

1/20/04

01-23-2004

Form **PTO-1595**  
(Rev. 10/02)  
OMB No. 0651-0027 (exp. 6/30/2005)  
Tab settings  $\Rightarrow \Rightarrow \Rightarrow$

**RECOF**



U.S. DEPARTMENT OF COMMERCE  
U.S. Patent and Trademark Office

102653176

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

1. Name of conveying party(ies):  
SignalGene, Inc.

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

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

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

Street Address: 2270-K Camino Vida Roble

City: Carlsbad State: CA Zip: 92009

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

3. Nature of conveyance:

Assignment  Merger  
 Security Agreement  Change of Name  
 Other \_\_\_\_\_

Execution Date: May 9, 2003

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) \_\_\_\_\_

B. Patent No.(s)  
6183963

Additional numbers attached?  Yes  No

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

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

Street Address: 611 Anton Blvd., 14th Floor

City: Costa Mesa State: CA Zip: 92626

6. Total number of applications and patents involved:  1

7. Total fee (37 CFR 3.41).....\$ 40.00

Enclosed  
 Authorized to be charged to deposit account

8. Deposit account number:  
502191

(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.*

Martin Fessenmaier  
Name of Person Signing

[Signature]  
Signature

01/17/04  
Date

Total number of pages including cover sheet, attachments, and documents: 4

Filed together with a new patent application to:  
Mail Stop Patent Application  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Not filed with new patent application to:  
Mail Stop Assignment Recordation Services  
Director of the U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PATENT**  
**REEL: 014892 FRAME: 0940**

OPR/FINANCE  
JAN 20 2004  
40.00 DA  
01/22/2004 ECDPER 00000189 502191 0163963  
01 FC:8021

## Patent Assignment Agreement

---

**THIS AGREEMENT** is made as of this 8<sup>th</sup> day of May 2003 (hereinafter the "Effective Date")

**BETWEEN:**

**SignalGene Inc.** having its principal place of business located at 8475 Christophe-Colomb Avenue, Suite 1000, Montréal, Québec, H2M 2N9 (hereinafter "**SignalGene**")

and

**AutoGenomics, Inc.** having its principal place of business located at 2270-K, Camino Vida Roble, Carlsbad, CA 92009 (hereinafter "**AutoGenomics**").

**SignalGene** and **AutoGenomics** are referred to in this Agreement individually as a "Party" and collectively as the "Parties".

**WHEREAS**, **SignalGene** is the owner of all rights, title and interests in United States Patent No. 6,183,963 (hereinafter referred to as the "Patent") and is willing to sell and assign such rights, title and interests;

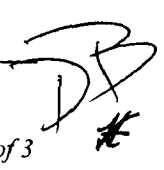
**AND WHEREAS**, **AutoGenomics** is willing to purchase and accept the rights, title and interests to the Patent and assume the related costs of the transfer;

**NOW THEREFORE**, in consideration of the foregoing premises, the mutual covenants and obligations hereinafter contained, and other and good and valuable consideration, the receipt and adequacy of which is acknowledged, the parties hereby agree to the following:

1. **Ownership:** **SignalGene** hereby represents and warrants that as of the Effective Date it is the owner of the entire rights, title and interests in the Patent and that rights, title and interests to the Patent have not been licensed or otherwise granted to any third parties.
2. **Assignment:** **SignalGene** shall promptly, but no later than May 31, 2003, assign all rights, title and interests to the Patent to **AutoGenomics**. **SignalGene** undertakes to do, sign, remit or cause to be done, signed or remitted, all other acts, documents and things that **AutoGenomics** may reasonably require to perfect and enjoy its rights under this Agreement and in particular, any and all documents necessary or useful in order for the Patent to be registered in the name of **AutoGenomics** in lieu and place of **SignalGene**.
3. **Consideration:**
  - 3.1 **Payments:** In consideration of the assignment of rights under this Agreement to **AutoGenomics**, **AutoGenomics** shall pay to **SignalGene** a one-time lump sum payment of thirty one thousand, one dollar and ninety nine cents (\$31,001.99).
  - 3.2 **Taxes:** No sales taxes are included in the payment described in clause 3.1. However, should **AutoGenomics** be registered with the Canadian Government for Goods and Services Taxes (GST) or with the Quebec Government for the Quebec Sales Tax (QST) then **AutoGenomics** shall add the GST (7%) and QST (7.5%) to the payment price for a total price of thirty five thousand, four hundred, ninety seven dollars and twenty eight cents (\$31,001.99 + \$2,170.14 GST + \$2,487.91 QST = \$35,660.04).
  - 3.3 **Cost of Assignment:** **AutoGenomics** hereby acknowledges and agrees that as the new owner of the assigned Patent it will directly assume the sole responsibility for the payment of any and all

---

**SignalGene** 

Page 1 of 3 

**PATENT**  
**REEL: 014892 FRAME: 0941**

costs and expenses, including but not limited to, any legal costs, United States Patent Office fees or patent agent fees related to the assignment of the Patent in favour of **AutoGenomics**.

