

PATENT ASSIGNMENT

Electronic Version v1.1

Stylesheet Version v1.1

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
Ortho-McNeil Pharmaceutical Inc.	04/26/2002
RECEIVING PARTY DATA	
Name:	King Pharmaceuticals, Inc.
Street Address:	501 Fifth Street
City:	Bristol
State/Country:	TENNESSEE
Postal Code:	37620
PROPERTY NUMBERS Total: 1	
Property Type	Number
Application Number:	11439171
CORRESPONDENCE DATA	
Fax Number:	(202)371-2540
<i>Correspondence will be sent via US Mail when the fax attempt is unsuccessful.</i>	
Phone:	202-371-2600
Email:	KQUACH@SKGF.COM
Correspondent Name:	Sterne, Kessler, Goldstein & Fox, P.L.LC
Address Line 1:	1100 New York Avenue, NW
Address Line 4:	Washington, DISTRICT OF COLUMBIA 20005
ATTORNEY DOCKET NUMBER:	2710.0990004/JUK
NAME OF SUBMITTER:	Katrina Y. Pei Quach
Total Attachments: 5 source=27100990004_ASSIGNMENT_ortho_king#page1.tif source=27100990004_ASSIGNMENT_ortho_king#page2.tif source=27100990004_ASSIGNMENT_ortho_king#page3.tif source=27100990004_ASSIGNMENT_ortho_king#page4.tif source=27100990004_ASSIGNMENT_ortho_king#page5.tif	

OP \$40.00 11439171

PATENT

500252436

REEL: 019112 FRAME: 0198

ASSIGNMENT OF RIGHTS AND OBLIGATIONS

This assignment of rights and obligations (the "Agreement") is entered into as of April __, 2002 by and between:

Ortho-McNeil Pharmaceutical, Inc., a corporation of the State of Delaware, having a principal place of business at U.S. Route 202, P.O.Box 300, Raritan, NJ 08869-0602, and successor in interest to Ortho Pharmaceutical Corporation, a corporation of the State of New Jersey, (hereinafter OMP or Seller) and

King Pharmaceuticals, Inc. a corporation of the State of Tennessee, having principal offices located at 501 Fifth Street, Bristol, Tennessee 37620, (hereinafter KING or Purchaser).

WHEREAS, OMP and KING have entered into that certain Asset Purchase Agreement dated as of April 26, 2002 ("Asset Purchase Agreement"); and

WHEREAS, in connection with such Asset Purchase Agreement, OMP wishes to assign certain rights and obligations and KING wishes to acquire all such rights and assume all such obligations as set forth below, with such assignment to be effective upon the closing of the Asset Purchase Agreement.

NOW, THEREFORE, OMP and KING, for good and valuable consideration the sufficiency of which is hereby acknowledged agree as follows:

1) Definitions:

- a) CASPER AGREEMENTS shall mean the (i) the Assignment by Robert F. Casper to Jencap Research, Ltd. ("Jencap") dated February 10, 1987, (ii) the License Agreement between Robert F. Casper, Jencap Research and Ortho Pharmaceutical Corporation dated May 1, 1987, (iii) the Agreement between Jencap, Medicor Development, Robert F. Casper and Ortho Pharmaceutical Corporation dated December 1, 1994 (to the extent it is still in effect), and (iv) the Letter of Acknowledgement by Robert F. Casper dated February 11, 1999.
- b) CASPER PATENT(S) shall mean U.S. Patent No. 5,108,995, U.S. Patent No. 5,382,573, U.S. Patent Appln. No. 09/538,485 filed March 30, 2000 and U.S. Provisional Appln. No. 60/126,970 filed March 30, 1999, and any and all continuations, continuations-in-part, divisionals, reissues, reexaminations, renewals and/or extensions thereof and any patents issued on the foregoing.
- c) EFFECTIVE DATE shall mean the date on which this Agreement becomes effective, which shall be the Closing Date under the Asset Purchase Agreement.
- d) PRODUCT shall mean the cyclophasic steroidal product for hormone replacement therapy approved for sale in the United States under NDA 021040 and bioequivalents thereto and any use, manufacture, sale or packaging thereof.
- e) TERRITORY shall mean the United States of America, its territories and possessions (including the Commonwealth of Puerto Rico).

- 15) This Agreement may be executed in any number of counterparts, and each such counterpart hereof shall be deemed to be an original instrument, but all such counterparts together shall constitute but one agreement.
- 16) The article and section headings contained in this Agreement are for reference purposes only and shall not affect in any way the meaning or interpretation of this Agreement.
- 17) This Agreement shall be construed, interpreted and the rights of the parties determined in accordance with the laws of the State of New Jersey without reference to the choice of law provisions thereof.
- 18) This Agreement may be executed in two or more counterparts, each of which shall be deemed an original, but all of which together shall constitute one and the same instrument.

IN WITNESS WHEREOF, OMP and KING have caused this agreement to be executed in duplicate by their duly authorized officer

By Ortho-McNeil Pharmaceutical, Inc:

Name:

Title:

Date:

By King Pharmaceuticals, Inc.:


Name:

Title:

Date:

CONSENT OF JENCAP RESEARCH, Ltd and ROBERT F. CASPER

Jencap and Casper, for good and valuable consideration the sufficiency of which is hereby acknowledged, agree as follows:

- A) Jencap and Casper consent to this Agreement by OMP to KING of the rights and obligations described above.
- B) OMP agrees, in consideration of Jencap and Casper entering into this Agreement, to pay to Jencap the sum of [REDACTED] (the "Payment"). The Payment shall be made to Casper within five (5) business days after the Closing under the Asset Purchase Agreement. If the Asset Purchase Agreement does not close, then the Payment shall

- 15) This Agreement may be executed in any number of counterparts, and each such counterpart hereof shall be deemed to be an original instrument, but all such counterparts together shall constitute but one agreement.
- 16) The article and section headings contained in this Agreement are for reference purposes only and shall not affect in any way the meaning or interpretation of this Agreement.
- 17) This Agreement shall be construed, interpreted and the rights of the parties determined in accordance with the laws of the State of New Jersey without reference to the choice of law provisions thereof.
- 18) This Agreement may be executed in two or more counterparts, each of which shall be deemed an original, but all of which together shall constitute one and the same instrument.

