

Form PTO-1595 (Rev. 09/04)
OMB No. 0651-0027 (exp. 6/30/2005)

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

RECORDATION FORM COVER SHEET PATENTS ONLY

To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.

1. Name of conveying party(ies)/Execution Date(s):

Waldemar Debinski
Val-Chum, LP

Execution Date(s) November 19, 2004

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

3. Nature of conveyance:

- Assignment Merger
- Security Agreement Change of Name
- Government Interest Assignment
- Executive Order 9424, Confirmatory License
- Other _____

2. Name and address of receiving party(ies)

Name: Centre Hospitalier de L'Universite de Montreal

Internal Address: _____

Street Address: 3840 St. Urbain Street

City: Montreal

State: Quebec

Country: Canada Zip: H2W 1T8

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

4. Application or patent number(s):

This document is being filed together with a new application.

A. Patent Application No.(s)

08/404,685

B. Patent No.(s)

Additional numbers attached? Yes No

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

Name: Livia N. Jones, Esq.

Internal Address: _____

Street Address: 811 University Drive

City: State College

State: PA Zip: 16801

Phone Number: 814-238-4826

Fax Number: 814-234-5620

Email Address: ljones@mcquaidablasko.com

6. Total number of applications and patents involved:

1

7. Total fee (37 CFR 1.21(h) & 3.41) \$ 40.00

- Authorized to be charged by credit card
- Authorized to be charged to deposit account
- Enclosed
- None required (government interest not affecting title)

8. Payment Information

a. Credit Card Last 4 Numbers _____
Expiration Date _____

b. Deposit Account Number 50-1740

Authorized User Name McQuaide Blasko

9. Signature:

Signature

January 10, 2005

Date

Livia N. Jones

Name of Person Signing

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

9

Documents to be recorded (including cover sheet) should be faxed to (703) 306-5996, or mailed to:
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

CH \$40.00 501740 08404685

ASSIGNMENT OF PATENTS AND AGREEMENT TO SHARE PROCEEDS OF COMMERCIALIZATION entered into in Montreal, this _____ day of October, 2004

BETWEEN:

VAL-CHUM, LIMITED PARTNERSHIP, a limited partnership legally constituted in the Province of Quebec, having its place of business at 69 Sherbrooke St. West., Montreal, Québec, H2X 1X2, Canada, and represented by its general partner VAL-CHUM INC., having its place of business at the same address, itself herein represented by Mr. Robert A. Dubé, President;
(hereinafter referred to as "Val-CHUM")

AND:

WALDEMAR DEBINSKI, MD, Ph.D., 237 Stanaford Rd., Winston-Salem, NC 27104-2721;
(hereinafter referred to as the "Inventor")

(Val-CHUM and the Inventor are collectively referred to as the "Parties" and individually referred to as a "Party")

WHERE INTERVENE:

CENTRE HOSPITALIER DE L'UNIVERSITÉ DE MONTRÉAL, a public institution duly constituted under the *Health and Social Services Act*, having its principal place of business at 3840 St. Urbain Street, Montreal, Quebec, H2W 1T8, Canada, herein represented by Dr Denis Roy, Executive Director, and Dr Pavel Hamet, Director of Research;
(hereinafter referred to as "CHUM")

AND:

UNIVERSITÉ DE MONTRÉAL,

a public institution duly constituted under "*la Charte de l'Université de Montréal*", 1967, 15-16 Eliz.II, chap.129, having its principal place at 2900, Édouard-Montpetit blvd., Montréal, Québec, H3C 3A7, Canada, herein represented by ~~Mrs Marielle Gosselin Barre, associate vice rector, research~~ and Mr Michel Lesperance general secretary . Réal Lallier
Executive Director
Office of Research
(hereinafter referred to as "UDM")

