

APPENDIX 4



REPUBLIC OF GHANA

**MINISTRY OF ENVIRONMENT, SCIENCE, TECHNOLOGY
AND INNOVATION (MESTI)**

**GHANA JOBS AND SKILLS PROJECT
Credit # 6716-GH
PROJECT ID: P166996**

DEVELOPMENT OF FRAMEWORK FOR TECHNOLOGY TRANSFER

MODEL COLLABORATIVE RESEARCH AGREEMENTS

Commercial Material Transfer Agreement

APRIL, 2023

THIS COMMERCIAL MATERIAL TRANSFER AGREEMENT (“Agreement”) is made this.....day of.....20-- BETWEEN Academic Institution/business (select one as appropriate) of (address) and duly represented by (name and position of authorized representative), (hereinafter referred to as “the Owner” which expression shall where the context so requires or admits, include its lawful representatives and assigns of the one part AND (name of Academic / Research Institution/business) of (address) and duly represented by (name and position of authorized representative), (hereinafter referred to as “the Recipient” which expression shall where the context so requires or admits, include its lawful representatives and assigns) of the other part. The Owner and the Recipient each shall be referred to herein as a “Party” and together as the “Parties”.

WHEREAS

- A. The Owner is a University/ Research Institution/business (select one as appropriate) that owns (or has (state type of right) rights to) a Material, more particularly described in the First Schedule and is willing to provide samples to Recipient for commercial purposes.
- B. The Recipient is University/ Research Institution/business (select one as appropriate) engaged in (state objects of institution / business) and has asked the Owner to provide a sample of the Material as well as Confidential information to the Recipient.
- C. The Material and the Confidential Information have a unique value to the Owner, and the Owner will suffer irreparable harm by any unauthorised use or disclosure of the Material or Confidential Information.

NOW, THEREFORE, in consideration of the promises and mutual covenants set forth herein, the Parties agree as follows:

- 1. **DEFINITIONS:** To avoid ambiguity in terminologies, for the purposes of this Agreement, the following words wherever used in this document shall mean:

Affiliate means any corporation or non-corporate business entity which controls, is controlled by, or is under common control with a party, and for that purpose control means the ownership or direct or indirect control of at least 50% of the voting shares of another corporation, or having directly or indirectly the power to direct or cause the direction of the management and policies of another corporation or non-corporate business entity.

Confidential Information means all information that is labelled or identified at the time of disclosure under this Agreement as confidential or proprietary to the Owner, including inventions; discoveries; facts; data; ideas; manner, method or process of manufacture;

method or principle of construction; chemical composition or formulation; techniques; products; prototypes; processes; names; know-how; routines; specifications; drawings; trade secrets; technology methods; computer programs; works in respect to which copyright subsists; circuit board layouts; business plans; marketing plans; strategies; market analysis; feasibility plans; concept documents; expert's reports; forecasts; projections; methodologies; financial accounts; financials statements; cash flow statements; valuations; and other knowledge. The Confidential Information may also specifically include, but is not limited to, ... * ¹.

Derivative means any material that is derived from or based upon the Material, whether or not progeny, and whether modified, or unmodified.

Investigator means the named the Investigator that will have supervision of the use of the Material

Material means the full description of the Material as provided in the First Schedule, as well as the quantity of the Material to be provided.

New IP means such of the following as arise from Recipient's possession or use of the Material or Confidential Information under this Agreement:

(a) Derivative

(b) inventions (whether patentable or not); discoveries; facts; data; ideas; manner, method or process of manufacture; method or principle of construction; chemical composition or formulation; techniques; products; prototypes; processes; know-how; routines; specifications; drawings; trade secrets; technology methods; works in respect to which copyright subsists; and other knowledge.

Purpose means using the Material in accordance with the Work Plan.

Work Plan means the work plan set out in the Second Schedule.²

New IP means inventions (whether patentable or not); discoveries; facts; data; ideas; manner, method or process of manufacture; method or principle of construction; chemical composition or formulation; techniques; products; prototypes; processes; know-how; routines; specifications; drawings; trade secrets; technology methods; works in respect to which copyright subsists; and other knowledge, arising from the Recipient's use of the Material

¹ Consider referring to types or categories of Confidential Information proposed to be disclosed. The more accurately Confidential Information is identified, the greater the protection afforded to the Confidential Information. If you do not intend to specify particular Confidential Information, delete this sentence.

² The Schedule should describe the scope of approved use of the Material by the Recipient.

Purpose means research purposes.

