ASSIGNMENT AGREEMENT

**THIS ASSIGNMENT AGREEMENT** is effective the \_\_\_\_\_ day of \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_, 20\_\_\_\_\_ (the “Effective Date”) between the University of New Brunswick, a University established by a Special Act of the Legislature of the Province of New Brunswick having an office at the City of Fredericton, in the Province of New Brunswick (the “University”) and \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ (the “Researcher”).

**WHEREAS** the Researcher has created certain intellectual property, more specifically described in Schedule “A” to this Agreement, and is desirous of entering into this Agreement to obtain support and assistance from the University to manage and transfer the intellectual property for commercial use as more particularly described hereinafter;

**AND WHEREAS** the University is willing to provide such support and assistance to the Researcher, and is desirous of entering into this Agreement to support the management and transfer of the intellectual property on the terms and conditions described hereinafter.

**NOW THEREFORE IN CONSIDERATION** of the foregoing and the covenants and agreements herein contained the University and the Researcher (the “Parties”) hereto agree as follows:

**1. DEFINITIONS**

* 1. The definitions for terms used in this Agreement are provided hereto.

(a) “Agreement” shall mean this Assignment Agreement, and includes Schedule “A” and Exhibit 1 hereto.

1. “Improvement” shall mean any improvements, variations, updates, modifications, and enhancements made or acquired by the Researcher relating to the Technology at any time after the Effective Date.

(c) “Intellectual Property Right” shall mean any and all patents, trade-marks, trade names, copyright, industrial designs, design patents, mask works, and integrated circuit topographies acquired under any statute law or act in any country and shall also include all registrations and applications for the foregoing trade secrets, knowledge, techniques, methods, know-how and show-how, and any and all other related property rights which exist or may in future come into existence.

(d) “Revenue” shall mean any and all income in the form of money or an in-kind contribution valued in money, however derived and in whatever form including royalty payments, license fees, lump sum payments, or other benefits arising out of the transfer of the Technology to one or more third parties or from the use or sale of the Technology by such third parties.

(e) “Technology” shall mean any and all technology and inventions (whether or not patentable) invented, developed, and/or acquired prior to the Effective Date by the Researcher relating to the technology described in Schedule “A” hereto, as amended from time-to-time, including, without limitation, all research, data, specifications, instructions, manuals, papers, or other materials of any nature whatsoever, whether written or otherwise, relating to same.

**2. ASSIGNMENT**

* 1. The Researcher hereby assigns his or her entire right, title, and interest in and to the Technology, and in and to the Intellectual Property Rights in and related to the Technology, to the University.
  2. At the request of the University, the Researcher agrees to execute and deliver any and all such instruments and papers, including the Assignment attached hereto as Exhibit 1, as may be from time-to-time considered reasonably necessary by the University to accomplish or confirm said assignment or to transfer and vest title in the Technology and Improvements.

**3. RESEARCHER’S RIGHTS AND IMPROVEMENTS**

* 1. The University acknowledges that the Researcher has the right to use the Technology and any Improvements for research and educational purposes, and to further develop and improve the Technology.
  2. The Researcher acknowledges and agrees that he or she shall have the obligation to advise and inform the University, from time-to-time, of Improvements which the Researcher has developed at the University and, when not prevented by other University contractual obligations, shall transfer and assign such Improvements to the University if requested by the University.

**4. PATENTS AND COPYRIGHT**

4.1 The Researcher agrees that he or she will provide all the assistance which is reasonably required by the University to prepare and prosecute patent applications filed by or assigned to the University, to register copyright and to file any application under trade-mark or any other form of intellectual property legislation which may be required to protect the Technology or Improvement in any country, territory, or jurisdiction.

* 1. The Researcher agrees not to disclose and to maintain in confidence the Technology and any Improvements, unless written notice is given to the University or such information becomes part of the public domain without breach of this Agreement. In the case of written notice, the Researcher shall advise the University in writing at least sixty (60) calendar days prior to making the disclosure.

