

04-03-2002

Attorney Docket No. 1944-00201

FORM PTO-1595

(Rev. 3/01) Patent and Trademark Office

OMB No. 0651-0027 (exp. 5/31/2002)

U. S. DEPARTMENT OF COMMERCE



102041463

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying parties(ies):

The University of Texas System

Additional name(s) of conveying party(ies):

Attached? ☐ Yes ☒ No

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

David A. Sirbasku
2536 Amherst, Suite C.
Houston, Texas 77005

3. Nature of conveyance:

☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

Additional name(s) & address(es)

Attached? ☐ Yes ☒ No

Execution Date: February 20, 2002

4. Application number(s) or patent number(s): 09/852,958

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).

Additional numbers attached? ☐ Yes ☒ No

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

Carol G. Mintz
Conley, Rose & Tayon, P.C.
P. O. Box 3267
Houston, Texas 77253-32676. Total number of application and patents involved: 17. Total fee (37 CFR 3.41)\$ 40.00☐ Enclosed☒ Authorized to be charged to deposit account

8. Deposit account number: 03-2769

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

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

Carol G. Mintz

Name of Person Signing

Carol G. Mintz

Signature

Mar. 7, 2002

Date

Mail documents to be recorded with required cover sheet information to:

Commissioner of Patents & Trademarks, Box Assignments

Washington, D. C. 20231


04/02/2002 L'VELLER 00000133 032769 09852958

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68942.01/1944.00700

PATENT
REEL: 012731 FRAME: 0181

ASSIGNMENT AGREEMENT

 This Assignment Agreement ("Agreement") is made and entered into this 20th day of February, 2002 ("Effective Date") by and between The University of Texas System ("System") on behalf of The University of Texas Health Science Center at Houston ("UTH") and David A. Sirbasku, Ph.D. ("Sirbasku").

RECITALS

A. Sirbasku, a U.S. citizen having a post office and residence address at 1701 Hermann Dr., Houston, Texas 77004, is currently and was a full time employee of UTH when he invented Compositions and Methods for Demonstrating Secretary Immune System Regulation of Steroid Hormone Responsive Cancer Cell Growth ("Invention"), as more specifically defined in the invention disclosure submitted to UTH on July 21, 1997, supplemented September 2, 1997, September 2, 5, 9, 10 and 20, 2000, and U.S. Patent Application No. 09/852,958 filed May 10, 2001, and pursuant to the Rules and Regulations of the Board of Regents ("Board") of System is required to assign the Invention to the System;

B. System, pursuant to the release letters dated November 29, 2000, June 4, 2001 and August 1, 2001 ("Release Letters"), as set forth in Attachment 1, agreed to release its entire right, title and interest in and to Invention to Sirbasku under the conditions set forth herein and in the Release Letters.

C. System and Sirbasku acknowledge that upon successful commercialization of Invention by Sirbasku, both parties stand to benefit and therefore Sirbasku desires to acquire and System is willing to assign to Sirbasku all of System's right, title and interest in and to the Invention subject to the conditions set forth herein.

NOW THEREFORE, in consideration of the promises, mutual covenants and conditions hereinafter set forth, the parties hereby agree as follows.

1. Invention was partially supported from funding received under one or more of United States Army Contracts No. DAMD17-94-J-4473, No. DAMD17-98-8337 and No. DAMS17-99-1-9405, System sought and received the necessary release in the Invention from the United States Army, by letters dated September 19, 2001 and November 21, 2001, attached hereto as Attachment 2.