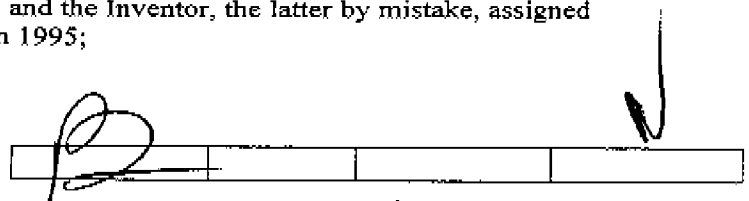
PREAMBLE

WHEREAS the Inventor, while conducting his research activities at the research center of the Hôpital Hôtel-Dieu de Montréal, an hospital affiliated with the UDM (hereinafter referred to as "HDDM"), made or reduced to practice certain inventions which are included within the Patent Rights (as defined in Paragraph 1.4 below), in collaboration with Dr. Raj Puri, Dr. Ira Pastan, and Dr. Nicholas Obiri, all then employed by the Department of Public Health Services of the United States of America (hereinafter referred to as "PHS");

WHEREAS the Inventor joined The Pennsylvania State University (hereinafter referred to as the "PSU") in 1994;

WHEREAS Dr. Raj Puri, Dr. Ira Pastan, Dr. Nicholas Obiri and the Inventor, the latter by mistake, assigned their rights, title and interests into the Patent Rights to PHS in 1995;

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WHEREAS the PHS assigned the Inventor's interest in the Patent Rights back to the Inventor on September 23, 1996;

WHEREAS the Inventor mistakenly assigned the Patent Rights to PSU on October 4, 1996, such assignment, which never was recorded, is now lost;

WHEREAS the Parties hereto, as well as PSU and The Penn State Research Foundation by letter dated July 7th, 2004 attached hereto as **Schedule A** agree that the such assignment of rights to PSU on October 4, 1996, is null and void and no rights in said Patent Rights will be asserted now or in the future;

WHEREAS the assignment by the Inventor of his interests in the Patent Rights should have been made to no other institution but HHDM;

WHEREAS HHDM merged with other hospitals affiliated with UDM on October 1st, 1996 to create CHUM, the hospital centre of the UDM;

WHEREAS CHUM shares its part in all intellectual property developed at CHUM with UDM in accordance with the *Contrat d'affiliation* executed on June 20th, 2000, and has the responsibility to manage such part for itself and UDM under the *Convention relative à la propriété intellectuelle* on June 13, 2002;

WHEREAS CHUM acts through its technology agent, Val-CHUM, constituted on March 19, 2004, to harvest CHUM's intellectual property rights;

WHEREAS it is the mutual desire of the Parties that their respective interests in said Patent Rights be administered in a manner to ensure the rapid commercialisation of the Patent Rights and to make their benefits widely available to the public;

WHEREAS Val-CHUM is in the process of negotiating, for the benefit of the Parties, an inter-institutional agreement with PHS for the licensing of the Patent Rights, replacing the previous *Inter-Institutional Agreement* signed by PHS and PSU on October 7, 1997 and amended in February 1999;

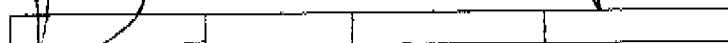
WHEREAS in accordance with the intellectual property policy of CHUM entitled *Règlement relatif à la propriété intellectuelle des résultats de la recherche*, dated May 14, 2002, (hereinafter the referred to as the "IP Policy") the Inventor agrees to assign all his rights, title and interests into the Patent Rights to Val-CHUM, under the conditions set forth herein;

NOW, THEREFORE, the Parties hereto agree to the following :

1. DEFINITIONS

- 1.1 "Gross Revenues" shall mean any and all consideration actually received by Val-CHUM from the licensing of said Patent Rights pursuant to this Agreement;
- 1.2 "Net Revenues" means Gross Revenues from which shall be subtracted i) fifteen percent (15%) for administrative overhead and ii) Recoverable Costs, when applicable;
- 1.3 "Patent Expenses" means all reasonable and actual out-of-pocket costs incurred by Val-CHUM for the preparation, filing, prosecution, and licensing of United States and foreign patent applications, related expenses, and the maintenance of resulting patents, exclusive of any salaries, administrative, or other indirect costs;
- 1.4 "Patent Rights" shall include:
- a) Patent applications (including provisional patent applications and nationalized PCT patent applications) and/or patents as follows:

