

Guidance to Material Transfer Agreements at the University of Maryland, College Park

A Material Transfer Agreement (MTA) is a contract that governs the transfer of tangible research materials between two organizations, when the recipient intends to use it for his or her own research purposes, and when no research collaboration between scientists is planned. The MTA defines the rights of the provider and the recipient with respect to the materials and any derivatives. Biological materials, such as reagents, cell lines, plasmids, and vectors, are the most frequently transferred materials, but MTAs may also be used for other types of materials, such as chemical compounds and even some types of software.

At UMCP, the Office of Research Administration and Advancement (ORAA) reviews and approves all incoming MTAs. Conversely, all MTAs from UMCP to external organizations are issued by the Office of Technology Commercialization (OTC). OTC only signs off on MTAs (outgoing) associated with technology disclosed to OTC. This requires the filing of an intellectual property disclosure form (see <http://www.otc.umd.edu/Disclose.html>) prior to or with a request for a MTA. OTC will then comply with University policy by having the Department of Environmental Safety issue an approval allowing the transfer of the biological material. This is in compliance with Federal Law. To expedite the process of approving MTAs, Principal Investigators are asked to complete and sign a MTA Review Form and submit it with the MTA.

Three types of MTAs are most common at academic institutions: transfer between academic or research institutions, transfer from academia to industry, and transfer from industry to academia. Each calls for different terms and conditions.

1. Material transfer between UMCP and another academic institution

Exchange of materials between academic (or non-profit) institutions is relatively straightforward. To encourage the process of sharing research tools between scientists, the National Institutes of Health and the Association of University Technology Managers developed standard language to simplify material transfers, issued as the Uniform Biological Material Transfer Agreement (UBMTA). The UBMTA is used for many transfers between academic institutions. The UBMTA includes two sample letters: the Implementing Letter Agreement and the Simple Letter Agreement. The first is used for transfer of materials that are the subject of a patent or patent application or that has been or is likely to be commercially licensed. The Simple Letter Agreement is used for all other transfers.

2. Material transfer from Industry to UMCP

Researchers often use materials provided by industry. For transfer of materials from industry, UMCP is usually required to use the agreement written by the company providing the materials. An industrial MTA usually carries more restrictions than the UBMTA.

ORAA reviews, negotiates, and approves all MTAs from industry. Each industrial MTA is different and must be negotiated separately on a case-by-case basis, depending on the terms used in the agreement, the investigator's obligations to the sponsor(s) of the research, and the use of the investigator plans for the material.

Industrial MTAs often contain restrictive language that conflicts with basic academic principles or that place investigators and universities at unnecessary risk. Companies may often ask to own all rights to inventions arising from use of the material or ask for exclusive license to future patent rights.

Potential Issues in MTAs

Confidentiality: When confidential information is exchanged along with the material, the company may request that such information not be further disclosed. If the information is necessary for interpretation of the research results obtained using the material, that same information may also be required for publication of those results. Having agreed to hold the information confidential could prohibit an investigator from ever publishing the results of work using the company's material.

Delay in publication: In order to protect potentially patentable inventions, companies often will seek a review period for the investigator's manuscripts, abstracts or hard-copies of presentation materials. This review may delay publications. Under UMCP policy this delay cannot exceed 90 days.

Use of materials in sponsored research projects: Many industry MTAs contain language that prohibits the use of the material in research that is subject to licensing or consulting obligations to any third party, including the sponsor of the research project.

Definition of material: The industry provider may propose a definition of material that includes not only the original material, but also modifications or derivatives made from the material that incorporate the investigator's original ideas or concepts. If the provider also claimed ownership of the modified material, the provider could own the results of the investigator's research. The investigator could be prevented from using research results in further research, transferring them to other organizations, meeting obligations to research sponsors, or ensuring that the results are made public.

Loss of control of intellectual property: If MTAs preempt ownership rights, investigators may be restricted in their ability to interact with a future sponsor or may have conflicts with obligations to current sponsors. Intellectual property restrictions may prevent the institution from conferring rights on a future developer.

Conflicts with existing agreements: Industrial MTAs may contain obligations that conflict with obligations in a preexisting agreement. Also, the material may be used in conjunction with a separate material received under another MTA. These situations could result in granting two or more parties conflicting rights to the same invention. When MTAs are used in conjunction with federally funded research, the federal government has certain rights to resulting inventions (Bayh-Dole Act).

Other considerations:

MTAs for the use of live animals or custom antibodies must have the protocol reviewed and approved by the Institutional Animal Care and Use Committee.

MTAs for the use of human tissue must have a protocol reviewed and approved by the University's Human Subject's Committee.

MTAs for use of hazardous materials must adhere to Department of Environmental Safety compliance procedures. OTC obtains approval from the Department of Environmental Safety prior to authorization of shipment of any material under an MTA.

As a reminder, the Office of Technology Commercialization administers MTAs to transfer research materials from UMCP to external institutions for technologies disclosed to OTC. Without an intellectual property disclosure on file, materials cannot be transferred. OTC ensures that the agreements conform to institutional research policies.

Additional Resources:

MTA Review Form and Model Agreement (Incoming Materials)

<http://www.umresearch.umd.edu/oraa/forms>

Materials Transfer in Academia, Council on Government Relations (COGR)

<http://www.cogr.edu/viewDoc.cfm?DocID=151740>

Association of University Technology Managers: UBMTA

http://www.autm.net/AM/Template.cfm?Section=Technology_Transfer_Resources&Template=/CM/ContentDisplay.cfm&ContentID=2810

National Institutes of Health:

Principles and Guidelines for Recipients of NIH Research Grants and Contracts on Obtaining and Disseminating Biomedical Research Resources

http://www.nih.gov/od/ott/RTguide_final.htm

Bayh-Dole Act:

Rights to Inventions Made by Nonprofit Organizations and Small Business Firms under Government Grants, Contracts, and Cooperative Agreements-Patents, Trademarks, and Copyrights -37 CFR Part 401

http://www.access.gpo.gov/nara/cfr/waisidx_99/37cfr401_99.html