2. PROVISION OF MATERIAL

2.1 The Owner shall provide the Material to the Recipient.

2.2 If the Owner requires reimbursement of the out-of-pocket expenses of transportation of the Material to the Recipient, the Owner shall provide an invoice for those out-of-pocket expenses, and the Recipient shall pay that invoice within 30 days of receipt of the Materials.

3. POSSESSION OF MATERIAL

3.1 The Recipient warrants that it has all regulatory approval(s), license(s) or consent necessary or required by any law, or any government agency or other body to receive and possess the Material.

3.2 The Recipient agrees that only the Investigator, and persons supervised by the Investigator, will have access to the Material.

3.3 The Recipient warrants that the Investigator is an employee of the Recipient.

3.4 The Recipient agrees not to transfer or permit the transfer of the Material, or any part of the Material, to another person without the Owner's prior written consent.

3.5 Upon the Owner's written request, the Recipient shall promptly return all quantities of the Material to the Owner.

4. SAFETY

4.1 The Recipient acknowledges that the Material may be toxic or may contain infectious agents, or other substances that are hazardous, dangerous, or harmful to persons or property.

4.2 The Recipient shall safely handle and store, and cause its employees to safely handle and store, the Material in a manner reasonably designed to prevent any harm to any person or property.

4.3 The Recipient warrants that it is aware of all requirements for the safe handling and storage of the Material and has all facilities that are required for the safe handling and storage of the Material.

5. USE OF MATERIAL

5.1 The Recipient may use the Material only for the Purpose, and must not use the Material for any other purpose.

5.2 The Recipient shall be responsible for use of the Material by its employees or agents.

5.3 The Recipient, for itself and its agents, assumes all risks associated with use of the Material.

5.4 The Recipient may not use the Material for any commercial purpose without the express written consent of the owner.

5.5 The Recipient may use the Material solely in accordance with the Work Plan.

5.6 The Recipient may not analyse, modify, or conduct experiments upon the Material, or use the Material upon human subjects, unless permitted by the Work Plan, and in that case, only to the extent permitted by the Work Plan.

5.7 The Recipient shall comply with all laws, and with all applicable codes of conduct, in relation to the use of the Material.

5.8 Where any ethics approval of any person or body is required to use the Material, the Recipient shall:

(a) obtain that ethical approval, and

(b) comply with all conditions of that ethical approval.

5.9 The Recipient may not file any patent application or any other application for the statutory protection of the Material, without the prior written consent of the Owner.

6. NEW IP

6. NEW IP - Version 1³

6.1 The Recipient shall promptly disclose any New IP to the Owner.

6.2 Recipient hereby assigns to Owner all New IP and intellectual property rights therein. Recipient agrees to sign all documents reasonably necessary to confirm this assignment.

6.3 The Recipient agrees that all New IP will be Owner's Confidential Information subject to this Agreement.

6. NEW IP - Version 2

6.1 The Recipient shall own any New IP.

³ There are three alternative versions of clause 6, dealing with the ownership and rights of New IP arising from the Owner's use of the Material. Select one option and remove the remaining two. Refer to the Guidelines in making this choice.

6.2 The Recipient shall disclose any New IP to the Owner. Such New IP shall be Recipient's Confidential Information and shall be held in confidence by Owner and not used for any purpose without prior approval of Recipient.

6.3 The Recipient grants to the Owner a right of first refusal, exercisable within three months after the notification in clause 6.2, to negotiate an exclusive, worldwide, royalty-bearing license to commercialise the New IP upon terms that the parties may negotiate in good faith.⁴

6. NEW IP - Version 3

6.1 The Recipient shall disclose any New IP to the Owner. Such New IP shall be Confidential Information of both parties and shall be held in confidence by each party for the benefit of the other party.

6.2 The Recipient hereby assigns to Owner an equal, undivided, 50% interest in any New IP and in any intellectual property therein. Recipient shall sign all documents reasonably necessary to confirm this assignment.

6.3 The Owner and the Recipient shall cooperate in obtaining intellectual property protection for any New IP and shall share equally in the cost thereof.

6.4 Each of the Owner and the Recipient may exploit any New IP in its respective business without accounting to the other. If either party grants a license to a third party under any New IP, it shall give notice to the other party and shall remit to the other party one-half of all consideration received for such license. Neither party may assign its interest in any New IP to any third party without the prior approval of the other party.

OR

6.4 In consideration for permitting the transfer to and use by Recipient of the Material, Recipient shall disclose to Owner any New IP on which Recipient has filed a patent application and hereby grants Owner a non-exclusive, royalty-free license under such New IP for research purposes only.⁵

7. PUBLICATIONS

7.1 The Recipient may not publish any paper which in any way refers to the Material without the prior written consent of the Owner. Owner may condition its consent on attribution and may withhold consent if publication would interfere with Owner's commercial interests.

