

04-26-2004



102729941

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

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

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

1. Name of conveying party(ies):

Ervin Essenfeld Harold Essenfeld

4.22.04

2. Name and address of receiving party(ies)

Name: University of Miami

Internal Address: 1600 N.W. 10th Avenue

Miami, Florida 33101

United States of America

Street Address: (same as above)

City: State: Zip:

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

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

3. Nature of conveyance:

- Assignment Merger Security Agreement Change of Name Other License Agreement

Execution Date: October 10, 1997

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) 09/735,914; 09/735,918; 10/400,060

B. Patent No.(s) US 6,513,167 B1 US 6,207,408 B1; and US 6,586,713 B2

Additional numbers attached? Yes No

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

Name: Mitchell P. Brook

Internal Address:

Luce, Forward, Hamilton & Scripps LLP

Street Address:

11988 El Camino Real, Suite 200

City: San Diego State: CA Zip: 92130

6. Total number of applications and patents involved:

7. Total fee (37 CFR 3.41) \$ 360.00

- Enclosed Authorized to be charged to deposit account

8. Deposit account number:

50-2298 (in the name of Luce, Forward, Hamilton & Scripps, LLP)

DO NOT USE THIS SPACE

9. Signature.

Mitchell P. Brook Name of Person Signing

Signature

4/19/04 Date

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

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

04/23/2004 MGETACHE 00000087 50298 6513167 01 FC:8021 360.00 DA

PATENT REEL: 015246 FRAME: 0020

RECORDATION FORM COVER SHEET – CONTINUATION
PATENTS ONLY

Form **PTO-1595**
(Rev. 10/02)

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

OMB No. 0651-0027 (exp. 6/30/2005)

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)

PCT/US00/33760	
PCT/US00/33761	
PCT/US01/18392	

LICENSE AGREEMENT

This License Agreement (the "Agreement") is entered into and made effective the 10th day of OCTOBER, 1997, (the "Effective Date") between UNIVERSITY OF MIAMI and its School of Medicine Department of Pathology, whose principal place of business is at 1600 N.W. 10th Avenue, Miami, Florida 33101 (hereinafter referred to as "LICENSEE") and Dr. Ervin Essinfeld and Dr. Harold Essinfeld, Anatomia Patologia y Citologia, Avenida Suere De Los Dos Caminos, Residencia Yutaje, pb, Local 4, Caracas 1071, Venezuela (hereinafter referred to as "LICENSOR").

WITNESSETH

WHEREAS, LICENSOR is the sole owner of the technology and product identified as Tissue Processing Methods and Procedures and all Products and Processes associated therewith including but not limited to any and all inventions, discoveries, information, know-how and data, technical or non-technical, and product samples and specifications whether patented or not patented relating to Tissue Processing Methods and Procedures and joint owner of University of Miami Invention Disclosure and patents deriving from said Invention Disclosure entitled Forty Minute Continuous Throughput Tissue Fixation, Processing and Paraffin Embedding Method dated May 20, 1997 and US Provisional Patent Application entitled A High Quality, Continuous Throughput, Tissue Fixation-Dehydration-Fat Removal-Impregnation Method and filed on August 20, 1997 outlined in Exhibit A (hereinafter "Technology"); and,

WHEREAS, LICENSEE wishes to obtain United States and foreign Patents, and attempt to commercialize the Technology; and,

WHEREAS, LICENSOR warrants that it possesses the right to license the aforestated Technology; and,

WHEREAS, LICENSOR wishes the LICENSEE to obtain the subject patents, and to attempt to commercialize the Technology; and,

WHEREAS, LICENSEE desires to acquire an exclusive license in the Territory with the right to sublicense or assign, the Technology (as defined in Paragraphs 1.4 and 1.5 below) for the purposes of making, having made for its own use and sale, using and selling Products or Process;

NOW THEREFORE, For these and other valuable considerations, the receipt of which is hereby acknowledged, the parties agree as follows:

1. DEFINITIONS:

1.5 "Product" shall mean any product or part thereof which is derived from the inventions, discoveries, information, know-how and data, technical or non-technical, and product samples and specifications whether patented or not patented relating to the Technology outlined in Exhibit A; and,

1.6 "Process" shall mean any process which is derived from the inventions, discoveries, information, know-how and data, technical or non-technical, and product samples and specifications whether patented or not patented relating to the Technology outlined in Exhibit A



1.10 "Territory" shall mean Worldwide.

1.11 "Field of Use" shall mean any and all uses.

2. GRANT:

2.1 In consideration for payment of royalties, LICENSOR hereby grants to LICENSEE an exclusive license to the Technology in the Territory for the Field of Use, with the right to sublicense or assign the Technology and, under the Technology or Patent Rights, to make, have made for its own use and sale, use and sell Product or Process and to practice the method of the Product or Process.

2.2 LICENSOR grants to the LICENSEE the authority to make application for Patents, in the name of the LICENSEE and LICENSOR; all expenses of obtaining and maintaining said patents shall be paid by LICENSEE. LICENSOR agrees to do such acts and execute such documents as shall be necessary or desirable to enable LICENSEE to file patent applications and prosecute said applications.

2.3 LICENSOR retains the right to use the Technology for its own use in its own medical practice.

2.4 Any improvements, extensions, modifications or additions to the Technology and any patents issued in relation thereto, whether developed by the LICENSEE, or the LICENSOR, shall be subject to this License Agreement, and specifically, the provisions of Paragraph 14 hereinbelow.



5. PATENT PROTECTION:

LICENSEE, during the term of this Agreement, is responsible for the filing, payment and the prosecution of all patents and applications and extensions thereof, and maintenance fees covered by this Agreement. In the event that any patent is issued, LICENSEE shall be responsible for the filing, payment and prosecution of any extensions thereto which may be available.



IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed by their respective officers thereunto duly authorized to be effective as of the Effective Date.

By: [Signature]

Name: Harold Essenfeld

Date: 10/2/97

Title: Licensor

By: [Signature]

Name: ERVIN ESSENFELD

Date: 10/2/97

Title: LICENSOR

UNIVERSITY OF MIAMI

By: [Signature]

Name: ALAN PISH

Date: 10/10/97

Title: VP BUS SER

agn\essenfe2.agn
10/01/97

[Handwritten mark]

[Handwritten mark]