

12-15-04

RECORDA

PATENT

102913542

12-27-2004

By Express Mail #EV528957395US

U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Attorney Docket 99-103

To the Honorable Commissioner of Patents and Trademarks: Please record this document and all documents or copy thereof.

1. Name of conveying party(ies):  
The Johns Hopkins University

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

Name: Joshua M. HARE

Internal Address:

Street Address: 928 1/2 Fell Street

City: Baltimore

State/Country: MD

Zip: 21231

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

3. Nature of conveyance:

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

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

Execution Date: December November 23, 2004

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)  
SN.:

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

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

Name: Myron Cohen

Internal Address: Cohen, Pontani, Lieberman & Pavane

Street Address: 551 Fifth Avenue, 12<sup>th</sup> Floor

City: New York State: New York Zip: 10176

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: 03-2412  
(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.*

Myron Cohen

Name of Person Signing

Reg. No. 17,358

Signature

December 15, 2004

Date

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

10

Mail documents to be recorded with required cover sheet information to:

Mail Stop Assignment Recordation  
Director of the US Patent and Trademark Office  
PO Box 1450  
Alexandria, VA 22313-1450

12/20/2004 MBIZUNES 00000032 11012778

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PATENT  
REEL: 016092 FRAME: 0653

# ASSIGNMENT OF RIGHTS AGREEMENT

## Federal Government Sponsored Invention

This Assignment of Rights Agreement (hereinafter "Agreement"), effective upon execution by the last party hereto, is between The Johns Hopkins University, a corporation of the State of Maryland, having a principle place of business at 3400 N. Charles St., Baltimore, Maryland 21218-2695 (hereinafter "JHU") and Joshua M. Hare, an individual(s), residing at 928 1/2 Fell Street, Baltimore, MD 21231 (hereinafter "RECIPIENT").

WITNESSETH:

WHEREAS, a valuable invention(s) entitled “The Use of Gene Expression Arrays to Diagnose Patients with Dilated Cardiomyopathy Vs Ischemic Cardiomyopathy - Molecular Signature Approach” (JHU Ref. No. 4375) (hereinafter “Invention”) was developed during the course of research conducted by Dr. Joshua M. Hare (hereinafter “Inventor(s)”), and are disclosed and/or claimed in patents and/or patent applications listed in Exhibit A (hereinafter “Patent Rights”); and

WHEREAS, JHU has acquired through assignment all rights to all JHU Inventors' interest in said valuable Invention; and

WHEREAS, JHU has determined that commercialization of said Invention is best served by releasing title back to RECIPIENT; and

WHEREAS, RECIPIENT desires to obtain certain rights in said Invention to pursue commercialization throughout the world;

NOW, THEREFORE, in consideration of the foregoing premises and the following mutual covenants, and other good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the parties hereto agree as follows:

## ARTICLE 1

### GRANT

1.1 **Grant.** JHU hereby assigns all of its intellectual property rights and interest in the Invention to RECIPIENT, subject to the terms of this Agreement, the rights retained by the United States government in accordance with the Bayh-Dole Act of 1980 (established by P.L. 96-517 and codified at 35 USC § 200 et. seq.; and implemented according to 37 CFR Part 401) and in particular subject to the approval of the United States government under 35 USC § 202(d). This assignment is

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contingent upon the accuracy of the Report(s) of Invention provided to the Offices of Technology Licensing, Technology Transfer, or Licensing & Technology Development (hereinafter "Office"), including, but not limited to, information relating to inventorship and sponsorship.

**1.2 Government Rights.** RECIPIENT acknowledges that the United States government has acquired a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the Invention described in Patent Rights throughout the world. The rights assigned herein are additionally subject to: (i) the requirement that any products produced for use or sale within the United States that practice any claim under Patent Rights shall be substantially manufactured in the United States (unless a waiver under 35 USC § 204 or equivalent is granted by the appropriate United States government agency), (ii) the right of the United States government to require the grant of sublicenses to responsible applicants on reasonable terms when necessary to fulfill health or safety needs, and, (iii) other rights acquired by the United States government under the laws and regulations applicable to the grant/contract award under which the Invention was made.

