

## ASSIGNMENT AGREEMENT

THIS ASSIGNMENT AGREEMENT is made effective as of [MONTH] [DAY], 200\_\_ (the “**Effective Date**”) between:

**University of Saskatchewan**, a statutory corporation pursuant to *The University of Saskatchewan Act, 1995*, of Saskatchewan, having an office for the conduct of its business located at Box 5000 RPO University, Suite 501-121 Research Drive, Saskatoon, Saskatchewan S7N 1K2 (the “**University**”); and

**UofS Employee Assignor (Use FULL Name)**, an individual resident at Street Address, City, Province/State Postal/Zip Code (the “**Assignor**”).

each said party being referred to hereinafter as a “**Party**”; the collectivity of both said parties being referred to hereinafter as the “**Parties**.”

WHEREAS:

A. The Assignor, being an employee of the University did, in the course of his or her said employment and/or through the use of University Resources (as hereinafter defined) conceive, develop, discover and/or invent subject matter related to **TITLE OF INVENTION or SUBJECT MATTER OF ASSIGNMENT** (hereinafter the “**Invention**”) as described and set forth in the following:

(a) document entitled “Title of Document (e.g., “Report of Invention”)” (ROI # 0x-xxx) appended as Schedule “A” hereto;

(b) document entitled “Title of Document (e.g., “Title of Manuscript”)” appended as Schedule “B” hereto;

(c) document entitled “Title of Document (e.g., “Title of Other Document”)” appended as Schedule “C” hereto;

(d) Instrument                      e.g., United States Provisional Patent Application  
Filed:                                  Filing Date  
Application Number:              Application #  
Priority Date:                        Priority Date  
Title:                                  Title of United States Provisional Patent Application  
Inventor:                              Full name of inventor

which instrument is appended as Schedule “X” hereto;

(e) Instrument                      e.g., Canadian Patent Application  
Filed:                                  Filing Date  
Priority Date:                        Priority Date  
Title:                                  Title of Canadian Patent Application  
Inventor:                              Full names of inventor

which instrument is appended as Schedule “Y” hereto;

(f) Instrument                      e.g., Assignment – Complete Title of Assignment Agreement  
Effective Date:                      Effective Date of Assignment Agreement  
Assignor:                              Full Name(s) of assignor  
Assignee                              Full Name(s) of assignee

which instrument is appended as Schedule “Z” hereto;

(g) each and every patent application filed in any jurisdiction of the world in the name of the Assignor claiming an invention described or disclosed in the foregoing;

(h) any and all substitutes, divisions, continuations, and continuations-in-part of each and every patent application among the foregoing, each and every patent issued therefrom, each and every reissue of said patent, and all other registrations or proceedings of any description, including patent applications and patents, that may provide for the protection of rights in and to the foregoing for the benefit of the holder thereof anywhere in the world.

B. The Assignor desires to absolutely and irrevocably assign, transfer and convey to the University, and the University desires to obtain from the Assignor, the entirety of the Assignor’s right, title and interest in and to the Invention so that the University may Commercialize (as hereinafter defined) the Invention and tangible embodiments thereof.

- C. Pursuant to the terms of the Invention Agreement (as hereinafter defined), the Assignor agreed to assign to the University all of his or her right, title and interest in and to the Invention as consideration for a right to participate equitably, with other persons who may have, jointly with the Assignor, conceived, developed, discovered and/or invented the Invention, in fifty percent (50%) of all Net Consideration that the University receives from Technology Transfer activities undertaken by the University in respect of the Invention.

NOW THEREFORE, in consideration of the premises, payments and mutual promises hereinafter described, the receipt and sufficiency of which is hereby acknowledged, the Parties agree as follows:

