuraMat Energy Materials Network (EMN) Master Material Transfer Agreement (MMTA)

Among

Alliance for Sustainable Energy, LLC, manager and operator of National Renewable Energy Laboratory (“NREL”) under the authority of its Contract No. DE-AC36-08GO28308 with the Department of Energy (DOE) and having an office for business at 15013 Denver West Parkway, Golden, CO 80401;

The Regents of the University of California, as the contract-operator for the U.S. DOE, under Prime Contract No. DE-AC02-05CH11231, of the Ernest Orlando Lawrence Berkeley National Laboratory (“LBNL”), having an office for business at One Cyclotron Road, Berkeley, California 94720;

Sandia Corporation, a Delaware Corporation, manager and operator of Sandia National Laboratories (“Sandia”) under Contractor No. DE-AC-04-94AL85000 with DOE and having an office for business at 1515 Eubank SE, Albuquerque, NM 87123;

The Board of Trustees of the Leland Stanford Jr. University, operator of the SLAC National Accelerator Laboratory (“SLAC”) under Contract Number DE-AC02-76SF00515 and having an office for business at 2575 Sand Hill Road, Menlo Park, CA 94025-7015;

NREL, LBNL, Sandia, and SLAC are jointly referred to as “Federal Laboratory Members.” Federal Laboratory Members and all parties who are added to this MMTA in accordance with Article 18 are hereinafter jointly referred to as the “Parties” or separately as “Party”;

With the exception of LBNL, Federal Laboratory Members may elect to use, at their sole discretion, the “Official Use Only” designation for sharing of their own confidential information to the extent that such information meets the requirements of DOE O 471.3, Admin. Change 1, and DOE M 471.3-1, Admin. Change 1, relating to the identification and protection of Official Use Only information, and the Federal Laboratory Members, with the exception of LBNL, agree to protect such information in accordance with this Agreement to the extent not inconsistent with the aforementioned DOE documents. Any confidential information to be shared with LBNL may be accomplished through use of the Multi-Party Non-Disclosure Agreement for the DuraMat Consortium.

The Parties anticipate the need to exchange MATERIAL (defined below) samples in connection with their work under the DuraMat Energy Material Network (“DuraMat” or “DuraMat EMN”);

Therefore, the Parties agree to be bound by the terms of this Master Material Transfer Agreement (“MMTA”) with an Effective Date for each Party as of the date such Party signs this MMTA and will continue for the term of DuraMat EMN funding.

I. Definitions:

1. LEAD INSTITUTION: National Renewable Energy Laboratory (NREL).
2. PROVIDER: Party providing the MATERIAL.
3. PROVIDER SCIENTIST: The scientist providing the MATERIAL on behalf of the corresponding PROVIDER.
4. RECIPIENT: Party receiving the MATERIAL.
5. RECIPIENT SCIENTIST: The scientist(s) receiving the MATERIAL on behalf of the corresponding RECIPIENT.
6. MATERIAL: Chemical or physical samples being transferred for purposes of carrying out work under the DuraMat EMN, as further defined in Appendix A, section 3. The MATERIAL shall not include other substances created by the RECIPIENT through the use of the MATERIAL that do not contain the MATERIAL.
7. MODIFICATIONS: Substances created by the RECIPIENT which contain/incorporate the MATERIAL.
8. COMMERCIAL PURPOSES: The sale, lease, license, or other transfer of the MATERIAL or MODIFICATIONS to a for-profit organization. COMMERCIAL PURPOSES shall also include uses of the MATERIAL or MODIFICATIONS by any organization, including RECIPIENT, to produce or manufacture products for general sale, or for the purpose of any sale, lease, license, or transfer of the MATERIAL or MODIFICATIONS to a for-profit organization. However, research sponsored by a for-profit organization that is a Party to this MMTA shall not be considered a use of the MATERIAL or MODIFICATIONS for COMMERCIAL PURPOSES unless any of the above conditions are met.
9. TRANSACTION: The exchange of MATERIALS or samples thereof between or among the Parties through the use of an Appendix A, Implementing Letter signed by representatives of the PROVIDER and the RECIPIENT.

II. Terms and Conditions of this MMTA

1. The PROVIDER retains ownership of the MATERIAL, including any MATERIAL contained within, or incorporated into MODIFICATIONS, and including those cases in which MATERIAL is further transferred by RECIPIENT to another Party under 3(b) below, and the PROVIDER shall remain free, in its sole discretion, to distribute the MATERIAL to others and to use it for its own purposes.
2. The RECIPIENT retains ownership of: (a) MODIFICATIONS (except that, the PROVIDER retains ownership rights to the MATERIAL included therein), and (b) those substances created through the use of the MATERIAL or MODIFICATIONS.

