

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT4405429

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
THE CHANCELLOR, MASTERS AND SCHOLARS OF THE UNIVERSITY OF OXFORD	03/21/2014
RECEIVING PARTY DATA	
Name:	THE PIRBRIGHT INSTITUTE
Street Address:	ASH ROAD
City:	PIRBRIGHT, WOKING, SURREY
State/Country:	GREAT BRITAIN
Postal Code:	GU24 ONF
PROPERTY NUMBERS Total: 1	
Property Type	Number
Application Number:	14779797
CORRESPONDENCE DATA	
Fax Number:	(732)594-4720
<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>	
Email:	us_efs@merck.com
Correspondent Name:	MERCK SHARP & DOHME CORP.
Address Line 1:	126 EAST LINCOLN AVENUE
Address Line 4:	RAHWAY, NEW JERSEY 07065-0900
ATTORNEY DOCKET NUMBER:	23492-US-PCT
NAME OF SUBMITTER:	ANGELA A. KIAUSAS
SIGNATURE:	/Angela A. Kiausas/
DATE SIGNED:	05/09/2017
Total Attachments: 12	
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Dated 21 MARCH 2014

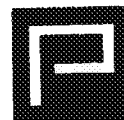
(1) The PIRBRIGHT INSTITUTE

(2) THE CHANCELLOR, MASTERS AND SCHOLARS OF THE UNIVERSITY OF
OXFORD

PATENT ASSIGNMENT AND REVENUE SHARE AGREEMENT

Pirbright Reference
Oxford Reference

Project 393
Project 9177



Penningtons Manches LLP
Oxford Business Park
9400 Garsington Road
Oxford Business Park
Oxford
OX4 2HN

3075605

PATENT
REEL: 042305 FRAME: 0835

THIS ASSIGNMENT is made on the 21 day of MARCH 2014

BETWEEN:

- (1) **THE CHANCELLOR, MASTERS AND SCHOLARS OF THE UNIVERSITY OF OXFORD** whose administrative offices are at University Offices, Wellington Square, Oxford, OX1 2JD ("the **Assignor**"); and
- (2) **THE PIRBRIGHT INSTITUTE** a research institute whose administrative office is at Pirbright Laboratory, Ash Road, Pirbright, Woking, Surrey, HU24 ONF ("the **Assignee**").

BACKGROUND

- A. The Stability Patent (defined below) arose as a result of two projects. One of the projects was funded by the Wellcome Trust (the "**Wellcome Trust Funded Project**") and the other project was funded by Defra (the "**Defra Funded Project**"). The Assignor and Assignee were parties to the underlying agreements relating to the Wellcome Trust Funded Project and the Defra Funded Project.
- B. The Assignor is willing to assign to the Assignee and the Assignee is willing to accept an assignment of all the Assignor's rights relating to the contribution of Professor David Stuart, Dr Robert Esnouf, Dr Elizabeth Fry and Mr Abhay Kotecha in and to the Stability Patent on the terms of this Assignment Agreement.

OPERATIVE PROVISIONS

1. Definitions

- 1.1. In this Assignment Agreement the following words and phrases will have the following meanings:

"Collaboration Agreement"	Means the collaboration agreement for the Wellcome Trust Strategic award between Intervet International BV, Assignee, Assignor, the University of Reading and the University of Dundee and under which the Stability Patents are licensed in relation to a vaccine used for the prevention of foot and mouth disease in animals and on the terms set out in Schedule 1 to this Agreement;
"Confidential Information"	means, the terms of this Agreement and any confidential information comprised within the Stability Patent- (to the extent such have not been published as part of the patent prosecution);
"Defra"	Means the Department of Environment, Food and Rural Affairs;
"Effective Date"	means the date of this Assignment Agreement;
"Exploitation Expenses"	Means documented expenses reasonably incurred by Assignee or its licensees in connection with the administration,

exploitation, further development, prosecution, maintenance or filing of the Stability patent including (a) any payments made to third party collaborators or third parties assisting or involved in the further development or exploitation of the Stability Patent; (b) any payments or share of Exploitation Receipts due to third parties under the terms of the Wellcome Trust Funded Project or Defra Funded Project; and (c) any external legal costs or patent agent costs;

- "Exploitation Receipts"** Means Income received by Assignee directly from (a) the supply of any product or service which infringes the Stability Patent; or (b) any licensing or sub-licensing of the Stability Patent (including any option to grant a licence) in each case after deduction of a sum equivalent to the Exploitation Expenses;
- "Stability Patent"** Means the patent application with number EP13161139;
- "Term"** means the period under clause 7.1 below.
- "Wellcome Trust"** means the Wellcome Trust Limited.