IN WITNESS WHEREOF, OMP and KING have caused this agreement to be executed in duplicate by their duly authorized officer

By Ortho-McNeil Pharmaceutical, Inc.

Name: PATRICK VERHEYEN

Title: V.P. Corp. Dev.

Date: April 126, 2002

By King Pharmaceuticals, Inc.:

Name:

Title:

Date:

CONSENT OF JENCAP RESEARCH, Ltd and ROBERT F. CASPER

Jencap and Casper, for good and valuable consideration the sufficiency of which is hereby acknowledged, agree as follows:

- A) Jencap and Casper consent to this Agreement by OMP to KING of the rights and obligations described above.
- B) OMP agrees, in consideration of Jencap and Casper entering into this Agreement, to pay to Jencap the sum of [REDACTED] (the "Payment"). The Payment shall be made to Casper within five (5) business days after the Closing under the Asset Purchase Agreement. If the Asset Purchase Agreement does not close, then the Payment shall

not be made (and this Agreement shall not become effective as specified in Section 2 above).

- C) Jencap and Casper from this date forward accept KING as solely accountable and responsible to fulfill the obligations previously owed by OMP and assigned to KING herein. Jencap and Robert F. Casper hereby release OMP from any further such obligations.
- D) Jencap and Casper acknowledge that any breach or default by KING or OMP of their respective obligations under this Agreement or the CASPER AGREEMENTS shall not be considered a breach or default by the other party under those same agreements.
- E) Jencap and Casper acknowledge that payment of a minimum royalty by OMP under Paragraph 4.1(c), of the License Agreement, which is referenced as CASPER AGREEMENTS (ii) in paragraph 1(a) hereinabove, shall meet OMP's payment obligations under Article IV of that License Agreement only with respect to the Product.
- F) Jencap and Casper represent and warrant that they have the unencumbered right to consent to this Agreement and to otherwise agree as set forth herein. Jencap and Casper further warrant that the CASPER AGREEMENTS are in full force and effect.
- G) Jencap and Casper, to their knowledge, represent and warrant that the CASPER PATENTS are valid and enforceable. Jencap and Casper, to their knowledge, further represent and warrant that all maintenance fees due and/or owed for the CASPER PATENTS have been timely paid. Jencap and Casper, to their knowledge, further represent and warrant that the CASPER PATENTS are not and have never been the subject of a Paragraph IV Certification, litigation or threatened litigation. Jencap and Casper, to their knowledge, further represent and warrant that the manufacture, use and/or sale of PRODUCT does not and has not infringed a claim in any United States Patent. Jencap and Casper, to their knowledge, further represent and warrant that they are unaware of any third party patent application, which is pending as of the Effective Date, that contains a claim, that if issued, would be infringed by the manufacture, use and/or sale of PRODUCT. Jencap represents and warrants that it owns all right, title and interest in, to and under U.S. Patent No. 5,108,995 and U.S. Patent No. 5,382,573, and co-owns all right, title and interest in, to and under U.S. Provisional Application No. 60/126,970, and that it has exclusively licensed the ~~Casper Patents to OMP only~~. Casper represents and warrants that he has conveyed all right, title and interest in, to and under the Casper Patents to Jencap and that he had the right to do so.
- H) Jencap and Casper agree to appoint counsel designated by KING to prosecute and transact all business in the U.S. Patent and Trademark Office with respect to the CASPER PATENTS and KING agrees to accept responsibility to prosecute and transact all business in the U.S. Patent and Trademark Office with respect to the CASPER PATENTS. KING will not abandon the maintenance of the CASPER PATENTS without Casper and Jencap's consent, nor will KING fail to pay any

APR-26-2002 19:45 FROM T. C. A. R. T. TO 190823.1
HPK 26 2002 19:45 HPK JMJ LHM DEPT 732 524 5845 TO 314183/2002

P.08/08
P.03


Attachment C:
OMP/King Agreement
(redacted) (Sheet 5 of 5)

maintenance fees with respect to the CASPER PATENTS without Casper and Jencap's consent. Jencap and Casper further agree to revoke all existing powers granted to counsel currently designated to prosecute and transact all business in the U.S. Patent and Trademark Office with respect to the CASPER PATENTS. Jencap and Casper further agree to cooperate with and assist KING in connection with the prosecution and transaction of all business in the U.S. Patent and Trademark Office with respect to the OMP PATENTS. Jencap and Casper further hereby waive any and all conflicts that may arise out of, relate to or concern the prosecution and transaction of all business in the U.S. Patent and Trademark Office with respect to the CASPER PATENTS.


- I) Jencap and Casper further agree to file with the U.S. Patent and Trademark Office on or before May 1, 2002, a continuation of U.S. Patent Appln. No. 09/535,485 filed March 30, 2000.
- J) The foregoing warranties will expire 18 months following the Effective Date of this Agreement.

AGREED TO BY:

By Jencap Research, Ltd:


Name: ROBERT F. CASPER
Title: PRESIDENT
Date: APRIL 26, 2002

By Robert F. Casper:


Date: APRIL 26, 2002

APR-26-2002 19:11

732 524 5845

974

*** TOTAL PAGE.09 ***
P.09

TOTAL P.08