

## PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1  
Stylesheet Version v1.2

EPAS ID: PAT4779125

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT
<b>NATURE OF CONVEYANCE:</b>	ASSIGNMENT
<b>CONVEYING PARTY DATA</b>	
<b>Name</b>	<b>Execution Date</b>
NEWSOUTH INNOVATIONS PTY LIMITED	10/30/2017
<b>RECEIVING PARTY DATA</b>	
<b>Name:</b>	NANYANG TECHNOLOGICAL UNIVERSITY
<b>Street Address:</b>	50 NANYANG AVENUE
<b>City:</b>	SINGAPORE
<b>State/Country:</b>	SINGAPORE
<b>Postal Code:</b>	639798
<b>PROPERTY NUMBERS Total: 1</b>	
<b>Property Type</b>	<b>Number</b>
<b>Patent Number:</b>	8425945
<b>CORRESPONDENCE DATA</b>	
<b>Fax Number:</b>	(617)849-5451
<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>	
<b>Email:</b>	patint@vjp.de
<b>Correspondent Name:</b>	VIERING, JENTSCHURA & PARTNER MBB
<b>Address Line 1:</b>	C/O 444 BRICKELL AVENUE
<b>Address Line 2:</b>	SUITE 51270
<b>Address Line 4:</b>	MIAMI, FLORIDA 33131
<b>ATTORNEY DOCKET NUMBER:</b>	P113626US
<b>NAME OF SUBMITTER:</b>	KARL J. KOLBINGER
<b>SIGNATURE:</b>	/Karl J. Kolbinger, REG.#41124/
<b>DATE SIGNED:</b>	01/17/2018
<b>Total Attachments: 10</b>	
source=P113626US_Assignment#page1.tif	
source=P113626US_Assignment#page2.tif	
source=P113626US_Assignment#page3.tif	
source=P113626US_Assignment#page4.tif	
source=P113626US_Assignment#page5.tif	
source=P113626US_Assignment#page6.tif	

source=P113626US\_Assignment#page7.tif  
source=P113626US\_Assignment#page8.tif  
source=P113626US\_Assignment#page9.tif  
source=P113626US\_Assignment#page10.tif

### Intellectual Property Assignment Deed (External)

DETAILS					
<b>DATE</b>					
<b>PARTIES</b>	<b>NewSouth Innovations Pty Limited ABN 25 000 263 025 (NSI)</b> Rupert Myers Building, Gate 14 Barker Street, UNSW, Sydney, NSW 2052, Australia  Contact: Chief Executive Officer Phone: +61 2 9385 6505 Fax: +61 2 9385 6502 Email: contracts.management@unsw.edu.au				
	<b>Nanyang Technological University (NTU)</b> 50 Nanyang Avenue, Singapore 639798  Contact: Michel Birnbaum Phone: +65 6 592 7572 Fax: +65 6 792 1737				
<b>ENTIRE DEED</b>	This deed consists of the General Terms, these Details and any annexures or schedules to this deed.				
<b>INTELLECTUAL PROPERTY RIGHTS (IPR)</b>	<b>Project name</b>	<b>Tech ID</b>	<b>Intellectual Property Notification Date</b>		
	NO regulation of biofilms (EBCRC).	12_2707	7 Oct 2012		
<b>DETAILS OF INTELLECTUAL PROPERTY RIGHTS</b>	<u>Intellectual Property Title</u>	<u>Jurisdiction</u>	<u>Type</u>	<u>Status</u>	<u>Patent/Application No</u>
	Methods and Compositions for Regulating Biofilm Development	Australia	National Phase	Granted	2006251861
	Method for promoting dispersal of a microbial biofilm and a use of at least one nitric oxide generating or releasing agent, together with a suitable carrier, for the manufacture of a composition for promoting dispersal of a microbial biofilm	Israel	National Phase	Granted	187606
	Methods and Compositions for	Singapore	National Phase	Granted	137915