2. Assignment

- 2.1. In consideration of the payment of a revenue share as set out in clause 4 below, the Assignor hereby assigns to the Assignee all its right, title and interest in and to:
- 2.1.1. the Stability Patent;
 - 2.1.2. (a) apply for all patent applications and patents directly or indirectly claiming priority from or claiming common priority with this application including all divisions, extensions, continuations, continuations-in-part, reissues, registrations and supplementary protection certificates (and any other extension in the term of a patent) in relation to any of them; and (b) any invention described or claimed in any of the patent applications or patents, whether existing or future; and (c) any foreign equivalents of the patents or patent applications in (a) or (b).
 - 2.1.3. the right to claim priority from the Stability Patent under section 5 of the Patents Act 1977, the Paris Convention or any other relevant international convention or treaty; and
 - 2.1.4. all causes of action and other enforcement rights under, or on account of, the Stability Patent including the right to sue for damages and other remedies in respect of any infringement of the Stability Patent occurring prior to the date of this Assignment Agreement.

- 2.2. As provided under clause 4.2.1 of the Collaboration Agreement, the Assignee hereby grants to the Assignor a limited, non-exclusive, non-transferrable, non-sublicensable, royalty-free licence and right under its rights in the Stability Patent for the sole purpose of conducting internal non-commercial research. Save as provided under the Collaboration Agreement, any results obtained by the Assignor in its non-commercial research with the use of the above referred to Stability Patent shall be owned by the Assignor.
- 2.3. Prosecution and maintenance of the Stability Patent shall be in accordance with the terms of the Collaboration Agreement.

3. Warranties and Undertakings

- 3.1. The Assignor warrants that as at the date of this Assignment Agreement:
 - 3.1.1. It is entitled to all its right, title and interest in and to the Stability Patent;
 - 3.1.2. Professor Stuart, Dr Esnouf, Dr Fry were employees of the Assignor and that Mr Kotecha was a student at the Assignor as at the date their inventions claimed under the Stability Patent were created and/or reduced to practice; and
 - 3.1.3. It has the right to assign all its right, title and interest in and to the Stability Patent to the Assignee in accordance with the provisions of this Assignment Agreement and has obtained consent to this Assignment Agreement from the Wellcome Trust; and
 - 3.1.4. as far as it is aware, the Assignor has not received any allegation or notification that the Stability Patent infringes the rights of any third party; and
 - 3.1.5. neither the Assignor nor Professor Stuart, Dr Esnouf, Dr Fry nor Mr Kotecha have granted any options or licences to, or entered into any agreements or other arrangements with, any third party in relation to the Stability Patent; or created any encumbrances on or in respect of the Stability Patent;
 - 3.1.6. as far as it is aware, none of Professor Stuart, Dr Esnouf, Dr Fry or Mr Kotecha have made any disclosure (save under conditions of confidentiality) of the inventions claimed in the Stability Patent prior to the date of filing of the Stability Patent.
- 3.2. Save as explicitly provided under clause 3.1 above, the Assignor gives no warranty or representation of any kind:
 - 3.2.1. regarding the validity or enforceability of any of the rights assigned under this Assignment Agreement, or that the Stability Patent or any of the patent applications as described in 2.1.2 will proceed to grant; or
 - 3.2.2. that exploitation of the Stability Patent or any of the patent applications or patents as described in 2.1.2 will not infringe any third party intellectual property rights

- 3.3. Each party acknowledges that in entering into this Assignment Agreement it does not do so in reliance on any representation, warranty or other provision except as expressly provided for in this Assignment Agreement and any conditions, warranties or other terms implied by statute or common law are excluded from this Agreement to the full extent permitted by law.
- 3.4. The Assignor agrees to provide all reasonable assistance as may be required by the Assignee (or any licensee under the Stability Patent) from time to time to support prosecution or enforcement of the Stability Patent including provision of information within the ownership or control of the Assignor or due diligence information relating to contributions made by the individuals listed in clause 3.1.2 or steps taken by Assignor in relation to prosecution of the Stability Patent prior to the Effective Date. Such assistance shall be subject to reimbursement of any out of pocket expenses incurred by Assignor in providing such assistance.

