

11-03-2003  
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11-302

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

1. Name of conveying party(ies):

Cell Works Inc.

2. Name and address of receiving party(ies)

Name: Cell Works Diagnostics Inc.

Internal Address: \_\_\_\_\_

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:



Assignment



Merger



Security Agreement



Change of Name



Other \_\_\_\_\_

Street Address: 2711 Centreville Road

Suite 400

City: Wilmington State: DE Zip: 19808

Execution Date: August 22, 2003

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

4. Application number(s) or patent number(s):

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

A. Patent Application No.(s) 60/413,987;  
60/451,060; 60/488,865; 09/430,175;  
09/501,179

B. Patent No.(s) \_\_\_\_\_

Additional numbers attached? ☐ Yes ☒ No

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

Name: Sherry H. Flax

Internal Address: Saul Ewing LLP

Street Address: 100 S. Charles St.

15th Floor

City: Baltimore State: MD Zip: 21201

6. Total number of applications and patents involved: ☐

7. Total fee (37 CFR 3.41).....\$ \_\_\_\_\_



Enclosed



Authorized to be charged to deposit account

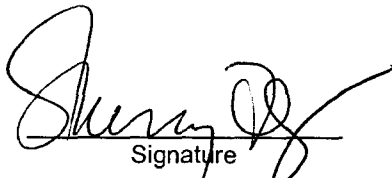
8. Deposit account number:

DO NOT USE THIS SPACE

9. Signature.

Sherry H. Flax

Name of Person Signing



Signature

Oct. 30, 2003

Date

Total number of pages including cover sheet, attachments, and documents: 11

11/04/2003 6T0N11 00000032 60413987

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Mail documents to be recorded with required cover sheet information to:  
Commissioner of Patents & Trademarks, Box Assignments  
Washington, D.C. 20231

Attachment 5(a) (8 Pages)

**Execution Version**

# Assignment

between

**Cell Works Inc.**

as Assignor

and

**Cell Works Diagnostics Inc.**

as Assignee

relating to

assignment of certain patents, patent applications,  
licences and other intellectual property

**Simmons & Simmons**

CityPoint One Ropemaker Street London EC2Y 9SS

T 020 7628 2020 F 020 7628 2070 DX Box No 12

C:\My Documents\Corporate Docs\Primary CWI-CWD assignment\Final-220803.doc

## CONTENTS

1.	Interpretation .....	1
2.	Assignment .....	2
3.	Consideration .....	3
4.	Further Assistance .....	3
5.	Charge .....	4
6.	Warranties .....	4
7.	Law and Jurisdiction .....	4
SCHEDULE 1 : THE PATENTS .....		5
SCHEDULE 2 : THE LICENSES .....		6

**THIS ASSIGNMENT** is dated as of and with effect from 22nd August 2003 and made

**BETWEEN:**

- (1) **CELLS WORKS INC.**, (the "**Assignor**"), a company organised and existing under the laws of Delaware whose registered office is c/o Corporation Service Company, 2711 Centerville Road, Suite 400, Wilmington, Delaware 19808, USA and whose principal place of business is at 6200 Seaforth Street, Freeport Centre, Holabird Business Park, Baltimore, Maryland 21224-6506, the United States of America; and
- (2) **CELL WORKS DIAGNOSTICS INC.**, (the "**Assignee**"), a company organised and existing under the laws of Delaware, and whose registered office is at 2711 Centerville Road, Suite 400, Wilmington, Delaware 19808, USA and whose principal place of business is at 6200 Seaforth Street, Freeport Centre, Holabird Business Park, Baltimore, Maryland 21224-6506, the United States of America

**Background:**

- (A) The Assignor has agreed to assign the Patents and the benefit of the Licenses to the Assignee, subject to the Charge, and to assign certain other intellectual property rights to the Assignee.

**The parties agree that:**

1. **Interpretation**

- 1.1 In this Agreement, the following expressions shall have the following meanings:

**"Charge"** means the Deed of Charge dated 15 July 2003 between Assignor and Tiger whereby the Assignor as beneficial owner charged the Patents and Licenses to Tiger by way of first fixed charge as a continuing security for the due and punctual performance and discharge of the Liabilities.

**"Business Day"** means any day on which branches of banks in Hong Kong are ordinarily open to the public for business (other than a Saturday or Sunday).

**"Inventions"** means all inventions, improvements, modifications, processes, formulae, models, prototypes and sketches, drawings, plans or specifications therefor or other matters which the Assignor alone or with one or more others has made, devised or discovered and/or may make, devise or discover at any time from the date hereof and which or will pertain or are or will be actually or potentially useful to the commercial or industrial activities from time to time of the Assignor or which pertain to, result from or are suggested by any work which the Assignor has done or may hereafter do, and which in all cases are or will be made, devised or discovered, directly or indirectly, pursuant to funding or other resources or assistance provided by Assignee.

