

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT4492711

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
PHARMACYCLICS LLC	07/20/2016
RECEIVING PARTY DATA	
Name:	UNIVERSITY OF TEXAS
Street Address:	3925 W. BRAKER LANE
Internal Address:	SUITE 1.9A, CAMPUS MAIL CODE R3500
City:	AUSTIN
State/Country:	TEXAS
Postal Code:	78759
PROPERTY NUMBERS Total: 9	
Property Type	Number
Patent Number:	6638924
Patent Number:	7449454
Patent Number:	5776925
Patent Number:	7112671
Patent Number:	7579338
Patent Number:	7109188
Patent Number:	6825186
Patent Number:	7547689
Patent Number:	8410263
CORRESPONDENCE DATA	
Fax Number:	(512)334-2900
<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>	
Phone:	5123342900
Email:	chamilton@phiplaw.com
Correspondent Name:	CAROLINE HAMILTON,PARKER HIGHLANDER PLLC
Address Line 1:	1120 S. CAPITAL OF TEXAS HIGHWAY
Address Line 2:	BUILDING ONE, SUITE 200
Address Line 4:	AUSTIN, TEXAS 78746
ATTORNEY DOCKET NUMBER:	UTSB.P1124US

PATENT

NAME OF SUBMITTER:	CAROLINE HAMILTON
SIGNATURE:	/Caroline Hamilton/
DATE SIGNED:	07/06/2017
Total Attachments: 8 source=UTSBP1124US_Assignment#page1.tif source=UTSBP1124US_Assignment#page2.tif source=UTSBP1124US_Assignment#page3.tif source=UTSBP1124US_Assignment#page4.tif source=UTSBP1124US_Assignment#page5.tif source=UTSBP1124US_Assignment#page6.tif source=UTSBP1124US_Assignment#page7.tif source=UTSBP1124US_Assignment#page8.tif	

AMENDMENT TO ASSIGNMENT AGREEMENT

THIS AMENDMENT ("*Amendment*") to the Assignment Agreement dated May 2, 2016, between the University of Texas, Austin, having a place of business at 3925 W. Braker Lane, Suite 1.9A, Campus Mail Code R3500, Austin, Texas 78759 ("*UTA*"), acting on behalf of the Board of Regents of the University of Texas System ("*Board*") and Pharmacyclics LLC, with an office at 995 E. Arques Avenue, Sunnyvale, California 94085 ("*Pharmacyclics*") is made as of July 20, 2016 (the "*Amendment Date*")

RECITALS:

- A. Pharmacyclics owns rights in and to certain MGd patents as listed on Exhibit A, any pending applications claiming priority to any of said patents or parent or child applications thereof, any continuations, divisionals, or reissue thereof, and any foreign counterparts thereof (the "*MGd Patents*").
- B. UTA and Pharmacyclics understand that many of the MGd Patents may be lapsed or abandoned. Some of the lapsed patents may be reinstated by paying any required fees.
- C. Pharmacyclics desires to assign all of its rights in the MGd Patents to the Board.

NOW, THEREFORE, in consideration the mutual covenants and agreements contained below, and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:

1. Exhibit A. The original Exhibit A is hereby replaced with the Exhibit A attached to this Amendment.
2. **Full Force and Effect.** Except as amended herein, all terms and conditions of Agreement, shall remain in full force and effect. In the event a provision of this Amendment conflicts with a provision of the Agreement, the provision contained in this Amendment shall control. This Amendment may be executed in separate counterparts, each of which shall be deemed an original and all of which together shall constitute one and the same instrument. Signatures transmitted by facsimile or e-mail shall be deemed effective for all purposes.

IN WITNESS WHEREOF, the parties hereto have caused this Amendment to be executed by their duly authorized officers as of the Amendment Date.

PHARMACYCLICS LLC

By: 

Name: Anis Ha

Title: Head of Legal

UNIVERSITY OF TEXAS, AUSTIN

By: 

Name: Dan Shary

Title: Associate Vice President for Research & Director, Office of Technology Commercialization