4. Consideration

- 4.1. In consideration for the assignment of rights set out in clause 2, the Assignee will pay to the Assignor a share of all Exploitation Receipts received by the Assignee. Where any Exploitation Receipts arise as a result of the grant of any licence under the Collaboration Agreement then the terms of the Collaboration Agreement shall be used to calculate the amount of share of Exploitation Receipts payable to Assignor. Should the Assignor exploit the rights assigned under clause 2 other than in accordance with the Collaboration Agreement then the parties will agree in good faith the amount of Exploitation Receipts payable to Assignor. Such share of the Exploitation Receipts shall be based on the relative contribution of the Assignor and Assignee to the reduction to practice of the inventions claimed in the Stability Patent and any further development contributions made by Assignor, Assignee or any third party involved in such further development. Any share will also take into account any obligation under Assignor or Assignee internal requirements for rewarding inventors, including Assignor's statutes. Any share and exploitation of the rights under clause 2 other than in accordance with the Collaboration Agreement will also be subject to prior agreement from the Wellcome Trust.
- 4.2. In the event the Stability Patent is exploited together with other technologies or other intellectual property rights, then the parties will agree in good faith a relative weighting to each technology or intellectual property rights included in any supply or licence as a contribution to the whole.
- 4.3. The Assignee shall account for any share of Exploitation Receipts payable to Assignor on an annual basis and shall provide a statement within three months of the end of Assignee's financial year which sets out any Exploitation Receipts received in the preceding financial year, together with details of the amount of Exploitation Expenses deducted and amount of any payment being made to Assignor. Following receipt of statement, Assignor shall invoice Assignee for the relevant amount of Exploitation Receipts payable to Assignor and Assignee shall pay such invoice within 60 days of receipt. Patent costs relating to the Stability Patent already incurred by Assignor's technology transfer company, Isis Innovation Ltd,

as shown in Schedule 3 shall be re-imbursed to the Assignor out of gross receipts of Assignee from the exploitation of the Stability Patent.

4.4. All invoices will be submitted as follows:

Account Name:	The Pirbright Institute
Account No.:	00468305
Bank:	Lloyds Bank Plc
Sort code:	30 98 41
IBAN:	GB84LOYD30984100468305
SWIFT code:	LOYDGB21106
Branch:	5 High Street, Swindon, Wiltshire, SN1 3EN
Account Currency:	Pounds Sterling
VAT Number:	GB 491 4528 31

4.5. All invoices will be paid together with any value added tax (as applicable) less any withholding or other taxes which the Assignee is required to withhold in accordance with any regulatory requirements or applicable laws. Assignee shall assist Assignor in reclaiming any withheld amounts to the extent reasonably necessary.

5. **Obligations on the Assignee**

- 5.1. The Assignee will comply with the terms of the Collaboration Agreement in relation to prosecution and maintenance of the Stability Patent and informing the Assignor of the progress of such Stability Patent.
- 5.2. The Assignee will comply with clauses 4.4.1-4.4.3 (inclusive) of the collaboration agreement dated 15 November 2009 (schedule 2) in relation to the option granted to the Agricultural Research Council under certain of the rights assigned to the Assignee under this Assignment Agreement and under its Background Intellectual Property (as set out and defined in said collaboration agreement dated 15 November 2009).

6. **Confidentiality**

- 6.1. Each party ("the Receiving Party") undertakes:
- 6.1.1. to keep the Confidential Information secret and confidential and to respect the other party's rights in it except where such confidential information is disclosed as part of any patent prosecution process;
 - 6.1.2. to disclose the Confidential Information only to those of its employees to whom and to the extent that such a disclosure is reasonably necessary.
- 6.2. The provisions of clause 6.1 will not apply to Confidential Information that the Receiving Party can demonstrate by reasonable, written evidence:
- 6.2.1. was, prior to its receipt from the Disclosing Party, in the possession of the Receiving Party without any obligation of confidence; or

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- 6.2.2. Is subsequently disclosed to the Receiving Party without any obligation of confidence by a third party who has not derived it directly or indirectly from the Disclosing Party; or
 - 6.2.3. Is or becomes generally available to the public through no act or default of the Receiving Party or its employees; or
 - 6.2.4. Is independently developed by the Receiving Party without the aid, application, or use of Confidential Information of the Disclosing Party, as can be demonstrated by written records created at the time of that independent development.
- 6.3. The Receiving Party may disclose Confidential Information of the Disclosing Party to the extent that it is required to disclose it by or to the courts of any competent jurisdiction, or to any government, regulatory agency or financial authority, provided that the Receiving Party must:
- 6.3.1. Inform the Disclosing Party of the requirement to disclose as soon as is reasonably practicable; and
 - 6.3.2. At the Disclosing Party's request, seek to persuade the court, agency or authority to have the Confidential Information treated in a confidential manner, where this is possible under the court, agency or authority's procedure.
- 6.4. Each party may also disclose the Confidential Information to the Wellcome Trust and Defra, subject to reasonable terms of confidentiality.