**5. UNIVERSITY SUPPORT AND SERVICES**

5.1 The University will undertake, as appropriate, one or more of the following activities with respect to the Technology:

1. conduct a preliminary assessment of the Technology;
2. develop with assistance of the Researcher a technology transfer strategy;
3. actively seek licensees for the Technology;
4. assist in the transfer of the Technology to a company when appropriate;
5. prepare and negotiate non-disclosure, option, license, and other agreements in implementing the technology transfer strategy;
6. administer non-disclosure, option, license, and other such agreements; and
7. provide financial accounting and reporting services for option, license, and other such agreements.

5.2 It is understood that costs associated with the services in Article 5.1 above will be absorbed by the University in the first instance and recovered out of its share of Revenues. Additional expenditures for such items as product development, more extensive market research, marketing, copyright, patent, and legal fees may be funded by third parties or by the University. If funded by third parties, the costs may either be reimbursed as part of a royalty or license agreement or repayable in a lump sum out of future Revenue. Such repayment will constitute a reduction from Revenue prior to sharing between the Researcher and the University. If the expenditures are funded by the University, repayment will be made to the University on the basis set out in Article 7.

**6. RESEARCHER’S WARRANTY**

* 1. The undersigned Researcher hereby warrants and certifies that to the best of his or her knowledge and belief, he or she is the sole and first creator, inventor, and/or developer of the Technology, he or she has full and complete rights to the Technology, and that, to the best of his or her knowledge and belief, the Technology does not infringe on and is not subject to any other proprietary rights of any third party.

6.2 In the event that a party other than the Researcher claims any right, interest, title, or ownership in the Technology or Intellectual Property Right, the Researcher agrees that the proven or verified rights or interest of any such party shall be accommodated out of the Researcher’s share as provided in Article 7.

**7. REVENUE SHARING**

* 1. After payment of all then existing out-of-pocket costs associated with the Technology or Improvements, and product development, market research, marketing, Intellectual Property Rights acquisition and protection, and legal fees, the University shall distribute to the Researcher fifty percent (50.0%) of the Revenue.

* 1. The Researcher acknowledges and agrees that Revenue will be distributed as follows:

Name Percentage of Revenue

University of New Brunswick 50.0%

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ 50.0%

7.3 Payments to the Researcher will be made by the University periodically in accordance with its current policy and practice.

7.4 Payments will be made in Canadian funds or equivalent. Revenue received in other than Canadian funds will be recorded at the rate of exchange in effect at the date of receipt.

**8. TERM AND TERMINATION**

8.1 This Agreement shall have a term which extends from the Effective Date to the latest date of expiry of a patent included in the Technology obtained by the University or its assigns, and in the event the Technology is protected under the provisions of copyright law, the term shall be the longer of: a period of twenty (20) years following the Effective Date, or upon expiry of the last patent claiming all of any part of the Technology or an Improvement.

8.2 The University shall have the right to terminate this Agreement when in the sole opinion of the University there appears to be no reasonable prospect or expectation of the successful protection or commercialization of the Technology. In the event of termination pursuant to this Article 8.2, the University shall be released from its obligation to pay any further costs associated with the Technology and will negotiate a settlement with the Researcher for any claim the University may have against Revenues ultimately derived from the Technology. The University shall advise the Researcher of its intention to terminate the Agreement pursuant to Article 8.2 by notice in writing sent to the Researcher in accordance with Article 10.

8.3 In the event of a termination of the Agreement under Article 8.2, the University shall upon written request by the Researcher reassign all right, title, and interest in the Technology and any Improvements to the Researcher or such other single third party as may be identified in writing by the Researcher, subject to satisfactory arrangements being made with the Researcher or the said third party for sharing of Revenues derived from the Technology.

**9. ASSIGNMENT OF THE INTELLECTUAL PROPERTY RIGHTS**

9.1 The Researcher acknowledges and agrees that the University may assign the Intellectual Property Rights assigned to the University under this Agreement to a third party with the prior written consent of the Researcher.

**10. NOTICE**

10.1 Any notice, payment, or communication required under this Agreement shall be addressed to the University at:  
  
University of New Brunswick, Saint John  
Hazen Hall, Room 224C  
100 Tucker Park Road  
PO Box 5050  
Saint John, New Brunswick E2L 4L5  
Attention: Shane Nason  
  
and to the Researcher at:  
\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_  
\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_  
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**11. GENERAL**

11.1 This Agreement shall not be assigned by the Researcher or the University without the prior written consent of all Parties.