**"Patents"** means the patents, patent applications and patent rights whose details appear in schedule 1.

**"Liabilities"** means the liabilities as defined in the Charge.

**"Licenses"** means all of the licenses which have been at the date of this Assignment granted by Assignor in respect of the Patents and the licence granted to Assignor and sub-licence granted by Assignor as specified in Schedule 2.

**"Intellectual Property"** means all patents, trade marks, service marks, rights (registered or unregistered) in any designs; applications for any of the foregoing; trade or business names; copyright (including rights in computer software), topography rights; know-how; secret formulae and processes; lists of suppliers and customers and other confidential and proprietary knowledge and information; rights protecting goodwill and reputation; Internet domain names; database rights and all rights and forms of protection of a similar nature to any of the foregoing or having equivalent effect anywhere in the world and all rights under licences and consents in respect of any of the rights and forms of protection mentioned in this definition, and which are made, created, devised, registered or are the result of work product made possible or resulting from, directly or indirectly, funding or other resources or assistance provided by Assignee.

**"Remaining IP Rights"** means all Intellectual Property owned by Assignor in any part of the world, other than the Patents, Licences and rights in the Inventions.

**"Tiger"** means Tiger Technology Limited whose registered office is at P.O. Box 957, Offshore Incorporations Centre, Road Town, Tortola, British Virgin Islands.

## **2. Assignment**

2.1 The Assignor hereby assigns as legal and beneficial owner the Patents to the Assignee with full title guarantee, including, without limitation:

- (A) all rights to bring any proceedings and obtain any remedy in respect of any infringement of the Patents which has occurred prior to the date of this Assignment;
- (B) all rights to claim priority from the Patents and file patent applications in respect of the inventions disclosed by the Patents;
- (C) all rights to any continuations, continuations in part, divisions, extensions, amendments, conversions, reissues, re-examinations, renewals or restorations of the Patents.

to hold the same to the Assignee, its successors and assigns absolutely and free from encumbrances, but subject always to the Charge.

2.2 The Assignor as beneficial owner hereby assigns the entire legal and beneficial interest in the benefit (subject to the burden) of the Licences, but subject always to the Charge.

2.3 The Assignor warrants that it has obtained all necessary consents to assign the benefit of the Licences to the Assignee hereunder.

2.4 The Assignor will promptly disclose and will forthwith deliver to Assignee full details of any inventions upon the making, devising or discovering of the same or in any event upon the request of Assignee, and will on request forthwith give all information and data in its possession as to the exact mode of working, producing and using the same and will also at the expense of the Assignor give all such explanations, demonstrations and instructions to the Assignee as it may deem appropriate to enable the full and effectual working, production or use of the same.

2.5 Any Invention shall upon the making, discovery or conception of the same or if now in existence shall belong to and vest in Assignee absolutely and beneficially together with all rights to apply for patent registrations or other similar protection. Without prejudice to the

foregoing the Assignor shall at the expense of the Assignor promptly execute and do all acts, matters, documents and things necessary to enable the Assignee or its nominee to apply for and obtain any or all applicable intellectual property rights in any or all countries relating to any inventions or other materials produced by the Assignor,

2.6 The Assignor as legal and beneficial owner hereby assigns to Assignee absolutely all right, title and interest in the Remaining IP Rights together with all rights of action and remedies in relation to infringements thereto accrued prior to the date hereof.

2.7 The parties agree that all Intellectual Property created by Assignor in the future in respect of its business and which would be owned by Assignor but for this provision shall on creation automatically vest in and be assigned to Assignee.

### 3. Consideration

3.1 In consideration for the assignments in clause 2, the Assignee pays to the Assignor the sum of US\$100, receipt of which is acknowledged by the Assignor.

### 4. Further Assistance

4.1 The Assignor shall promptly do all such things as may be reasonably required by the Assignee in order:

- (A) to perfect or confirm the Assignee's ownership of the Patents, the benefit to the Licenses, the inventions and/or the Remaining IP Rights;
- (B) to ensure that the Assignee is registered as the registered proprietor of the Patents with the relevant patent offices and/or that Assignee secures any appropriate registrations in respect of the inventions and/or Remaining IP Rights;
- (C) to assist the Assignee or its licensees to take legal proceedings against third parties in respect of any infringement of the Patents, inventions and/or Remaining IP Rights;
- (D) to assist the Assignee or its licensees to defend any legal proceedings brought by third parties in relation to the use of the Patents, inventions and/or Remaining IP Rights by the Assignee or its licensees;
- (E) to give the Assignee the full benefit of this Agreement.

4.2 Within 5 Business Days of the date of this Agreement, the Assignor shall deliver up to the Assignee the following items (in so far as the same have not already been provided to Assignee):

- (A) originals of all registration certificates and renewal certificates for the Patents (and where no Patent has yet been granted the application receipts therefor);
- (B) originals (or, if not available, then copies) of all documents concerning all previous transfers of ownership of the Patents; and
- (C) copies of all correspondence, evidence and legal advice which concerns any ongoing matters relating to the Patents.
- (D) Originals and all copies of the Licenses.

