

PATENT ASSIGNMENT

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SUBMISSION TYPE:

NEW ASSIGNMENT

NATURE OF CONVEYANCE:

Final Judgment, U.S. District Court, S.D. Florida

CONVEYING PARTY DATA

Name	Execution Date
NDA International, Inc.	08/18/2000
Howard S. Lotsof	08/18/2000

RECEIVING PARTY DATA

Name:	Deborah Mash Ph.D
Street Address:	7552 West Treasure Drive
City:	North Bay Village
State/Country:	FLORIDA
Postal Code:	33141

Name:	Juan Sanchez-Ramos M.D.
Street Address:	12901 Bruce B. Downs Boulevard
Internal Address:	MDC55
City:	Tampa
State/Country:	FLORIDA
Postal Code:	33612

Name:	William Lee Hearn Ph.D
Street Address:	1028 Westward Drive
City:	Miami Springs
State/Country:	FLORIDA
Postal Code:	33166

PROPERTY NUMBERS Total: 2

Property Type	Number
Application Number:	08280187
Patent Number:	5591738

PATENT

500161615

REEL: 018362 FRAME: 0318

CH \$80.00 08280187

CORRESPONDENCE DATA

Fax Number: (703)391-2901

Correspondence will be sent via US Mail when the fax attempt is unsuccessful.

Phone: 703-391-2900

Email: aoberst@globe-ip.com

Correspondent Name: Roberts Mardula & Wertheim LLC

Address Line 1: 11800 Sunrise Valley Drive

Address Line 2: Suite 1000

Address Line 4: Reston, VIRGINIA 20191

ATTORNEY DOCKET NUMBER:

1129

NAME OF SUBMITTER:

Jon L. Roberts, Ph.D., J.D.

Total Attachments: 6

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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
MIAMI DIVISION

CASE NO. 96-3712-CIV-HIGHSMITH/BROWN

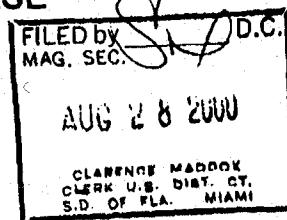
THIS IS A CONSENT CASE

DEBORAH MASH, Ph.D.,
Plaintiff,
and

UNIVERSITY OF MIAMI,
Intervening Plaintiff,

v.

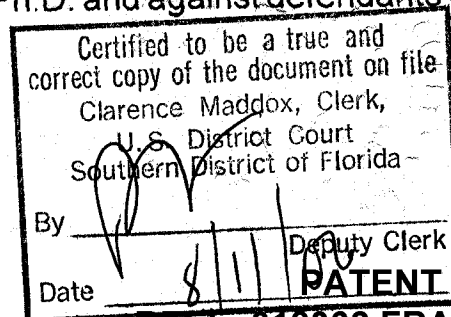
NDA INTERNATIONAL, INC.,
a New York corporation, and
HOWARD S. LOTSOFF,
Defendants.



FINAL JUDGMENT

This cause having come before this court on the Second Amended Complaint, the Complaint of Intervening Plaintiff, and the Counterclaim Against Intervening Plaintiff, and after notice to all parties and concerned persons pursuant to 35 U.S.C. § 256, it is hereby ORDERED and ADJUDGED as follows:

1. As to Count I of the Second Amended Complaint, judgment is entered in favor of plaintiff Deborah Mash, Ph.D. and against defendants NDA



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International, Inc. and Howard S. Lotsof. The patent entitled "Method of Treating Chemical Dependency Using Betacarboline Alkaloids, Derivatives and Salts Thereof" (Patent No. 5,591,738) is hereby corrected pursuant to 35 U.S.C. § 256, and is ordered corrected, requiring the Director of the United States Patent and Trademark Office to issue a certificate correcting Patent No. 5,591,738 to reflect inventorship of said patent in the names of Deborah Mash, W. Lee Hearn, and Juan Sanchez- Ramos.

2. As to Counts II and III of the Second Amended Complaint and Counts I, II and III of the Complaint of the Intervening Plaintiff, judgment is entered in favor of plaintiff Deborah Mash, Ph.D. and the University of Miami, and against defendants NDA International, Inc. and Howard S. Lotsof, and the assignment of the Noribogaine patent application and related rights (Patent Application Serial No. 08/280,187) is cancelled and rescinded. The Director of the United States Patent and Trademark Office is directed to cancel the assignments of Patent Application Serial No. 08/280,187 to NDA International, Inc. by Deborah Mash, Juan Sanchez-Ramos, and W. Lee Hearn dated July 19, 1994.