7. Term and Termination

- 7.1. This Assignment Agreement will come into force on the Effective Date and will remain in force until the earlier of the date on which the Stability Patent or any other patent as described in 2.1.2(a) have expired or been abandoned, withdrawn or revoked without a right of further appeal.
- 7.2. On termination of this Assignment Agreement:
 - 7.2.1. each party will cease to use any Confidential Information of the other and will return to the other or destroy (at the Disclosing Party's option) all copies and delete all electronic records of the Disclosing Party's Confidential Information that remain in its possession or under its control save that the receiving Party may keep one copy in secure conditions in order to fulfil its ongoing obligations under this Agreement;
 - 7.2.2. neither party will have any further obligation to the other except in respect of any accrued rights; and
 - 7.2.3. the provisions of clauses 3, 6, 7, 8, 9 and 10 will survive termination and remain in force for the time specified in that clause or, if none, indefinitely.

8. LIMITATION OF LIABILITY

- 8.1. Each party to this Agreement undertakes to make no claim in connection with this Agreement or its subject matter against any employee, student, agent or appointee of the other party to this Agreement (apart from claims based on

fraud or wilful misconduct). This undertaking is intended to give protection to individuals: It does not prejudice any right that each party might have to claim against the Assignee.

- 8.2. The liability of any party for any breach of this Agreement, or arising in any other way out of the subject-matter of this Agreement, will not extend to loss of business, or to any indirect or consequential damages or losses.
- 8.3. In any event, other than in the case of personal injury or death resulting from negligence, or any fraud, or any sort of liability which, by law, cannot be limited or excluded, the maximum liability of one party to the other for any loss or damage whatsoever arising under or otherwise in connection with this Agreement or its subject matter shall not exceed the sum of £500,000.
- 8.4. If any sub-clause of this clause 8 is held to be invalid or unenforceable under any applicable statute or rule of law then it shall be deemed to be omitted, and if as a result any party becomes liable for loss or damage which would otherwise have been excluded then such liability shall be subject to the remaining sub-clauses of this clause 8.
- 8.5. When exploiting the Stability Patent other than in accordance with the Collaboration Agreement, the Assignee will take reasonable steps to obtain appropriate indemnities in favour of both the Assignee and the Assignor from any licensee of the Stability Patent against claims asserted by third parties arising from the use of the Stability Patent by such licensee ("Indemnified Claim") provided that:
- 8.5.1. no liability arising from the Assignor's fraud or negligence will be an Indemnified Claim;
- 8.5.2. the Assignor will use its reasonable endeavours to avoid, dispute, resist, appeal, compromise, mitigate or defend any Indemnified Claim and to minimise its losses, claims, liabilities, costs and charges (to the extent such claim is not taken over by the indemnifying party); and
- 8.5.3. the Assignor will not (except as required by law) take any material action in respect of any Indemnified Claim without the consent of the indemnifying party.

9. **General**

- 9.1. *Amendments.* This Assignment Agreement may only be amended in writing signed by duly authorised representatives of the parties.
- 9.2. *Assignment.* Neither party may assign, mortgage, charge or otherwise transfer its rights under this Assignment Agreement in whole or part to any third party without the prior written consent of the other which may (not be unreasonably withheld), except (a) in accordance with the Collaboration Agreement or other agreement to which Assignor or Assignee is a party and which relates to the rights assigned under this Agreement; or (b) that either party may assign all of its rights under this Assignment Agreement to an Affiliate or to any successor to the whole or relevant part of its business.
- 9.3. *No Waiver.* No failure or delay on the part of either party to exercise any right or remedy under this Assignment Agreement will be construed or operate as a waiver thereof, nor will any single or partial exercise of any right or remedy preclude the further exercise of such right or remedy.

