

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT3397844

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
MIRIAM CATHER SIMPSON	08/05/2014
CHARLES A. ROHDE	08/05/2014
RECEIVING PARTY DATA	
Name:	AUCKLAND UNISERVICES LIMITED
Street Address:	70 SYMONDS STREET
Internal Address:	LEVEL 10
City:	AUCKLAND
State/Country:	NEW ZEALAND
PROPERTY NUMBERS Total: 1	
Property Type	Number
Application Number:	14417622
CORRESPONDENCE DATA	
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<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>	
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ATTORNEY DOCKET NUMBER:	0074-P05596US01#1
NAME OF SUBMITTER:	VINCENT T. PACE
SIGNATURE:	/Vincent T. Pace/
DATE SIGNED:	06/16/2015
Total Attachments: 8	
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PATENT

REEL: 035918 FRAME: 0532

INVENTOR DEED OF ASSIGNMENT

THIS DEED made this 5th day of August 2014

BETWEEN **Auckland UniServices Limited**, a New Zealand Company of Level 10, 70 Symonds Street, Auckland, New Zealand (the "Assignee")

AND **Miriam Cather Simpson**, a US citizen residing at 22 St Peters St, Northcote, Auckland, Auckland **and**
Charles A. Rohde, a US citizen residing at 248 Maynard St. Apt 5, Santa Fe, NM 87501, USA, (Together the "Inventors")

BACKGROUND

A. UniServices is responsible for the management of the intellectual property rights of the University of Auckland (the "University"), and all of those rights are vested by the University in UniServices by Deed of Agreement dated 27 February 1997.

B. The Inventors are, or were at the relevant time, either staff or students at the University and in the course of this relationship have conducted research which has resulted in the conception and reduction to practice of an invention entitled "**Method and System for Microfluidic Particle Orientation and/or Sorting**" for which a provisional patent specification was filed as **61/676391** on **27/07/2012** (the "Invention"). Subsequently there have been developments, modifications or improvements (the "Developments") which have been included in a PCT patent application number **PCT/NZ2013/000135** filed on **29/07/2013** (the "Application").

C. In order to carry out the research the Inventor has required access to and the use of pre-existing Intellectual Property or Confidential Information of the University or UniServices, and/or access to and the use of Intellectual Property of any third party with which UniServices has contractual obligations in terms of confidentiality and/or protection of Intellectual Property rights (a "Third Party"), (collectively "UniServices Interests").

D. In the course of developing the Invention the Inventor has produced or had produced works in which copyright may exist, including, without limitation, sketches, drawings, photographs, formulae, prototypes, models, descriptions, tables, technical data and databases (the "Works"), but specifically excluding copyright in academic publications for which the Inventor is author.

NOW THIS DEED WITNESSES

1. Definitions

"**Agreement**" means this agreement signed by all parties.

"**Confidential Information**" means any and all information of the University or UniServices and/or any Third Party(s), whether scientific, technical, trade, business or

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31775 - Method of using light to sort microparticles

PCT/NZ2013/000135 - Method and System for Microfluidic Particle Orientation and/or Sorting

This document is a certified, true copy of the original.

E. B. Simpson **PATENT** 8/8/14
REEL: 035918 FRAME: 0533

information of any kind, which is treated by UniServices as confidential, whether or not that information is labeled or stated to be confidential, subject to the proviso below. Without limitation, this information includes techniques, formulations, equipment, tests, data, text, reports, compilations, tables, drawings, sketches, know-how, sources of supply, patent position, relationships with consultants and employees, business plans and business developments, information concerning the scope or activities of research, development, manufacturing, marketing or other projects, samples and Materials; whether existing at the date of this Agreement or subsequently developed, **and specifically including the Results.**

Providing that "Confidential Information" does not include information:

- a. already in the public domain prior to the date of disclosure to the Inventor by or on behalf of UniServices; or
- b. demonstrated, from written records, to have been in the Inventor's possession from another source, not under obligation of secrecy to UniServices, prior to disclosure by UniServices; or
- c. that subsequently becomes part of the public domain through no fault of the Inventor.

"Intellectual Property" means all intellectual property rights including, but not limited to, inventions (whether or not patentable), designs (whether or not registrable), know-how, Confidential Information of any type and in any form, and copyright material including, without limitation, sketches, drawings, models, prototypes, technical data, databases and compilations, software, descriptions and publications, recordings and photographs.