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- U.S. Patent Application Serial No. 08/404,685, filed March 15, 1995, and issued as US patent 5,614,191;
- U.S. Patent Application Serial No. 08/821,840, filed March 21, 1997, and issued as US patent 5,919,456;
- U.S. Patent Application Serial No. 08/913,370, filed February 17, 1998, and issued as US patent 6,518,061;
- U.S. Patent Application Serial No. 10/318,608, filed December 13, 2002;
- and the claims of any patent application(s) claiming the benefit of priority of the above applications including all divisions and continuations of these applications, all patents issuing from such applications, divisions, and continuations, and any reissues, reexaminations, and extensions of all such patents to the extent that at least the Inventor is under obligation to assign his rights to the claims in these patents and patent applications to Val-CHUM.

1.5 "Recoverable Costs" means fifty percent (50%) of Patent Expenses incurred by the Val-CHUM from its management of Patent Rights pursuant to this Agreement, excluding costs reimbursed by third parties.

2. ASSIGNMENT OF PATENT RIGHTS

2.1 The Inventor, for good and valuable consideration, the receipt and adequacy of which is hereby acknowledged and released for as much is granted, hereby sells, assigns and transfers, exclusively to Val-CHUM any and all of his rights, title and interests in and to the Patent Rights, in the world.

2.2 Val-CHUM hereby grants to the Inventor, CHUM and UDM a perpetual license free of charge granting the right to use the Patent Rights for non-commercial research and teaching purposes only. The Inventor understands that should he need to use the Patent Rights for any other purposes, including commercial research and commercialization, he shall be required to apply for a license to use the Patent Rights.

3. PROTECTION, PROMOTION AND COMMERCIALIZATION OF PATENT RIGHTS BY VAL-CHUM

3.1 The Parties hereto agree that Val-CHUM be responsible for the protection, the promotion and the commercialization of Patent Rights.

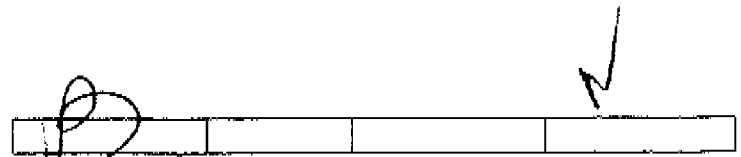
4. CONSIDERATION, PAYMENTS AND REPORTS

4.1 As consideration for entering into this Agreement and for the rights granted herein, Val-CHUM undertakes and agrees to pay to the Inventor royalties at the rate of fifty percent (50%) of total Net Revenues.

4.2 Payments due under this Agreement shall be made in American currency by way of check at the order of "Waldemar Debinski", mailed at the address set forth above or at any other address the Inventor may provide to Val-CHUM from time to time, within sixty (60) days of the receipt of any Gross Revenues by Val-CHUM.

4.3 Payments made hereunder shall be accompanied by a report setting forth the computation of royalties due and paid to Inventor by Val-CHUM.

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4.4 Should the Inventor disagree with Val-CHUM's computation of royalties, the Inventor shall have a period of six (6) months from reception of the royalty payment to notify Val-CHUM in writing. Otherwise, such payment shall be considered final and full satisfaction of the Inventor's rights.