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- 9.4. *No Agency.* Neither party may act or describe itself as the agent of the other, nor may it make or represent that it has authority to make any commitments on the other's behalf.
- 9.5. *Notices.* Any notice to be given under this Assignment Agreement must be given in writing and must be delivered personally or sent by first class mail or reputable courier to the address of the relevant party, set out at the head of this Assignment Agreement, or such other address as that party may from time to time notify to the other party in accordance with this clause 9.5. Notices sent as above will be deemed to have been received at the time of delivery (if delivered personally or by courier) and three working days after the date of posting (if sent by first class mail).
- 9.6. *Further Assurance.* Each party agrees to execute, acknowledge and deliver such further instruments, and do all further similar acts, as may be necessary or appropriate to carry out the purposes and intent of this Assignment Agreement. Without limiting the generality of the foregoing, each party agrees that it will, at the request of the other, execute and deliver any such further instrument as may be required to register the assignment of the Patents at relevant national patent offices.
- 9.7. *Announcements.* Except to the extent required by applicable laws or regulations, neither party may make any press or other public announcement concerning any aspect of this Assignment Agreement, or make any use of the name of the other party in connection with or in consequence of this Assignment Agreement, without the prior written consent of the other party. Neither party will deposit or allow any third party to deposit a copy of this Assignment Agreement on any public register (including at any patent office) without the prior written consent of the other.
- 9.8. *Entire Agreement.* This Agreement (including its schedules and other agreements explicitly incorporated by reference into this Agreement) sets out the entire agreement between the parties relating to its subject matter and supersedes all prior oral or written agreements, arrangements or understandings between them relating to such subject matter. Except in the case of fraud, the parties acknowledge they are not relying on any representation, agreement, term or condition which is not set out in this Assignment Agreement.
- 9.9. *Severability.* If any clause or part of any clause in this Assignment Agreement is declared invalid or unenforceable by the judgement or decree by consent or otherwise of any court or authority of competent jurisdiction from whose decision no appeal is or can be taken, all other clauses or parts of clauses contained in this Assignment Agreement will remain in full force and effect and will not be affected thereby for the term of this Assignment Agreement, but the parties will negotiate appropriate amendments to this Assignment Agreement with a view to restoring the balance of commercial interests as it stood prior to such invalidity or unenforceability being declared.
- 9.10. *Rights of Third Parties.* No person who is not a party to this Assignment Agreement has any right to prevent the variation or cancellation of any provision of this Assignment Agreement or its termination, and no person who is not a party to this Assignment Agreement may enforce any benefit conferred upon them by it.

- 9.11. *Law and Jurisdiction.* This Agreement is made and will be construed in accordance with the laws of England and Wales, and subject to clause 9.12 the parties submit to the exclusive jurisdiction of the English courts, except that a party may seek an interim or emergency injunction in any court of competent jurisdiction.
- 9.12. *Arbitration.* Any dispute, controversy or claim arising under, out of or relating to this Agreement and any subsequent amendments of this Agreement, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, shall be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules. The place of arbitration shall be London, England. The language to be used in the arbitral proceedings shall be English. The dispute, controversy or claim shall be decided in accordance with the law of England.
- 9.13. *Freedom of Information Act.* If the Assignor receives a request under the Freedom of Information Act 2000 to disclose any information concerning this Agreement or its subject matter that may be considered confidential, it will notify and will consult with the Assignee. The Assignee will respond to the Assignor within seven (7) days after receiving the Assignor's notice if that notice requests the Assignee to provide information to assist the Assignor to determine whether or not an exemption to the Freedom of Information Act applies to the information requested under that Act.

10. NOTICE

The Assignee's representative for the purpose of receiving notices and payments shall until further notice be:

Director of Operations
The Pirbright Institute
Ash Road
Pirbright
Woking
GU24 0NF

Attn: Richard Shaw ref P323/ Project 1763

The representative of the Assignor for the purpose of receiving notices shall until further notice be:

The Director of Research Services
University of Oxford
University Offices
Wellington Square
Oxford OX1 2JD
England

SIGNED by the authorised representatives of the parties on the date set out above.

SIGNED for and on behalf of
THE PIRBRIGHT INSTITUTE

R SHAW
Director of Operations
Name: ~~Rind Sangany~~ Secretary

Position: Director of Operations

Signature:



SIGNED for and on behalf of
**THE CHANCELLOR, MASTERS AND
SCHOLARS OF THE UNIVERSITY OF
OXFORD**

Name: Lucy Booth

Position: IP Rights Manager

Signature:

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SIGNED by the authorised representatives of the parties on the date set out above.

SIGNED for and on behalf of
THE PIRBRIGHT INSTITUTE

Name: Richard Shaw

Position: Director of Operations

Signature:

SIGNED for and on behalf of
**THE CHANCELLOR, MASTERS AND
SCHOLARS OF THE UNIVERSITY OF
OXFORD**

Name: Lucy Booth

Position: IP Rights Manager

Signature:



**Dr Glenn Swafford
Director
Research Services
University of Oxford**

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