

INTELLECTUAL PROPERTY TRANSFER AGREEMENT
(DALHOUSIE SPINOFF)

THIS AGREEMENT (this “**Agreement**”) effective from the **DAY** day of **MONTH and YEAR** (the “**Effective Date**”).

BETWEEN:

DALHOUSIE UNIVERSITY, a university existing under the laws of the Province of Nova Scotia, (hereinafter “**Dalhousie**”)

-AND-

INVENTORS, (hereinafter collectively referred to as the “**Inventors**”, and, together with Dalhousie, the “**Parties**”)

BACKGROUND

- A.** Office of Commercialization & Industry Engagement at Dalhousie (“**OCIE**”), acting on behalf of Dalhousie, is experienced in the protection and commercialization of intellectual property resulting from university and other public sector research programs.
- B.** A “**Dalhousie Spinoff**” is a company formed to commercialize and exploit technology inventions derived from research conducted by Dalhousie academics, researchers and/or students.
- C.** As part of its mandate, OCIE provides a suite of Services (defined below) in the interests of increasing the number of Dalhousie Spinoffs.
- D.** The Inventors have expressed an interest in starting, or have already started, a Dalhousie Spinoff with the intention of commercializing technology inventions from research conducted at Dalhousie.
- E.** The Inventors have disclosed to OCIE a technology entitled “**TECHNOLOGY**” which is more particularly described in the attached Schedule “A” (the “**Technology**”) and which may be protected under patent, copyright, industrial design or other intellectual property law.
- F.** OCIE has consulted with the Inventors and is willing to provide the Services to effect the Protection (defined below) of the Intellectual Property (defined below) so as to assist the Inventors in their efforts to commercialize the Technology.
- G.** The Inventors acknowledge that in order for OCIE to perform the Services, it is necessary for the Inventors to assign all right, title and interest in the Intellectual Property to OCIE, subject to the provisions of this Agreement.

- H. The Parties acknowledge that the support of Dalhousie in the promotion of Dalhousie Spinoffs, and the Inventors' obligations to Dalhousie under this Agreement represent the Parties' joint obligations to pay it forward for the benefit of the entrepreneurial ecosystem and the greater public good.
- I. If the Inventors determine not to pursue the commercialization of the Intellectual Property through a Dalhousie Spinoff, the Parties may, but are not required to, terminate this Agreement and enter into a subsequent agreement to pursue commercialization of the Intellectual Property.

IN CONSIDERATION of the mutual covenants herein contained, and other good and valuable consideration (the sufficiency of which is hereby acknowledged), Dalhousie and the Inventors agree as follows:

1. Definitions. In this Agreement:

- a) **"Direct Costs"** means all direct and out of pocket expenses incurred by Dalhousie in connection with its performance of the Services in the Protection of the Intellectual Property not reimbursed by a third party. For greater certainty, Direct Costs shall not include the salaries of Dalhousie employees involved in the management of the Intellectual Property;
- b) **"Improvements"** means all improvements, developments or enhancements of the Technology or the Intellectual Property and any derivative works made in the field of the Intellectual Property, whether or not patentable;
- c) **"Intellectual Property"** means all rights in and to the Technology and any Improvements assigned to Dalhousie pursuant to this Agreement, including any of the following associated with the Technology:
 - i. a new, useful and non-obvious discovery, art, process, method, machine, manufacture or composition of matter or any improvements thereon, whether or not patentable, together with any and all materials, knowledge, know-how and techniques developed, invented or created relating thereto;
 - ii. an original literary, dramatic, musical or artistic work, or other work protected by copyright, including computer software;
 - iii. a feature of shape configuration, pattern or ornament design capable of registration under legislation regarding industrial design;
 - iv. a word, design or other symbol which can be protected under legislation regarding trademarks;
 - v. any other intellectual or industrial property right, trade secret or confidential information which is disclosed in, related to, and/or by necessary inference is included in the Technology;

- d) “**Protection**” means any and all necessary steps to protect the Intellectual Property from use, sale, manufacture or other exploitation by third parties, including patent applications, copyright registrations, trade mark and trade name applications, industrial design applications, applications to protect integrated circuit topography, and may include entering into option, non-disclosure and proprietary right agreements; and

2. Interpretation. In this Agreement, unless the context otherwise requires:

- a) any use of the word “including” shall be deemed and interpreted to mean “including without limitation”;
- b) any use of the singular or plural shall be interpreted to include the other case as may be required and any use of words importing female persons include male persons and words importing male persons include female persons as may be required;
- c) words or phrases appearing in this Agreement with capitalised initial letters are defined terms and have the meanings given to them in this Agreement;
- d) a reference to any document, including this Agreement, includes a reference to that document as amended or replaced from time to time;
- e) headings appear as a matter of convenience and do not affect the construction of this Agreement; and
- f) a reference to a party to this Agreement or any other document includes that party's personal representatives, successors and permitted assigns.