- 3.4 Payment Due:** AutoGenomics shall make the payment to **SignalGene** by returning a signed copy of this Agreement along with a valid cheque for the full amount of the payment stipulated in clause 3.1. Once the funds have been confirmed deposited and accessible by **SignalGene's** bank, **SignalGene** will instruct its patent agent to proceed with the assignment according to the instructions provided by **AutoGenomics**.
- 3.5 Payment Refused:** Should the payment not be effected correctly or should the bank refuse the cheque for non sufficient funds this Agreement shall automatically become null and void and **SignalGene** shall have no further obligation to proceed with the assignment of the Patent.
- 4. Deadline:** The Parties recognise that **SignalGene** must complete this transaction prior to May 31, 2003 and both Parties shall do everything reasonable to meet that deadline. Should the deadline not be met, **SignalGene** reserves the right to unilaterally terminate this Agreement without further notice and shall have no further obligation to proceed with the assignment of the Patent.
- 5. Restricted Use:** AutoGenomics hereby acknowledges that Hôpital Sainte-Justine has a teaching and research mission and that despite this assignment, Hôpital Sainte-Justine and the registered inventors Dr. Damian Labuda and Dr. Daniel Sinnett shall be entitled to use the invention as claimed and disclosed in order to pursue such mission for teaching and non-commercial research. For the sake of clarity, it is understood that the above mentioned restricted use shall not include the right for Hôpital Sainte-Justine, Dr. Damian Labuda and Daniel Sinnett to grant licenses with respect to the Patent or commercially exploit the Patent in any manner whatsoever.
- 6. Maintenance:** AutoGenomics hereby acknowledges that as the owner of the assigned Patent, all matters related to the maintenance and enforcement of the Patent shall be the sole responsibility of **AutoGenomics** and in particular, but without restriction, that **AutoGenomics** shall be solely responsible for the payment of all maintenance and other fees to the United States Patent Office relating to the maintenance of the assigned Patent as well as all enforcement matters whether by way of infringement or other legal challenges. Notwithstanding, AutoGenomics has no obligation to maintain or enforce the patent.
- 7. Disclaimer:** **SignalGene** hereby excludes and disclaims and **AutoGenomics** hereby waives all warranties, conditions, representations and guarantees, whether express or implied, and whether arising by law, by custom, by oral or written statements of **SignalGene** with respect to the Patent, its merchantability or its fitness for a particular purpose. The entire risk as to the results and performance of the Patent and any product, service or methods based on the Patent is assumed by **AutoGenomics**.
- 8. General:**
- 8.1 Currency:** Unless otherwise specified, all dollar amounts referred to in this Agreement are in the funds of the United States of America.
- 8.2 Binding Effect:** The provisions hereof shall enure to the benefit of and be binding upon, the Parties hereto and their respective employees, agents, officers, directors, Affiliates, subsidiaries, heirs, executors, administrators, successors and permitted assigns. For the purpose of this Agreement, the term "Affiliate" shall mean any corporation or other business entity controlling, controlled by or under common control with a Party; and for such purpose "control" shall mean direct or indirect ownership of: i) fifty percent (50%) or more of the voting interest in such corporation or other entity; ii) fifty percent (50%) or more of the interest in the profit or income in the case of the business entity other than a corporation; or iii) in the case of a partnership, control of the general partners.

- 8.3 Entire Agreement:** With respect to the subject matter of this Agreement, this Agreement sets forth the entire agreement between the Parties hereto and any persons who have in the past or who are now representing either of the Parties hereto, and supersedes all prior understandings and communications between the Parties hereto or any of them, oral or written.
- 8.4 Reliance:** Each Party hereto acknowledges and represents that this Agreement is entered into after full investigation and that no Party is relying upon any statement or representation made by the other of them or by any other person which is not embodied in this Agreement.
- 8.5 Amendments:** The Parties hereto further acknowledge that they shall have no right to rely upon any amendment, promise, modification, statement or representation made or occurring subsequent to the execution of this Agreement unless the same is in writing and executed by each of the Parties hereto.
- 8.6 Severability:** If any provision of this Agreement or the application thereof to any person or circumstance shall, to any extent, be invalid or unenforceable, the remainder of this Agreement, or the application of such provision to persons or circumstances other than those as to which it is held invalid or unenforceable, shall not be affected thereby and each provision of this Agreement shall be valid and enforced to the fullest extent permitted by law and be independent of every other provision of this Agreement.
- 8.7 Governing Law:** This Agreement and the rights, obligations and relations of the Parties hereto shall be governed by and construed in accordance with the laws of the Province of Québec and the federal laws of Canada applicable therein but without giving any consideration to conflict of laws rules.
- 8.8 Headings:** The section and subsection titles and headings contained in this Agreement are for convenience of reference only. Such titles and headings do not form a part of this Agreement, shall not define or limit the scope of the sections or subsections, and shall not affect the construction or interpretation of any of the sections or subsections.
- 8.9 Language:** The Parties hereto have requested that this Agreement and all notices given pursuant hereto be drafted in the English language. Les Parties aux présentes confirment et déclarent qu'elles ont demandé que cette Convention et les avis qui s'y rattachent soient rédigés en langue anglaise.
- 8.10 Execution:** This Agreement shall be binding on the Parties when signed by Autogenomics and accepted by SignalGene, or *vice versa*, as the case may be.

IN WITNESS WHEREOF each of the Parties hereto has caused this Agreement to be executed by a duly authorised representative.

FOR SignalGene Inc.:

Doris Belzile  
Name (Please Print)

Chief Financial officer  
Title (Please Print)

*D. Belzile*  
Signature

May 8<sup>th</sup>, 2003  
Date

FOR AutoGenomics, Inc.:

Fareed Kureshy  
Name (Please Print)

Chairman, President & CEO  
Title (Please Print)

*Fareed Kureshy*  
Signature

May 9<sup>th</sup> 2003  
Date