⁴ Delete this clause if it is not intended to grant an option to negotiate a license. Refer to the Guidelines on Material Transfer Agreements.

⁵ This alternative paragraph may be appropriate if Recipient could obtain patent protection on an invention derived from the Material that could interfere with Owner's research with the Material.

8. DISCLOSURE OF CONFIDENTIAL INFORMATION

8.1 The Owner may disclose the Owner's Confidential Information to the Recipient to the extent such information, in the reasonable option of Owner, would be useful in using the Material for the Purpose.

8.2 If Confidential Information is disclosed orally, it shall be confirmed in writing by the Owner within 30 days after the date of the oral disclosure, and this Agreement shall apply in relation to an oral disclosure only to the extent to which it is confirmed in writing within that period.

9. CONFIDENTIALITY

9.1 The Recipient shall keep the Owner's Confidential Information secret and confidential.

9.2 Except as provided in clause 11, 12, 13 or 14 of this Agreement, the Recipient shall not disclose to any person or make known in any manner any part of the Owner's Confidential Information.

9.3 The Recipient shall keep the Confidential Information in a secure place to ensure that unauthorised persons do not have access to the Confidential Information.

9.4 The Recipient acknowledges that damages may be an inadequate remedy to the Owner in the event of any breach of this Agreement occurring, and that only an injunction might be adequate to properly protect the interests of the Owner.

10. USE OF CONFIDENTIAL INFORMATION

The Recipient may use the Owner's Confidential Information only for the Purpose, and shall not use that Confidential Information for any other purpose.

11. DISCLOSURE WITH CONSENT

11.1 The Owner may consent to the Recipient making a disclosure or relieve the Recipient from complying with the whole or any part of this Agreement. The consent shall be in writing.

11.2 The Owner may consent pursuant to clause 11.1 subject to conditions, including a condition that the person to whom the Recipient proposes to disclose executes in favor of the Owner a Confidentiality Agreement upon the same terms as this Agreement.

12. DISCLOSURE TO OFFICERS AND EMPLOYEES

The Recipient may only disclose the Owner's Confidential Information only to an officer or employee who is bound by obligations of confidentiality to the Recipient at least to the extent imposed upon the Recipient by this Agreement and who has a need to know to fulfill the Purpose.

13. DISCLOSURE TO AFFILIATES AND ADVISERS

13.1 The Recipient may not disclose the Owner's Confidential Information to any of the Recipient's Affiliates, consultants or advisers without the Owner's prior written consent.

13.2 The Owner may consent pursuant to clause 13.1 only upon receipt of a written agreement between the Owner, and the Affiliate, consultant or adviser to which the Recipient proposes to make a disclosure, to the same terms as this Agreement, signed by that Affiliate, consultant or adviser.

14. LEGAL OBLIGATION TO DISCLOSE

14.1 Where the Recipient is required by law to make a disclosure of any part of the Owner's Confidential Information the Recipient shall immediately notify the Owner of that requirement and provide full particulars relating to the requirement to disclose.

14.2 Unless the Owner is able to secure some relief to the Recipient from the legal obligation to disclose the Owner's Confidential Information, the Recipient is relieved from its obligations in this Agreement, but only to the extent of the legal obligation to disclose.

15. OBLIGATIONS OF THE TRANSFEROR (UNIVERSITY)

15.1 Transferor shall provide requisite training for the transferee and its personnel on the effective utilization of licensed technology as detailed in the Schedule which shall serve as a guide and transferor shall adhere to the training schedule

15.2 The transferor shall pay all taxes due on all royalties.

15.3 Transferor shall give full description of the technology and to supply all necessary documentation and information in the English language.

15.4 Transferor guarantees the efficient performance of the technology and the continuous availability of essential spare parts during the tenure of the agreement.

15.5 Transferor shall inform the transferee of improvements and innovations relating to the technology and shall supply them on terms mutually acceptable to the parties.

16. DURATION OF CONFIDENTIALITY

Unless earlier terminated by the parties, this Agreement shall determine on the* anniversary of the Effective Date.

- *⁶ The duration of the obligations upon the Recipient in this Agreement is.... *⁷ years after expiration or termination of the Agreement.
- * The obligations on the Recipient under this Agreement shall continue indefinitely, and cease only to the extent that a part of the Owner's Confidential Information becomes subject to clause 16.