PATENT

REEL: 042927 FRAME: 0598

EXHIBIT A

List of Patents

#	Title	US Patent No.	Issue Date
1	NOVEL METALLOTEXAPHYRIN DERIVATIVES	6,638,924	28-Oct-03
2	NOVEL METALLOTEXAPHYRIN DERIVATIVES	7,449,454	11-Nov-08
3	METHODS FOR CANCER CHEMOSENSITIZATION	5,776,925	07-Jul-98
4	NON-SYMMETRIC TRIPYRRANES IN THE SYNTHESIS OF NOVEL MACROCYCLES	7,112,671	26-Sep-06
5	METHODS AND COMPOSITIONS FOR TREATING ATHEROMA, TUMORS AND OTHER NEOPLASTIC TISSUES	7,579,338	25-Aug-09
6	METHODS AND COMPOSITIONS FOR TREATING ATHEROMA, TUMORS AND OTHER NEOPLASTIC TISSUE	7,109,188	19-Sep-06
7	METHODS AND COMPOSITIONS FOR TREATING ATHEROMA, TUMORS AND OTHER NEOPLASTIC TISSUE	6,825,186	30-Nov-04
8	METHODS AND COMPOSITIONS FOR TREATING ATHEROMA, TUMORS AND OTHER NEOPLASTIC TISSUES	7,547,689	16-Jun-09
9	HIGH-PURITY TEXAPHYRIN METAL COMPLEXES	8,410,263	02-Apr-13

ASSIGNMENT AGREEMENT

This Assignment Agreement (the “**Agreement**”) is effective as of the date of the last signature herein (the “**Effective Date**”), by and between the University of Texas, Austin, having a place of business at 3925 W. Braker Lane, Suite 1.9A, (R3500), Austin, Texas 78759 (“**UTA**”), acting on behalf of the Board of Regents of the University of Texas System (the “**Board**”), and Pharmacyclics LLC, with an office at 995 E. Arques Avenue, Sunnyvale, California 94085 (“**Pharmacyclics**”).

RECITALS

- A. Pharmacyclics owns rights in and to certain MGd patents as listed on Exhibit A, any pending applications claiming priority to any of said patents or parent or child applications thereof, any continuations, divisionals, or reissue thereof, and any foreign counterparts thereof (the “**MGd Patents**”).
- B. UTA and Pharmacyclics understand that many of the MGd Patents may be lapsed or abandoned. Some of the lapsed patents may be reinstated by paying any required fees.
- C. Pharmacyclics desires to assign all of its rights in the MGd Patents to the Board.

NOW THEREFORE, it is agreed:

- 1. Assignment – Simultaneously with this Agreement Pharmacyclics hereby agrees to execute an assignment document in the form attached hereto as Exhibit B, conveying to the Board Pharmacyclics’ entire right, title, and interest in and to the MGd Patents. In addition, Pharmacyclics shall transfer to UTA’s Office of Technology Commercialization a copy of the prosecution file history of each of the MGd Patents, to the extent in Pharmacyclics’ possession or, if not publicly available, in Pharmacyclics’ control. Pharmacyclics hereby disclaims all implied licenses.
- 2. Representations and Warranties of Pharmacyclics – Pharmacyclics represents and warrants that (a) Pharmacyclics has not assigned, licensed or in any other way conveyed to any third party any rights to the MGd Patents, (b) Pharmacyclics has the power and authority to enter into this Agreement and to perform its obligations hereunder and can do so without the consent or approval of any other person or entity, (c) Pharmacyclics has not sold, leased, offered for sale or otherwise made available and will not sell, lease, offer for sale or make available the MGd Patents and (d) to its knowledge, Pharmacyclics owns the exclusive right to assign all of the ownership of the MGd Patents.
- 3. Disclaimer of Warranty – Apart from the warranties and representations made by Pharmacyclics pursuant to Paragraph 2 above, Pharmacyclics makes no other warranties of any kind, either express or implied, as to the MGd Patents, or any materials or products made or used in accordance therewith, including warranties of fitness for a particular purpose, merchantability, patentability, or that use by UTA or any parties in privity with UTA, of the results obtained will be free from infringement of patents not assigned herein or will not give rise to claims for damages.