11.2 There are no understandings, agreements, representations, or warranties, express or implied, other than as herein set forth or incorporated by specific reference in this Agreement.

* 1. This Agreement shall enure to and be binding upon the Parties, their successors, and lawful assigns.
  2. This Agreement may not be amended except in writing by all of the Parties.
  3. The singular shall include the plural, words denoting the masculine shall include the feminine, and vice versa.
  4. This Agreement may be signed in counterparts, each of which when taken together, will constitute an original Agreement.
  5. This Agreement shall be governed by the laws of the Province of New Brunswick and the laws of Canada as applicable, and any dispute between the Parties with respect to this Agreement shall be subject to the jurisdiction of the Courts of New Brunswick.

**IN WITNESS WHEREOF** the Parties have executed this Agreement as of the date first herein set forth.

**WITNESS RESEARCHER**

Signature: Signature:

Name: (Print) \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ Name: (Print) \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Date: (Print) \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ Date: (Print) \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

# UNIVERSITY OF NEW BRUNSWICK

Kelly Ashfield

Executive Director, Office of Research Services

**Schedule “A”**

[Add digital copy of Invention Disclosure form, Patent Application, or equivalent document.]

**Exhibit 1**

**ASSIGNMENT**

FOR GOOD AND VALUABLE CONSIDERATION,

I, **\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_** (Name of Researcher), being the only and original inventor, have agreed and hereby agree to assign for good and valuable consideration, receipt of which is hereby expressly acknowledged, and do hereby sell, assign and transfer unto

**UNIVERSITY OF NEW BRUNSWICK** (the “Assignee”) whose address is P.O. Box 4400, Fredericton, New Brunswick, E3B 5A3, Canada and its successors, assigns and legal representatives, the entire right, title and interest, for all countries in and to the inventions relating to the

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ (Title of Invention)

described in the \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ (e.g., Invention Disclosure Form or Patent Application, etc.) dated \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ (date) and to any invention(s) and improvement(s) set forth in said \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ (e.g., Invention Disclosure Form or Patent Application, etc.), and any and all applications, continuations, continuations-in-part, divisionals, and renewals of and substitutes for Letters Patent for said invention(s) and improvement(s), and all the rights and privileges under any and all Letters Patent that may be granted therefor in any country, and any reissues, or reexaminations, or extensions of said Letters Patent. I request that any and all Letters Patent for said inventions and improvements be issued to said Assignee, its successors, assigns and legal representatives, or to such nominees as it may designate.

I agree that, when requested, I will, without charge to said Assignee, sign all papers, take all rightful oaths, and do all acts which may be necessary, desirable or convenient for securing and maintaining patents for said inventions in any and all countries and for vesting title thereto in said Assignee, its successors, assigns and legal representatives or nominees.

I authorize and empower said Assignee, its successors, assigns and legal representatives or nominees, to invoke and claim for any application for patent or other form of protection for said inventions and improvements filed by it or them, the benefit of the right of priority provided by the Patent Cooperation Treaty, the Paris Convention, and the International Convention for the Protection of Industrial Property, as amended, or by any convention which may henceforth be substituted for said treaties and conventions, and to invoke and claim such right of priority without further written or oral authorization from me.

I hereby consent that a copy of this assignment shall be deemed a full legal and formal equivalent of any assignment, consent to file or like document which may be required in any country for any purpose and more particularly in proof of the right of said Assignee or nominee to claim the aforesaid benefit of the right of priority provided by any international treaty or convention which may henceforth be substituted for it.

I covenant with said Assignee, its successors, assigns and legal representatives, that the rights and property herein conveyed are free and clear of any encumbrance, and that I have full right to convey the same as herein expressed.

IN WITNESS WHEREOF, I have hereunto signed my name on the day and year set forth below.

|  |  |  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- | --- | --- |
| EXECUTED at | |  | this |  | day of |  | 20\_\_ |
|  | | *(City and Country)* |  | *(Day)* |  | *(Month)* |  |
|  | |  |  |  |  |  |  |
|  | |  |  |  |  |  |  |
| Witness: | |  |  | \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_  Inventor’s Name | | | |
|  | Signature | |  |  |  |  |  |
|  | Name | |  |  |  |  |  |
|  | Date | |  |  | | | |