**1.3 Third Party License.** The Invention assigned in Paragraph 1.1 may be licensed to third parties by RECIPIENT, provided that, as a condition to its validity and enforceability, any license agreement shall (a) incorporate by reference the terms and conditions of this Agreement; (b) be consistent with the terms and conditions of this Agreement; and, (c) specifically incorporate Paragraphs 4.2 (Representations by JHU), 5.1 (Indemnification of JHU), 6.3 (Use of JHU's name) and 6.4 (Product Liability) into the body of such agreement, and cause the terms used therein to have the same meaning as in this Agreement.

**1.4 JHU Retained Rights.** RECIPIENT hereby grants JHU a paid-up, royalty-free, non-exclusive license to use all intellectual property rights in the Invention for its and The Johns Hopkins Health Systems' nonprofit purposes, including the ability to distribute any biological material covered under Patent Rights for nonprofit academic research use as is customary in the scientific community.

## ARTICLE 2 FEES AND PAYMENTS

**2.1 Patent Reimbursement.** RECIPIENT shall reimburse JHU for all of JHU's costs associated with the preparation, filing and maintenance of Patent Rights within thirty (30) days of the first to occur of a) a license of any rights granted in accordance with Paragraph 1.3, or b) first commercial sale of any Invention.

**2.2 Assignment and License consideration.** RECIPIENT shall pay to JHU five (5%) percent of all revenue and consideration received for any agreement executed by RECIPIENT pertaining to the patent rights and/or incorporating the invention. Said revenue and consideration

paid to RECIPIENT, whether in cash or in equity, shall include: 1) up front payments for a license, whether exclusive or non-exclusive, or an assignment of all or a portion of said patent rights or said invention; 2) an advance or future royalties or other payments required by such license or assignment; 3) periodic or running royalties required by any such license and 4) periodic or running payments as consideration for such an assignment. Not included in such revenue or consideration are amounts for wages or salary or other compensation paid by any assignee, licensee or any third party to RECIPIENT for serving under specific written agreement as a member of the board, or as an executive, employee, consultant or contract worker of said licensee, assignee or third party on any task including, but not limited to, product development, research work, clinical studies or regulatory approvals. RECIPIENT shall notify JHU in writing that he has entered into any license, assignment or specific written agreement within ten (10) days; all payments due JHU under this paragraph 2.2 shall be paid within sixty (60) days of actual receipt of such revenue or other consideration by RECIPIENT. Also not to be included as revenue or consideration shall be any income, benefit, or gain from equity received by RECIPIENT as all or a part of his revenue or consideration for assigning or licensing or otherwise transferring all or a portion of said patent rights or invention, five (5%) percent of which equity has already been paid to JHU under this paragraph 2.2, provided such income, benefit or gain is available to JHU as an owner of said equity.

**2.3 Form of Payment.** All payments under this Agreement shall be made in U.S. Dollars. Checks are to be made payable to "The Johns Hopkins University". Wire transfers may be made through:

Johns Hopkins University  
M&T Bank  
One M&T Plaza  
Buffalo, NY 14203

Transit/Routing/ABA number: 022000046  
SWIFT code: MANTUS33INT  
CHIPS ABA number: 0555  
Account Number: 09000522  
Reference: JHU Licensing and Technology Development  
(JHU REF. 4375)  
Attn: Financial Manager

RECIPIENT shall be responsible for any and all costs associated with wire transfers.

### ARTICLE 3 PATENT MATTERS

**3.1 Patent Assignment Documents.** As applicable, RECIPIENT agrees to record

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corrected assignments of Patent Rights at the U.S. Patent and Trademark Office and patent offices within other countries within sixty (60) days of the date of execution of this Agreement.

**3.2 Patent Prosecution and Maintenance.** RECIPIENT acknowledges that RECIPIENT is responsible for all future continued patent prosecution and maintenance. RECIPIENT acknowledges that any future costs regarding patent matters, including but not limited to, costs related to prosecution, maintenance and infringement, are solely the responsibility of RECIPIENT.

#### **ARTICLE 4 REPRESENTATIONS**

**4.1 Duties of the Parties.** JHU is not a commercial organization. It is an institute of research and education. Therefore, JHU has no ability to evaluate the commercial potential of any Invention or Patent Rights or other license or rights granted in this Agreement. It is therefore incumbent upon RECIPIENT to evaluate the rights and products in question, to examine the materials and information provided by JHU, and to determine for itself the validity of any Patent Rights, its freedom to operate, and the value of any Invention or other rights granted.