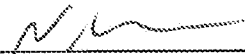
	Regulating Biofilm Development				
	Methods and Compositions for Regulating Biofilm Development	United States	National Phase	Granted	8425945
	Methods and Compositions for Regulating Biofilm Development	Europe	National Phase	Validated	1899451
	Methods and Compositions for Regulating Biofilm Development	Europe	Divisional	Allowed	11156424 .1
	Methods and Compositions for Regulating Biofilm Development	Germany	National Phase	Granted	60200605 0558.2
	Methods and Compositions for Regulating Biofilm Development	Denmark	National Phase	Granted	1899451
	Methods and Compositions for Regulating Biofilm Development	France	National Phase	Granted	1899451
	Methods and Compositions for Regulating Biofilm Development	United Kingdom	National Phase	Granted	1899451
	Methods and Compositions for Regulating Biofilm Development	Ireland	National Phase	Granted	1899451
	Methods and Compositions for Regulating Biofilm Development	Netherlands	National Phase	Granted	1899451
	Methods and Compositions for Regulating Biofilm Development	Sweden	National Phase	Granted	1899451
	<p>(a) Any patents or patent applications which are based on the invention and any patents or patent applications which claim priority from, or are divided from, or are continuations of any such patents or patent applications.</p> <p>(b) Know-how means all unpatented technical and other information not in the public domain including inventions, discoveries, concepts, data, formulae, ideas, specifications, procedures and results for experiments and tests, experimentation and testing, and results of research and development, including laboratory records, clinical trial data, case reports, data analysis and summaries, and information in submissions to and information from ethics committees and regulatory bodies, relating to the inventions the subject of the patents.</p>				
<b>SPECIAL CONDITIONS</b>	Not used				
<b>PATENT</b>	AUD\$ [REDACTED]				

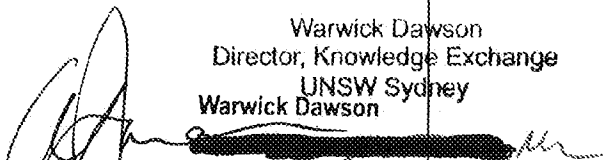
<b>MANAGEMENT COSTS</b>	being Application Expenses incurred NSi in the period of 01 Nov 2015 to 8 August 2017
<b>BACKGROUND</b>	<p>(a) NSi owns the Intellectual Property rights in the technology known as "NO regulation of Biofilms" and has the right to assign the IRP.</p> <p>(b) NSi assigns its interest in the Invention IP to NTU and agrees to do all things necessary to enable NTU to Commercialise the Invention IP and to undertake certain other obligations, in return for the Revenue Share, on the terms and conditions set out in this deed.</p> <p>(c) NTU accepts the assignment of the Invention IP and agrees to undertake Commercialisation activities in relation to the invention IP, on the terms and conditions set out in this deed.</p>

**EXECUTED AS A DEED**

Signed by the authorised representative of  
**NewSouth Innovations Pty Limited ABN  
25 000 263 025** in the presence of

Warwick Dawson  
Director, Knowledge Exchange  
UNSW Sydney  
Warwick Dawson

  
Signature of witness

  
Signature of authorised representative

Naomi Lewis  
Name of witness

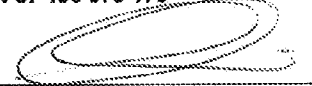
WARWICK DAWSON  
Name of authorised representative

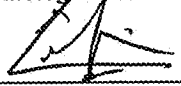
27/10/17  
Date

27/10/17  
Date

Signed for and on behalf of **UNSW Australia  
ABN 57 195 973 179**

Signed for and on behalf of **Nanyang  
Technological University**

  
Signature of Authorised Person

  
Signature

Print Name Annette McLaren  
Acting Director  
Position Research Strategy and Partnerships  
UNSW Sydney

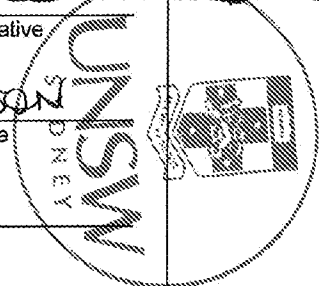
Print Name Dr. Lim Jui  
Chief Executive Officer (NTU Innovation)  
President's Office  
Position

