

Form PTO-1595

6-93

OMB No. 0651-0011 (exp. 4/94)

RECORDATION FORM COVER SHEET  
PATENTS ONLY

12-08-2004



102896588

To the Honorable Commissioner of Patents and Trademarks. Please record the attached original documents or copies.

1. Name of conveying party(ies):

Duke University

Additional name(s) of conveying party(ies) attached?

☐ Yes ☒ No

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

Name: Timothy R. DeGrado

Street Address: 942 Franklin Trace

City: Zionsville, IN

Country: USA

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

3. Nature of Conveyance:

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

Execution Date(s): November 15, 2004

4. Application number(s) or patent number(s): 6,362,352

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

Title: F18-labeled thia fatty acids and methods of making and using the same

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

Name: Timothy R. DeGrado

Internal Address:

Street Address: 942 Franklin Trace

City: Zionsville State: IN Zip: 46077

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:

(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.

Timothy R. DeGrado

Name of Person Signing

Signature

11/23/2004

Date

Total number of pages including cover sheet, attachments and document

Mail documents to be recorded with required cover sheet information to:  
Commissioner of Patents and Trademarks, Box Assignments  
Washington, D.C. 20231OPR/FINANCE  
2004 DEC -6 AM 7:15

12/07/2004 NGETACHE 00000024 6362352

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PATENT  
REEL: 016038 FRAME: 0505

## ASSIGNMENT AGREEMENT

This AGREEMENT is made this 15th day of November, 2004, ("EFFECTIVE DATE") by and between

"UNIVERSITY": DUKE UNIVERSITY, a nonprofit educational, research, and healthcare corporation, formed under the laws of North Carolina, located in Durham, North Carolina 27708

and

"SUBMITTERS": Dr. Timothy R. DeGrado and Dr. Shuyan Wang, current and/or previous employees of Duke University who disclosed the INVENTION (hereinafter defined) to UNIVERSITY.

### WITNESSETH:

WHEREAS, SUBMITTERS have made an invention/discovery entitled, "F-18 labelled thia fatty acids and methods of making same" disclosed in an invention disclosure form identified as Duke File #1551 (hereinafter referred to as "INVENTION");

WHEREAS, UNIVERSITY is interested in efficiently transferring technology into the public domain where it can be used for broad social benefits; and

WHEREAS, SUBMITTERS are interested in effecting an efficient transfer of this INVENTION into the public domain; and

WHEREAS, UNIVERSITY believes it is in the best interest of the UNIVERSITY to assign, all right, title and interest UNIVERSITY may have now in such INVENTION *and issued patents (SN6,362,352; issued March 26, 2002), referred to as "INVENTION PATENTS"* (see Exhibit 'A') to SUBMITTERS collectively, and for UNIVERSITY to waive any future ownership interest in the INVENTION, subject to the conditions and reserved rights set forth below; and

WHEREAS, Submitters represent that no government funding from any funding agency was used in the conduct of the research leading to the patent filing and 'INVENTION' as described above; and no other private funding sources were used in the conduct of the research leading to the patent filing and 'INVENTION' as described above which might lead to a third party claim of inventorship or ownership in said 'INVENTION';

WHEREAS, SUBMITTERS wish to accept such an assignment and the incumbent responsibility for the transfer of the INVENTION into the public domain;

NATURE SAVER™ FAX MEMO 01616		Date <u>11/16</u>	# of pages <u>7</u>
To <u>Tim DeGrado</u>		From <u>Alan</u>	
Co./Dept.		Co.	
Phone #		Phone #	
		Fax #	

NOW THEREFORE, in consideration of the LUMP SUM REIMBURSEMENT of **\$16,481.64** (hereinafter defined) paid to UNIVERSITY by SUBMITTERS and other good and valuable consideration and the premises and covenants herein contained, the parties hereto agree as follows:

1. Subject to *the provisions set forth in Paragraph 7 (a) herein* and to the agreement of any UNIVERSITY ADDITIONAL INVENTORS (as hereinafter defined) as set forth in Paragraph 3, UNIVERSITY hereby assigns to SUBMITTERS all of UNIVERSITY's right, title and *interest to all patents covering the INVENTION and INVENTION PATENTS*, and waives any future ownership interest UNIVERSITY may otherwise have in such INVENTION and INVENTION PATENTS (not to include improvements thereto as set forth below). However, notwithstanding the foregoing or anything else to the contrary in this AGREEMENT, any subsequent inventions/discoveries including, but not limited to, improvements to the INVENTION, made in full or in part using UNIVERSITY resources including, *inter alia*, facilities, time, funds, etc. ("SUBSEQUENT INVENTIONS/DISCOVERIES") shall be disclosed and managed in accordance with UNIVERSITY PATENT POLICY (as hereinafter defined), including, but not limited to, any SUBSEQUENT INVENTIONS/DISCOVERIES that arise from the practice of the INVENTION. Provided, however, that UNIVERSITY shall have no rights to any subsequent inventions/discoveries relating to the INVENTION (and associated patent rights, if any) or arising from the use of the INVENTION (and associated patent rights, if any) including, but not limited to, improvements to the INVENTION, made without use of any UNIVERSITY resources, *except as set forth in Paragraph 6*.
2. SUBMITTERS hereby accept the assignment set forth under Paragraph 1 and agree to assume responsibility to facilitate the transfer of the technology into the public domain.
3. SUBMITTERS represent that they are the only inventors of the INVENTION, as inventorship is defined by U.S. patent law ("INVENTOR"). It is understood and agreed that if any other individual is at any time identified as another INVENTOR ("ADDITIONAL INVENTOR") who was, at the time of her/his contribution to the INVENTION, an employee, student, agent or faculty member of the UNIVERSITY obligated under UNIVERSITY policy to assign her/his rights to the INVENTION to the UNIVERSITY ("UNIVERSITY ADDITIONAL INVENTOR") then, if, in accordance with UNIVERSITY policy, the UNIVERSITY ADDITIONAL INVENTOR assigns her/his rights in the INVENTION to UNIVERSITY and if such UNIVERSITY ADDITIONAL INVENTOR indicates in writing that s/he wishes such UNIVERSITY rights in the INVENTION to be transferred to SUBMITTERS, such rights shall be included in the assignment to SUBMITTERS set forth in Paragraph 1 as shall be documented by an amendment of this AGREEMENT. However, if such UNIVERSITY ADDITIONAL INVENTOR does not indicate in writing that s/he wishes such UNIVERSITY rights in the INVENTION to be transferred to SUBMITTERS, then such UNIVERSITY rights shall be expressly excluded from the assignment set forth in Paragraph 1. It is understood and agreed that SUBMITTERS shall have full responsibility, at their own cost, to secure (as may be desired) assignment of the rights of ADDITIONAL INVENTOR(S) (if any) who are UNIVERSITY ADDITIONAL INVENTORS and/or the rights of any ADDITIONAL INVENTOR(S) (if any)

who are not UNIVERSITY ADDITIONAL INVENTOR(S) (hereinafter, "NON-DUKE ADDITIONAL INVENTOR(S)"). Moreover, SUBMITTERS acknowledge that if it is determined that there is one or more NON-DUKE ADDITIONAL INVENTOR then the employers of and/or other third parties associated with the respective NON-DUKE ADDITIONAL INVENTORS may have rights of ownership in the INVENTION ("CO-OWNERS"). Further, SUBMITTERS acknowledge and agree that UNIVERSITY has no obligation to enter into any inter-institutional agreement or other relationship with any such CO-OWNERS as regards the INVENTION and that any agreement between SUBMITTERS and any CO-OWNERS as regards the INVENTION shall be binding solely to the parties of such agreement.

4. In consideration for said assignment, SUBMITTERS agree

- (a) to waive the income share to which they would be entitled as inventors under the "Duke University Policy on Inventions, Patents, and Technology Transfer" ("UNIVERSITY PATENT POLICY"), Paragraph VI, Section C; and
- (b) to reimburse UNIVERSITY for all expenses related to pursuit of patent protection for the INVENTION which were incurred prior to the EFFECTIVE DATE ("LUMP SUM REIMBURSEMENT"), including but not limited to fees and expenses (from attorneys, national patent offices, etc.) for patentability opinions, patent applications, patent prosecution, patent issue and maintenance fees, etc., which LUMP SUM REIMBURSEMENT amounts to Sixteen Thousand Four Hundred Eighty One and 64/100 dollars (US\$16,481.64). UNIVERSITY shall invoice SUBMITTERS in writing via regular U.S. mail for the LUMP SUM REIMBURSEMENT within sixty (60) days of the EFFECTIVE DATE and such payment shall be due and payable within thirty (30) days following receipt of such invoice. Payment shall be made in the form of a check made payable to the "Duke University", shall cite Duke File # 1551 and shall be sent to the appertaining address set forth below:

*For delivery via the U.S. Postal Service:*

Duke University Office of Science and Technology  
Attention: Agreements Administrator  
Box 90083 Duke University  
Durham, NC 27708 USA

*For delivery via nationally/internationally recognized courier:*

Duke University Office of Science and Technology  
Attention: Agreements Administrator  
2020 West Main Street Suite 10  
Durham, NC 27705 USA

5. If the payment in full of LUMP SUM REIMBURSEMENT is not received by UNIVERSITY within ninety (90) days of the original payment due date, then this AGREEMENT shall immediately terminate as shall all rights granted to the SUBMITTERS hereunder.