## 1. INTERPRETATION

1.1 The recitals to this Agreement are hereby incorporated into and comprise an integral part hereof.

1.2 In this Agreement certain words and terms shall have meanings as follows:

- (a) “**Commercialization**” means, realizing and attempting to realize monetary and/or other commercial value from the Invention and activities related thereto including, without limiting the generality of the foregoing, marketing, protecting rights, interests and entitlements by preparing, filing and prosecuting applications for statutory protection, issuing, causing to be issued and maintaining grants and registrations of intellectual property, funding reduction-to-practice and development of prototypes, Technology Transfer, creating companies and providing management services and advice to such companies, advising interested parties, and otherwise protecting and/or exploiting interests in the Invention.
- (b) “**Disbursements**” means money actually expended by the University is to assist Commercialization and amounts of money deemed the same under the MOA re Inventions, but Disbursements do not include any amounts which would be expended whether or not a specific Commercialization activity commences or occurs including, but not limited to, overhead charges, pre-existing salaries and wages, rent (except where incurred for the sole purpose of a specific Commercialization activity), utilities or any other indirect costs.
- (c) “**Invention Agreement**” means and includes the MOA re Inventions, any other entitlement of the University arising at law or in equity or pursuant to University policy and giving the University a right to claim an ownership interest in an invention such as and including the Invention hereof and that policy of the University preferring that each individual who is an employee of or student at the University or who uses University Resources to conceive, develop, discover and/or invent subject matter such as the Invention hereof should participate equitably with other inventors of the same subject matter in fifty percent (50%) of all Net Consideration that the University receives from Technology Transfer activities undertaken by the University in respect of the Invention.
- (d) “**MOA re Inventions**” means any memorandum of agreement and any other agreement made between the Assignor and the University giving the University a right to claim an ownership interest in an invention such as and including the Invention.
- (e) “**Net Consideration**” means gross consideration received by the University from Technology Transfer activities less Disbursements. Net consideration does not include securities in corporations such as shareholdings but does include cash proceeds of sale of such securities. Notwithstanding the foregoing, Net Consideration does not include revenue received by the University as compensation for the delivery of research services or in aid of research or scholarly activity in accordance with usual practices or any overhead component of such compensation to the extent that such overhead is usually charged to purchasers or sponsors of research or scholarly activity.
- (f) “**Technology Transfer**” means assigning, selling, licensing, or otherwise transferring from the University to a third party: (i) rights, title, or interests in or to the Invention; and/or (ii) materials, wares, or services the making or delivery of which requires the exercise of rights in or to the Invention.
- (g) “**University Resources**” means and includes resources owned, administered, or controlled by the University including, premises, equipment, other facilities, University-employee- (including Assignor) and University-student time, effort and assistance, funds, including gifts, grants and contractually allocated funds received or accessed through the University, and other resources.

1.2 The division of this Agreement into articles and clauses and the insertion of headings and numeration of articles and clauses is for convenience of reference only and shall not affect the interpretation or construction of this Agreement.

- 1.3 In this Agreement, where the context requires or permits, words importing the plural shall include the singular and vice versa, the words "person" and "persons" shall include corporations, partnerships and all other entities of whatever nature and description, and all references to a clause or article shall be a reference to the appropriate clause or article of this Agreement unless specifically stated otherwise.
- 1.4 Except as expressly stated otherwise herein, this Agreement constitutes the entire agreement between the Parties pertaining to the subject matter hereof. This Agreement may not be amended or modified except by written agreement executed by the Parties.
- 1.5 This Agreement shall be interpreted in accordance with the laws of Saskatchewan and the laws of Canada applicable therein. Subject to any alternative dispute resolution means provided under the Invention Agreement all judicial proceedings taken respecting this Agreement shall be taken in the courts of Saskatchewan and the Parties irrevocably attorn to the jurisdiction of the courts of Saskatchewan.
- 1.6 Notwithstanding that this Agreement may be executed on different dates or in several counterparts each executed counterpart shall constitute an original and all such counterparts shall together constitute but one instrument.

## **2. ASSIGNMENT & CONSIDERATION FOR ASSIGNMENT**

- 2.1 The Assignor hereby absolutely and irrevocably sells, assigns, transfers and conveys to the University the entirety of his or her rights, title and interests arising at law or in equity in and to the Invention free of all liabilities and encumbrances of any description, the same to be held and enjoyed by the University for its own exclusive use and benefit and for the use and benefit of its successors and assigns to the full extent that same would have been held and enjoyed by the Assignor had this Agreement not been made and the University accepts such assignment.
- 2.2 The Assignor shall, at the request of the University and at the expense of the University, execute and deliver any and all further information, documents and instruments (including assignments, waivers and powers of attorney), provide assistance, and do all acts and things which the University may deem necessary or desirable in order to give effect to this Agreement, perfect, obtain or protect the rights, title, interests assigned hereby, and prepare, prosecute or maintain any application for statutory protection of the Invention or any part thereof.
- 2.3 In consideration of the assignment of the Invention from the Assignor to the University granted hereby and in accordance with the Invention Agreement the University agrees to pay to the Assignor, as the sole conceiver, developer, discover and/or inventor of the Invention, fifty percent (50%) of all Net Consideration that the University receives from Technology Transfer activities undertaken by and for the University in respect of the Invention.
- 2.4 The Parties acknowledge that that execution by the Assignor of further documents and instruments such as assignments, waivers and powers of attorney is likely and that expediency and the requirements of certain intellectual property-granting authorities may require or prefer that such documents and instruments do not recite all of the various obligations between or among the Parties. Therefore, it is agreed that, as between and among the Parties, notwithstanding such further documents and instruments, the obligation of the University to the Assignor under Section 2.3 herein above shall survive for the benefit of the Assignor until and unless specifically waived or disclaimed in a writing duly executed by or on behalf of the Assignor.

