



Shaded Area - Internal University Use Only
OTC Agreement No.: 094 A20120698
OTC Docket No.(s): Giblin, Chad; Gillman, J.
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UNIVERSITY OF MINNESOTA PLANT MATERIAL TESTING AGREEMENT

THIS AGREEMENT is dated and effective as of the date of last signature (the “Effective Date”), and is made by and between Regents of the University of Minnesota, a constitutional corporation under the laws of the state of Minnesota having a place of business at 1000 Westgate Drive, Suite 160, St. Paul, Minnesota 55114 (the “University”), and City of Saint Paul - Parks & Recreation, a Municipality, under the laws of the State of Minnesota having a place of business at 1100 Hamline Ave. N, Saint Paul, MN, 55108 (the “Recipient”).

Purpose

The University possesses, and is willing to deliver to the Recipient, certain plant material on the terms and conditions set forth below. In addition and in connection with the delivery of the plant material, the Recipient desires to, and the University shall allow, the Recipient and its agents to conduct evaluations of the plant material.

The University possesses the plant material described in section 1 of the attached Schedule A (the “Plant Material”), which resulted from research conducted at the University. The University shall provide the Recipient with a sample of the Plant Material so as to permit the Recipient to evaluate the Plant Material. The University also desires to protect its proprietary rights in and to the Plant Material and in any proprietary information that may be disclosed between the parties concerning the Plant Material. The University is willing to provide the Plant Material and such information to the Recipient on the terms and conditions set forth below.

NOW, THEREFORE, the parties agree that:

1. Term and Termination. The term of this Agreement shall commence on the Effective Date and, unless terminated earlier as provided in section 8 of this Agreement, shall expire on the anniversary of the Effective Date specified in section 4 of attached Schedule A.

2. Delivery of the Plant Material. Subject to the terms of this Agreement, the University shall deliver the Plant Material or cause the Plant Material to be delivered, to the Recipient at the Recipient’s address described in section 2 of attached Schedule A.

3. The Recipient’s Use of the Plant Material and the Confidential Information.

3.1. The Recipient shall use the Plant Material only for the purposes set forth in section 6 of Schedule A. Solely in connection with its use of the Plant Material as permitted under this subsection, the Recipient may evaluate the individual plant specimens of the Plant Material only in the territory, territories or defined test sites as specified in section 7 of Schedule A. If allowed to do so by section 5 of Schedule A, Recipient may propagate the material only in

the territory, territories or defined test sites as specified in section 7 of Schedule A, and only by the method or means described in section 5 of Schedule A. Except as permitted in this subsection, the Recipient shall not use for breeding (including the use of pollen), alter (genetically or otherwise), propagate, divide, or reproduce the Plant Material, in any form. The Recipient shall abide by the University's written instructions concerning the Recipient's use of the Plant Material. In no event shall the Recipient sell, give, or deliver any of the Plant Material to a third party except as may be provided for in section 6 and/or 7 of Schedule A. The Recipient shall use the Confidential Information, as that term is defined below in this Agreement, only in connection with its evaluation of the Plant Material.

3.2. No later than thirty (30) days after 31 November of each year during the term of this Agreement, the Recipient shall deliver to the University to the person(s) and address(es) identified in section 3 of Schedule A true, correct, and complete copies of all the Recipient's records of the propagation and planting of the Plant Material along with a statement of the results of the evaluation since the last such report. Each report shall include the Recipient's data and observations on the performance of the Plant Material and any further information as may be required in section 3 of Schedule A.

3.3. The Recipient shall deliver the University written notice within thirty (30) days of the discovery or propagation of a sport or mutation of the Plant Material. The Recipient hereby grants the University all rights, titles, and interests, including all patent and other intellectual property rights in and to any such sport or mutation. Further, the Recipient shall cooperate with the University as may be needed to file patents or other intellectual property protections.

3.4. Upon Recipient's receipt of written notice from the University, the Recipient shall permit the University (including its agents and contractors) to enter the site(s) on which the Recipient is growing or propagating, or any locations to which the Recipient is having grown or having propagated on its behalf, the Plant Material to inspect the Plant Material and to confirm the Recipient's compliance with the terms of this Agreement.

3.5. The Recipient shall furnish the Plant Material and the Confidential Information only to its employees, other persons within its organization, or to those additionally authorized by the University, as may be provided for in section 6 and/or 7 of Schedule A. The Recipient shall only furnish the Plant Material and the Confidential Information to those for whose actions are required by the Recipient, who, strictly defined, "need to know" for purposes of the Recipient's evaluation of the Plant Material. The Recipient shall inform each employee or such person using or having access to the Plant Material and/or the Confidential Information of the restrictions set forth in this Agreement regarding the use and disclosure of the Plant Material and the Confidential Information and it shall be the Recipients obligation to ensure compliance with this Agreement.

3.6. The Recipient acknowledges and agrees that no provision of this Agreement grants it any right under any existing or future patent or other intellectual property right to make or use any products or processes derived from or with Plant Material for any profit-making or commercial purposes. The Recipient shall obtain a license from the University prior to making any profit-making or commercial use of any product or process derived from or with the Plant Material. The University shall have no obligation to grant any such a license to the Recipient.

