

DuPont Cre-Lox License Agreement Information Sheet

On December 9, 1998, the University of California (UC) and DuPont executed a license agreement (DuPont License Agreement) covering any UC use of DuPont's proprietary Cre-lox technology. The OTT Operating Guidance Memo (98-5) concerning the DuPont License Agreement with UC can be accessed from the Office of Technology Transfer web site: <http://www.ucop.edu/ott/ottmemos/ottmemos.html>. The authorization under the DuPont License Agreement relates to DuPont's rights under U.S. Patent 4,959,317, and any patents granted on any divisional and continuation applications thereof (Licensed Patents). The DuPont License Agreement allows UC researchers to legally use Cre-lox technology without infringing DuPont's rights. The license agreement distinguishes between academic and commercial uses of the technology. DuPont has agreed to make the technology available without cost to UC researchers for non-commercial purposes. UC researchers may disseminate Cre-lox materials for academic research to other academic laboratories and investigators that have similar license agreements with DuPont or under a Cre-lox material transfer agreement (MTA) between UC and the recipient's institution. The recipient of the Cre-lox material may need an additional agreement directly with DuPont to further transfer the Cre-lox material provided by UC to any third parties. Discoveries made by UC researchers through use of the Cre-lox technology will not be subject to any payments to DuPont so long as a commercial entity receives no direct benefit from it. The transfer of Cre-lox material from UC to a for-profit institution will require verification from a list provided by DuPont on the existence of a valid commercial research license between DuPont and the for-profit institution prior to any transfer of Cre-lox material.

FREQUENTLY ASKED QUESTIONS

1. Can UC researchers use the Licensed Patents in any area of research?

No. Under the terms of the DuPont License Agreement, UC research involving the use of Cre-lox technology is restricted to noncommercial biomedical research. In fact, there are three specific research areas excluded by the DuPont License Agreement. Those areas of exclusion are i) agricultural applications, ii) alteration of mouse embryonic stem cells for the purpose of preparing a library, and iii) all commercial uses. In addition, the external distribution of Cre-lox material generated under research performed by UC is also restricted.

2. What happens if a UC researcher needs to use the Licensed Patents in conducting research in an area excluded by the DuPont License Agreement?

The UC researcher must obtain permission from DuPont to do so. Specifically, UC must execute a separate agreement with DuPont that grants the UC researcher the right to conduct research in the excluded area of interest. This must be accomplished

prior to the commencement of any research activities in the areas of exclusion. The UC researcher should contact the appropriate campus/Laboratory authority for execution of the appropriate agreement.

3. *Can a UC researcher receive Cre-lox material from other institutions or agencies?*

Yes. With the execution of this license agreement with DuPont, UC has the right to receive Cre-lox material from a third party. The acceptance and use of such Cre-lox material is subject to the terms and conditions of the DuPont License Agreement.

4. *Can a UC researcher send Cre-lox material created under the practice of the Licensed Patents to other non-profit institutions (e.g. university collaborators, government agency research facilities, etc.)?*

Yes, under the following conditions:

- i) If either the non-profit institution has entered into a license agreement with DuPont for the Cre-lox technology, as identified in a list provided by DuPont; or
- ii) UC has executed an MTA with the recipient's institution. The MTA must include the provisions stated under Section 2.2 of the DuPont License Agreement. A sample MTA is included in the DuPont License Agreement as Attachment B.

Please contact your campus/Laboratory technology transfer office or the systemwide Office of Technology Transfer for additional guidance.

5. *Can a UC researcher send Cre-lox material created under the practice of the Licensed Patents to a corporate sponsor or a collaborator affiliated with a for-profit institution?*

Yes, provided that the for-profit institution is identified as a licensed for-profit institution in a list provided by DuPont. The transfer and use of the Cre-lox material by the recipient for-profit institution shall be subject to the terms and conditions of the license agreement between the recipient for-profit institution and DuPont.

Please contact your campus technology transfer office or the systemwide Office of Technology Transfer for additional guidance.

6. *Does UC have any other obligations to DuPont?*

Yes. Upon written request from DuPont, UC must provide reasonable quantities of any Cre-lox material identified in a public disclosure that UC generates in the course of its research activities under the DuPont License Agreement. The Cre-lox material is to be provided solely for internal research purposes and at no cost to DuPont. The UC researcher should note that compliance with this obligation could result in unexpected costs. The UC researcher must consider the resources required (labor, Cre-lox materials) to comply with this obligation along with the identification of an appropriate funding source.

If you have any questions or would like to discuss the details of the DuPont License Agreement, please contact your local technology transfer office, Contract and Grant office, or Chuck Rzeszutko of the systemwide Office of Technology Transfer at (510) 587-6063, or at charles.rzeszutko@ucop.edu.