

APPENDIX 10A

(University-led Commercialization)

BY AND BETWEEN:

CONCORDIA UNIVERSITY, a body corporate, duly constituted by Special Act of the National Assembly of Quebec, having its principal establishment located at 1455 de Maisonneuve Boulevard West, in the City and District of Montreal, Quebec, H3G 1M8, herein represented by the Director of the Office of Research;

Referred to as the “University”

AND

domiciled and residing at _____

domiciled and residing at _____

(together referred to as the “**Inventor**” and together with the University the “**parties**”)

WHEREAS the Inventor has produced an Invention entitled “ _____ ” (the “**Project Intellectual Property**”);

WHEREAS in accordance with Article 27.11 of the CUFA Collective Agreement, the Inventor has disclosed the Project Intellectual Property to the Office of Research by completing and signing a Declaration of Invention, (insert Concordia Reference File No. DOI 20XX-XX);

WHEREAS the Declaration of Invention has been received and signed by the Director of the Office of Research of Concordia on (insert date from page 8 of DOI);

WHEREAS in accordance with the provisions of Articles 27.14 and 27.15 of the CUFA Collective Agreement the Inventor wishes to seek the assistance of the University to evaluate, develop and Commercialize, where possible, their respective interest in the Project Intellectual Property and the parties wish to provide for:

- (i) the assignment of rights and/or licensing of the Project Intellectual Property and its development and marketing;
- (ii) the allocation and payment of expenses incurred in obtaining, maintaining and defending patent protection for the Project Intellectual Property; and
- (iii) the receipt and division of royalties, fees, equity interests, revenues and other consideration received or derived from the licensing, sale or other Commercialization of the Project Intellectual Property in proportion to their respective interests;

WHEREAS The Declaration of Invention as well as the present preamble form part of this Agreement (the “Agreement”);

WHEREAS the Effective Date (the “Effective Date”) of this Agreement shall be the date on which the last party signed;

NOW, THEREFORE, IN CONSIDERATION FOR THE MUTUAL COVENANTS, WARRANTIES AND FOR OTHER VALUABLE CONSIDERATION THE SUFFICIENCY OF WHICH THE PARTIES ACKNOWLEDGE, THE PARTIES AGREE TO THE FOLLOWING:

1. DEFINITIONS

All terms, unless otherwise defined herein, shall have the meaning assigned to them in the CUFA Collective Agreement.

CUFA Collective Agreement means the agreement entered into between the University and the Concordia University Faculty Association (CUFA) that is in effect as at the Effective Date.

Effective Date means the latest date on which a party to this Agreement has signed and all references to the Effective Date shall mean the date on which the last person to sign affixed his or her signature.

Inventor includes the plural and refers either to a single Inventor or more than one Co-Inventor.

Project Intellectual Property means the Invention and legal rights relating to the Invention described in this Agreement, and any patent applications, patents, copyrights,

trademarks, trade secrets, and any other legally protectable information, including computer software, which form part of the Invention or result from the Project Intellectual Property but that do not constitute a new and separate Invention.

2. PURPOSE OF THIS AGREEMENT

- 2.1 This Agreement applies only to matters relating to the Project Intellectual Property.
- 2.2 This Agreement governs the protection through patenting, copyright or other relevant applicable legislation regarding intellectual property, as well as the development and potential Commercialization of the Project Intellectual Property.

3. ASSIGNMENT

- 3.1 The Inventor hereby assigns to Concordia University all right, title and interest throughout the world in and to the Project Intellectual Property, as well as all corresponding right, title and interest in and to any patent which may be accorded with respect to the Project Intellectual Property, and to all divisions, reissues, continuations, continuations-in-part and extensions thereof.
- 3.2 The Inventor agrees that title to the Project Intellectual Property shall be held by and in the name of the University and that in order to Commercialize the Project Intellectual Property, the University has complete authority to apply for patents for and related to the Project Intellectual Property and the authority to take such other action as may be necessary or desirable to sell, assign, license or otherwise deal with the Project Intellectual Property.
- 3.3 The Inventor also agrees to sign and require all Co-Inventors to sign all documents, to execute all oaths and to do everything else possible to aid the University, its successors, assignees and nominees to obtain and enforce patent protection for the Project Intellectual Property.
- 3.4 The Inventor agrees that the University shall have control of the working, selling, assigning, or licensing or otherwise dealing with the Project Intellectual Property; however, the University shall consult with the Inventor and carefully consider any information or requests made to it concerning the Project Intellectual Property before proceeding with the working, selling, assigning or licensing to any third party.
- 3.5 Where the University has not initiated any reasonable action or has not diligently pursued the Commercialization of the Project Intellectual Property or has not taken any reasonable steps toward protection through patenting, through copyright, or under other relevant applicable legislation regarding intellectual property or toward Commercialization, within one (1) year of the Effective Date, the University shall be deemed to have abandoned its rights to the Project

Intellectual Property, and shall assign all right, title and interest in and to the Project Intellectual Property back to the Inventor and shall not claim any costs or disbursements from the Inventor.

