

09-20-2001



Docket No.:

EET

U.S. DEPARTMENT OF COMMERCE

Patent and Trademark Office

Tab settings → → → ▼

To the Honorable Commissioner of Patents and Trademarks, P.O. Box 101850322, the attached original documents or copy thereof.

1. Name of conveying party(ies):
Advanced Bioanalytical Services, Inc.

2. Name and address of receiving party(ies):

Name: **Tompkins Trust Company**

Internal Address: _____

Additional names(s) of conveying party(ies) ☐ Yes ☒ No

3. Nature of conveyance:

9-14-01

☐ Assignment

☐ Merger

☒ Security Agreement

☐ Change of Name

☐ Other _____

Street Address: **The Commons**

City: **Ithaca**

State: **NY**

ZIP: **14850**

Execution Date: **August 2, 2001**

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or registration numbers(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s)

B. Patent No.(s)

09/468,535

60/210,890

60/179,844

09/156,507

60/264,501

60/243,952

09/748,518

60/269,973

60/261,653

09/764,698

60/130,761

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: **Neal L. Slifkin**

Internal Address: **HARRIS BEACH LLP**

Street Address: **The Granite Building**

130 East Main Street

City: **Rochester**

State: **NY** ZIP: **14604**

6. Total number of applications and patents involved: **11**

7. Total fee (37 CFR 3.41):.....\$ **440.00**

☒ Enclosed - Any excess or insufficiency should be credited or debited to deposit account

☐ Authorized to be charged to deposit account

8. Deposit account number:

08-0865

440E

09/19/2001 LABELER 00000073 09465353

DO NOT USE THIS SPACE

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9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Neal L. Slifkin

Signature

15

Date

Name of Person Signing

Total number of pages including cover sheet, attachments, and document:

PATENT

REEL: 012168 FRAME: 0049

CONTINGENT PATENT, TRADEMARK, AND LICENSE ASSIGNMENT

THIS CONTINGENT PATENT, TRADEMARK, AND LICENSE ASSIGNMENT ("*Assignment*") is made by ADVION BIOSCIENCES, INC., formerly known as Advanced Bioanalytical Services, Inc., a New York corporation having its principal office and place of business at 15 Catherwood Road, Ithaca, New York 14850 ("*Assignor*"), in favor of TOMPKINS TRUST COMPANY, a New York banking corporation having an office and place of business at The Commons, Ithaca, New York 14850 ("*Assignee*");

THIS AGREEMENT IS SUBJECT TO THE TERMS OF AN INTERCREDITOR AGREEMENT (the "*Intercreditor Agreement*") DATED AUGUST 2, 2001 AMONG ASSIGNOR, ASSIGNEE, AND CEPHAS CAPITAL PARTNERS, L.P. (the "*Subordinated Creditor*")

WITNESSETH:

WHEREAS, Assignor has indebtedness and obligations to Assignee pursuant to the:

- (a) commercial variable rate revolving or draw note dated December 21, 2000, having a credit limit of \$1,000,000,
- (b) commercial variable rate revolving or draw note dated June 13, 2001, having a credit limit of \$1,000,000,
- (c) commercial note dated June 18, 1999, in the original principal amount of \$271,395.81,
- (d) commercial note dated July 2, 1999, in the original principal amount of \$95,480.74,
- (e) capital leases, having the following contract numbers, commencement dates and approximate balances: 0036447-005, 10/14/97 - \$78,000; 0036447-007, 06/12/98 - \$20,000; 0036447-008, 10/28/98 - \$151,000; 0036447-009, 02/16/99 - \$203,000; 0036447-010, 06/18/99 - \$128,000; 0036447-011, 02/20/2000 - \$206,000; 0036447-012, 07/20/2000 - \$124,000; 0036447-013, 07/20/2000 - \$124,000; 0036447-015, 03/20/2001 - \$1,081,000; 0036447-016, 06/11/2001 - \$643,000; 0036447-017, 07/11/2001 - \$549,000, and
- (f) visa credit card account,