3. Services.

- a) The Inventors hereby engage OCIE, and OCIE hereby accepts such engagement, to provide the following services (the “**Services**”) in accordance with the terms and conditions of this Agreement:
- i. performing prior art searches relating to the Technology;
- ii. assessing inventorship and patentability of the Technology;
- iii. consulting with the Inventors with respect to the appropriate form of Protection for the Technology;
- iv. assisting the Inventors with applying for funding from Springboard Atlantic for patent costs, market assessments, and proof of concept, as applicable;
- v. assisting the Inventors with applying for funding from various sources, including but not limited to ACOA, NSERC i2i, and CABHI, by developing knowledge mobilization and commercialization strategies for such funding applications; and
- vi. upon assignment of the Technology to Dalhousie, the filing and prosecution of patents relating to the Technology, if applicable.

- b) In performing the Services, Dalhousie agrees:
- i. to pay, or arrange for payment of, all costs reasonably required for the Protection of the Intellectual Property which Dalhousie, in its sole judgment, deems necessary or desirable using reasonable commercial efforts, including all costs for preparing and maintaining all patent, trademark or industrial design applications and registering all copyrights;
 - ii. not to permit any application or registration related to the Intellectual Property to become irrevocably abandoned, other than by way of final rejection by the appropriate office from which there is no further appeal within that office, without informing the Inventors and affording them at least thirty (30) days to assume responsibility for continued prosecution and/or maintenance of the application or registration at their expense;
 - iii. not to assign the Intellectual Property in the Technology or any Improvements assigned to it by the Inventors to any third party for any reason whatsoever; and
 - iv. to regularly update and communicate with the Inventors as to the performance of the Services and the status of the Protection.

4. Representations. The Inventors jointly and severally acknowledge, represent and warrant that, to the best of their knowledge and belief:

- a) they are the only creators and owners of the Intellectual Property;
- b) they have not disclosed the Technology to any third party, except as discussed with the OCIE;
- c) they have not assigned the Intellectual Property to a corporation whether or not they are shareholders in such corporation;
- d) they have full and complete rights to the Intellectual Property;
- e) the Intellectual Property does not infringe on any proprietary rights of any third party; and
- f) there are no outstanding licenses or other agreements which are inconsistent with any of the terms and conditions hereof.

5. Assignment. Subject to the right of reassignment of the Intellectual Property by Dalhousie to the Inventors pursuant to Section 12 below, the Inventors hereby assign all of their right, title, and interest in and to the Intellectual Property to Dalhousie on the terms and conditions set forth in this Agreement. To that end, and as further evidence thereof, the Inventors shall, concurrent with the execution and delivery of this Agreement, execute and deliver to Dalhousie a deed of assignment in the form of Schedule “B” attached hereto, with such amendments as the Parties may agree.

6. Reservation Of Rights. Notwithstanding the assignment contemplated in Section 5 above,

each of the Inventors expressly reserves an exclusive and royalty-free right to use the Intellectual Property and assigned Improvements to create further improvements, explore marketability, and for educational and research purposes at Dalhousie, subject to publication and non-disclosure limitations described in Subsections 7(e), (f) and (g) below. The Inventors acknowledge and agree that any use of the Intellectual Property or assigned Improvements for educational or research purposes other than at Dalhousie will require a non-exclusive and royalty-free research license from Dalhousie.

7. Further Assistance. The Inventors further agree to:

- a) provide any necessary technical aid, guidance and assistance to Dalhousie, through OCIE, in activities related to the Protection of the Intellectual Property;
- b) ensure that written descriptions and patent or other filings related to the Intellectual Property are accurate;
- c) keep Dalhousie, through OCIE, reasonably informed about any Improvements, by providing a written disclosure of the particulars of Improvements to OCIE, and if requested by OCIE, assign the Intellectual Property rights in any such Improvements to Dalhousie;
- d) execute all necessary instruments and documents, at the expense of Dalhousie, reasonably necessary to perfect Dalhousie's title in and to the Intellectual Property and any patent or other applications, reissues, divisions, continuations, or continuations-in-part thereof arising from the Intellectual Property;
- e) provide OCIE with copies of any proposed articles, presentations (whether oral or written) or any other form of public disclosure relating to the Intellectual Property at least thirty (30) days in advance of the intended submission for publication or presentation to give Dalhousie the opportunity to review the proposed publication or presentation for patentable subject matter;
- f) if requested by OCIE, delay any publication or presentation referred to in the preceding paragraph for a reasonable period of time, which the Parties shall endeavour to not exceed sixty (60) days (or a longer period agreed upon by the Parties), to permit the Protection of any patentable subject matter which might be disclosed by the proposed publication or presentation;
- g) not disclose information related to the Intellectual Property to any third party unless it has been previously disclosed to the public through a presentation or publication reviewed by OCIE pursuant to subsections (e) and (f) above, or unless such third party has executed a confidentiality agreement in a form approved by Dalhousie;
- h) take such other steps or actions as may be reasonably required by Dalhousie for the Protection of the Intellectual Property; and
- i) promptly inform Dalhousie in writing of any change in the address specified in Section 16.

