

# ASSIGNMENT

## For Provisional Patent Applications Without Federal Funding

WHEREAS, as of \_\_\_\_\_, (the "Effective Date"), the University of Virginia Patent Foundation, a non-profit organization having a place of business at 250 West Main Street, Suite 300, Charlottesville, Virginia 22902, (the "Assignor") possesses the right, title and interest for and in provisional patent application No. \_\_\_\_\_ filed \_\_\_\_\_ and titled \_\_\_\_\_; and

WHEREAS, \_\_\_\_\_ (collectively, the "Assignee") is desirous of acquiring Assignor's entire right, title and interest in and to said provisional patent application, in all U.S. patent applications directly or indirectly claiming priority to the same, including divisionals, equivalent continuations, and claims in continuations-in-part applications that are entitled to the priority filing date of any of the above-referenced U.S. patents or applications, as well as foreign equivalents of same, and all patents issuing therefrom, including reissues and re-examinations, (the "Rights"), subject to the reservations of rights set forth below;

NOW, THEREFORE, for and in consideration of the sum of One Dollar (\$1.00) and other good and valuable consideration, the receipt of which is hereby acknowledged, Assignor does hereby sell, assign, transfer and convey to Assignee, its successors and assigns, Assignor's entire right, title and interest in and to the aforesaid Rights in existence as of the Effective Date, except that Assignor reserves a perpetual and royalty free right for itself, the University of Virginia, the named inventors and their future not-for-profit employers to make and use the Invention, and to practice under the Rights for educational, research, and patient care and treatment purposes. In addition, Assignee hereby agrees not to use the Rights, or permit its further assignees and/or licensees to use the Rights, to block Assignor's licensees from commercializing other inventions made by the inventors or others at the University of Virginia. Furthermore, nothing herein shall be construed to affect or limit the pre-existing royalty-free rights required to be granted to the U.S. Government pursuant to 35 USC §§200-206 and to 37 CFR Part 401, should any such rights exist. This assignment is further subject to any pre-existing rights of, or obligations to, third parties or other research sponsor restrictions (e.g., non-exclusive licenses, royalty sharing obligations) which may attach as a result of Government or non-Government sponsorship of research at UVA under which the Invention was made.

AND, the aforesaid assignment includes the Assignor's right in and to all income, royalties, damages and payments now or hereafter due or payable with respect to any Letters Patent which may be granted, and in and to all causes of action (either in law or in equity), and

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the right to sue, counterclaim, and recover for past, present and future infringement of the rights assigned or to be assigned under this Assignment, as fully and entirely as the same would have been held and enjoyed by Assignor if this sale and assignment had not been made.

AND, Assignor hereby authorizes and requests the appropriate governmental officials to issue any and all such United States or foreign Letters Patent under said Rights to Assignee.

AND, nothing herein shall be construed as an assignment of any rights of Assignor or the University of Virginia, other than the Rights. Assignee acknowledges that in order to maintain the Rights, Assignee must file a non-provisional patent application claiming priority to said provisional patent application prior to its expiration. Assignee further acknowledges that the assignment of the Rights provided hereunder does not include assignment of improvement inventions, related inventions, or other intellectual property or proprietary information that has been or is made by the inventors or others at the University of Virginia.

AND, nothing herein shall be construed as (i) a warranty or representation by Assignor as to the validity or scope of any Rights, (ii) a warranty or representation that anything made, used, imported, developed, promoted, offered for sale, sold, or otherwise disposed of under the Rights does not or will not infringe patents, trade secrets or other proprietary rights of third parties; (iii) a representation or warranty of operability or that development of a commercial products is possible; (iv) any other representations or warranties, either express or implied, unless specified herein; (v) directly or indirectly operating or applying as a waiver of sovereign immunity by the Commonwealth of Virginia; or (vi) imposing any obligation or any liability on any party contrary to the laws of the Commonwealth of Virginia. **ALL RIGHTS ARE ASSIGNED HEREUNDER "AS IS." ASSIGNOR DISCLAIMS AND MAKES NO EXPRESS OR IMPLIED WARRANTIES OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE WITH RESPECT TO THE RIGHTS.**

AND, Assignee hereby represents and warrants that, as of the Effective Date, Assignee has disclosed to Assignor any and all (i) companies that Assignee is aware of which now have or previously had an interest in licensing or otherwise acquiring any of the Rights; (ii) start-up companies that Assignee has founded, is in the process of founding, or plans to found, and (iii) companies in which Assignee and/or immediate relatives of same owns or has the right to acquire equity (other than via an individual retirement account) that cumulatively exceeds 3% of the company's total equity, or exceeds a value of \$10,000. Assignee hereby agrees not to license or assign any of the Rights to any company falling within categories (i), (ii) or (iii) above which was not disclosed to Assignor on or before the Effective Date, as required above, unless Assignor has first consented to such license or assignment in writing. In the event that such consent is necessary, or in the event of a breach of any warranty herein by Assignee, Assignor may require Assignee, as a condition of such consent, to make payments to Assignor in the same manner as such company would have reasonably made to Assignor if this Assignment had not been made, and such license or assignment to such company had been made by Assignor.

HOWEVER, Assignee acknowledges that Assignee has requested permission of the U.S. Government for this Assignment pursuant to 35 USC §202(d); and Assignee hereby agrees that if such permission is granted, Assignee shall comply with the conditions set forth in 37 CFR 401.9.

Assignee further agrees that if such permission is denied, Assignee shall take whatever action is necessary to comply with the Government's requirements, including without limitations assignment of the Rights to the U.S. Government if so ordered.

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IN WITNESS WHEREOF, said Assignor has hereunto set its hand and seal.

Signature of  
Representative for Assignor:

\_\_\_\_\_  
Marie C. Kerbeshian  
Interim Executive Director and CEO  
University of Virginia Patent Foundation

Representative's Title:

Signature of  
Representative for Assignee:

\_\_\_\_\_

Representative's Name:

\_\_\_\_\_

Date:

\_\_\_\_\_

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