## **3. LIMITATION**

- 3.1 In the event of a breach of any of the provisions in this Agreement by the University, the Assignor hereby acknowledges and agrees that liquidated damages will be the sole and exclusive remedy available to the Assignor, and the Assignor hereby waives every other legal and equitable remedy he or she may otherwise have or be entitled to seek, including, without limitation, claims for specific performance, injunctive relief, rights of repudiatory breach, anticipatory breach, or rescission. The Assignor acknowledges that the covenants of this Agreement are reasonable and valid and all defences to the strict enforcement thereof by the University are hereby waived by the Assignor.

## **4. REPRESENTATIONS AND WARRANTIES**

- 4.1 The Assignor warrants that he or she was, during the entirety of the time period during which the

Invention was conceived, developed, discovered and/or invented, an employee of the University as stated in Recital A of this Agreement.

4.2 The Assignor warrants that:

- (a) he or she has all requisite power and authority to enter into this Agreement and to carry out the transactions contemplated hereby; and
- (b) subject to the University's interest under the Invention Agreement, the Assignor is the owner of the entire right, title and interest in and to the Invention and can transfer such right title and interest to the University in accordance with the other terms hereof free and clear of any liens, pledges, security interests or other encumbrances of any description.

4.3 The University represents that it will undertake reasonable efforts to Commercialize and maximize the potential of the Invention in accordance with the Invention Agreement.

4.4 The University acknowledges that nothing in this Agreement is or shall be construed as a representation or warranty of the Assignor, express or implied, as to the merchantability or fitness for a particular purpose of the Invention, or a representation or warranty that the Assignor shall bear liability in any amount or of any nature to the University arising from any loss or damage sustained directly or indirectly by the University, its governors, officers, employees, agents, or any third party, which loss or damage arises from use of the Invention or any tangible embodiment thereof by the University, any governor, officer, employee or agent of the University, or any third party.

## 5. INDEMNITY

5.1 The University shall indemnify, hold harmless and defend the Assignor from all claims arising directly or indirectly from the University's exercise of any right, title or interest acquired under this Agreement including use of the Invention or any tangible embodiment thereof, which obligation covers, without limitation, any loss or liability associated with death or other injury to a person or damage to property.

## 6. OTHER PROVISIONS

6.1 The Assignor shall not assign this Agreement or any right or obligation under this Agreement without the prior written consent of the University.

6.2 This Agreement shall enure to the benefit of and bind the Parties and their respective heirs, successors and permitted assigns.

6.3 Any notice, demand or writing required or permitted to be given under this Agreement by a Party to another Party may be hand delivered or given by letter sent by electronic facsimile transmission, commercial courier, or registered mail, postage prepaid, addressed to the recipient Party and as follows:

- (a) University      University of Saskatchewan, Industry Liaison Office  
                            Box 5000 RPO University, Suite 501-121 Research Drive  
                            Saskatoon, Saskatchewan S7N 1K2  
                            Facsimile: (306) 966-7806                              Attention: Managing Director
- (b) Assignor      (i) the address of the Assignor written on the first page of this Agreement; or  
                            (ii) Department of Name of Department  
                                University of Saskatchewan  
                                Name of Building, Street Address  
                                Saskatoon, Saskatchewan S7N #A#  
                                Facsimile: (306) 966-xxxx                              Attention: UofS Employee Assignor

If mailed such notice shall be deemed to have been given on the fifth (5<sup>th</sup>) business day after the date of posting and if delivered personally, by commercial courier, or electronic facsimile transmission, on first (1<sup>st</sup>) business day after the date of actual delivery. Any Party may change its address for service by giving advance notice in writing to the other Parties in accordance with the foregoing.

6.4 For the purposes of this Agreement, each Party acknowledges that it is an independent contractor and nothing in this Agreement shall, directly, indirectly or by implication, constitute a Party an agent of another of them.

IN WITNESS WHEREOF, the **University** has hereunto affixed its corporate seal attested to by the signatures of its duly authorised officers in that behalf given as of the Effective Date hereof.

THE UNIVERSITY OF SASKATCHEWAN

Per: \_\_\_\_\_  
for Chair, Board of Governors Date \_\_\_\_\_ (*"seal"*)

Per: \_\_\_\_\_  
for Secretary, Board of Governors Date \_\_\_\_\_

IN WITNESS WHEREOF the **Assignor** has set his or her and seal at Saskatoon, Saskatchewan as of the Effective Date hereof.

(*"seal"*)

\_\_\_\_\_  
Witness to the Assignor

\_\_\_\_\_  
Assignor, **UofS Employee Assignor**

\_\_\_\_\_  
Name of Witness (Print)

\_\_\_\_\_  
Date