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3. As to Count IV of the Second Amended Complaint, judgment is entered in favor of plaintiff Deborah Mash, Ph.D. and the University of Miami and against defendants NDA International, Inc. and Howard S. Lotsof, and the 1994 Agreement is rescinded.

4. As to Count V of the Second Amended Complaint, judgment is entered in favor of plaintiff Deborah Mash, Ph.D. and the University of Miami and against defendants NDA International, Inc. and Howard S. Lotsof, and Patent Application Serial No. 08/280,187, and Patent No. 5,591,738, and their respective related rights are restored to plaintiff Deborah Mash, Ph.D., her co-inventors, and to the University of Miami, which has a contractual agreement with the co-inventors.

5. As to Count VI of the Second Amended Complaint, judgment is entered in favor of plaintiff Deborah Mash, Ph.D. and against defendants NDA International, Inc. and Howard S. Lotsof, and a declaratory judgment is entered in favor of plaintiff Deborah Mash, Ph.D. as follows:

(a) The invention/discovery of Noribogaine (Patent Application Serial No. 08/280,187) does not relate to the Study which is the subject of the 1992 Agreement nor did it result from the Study or the work performed under

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the Study, and is not the intellectual property of Howard Lotsof and/or NDA International, Inc.

(b) The invention/discovery of Patent No. 5,591,738 does not relate to the Study which is the subject of the 1992 Agreement nor did it result from the Study or work performed under the Study, and is, and at all material times hereto, was not the intellectual property of Howard Lotsof and/or NDA International, Inc.

(c) NDA is and was at all times since its dissolution in 1994 without the legal right to own any of the intellectual property that is the subject of this litigation.

(d) NDA is without the legal right to request or obtain affirmative relief as a party to this litigation.

(e) Assignment of Patent Application Serial No. 08/280,187 is cancelled and said application is restored to plaintiff Deborah Mash, her co-inventors, and intervening plaintiff University of Miami.

(f) Patent No. 5,591,738 is the property of plaintiff Deborah Mash, W. Lee Hearn, and Juan Sanchez-Ramos as inventors, subject to their

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contractual obligation with the University of Miami and defendant NDA International, Inc. has no right, title, or interest in said patent.

6. As to Count VII of the Second Amended Complaint, judgment is entered in favor of plaintiff Deborah Mash, Ph.D. and against defendant Howard S. Lotsof, and a declaratory judgment is entered in favor of plaintiff Deborah Mash, Ph.D. as follows:

(a) Patent No. 5,591,738 is corrected and issued in the name of Deborah Mash, W. Lee Hearn, and Juan Sanchez-Ramos as inventors.

(b) Ownership of Patent No. 5,591,738 in the U.S. Patent and Trademark Office is awarded to Deborah Mash, W. Lee Hearn, and Juan Sanchez-Ramos, subject to the contractual rights of the University of Miami.

(c) Assignment of Patent Application Serial No. 08/280,187 by Deborah Mash, W. Lee Hearn, and Juan Sanchez-Ramos to NDA International, Inc. is cancelled, rescinded, and void ab initio.

7. The entire counterclaim by defendants is dismissed with prejudice.

8. The parties are to bear their own costs and fees.

9. The court retains continuing jurisdiction to enforce the terms of this Final Judgment and the confidential Mediation Settlement Agreement

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executed on June 28, 2000, and for the prosecution and award of such supplemental relief as the court deems necessary, proper, and just.

DONE AND ORDERED this 18th day of August 2000, in Miami,

Miami-Dade County, Florida.



STEPHEN T. BROWN
UNITED STATES MAGISTRATE JUDGE

Copies furnished to:
Steven H. Kassner, Esq.
Benedict P. Kuehne, Esq.
Michael B. Ronemus, Esq.
Eric D. Isicoff, Esq.
Joseph S. Geller, Esq.
Peggy Fisher, Esq.
Charles Knapp, Esq.
Robert Rand a/k/a Robert Sisko
Addiction Research Institute, Inc.