3. The RECIPIENT agrees that the MATERIAL:
 - (a) is to be used solely for the benefit of the DuraMat EMN and its research;
 - (b) will not be further transferred, except to other Parties to this MMTA, who have signed the Implementing Letter for the transaction, in furtherance of the purposes of the DuraMat EMN. Such PROVIDER shall give written notification to the original PROVIDER and owner of the MATERIAL.
4. The RECIPIENT agrees to refer to the PROVIDER any request for the MATERIAL from anyone other than those persons working under the RECIPIENT SCIENTIST's direct supervision.
5. MODIFICATIONS.
 - (a) The RECIPIENT shall have the right, without restriction, to distribute substances created by the RECIPIENT through the use of the MATERIAL, only if those substances are not MODIFICATIONS.
 - (b) Without written consent from the PROVIDER, the RECIPIENT may not distribute to others MODIFICATIONS. Additionally, it is recognized by the RECIPIENT that using MODIFICATIONS for COMMERCIAL PURPOSES may require a commercial license from the PROVIDER, and the PROVIDER has no obligation to grant a commercial license to its ownership interest in the MATERIAL incorporated in the MODIFICATIONS. Nothing in this paragraph, however, shall prevent the RECIPIENT from granting commercial licenses under the RECIPIENT's intellectual property rights claiming such MODIFICATIONS, or methods of their manufacture or their use.
6. The RECIPIENT acknowledges that the MATERIAL is or may be the subject of a patent application. Except as provided in this MMTA, no express or implied licenses or other rights are provided to the RECIPIENT under any patents, patent applications, or other proprietary rights of the PROVIDER, including any altered forms of the MATERIAL made by the PROVIDER. In particular, no express or implied licenses or other rights are provided to use the MATERIAL, MODIFICATIONS, or any related patents of the PROVIDER for COMMERCIAL PURPOSES.
7. If the RECIPIENT desires to use or license the MATERIAL 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 license 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 and obligations to the Federal Government or other sponsors including those as set forth in the DuraMat Intellectual Property Management Plan.

8. The RECIPIENT is free to file patent application(s) claiming inventions made by the RECIPIENT through the use of the MATERIAL, but agrees to notify the PROVIDER upon filing a patent application claiming MODIFICATIONS or method(s) of manufacture or use(s) of the MATERIAL.

9. Any MATERIAL delivered pursuant to this MMTA is understood to be experimental in nature and may have hazardous properties. The PROVIDER MAKES NO REPRESENTATIONS AND EXTENDS NO WARRANTIES OF ANY KIND, EITHER EXPRESSED OR IMPLIED. THERE ARE NO EXPRESS OR IMPLIED WARRANTIES OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE, OR THAT THE USE OF THE MATERIAL WILL NOT INFRINGE ANY PATENT, COPYRIGHT, TRADEMARK, OR OTHER PROPRIETARY RIGHTS.

10. Except to the extent prohibited by law, RECIPIENT agrees to assume all liability for damages which may arise from its use, storage or disposal of the MATERIAL, except to the extent that such liability arises from the negligence or willful misconduct of PROVIDER.

11. This MMTA shall not be interpreted to prevent or delay publication of research findings resulting from the use of the MATERIAL or the MODIFICATIONS. The RECIPIENT agrees to provide appropriate acknowledgement of the source of the MATERIAL in all publications.

12. The RECIPIENT agrees to use the MATERIAL in compliance with all applicable statutes and regulations. RECIPIENT further agrees to use the MATERIAL under suitable and appropriate containment conditions. RECIPIENT shall be solely liable for its use of the MATERIAL, including the proper disposal of the MATERIAL.

13. Obligations of RECIPIENT under this MMTA will terminate on the earliest of the following dates: (a) on completion of the RECIPIENT's current research with the MATERIAL as it relates to DuraMat EMN, or (b) on thirty (30) days written notice by PROVIDER to RECIPIENT, or (c) on the end-date specified in an Implementing Letter, if used, provided that:

13.1. if termination should occur under 13(a), 13(b), or 13(c) 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 MMTA as they apply to MODIFICATIONS; or,

13.2. in the event the PROVIDER terminates this MMTA under 13(b) above, other than for breach of this MMTA, or for 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 written request from the RECIPIENT, to permit completion of research in progress. Upon the effective date of termination (or a deferred effective date of termination, as the case may be), 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 MMTA as they apply to MODIFICATIONS.