- 3.6 Under the circumstances contemplated in section 3.5 of this Agreement, where the Inventor does proceed to the protection or the Commercialization of the Project Intellectual Property, the sharing of Net Proceeds shall be that set out in Articles 27.15(e), 27.18(b) and 27.19 of the CUFA Collective Agreement.

4. PROTECTION AND COMMERCIALIZATION OF THE PROJECT INTELLECTUAL PROPERTY

- 4.1 Upon the signing of this Agreement, the University shall make a preliminary evaluation of the commercial potential of the Project Intellectual Property and where that potential appears reasonable to the University, acting in its entire discretion, shall proceed to take whatever steps it deems appropriate for its protection and Commercialization.
- 4.2 Where the University determines, in its entire discretion, to Commercialize the Project Intellectual Property it will take reasonable measures to protect the said Project Intellectual Property. In pursuing Commercialization of the Project Intellectual Property, the University may have recourse to commercialization agents.
- 4.3 The Inventor shall be informed in writing by the University of all third-party interest in the Project Intellectual Property, and the Inventor agrees to respect and sign, where requested to do so by the University, any agreement with third parties relating to the protection and Commercialization of the Project Intellectual Property.
- 4.4 The Inventor shall be informed in writing by the University of any material development in any negotiations with third parties involved in the Commercialization of the Project Intellectual Property.
- 4.5 The Inventor hereby agrees to assist the University in Commercializing the Project Intellectual Property. Such efforts may include, but without limitation, the suggestion of names of potential licensees, the explanation and description of any technical aspects of the Project Intellectual Property which may be requested by the University to further discussions with any potential licensee or partner that may show interest in obtaining a licence or other rights to the Project Intellectual Property or for any other purpose which the University may consider will assist the Commercialization process. The Inventor further agrees to make himself/herself available to provide the assistance requested and to provide such written notes or other documentation as may be needed.

- 4.6 A copy of all agreements in final draft with any third party involved in the Commercialization of the Project Intellectual Property shall be provided to the Inventor ten (10) days prior to signature of any such agreement. All agreements with any third party shall be consistent with the rights of the University and the Inventor as set out in Article 27 of the CUFA Collective Agreement and this Agreement or, as the case may be, with the provisions of any grant, contract or other form of research support agreement through which the development of the Project Intellectual Property was funded either in whole or in part. The Inventor shall cooperate fully with the University by signing all lawful papers required to confirm or give full effect to any such agreement with third parties.
- 4.7 The Inventor understands clearly that although the University undertakes to use its best reasonable efforts to evaluate the commercial potential of the Project Intellectual Property it does not guarantee that it shall pursue protection through patenting, copyright or other relevant applicable legislation regarding intellectual property or Commercialization of the Project Intellectual Property nor that, if it does pursue such activities that such protection or Commercialization efforts will be successful.
- 4.8 The University agrees that the Inventor may use the Project Intellectual Property nonexclusively and without compensation in connection with research or grant applications or other development activities, including inclusion in project reports and any other applications for continued funding. However, the Inventor shall ensure that any use of the Project Intellectual Property for any purpose referred to in this paragraph or any similar purpose shall be protected by a confidentiality agreement drafted in accordance with the principles set out in section 7 of this Agreement.
- 4.9 The University agrees to keep accurate records and books of accounting in accordance with good accounting practice with respect to the Project Intellectual Property, including an account of all (i) costs and expenses incurred in obtaining, maintaining and defending patent protection for the Project Intellectual Property and (ii) all moneys or other consideration received by the University during the calendar year for which it is accounting and all other information necessary for the accurate determination of charges and payments hereunder. The University agrees to provide the Inventor with reports in accordance with the provisions of Article 27.19 of the CUFA Collective Agreement.