4. Royalty – UTA is under no obligation to commercialize the MGd Patents. In the event commercialization does take place UTA agrees to pay Pharmacyclics a royalty in the amount of one percent (1%) of Net Revenue (defined below). The amount due shall be calculated on an annual basis for the period from January 1 through December 31 (the “**Royalty Period**”) and shall be payable no later than ninety (90) days after December 31 of each year. For each Royalty Period where Net Revenues have been received by UTA, UTA shall provide Pharmacyclics with a written statement of Net Revenues and royalties by country, in a form reasonably accessible to Pharmacyclics. Such royalty statement shall be certified as accurate by UTA. Net Revenue shall mean amounts UTA receives as a result of commercialization of the MGd Patents (including without limitation the making, using, or selling of products or services that infringe unexpired MGd Patents or practice claims in pending applications), less taxes, discounts and allowances actually shown, and less any out of pocket expenses that UTA may incur in order to file, prosecute, maintain or commercialize the MGd Patents. All books and records relative to UTA’s obligations hereunder, including without limitation its royalty and reporting obligations, shall be maintained and made accessible to Pharmacyclics for inspection at a location in the United States at reasonable times upon reasonable notice.
5. Term – The term of this Agreement shall begin on the Effective Date and remain in effect (a) until Pharmacyclics has received payment of royalties on Net Revenues from commercialization of the last unexpired MGd Patents, if patents are granted, or (b) until the close of prosecution of all MGd Patents without patent issuance. Sections 7 and 8 shall survive the expiration or termination of this Agreement.
6. Patent Prosecution – UTA shall have the sole discretion to prosecute, reinstate, or abandon the MGd Patents, including the filing of any divisional, continuation, reexamination, or reissue applications. Pharmacyclics agrees to cooperate to the extent reasonably possible in prosecution or reinstatement by executing any documents that are reasonably necessary for such prosecution, and by making documents and inventors available for consultation upon reasonable request and UTA’s reimbursement of out-of-pocket expenses. For avoidance of doubt, Pharmacyclics shall have no responsibility for any annuity or other payment relating to the MGd Patents, including without limitation payments due before the effective date of this Agreement.
7. Responsibility – To the extent permitted by Texas law, UTA agrees to be responsible for those damages or losses that arise directly from the negligence or willful misconduct of UTA or its officers, directors, employees or agents in its/their use(s) of the MGd Patents. Nothing in this Agreement shall be construed as a waiver of the protections of the doctrine of sovereign immunity.

Signature Page Follows

IN WITNESS WHEREOF, the parties have executed this Agreement as of the Effective Date.

PHARMACYCLICS LLC

By:  _____

Name: Anis Ha

Title: Head of Legal

Date: 5/2/16

UNIVERSITY OF TEXAS, AUSTIN

By:  _____

Daniel W. Sharp
Associate Vice President for Research
and Director,
Office of Technology Commercialization

Date: 4/28/16

EXHIBIT A**List of MGd Patents**

#	Title	US Patent No.	Issue Date
1	NOVEL METALLOTEXAPHYRIN DERIVATIVES	6,638,924	28-Oct-03
2	NOVEL METALLOTEXAPHYRIN DERIVATIVES	7,449,454	11-Nov-08
3	METHODS FOR CANCER CHEMOSENSITIZATION	5,776,925	07-Jul-98
4	NON-SYMMETRIC TRIPYRRANES IN THE SYNTHESIS OF NOVEL MACROCYCLES	7,112,671	26-Sep-06
5	METHODS AND COMPOSITIONS FOR TREATING ATHEROMA, TUMORS AND OTHER NEOPLASTIC TISSUES	7,579,338	25-Aug-09
6	METHODS AND COMPOSITIONS FOR TREATING ATHEROMA, TUMORS AND OTHER NEOPLASTIC TISSUE	7,109,188	19-Sep-06

EXHIBIT B

Patent Assignment

WHEREAS, **Pharmacyclics LLC**, a Delaware limited liability company having a place of business at 995 East Arques Avenue, Sunnyvale, California 94085, (hereinafter "**Assignor**"), owns right, title and interest in and to the inventions disclosed in the patents listed on Exhibit A of the Agreement, including all valid and active foreign counterparts thereof (hereinafter "**Patents**").

WHEREAS, the **University of Texas, Austin**, having a place of business at 3925 W. Braker Lane, Suite 1.9A (R3500), Austin, Texas 78759 ("**UTA**"), acting on behalf of the **Board of Regents of the University of Texas System** (the "**Board**"), (hereinafter "**Assignee**"), is desirous of acquiring the entire right, title and interest in and to said Patents.

NOW, THEREFORE, with good and valuable consideration acknowledged by said Assignor to have been received in full from said Assignee:

1. Said Assignor has sold, assigned, transferred and conveyed and does hereby sell, assign, transfer and convey unto said Assignee, Assignor's entire right, title and interest in and to said Patents.
2. The terms and covenants of this assignment shall inure to the benefit of said Assignee, its successors, permitted assigns and other legal representatives, and shall be binding upon the Assignor, its successors, permitted assigns and other legal representatives.
3. This instrument may be executed in counterparts, each of which is deemed an original, but all of which together constitute one and the same agreement.

Signature Page Follows


IN WITNESS WHEREOF, said Assignor has executed and delivered this instrument to said Assignee as of the date written below.

PHARMACYCLICS LLC

By: 

Anis Ha
Head of Legal

Date: 5/2/16

Witness: 

Ravi Upasani
Sr. Director of IP

Date: 5/2/16

RECEIVED AND AGREED TO BY ASSIGNEE: UNIVERSITY OF TEXAS, AUSTIN

By: 

Daniel W. Sharp
Associate Vice President for Research and
Director, Office of Technology Commercialization

Date: 4/28/16

Exhibit B - 2