14. Section II, Paragraphs 5, 6, 7, 8, 9, 10, and 11 shall survive termination.
15. The MATERIAL may be provided at no cost, or with an optional transmittal fee, solely to reimburse the PROVIDER for its preparation and distribution costs which are not otherwise covered under the DuraMat funding to PROVIDER.
16. In view of its management by an institution of higher education, LBNL intends to conduct its activities as fundamental research under U.S. export regulations, and has many foreign persons who are students and employees. Accordingly, neither PROVIDER or RECIPIENT may knowingly transfer to any Party any MATERIAL that is export controlled under the International Traffic in Arms Regulations, and may not knowingly transfer to any Party MATERIAL that is export controlled under the Export Administration Regulations except information that is classified as EAR99.
17. Notices.

The addresses, telephone numbers and facsimile numbers for the Parties are as follows:

Alliance for Sustainable Energy, LLC	Telephone:
15013 Denver West Parkway	(303)275-3028
Golden, CO 80401	Facsimile:
Attn: Bill Hadley	(303) 275-3040

Lawrence Berkeley National Laboratory	Telephone:
Innovation & Partnerships Office	(510) 486-6467
One Cyclotron Road, MS-56A-120	Facsimile:
Berkeley, CA 94720	(510) 495-2950
Attention: Licensing Manager	
Email: LicensingManager@lbl.gov	

Sandia Corporation	Telephone:
1515 Eubank SE	(505) 284-8293
Albuquerque, NM 87123	
Attn: Samantha Updegraff	

SLAC National Accelerator Laboratory	Telephone:
Research Partnerships & Technology Commercialization Office	(650) 926-3580
2575 Sand Hill Road	
Menlo Park, CA 94025	
Attention: Mike Willardson, Director	
Email: michaelw@slac.stanford.edu	

18. Upon receipt of an award under the DuraMat EMN, additional parties shall agree to abide by the terms of this MMTA by executing a copy of the Third Party Material Transfer Agreement (MTA) which is included as Appendix B to this MMTA. LEAD INSTITUTION shall accept and acknowledge receipt of such Third Party MTA and shall keep Appendix C updated with a list of all current Parties to the MMTA.

19. This MMTA may be signed in two or more counterparts, each of which shall be deemed an original, and all of which taken together shall be deemed one and the same instrument.

Signatures for Parties are on the following page.

Example

APPENDIX A
DuraMat MMTA Implementing Letter

The purpose of this letter is to provide a record of the material transfer under the terms and conditions of the DuraMat Energy Materials Network Master Material Transfer Agreement (“MMTA”) to which both the PROVIDER and the RECIPIENT are parties, and to memorialize the agreement between PROVIDER SCIENTIST (identified below) and the RECIPIENT SCIENTIST (identified below) to abide by all terms and conditions of the DuraMat MMTA. The RECIPIENT organization's Authorized Official will sign this letter on behalf of the RECIPIENT organization. . The PROVIDER will forward the material to the RECIPIENT upon receipt of the signed copy from the RECIPIENT organization.

Please fill in all of the blank lines below:

1. PROVIDER: Party providing the MATERIAL

Organization: _____

PROVIDER SCIENTIST: _____

Title: _____

Address: _____

Phone: _____

E-mail: _____

2. RECIPIENT: Party receiving the MATERIAL

Organization: _____

RECIPIENT SCIENTIST: _____

Title: _____

Address: _____

Phone: _____

E-mail: _____

3. MATERIAL (Enter a complete description):

Common Name: _____

Sample Number: _____

Description: _____

4. Termination date for this letter (optional): _____

5. Transmittal Fee to reimburse the PROVIDER for preparation and distribution costs (optional).

Amount: _____

6. Other Provisions the PROVIDER and RECIPIENT wish to include:

This Implementing Letter is effective when signed by both parties. The parties executing this Implementing Letter certify that their respective organizations have accepted and signed an unmodified copy of the DuraMat MMTA, and further agree to be bound by its terms, for the transfer specified above.

PROVIDER

Signature _____

Name of Authorized Official _____

Title _____

Contact Address: _____

Date: _____

RECIPIENT

Signature _____

Name of Authorized Official _____

Title _____

Contact Address: _____

Date: _____

APPENDIX B

THIRD PARTY MATERIAL TRANSFER AGREEMENT

The _____, having an address at _____, hereby agrees to be bound by the terms and conditions of this DuraMat Energy Materials Network (EMN) Master Material Transfer Agreement (MMTA) to which this Appendix B is attached, and shall be deemed to be a "Party" to such agreement for all purposes from and after the latest date set forth below. This Appendix B will be effective as of the date receipt is acknowledged by the LEAD INSTITUTION.

Party Name: _____

Contact Name: _____

Mailing Address: _____

Email address: _____

Phone: _____

By: _____

Title: _____

Date: _____

Example

APPENDIX C

CURRENT LIST OF PARTIES

Alliance for Sustainable Energy, LLC

Sandia Corporation

The Regents of the University of California through the Ernest Orlando Lawrence Berkeley

National Laboratory

SLAC National Accelerator Lab

Example