5. SHARING OF REVENUES

5.1 Subject to the terms of any third-party relationship established in accordance with section 4 hereto, where the University has at any time handled the protection and Commercialization activities relating to the Project Intellectual Property, all Net Proceeds related to the Commercialization of the Project Intellectual Property, whether the Project Intellectual Property be a Qualifying or Independent Project Intellectual Property, shall be allocated between the University and the Inventors in accordance with Article 27.18 (a) of the CUFA Collective Agreement as follows:

50% to the Inventors in the proportions identified under Section 3 of DOI 20XX-XX ;

AND

50% to the University

5.2 In the event the Commercialization of the Project Intellectual Property leads to the establishment of a legal person (body corporate) or other entity, whether incorporated or otherwise in any jurisdiction whether Canadian or foreign, (the "Company") for the exploitation or licensing of the Project Intellectual Property, the University, the Inventor and any third party shall negotiate their respective participation in the Company. Such negotiation shall be subject to the terms of this Agreement, and shall acknowledge this Agreement by signing it. Further, the amount of any development funds made available and the relevant mechanism through which it is repaid, the participation of any other parties, together with any other matter which the parties consider relevant, shall be subject to the terms of this Agreement.

5.3 All Net Proceeds shall be distributed in accordance with Articles 27.18 (a) and 27.19 of the CUFA Collective Agreement.

6. REPRESENTATIONS AND WARRANTIES

The Inventor makes the following representations and warranties, in the understanding that the University is relying upon them:

6.1 In the case of a sole Inventor, he or she hereby warrants and declares that he or she possesses all right, title and interest in the Project Intellectual Property and that to the best of his or her knowledge the Project Intellectual Property does not infringe the right, title or interest of any third party; and that further, he or she is able to assign, transfer or in any other manner deal with the Invention, free from any lien, claim, pledge, charge, mortgage, hypothec, debt or any other security interest of any kind.

- 6.2 In the case of Co-Inventors, each of the Co-Inventors, hereby warrants and declares that he or she possesses all right, title and interest in the Invention in the proportions set out in Section 3 of DOI 20XX-XX and that to the best of his or her knowledge the Project Intellectual Property does not infringe the right, title or interest of any third party; and that further, he or she is able to assign, transfer or in any other manner deal with the Project Intellectual Property, free from any lien, claim, pledge, charge, mortgage, hypothec, debt or any other security interest of any kind.
- 6.3 That where any background Intellectual Property has or will be used in connection with the Project Intellectual Property, that the Inventor hereby warrants and declares that he or she is entitled to use the background Intellectual Property.

7. CONFIDENTIALITY AND DISCLOSURE:

- 7.1 The whole of this section 7 shall survive the termination for any reason of this Agreement. The parties agree not to disclose and to maintain in confidence the Project Intellectual Property and any improvements. The Inventor shall advise the University in writing at least ninety (90) days in advance of any proposed disclosure relating to the Project Intellectual Property or improvements. If, at its sole discretion, the University determines that such a proposed disclosure may adversely affect the patentability or protection by any other means of the Project Intellectual Property or improvements, the University reserves the right to require that the Inventors delay such proposed disclosure for a period not to exceed six (6) months.
- 7.2 Confidential information includes all of the following: all material, including any text, letter, memorandum, sound recording, videotape, film, photograph, chart, graph, map, survey, diagram, model, sketch, book, technical data, research documentation and generally any information relating to the Project Intellectual Property that is recorded or stored by means of any device (the "Confidential Information").

7.3 The parties promise:

- (a) to maintain the secrecy and confidentiality of the Confidential Information;
- (b) not to disclose any Confidential Information to a third party, except where the disclosing party has entered into a written agreement with such third party which binds the third party to obligations of confidentiality and restricted use which are no less onerous than those imposed upon the parties hereunder before any such disclosure;
- (c) not to use any Confidential Information for any purposes other than the purposes of this Agreement;
- (d) Only to disclose the confidential information to their employees, work colleagues and assistants (together, "Representatives"): (i) who have a need to know the information for academic purposes and (ii) who have been informed of the confidential nature of the Confidential Information. The receiving parties warrant that they will take reasonable steps to prevent the Representatives from acting in a manner inconsistent with the terms of this Agreement.

7.4 The obligations of confidentiality set out above do not apply to information that:

- (a) has been published or has otherwise entered the public domain without a breach of this Agreement;
- (b) is obtained from a third party who has no obligation of confidentiality; or
- (c) is independently developed or obtained by the receiving party without breach of this Agreement.

7.5 It is not a breach of this Agreement to:

- (a) disclose Confidential Information required to be disclosed by law or judicial process or governmental authorities; or
- (b) disclose Confidential Information that is disclosed with the prior written consent of the parties to this Agreement.

