

PATENT ASSIGNMENT

Electronic Version v1.1

Stylesheet Version v1.1

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
Purdue Research Foundation	11/07/2000
RECEIVING PARTY DATA	
Name:	The Texas A&M University System
Street Address:	3369 TAMU
City:	College Station
State/Country:	TEXAS
Postal Code:	77843-3369
PROPERTY NUMBERS Total: 1	
Property Type	Number
Application Number:	10473303
CORRESPONDENCE DATA	
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<i>Correspondence will be sent via US Mail when the fax attempt is unsuccessful.</i>	
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ATTORNEY DOCKET NUMBER:	017575.0696
NAME OF SUBMITTER:	Bradley P. Williams
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INTERINSTITUTIONAL AGREEMENT

Between

Purdue Research Foundation

And

The Texas A&M University System

THIS INTERINSTITUTIONAL AGREEMENT is made and entered into by and between Purdue Research Foundation, West Lafayette, Indiana, 47907 (hereinafter referred to as "PRF"), and The Texas A&M University System, College Station, Texas 77843-3369 (hereinafter referred to as the "SYSTEM").

WITNESSETH:

WHEREAS, PRF is owner by election of title from the National Institutes of Health of U.S. Patent Application 60/103,609 entitled, "Characterization of Luminescence in a Scattering Medium," filed on October 9, 1998, and a related Patent Cooperation Treaty (PCT) application No. PCT/US99/23709 filed on October 8, 1999, claiming technology developed by Professor Eva Sevick-Muraca, formerly Associate Professor of Chemical Engineering, R.H. Mayer and J.S. Reynolds at Purdue University (hereinafter called "PRF Luminescence Technology"), PRF Reference Number P-98081 and

WHEREAS, Dr. Eva Sevick-Muraca is now Professor of Chemical Engineering at Texas A&M University and a researcher in the Chemical Engineering Division of the Texas Engineering Experiment Station, both components of the SYSTEM; and

WHEREAS, Dr. Eva Sevick-Muraca will continue to conduct research and development at the SYSTEM in the area of characterization of luminescence in a scattering medium; and

WHEREAS, both PRF and SYSTEM desire to transfer intellectual property rights related to the PRF Luminescence Technology in SYSTEM to facilitate the continued research and development of the technology, and to promote the commercialization of the consolidated intellectual property rights, for the benefit of the public.

NOW THEREFORE, in consideration of the foregoing and the mutual covenants and promises contained herein, the receipt and sufficiency of which is hereby acknowledged, this Interinstitutional Agreement is made by PRF and the SYSTEM to establish the rights and obligations of PRF and the SYSTEM with respect to the PRF Luminescence Technology.

ARTICLE I - DEFINITIONS

- 1.01 "PRF Luminescence Technology" shall mean U.S. Patent Application 60/103,609 entitled, "Characterization of Luminescence in a Scattering Medium," filed on October 9, 1998, and a related Patent Cooperation Treaty (PCT) application No. PCT/US99/23709 filed on October 8, 1999.
- 1.02 "Effective Date" shall mean the date this Agreement is executed by both parties hereto.