"Materials" includes any material of biological or chemical origin which is proprietary to the University or UniServices.

"Net Revenue" means revenue of any type received from direct commercialisation of Intellectual Property, or the licensing or assignment of Intellectual Property, **minus** direct expenses incurred in connection with such commercialisation, including the costs associated with patent or other Intellectual Property protection and marketing/commercialisation.

"Results" means any and all outcomes from the research which form part of the Invention, including without limitation, all information, data and Materials.

2. Confidentiality and Publications

2.1 Except in accordance with a direction by, or prior written approval from, UniServices the Inventor will not at any time either directly or indirectly use, publish or disclose to any person, and will use his/her best endeavours to prevent the use, publication or disclosure of, any Confidential Information and, where appropriate, will take all reasonable steps to prevent access by third parties to such Confidential Information.

2.2 If the Inventor is reasonably of the view that disclosure of any Confidential Information to a third party is necessary, he/she must seek the prior written approval of UniServices by submitting a written proposal to UniServices stating to whom he/she considers such disclosure to be necessary and why.

2.3 When the Inventor is a student and completes a thesis, the Inventor shall inform UniServices and make a copy available to UniServices, on request. If the thesis is deemed by UniServices to contain commercially sensitive information it shall co-ordinate with the University to not release the thesis to any examiner until the examiner has signed a confidentiality agreement with UniServices or the University. If the thesis includes potentially protectable Intellectual Property, UniServices may request the Inventor and the University that such Intellectual Property in the thesis be sequestered in a confidential annex to the thesis, or that any disclosure of the entire thesis be subject to an embargo, for the purpose of applying for patent protection. Any such embargo shall be for no longer than the maximum period of time allowed under the University's regulations. For the avoidance of doubt, it is agreed that the maximum embargo period allowed is currently a period of one year, which may be renewed for a further period of one year (Reference: University of Auckland Calendar 2002, Page 36, Paragraph 23 (d)).

2.4 UniServices acknowledges that the right to publish the Results in scientific articles is the Inventor's. However, the Inventor agrees that a copy of any scientific article (including any poster, abstract, full paper or intended oral presentation) arising from the research must be supplied to UniServices for review at least 1 month prior to its submission or presentation, and it shall not be submitted for publication or disclosed without the prior written approval of UniServices. UniServices may require the removal of any commercially sensitive information and/or may require that the submission or presentation be deferred for a maximum of 3 months to allow for the filing of applications to protect any Intellectual Property rights.

2.5 The Inventor will ensure that laboratory recording books, computer disks, or other media relating to the Invention are kept confidential and that these documents or records are left with the University when the Inventor is no longer an Inventor or employee of the University.

2.6 The Inventor will not use any Confidential Information for any purpose other than to carry out research or as otherwise set out in this Agreement and, in particular, will not use any Confidential Information for his/her own benefit (whether financial or otherwise).

2.7 The restrictions contained in this section 2 will continue to apply without limit in point of time, but will cease to apply to knowledge or information which becomes public through no fault of the Inventor.

2.8 UniServices acknowledges that it cannot, by virtue of this Agreement or otherwise, unreasonably or arbitrarily:

2.8.1 restrict the Inventor's ability to submit his/her thesis to the University or any examiner, except in accordance with clause 2.3; or

2.8.2 withhold approval for the Inventor to publish the results of his/her research in scientific articles, except in accordance with clause 2.4.

3. Intellectual Property Ownership and Protection

3.1 In consideration of the employment, contract, commissioning and/or other valuable consideration, and one dollar New Zealand currency (NZ\$1.00), the receipt and

sufficiency of which the Inventors acknowledge, the Inventors HEREBY ASSIGN AND TRANSFER to the Assignee, its successors and assigns, absolutely, all their right, title and interest in the Invention and the Works for all countries and regions of the world, including, without limitation, the right to apply for, claim Convention priority in respect of, obtain and hold intellectual property protection for the Invention and/or Works, by way of patent, copyright, design or any other form of protection which may be available in any country or region.

3.2 The Inventor will promptly notify UniServices of all Intellectual Property made or discovered by the Inventor while conducting his/her research in relation to the Invention. All such Intellectual Property developed by the Inventor which constitutes a modification, improvement or development of the Invention will belong to and be the absolute property of UniServices and will not be used by the Inventor for any purpose other than as set out in this Agreement or for carrying out his/her research. Any other Intellectual Property developed by the Inventor in the course of his/her research will belong to and be the absolute property of the Inventor ("Inventor IP") and shall not in any way be bound by the terms of this agreement.