(as the same may hereafter be amended, supplemented, amended and restated, renewed or otherwise modified from time to time, collectively the "*Financing Agreement*") , which Financing Agreement provides (i) for the Assignee to, from time to time, extend credit to or for the account of Assignor and (ii) for the grant by Assignor to Assignee of a security interest in certain of Assignor's assets,

including, without limitation, its patents, patent applications, service marks, service mark applications, service names, trademarks, trademark applications, trade names, goodwill and licenses;

NOW, THEREFORE, in consideration of the premises set forth herein and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Assignor agrees as follows:

1. Assignment of Patents. To secure the complete and timely satisfaction of all of the liabilities and obligations of every kind or nature of Assignor to Assignee now existing or hereafter incurred, including liabilities and obligations under or related to the Financing Agreement and all notes, agreements, and documents delivered in connection therewith, including as extended, modified, or replaced from time to time (collectively, the "*Obligations*"), Assignor hereby grants, assigns and conveys, as collateral security, to Assignee all of the Assignor's right, title and interest in and to all of its now owned or existing and filed and hereafter acquired or arising and filed patents and patent applications, including, without limitation, the inventions and improvements described and claimed therein, including those listed on Schedule A, attached hereto and made a part hereof, and (a) the reissues, divisions, continuations, renewals, extensions and continuations-in-part thereof, (b) all income, royalties, damages and payments now and hereafter due and/or payable under and with respect thereto, including, without limitation, damages and payments for past or future infringements thereof, (c) the right to sue for past, present and future infringements thereof, and (d) all rights corresponding thereto throughout the world (all of the foregoing patents and applications, together with the items described in clauses (a)-(d), are sometimes hereinafter individually and/or collectively referred to as the "*Patents*").

2. Security Interest in Trademarks, Goodwill, and Licenses. To secure the complete and timely satisfaction of all of the Obligations, Assignor hereby grants and conveys, as collateral security, to Assignee a lien and security interest in all of the Assignor's right, title and interest in and to all of its now owned or existing and filed and hereafter acquired or arising and filed:

(i) trademarks, trademark registrations, trade names and trademark applications, service marks, service mark registrations, service names and service mark applications, including, without limitation, the trademarks, trademark registrations, trade names and trademark applications, service marks, service mark registrations, service names and service mark applications listed on Schedule B, attached hereto and made a part thereof, and (a) renewals thereof, (b) all income, royalties, damages and payments now and hereafter due and/or payable with respect thereto, including, without limitation, damages and payment for past or future infringements thereof, (c) the right to sue for past, present and future infringements thereof, and (d) all rights corresponding thereto throughout the world (all of the foregoing trademarks, service marks, trademark and service mark registrations, trade names, service names and applications, together with the items described in clauses (a)-(d), are sometimes hereinafter individually and/or collectively referred to as the "*Trademarks*");

(ii) the goodwill of Assignor's business including but not by way of limitation such goodwill connected with and symbolized by the Trademarks (the "*Goodwill*"); and

(iii) license agreements with any other party relating to intellectual property or proprietary rights of any kind or nature, whether Assignor is a licensor or licensee under any such license agreement, including, without limitation, the licenses listed on Schedule C attached hereto (the "*Licenses*").

3. Restrictions on Future Assignments. Assignor agrees that until the Obligations shall have been satisfied in full and the Financing Agreement shall have been terminated, Assignor will not, without Assignee's prior written consent, enter into any agreement relating to the Patents, Trademarks, Goodwill, or Licenses which would limit or restrict the rights of Assignee hereunder and Assignor further agrees that it will not take any action, or permit any action to be taken by others subject to its control, including licensees, or fail to take any action which would affect the validity or enforcement of the rights transferred to Assignee under this Assignment. Notwithstanding the foregoing, Assignor may enter into a Contingent Patent, Trademark, and License Agreement (the "*Subordinated Assignment Agreement*") with the Subordinated Creditor, or into license agreements licensing the right to use the Patents, Trademarks or Licenses in the ordinary course of business.