ARTICLE II - TRANSFER OF RIGHTS

- 2.01 Assignment. Subject to the terms of this Agreement, PRF hereby assigns all right, title and interest in the PRF Luminescence Technology to SYSTEM. Upon the Effective Date, PRF shall cooperate with SYSTEM to effect the filing of formal assignment documentation with the U.S. Patent and Trademark Office, as well as comparable foreign offices, for recordation of the title assignment in patent rights to SYSTEM. Furthermore, PRF shall cooperate with SYSTEM to effect the transfer of file wrappers for all patent applications comprising PRF Luminescence Technology from the law firm of Woodard, Emhardt, Naughton, Moriarty & McNett (Indianapolis, Indiana) to the law firm designated by SYSTEM. PRF shall pay any costs incurred in the transfer of the file wrappers, subject to reimbursement by SYSTEM in accordance with paragraph 3.02 below.
- 2.02 Government Rights. PRF represents that the U.S. Government holds certain rights in the PRF Luminescence Technology, as set forth in 37CFR401.14(a), in light of funding provided to PRF by agencies of the U.S. Government for development of the PRF Luminescence Technology. Upon the Effective Date, PRF shall provide to SYSTEM the relevant contract documentation to enable SYSTEM to comply with all applicable U.S. Government regulations regarding PRF Luminescence Technology.
- 2.03 Retained Rights. PRF and Purdue University retain the royalty-free, non-exclusive right to use the PRF Luminescence Technology for educational and research purposes. Research purposes include the right to conduct sponsored research on behalf of for-profit entities, except that PRF may not grant rights in PRF Luminescence Technology to such research sponsors; commercial use of the results of such sponsored research shall require such research sponsor to obtain a separate license to PRF Luminescence Technology from SYSTEM. SYSTEM does not represent that such separate license will be available or shall be granted to such research sponsor.
- 2.04 Reassignment of Patents. Should SYSTEM decide to abandon any patents or patent applications encompassed by PRF Luminescence Technology, SYSTEM shall first offer to reassign said patents or patent applications to PRF. Said offer will be made at least six (6) months prior to any date at which time the patent or patent applications are or become abandoned. Any reassigned patents or patent applications will not be subject to this Agreement.

ARTICLE III - CONSIDERATION & SYSTEM RESPONSIBILITIES

- 3.01 Technology Development. In consideration for the transfer of rights made by PRF hereinabove, SYSTEM agrees to use all reasonable efforts to accomplish continued development of the technology comprising PRF Luminescence Technology for the benefit of the public.
- 3.02 Reimbursement of Patent Expenses. As additional consideration for the transfer made by PRF above, SYSTEM agrees to reimburse PRF for a) outstanding and unreimbursed patent expenses, if any, incurred as of the Effective Date, and b) reasonable costs incurred in transfer of patent application file wrappers from the firm of Woodard, Emhardt, Naughton, Moriarty & McNett (Indianapolis, Indiana) to the law firm designated by SYSTEM. Reimbursement of such patent expenses shall be provided by SYSTEM no later than sixty (60) days after receipt of an invoice from PRF.
- 3.03 Commercialization. SYSTEM agrees to use all reasonable efforts to accomplish commercialization of the PRF Luminescence Technology for public benefit through the licensing of the PRF Luminescence Technology to one or more commercial companies. Gross Income which may be received by SYSTEM from such licensing shall be distributed in accordance with the process described below. As used in this Agreement, the term Gross Income shall mean any money actually received by the

SYSTEM as financial consideration from the licensing of the PRF Luminescence Technology to one or more third parties, including but not limited to Mallinckrodt, Inc.

- a. First, SYSTEM shall recover from Gross Income its unreimbursed funds expended for continued prosecution and maintenance of the patent rights for PRF Luminescence Technology, if any, including amounts paid to PRF in accordance with paragraph 3.02 above.
- b. Second, after deduction of patent expenses as set forth in subparagraph 3.03a., if any, one-third (1/3) of the balance shall be distributed to PRF for distributions to the inventors of the PRF Luminescence Technology under PRF's Intellectual Property Policy, as previously agreed among the inventors of the PRF Luminescence Technology, and the terms of this Agreement. PRF hereby confirms and represents that the funds received by PRF from SYSTEM for inventor distribution shall be paid to inventors in accordance with the terms of this Agreement.
- c. Third, after implementing the two steps described above, SYSTEM shall distribute forty-two and one-half percent (42.5%) of the balance to PRF solely for the benefit of Purdue University.

The parties understand and agree that claims issued on PRF Luminescence Technology may dominate any claims issued on improvements to the technology and that improvements may be required to achieve commercial viability of the technology. Therefore, the parties also understand and agree that SYSTEM may need to make reasonable judgments as to the relative values to licenses that are contributed by PRF Luminescence Technology and improvements. SYSTEM agrees to notify PRF in writing of its reasoning for said judgments prior to any distributions under this paragraph 3.03.