- 8. Records.** Dalhousie shall maintain accurate records of all Direct Costs and shall notify the Inventors of the Direct Costs as they become incurred. Upon termination of this Agreement, Dalhousie shall provide the Inventors with a final accounting of all Direct Costs.
- 9. Relationship Of The Parties.** The relationship formed by this Agreement between Dalhousie and the Inventors is that of independent contractors, and, for greater certainty, is not a partnership agreement or a joint venture agreement.
- 10. Term.** This Agreement shall be effective as of the Effective Date and shall continue in force until it is terminated by either Party with thirty (30) days' written notice to the other in accordance with Section 16 below.
- 11. Termination.** This Agreement may be terminated prior to its expiry:
- a) by the Inventors, by providing Dalhousie with thirty (30) days' prior written notice of termination, signed by all of the Inventors, and by providing the following to Dalhousie:
 - i. payment of any and all Direct Costs incurred up until the date the Technology is returned to the Inventors;
 - ii. 2% equity in any start-up company owned, in whole or in part, by the Inventors which produces, markets or sells the Technology at any time after the Effective Date;
 - iii. a non-binding undertaking, signed by the Inventors, to pay it forward to support Dalhousie's innovation, commercialization and entrepreneurship programming financially or in kind in the future.
 - b) by Dalhousie:
 - i. by providing the Inventors with thirty (30) days' prior written notice of termination, if Dalhousie, in its sole discretion, determines that Dalhousie can no longer add value to the Technology; or
 - ii. without notice in the event of breach of this Agreement or a material misrepresentation by any of the Inventors.
 - c) at any time, with the written agreement of all Parties.
- 12. Effect Of Termination.** In the event this Agreement is terminated by either Party for any reason whatsoever, Dalhousie's right, title and interest in the Intellectual Property and any Improvements shall automatically be reassigned and revert to the Inventors and the Parties agree to sign all necessary documentation and perform all acts required to be done to effect the reassignment of the Intellectual Property to the Inventors.
- 13. Personal Information.** The Inventors hereby consent to Dalhousie collecting, using and disclosing to patent agents and government patent offices, both within Canada and outside of Canada, personal information about the Inventors which is reasonably necessary for the purposes of performing the Services and obtaining and maintaining Intellectual Property Protection, including the Inventors' names, residential addresses and citizenship.

- 14. Dispute Resolution.** Should any dispute or difference arise between the Inventors and Dalhousie either during the term of this Agreement or after termination of this Agreement as to any matter arising out of or as a result of this Agreement, except to the extent that an equitable remedy is sought or circumstances clearly indicate that the time required for the process set forth in this Section would cause irreparable harm to a Party, either Party shall first give to the other Party notice in writing of such dispute or difference and, at the expiration of fifteen (15) days, unless it shall have been settled, such dispute or difference shall be referred to the Inventors and AVP, Industry Relations or their designate for resolution. If within an additional fifteen (15) days, such dispute shall not have been settled, then the matter shall be referred to the Inventors and Dalhousie's VP Research and Innovation or their delegates for resolution. Each Party shall then negotiate in good faith to attempt to resolve such dispute and both Parties agree to spend at least four (4) hours in face-to-face negotiations on at least two (2) separate occasions, the location being selected by each Party at least once. Should these negotiations fail, the Parties are free to attempt any other mutually agreeable types of alternative dispute resolution, such as mediation or arbitration, or either Party may bring the dispute to an appropriate trial court in Nova Scotia, where the Party not filing the suit will agree to subject matter jurisdiction and declare there is a case or controversy in order to facilitate the trial court's taking, hearing and deciding the case.
- 15. Surviving Clause.** Notwithstanding the termination or expiration of this Agreement, the rights and obligations in Sections 11, 12 and 14 will survive and continue to bind the Parties and their heirs, legal representatives, successors and permitted assigns.
- 16. Communication.** Any notice or communication required or permitted to be given by the Parties to this Agreement shall be deemed sufficiently given or made, if the notice or communication is couriered or mailed by registered mail, return receipt requested, or faxed (in the case of a notice or communication) and addressed to the Party to whom notice is given as follows:

If to Dalhousie, to:

Dalhousie University
Office of Commercialization & Industry Engagement
1344 Summer Street, Suite 207
PO Box 15000
Halifax, NS
B3H 4R2

902-494-5189 (fax)
Attention: Stephen Hartlen, Assistant Vice-President, Industry Relations

If to the Inventors, to:

Institution
Street Address
Halifax, NS
Postal Code

Fax
Attention:

17. **Assignment.** This Agreement may not be assigned by the Inventors or Dalhousie without prior written consent, which consent shall not be unreasonably withheld. Notwithstanding the foregoing, Dalhousie may assign this Agreement to any entity that it controls without the consent of the Inventors but Dalhousie shall give notice of such assignment to the Inventors.
18. **Waiver.** A failure by one of the Parties to assert its rights for or upon any breach or default of this Agreement shall not be deemed a waiver of such rights nor shall any such waiver be implied from acceptance of any payment. No such failure or waiver in writing by any one of the Parties hereto with respect to any rights shall extend to or affect any subsequent breach or impair any right consequent thereon.
19. **Severability.** The Parties agree that it is the intention of neither Party to violate any public policy, statutory or common laws, any governmental or supranational regulations and that if any sentence, paragraph, clause or combination of the same is in violation of any applicable law or regulation, or is unenforceable or void for any reason whatsoever, such sentence, paragraph, clause or combinations of the same shall be deemed to be severed from this Agreement and the remainder of the Agreement shall remain binding upon the Parties.
20. **Binding On Parties.** This Agreement shall enure to and be binding upon the Parties, their personal representatives, successors and permitted assigns.
21. **Governing Law.** This Agreement shall be governed by the laws of the Province of Nova Scotia and the laws of Canada applicable therein. The Parties attorn to the jurisdiction and venue of the courts of Nova Scotia in respect of any matter relating to this Agreement.

[signature page follows]

IN WITNESS WHEREOF the Parties have properly executed this Agreement as of the Effective Date.

DALHOUSIE UNIVERSITY

WITNESS

Per: _____
Dr. Alice Aiken
Vice-President, Research & Innovation

Per: _____
Name: _____

Date: _____ Date: _____

INVENTOR(S)

INVENTOR

WITNESS:

Per: _____
Name: _____
Title: _____

Per: _____
Name: _____

Date: _____ Date: _____

INVENTOR

WITNESS:

Per: _____
Name: _____
Title: _____

Per: _____
Name: _____

Date: _____ Date: _____

**SCHEDULE A
DESCRIPTION OF TECHNOLOGY**

The subject technology is described in Dalhousie disclosure #FILE NUMBER. A summary of the technology is provided below.

provide completed OCIE Invention Disclosure form here:

SAMPLE

SCHEDULE B**ASSIGNMENT OF INVENTIONS**

by:

[INVENTORS NAMES](hereinafter collectively referred to as the “**Inventors**”)

in favour of

DALHOUSIE UNIVERSITY (“Assignee”)**WHEREAS:**

- A. The Inventor(s), the full postal address of whose principal office or place of business is **ADDRESS**, is the owner of certain inventions and patents as listed at Appendix “A” to this Assignment;
- B. The Assignee, the full postal address of whose principal office or place of business is 6299 South Street, Halifax, NS B3H 4R2, has acquired from Inventors the whole right, title and interest in the inventions and patents as listed at Appendix “A”;

FOR GOOD AND VALUABLE consideration the receipt and sufficiency of which is hereby acknowledged by all Inventor(s):

Inventor hereby confirms that Inventor does hereby sell, assign and transfer to Assignee throughout the world, all right, title and interest in and to the inventions and patents as listed at **Appendix A** (collectively the “**Inventions**”), including all rights to all patent applications and all related applications and patents thereon, the right to claim priority to the applications and to all related applications and patents thereon, all to be held and enjoyed by Assignee, its successors and assigns, as fully and entirely as the same would have been held and enjoyed by Inventor, had this Assignment not been made.

IN WITNESS WHEREOF, the Inventor(s) **has/have** duly executed this Assignment under the hand of its officer duly authorized on its behalf effective this **DD** day of **MONTH YEAR**.

INVENTOR(S)

Witness

Name:_____
Name:_____
Date:_____
Date:

APPENDIX A

<u>DALHOUSIE File #</u>	<u>Inventor(s)</u>	<u>Description</u>	<u>Patent #</u>

SAMPLE