

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT5922232

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
UNIVERSITÀ DEGLI STUDI DI MILANO - BICOCCA	08/01/2019
RECEIVING PARTY DATA	
Name:	OSPEDALE SAN RAFFAELE S.R.L.
Street Address:	VIA OLGETTINA 60
City:	MILANO (MI)
State/Country:	ITALY
Postal Code:	20132
PROPERTY NUMBERS Total: 1	
Property Type	Number
Application Number:	14416128
CORRESPONDENCE DATA	
Fax Number:	(212)661-8002
<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:	2126618000
Email:	info@lmplaw.com
Correspondent Name:	LUCAS & MERCANTI LLP
Address Line 1:	30 BROAD STREET, 21ST FLOOR
Address Line 4:	NEW YORK, NEW YORK 10004
ATTORNEY DOCKET NUMBER:	128-1098-W-US
NAME OF SUBMITTER:	MICHAEL N. MERCANTI
SIGNATURE:	/Michael N. Mercanti/
DATE SIGNED:	01/22/2020
Total Attachments: 4	
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source=128-1098-W-US-Assignment#page4.tif	

TRANSFER AGREEMENT

This transfer agreement (the "Agreement") is made effective as of 01/08/2018 (the "Effective Date")

by and between

Università degli Studi di Milano Bicocca, located at Piazza dell'Ateneo Nuovo no. 1, 20126, Milan, (C.F. and P.IVA 12621570154), hereby represented by its Rector Prof. Maria Cristina Messa (hereinafter referred to as "University")

- on the one side -

and

Ospedale San Raffaele S.r.l., located at via Olgettina no. 60, 20132, Milan, (C.F. and P.IVA 07636600962), hereby represented by its Chief Executive Officer Eng. Elena Angela Maria Bottinelli (hereinafter referred to as "OSR")

- on the other side -

Collectively, but not jointly, defined as the "Parties".

WHEREAS:

- (i) The provisional patent application US no. 61/676071 entitled "HMGB1 variants and uses thereof" has been filed on 26 July 2012 and has originated the following patent and patent applications claiming a mutated form of HMGB1 protein for the treatment of some diseases ("Invention") and as inventors Marco Emilio Bianchi, Maura Casalgrandi, Joelle Emilie Venereau, Silvia Brunelli:

A. PCT/EP2013/065829 filed on 26 July 2013 and related:

- o US N. 14/416128 filed on 26 July 2013, published on 23 July 2015 with N. US 2015-0203551;
- o EP no. 2877248 filed on 26 July 2013 and related national patents:
 - o UK N. 2877248 published on 03 June 2015 with N. EP2877248
 - o FR N. 2877248 published on 03 June 2015 with N. EP2877248
 - o DE N. 602013028407.5 published on 03 June 2015 with N. EP2877248
 - o ES N. 2661500 published on 03 June 2015 with N. ES2661500
 - o IT N. 502018000008882 published on 03 June 2015 with N. EP2877248

hereinafter all the above mentioned patents and patent applications under letter A are collectively indicated as the "Patent" (Attachment A).

- (ii) The Parties are joint owners of the Patent, according to the following shares:

1. University: 10% ("University Patent Share");
2. OSR: 90% ("OSR Patent Share").

- (iii) On 18 June and 10 July 2018, University notified OSR its intention to cease to maintain the University Patent Share and its will to transfer such University Patent Share to OSR.

- (iv) OSR has subsequently expressed the interest in purchasing the University Patent Share under the terms and conditions of this agreement.

NOW, THEREFORE, based on the foregoing premises, the mutual covenants and obligations set forth below, the Parties agree as follows:

Article 1 – Premises

The premises and the Attachment A constitute an integral and substantial part of the present agreement (hereinafter "Agreement").

Article 2 – Object



- 2.1 Subject to Articles 2.3 and 3, University hereby sells, assigns, and transfers to OSR, who hereby accepts and purchases, all University's rights, titles and interests in and to the University Patent Share. Therefore, OSR acquires the full ownership of the Patent and any and all related rights, titles and interests, including those relating to each and all (for example) patent applications, patents, reissues, extensions continuations, continuations-in-part, divisions deriving from the Patent and/or which claim priority from or have a common priority with any of the foregoing.
- 2.2 OSR acknowledges Prof. Silvia Brunelli, belonging to University ("**University Inventor**"), as an author of the Invention and her moral right to be mentioned in any communication of the Invention in accordance with the best practice. Nothing in the Agreement is construed to confer any other right to the University Inventor.
- 2.3 OSR grants to University a non-exclusive, non-transferrable, royalty free, license, without the right to sub-licence, to use the Patent for non-commercial internal research activities and educational purposes only.
- 2.4 University shall promptly cooperate, at OSR's request, for registration with patent offices and other relevant authorities of the rights granted under this Agreement, including to sign acts and records as may be necessary for this purpose.