- 3.04 Government Rights. SYSTEM hereby accepts and confirms that upon the Effective Date, it shall assume all obligations and responsibilities to the U.S. Government originally held by PRF under 37CFR401.14(a), as if SYSTEM had been the original grantee under the contracts or grants received by Purdue from the Federal Government for sponsorship of the PRF Luminescence Technology.
- 3.05 Patent Prosecution. SYSTEM agrees to use all reasonable efforts to obtain the broadest and strongest scope of patent protection for PRF Luminescence Technology, subject to paragraph 2.04. SYSTEM will provide copies to PRF of all correspondence with patent offices regarding prosecution of these applications and maintenance of the resulting patents.

ARTICLE IV - PAYMENTS AND REPORTS

- 4.01 Commercialization Reports. Within sixty (60) days following the close of each Calendar Year, SYSTEM shall deliver to the PRF a letter report as to SYSTEM's efforts and accomplishments during the preceding year in the further development and/or commercialization of PRF Luminescence Technology.
- 4.02 Inventors' Income. SYSTEM represents that it shall provide payment of any amounts due PRF on behalf of inventors under paragraph 3.04(b) above within thirty (30) days of its receipt of such income from a licensee. Furthermore, PRF represents that it shall provide payment of any such amounts due inventors under paragraph 3.04(b) above within thirty (30) days of its receipt of such payment from SYSTEM.
- 4.03 Other Considerations Due PRF. Any amounts due PRF under paragraphs 3.04(c) above shall be paid to PRF on a semi-annual basis, no later than July 31 for the period January-to-June, and January 31 for the period July-to-December. SYSTEM shall provide information sufficient to allow PRF to calculate the amounts due for that semi-annual period.

- 4.04 Inspection of Books and Records. At its own expense, PRF may inspect SYSTEM's books and records up to twice a year to determine amounts payable to the PRF. SYSTEM shall maintain such books and records for at least three (3) years following the dates of the underlying transactions. Any such inspections shall be in confidence and conducted during ordinary business hours. PRF will provide SYSTEM notice of two (2) weeks before making such inspections. PRF may employ a Certified Public Accountant for this purpose.

ARTICLE V - EFFECTIVE DATE AND TERM

- 5.01 Effective Date. This Agreement shall become effective upon the signatures of duly authorized representatives of both PRF and SYSTEM.
- 5.02 Term and Expiration. This Agreement shall expire automatically upon (i) the expiration of the last to expire valid claim covering PRF Luminescence Technology and (ii) final payment of all considerations required hereunder.

ARTICLE VI - REPRESENTATIONS, WARRANTIES AND LIABILITY

- 6.01 Liability and Indemnification. SYSTEM represents that it shall expressly require in any license agreement to PRF Luminescence Technology that the licensee shall indemnify, defend and hold harmless PRF, Purdue University, their regents, officers, and employees, against any claim, proceeding, demand, liability, or expenses (including legal expenses and attorney's fees) which relates to injury to persons or property, or against any other claim, proceeding, demand, expense and liability of any kind whatsoever resulting from the production, manufacture, sale, use, lease, consumption or advertisement of products made, used or sold under patents comprising PRF Luminescence Technology.
- 6.02 PRF Representation. PRF represents that:
- a. It owns and has title to the PRF Luminescence Technology; and
 - b. Other than the obligations to the U.S. Government, there are no rights held by any third party in the PRF Luminescence Technology; and
 - c. It has the full right and power to make the transfer and assignment of rights set forth in paragraphs 2.01 and 2.02; and
 - d. It shall and does hereby retain all obligations to inventors set forth in this Agreement and PRF Intellectual Property Policies in respect to the PRF Luminescence Technology.

