

## PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1  
Stylesheet Version v1.2

EPAS ID: PAT6652864

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT
<b>NATURE OF CONVEYANCE:</b>	ASSIGNMENT
<b>CONVEYING PARTY DATA</b>	
<b>Name</b>	<b>Execution Date</b>
COMMONWEALTH SCIENTIFIC AND INDUSTRIAL RESEARCH ORGANISATION	12/09/2016
<b>RECEIVING PARTY DATA</b>	
<b>Name:</b>	NANOMED PTY LTD
<b>Street Address:</b>	11 CAMERON ROAD
<b>City:</b>	PYMBLE, NSW
<b>State/Country:</b>	AUSTRALIA
<b>Postal Code:</b>	2073
<b>PROPERTY NUMBERS Total: 1</b>	
<b>Property Type</b>	<b>Number</b>
Patent Number:	8603999
<b>CORRESPONDENCE DATA</b>	
<b>Fax Number:</b>	(703)997-7808
<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>Phone:</b>	2022366751
<b>Email:</b>	mail@pilloffpassino.com
<b>Correspondent Name:</b>	PILLOFF PASSINO & COSENZA LLP
<b>Address Line 1:</b>	2000 DUKE STREET
<b>Address Line 2:</b>	SUITE 300
<b>Address Line 4:</b>	ALEXANDRIA, VIRGINIA 22314
<b>ATTORNEY DOCKET NUMBER:</b>	271-004
<b>NAME OF SUBMITTER:</b>	SEAN A. PASSINO, REG. NO. 45943
<b>SIGNATURE:</b>	/Sean Allen Passino, reg. no. 45943/
<b>DATE SIGNED:</b>	04/13/2021
<b>Total Attachments: 8</b>	
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# **Deed of Assignment**

**Commonwealth Scientific and Industrial Research Organisation**

**NanoMed Pty Ltd**

## Deed of Assignment

DATE

PARTIES

**Commonwealth Scientific and Industrial Research Organisation** a body corporate established by the Commonwealth Science and Research Act 1949 and having its principal office at Limestone Avenue, Campbell in the Australian Capital Territory (**Assignor**)

NanoMed Pty Ltd ABN 35615635142 (**Assignee**) of 11 Cameron Road, Pymble, NSW, 2073.

RECITALS

The Assignor assigns all of its right, title and interest in and to the Patents set out in the attached Schedule to the Assignee, on the terms set out in this Deed of Assignment.

OPERATIVE PROVISIONS

1 DEFINITIONS

The following definitions apply in this document:

**Exploitation Benefits** means all pecuniary benefits (including, without limitation, monetary amounts, royalties, upfront or milestone fees, and securities in a corporation including shares) received by Assignee:

- (a) from the sale, disposal or other exploitation of the Patents, or products or services incorporating or created using the Patents; and
- (b) as consideration in respect of the licensing, sub-licensing, transfer or other grant of rights to a third party in respect of the Patents, or of any products or services incorporating or created using the Patents,

but will exclude:

- (c) any grant, benefit or payment received or to be provided solely in relation to the further research and development of the Patents.

**Patents** means the registered patents and patent applications described in Schedule 1 and any divisional applications from any of them and any amendments, extensions, re-issues, or re-grants of any of them.

**Royalty** means the sum which is equivalent to 5% of the Exploitation Benefits received by the Assignee.

**Term** means the period from the date of this Deed of Assignment to the date on which the Patents remain registered on an official patent office register or database anywhere in the world.

2 ASSIGNMENT

2.1 In consideration of the sum of \$1 and other good and valuable consideration now paid by the Assignee to the Assignor, the receipt and sufficiency of which the

Assignor acknowledges, the Assignor hereby assigns to the Assignee all of its right, title and interest in and to the Patents, including the right to file and prosecute in any country in the world any applications for registration of intellectual property rights claiming priority from the Patents, including applications for patents, divisionals, continuations, continuations-in-part, petty patents, innovation patents, utility models and inventors' certificates, together with the right to bring an action for and to claim (and retain) any damages or other remedies for past infringement of those rights which arose before this assignment.