2. System hereby transfers, grants, conveys, assigns and relinquishes exclusively to Sirbasku all of System's right, title, and interest throughout the world in and to:

- (a) The Invention in Compositions and Methods for Demonstrating Secretary Immune System Regulation of Steroid Hormone Responsive Cancer Cell Growth, which the parties agree has been reduced to practice;

- (b) United States of America non-provisional patent application on said Invention, Serial No. 09/852,958 filed May 10, 2001, entitled "Compositions and Methods for Demonstrating Secretary Immune System Regulation of Steroid Hormone Responsive Cancer Cell Growth";
- (c) All applications for patent or like protection on Invention that have been made by Sirbasku;
- (d) All patents and like protection that may in the future be granted on Invention to Sirbasku or his legal representatives in any country or place anywhere in the world;
- (e) All substitutions for divisions, continuations, renewals, reissues, extensions, re-examinations and the like of said applications and patents and like grants, including without limitation, those obtained or permissible under past, present and laws and statutes granted on the Invention;
- (f) The right of Sirbasku to file in his name applications for patents and like protection for Invention in any country or countries; and
- (g) All international rights of priority, applications, patents and like protection associated with Invention, including, but not limited to International Patent Application No. PCT/US01/15183 filed May 10, 2001 (WO01/85210 published on November 15, 2001), entitled "Compositions and Methods for Demonstrating Secretary Immune System Regulation of Steroid Hormone Responsive Cancer Cell Growth."

(collectively, the "Invention Rights"), subject to the terms and conditions set forth herein. In accepting this assignment from System, Sirbasku agrees to the terms and conditions of this Agreement. This Agreement shall not negate the non-exclusive license with respect to Invention granted to System pursuant to Section 7 hereof.

3. Sirbasku agrees to comply with all applicable requirements of all applicable laws, including but not limited to, the U.S. Patent Statute (Title 35 of the United States Code now in effect or as may hereafter be in effect) and implementing regulations, and specifically, the provisions relating to the patenting of inventions made with federal funds (35 U.S.C. 200 *et seq.*).

4. In consideration of the release and assignment of the Invention Rights to Sirbasku, Sirbasku agrees to pay UTH, on behalf of System, twenty-five percent (25%) of any consideration (including, but not limited to running royalties, license fees, sublicense fees, stock dividends, non-cash consideration such as stocks, warrants for stock, options for stock, and equity holdings) Sirbasku receives for the transfer, sale or other conveyance of the Invention Rights to a third party. For the sake of clarity the parties understand that System receives twenty-five percent (25%) of any additional consideration, as defined above, Sirbasku receives

for the transfer, sale or other conveyance of the Invention Rights to a third party. System shall have no right to receive (a) any portion of the funds invested by an investor in the Invention Rights except those funds provided to purchase or license Invention Rights or (b) any consideration received by Sirbasku for rendering personal services with respect to the Invention Rights so long as such consideration for personal services does not constitute a characterization of compensation that avoids payment to System of an amount at least equal to 25% of the reasonable value of the Invention Rights at the time of the transfer, sale or conveyance. Sirbasku shall tender to the System its portion of the consideration within thirty days of his receipt thereof.

5. Notwithstanding the creation of or transfer, assignment or conveyance of Invention Rights to any entity, Sirbasku agrees to submit an annual report no later than January 31 of each year following the release and assignment of the Invention Rights to him, describing his progress in commercializing the Invention, until he receives any consideration, as set forth in Section 4 above, for the Invention Rights. When Sirbasku receives any consideration from Invention Rights, the following shall apply:

A. During the period of time that Sirbasku receives any consideration for the Invention Rights and for one (1) year thereafter, Sirbasku shall keep complete and accurate records of all consideration from the Invention Rights in sufficient detail to enable the payment of any consideration payable hereunder to be determined. Upon thirty (30) days written notice, and not more often than once each calendar quarter, Sirbasku shall permit UTH or its representatives, at its expense, to periodically examine Sirbasku's or any licensee's books, ledgers, and records to the extent necessary to verify any amount(s) required to be paid pursuant to Section 4. In the event that such amounts due to UTH are determined to have been underpaid by more than five percent (5%) of the true and verified amount, Sirbasku shall pay the cost of such examination, the underpaid amount, and accrued interest at the highest allowable rate. All payments shall be payable within thirty (30) days of notice of the completion and verification of such audit and the report of such discrepancy, except to the extent such notice and report are disputed, in which case such amount shall be due and owing within thirty (30) days of the resolution of such dispute.