PRF MAKES NO OTHER REPRESENTATIONS AND EXTENDS NO OTHER WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED, INCLUDING BUT NOT LIMITED TO WARRANTIES OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE, NOR DOES PRF ASSUME ANY OBLIGATIONS WITH RESPECT TO INFRINGEMENT OF PATENT RIGHTS OR OTHER RIGHTS OF THIRD PARTIES DUE TO SYSTEM'S ACTIVITIES UNDER THIS AGREEMENT.

ARTICLE VII - NOTICES

- 7.01 Notices. Payments, notices, or other communications required by this Agreement shall be sufficiently made or given if mailed by certified First Class United States mail, postage pre-paid, or by commercial carrier (e.g., Federal Express, Airborne, etc.) when such carrier maintains receipt or record of delivery, addressed to the address stated below, or to the last address specified in writing by the intended recipient.

a) If to the SYSTEM:

Terry A. Young
Executive Director
Technology Licensing Office
The Texas A&M University System
310 WERC
College Station, Texas 77843-3369

(b) If to PRF:

Elizabeth J. Kuuttila
Assistant Vice President and Director
Purdue Research Foundation
Office of Technology Commercialization
1291 Cumberland Avenue, Suite F
West Lafayette, IN 47906

ARTICLE VIII - MISCELLANEOUS PROVISIONS

- 8.01 Non-Use of Names. SYSTEM shall not use the names or marks of the Purdue Research Foundation or Purdue University, nor any adaptation thereof, in any advertising, promotional or sales literature without the prior written consent obtained from PRF in each case. Likewise, PRF shall not use the names or marks of SYSTEM, in any advertising, promotional or sales literature without the prior written consent obtained from SYSTEM in each case.
- 8.02 Independent Contractors. PRF and SYSTEM are and shall remain independent contractors as long as this Agreement is in effect and neither party shall act as an agent, legal representative, partner or joint venturer of the other party for any purpose whatsoever, and the employees of one shall not be deemed the employees of the other. Neither PRF nor SYSTEM shall have any rights, power, or authority to make any contract or other agreement or to assume or create any obligations or responsibility, express or implied, on behalf of or in the name of the other, or to bind the other in any way.
- 8.03 Confidentiality. The parties do not contemplate entering into a confidential relationship under this Agreement. Notwithstanding, in the event that confidentiality is required for any action contemplated hereunder, the parties agree that they shall at that time enter into a duly executed confidentiality agreement.
- 8.04 Force Majeure. Each party shall be excused from any breach of this Agreement, which is proximately caused by government regulation, war, strike, act of God, or other similar circumstance normally deemed outside the control of well-managed businesses.

- 8.05 U.S. Laws. No party shall be liable for failures or delays in performance hereunder owing to compliance with the laws of the United States of America or any other governmental authority or to any other cause beyond the actual control of the party in question.
- 8.06 Provisions. If any provision or provisions of this Agreement shall be held to be invalid, illegal or unenforceable, the validity, legality and enforceability of the remaining provisions shall not in any way be affected or impaired thereby. Headings appear solely for convenience of reference. Such headings are not part of this Agreement and shall not be used to construe it.
- 8.07 Execution and modification. This Agreement will become binding only when signed by both parties. It may be modified or amended only by a written document signed by the parties. The persons signing below hereby warrant and represent that they have the authority to execute the Interinstitutional Agreement on behalf of the party for whom they have signed.
- 8.08 Entire Agreement. This Agreement contains the entire understanding of the parties with respect to the PRF Luminescence Technology and supersedes all other written and oral agreements between the parties with respect to the PRF Luminescence Technology.

IN WITNESS WHEREOF, the parties have caused this Agreement to become effective as of the date last executed below by a signatory to this Agreement.

PURDUE RESEARCH FOUNDATION

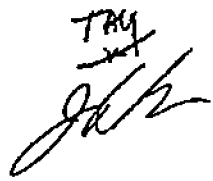
THE TEXAS A&M UNIVERSITY SYSTEM


Elizabeth J. Kuuttila
Assistant Vice President & Director

Date: 11/7/00


Tom D. Kale
Vice Chancellor for Business Services

Date: 11/1/00


TMY