### **3 LICENCE BACK**

- 3.1 The Assignee grants to the Assignor for the Term a non-exclusive, royalty-free, irrevocable, worldwide licence to exploit the subject matter of the Patents in or for research and development, excluding commercialisation by the Assignor. The Assignor may sublicense this research licence to Assignor's research and development collaborators.

### **4 REGISTRATION**

- 4.1 The Assignee may take such steps as it requires, at the expense of the Assignee, to do all acts and execute all documents necessary to ensure that the Patents will issue or vest in the sole name of the Assignee.
- 4.2 The Assignor will take all necessary steps (at Assignee's expense) to assist the Assignee in the completion of the matters set out in clause 4.1.
- 4.3 Nothing in this clause 4 shall oblige the Assignee to take any steps in relation to the maintenance or ongoing registration of the Patents, which matters shall be the sole discretion of the Assignee.

### **5 Acknowledgements**

- 5.1 The Assignee acknowledges that on and from the date of this Deed, the Assignee will, in his discretion, be solely responsible for determining whether to advance, continue or maintain prosecution of the Patents paying all annuities or maintenance fees for the Patents, and maintaining awareness of all due dates in respect of the Patents, and that Assignor will remove the Patents from its IP management systems and will not accept any responsibility for any missed deadlines or payments. Nothing in this clause requires the Assignee to advance, maintain or prosecute the applications, which the Assignee may discontinue or allow to lapse, in his sole discretion.
- 5.2 Other than as set out in this Deed, the Assignor has not made any and excludes all warranties, terms, conditions or undertakings, whether express or implied, written or oral, statutory or otherwise including any implied warranty of merchantability or of fitness for a particular purpose in respect of the Patents. To the full extent permitted by law, all conditions or warranties imposed by such legislation are excluded.
- 5.3 To the full extent permitted by law, Assignor will not be liable for any special, indirect or consequential damages arising under or pursuant to this Deed.

- 5.4 Assignor has not made and does not by entering into this document make any representation or warranty, express or implied:
- (a) as to the prospects of the successful grant of patents from any patent applications which are part of the Patents
  - (b) as to the validity of the Patents or of any claims or statements of invention therein; or
  - (c) as to the utility of the Patents; or
  - (d) as to the prospects of the successful exploitation of the Patents; or
  - (e) that the use or exploitation of the Patents will not infringe the intellectual property rights or any other rights of any person
- 5.5 Assignee uses and exploits the Patents at its own risk.

## **6 BENEFIT SHARING**

### 6.1 Ongoing entitlement

- (a) The Assignee will pay to the Assignor the Royalty in respect of the Term.
- (b) In the event that Assignee becomes entitled to receive Exploitation Benefits in the form of securities in a corporation, then Assignor has an option to either require that Assignee assign 5% of its securities to Assignor or to require Assignee to procure that 5% of the securities allocated to Assignee are issued directly to Assignor.

### 6.2 Payment

Amounts due under this clause 6 in respect of a financial year (commencing 1 July and ending 30 June of the subsequent year) must be paid to Assignor within 60 days of the end of that financial year, and must be accompanied by a statement evidencing the calculation of those amounts.

### 6.3 Records and audit

Assignee must keep and, on Assignor's reasonable request, make available to Assignor, complete and accurate written records and accounts in respect of all Exploitation Benefits received in relation to the Patents. Assignor has the right, once per financial year, to audit those records and accounts. If the audit reveals that any amounts to be paid under this clause 6 are outstanding, Assignee must immediately pay those amounts to Assignor. If those amounts represent at least 10% of the total amount of payments due to Assignor under this clause 6 in respect of that financial year, Assignee must pay or reimburse Assignor for its reasonable costs of that audit within 60 days after receipt of Assignor's invoice.

**7 WARRANTIES**

- 7.1 Assignee represents and warrants that, save for any information disclosed in Schedule 2, Assignee is not aware of any investment or licensing opportunities in relation to the Patents of which Assignee has not informed Assignor.
- 7.2 In the event that the warranty of clause 7.1 is breached by Assignee, Assignee acknowledges that damages will not be an adequate remedy, and the parties agree that Assignee will hold all assets and proceeds received in connection with the undisclosed investment or licensing opportunity on trust for Assignor.