B. Within thirty (30) days after March 31, June 30, September 30, and December 31, respectively, Sirbasku shall deliver to UTH a true and accurate report, giving such particulars of the business conducted by Sirbasku, if any exists, during the preceding three (3) calendar months as are pertinent to account for payments hereunder. Such report shall include at least (a) the total sales, U.S. and foreign; (b) the calculation of the amount due System; and (c) the total amounts so computed and due System. Simultaneously with the delivery of each such report, Sirbasku shall pay to System the amount, if any, due for the period of such report. If no payments are due, it shall be so reported. All amounts payable hereunder by Sirbasku shall be payable to The University of Texas Health Science Center at Houston, in United States funds without deductions for taxes, assessments, fees, or charges of any kind.

6. Sirbasku also agrees to comply and abide to all rules and regulations set forth by UTH and System, including but not limited to, submission of an invention disclosure form for each and every discovery he creates while an employee of UTH or System.

7. System reserves for itself and its component institutions a royalty-free, non-exclusive license to use the Invention in educational, research and patient care activities.

8. Subject to any existing or pre-existing rights of the United States Government, System represents, to the best of its knowledge, that it owns all right, title and interest in and to the Invention and that it has the right to enter into this Agreement and that no consents from any other parties other than that described in Section 1 herein, are necessary or appropriate under any agreements concerning the Invention in order for the transfer and assignment of the Invention Rights under this Agreement to be legally effective.

9. System represents that, to the best of its knowledge, upon consummation of this Agreement and subject to the terms described herein, Sirbasku shall have title to the Invention Rights, free and clear of any and all liens, mortgages, encumbrances, pledges, security interests, licenses or charges of any nature whatsoever that may have been imposed by System.

10. This assignment shall be binding upon and inure to the benefit of all parties hereto and their respective successors, assigns and personal representatives. Sirbasku may transfer, sell or otherwise convey all or a portion of Invention Rights to a third party if (a) the consideration for any such transfer, sale or other conveyance is not less than the fair market value of the Invention Rights or (b) Sirbasku has obtained the prior written consent of System, which consent will not be unreasonably withheld. Any such transfer, sale or other conveyance shall not release Sirbasku from any of his duties and obligations set forth in this Agreement.

11. If any further action is necessary and reasonable to carry out the purpose of this Agreement, each of the parties hereto will take such further action (including the execution and delivery of such further instruments and documents) as Sirbasku reasonably may request, all at the sole cost and expense of Sirbasku.

12. This Agreement, including the Attachments hereto, constitutes the entire agreement between the parties with respect to the subject matter hereof, and supersedes any and all oral and/or written communications or understandings relating to the subject matter hereof. The terms of this Agreement may not be changed, modified or amended except by the execution of a written instrument signed by the parties. The failure of any party to assert a right hereunder or to insist upon compliance with any term or condition of this Agreement shall not constitute a waiver of that right or excuse a similar subsequent failure to perform any such term or condition by any other party.

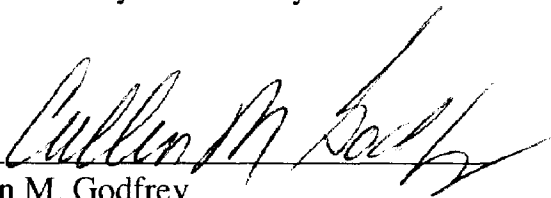
13. Any conflict between this Agreement and the Release Letters shall be controlled by this Agreement.

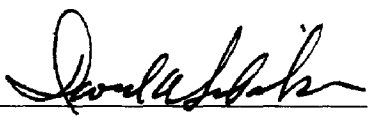
14. This Agreement shall be governed by and construed in accordance with the laws of the State of Texas.

In Witness Whereof, the parties hereto have executed this Agreement as of the day and year first written above.