5. REPRESENTATIONS AND WARRANTIES OF THE INVENTOR

5.1 The Inventor hereby represents and warrants the following:

- i. no other member of the HHDM' and UDM' communities has contributed to the development of the Patent Rights nor may claim inventorship into the Patent Rights;
- ii. the other contributors to the technologies that lead to the Patent Rights are those named in the preamble;
- iii. subject to the rights of PHS, he has all the rights into the Patent Rights;
- iv. he has the right to assign the Patent Rights;
- v. he has not granted any security interest in the Patent Rights to any person or organization;
- vi. he has not granted a right, license or sublicense to use the Patent Rights to any person or organization;
- vii. he shall not oppose any registration, initiate any interference proceedings, attempt to expunge, or challenge the title or ownership to, or have declared invalid any rights to the Patent Rights, or do any act which may, impair, diminish, limit or abridge Val-CHUM's, its successors' or assigns' rights in the Patent Rights, or prevent the protection or the advertising, publicizing or selling of the Patent Rights.

6. COMMITMENTS OF VAL-CHUM

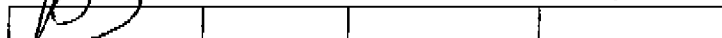
6.1 Val-CHUM commits to make its best efforts, under the circumstances, to commercialize the Patent Rights the way that, according to its own opinion, may generate the most benefits to the Parties. Such efforts may include the filing of patents applications, the grant of licenses and sublicenses and the assignment of the Patents Rights to third parties or companies affiliated to the Parties. The Inventor acknowledges that Val-CHUM has no results obligation relating to the protection, the promotion or the commercialization of Patent Rights. Val-CHUM assumes no other responsibility, nor makes any representation nor give any warranty relating to the protection, the promotion or the commercialization of Patent Rights.

6.2 Val-CHUM agrees to notify the Inventor of any license and sublicense it shall grant, or that may be granted by any licensees on the Patent Rights, world-wide. Val-CHUM declares and the Inventor acknowledges and agrees that to this date, the privileged path to commercialize the Patent Rights is by granting to PHS an exclusive license agreement including the right to sublicense, under the Patent Rights.

6.3 Val-CHUM commits to cease all commercialization approaches with regards to the Patent Rights and to grant back the Patent Rights to the Inventor under the terms and conditions contained in the IP Policy and in a grant back agreement to negotiate in good faith, provided however that there be no license remaining on the Patent Rights.

6.4 In order for royalties payable hereunder to be accurately determined and related reports to be verified, Val-CHUM undertakes and agrees to keep full, clear and complete books and records relating to its operations under this Agreement. All of the said records and books of Val-CHUM shall be open at all reasonable times and upon a five (5) day written notice during business hours for inspection and audit by any duly authorized representative of the Inventor, at the latter's expense, to ascertain the accuracy of the royalty payments made hereunder by Val-CHUM or claimed to be due hereunder by the Inventor.

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7. COMMITMENTS OF THE INVENTOR

- 7.1 The Inventor commits to provide reasonable assistance to Val-CHUM and its representatives and to contribute in the protection, promotion and commercialization of the Patent Rights, upon simple request and without charge.
- 7.2 The Inventor commits to give timely assistance, if and when required, to Val-CHUM in recording the assignment of rights on the Patent Rights to Val-CHUM, its successor or assigns, including signing any documents and taking all lawful oaths, and will notify Val-CHUM in a timely manner of any correspondence addresses to him in respect to the Patent Rights.
- 7.3 The Inventor commits to promptly communicate to Val-CHUM all information request from third parties relating to the protection, promotion and commercialization of the Patent Rights.

8. INFRINGEMENT

- 8.1 Should either Party have knowledge that the Patent Rights are being infringed, such knowledge shall be promptly transmitted in writing to the other Party.
- 8.2 The Parties agree to consult each other as to how to respond to infringement of the Patent Rights. If the Parties jointly conclude that legal action should be taken with respect to such infringement, the Parties shall promptly and diligently prosecute such action.
- 8.3 In the event one Party advises the other Party that it will not participate in such legal action, the other Party shall be free to prosecute such action as it may deem advisable. Then, the non-prosecuting Party shall assist the prosecuting Party in all reasonable ways and at all reasonable times, provided that the prosecuting Party shall pay all costs and expenses, and shall be entitled to receive all recoveries and awards, in connection with such proceedings.