**8 DISPUTES**

If a dispute arises between the parties (the "Dispute"), the parties agree to negotiate in good faith to resolve the Dispute. If the Dispute has not been resolved by negotiation within 30 days, of a written notification of the Dispute by a party, the parties may refer the Dispute for arbitration in accordance with the UNCITRAL Arbitration Rules. The appointing authority will be the Australian Centre for International Commercial Arbitration. There is to be a single arbitrator. The place of arbitration is to be Melbourne, Victoria, Australia. The language of the arbitration is to be English. The parties must agree on the appointment of an arbitrator. If the parties do not agree on the arbitrator to be appointed within fourteen (14) days of the Dispute proceeding to arbitration, the arbitrator is to be appointed in accordance with the ACICA's Rules for Arbitration. The parties agree to request the arbitrator to make their determination within 90 days after the Dispute was referred to arbitration. Any arbitration is to be final and binding, including any award as to costs. Offers of settlement or any matter disclosed in the course of arbitration must be treated as without prejudice and not an admission of liability. Nothing in this clause will prevent a party from seeking urgent interlocutory relief through courts of appropriate jurisdiction.

**9 RELEASE AND INDEMNITY**

Assignee indemnifies and releases Assignor, its officers, employees and agents against any actions, claims and demands and all loss, liabilities, costs and expenses that Assignor may suffer or incur to the extent that they arise out of any act or omission of Assignee in exploiting the Patents or as a result of any breach by Assignee of the terms of this Deed.

**10 INSURANCE**

Assignee will procure and maintain adequate insurances in respect of its exploitation of the Patents and will require any assignee or licensees to undertake no less onerous insurance obligations in respect of their exploitation of the Patents.

**11 ASSIGNMENT**

Assignee may not without Assignor's prior written consent (which must not be unreasonably withheld) assign its rights in the Patents to a third party unless the third party provides undertakings directly to Assignor that protect the Assignor no less than the protections of Assignor set out in this Deed.

**12 USE OF NAME**

Assignee must not use Assignor's name (that is, "CSIRO" or "Commonwealth Scientific and Industrial Research Organisation") in a manner that suggests that Assignor endorses or is associated with your business, products or services. In no case may you use Assignor's logo without first receiving Assignor's prior written consent.

**13 Costs and stamp duty**

13.1 Each Party shall bear its own costs (including legal costs) incurred in connection with the preparation and execution of this Deed and any other document or instrument required to be executed to complete this Deed.

13.2 All stamp duty (including fines, penalties and interest) which may be payable on this Deed or any instrument executed under this Deed in respect of a transaction evidenced by this Deed shall be borne by Assignee.

**14 GOVERNING LAW**

This Deed is governed by the law of New South Wales. The parties submit to the non-exclusive jurisdiction of courts exercising jurisdiction there.

**EXECUTED** as a deed this 9<sup>th</sup> day of December 2016

**EXECUTED** for and on behalf of  
**COMMONWEALTH SCIENTIFIC AND  
INDUSTRIAL RESEARCH  
ORGANISATION** by:



Signature

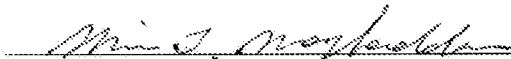
Paul Savage, Research Program Director  
Name and position



Signature of witness

Lynda Berkahn  
Name of witness

**EXECUTED** by **Dr Minoo Moghaddam** :



Signature of **Dr Minoo Moghaddam**



Signature of witness

BARBAR ZAHEDI  
Name of witness



**SCHEDULE 1  
PATENTS**

<b>Title</b>	<b>Parent Patent</b>	<b>Patent No.</b>
Amphiphilic Pro-drugs	WO2010063080	EP2393472-A1
		US2011301114-A1
		US8603999-B2
		US2014094426-A1
		IN201101395-P3

8.

**SCHEDULE 2  
DISCLOSURES**

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