4. The University's Use of the Plant Material and Confidential Information. The parties acknowledge and agree that no provision of this Agreement limits, conditions or otherwise affects the University's right to (a) use the Plant Material or the Confidential Information, (b) deliver the Plant Material or the Confidential Information to a third party, or (c) grant a third party an exclusive or non-exclusive license or other right to the Plant Material.

5. Third Party's Rights in the Plant Material and Confidential Information. The parties acknowledge and agree that no provision of this Agreement alters, limits, conditions or otherwise affects the federal government of the United States of America or any other third-party's rights and interests which may exist in and to the Plant Material or the Confidential Information.

6. Confidentiality and the Confidential Information.

6.1. For purposes of this Agreement, the term "Confidential Information" refers to any non-public, proprietary information delivered by the University to the Recipient in connection with this Agreement. The parties acknowledge and agree that the Plant Material is "Confidential Information" as defined herein.

6.2. The term "Confidential Information" shall not include, and the restrictions in section 6.3 of this Agreement shall not apply to, any information that:

- (i) was generally available in the public domain or after the Owner's disclosure of it to the Recipient, was placed in the public domain through no act or fault of the Recipient or its employees, agents or representatives; or,
- (ii) the Recipient had actual knowledge of such Confidential Information as evidenced by written records, provided the Recipient acquired such knowledge in conformance with all applicable laws and not as the recipient, directly or indirectly, of such information in violation of a valid and enforceable confidentiality agreement; or,
- (ii) that Recipient obtains in good faith from a third party not bound by confidentiality obligations to Owner; or,
- (iv) that Recipient develops independently, for which Recipient can demonstrate by written records that independent development occurred without knowledge or use of Confidential Information.

6.3. Except as permitted under section 3 of this Agreement or by the University in a separate written consent, during the term of this Agreement and forever thereafter, the Recipient shall maintain the Confidential Information in confidence and shall not use or disclose and shall not permit its employees or other persons within its organization for whose actions the Recipient is responsible to use or disclose the Confidential Information.

7. Limited Rights.

7.1. Except for the right to use the Plant Material and the Confidential Information as described in section 3 of this Agreement, the Recipient shall have no right to use or disclose the Plant Material or the Confidential Information. The Recipient acknowledges and agrees that no provision of this Agreement grants it (a) any right or interest in the patent, copyright, trademark, or equivalent rights in the Plant Material or the Confidential Information or (b) any license, right, or option to commercially utilize the Plant Material under such patent, copyright, trademark, or equivalent right.

7.2. The Recipient acknowledges and agrees that the Plant Material and the Confidential Information shall remain the property of the University and that, upon the University's written request, the Recipient shall destroy or return to the University at the address listed in section 3.1 in Schedule A, (a) the Plant Material and (b) all documents, papers, samples, and other tangible goods and property delivered to the Recipient that contain or reflect the Confidential Information or other information accumulated about the Plant Material by the Recipient provided, however, the Recipient may retain one (1) copy of any documents and papers containing or reflecting the Confidential Information for the sole purpose of determining Recipient's obligations under this Agreement.

7.3. As provided for in section 3.3 above, the University shall own all rights, titles, and interests, including all patent and other intellectual property rights in and to any sports discovered or propagated in connection with the use of the Plant Material.

8. Termination.

8.1. This Agreement may be terminated by the University at any time.

8.2. If Recipient fails to perform, when due, a material obligation under this Agreement, University may deliver a notice of default to Recipient, and such notice shall describe the unperformed obligation. If the obligation remains unperformed at the end of the thirty (30)-day period that began three (3) days from the date on which the notice of default was sent, the University may deliver a notice of termination, and this Agreement shall terminate on the date on which the notice of termination was sent. All notices to be sent under this section shall be sent by United States Mail, certified, return receipt requested or by other such qualified delivery service (e.g. United Parcel Service, Federal Express, etc.) to the address provided in the first paragraph of this Agreement.

8.2. Upon the termination or expiration of this Agreement, unless the University otherwise agrees in writing, the Recipient shall destroy all Plant Material and Confidential Information then in its possession and, within ten (10) days of such destruction, shall deliver to the University written confirmation of the destruction.

9. No Warranties or Liability. The Recipient acknowledges its understanding that the Plant Material is experimental in nature. **THE RECIPIENT ACCEPTS THE PLANT MATERIAL AND CONFIDENTIAL INFORMATION "AS IS, WITH ALL FAULTS." THE RECIPIENT ACKNOWLEDGES THAT IT HAS NOT RELIED UPON ANY STATEMENTS MADE BY THE UNIVERSITY CONCERNING THE PLANT**