Article 3 – Compensation and Registration fees

- 3.1 As payment for the transfer referred to in Article 2, a total amount of Euros 5.207,33 (VAT included, if applicable) shall be paid by OSR to University, taking into account all costs borne by University for the University Patent Share registration and maintenance up to the Effective Date. Therefore, upon the Effective Date the University shall be entitled to issue an invoice for an amount equal to Euros 5.207,33 (VAT included, if applicable) and OSR shall pay such amount within 60 days from the Effective Date, after receipt of the invoice related to "*Payment for Transfer Agreement between UNIMIB and OSR – Patent: HMGBI variants and uses thereof – Delib. Board of Directors UNIMIB - 428/2019/CdA - dated 18/06/2019*". In accordance with article 5 of Legislative Decree n. 82/2005 – "*Digital Administration Code*" and with article 15, paragraph 5-bis, of Legislative Decree n. 179/2012, the aforementioned invoice shall be electronically paid by OSR, through the national technological platform "Nodo dei Pagamenti", using the IUV ("*Identificativo Unico Versamento*") code indicated on the "pagopa" payment notice attached to the invoice.
- 3.2 The Parties agree that, as of the Effective Date, the University is no more obliged to bear the costs for the maintenance and prosecution of the University Patent Share.
- 3.3 All the fees, taxes and expenses regarding this Agreement, including those arising under or resulting from Article 2.4, shall be borne by OSR.

Article 4 – Representations and Warranties

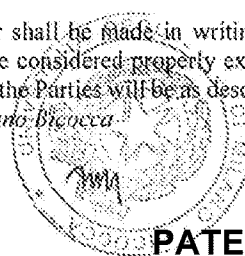
- 4.1 University, to the best of its knowledge, warrants that:
1. has the power, authority and legal right to enter into this Agreement and perform its obligations hereunder; has taken all necessary actions (if any) to authorize the execution of this Agreement and the performance of its obligations hereunder;
 2. has not done anything that would be inconsistent with the assignment of the University Patent Share to OSR; has not entered, and will not enter, into any agreement with any third party that is in conflict with the rights granted to OSR under this Agreement;
 3. has no knowledge of any claim of infringement of the Patent of any third party;
 4. the University Inventor, so far as necessary, has agreed to assigning the University Patent Share to OSR under the terms and conditions of this Agreement. In any case, University guarantees and agrees to hold harmless and indemnify OSR from any and all losses, expenses, costs, damages resulting from University Inventor's claims, actions and demands against OSR in relation to the University Patent Share and/or this Agreement.

Article 5 – Miscellaneous

- 5.1 The terms and conditions and existence of this Agreement shall be deemed confidential. Except to the extent that either Party may file a copy of this Agreement or any portions thereof to the extent necessary to enforce and/or submit the Agreement before the competent judicial or administrative or fiscal authorities (including patent offices) or otherwise required by applicable law, neither Party shall issue any press release or otherwise disclose to third parties the existence of this Agreement or any of the terms or conditions of this Agreement without the prior written consent of the other Party (which consent shall not be unreasonably withheld).
- 5.2 This Agreement embodies the entire agreement of the Parties hereto with respect to the subject matter hereof and supersedes any prior agreements and understandings with respect thereto. The Agreement may be amended, and any provision hereof waived, by a written agreement of the Parties.
- 5.3 Any delay in enforcing a Party's right under this Agreement, or any waiver as to a particular default or other matter, will not constitute a waiver of such Party's right to the future enforcement of its rights under this Agreement.
- 5.4 All notices, requests, and other communications to any Party hereunder shall be made in writing (including recorded-delivery letter and certified e-mail). Any communication will be considered properly executed at the receipt date. Unless otherwise specified in writing, the notice addresses of the Parties will be as described below:

For University:

Università degli Studi di Milano-Bicocca



Piazza dell'Ateneo Nuovo 1 - 20126 Milano
PEC: ateneo.bicocca@pec.unimib.it
Phone: [+39-0264486293]
Email: Brevetti-Spinoff@unimib.it

For OSR:

Ufficio di Trasferimento Biotecnologico
Via Olgettina, 58 - 20132 Milano
Fax: +39-022643.5264
Phone: +39-022643.4281
E-mail: vella.paola@hsr.it

- 5.5 Each provision in this Agreement is independent and severable from the others, and no provision will be rendered unenforceable because any other provision may be invalid or unenforceable in whole or in part.
- 5.6 In the event that any provision of this Agreement is held to be invalid (null and void), ineffective, or unenforceable, in whole or in part, in any relevant jurisdiction where any of the Patent is registered, the validity, effectiveness, and/or enforceability of the remaining provisions of this Agreement shall not be affected or impaired in any way. The Parties agree to amend in good faith any provision of this Agreement so held invalid (null and void), ineffective or unenforceable, so as to render it valid, effective, and enforceable in the relevant jurisdiction in a way that reflects as closely as possible the scope and intent of the original provision; it being understood that the provision so amended shall be fully binding on the Parties.
- 5.7 Pursuant to Articles 1341 and 1342 of the Italian Civil Code, this Agreement has been made jointly and will not be strictly construed against either Party.
- 5.8 This Agreement is governed by Italian laws. Any action or proceeding seeking to enforce any provision of or based on any right arising from this Agreement shall only be brought against any of the Parties before the court of Milan and each of the Parties consents to the exclusive jurisdiction of such court in any such action or proceeding.
- 5.9 This Agreement will be executed in two or counterparts, each of which will be deemed an original, but all of which together will constitute one and the same instrument.

Attachment A: copy of the Patent

IN WITNESS WHEREOF the Parties have executed this Agreement in duplicate originals by their duly authorized officers as of the Effective Date.

UNIVERSITÀ DEGLI STUDI DI MILANO
BICOCCA

By: _____

Name: Prof.ssa Maria Cristina Messa

Title: RECTOR

Date: 01 AGO. 2019

OSPEDALE SAN RAFFAELE S.R.L.

By: _____

Name: Eng. Elena Angela Maria Bottinelli

Title: CEO / Managing Director

Date: 30/9/2019



DICHIARAZIONE CONGIUNTA DI CESSIONE
DI BREVETTI

Università degli Studi di Milano - Bicocca, con sede in Piazza dell'Ateneo Nuovo n. 1, 20126, Milano, (C.F. e P.IVA 12621570154), in persona del legale rappresentante pro tempore Prof.ssa Maria Cristina Messa (di seguito "Università"), con riferimento ai seguenti domande di brevetto e brevetti, aventi ad oggetto l'utilizzo di una forma mutuata della proteina HMGB1 per il trattamento di alcune patologie, inventori i dott.ri Marco Emilio Bianchi, Maura Casalgrandi, Joelle Emilie Veneteau, Silvia Brunelli (i "Brevetti", di cui si allega copia sub doc. A):

A. PCT/EP2013/065829 depositato in data 26 luglio 2013 e relative domande nazionali:

1. US no. 14/416128 depositata in data 26 luglio 2013 e pubblicata in data 23 luglio 2015 con numero US 2015-0203551;
2. EP no. 2877248 depositata in data 26 luglio 2013 e relative validazioni nazionali:
 - o UK N. 2877248 pubblicata in data 03 giugno 2015 con numero EP2877248
 - o FR N. 2877248 pubblicata in data 03 giugno 2015 con numero EP2877248
 - o DE N. 602013028407.5 pubblicata in data 03 giugno 2015 con numero EP2877248
 - o ES N. 2661500 pubblicata in data 03 giugno 2015 con numero ES2661500
 - o IT N. 502018000008882 pubblicata in data 03 giugno 2015 con numero EP2877248

DICHIARA e RICONOSCE

di aver ceduto l'intera quota di propria titolarità (pari al 10%) dei predetti Brevetti e tutti i diritti relativi e/o in qualunque modo connessi, anche rispetto a tutte le successive domande di brevetto e brevetti che dai Brevetti dovessero originarsi - in virtù di contratto di cessione in data 08.08.2014 - a Ospedale San Raffaele S.r.l., con sede in via Olgettina n. 60, 20132, Milano, (C.F. e P.IVA 07636600962), in persona del legale rappresentante pro tempore, ing. Elena Angela Maria Bottinelli, che dichiara e riconosce di averli acquistati in virtù del menzionato contratto di cessione.

Milano, 01 AGO. 2019


IL LEGALE RAPPRESENTANTE PRO TEMPORE
MARIA CRISTINA MESSA

Università degli Studi di Milano - Bicocca


Ospedale San Raffaele S.r.l.

