

INTELLECTUAL PROPERTY TRANSFER AGREEMENT

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**”) is experienced in the protection and commercialization of intellectual property resulting from university and other public sector research programs.
- B.** 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 legislation, and which the Inventors wish to have commercialized through Dalhousie.
- C.** Dalhousie is willing to assist in the Protection (defined below) and Commercialization (defined below) of the Intellectual Property (defined below) so that public utilization will result.
- D.** Recognizing that Dalhousie will be undertaking financial risk by expending funds and resources for the Protection and Commercialization of the Intellectual Property and in recognition of the financial and other support which Dalhousie provided during the creation, investigation and/or development of the Intellectual Property, the Parties agree to equitably share the benefits and revenues resulting from the Protection and Commercialization of the Intellectual Property.
- E.** As a condition of Dalhousie agreeing to undertake the Protection and Commercialization of the Intellectual Property as described in this Agreement, Dalhousie has requested and the Inventors have agreed to assign all of their right, title and interest in the Intellectual Property to Dalhousie.

AGREEMENT

Dalhousie and the Inventors agree as follows:

1. **Definitions.** In this Agreement:

- a) “**Commercialization**” means all of the activities undertaken by Dalhousie in order to make the Technology available to the public and to derive revenues, equity or other property and benefits by transferring the Intellectual Property to one or more third Parties by licensing, sale or assignment or such other means as may be appropriate, including, without limiting the generality of the foregoing, licensing to a third party, creating a new company or forming a joint venture company with a strategic partner to exploit the Intellectual Property;
- b) “**Direct Costs**” means all direct and out of pocket expenses incurred by Dalhousie in connection with the Protection and Commercialization 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;
- c) “**Gross Revenues**” means revenue, cash or in kind, actually received by Dalhousie in consideration of the Commercialization of the Intellectual Property under this Agreement;
- d) “**GST**” or “**HST**” means the tax exigible pursuant to Part IX of the *Excise Tax Act* (Canada), including, for greater certainty, the taxes commonly referred to as the goods and services tax and the harmonized sales tax;
- e) “**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;
- f) “**Intellectual Property**” means all rights in and to the Technology, 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;

together with any Improvements assigned to Dalhousie under the terms of this Agreement;

- g) **“Net Proceeds”** means Gross Revenues, less all Direct Costs; and
- h) **“Protection”** means any and all necessary steps to protect the Intellectual Property from use, sale, manufacture or other exploitation by unrelated 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
- i) **“Taxes”** shall have the meaning ascribed thereto in Section 11(b).

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. 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 full and complete rights to the Intellectual Property;
- c) the Intellectual Property does not infringe on any proprietary rights of any third party; and
- d) there are no outstanding licenses or other agreements which are inconsistent with any of the terms and conditions hereof.

4. Assignment. 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.

The Inventors further agree that all Improvements shall be disclosed to OCIE, and, upon the written request from OCIE, assigned to Dalhousie.

- 5. Reservation Of Rights.** Notwithstanding the assignment in Section 4, each of the Inventors expressly reserves a non-exclusive and royalty-free right to use the Intellectual Property and assigned Improvements for educational and research purposes at Dalhousie, subject to publication and non-disclosure limitations described in subsections 6(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.
- 6. Further Assistance.** The Inventors further agree to:
- a) provide any necessary technical aid, guidance and assistance to Dalhousie in activities related to the Protection and Commercialization 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;
 - d) execute all necessary papers, 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 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.

- 7. Protection.** Dalhousie agrees 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, including all costs for preparing and maintaining all patent, trade-mark or industrial design applications and registering all copyrights. Dalhousie shall not 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.
- 8. Commercialization.** Dalhousie shall exercise such efforts as are reasonable in the circumstances for the Commercialization of the Intellectual Property in a manner which, in its sole judgment, is most likely to generate the maximum advantage for all Parties concerned. Dalhousie shall endeavour to involve the Inventors in the Commercialization of the Intellectual Property if they so wish.
- 9. Records.** Dalhousie shall maintain accurate records of all Gross Revenues and Direct Costs and shall be entitled to deduct Direct Costs from the Gross Revenues received from Commercialization of the Intellectual Property before the distribution of any Net Proceeds in accordance with this Agreement.
- 10. Distribution Of Net Proceeds.** Dalhousie shall provide the Inventors with an annual report regarding its Protection and Commercialization efforts and the Gross Revenues received, Direct Costs incurred and Net Proceeds in connection with the Intellectual Property during each fiscal year of Dalhousie. Dalhousie shall retain 50% of the Net Proceeds for each such fiscal year and shall pay 50% of the Net Proceeds for each such fiscal year, within 6 months of the end of such fiscal year, to Inventors and, at the direction of the Inventors, to such other individuals with whom the Inventors wish to share the Net Proceeds, in accordance with Schedule "B".