17. ENDING OF CONFIDENTIALITY

The Recipient shall be relieved from its obligations of confidentiality under this Agreement in respect to any part of the Owner's Confidential Information which the Recipient can show:

- (a) was in the possession of the Recipient as at the date of the disclosure; or
- (b) is or becomes part of the public domain otherwise than by a breach of this Agreement; or
- (c) was received in good faith from a person entitled to provide it to the Recipient without an obligation of confidentiality; or
- (d) was independently developed by employees of the Recipient who did not have access to the Confidential Information.

18. RETURN OF CONFIDENTIAL INFORMATION

18.1 The Owner may at any time by written request to the Recipient require the return of the Owner's Confidential Information.

18.2 Within seven (7) days of receipt of such a request the Recipient shall deliver to the Owner all the Owner's Confidential Information in its possession together with all copies.

18.3 Any part of the Owner's Confidential Information which cannot be returned by the Recipient to the Owner shall be completely destroyed in such manner and at such time as directed by the Owner, including by deletion from all computer records and electronic or magnetic storage devices.

⁶ There are two versions of this clause to select from. Select one and delete the other. Refer to the Guidelines in relation to making this choice.

⁷ Insert a period of time to be the duration of the obligations in the Agreement. Refer to the Guidelines in relation to this.

18.4 Notwithstanding clauses 17.2 and 17.3, the Recipient may retain one copy of the Owner's Confidential Information for the Recipient's archival record keeping and evidentiary purposes.

19. FORCE MAJEURE.

19.1. In this Agreement, force majeure means an event which could not reasonably have been foreseen or avoided by the diligence of either party in any circumstance, which is beyond the reasonable control of either party and which renders performance of the obligations of either party impossible or so impracticable as reasonably to be considered impossible. Force majeure includes but is not limited to earthquakes, fires, adverse weather conditions, a health pandemic and other acts known as acts of God, as well as war, riots, civil disorder, confiscation or other adverse action by the Government or any of its agencies.

19.2. In the event of the occurrence of force majeure, a party to this agreement shall, notwithstanding anything to the contrary in this Agreement, not be liable for any delay or failure in carrying out or performing any of its obligations contained in this Agreement.

19.3. Force majeure shall not include any of the following: i. Any event caused by the negligence or intentional action of either party, its agents, employees or subcontractors; or ii. Insufficiency of funds or the inability of a party to pay any sum of money required to be paid under this Agreement.

19.4. A party affected by force majeure shall take reasonable measures with a minimum of delay, to remedy its inability to fulfil its obligations by reason of such force majeure.

19.5. A party affected by an event of force majeure shall give notice of such event to the other party as soon as reasonably practicable and in any event not later than seven (7) days after the occurrence of such event and shall provide full particulars of the nature and cause of such an event and where normal conditions are restored, give prompt notice thereof to the other party.

19.6. The period during which an event of force majeure persists shall be taken into account in computing the time within which a party may do anything or perform any act under this Agreement and such time shall be extended by the period by which the event of force majeure continues. Provided that if the event of force majeure persists for more than [days] [weeks] [months], either party may terminate this Agreement by giving [days] [weeks] [months] notice to the other of its intention to do so.

20. MISCELLANEOUS PROVISIONS.

20.1. Communication.

Any notice, consent or agreement required to be given under this agreement shall be in writing and sent by registered mail, electronic mail or facsimile numbers as either party hereto may from time to time notify to the other party or by hand to the said addresses.

20.2. Ratification.

Each of the parties herein undertakes to ensure that as soon as practicable after the signing of this agreement, all necessary steps will be taken on acts done to obtain ratification thereof in accordance with the party's regulations or articles and where such ratification requires the amendment of the said regulations or articles, to procure such amendment.

21. GOVERNING LAW

This Agreement is made and entered into in the Republic of Ghana and this Agreement shall be construed and applied under the law thereof. The parties agree to submit themselves to the exclusive jurisdiction of the laws in force for the time being in Ghana.

22. NO LICENSE

Nothing in this Agreement grants Recipient any right or license to use or practice any intellectual property owned by Owner, provided, however, that Owner shall not enforce its intellectual property against Recipient's use of Material as permitted by this Agreement.

IN WITNESS WHEREOF, the Parties hereto have hereunto set their respective hands and seals the day and year first above written.

SIGNED for and on behalf of the Owner

By the above-named Representative

.....

Signature

In the presence of:

.....

Name & Signature

Name:

Address:

Occupation:

SIGNED for and on behalf of the Recipient

By the above-named Representative

.....

Name & Signature

In the presence of

.....

Signature

Name:

Address:

Occupation:

FIRST SCHEDULE (Material description)

SECOND SCHEDULE (Work Plan)

The Schedule should describe the scope of approved use of the Material by the Recipient.