4. New Patents, Trademarks. Assignor represents and warrants that the Patents, Trademarks, and Licenses listed on Schedules A, B, and C, respectively, constitute all of the patents, service marks, trademarks, applications and licenses now owned by Assignor. If, before the Obligations shall have been satisfied in full, Assignor shall (i) obtain rights to any new patentable inventions, trademarks, trademark registrations, trade names, service marks, service mark registrations, service names, or licenses, or (ii) become entitled to the benefit of any patent, service mark or trademark application, service mark, service mark registration, trademark, trademark registration, or license renewal, or patent for any reissue, division, continuation, renewal, extension, or continuation-in-part of any Patent or any improvement on any Patent, the provisions of this Assignment shall automatically apply thereto and Assignor shall give to Assignee prompt written notice thereof. Assignor hereby authorizes Assignee as attorney in fact to modify this Assignment by amending Schedules A, B, and C, as applicable, to include any future patents, patent applications, service marks, service mark registrations, service mark applications, service names, trademarks, trademark registrations, trademark applications, trade names and licenses which are Patents, Trademarks or Licenses, as applicable, under Sections 1 and 2 above or under this Section 4, and to file or refile this Assignment with the United States Patent and Trademark Office.

5. Representations and Warranties. Assignor represents and warrants to and agrees with Assignee that:

(i) the Patents (to the extent issued), Trademarks, and Licenses are subsisting and have not been adjudged invalid or unenforceable, in whole or in part;

(ii) to the best knowledge of Assignor, each of the Patents, Trademarks, and Licenses is valid and enforceable;

(iii) Assignor is the owner of the Patents, Trademarks, and to the extent indicated therein, Licenses, and has the power and authority to make, and will continue to have authority to perform, this Assignment according to its terms;

(iv) to the best knowledge of Assignor, this Assignment does not violate and is not in contravention of any other agreement to which Assignor is a party or any judgment or decree by which Assignor is bound and does not require any consent under any other agreement to which Assignor is a party or by which Assignor is bound; and

(v) there has been no prior sale, pledge, encumbrance, assignment or other transfer or disposition of any of the Patents, Trademarks, or Licenses or any part thereof, and the same are free from all liens, charges and encumbrances of any kind, including but not limited to licenses, shop rights and covenants not to sue third persons, other than liens permitted by the Financing Agreement.

Notwithstanding anything to the contrary contained herein, however, Assignor may license the right to use the Patents, Trademarks, or Licenses to others in the ordinary course of business and has or may grant rights to Subordinated Creditor and the rights of Assignee and the Subordinated Creditor shall be subject to the Intercreditor Agreement.

6. Default.

(a) Upon an "Event of Default" (as defined in the Financing Agreement). Assignee shall have, subject to section 6(b), in addition to all other rights and remedies given it by this Assignment, those allowed by law and the rights and remedies of a secured party under the Uniform Commercial Code as enacted in any jurisdiction in which the Patents, Trademarks, and Licenses may be located, including, but not by way of limitation, the location of Assignee's headquarters.

(b) Notwithstanding anything in this Assignment to the contrary, however, after the occurrence of any Event of Default, prior to the exercise of any remedy hereunder Assignee shall give Assignor written notice of its intention to exercise such remedy. Assignor, during the ninety (90) day period following the giving of such notice, shall have the right, and a limited license to the extent necessary in connection with such right, to sell or otherwise dispose of the Patents, Trademarks, and Licenses in a commercially reasonable manner; provided, however, that all proceeds of any kind or nature from such disposition up to a maximum of the full amount of the Obligations shall be delivered to Assignee, subject, however, to rights of holders of Senior Indebtedness.

7. Termination. Upon payment in full of the Obligations and termination of the Financing Agreement, this Assignment will terminate.

8. Duties of Assignor. Assignor shall have the duty to preserve and maintain all of its rights in the Patents and Trademarks in the ordinary course of business.