The Inventors may modify Schedule "B" at any time upon delivery to Dalhousie of written notice, signed by all of the Inventors, but such amended Schedule "B" shall not be binding on Dalhousie unless received at least 60 days prior to the next distribution of Net Proceeds.

11. Taxes.

- a) The relationship formed by this Agreement between Dalhousie and the Inventors is that of independent contractors, and, for greater certainty, is not an employment agreement, a partnership agreement or a joint venture agreement.
- b) All amounts paid to the Inventors pursuant to this Agreement (or to any other person at the direction of the Inventors as provided for in Section 10 hereof) shall be inclusive of all applicable federal, provincial and municipal sales taxes, GST, HST, excise taxes and all other taxes (other than income taxes of Dalhousie), duties and other like charges properly payable upon and in connection with the conveyance and transfer of the Intellectual Property to Dalhousie (collectively, all such taxes are referred to herein as "Taxes"). All Taxes shall be paid and remitted in accordance with applicable laws.
- c) If at any time an Inventor is registered for, or is required to register for, GST or HST

purposes, and is required to collect and remit GST or HST (which amount is included in the Net Proceeds payable to such Inventor pursuant to Section 11(b) hereof) with respect to the Inventor's share of the Net Proceeds payable to such Inventor, the Inventor shall at such time provide Dalhousie with an invoice, which shall include the Inventor's GST/HST number, or such other documentary information as may reasonably be required by Dalhousie to enable it to claim an input tax credit or rebate of any such applicable GST or HST. Dalhousie shall not be required to pay Net Proceeds to such Inventor (or to another person at the direction of such Inventor) until such invoice or other documentary information is provided to Dalhousie.

- d) Any amounts paid to a person (other than the Inventors) at the direction of the Inventors pursuant to Section 10 hereof shall be deemed to have been paid to the Inventor or Inventors making the direction, and such Inventor or Inventors, together with such person, shall be responsible for any GST, HST, income tax, Canada Pension Plan, Employment Insurance, and any withholding thereof, or any other taxes or Taxes applicable to any such payments to such person.
- e) Each of the Inventors shall be responsible for the reporting, remittance and payment of any and all Taxes (including, for greater certainty, GST, HST and income taxes) on their share of the Net Proceeds under the terms of this Agreement (including any amounts paid to another person out of their share at the direction of the Inventors pursuant to Section 10 hereof). Each Inventor shall be responsible to pay any such Taxes from their share of the Net Proceeds.

12. Term. This Agreement shall be effective as of the Effective Date and shall continue in force until the later of (a) the last to expire patent arising from the Intellectual Property, or (b) for as long as Dalhousie is entitled to receive Gross Revenues, unless earlier terminated in accordance with Section 13 below.

13. Termination. This Agreement may be terminated prior to its expiry:

- a) by the Inventors providing Dalhousie with written notice of termination, signed by all of the Inventors:
 - i. at any time after five (5) years from the Effective Date in the event that Dalhousie has not entered into a Commercialization agreement; or
 - ii. at any time in the event that Dalhousie does not pay Net Proceeds due and payable hereunder, provided that Dalhousie shall have a sixty (60) day period following receipt of such notice of termination in which to pay the Inventors all such unpaid Net Proceeds. Upon the expiration of the sixty (60) day period, if Dalhousie shall not have paid all such Net Proceeds, the rights and privileges granted hereunder shall automatically terminate.
- b) by Dalhousie by providing the Inventors with a written notice of termination:
 - i. at any time after one (1) year from the Effective Date, upon 30 days' notice of termination to Inventors, if Dalhousie is of the opinion that there is not a reasonable expectation that Gross Revenues will be received through Commercialization; or

- ii. at any time in the event of breach of this Agreement or a material misrepresentation by any of the Inventors.
- iii. at any time, with the written agreement of all Parties.

Except as otherwise specified above, any notice of termination issued by one of the Parties under this Section must be received by the other party at least ninety (90) days prior to the proposed date of termination.

14. Effect Of Termination. In the event this Agreement is terminated in accordance with the terms of Section 13:

- a) any Net Proceeds held or received by Dalhousie shall be distributed according to the terms of this Agreement;
- b) all of Dalhousie's right, title and interest in the Intellectual Property shall revert to the Inventors unless they have previously been granted to a third party in accordance herewith.

15. 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 inventor's which is reasonably necessary for the purposes of obtaining and maintaining Intellectual Property protection, including inventor's name, residential address and citizenship.

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, and any payment obligation of Dalhousie shall be deemed satisfied if the notice, communication or payment 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"
THE TECHNOLOGY**

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

<provide a brief description of the technology being assigned>

SAMPLE

**SCHEDULE "B"
DIVISION OF REVENUES**

<Include all Inventors by Name: 50% total distributed>

Dalhousie University: 50% - Commercialization Partner

SAMPLE