Date 30/10/17

Date

The signatory warrants that they are authorised to execute this deed on behalf of **UNSW Australia.**

The signatory warrants that they are authorised to execute this deed on behalf of **Nanyang Technological University**



## GENERAL TERMS

### 1 DEFINITIONS and INTERPRETATION

#### 1.1 Definitions

In this Deed, unless the context otherwise requires:

**Application Expenses** means the costs and expenses (including legal and other professional fees, Goods and Services Tax and stamp duties) incurred by NSi prior to the date of this Agreement, as set out in Annexure A in relation to the preparation, filing, prosecution, and maintenance of the Patent Applications stated in the Details.

**Commercialisation** means any commercialisation, commercial or commercially directed use, application, activity or other commercial exploitation of the Invention IP, such as:

(a) entering into any agreement or understanding, including any joint venture or strategic alliance, for the sale, transfer, assignment, hire, licensing or sub-licensing of all or any part of the Invention; or

(b) the manufacture of any products using or embodying the Invention for sale or marketing;

And "Commercialise" will be similarly construed.

For the avoidance of doubt, the use of the Invention IP or Patent Applications for collaborative research projects with third parties is not regarded as a Commercialisation of the Invention IP.

**Expenses** means all costs and expenses (including legal and other professional fees, Goods and Services Tax and stamp duties) incurred by NTU in relation to the preparation, filing, prosecution and maintenance of Patent Rights in respect of the Invention IP and in respect of any Commercialisation of the Invention IP after the date of this Agreement.

**Exploit or Exploitation** means:

(a) generally to develop, manufacture, use and market;

(b) in relation to IPRs, the exercise of the rights exclusively granted to the holder of such IPRs by the laws of the jurisdiction in which the IPRs subsist;

(c) in relation to a product, kit, apparatus, substance, documentation or information resource (or any part of such materials), to develop, make, distribute, market, sell, hire out, lease, supply, or otherwise dispose of it, and

(d) in relation to a method or process, to use the method or process or to develop, make, distribute, market, sell, hire out, lease, supply, or otherwise dispose of a product, kit or apparatus the use of which is proposed or intended to involve the exercise of the method or process.

**Intellectual Property** means statutory and other proprietary rights in respect of copyright and neighbouring rights, all rights in relation to inventions, patents, plant varieties, registered and unregistered trade marks, registered and unregistered designs, circuit layouts and rights to require information to be kept confidential, and all other rights as defined by Article 2 of the Convention establishing the World Intellectual Property Organization of July 1967, and all rights to apply for any of the above, but does not include moral rights that are not transferable.

**Invention IP** means the IPRs set out in the Details.

**Net Revenue** means the Revenue less (i) reimbursement of Application Expenses, pursuant to Clause 2.3(a), and less (ii) Expenses, pursuant to Clause 2.3(b) below.

**Patent Applications** means the patent applications filed in respect of the Invention IP as stated in the Details.

**Patent Rights** means the Patent Applications, and any and all patents (including extensions thereof) of any country issuing from any of the aforesaid patent applications, or any part thereof.

**Revenue** means the gross consideration received by NTU in connection with or arising from or pursuant to any Commercialisation of the Invention IP.

**UNSW** means the University of New South Wales (ABN 57 195 873 179).

## 1.2 Interpretation

In this Deed:

- (a) headings are for convenience only and "including" is not a word of limitation; and
- (b) a reference to any party in this Deed includes the party's successors and permitted assigns.