MATERIAL OR THE CONFIDENTIAL INFORMATION. THE UNIVERSITY DISCLAIMS ALL WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED, INCLUDING THE IMPLIED WARRANTIES OF MERCHANTABILITY, FITNESS FOR A PARTICULAR PURPOSE, AND THAT THE USE OF THE PLANT MATERIAL OR THE CONFIDENTIAL INFORMATION WILL NOT INFRINGE ANY THIRD PARTY'S PATENT, COPYRIGHT, TRADEMARK, OR OTHER RIGHTS. IN NO EVENT SHALL THE UNIVERSITY BE LIABLE FOR ANY CONSEQUENTIAL, INCIDENTAL, PECUNIARY, EXPECTANCY, OR COMPENSATORY DAMAGES, INCLUDING (A) PERSONAL INJURY, PROPERTY DAMAGES OR (B) LOST PROFITS, LOST BUSINESS OPPORTUNITY, INVENTORY LOSS, WORK STOPPAGE, LOST DATA OR ANY OTHER RELIANCE OR EXPECTANCY, DIRECT OR INDIRECT, SPECIAL, INCIDENTAL OR CONSEQUENTIAL DAMAGES OF ANY KIND. EVEN IF ADVISED OF THE POSSIBILITY OF SUCH DAMAGES, IN NO EVENT SHALL THE UNIVERSITY'S TOTAL LIABILITY FOR THE BREACH OR NON-PERFORMANCE OF THIS AGREEMENT EXCEED THE AMOUNT OF PAYMENTS PAID TO THE UNIVERSITY UNDER THIS AGREEMENT. THIS LIMITATION SHALL APPLY TO CONTRACT, TORT AND ANY OTHER CLAIM OF WHATEVER NATURE.

10. Release. The Recipient, for itself and its employees and agents, releases the University and its employees and agents from any claim, suit, action, or liability arising out of this Agreement, including, without limitation, the Recipient's use of the Plant Material or Confidential Information. In no event shall the University be liable for any use of such Plant Material or Confidential Information.

11. Indemnification. The Recipient shall defend, indemnify, and hold the University harmless from any loss, claim, damage, or liability, of whatsoever kind or nature that may arise from or in connection with this Agreement or the use of such Plant Material or Confidential Information.

12. General Terms. This Agreement shall constitute the entire understanding of the parties with respect to the subject matter of this Agreement, and shall supersede all prior agreements and understandings of the parties on such subject matter. This Agreement shall be amended only in a writing duly executed by all the parties. No party may assign or delegate any right or duty under this Agreement unless the other party has consented in writing to such assignment or delegation. An assignment or delegation made in violation of this section 12 shall be void and shall not bind the other party. This Agreement shall be interpreted in accordance with the laws (with the exception of conflicts of laws provisions) of the state of Minnesota. All claims, suits, or causes of action arising out of this Agreement shall be brought in the courts of the state of Minnesota, county of Hennepin.

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

Regents of the University of Minnesota

By: _____
Name: Margaret Hamm
Title: Contracts Manager
Office for Technology Commercialization
Date: _____

City of Saint Paul - Parks & Recreation

By: _____
Name: Michael Hahm
Title: Director of Parks and Recreation
Date: _____

City of Saint Paul

By: _____
Name: [Enter Signatory Name]
Title: [Enter Signatory Title]
Date: _____

City of Saint Paul

By: _____
Name: [Enter Signatory Name]
Title: [Enter Signatory Title]
Date: _____

SCHEDULE A
PLANT MATERIAL TESTING AGREEMENT

- 1. Description of the Plant Material.** The term “Plant Material” includes the progeny, portions, sports, and derivatives of the material described in this section.

Three bareroot clones from UMN elm selection program. One each of S4, MP, and SL (University identification codes)

- 2. The Recipient's Contact/Shipping Address:**

City of Saint Paul - Parks & Recreation
Attn: Karl Mueller
1100 Hamline Ave. N

Saint Paul, MN 55108

U.S.A.

Phone: (651) 632 - 2429

Fax: () -

Email: karl.mueller@ci.stpaul.mn.us

- Check here, if you desire express shipping. (University will send via common carrier at its discretion, unless you direct otherwise).

Indicate your Express Shipper and Account Number:

Shipper:

Account No.:

- 3. Report Information:**

3.1. University Recipient of the Recipient's Reports:

University of Minnesota
Chad Giblin
Horticultural Science
1970 Folwell Ave
St Paul, MN 55108
Phone (612) 624 - 2729
Fax: () 624 -
Email: gibli002@umn.edu

3.2. Additional Report Requirements:

University of Minnesota
Jeffrey Gillman
Horticultural Science
1970 Folwell Ave
St Paul, MN 55108

4. Term. This Agreement expires on the tenth (10th) anniversary of the Effective Date.

5. Propagation:

5.1: Allowed: No

5.2: Allowable Propagation Methods: None

6. Permitted Uses of the Plant Material:

The Recipient may use the Plant Material to evaluate its potential for development and/or commercialization. This is not a license agreement. University and Recipient may enter into negotiations at a later date if Recipient desires to license the University's rights in and to the Plant Material but the University is under no obligation to do so.

The Recipient may use the Plant Material for non-commercial, research, academic and/or educational purposes only.

Other:

7. Territory or Test Sites:

Horton Park, Saint Paul, MN

8. Other Terms:

None