9. Financing Statements; Documents. At the request of Assignee, Assignor will join with Assignee in executing one or more financing statements pursuant to the New York version of the Uniform Commercial Code in form satisfactory to Assignee and will pay the costs of filing and/or recording this Assignment and all financing, continuation and termination statements in all public offices where filing or recording is deemed necessary or desirable by Assignee. Assignor will execute and deliver to Assignee from time to time such supplemental assignments or other instruments, including, but not by way of limitation, additional assignments to be filed with the United States Patent and Trademark office, as Assignee may require for the purpose of confirming Assignee's interest in the Patents, Trademarks and Licenses.

10. Assignee's Right to Sue. Upon an Event of Default, Assignee shall have the same rights, if any, as Assignor has, but shall in no way be obligated, to bring suit in its own name to enforce the Patents, Trademarks, and Licenses, and, if Assignee shall commence any such suit, Assignor shall, at the request of Assignee, do any and all lawful acts and execute any and all proper documents required by Assignee in aid of such enforcement and Assignor shall promptly, upon demand and as a part of the obligations, reimburse and indemnify Assignee for all costs and expenses incurred by Assignee in the exercise of its rights under this Section 10. Upon an Event of Default, after first giving Assignee a reasonable opportunity to bring suit in its own name to enforce the Patents, Trademarks, and Licenses, Assignor may bring such suit in its own name.

11. Waivers. No course of dealing between Assignor and Assignee nor any failure to exercise nor any delay in exercising, on the part of Assignee, any right, power or privilege hereunder or under the Financing Agreement shall operate as a waiver thereof; nor shall any single or partial exercise of any right, power or privilege hereunder or thereunder preclude any other or further exercise thereof or the exercise of any other right, power or privilege.

12. Severability. The provisions of this Assignment are severable, and if any clause or provision shall be held invalid and unenforceable in whole or in part in any jurisdiction, then such invalidity or unenforceability shall affect only such clause or provision, or part thereof, in such jurisdiction, and shall not in any manner affect such clause or provision in any other jurisdiction, or any other clause or provision of this Assignment in any jurisdiction.

13. Modification. This Assignment cannot be altered, amended or modified in any way, except as specifically provided in Section 4 hereof or by a writing signed by the parties hereto.

14. Cumulative Remedies; Effect on Financing Agreement. All of Assignee's rights and remedies with respect to the Patents and Trademarks, whether established hereby or by the Financing Agreement, or by any other agreements or by law shall be cumulative and may be exercised singularly or concurrently. Assignor acknowledges and agrees that this Assignment is not

intended to limit or restrict in any way the rights and remedies of Assignee under the Financing Agreement but rather is intended to facilitate the exercise of such rights and remedies.

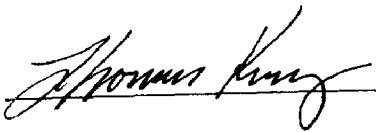
15. Binding Effect; Benefits. This Assignment shall be binding upon the Assignor and its respective successors and assigns, and shall inure to the benefit of Assignee, its successors and assigns.

16. Governing Law. This Assignment has been delivered and accepted in Rochester, New York, and shall be governed by and construed in accordance with the local laws of the State of New York without giving effect to principles of conflicts of laws.

17. Notices. All notices, demands or other communications to be given or delivered under or by reason of the provisions of this Assignment shall be in writing and shall be deemed to have been given when (i) delivered personally to the recipient, (ii) deposited for delivery to the recipient with a reputable overnight courier service (charges prepaid), (iii) faxed to recipient with a confirmation receipt and followed by deposit on the same day with a reputable overnight courier service, or (iv) five days after being mailed to the recipient by certified or registered mail, return receipt requested and postage prepaid. Any notice or communication shall be sent to the respective addresses shown for the parties at the top of this Agreement, or, to such additional or different address as any party designates by notice to the other given in accordance with this Section 17.