---

## 2 ASSIGNMENT

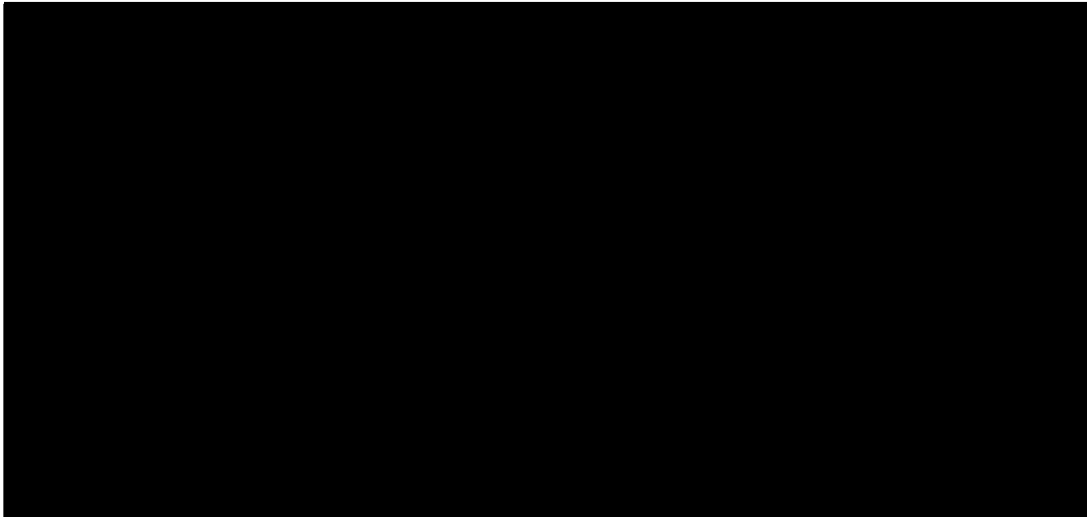
### 2.1 Assignment

Subject to clause 2.3, NSi hereby assigns to **NTU**, and **NTU** accepts NSi's entire right, title and interest (whether legally or beneficially owned) in the Invention IP, existing at, and with effect from, the date of this Deed.

### 2.2 Consideration

In consideration of the Assignment made in clause 2.1, **NTU** must pay to NSi the Patent Management Costs and the Revenue Share.

### 2.3 Revenue Share



### 2.4 NSi's and UNSW's continuing rights

The Parties acknowledge and agree that the assignments in clause 2.1 are subject to a grant by **NTU** of a non-exclusive, perpetual, royalty-free, irrevocable, worldwide licence to NSi, with a limited right to sub-licence to UNSW (but with no right for UNSW to sub-licence), to use the

Invention IP for education and non-commercial research purposes. For the avoidance of doubt, NSi must not grant any sub-licences, or rights to use the Invention IP to any third party, apart from UNSW, without the prior written consent of **NTU**.

## **2.5 Assistance**

NSi must, on **NTU** reasonable request and at **NTU** cost, provide **NTU** with reasonable assistance, including access to records and execution of documents, required to give full effect to the assignments in clause 2.1. **NTU** will bear all costs associated with the assignment of ownership of the Invention IP, including but not limited to all costs associated with recording of ownership of the Invention IP upon any register of patents that is incurred on and after the date of assignment.

---

## **3 WARRANTIES**

### **3.1 NSi warranties**

NSi warrants as at the date of execution of this Deed that:

- (a) it has the power and authority to enter into and perform its obligations under this Deed and that the execution of this Deed by it has been duly and validly authorised by all necessary corporate action;
- (b) its obligations under this Deed are valid and binding and enforceable against it in accordance with their terms;
- (c) this Deed and its performance do not contravene its constituent documents or any law, or any of its obligations or undertakings by which it is bound, or cause a limitation on its powers of its corporate officers to be exceeded;
- (d) to the best of its knowledge and belief it owns its interest in the Invention IP, which is held without mortgage or charge;
- (e) to the best of its knowledge and belief it has not granted to any person any licence to the Invention IP which may conflict with the rights granted under this Deed;
- (f) to the best of its knowledge and belief it is not aware of any matter (other than matters disclosed to **NTU** prior to the date of execution of this Deed, or otherwise to which **NTU** has knowledge or reasonably ought to have knowledge thereof) that would be or is likely to render any of the Invention IP invalid;
- (g) to the best of its knowledge and belief no rights of third parties (other than rights disclosed to **NTU** prior to the date of execution of this Deed, or otherwise to which **NTU** has knowledge or reasonably ought to have knowledge thereof) would be or are likely to be infringed as a consequence of the rights granted under this Deed.
- (h) without limitation of the foregoing warranties it is in possession of duly signed and enforceable assignments of the Invention IP in favour of NSi or UNSW.