9. NOTICE

- 9.1 Any notice, demand, consent, or other communication to be given in connection with this Agreement shall be deemed sufficient if made in writing and addressed to its addressee, and to all other Parties in carbon copy, at the addresses as set forth below or to any other address a Party may specify from time to time:

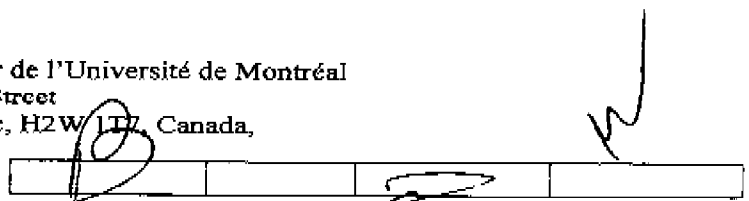
For Val-CHUM: VAL-CHUM, l.p.
 69 Sherbrooke St. West
 Montreal, Quebec, H2X 1X2 Canada
 C/O: Mr Robert Dubé, Président
 Fax: (514) 982-2525

For the Inventor: Dr Waldemar Debinski
 237 Stanaford Rd.
 Winston-Salem, NC 27104-2721;
 Fax: (336) 713-7639

With copy to counsel:

For CHUM: Centre hospitalier de l'Université de Montréal
 3850 St. Urbain Street
 Montreal, Quebec, H2W 1T7, Canada,

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C/O: Dr Pavel Hamet, Director of Research
Fax: (514) 412-7186

For UDM

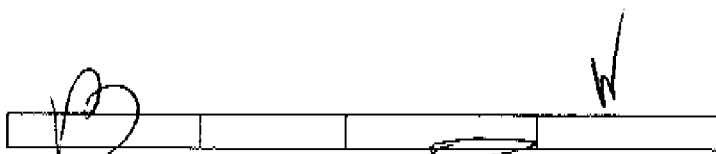
Université de Montréal
2900, Édouard-Montpetit blvd.
Montréal, Québec, H3C 3A7, Canada
C/O: Mrs Marielle Gascon-Barré, associate vice-rector, research
Fax: (514) 343-2326

10. GENERAL PROVISIONS

- 10.1 *Preamble and Appendices* – The preamble and the appendices form an integral part hereof.
- 10.2 *Effect* – The Parties undertake to sign any document and take all lawful oaths required to give effect to the present Agreement.
- 10.3 *Validity* – The invalidity, illegality or unenforceability of any provision herein shall not affect the validity, legality or enforceability of any other provision herein which shall remain in full force and effect.
- 10.4 *Entire Agreement* – The present Agreement represents the entire understanding between the Parties hereto and supersedes all other oral or written understandings and agreements between them.
- 10.5 *Amendment* – No modification, amendment, addition to the present Agreement shall be valid except by written agreement signed by the Parties hereto.
- 10.6 *Applicable Laws* – This Agreement shall be governed, construed and enforced in accordance with the laws in force in the Province of Quebec except for patent matters which shall be governed by the laws of the relevant country.
- 10.7 *No Waiver* – No waiver of any term, provision or condition of this Agreement whether by conduct or otherwise in any one or more instances shall be deemed to be or construed as a further or continuing waiver of any such term, provision or condition, or of any other term, provision or condition of this Agreement.
- 10.8 *Language* – The Parties have accepted that this Agreement and be written in English. Les Parties ont accepté que le présent contrat soit rédigé en anglais.

[The signatures follow on next page]

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A horizontal line representing a signature line. On the left, there is a handwritten signature that appears to be 'P. Hamet'. On the right, there is another handwritten signature that appears to be 'M. Gascon-Barré'. Below the line, there is a rectangular stamp with the word 'PATENT' written inside.

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RECORDED: 01/14/2005

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