The Board of Regents
The University of Texas System

David A. Sirbasku

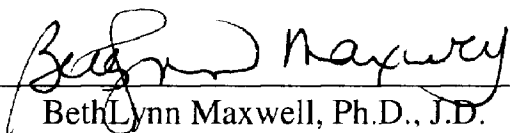
By: 
Cullen M. Godfrey
Vice Chancellor and General Counsel

By: 
David A. Sirbasku

Date: February 20, 2002


Date: Jan 19, 2002
DS

Approved as to Form:

By: 
Beth Lynn Maxwell, Ph.D., J.D.
Office of General Counsel
The University of Texas System

Date: 19 Feb 02

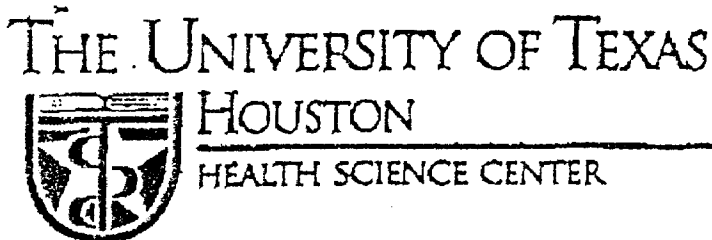
Approved as to Content:

By: 
George Stancel, M.D., Ph.D.
Interim Executive Vice President for Research
The University of Texas
Health Science Center at Houston

Date: 2/17/02

Attachment 1

Release Letters from The University of Texas Houston Health Science Center
Dated November 29, 2000, June 4, 2001 and August 1, 2001



Office of Legal Affairs
and Risk Management

November 29, 2000

Ms. Rosalie A. Putman
Contract Specialist
USAMRAA
ATTN: MCMR-AAA-V (Closeout)
820 Chandler Street
Ft. Detrick, Maryland 21702-5014

RE: Confirmatory Licenses

Dear Ms. Putman:

I am enclosing a confirmatory license for each of the following invention disclosures submitted by Dr. David Sirbasku:

- A. Secretory Immune System Regulation of Breast and Prostate Cancer Growth
- B. Compositions and Methods for Demonstrating High Level Steroid Hormone Effects on in vitro Cell Growth
- C. Bacterial Oncogenesis in Mucosal Epithelial Tissues
- D. Breast Cancer Prevention and the Secretory Immune System; and New Frontiers in Breast Cancer Prevention
- E. Breast Cancer Progression and the Role of Immunoglobulin Receptors; and Immunoglobulin Superfamily Receptors and Secretory Immune System Regulation of Androgen Responsive and Autonomous Prostate Cancer

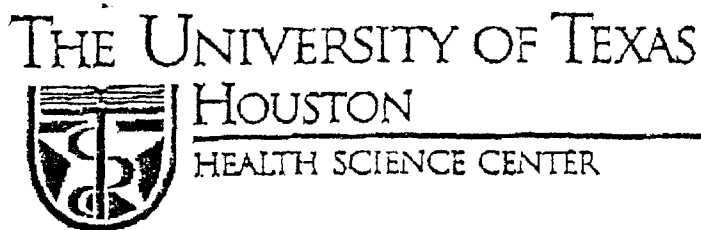
The inventions were developed under U.S. Army Grants DAMD17-94-J-4473, DAMD17-98-1-8337, and DAMD17-99-1-9405. Should any further information be required, please do not hesitate to contact me.

Sincerely,

David E. Kusnerik
Contract Administrator

Enclosure

cc: Dr. David A. Sirbasku



Office of Legal Affairs
and Risk Management

June 4, 2001

Rosalie A. Putman
Contract Specialist
U.S. Army Medical Research Acquisition Activity
820 Chandler Street
Fort Detrick
Frederic, Maryland 21702-5014

RE: U.S. Army Contracts DAMD17-94-J-4473; DAMD17-98-1-8337 DAMD17-99-1-9405

Dear Ms. Putman:

