

## ASSIGNMENT

### For Issued Patents

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 an Invention entitled

described in U.S. Patent No. \_\_\_\_\_ filed \_\_\_\_\_; and

WHEREAS, \_\_\_\_\_ (collectively, the "Assignee") is desirous of acquiring Assignor's entire right, title and interest in and to said patent, including reissues and re-examinations, (the "Rights"), subject to the reservations of rights set forth below;

\_\_\_\_\_  
PP

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.

\_\_\_\_\_  
CA

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

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 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 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.

\* \* \*

\_\_\_\_\_  
Assoc. D

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:

\_\_\_\_\_

Name and address to which future  
correspondence from the U.S. Patent  
and Trademark Office should be sent:

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

**Inventor Certification Form**  
**To be completed by all U.Va. inventors if the invention is federally-funded**

Institution: \_\_\_\_\_

Grant Number(s): \_\_\_\_\_ Federal Granting Agency EIR Number: \_\_\_\_\_

Title of Invention: \_\_\_\_\_

Inventor(s): \_\_\_\_\_

I am an inventor of the above-referenced subject invention and the current owner, identified above, has elected not to retain title to this invention or has agreed to assign this invention to me, and has permitted me to request that I be allowed to retain title pursuant to 37 CFR 401.9 and 35 U.S.C 35 202(d) or obtain title from the institution by assignment pursuant to 37 CFR 401.14(k)(1) and 35 USC 202(c)7. In support of the request that I be allowed to obtain title, I hereby certify that:

1. If allowed to retain or obtain title, I agree to be bound by any conditions imposed by the above-referenced institution, and at least those conditions that would apply to a small business firm under paragraphs (d)(1) and (3), (f)(4), (h), (I); and (j) of the clause at 37 CFR 401.14(a);
2. If allowed to retain or obtain title, I will seek patent protection for the subject invention within one year of the date of approval of title retention and provide the funding agency with documentation of the patent application number, filing date and inclusion of the Federal support clause;

And I certify, to the best of my knowledge and belief, that the statements herein are true, accurate, and complete. I understand that willful provision of false information is a criminal offense (Title 18 U.S. Code, Section 1001) and that any person making any false, fictitious, or fraudulent statement may, in addition to other remedies available to the government, be subject to civil penalties under the Program Fraud Civil Remedies Act of 1986 (45 CFR Part 79). I agree that the right to title to this invention shall immediately revert back to the U.S. Government if a patent application has not been filed on this subject invention within one year unless written approval is received from the federal granting agency for an extension of time.

(Information and signatures of additional inventors may be attached.)

\_\_\_\_\_  
Signature of Inventor Date: \_\_\_\_\_

Printed Name: \_\_\_\_\_

Street Address: \_\_\_\_\_

City, State, Zip Code: \_\_\_\_\_

Area Code / Phone Number: \_\_\_\_\_ E-mail: \_\_\_\_\_

(Information and signatures of additional inventors may be attached.)

As the authorizing official of the above-referenced institution or its invention management organization assignee, subject to the conditions attached hereto, I hereby approve the release of rights to the above-reference invention by the federal granting agency to all of the inventors if the institution has elected not to retain title, or alternatively, the institution requests the federal granting agency's permission to assign those rights to the inventors.

\_\_\_\_\_  
Authorizing Official's Signature and Title Date: \_\_\_\_\_

\_\_\_\_\_  
Organization (if other than Institution)

**Patent-Related Information**

**To be completed by all U.Va. inventors if the invention is federally-funded**

1. Date of patent application filing: \_\_\_\_\_

U.S. Serial Number (if any): \_\_\_\_\_

2. Date of presentation at a conference or symposium on which invention was disclosed (if applicable):  
\_\_\_\_\_

3. Publication information for article concerning this invention:

Date of Submission: \_\_\_\_\_

Date of Acceptance: \_\_\_\_\_

Date of Publication: \_\_\_\_\_

Publication Pending: \_\_\_\_\_

Citation: \_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

SAMPLE