8. NOTICE

Unless otherwise agreed by the parties, all notices required to be given pursuant to this Agreement shall be in writing and shall be considered as duly delivered when sent by registered mail, or messenger to the other party at the address stated below or such other address as either party shall advise the other in writing:

Concordia
ADDRESS

Attention: []

Inventor
ADDRESS

Attention: []

or to such subsequent address as any party hereto may furnish the other party hereto in writing.

9. TERM AND TERMINATION

9.1 Where the Inventor or any third-party nominee (“Nominee”) or legal person (“Legal Person”) who has control of any rights over the Project Intellectual Property has been declared bankrupt, filed for bankruptcy or where a creditor has filed a claim in bankruptcy against the Inventor Nominee or Legal Person which results in the bankruptcy of the Inventor, Nominee or Legal Person or where the Inventor, Nominee or Legal Person files for creditor protection or makes an arrangement with creditors which results in the bankruptcy of the Inventor, Nominee or Legal Person, then the University may terminate the present Agreement against the Inventor or Nominee or Legal Person having control of any rights over the Project Intellectual Property, as the case may be. Except with respect to the Inventor, the University may terminate the present Agreement with respect to any Nominee or Legal Person that ceases to pursue its normal business operations, ceases to exist legally or files for creditor protection or makes an arrangement with creditors which does not result in the bankruptcy of the said Nominee or Legal Person, as the case may be. Such notice of termination shall be in writing and delivered to the Nominee or Legal Person in default under this section and the termination shall be effective on the date of receipt of the termination notice. Where the University terminates this Agreement acting under this section 9, any assignment, transfer, conveyance or licensing of the Project Intellectual Property shall be immediately null and void and of no effect as if it had never taken place. Any agreement entered into by the Inventor and any Nominee or other Legal Person involving the Project Intellectual Property shall make reference to this section 9 and include it as a binding obligation.

- 9.2 This Agreement may otherwise be terminated by either party in the event of default upon thirty (30) days written notice to the defaulting party. Such termination occurs where a party has defaulted or failed to comply with the terms of this Agreement and, following receipt by the defaulting party of a written notice of default, has failed to cure any such default within that period of thirty (30) days.
- 9.3 Unless otherwise terminated or extended, this Agreement will expire automatically on a date that is ninety (90) days from the Effective Date. However, it may be extended in accordance with the provisions of Article 27.15 (d) of the CUFA Collective Agreement.
- 9.4 Where, prior to the expiry or termination of this Agreement, the University provides the Inventor with written confirmation of its intent to pursue protection and Commercialization of the Project Intellectual Property, the terms of this Agreement shall be automatically extended to coincide with the expiration or abandonment by the University, or by any third party acting on its behalf, of all patents or other rights relating to the Project Intellectual Property. The provisions relating to confidentiality, dispute resolution and all waivers shall survive the expiry or termination of this Agreement.

10. DISPUTE RESOLUTION

Any dispute relating to the interpretation or the applicability of any of the provisions of this Agreement shall be referred to the PACO in accordance with Articles 27.03 to 27.08 of the CUFA Collective Agreement. This section 10 dealing with dispute resolution shall survive the termination for any reason of this Agreement.

11. ENTIRE AGREEMENT

It is understood that this Agreement contains the entire agreement between the parties hereto. This Agreement shall be binding on and shall inure to the benefit of the parties hereto, their respective assigns and successors in interest.

12. GOVERNING LAW AND JURISDICTION

The Agreement shall be governed and interpreted in accordance with the laws applicable and in force in the Province of Quebec. The parties hereby attorn to the exclusive jurisdiction of the competent courts of Quebec sitting in the judicial district of Montreal.

13. LANGUAGE

This Agreement is drawn up in English at the request of the parties. Les parties aux présentes ont expressément convenu que ce contrat soit rédigé en anglais.

14. AMENDMENTS

No modifications to this Agreement shall be binding unless agreed to in writing by the duly authorised representatives of the parties hereto and the Concordia University Faculty Association and formalized through a written amendment to this Agreement signed by the duly authorized representatives of the parties hereto.

IN WITNESS WHEREOF THE PARTIES HAVE SIGNED:

THIS AGREEMENT shall take effect as of the date of the last signing party (DATE)

CONCORDIA UNIVERSITY

INVENTOR

Signature

Signature

Typed Name

Typed Name

Title

Title

Date

Date

INVENTOR

Signature

Typed Name

Title

Date