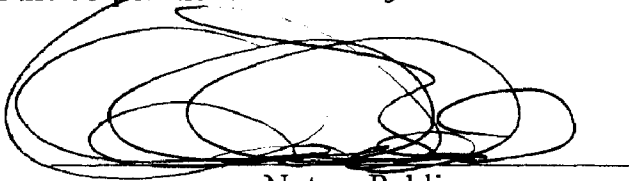
IN WITNESS WHEREOF, the Assignor, by its duly authorized officer, has executed this Assignment as of August 2, 2001.

ADVION BIOSCIENCES, INC.

By: 
Title: COO

STATE OF NEW YORK)
) ss:
COUNTY OF TOMPKINS)

The foregoing Contingent Patent, Trademark and License Assignment was
executed and acknowledged before me this 10th day of August, 2001, by
Thomas Kurz, the Chief Operating Officer of Advion
Biosciences, Inc., on behalf of the corporation.



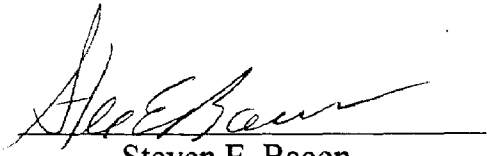
Notary Public

MARK B. WHEELER
Notary Public, State of New York
No. 4748671
Qualified in Tompkins County
Commission Expires March 30, 2003

Accepted at Ithaca, New York
as of August 2, 2001.

TOMPKINS TRUST COMPANY

By:

A handwritten signature in dark ink, appearing to read "Steve E. Bacon", is written over a horizontal line.

Steven E. Bacon
Vice President

**SCHEDULE A
(Patents)**

Patent Applications:

| <u>Title</u> | <u>Serial #</u> |
|--|-----------------|
| Integrated Monolithic Microfabricated Dispensing Nozzle and Liquid Chromatography-Electrospray | 09/468,535 |
| Integrated Monolithic Microfabricated Electrospray and Liquid Chromatography System and Method (joint with Kionix) | 09/156,507 |
| Multiple Electrospray Device, System And Method | 09/748,518 |
| Separation Media, Multiple Electrospray Nozzle System And Method | 09/764,698 |
| Surface Modification of a Porous Polymer Monolith and Products Therefrom | 60/210,890 |
| Robotic Autosampler for Automated Electrospray From A Microfluidic Chip | 60/264/501 |
| A Microchip Electrospray Device And Column With Affinity Adsorbents And Use of The Same | 60/269,973 |
| High-Throughput Parallel Liquid Chromatography System | 60/130,761 |
| Single Nucleotide Polymorphism Detection System and Method | 60/179,844 |
| A One-Well Assay for High Throughput Detection of Single Nucleotide Polymorphisms | 60/243,952 |
| Computer System and Software for the Determination of Single Nucleotide | 60/261,653 |

Polymorphisms by the Detection of
Dideoxynucleotide Triphosphate Bases
Not Consumed in Primer Extension Reactions

SCHEDULE B
(Trademarks)

| | |
|----------------------------|------------|
| Advion (as a service mark) | 76/180,935 |
| Advion (as a trademark) | 76/181,857 |
| Advion Biochips | 76/182,105 |
| ESI Chip | 76/132,859 |
| LC/MS Chip | 76/132,858 |
| CE/MS Chip | 76/132,855 |
| Metabolism Chip | 76/181,859 |
| Proteomics Chip | 76/182,047 |
| Genomics Chip | 76/132,856 |
| Combichem Chip | 76/132,860 |
| Nanospray Chip | 76/132,857 |

**SCHEDULE C
(Licenses)**

Patents Licensed:

| <u>Title</u> | <u>Serial #</u> |
|---|-----------------|
| Separation Columns with Macroporous Polymer Media (Cornell Univ., exclusive) | 5,334,310 |
| Column with Macroporous Polymer Media (Cornell University, exclusive) | 5,453,185 |
| Microscale Fluid Handling System (Northeastern University, nonexclusive) | 5,872,010 |
| Integrated Monolithic Microfabricated Electrospray and Liquid Chromatography System and Method (Kionix, nonexclusive) | 6,245,227 |