6. SUBMITTERS hereby grant to the UNIVERSITY a perpetual, irrevocable, non-exclusive, non-transferable, royalty-free license to use said INVENTION and patents arising therefrom [INVENTION PATENTS] as well as any improvements thereon, including any patent rights arising therefrom, for its non-commercial clinical, research and educational purposes at UNIVERSITY.

7. The parties acknowledge and represent, to the best of their knowledge, that no constraints on the rights to the INVENTION exist and that after the EFFECTIVE DATE and all constraints which may emerge shall constrain SUBMITTERS instead of UNIVERSITY.

8. Notwithstanding anything to the contrary in this AGREEMENT, this AGREEMENT may not be assigned without the express, prior written mutual consent of the parties, such consent not to be unreasonably withheld.

9. SUBMITTERS acknowledge that UNIVERSITY's rights in the INVENTION PATENT are being assigned to them for the purposes stated herein. SUBMITTERS further acknowledge that UNIVERSITY does not have any responsibility to further develop, improve, or support the INVENTION PATENT, and UNIVERSITY shall not be obligated to expend nor shall any SUBMITTER utilize any UNIVERSITY funds, equipment, facilities or other resources to develop, improve, or support said INVENTION PATENT after execution of this AGREEMENT.

10. UNIVERSITY MAKES NO REPRESENTATIONS AND EXTENDS NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED. IN PARTICULAR, THERE ARE NO EXPRESS OR IMPLIED WARRANTIES OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE, OR THAT THE USE OF THE INVENTION AND/OR ANY ASSOCIATED PATENT RIGHTS COVERING THE INVENTION WHICH SUBMITTERS AND/OR THEIR ASSIGNEES, OPTIONEES, LICENSEES, SUBLICENSEES, MARKETING PARTNERS, AFFILIATES, AND/OR THE LIKE MAY PURSUE ("ASSOCIATED PATENT RIGHTS") WILL NOT INFRINGE ANY PATENT, COPYRIGHT, TRADEMARK, OR OTHER RIGHTS. IT IS UNDERSTOOD AND AGREED THAT DUKE ENCOURAGES SUBMITTERS AND/OR THEIR ASSIGNEES, OPTIONEES, LICENSEES, SUBLICENSEES, MARKETING PARTNERS, AFFILIATES, AND/OR THE LIKE TO SECURE RIGHTS UNDER ANY THIRD PARTY INTELLECTUAL PROPERTY RIGHTS REQUIRED TO PRACTICE THE INVENTION AND/OR ASSOCIATED PATENT RIGHTS AND THAT DUKE SHALL HAVE NO RESPONSIBILITY IN SECURING ANY SUCH RIGHTS. IN ADDITION, NOTHING IN THIS AGREEMENT SHALL BE DEEMED TO BE A REPRESENTATION OR WARRANTY BY UNIVERSITY OF THE ACCURACY, SAFETY, EFFICACY, OR USEFULNESS, FOR ANY PURPOSE, OF THE INVENTION AND/OR ANY ASSOCIATED PATENT RIGHTS OR THE VALIDITY OF ANY ASSOCIATED PATENT RIGHTS. FURTHER, UNIVERSITY SHALL HAVE NO OBLIGATION, EXPRESS OR IMPLIED, TO SUPERVISE, MONITOR, REVIEW OR OTHERWISE ASSUME RESPONSIBILITY FOR THE PRODUCTION, MANUFACTURE, TESTING, MARKETING OR SALE OF ANY PRODUCT, PROCESS OR SERVICE AND UNIVERSITY SHALL HAVE NO LIABILITY WHATSOEVER TO SUBMITTERS OR ANY THIRD PARTIES FOR

OR ON ACCOUNT OF ANY INJURY, LOSS, OR DAMAGE, OF ANY KIND OR NATURE, SUSTAINED BY, OR ANY DAMAGE ASSESSED OR ASSERTED AGAINST, OR ANY OTHER LIABILITY INCURRED BY OR IMPOSED UPON SUBMITTERS OR ANY OTHER PERSON OR ENTITY, ARISING OUT OF OR IN CONNECTION WITH OR RESULTING FROM:

- (a) the production, use, practice, lease, or sale of any product, process, or service based on (in whole or in part, directly or indirectly) or derived from (directly or indirectly) the use or practice of the INVENTION and/or ASSOCIATED PATENT RIGHTS; or
- (b) any advertising or other promotional activities with respect to any of the foregoing.