I am writing in regards to four new invention disclosures that were developed with funding provided by the above referenced contracts. The inventions are entitled 1) Compositions and Methods for Demonstrating High Level Steroid Hormone Effects on in vitro Cell Growth; 2) Bacterial Oncogenesis in Mucosal Epithelial Tissues; 3) Breast Cancer Prevention and the Secretory Immune System; and New Frontiers in Breast Cancer Prevention; and 4) Breast Cancer Progress and the Role of Immunoglobulin Receptors; and Immunoglobulin Superfamily Receptors and Secretory Immune System Regulation of Androgen Responsive and Autonomous Prostate Cancer. Confirmatory licenses to the U.S. Government were previously submitted to your office on November 29, 2000 (copy attached).

The Intellectual Property Advisory Committee of The University of Texas Health Science Center at Houston (UTH) reviewed the invention disclosures. As a result of that review, UTH elected not to retain title to the invention. The inventor, Dr. David Sirbasku, subsequently requested that UTH return the inventions to him. UTH has approved Dr. Sirbasku's request subject to the U.S. Army approval. We now seek the approval of the U.S. Army to return these inventions to Dr. Sirbasku subject to the requirements of 35 USC, Section 201 et seq.

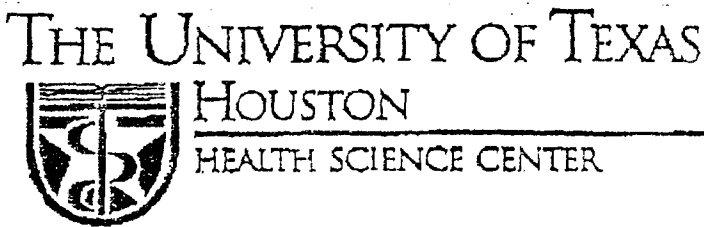
Kindly advise us of any further documentation, forms, etc. that are necessary in completing this transaction and acquiring the Army's approval for this release. We look forward to hearing from you soon.

Sincerely,

David E. Kusnerik
Contract Administrator

Enclosures

cc: Dr. Bruce Butler



Office of Legal Affairs
and Risk Management

August 1, 2001

VIA OVERNIGHT MAIL

Office of the Staff Judge Advocate
U.S. Army Medical Research & Materiel Command
504 Scott Street
Fort Detrick, MD 21702-5012
ATTN: MCMR-JA (Ms. Arwine)

RE: Request for Release of Inventions for Dr. David Sirbasku

Dear Ms. Arwine:

As a follow up to our conversation, please find enclosed the following documents:

- Copy of letter of the June 4, 2001, letter to Ms. R. Putman seeking the approval of the U.S. Army to release certain inventions to Dr. David Sirbasku.
- Copy of U.S. Patent Application Ser. No. 09/852,958 entitled Compositions and Methods for Demonstrating Secretory Immune System Regulation of Steroid Hormone Responsive Cancer Cell Growth
- Copy of U.S. Patent Application Ser. No. 09/852,547 entitled Compositions and Methods for Diagnosis, Treatment and Prevention of Steroid Hormone Responsive Cancers

The above patent applications encompass the four inventions addressed in the June 4, 2001, correspondence. Inasmuch as The University of Texas Health Science Center at Houston recommended approval of the return of the inventions to Dr. Sirbasku, we respectfully request that the U.S. Army release to Dr. Sirbasku all four inventions as they are described in the four provisional patent applications as well as the two utility applications and corresponding PCT applications. Should you require any further information, please do not hesitate to contact me. We look forward to hearing from you.