4.3 The Assignor shall on demand forthwith deliver up to Assignee all documents and other materials and items relating to or embodying the Inventions and/or Remaining IP Rights.

5. **Charge**

5.1 The Assignee acknowledges that the effect of assigning the Patents and Licences subject to the Charge is that in so far as Assignor defaults in its due performance and discharge of the Liabilities, Assignee will be obliged to assign the Patents and benefit of the Licences to Tiger or its nominee on terms to be agreed with Tiger. For this purpose the Assignee acknowledges that it will be required to execute an assignment in favour of Tiger or its nominee which will be put in escrow on agreed terms.

6. **Warranties**

6.1 The Assignor hereby warrants to and undertakes with the Assignee that:

- (A) The Assignor is the beneficial owner of the Patents, Inventions and/or Remaining IP Rights and has good right and title to assign the same on the terms of this Assignment and subject to the Charge no third party has any right or claim to the Patents, Inventions and/or Remaining IP Rights whether at law or in equity;
- (B) The Assignor has full power, authority and legal right to enter into and perform its obligations under this Assignment and has taken or obtained all necessary corporate and other actions to authorise the execution and performance of this Assignment;
- (C) The Patents are to the best of the Assignor's knowledge and belief valid and subsisting and registered or subject to applications for registration in the name of the Assignor.

7. **Law and Jurisdiction**

7.1 This Agreement shall be governed by and construed in accordance with Maryland law.

7.2 In respect of any dispute or disagreement arising under or in connection with this Agreement, each of the parties shall submit to the non-exclusive jurisdiction of the Maryland courts.

### **SCHEDULE 1: THE PATENTS**

1. As attached and marked in Schedule (A).
2. All rights to apply for patent protection worldwide based on the patents and patent applications specified at 1 above and/or based on improvements, findings or discovering flowing from or otherwise howsoever deriving from the invention, technology, know-how or within the disclosure in such patents and patent applications.
3. Any and all other patents and patent applications that now or in the future are or become subject to the Charge, and which are based upon patents or patent applications under items 1 and/or 2 above.



## **SCHEDULE 2: THE LICENSES**

1. The exclusive patent licence effective 25 November 1996 granted to Assignor (formerly Cell-Gen Laboratories, L.P.) by John Hopkins University ("the JHU License") in respect of an invention entitled "A Method of Enriching Rare Non-Blood Cells" the subject of US Patent No.5,962,237.
2. The sub-licence granted under the Agreement dated 21 November 2001 by the Assignor to Cell Works Asia Limited in respect of the JHU Licence.

IN WITNESS WHEREOF the duly authorised representatives of the parties have signed this Agreement on the date first before written.

Signed by )  
Harold E. Chappellear, LLD (Hon.) )  
President and CEO )  
For and on behalf of )  
Cell Works Inc. )

*Harold E. Chappellear*

Signed by )  
Harold E. Chappellear, LLD (Hon.) )  
President and CEO )  
For and on behalf of )  
Cell Works Diagnostics Inc. )

*Harold E. Chappellear*

### SCHEDULE A INTELLECTUAL PROPERTY LISTING

The following patent applications are owned by CWI and will be transferred to Cell Works  
Diagnostics:

Title	Cell Works #	Official #
Multiple Marker Characterization of Single Cells	CW-304	09/430,175
Multiple Marker Characterization of Single Cells	CW-304PCT	US99/25324
Multiple Marker Characterization of Single Cells - FOREIGN	304-Austria 304-Australia 304-Canada 304-Gbritan 304-Germany 304-Japan	A9110/99 14552/00 2,350,692 0111742.3 DE19983691.4 2000-579996
Class Characterization of Circulating Cancer Cells Isolated from Body Fluids and Methods of Use	CW-307	09/501,179
Automated Magnetic Sorter	CW-401P	60/413,987
Standardized Evaluation of Therapeutic Efficacy Based on Cellular Biomarkers	CW-404P	60/451,050
A Universal Test with Quantitative Measurement & Characterization of Circulating Cancer Cells	CW-412P	60/488,865

The following patents and patent applications are owned by Johns Hopkins University (JHU) and licensed to CWI and will be sublicensed to Cell Works Diagnostics upon JHU approval:

Title	Cell Works #	Official #
Method of Enriching Rare Cells ISSUED 10/5/99	DM-3094	08/832,468 6,962,237
Method of Enriching Rare Cells	DM-3094- CON2	10/281,043 Con of 09/348,670
Method of Enriching Rare Cells	DM-3094PCT	US97/05586 WO 97/38313
Method of Enriching Rare Cells FOREIGN	DM-3094CAN DM-3094CH DM-3094EPO DM-3094HK DM-3094JPN DM-3094ROC	2,251,186 97195305.8 97920110.0 99105069.7 536336/1997 86104288