### **3.2 NTU warranties**

**NTU** warrants, as at the date of execution of this Deed, and it is a condition of this Deed that:

- (a) it has the power and authority to enter into and perform its obligations under this Deed and that the execution of this Deed by it has been duly and validly authorised by all necessary corporate action;
- (b) its obligations under this Deed are valid and binding and enforceable against it in accordance with their terms;
- (c) this Deed and its performance do not contravene its constituent documents or any law, or any of its obligations or undertakings by which it is bound, or cause a limitation on its powers of its corporate officers to be exceeded;
- (d) it has made its own assessment of the Invention IP;



- (e) it has exercised its independent skill and judgment and has carried out its own investigations in its decision to enter into this Deed;
- (f) it has not relied on any advice, promise or representation made by NSi or UNSW which has not been expressly included in this Deed; and
- (g) it has obtained, or where required in the future will obtain, all authorisations, registrations, approvals or permits required by any governmental body or under any government legislation in any relevant jurisdiction in connection with NTU entry into and performance of this Deed.

### 3.3 Exclusion of warranties

NTU acknowledges and agrees that:

- (a) except for such warranties on the part of NSi as are expressly set out in this Deed there are no other warranties binding upon NSi or between NSi and NTU;
- (b) NSi has not made, nor has any person on behalf of NSi made any term, warranty, undertaking, or understanding whatsoever that is not expressly set out in this Deed;
- (c) no representation or promise of any description, not expressly included in this Deed, was made before this Deed was entered into; and
- (d) NSi has not made and does not make any warranty or representation whatsoever as to:
  - i. the safety of the Invention IP or of any products derived from such;
  - ii. the Exploitation of the Invention IP;
  - iii. the marketability of the Invention IP;
  - iv. the profits or revenues that may result from the Exploitation of the Invention IP;
  - v. the Exploitation prospects or success of any part of the Invention IP; and
  - vi. the Exploitation of the Invention IP being lawful or not requiring consent or approval by a third party (including regulatory approval) but without limiting NSi warranties in clause 3.1.

---

## 4 ACKNOWLEDGEMENTS

### 4.1 Release

To the full extent permitted by law, NSi will not be liable to NTU for any special, incidental, indirect or consequential loss or damages, loss of profits, loss of data, loss of business opportunity or liabilities in respect of third parties which may be suffered or incurred or which may arise directly or indirectly out of or in connection with this Deed, however caused, under any theory of liability, whether based on breach of contract, breach of statute, tort (including any negligent act or omission) or otherwise, and whether or not the Party has been advised of the possibility of such loss or damage.

### 4.2 Acknowledgement

NTU acknowledges and agrees that to the extent permitted by law, NSi and UNSW do not provide any warranties or assurances, except for such warranties as expressly set out in clause 3 and NSi and UNSW do not otherwise accept any liability, however arising, with respect to the Invention IP or its exploitation except to the extent such loss, damage or expense arose from breach of this Deed including a breach of warranty under clause 3 or breach of this Deed arising from use by UNSW in accordance with clause 2.3.

### 4.3 Indemnity

NTU indemnifies NSi, UNSW, and their officers, employees, contractors and agents (**those indemnified**) against all loss, damage and expense (including legal expense) suffered or incurred by those indemnified or any of them as a result of a third party action or claim,

whether under contract, tort (including negligence), statute, in equity or otherwise, arising out of or in connection with the use, Commercialisation or exploitation of the Invention IP on or after the date of this Deed, except to the extent such loss, damage or expense arose from use by UNSW in accordance with clause 2.3, or breach of this Deed including a breach of warranty under clause 3. The liability of NTU under this clause 4.3 shall be capped at the greater of Singapore Dollars One million (S\$ 1,000,000.00) or NTU's share of the revenue.