Sincerely,

David E. Kusnerik
Contract Administrator

Enclosure

cc: Dr. David Sirbasku (w/o enclosure)

Attachment 2

Release Letters from U.S. Army of Grant Nos. DAMD17-94-J-4473, DAMD17-98-8337
and DAMD17-99-1-9405, dated September 19, 2001 and November 21, 2001



DEPARTMENT OF THE ARMY
US ARMY MEDICAL RESEARCH AND MATERIEL COMMAND
504 SCOTT STREET
FORT DETRICK, MARYLAND 21702-5012

REPLY TO
ATTENTION OF

November 21, 2001

Office of the
Staff Judge Advocate

Mr. David E. Kusnerik
Contract Administrator
Office of Legal Affairs & Risk Management
University of Texas, Houston Health Science Center
P.O. Box 20036
Houston, Texas 77225

SUBJECT: U.S. Patent Application Serial No. 09/852,958, Compositions & Methods for Demonstrating Secretary Immune System Regulation of Steroid Hormone Responsive Cancer Cell Growth; Patent Application Serial No. 09/852,547, Compositions & Methods for Diagnosis, Treatment & Prevention of Steroid Hormone Responsive Cancers; U.S. Provisional Patent Applications Serial No. 60/203,314 and 60/208,348, 60/208,111, and 60/231,273; International Patent Applications Serial No. PCT/US01/15183 and PCT/US01/15171; Inventor: David Sirbasku, Army Funding Agreements: DAMD17-94-J-4473, DAMD17-98-1-8337, and DAMD17-98-1-9405

Dear Mr. Kusnerik:

It has come to my attention that my letter dated September 19, 2001 regarding the above identified invention and patent applications omitted reference to two funding agreements, DAMD17-98-1-8337 and DAMD17-98-1-9405. Dr. Sirbasku has informed me that the invention was supported not only by funding under DAMD17-94-J-4473 but also by funding under DAMD17-98-1-8337 and DAMD17-98-1-9405.

We release the U.S. Army's interest in the title to the invention identified above in favor of the inventor. As agreements DAMD17-98-1-8337 and DAMD17-98-1-9405 are still active, other inventions that may arise during the course of the continuing research or life of the agreements will have to be separately reported and considered.

Please give me a call at (301) 619-7808 if you have questions.

Sincerely,

Elizabeth Arwine

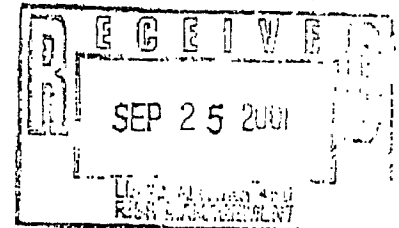
Elizabeth Arwine
Department of the Army
Patent Attorney



DEPARTMENT OF THE ARMY
US ARMY MEDICAL RESEARCH AND MATERIEL COMMAND
504 SCOTT STREET
FORT DETRICK, MARYLAND 21702-5012

REPLY TO
ATTENTION OF

September 19, 2001



Office of the
Staff Judge Advocate

Mr. David E. Kusnerik
Contract Administrator
Office of Legal Affairs & Risk Management
University of Texas, Houston Health Science Center
P.O. Box 20036
Houston, Texas 77225

SUBJECT: DAMD17-94-J-4473, U.S. Patent Application Serial No. 09/852,958, Compositions & Methods for Demonstrating Secretory Immune System Regulation of Steroid Hormone Responsive Cancer Cell Growth; Patent Application Serial No. 09/852,547, Compositions & Methods for Diagnosis, Treatment & Prevention of Steroid Hormone Responsive Cancers; U.S. Provisional Patent Applications Serial No. 60/203,314 and 60/208,348, 60/208,111, and 60/231,273; International Patent Applications Serial No. PCT/US01/15183 and PCT/US01/15171; Inventor: David Sirbasku

Dear Mr. Kusnerik:

Our Invention Evaluation Committee met today to consider University of Texas, Houston's request that we release the U.S. Army's interest in the title to the invention identified above in favor of the inventor. We have no objection to Dr. Sirbasku receiving title to the invention so long as the government retains a royalty-free, non-exclusive license to the invention such that we can practice or have the invention practiced for government purposes.

Please give me a call at (301) 619-7808 if you have questions.

Sincerely,

Elizabeth Arwine

Elizabeth Arwine
Department of the Army
Patent Attorney

Copy Furnished:
Dr. Patricia Modrow, CDMRP
Mr. Danny Laspe, USAMRAA