**4.2 Representations by JHU.** JHU warrants that it has good and marketable title to its interest in the Invention claimed under Patent Rights with the exception of certain retained rights of the United States Government, which may apply if any part of the JHU research was funded in whole or in part by the United States Government. JHU does not warrant the validity of any patents or that practice under such patents shall be free of infringement. EXCEPT AS EXPRESSLY SET FORTH IN THIS PARAGRAPH 4.2, RECIPIENT AGREES AND SHALL CAUSE EACH LICENSEE(S) AND SUBLICENSEE(S) TO AGREE THAT THE PATENT RIGHTS ARE PROVIDED "AS IS", AND THAT JHU MAKES NO REPRESENTATION OR WARRANTY WITH RESPECT TO THE PERFORMANCE OF THE INVENTION INCLUDING ITS SAFETY, EFFECTIVENESS, OR COMMERCIAL VIABILITY. JHU DISCLAIMS ALL WARRANTIES WITH REGARD TO THE INVENTION ASSIGNED UNDER THIS AGREEMENT, INCLUDING, BUT NOT LIMITED TO, ALL WARRANTIES, EXPRESSED OR IMPLIED, OF MERCHANTABILITY AND FITNESS FOR ANY PARTICULAR PURPOSE. NOTWITHSTANDING ANY OTHER PROVISION OF THIS AGREEMENT, JHU ADDITIONALLY DISCLAIMS ALL OBLIGATIONS AND LIABILITIES ON THE PART OF JHU AND INVENTORS, FOR DAMAGES, INCLUDING, BUT NOT LIMITED TO, DIRECT, INDIRECT, SPECIAL, AND CONSEQUENTIAL DAMAGES, ATTORNEYS' AND EXPERTS' FEES, AND COURT COSTS (EVEN IF JHU HAS BEEN ADVISED OF THE POSSIBILITY OF SUCH DAMAGES, FEES OR COSTS), ARISING OUT OF OR IN CONNECTION WITH THE MANUFACTURE, USE, OR SALE OF THE INVENTION ASSIGNED UNDER THIS AGREEMENT. RECIPIENT, LICENSEE(S) AND SUBLICENSEE(S) ASSUME ALL RESPONSIBILITY AND LIABILITY FOR LOSS OR DAMAGE CAUSED BY A PRODUCT AND/OR SERVICE (WHICH IS AN INVENTION AS DEFINED IN THIS AGREEMENT) MANUFACTURED, USED, OR SOLD BY RECIPIENT, LICENSEE(S) OR ITS SUBLICENSEE(S).

## ARTICLE 5

### INDEMNIFICATION

5.1 **Indemnification.** JHU and the Inventors (who are not RECIPIENT) will have no legal liability exposure to third parties if JHU does not license the Invention or Patent Rights, and any royalties JHU and the non-RECIPIENT Inventors may receive is not adequate compensation for such legal liability exposure. Therefore, JHU requires RECIPIENT to protect JHU and the non-RECIPIENT Inventors from such exposure to the same manner and extent to which insurance, if available, would protect JHU and non-RECIPIENT Inventors. Furthermore, JHU and the non-RECIPIENT Inventors will not, under the provisions of this Agreement or otherwise, have control over the manner in which RECIPIENT or its, licensees or sublicensee(s) or those operating on its account or third parties who purchase products, which are Inventions as defined in this Agreement, from any of the foregoing entities, develop, manufacture, market or practice the Inventions under the Patent Rights. Therefore, RECIPIENT, its licensees and sublicensee(s) shall indemnify, defend with counsel reasonably acceptable to JHU, and hold JHU, The Johns Hopkins Health Systems, their present and former trustees, officers, non-RECIPIENT Inventors

of Patent Rights, agents, faculty, employees and students harmless as against any judgments, fees, expenses, or other costs arising from or incidental to any product liability or other lawsuit, claim, demand or other action brought as a consequence of the practice of said inventions by any of the foregoing entities, whether or not JHU or said non-RECIPIENT Inventors, either jointly or severally, is named as a party defendant in any such lawsuit and whether or not JHU or the non-RECIPIENT Inventors are alleged to be negligent or otherwise responsible for any injuries to persons or property. Practice of the Inventions covered by Patent Rights by a licensee or an agent or a sublicensee or a third party on behalf of or for the account of RECIPIENT or by a third party who purchases licensed product(s) or licensed services(s) from RECIPIENT, shall be considered RECIPIENT's practice of said Inventions for purposes of this Paragraph. The obligation of RECIPIENT to defend and indemnify as set out in this Paragraph shall survive the termination of this Agreement and shall not be limited by any other limitation of liability elsewhere in this Agreement.