11. Neither SUBMITTERS, nor any of their assignees, optionees, licensees, sublicensees, marketing partners, affiliates, nor the like shall

- (a) use in any publication, advertising, publicity, press release, promotional activity or otherwise, any trade-name, personal name, trademark, trade device, service mark, symbol, image, icon or any abbreviation, contraction or simulation thereof owned by UNIVERSITY; or
- (b) use the name or image of any employee (other than SUBMITTERS, as SUBMITTERS give their approval) or agent of the UNIVERSITY in any publication, advertising, publicity, press release, promotional activity or otherwise; or
- (c) represent, either directly or indirectly, that any product or service arising from the use of the INVENTION is a product or service of UNIVERSITY or that it is made in accordance with or utilizes the information or documents of UNIVERSITY.

12. UNIVERSITY and its trustees, officers, employees (except SUBMITTERS), students, faculty (except SUBMITTERS), and agents (collectively, "UNIVERSITY INDEMNITEES") will be indemnified, defended by counsel acceptable to UNIVERSITY, and held harmless by SUBMITTERS (and/or by their assignees, optionees, licensees, sublicensees, marketing partners, affiliates, and the like) from and against any claim, liability, cost, expense, damage, deficiency, loss or obligation, of any kind or nature (including, without limitation, reasonable attorneys' fees and other costs and expenses of defense) (collectively, "CLAIMS") based upon, arising out of, or otherwise relating to this AGREEMENT, including, but not limited to, the exercise of the assignment granted hereunder and any action relating to product liability. The previous sentence will not apply to any CLAIM that is determined with finality by a court of competent jurisdiction to result solely from the gross negligence or willful misconduct of a UNIVERSITY INDEMNITEE. SUBMITTERS (and/or by his assignees, optionees, licensees, sublicensees, marketing partners, affiliates, and the like) shall maintain in force at their sole cost and expense, with reputable insurance companies, general liability insurance and products liability insurance coverage in an amount reasonably sufficient to protect against liability under this Paragraph. UNIVERSITY shall have the right to ascertain from time to time that such coverage exists, such right to be exercised in a reasonable manner.

13. The parties agree to attempt to resolve promptly any dispute arising out of or relating to this AGREEMENT by good faith negotiation. Provided, however, if such attempts at dispute resolution shall fail, disputes relating to the terms and conditions of this AGREEMENT shall be exclusively resolved, upon written request by either party, by final and binding arbitration in the City of Durham in the State of North Carolina pursuant to the commercial arbitration rules of the American Arbitration Association, in accordance with the following procedures:

- (a) The arbitration tribunal shall consist of three (3) arbitrators. The parties shall respectively nominate one (1) arbitrator in the request for arbitration and one (1) arbitrator in the answer thereto, and the two (2) arbitrators so

and one (1) arbitrator in the answer thereto, and the two (2) arbitrators so named will then jointly appoint third arbitrator as chairperson of the arbitration tribunal.


- (b) The decision of the arbitration tribunal shall be final and binding upon the parties hereto, and judgment upon such decision may be entered in any competent court for juridical acceptance of such an award and order of enforcement. Each party hereby submits itself to the courts of the place of arbitration, but only for the entry of judgment with respect to the decision of the arbitrators hereunder.

14. It is understood and agreed that all licenses, sub-licenses, options, assignments, marketing arrangements, and the like involving the rights assigned by UNIVERSITY to SUBMITTERS under this AGREEMENT as well as those involving ASSOCIATED PATENT RIGHTS shall be subject to the terms and conditions of this AGREEMENT and shall be no less favorable to or protective of DUKE than this AGREEMENT.

15. North Carolina law shall govern this AGREEMENT.

IN WITNESS WHEREOF, the parties hereto have caused this AGREEMENT to be duly executed by affixing their signatures below.

**SUBMITTERS**


By:   
Dr. Timothy DeGrado

Date: 11/23/2004

By:   
Dr. Shuyan Wang

Date: 11/23/2004

**DUKE UNIVERSITY**

By:   
Robert L. Taber, Ph.D.  
Vice Chancellor, Science and Technology  
Development

Date: 11/16/04

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