---

## **5 GENERAL**

### **5.1 Terms and entire agreement**

This Deed consists of these General Terms, the Schedule and any annexures or schedules expressly incorporated and constitutes the entire agreement of the Parties about its subject matter and supersedes all previous agreements, understandings and negotiations on that subject matter.

### **5.2 Inconsistency**

If there is an inconsistency between a provision of the Schedule, the General Terms, a schedule or an annexure then the first-mentioned terms prevail.

### **5.3 Requirements for valid legal notice**

Any notice or other formal communication having legal effect under this Deed must be:

- (a) in writing signed by an authorised representative of the sender;
- (b) must be marked to the attention of the recipient's Contact and be delivered to the recipient by hand, pre-paid post or fax at the address or number shown in the Schedule (or as last notified); and
- (c) will be effective once received.

### **5.4 No agency or partnership**

Nothing contained or implied in this Deed is intended to create a partnership between the Parties or, except as otherwise provided in this Deed, establish any of the Parties as an agent or representative of another Party. Except as otherwise provided in this Deed, no Party has any authority to bind another Party, or to act for, or to incur any obligation or assume any responsibility on behalf of, another Party in any way.

### **5.5 Variation and waiver**

A provision of this Deed or a right created under it, may not be waived or varied except in writing, signed by the Party or Parties to be bound. A failure or delay in exercise of a right arising from a breach of this Deed does not constitute a waiver of that right.

### **5.6 Remedies cumulative**

Unless otherwise stated, the rights, powers and remedies provided in this Deed are in addition to and not exclusive of the rights, powers and remedies given by law independently of this Deed.

### **5.7 Severability**

If the whole or any part of a provision of this Deed is void, unenforceable or illegal in a jurisdiction in which this Deed is performed it is severed for that jurisdiction. The remainder of this Deed has full force and effect and the validity or enforceability of that provision in any other jurisdiction is not affected. This clause has no effect if the severance alters the basic

nature of this Deed or is contrary to public policy. In that event, the Parties agree to use their respective reasonable efforts to negotiate a substitute, valid and enforceable provision which most nearly effects the Parties' commercial intent in entering into this Deed.

**5.8 Counterparts**

This Deed may be executed in counterparts. All counterparts when taken together are to be taken to constitute one instrument.

**5.9 Construction**

No rule of construction applies to the disadvantage of a Party because that Party was responsible for the preparation of, or seeks to rely on, this agreement or any part of it.

**5.10 Dispute Resolution**

**5.10.1** In the event of any difference or dispute arising between the Parties relating to the validity, interpretation, construction or performance of this Agreement, the Parties will use their best endeavours to settle amicably such difference or dispute by consultation and negotiation.

**5.10.2** If such efforts taken under clause 5.10.1 above fail, then the Parties will refer the matter to mediation in accordance with the rules and procedures of the Singapore Mediation Centre.

**5.10.3** If, and to the extent that, any dispute has not been settled pursuant to clause **5.10.1** and **5.10.2** above, then the dispute will be referred to and finally resolved by arbitration in Singapore in accordance with the Arbitration Rules of the Singapore International Arbitration Centre for the time being in force, which rules are deemed to be incorporated by reference to this clause **5.10**. The language of the arbitration will be English. Any award made hereunder will be final and binding upon the Parties hereto and judgment on such award may be entered into any court or tribunal having jurisdiction thereof.

**5.10.4** The institution of any arbitration hereunder will not prevent NTU from applying for and obtaining from a court a temporary restraining order and/or preliminary injunctive relief pending the outcome of the arbitration.

---

**6 Governing law**

**6.1** This Deed is governed by the laws of New South Wales and the parties submit to the non-exclusive jurisdiction of the courts of that State. Serving documents

**6.2** Without preventing any other method of service, any document in an action may be served on a Party by being delivered or left at that Party's address provided in page 1 of this agreement.