3.3 The Inventor, if and when required to do so, will assist UniServices in applying for and obtaining, such patents or other intellectual property protection in New Zealand or any other part of the world for the Invention, and will execute all instruments and do all things necessary to vest all right, title, and interest in the Invention, and associated applications for protection of all rights in that Invention, in UniServices absolutely as sole legal and beneficial owner.

3.4 The Inventor warrants that to the best of his/her knowledge he/she is entitled to assign all rights referred to in clause 3.1 and 3.2 to UniServices, and that no third party has any proprietary or similar rights in respect of the Invention, other than has been previously disclosed to UniServices by the Inventor. In particular the Inventor warrants that he/she has not and will not receive any commercial or other funding in respect of his/her research relating to the Invention which could compromise his/her ability to comply with the provisions of this section of the Agreement.

3.5 UniServices confirms that the Inventor shall retain authorship and copyright in his/her thesis and any academic publications prepared by the Inventor.

3.6 In respect of any Works, other than as described in paragraph 3.5 above, the Inventor hereby waives any moral rights he/she may have which are capable of waiver, including the right to be acknowledged as author of any such works and the right to object to derogatory treatment of the works.

3.7 UniServices confirms the Inventor's right to be named as an inventor on any patent application for the Invention.

4. Dispute Resolution

4.1 The parties to this Agreement will attempt to resolve by discussion any dispute arising out of or relating to this Agreement.

4.2 In the absence of resolution in accordance with 4.1, the parties may use any alternate dispute resolution mechanism to which they all consent. In the absence of agreement or upon failure to resolve the dispute any party may resort to the courts. This Agreement will be governed by the laws of New Zealand and shall be under the jurisdiction of the courts of New Zealand.

5. Miscellaneous

5.1 THE INVENTOR ACKNOWLEDGES THAT UNISERVICES OR THE INVENTOR'S UNIVERSITY SUPERVISOR HAS ADVISED HIM/HER TO OBTAIN INDEPENDENT LEGAL ADVICE IN RESPECT OF ANY ASPECT OF THIS AGREEMENT ABOUT WHICH THEY HAVE ANY UNCERTAINTY, AND THAT THE INVENTOR HAS HAD SUFFICIENT TIME AND OPPORTUNITY TO OBTAIN SUCH ADVICE.

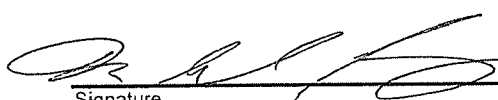
5.2 This Agreement constitutes the entire agreement between the parties. Any prior arrangements, agreements, representations or undertakings are hereby superseded.

5.3 This Agreement may be amended at any time by agreement in writing between the parties.

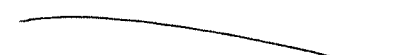
5.4 UniServices agrees at all times to act in good faith in its dealings with the Inventor pursuant to this Agreement, and to endeavour to support and further the Inventor's career.

IN WITNESS WHEREOF this Deed has been executed the day and year first written above

Signed for and on behalf of **Miriam Cather Simpson**

 _____ Signature	 _____ Witness Signature
Miriam Cather Simpson _____ Name	Jacob Martin _____ Witness Name
INVENTOR, RESEARCHER _____ Capacity	Auckland _____ Witness City of Residence
	5/8/14 _____ Date

Signed for and on behalf of **Charles A. Rohde**

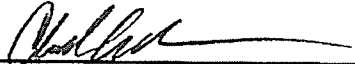
 _____ Signature	 _____ Witness Signature
Charles A. Rohde _____ Name	_____ Witness Name
_____ Capacity	_____ Witness City of Residence
	_____ Date

IN WITNESS WHEREOF this Deed has been executed the day and year first written above

Signed for and on behalf of Miriam Cather Simpson

Signature	Witness Signature
Miriam Cather Simpson	
Name	Witness Name
Capacity	Witness City of Residence
	Date

Signed for and on behalf of Charles A. Rohde

	
Signature	Witness Signature
Charles A. Rohde	Theodore Martin
Name	Witness Name
self	Springfield, VA
Capacity	Witness City of Residence
	8/5/14
	Date

Signed for Auckland UniServices Limited
By



Director Signature

Tony Andrew McNaught

Director Name

5/8/14

Date



Director Signature

JANE HARDING

Director Name

7/8/14

Date