## ARTICLE 6 MISCELLANEOUS

**6.1 Sponsor Imposed Obligations.** RECIPIENT agrees to honor all obligations imposed by all sponsor(s) of research under which Invention was made, including, but not limited to, the obligations to the U.S. federal government under 37 CFR 401.9 regarding patent protection and commercialization.

**6.2 Continued Development.** RECIPIENT acknowledges that any further development of the Invention by RECIPIENT using JHU resources or through his/her/their role as a JHU employee(s), shall be subject to JHU's Intellectual Property Policy and shall be reported to JHU's Licensing & Technology Development office and assigned to JHU.

**6.3 Use of Name.** RECIPIENT and any licensee or sublicensee shall not use the name of The Johns Hopkins University or The Johns Hopkins Health System or any of its constituent parts, such as the Johns Hopkins Hospital or any contraction thereof in any advertising, promotional, sales literature or fundraising documents without prior written consent from an authorized representative of JHU. RECIPIENT, licensee or sublicensee shall allow at least seven (7) business days notice of any proposed public disclosure for JHU's review and comment or to provide written consent.

**6.4 Product Liability.** Prior to initial human testing or first commercial sale of any Invention in any particular country, RECIPIENT shall establish and maintain, in each country in which RECIPIENT, each licensee or sublicensee shall test or sell an Invention, product liability or other appropriate insurance coverage appropriate to the risks involved in marketing an Invention. Upon JHU's request, RECIPIENT will furnish JHU with a Certificate of Insurance of each product liability insurance policy obtained. JHU shall be listed as an additional insured in RECIPIENT's said insurance policies. If such Product Liability insurance is underwritten on a 'claims made' basis, JHU Ref. 4375

RECIPIENT agrees that any change in underwriters during the term of this Agreement will require the purchase of 'prior acts' coverage to ensure that coverage will be continuous throughout the term of this Agreement.

**6.5 Successors and Assigns.** Neither this Agreement nor any of the rights or obligations created herein, including but not limited to the intellectual property rights and interests assigned in Paragraph 1.1, except for the right to receive any remuneration hereunder, may be assigned by RECIPIENT, in whole or in part, without the prior written consent of JHU. This Agreement shall bind and inure to the benefit of the successors and permitted assigns of the parties hereto.

**6.6 Voidable Agreement.** In the event that there are additional inventors or sponsors of the Invention that were not reported in the Report(s) of Invention or any subsequent related written correspondence with the Office, this Agreement will be considered void and shall immediately terminate and all interests and rights conveyed herein shall immediately revert back to JHU.

**6.7 Notices.** All notices or communication shall be sent to JHU at the following address:

Licensing and Technology Development  
Johns Hopkins University  
100 N. Charles Street, 5<sup>th</sup> Floor  
Baltimore, MD 21201  
Attn: Director

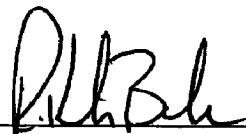
RECIPIENT shall be responsible for obtaining any subsequent Office mailing addresses. Additionally, RECIPIENT shall keep Office apprised of RECIPIENT'S current mailing address.

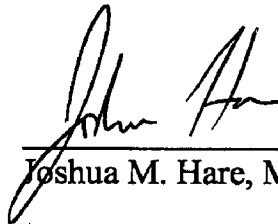


IN WITNESS WHEREOF the respective parties hereto have executed this Agreement by their duly authorized officers on the date appearing below their signatures.

THE JOHNS HOPKINS UNIVERSITY

RECIPIENT

By  <sup>HAB</sup>  
R. Keith Baker, Ph.D.  
Director, Licensing & Technology  
Licensing & Technology Development  
Johns Hopkins University

By   
Joshua M. Hare, M.D.

Date: 11/23/04

Date: 11/17/2004

**EXHIBIT A**  
**PATENT RIGHTS**

**U.S. Provisional Patent application, 60/529,834 – Filed on 12/16/2003 and  
Entitled “Molecular Signature Approach to Diagnosis of Dilated Cardiomyopathy”**