

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT6740401

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	INVENTION OWNERSHIP AGREEMENT AND CONSENT JUDGEMENT
CONVEYING PARTY DATA	
Name	Execution Date
PHIO PHARMACEUTICALS CORP.	05/06/2021
RECEIVING PARTY DATA	
Name:	UNIVERSITY OF MASSACHUSETTS
Street Address:	ONE BEACON STREET
Internal Address:	31ST FLOOR
City:	BOSTON
State/Country:	MASSACHUSETTS
Postal Code:	02108
PROPERTY NUMBERS Total: 4	
Property Type	Number
Application Number:	15089423
Application Number:	15691120
Application Number:	16927543
Application Number:	17173701
CORRESPONDENCE DATA	
Fax Number:	(857)300-4001
<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:	(857) 300-4000
Email:	leslie.roberts@lathropgpm.com, internalip@lathropgage.com
Correspondent Name:	LATHROP GPM LLP
Address Line 1:	28 STATE STREET
Address Line 2:	7TH FLOOR
Address Line 4:	BOSTON, MASSACHUSETTS 02109
ATTORNEY DOCKET NUMBER:	UM9-209 FAMILY
NAME OF SUBMITTER:	JAMES H. VELEMA
SIGNATURE:	/James H. Velema/
DATE SIGNED:	06/02/2021
Total Attachments: 7	

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INVENTION OWNERSHIP AGREEMENT

This Invention Ownership Agreement (“**Agreement**”) between **Phio Pharmaceuticals Corp.** f/k/a RXi Pharmaceuticals Corp. (“**Phio**”), a Delaware corporation having its principal place of business at 257 Simarano Drive, Suite 101, Marlborough, Massachusetts 01752; and **University of Massachusetts** (“**UMass**”), having its principal place of business at One Beacon Street, 31st Floor Boston, Massachusetts 02108 is effective as of May 6, 2021 (“**Effective Date**”). UMass and Phio hereby agree as follows:

I. Definitions

A. “Application” means U.S. Patent Application No. 15/089,423 and any application from which it claims priority.

B. “Inventions” means any and all inventions and designs by Anastasia Khvorova, Ph.D. (“**Dr. Khvorova**”) by herself or with others disclosed publicly for the first time in or within the scope of: (a) the Application and any patents that issue or have issued from the Application; (b) any and all refiling, divisions, continuations and continuations-in-part of the Application and any patents that issue from such refiling, divisions, continuations and continuations-in-part; (c) any and all reissue and reexamination of any patent within the scope of (a)-(b) of this definition; (d) any foreign application for a patent upon an invention disclosed in any patent or patent application within the scope of (a)-(c) of this definition, any and all refiling, divisions, and continuations of such foreign-filed applications, any foreign patent which issues from the foregoing foreign-filed applications, refiling, divisions and continuations, and any and all extensions of and additions to such foreign patents; (e) all claims, causes of action and damages for patent infringement, misappropriation of trade secrets, breach of confidentiality, or violation of any other intellectual property rights, if any, relating to any application or patent within the scope of (a)-(d) of this definition.

C. “Phio Filing” means that patent assignment document dated July 5, 2017, purportedly between Dr. Khvorova and Phio and recorded on Reel: 042906 / Frame: 0858-0860.

D. “UMass Assignment” means the patent assignment effective April 1, 2016, by and among UMass and Dr. Khvorova and the other inventors party thereto and recorded on Reel: 039335 / Frame: 0300-0305.

II. Invention Ownership

A. Phio agrees that UMass is the sole and exclusive owner of the Application and the Inventions. Phio agrees that it does not own, co-own, or have any other rights in the Application or the Inventions.

B. Phio rescinds, abrogates, terminates, and withdraws the Phio Filing and acknowledges and agrees that it is null and void, does not, and has never had any legal effect.

C. Notwithstanding anything to the contrary, if and to the extent Phio ever had or could ever have had any right, title or interest in and to the Inventions, it hereby quitclaims, assigns, and transfers to UMass and UMass’ successors, assigns and legal representatives, Phio’s

entire right, title and interest for the United States and all foreign countries, in the Inventions and, for avoidance of doubt, in and to any and all rights identified in the Phio Filing, namely, (1) all inventions (as that word is used in the Phio Filing) and designs which are disclosed in the Application and in and to all corresponding non-provisional, divisional, continuing, substitute, renewal, reissue and all other applications for Letters Patent, utility models, industrial designs or similar intellectual property rights which have been or shall be filed in the United States, internationally, and in any foreign country, including but not limited to China, Japan and Korea, on inventions; and in and to all original and reissued patents which have been or shall be issued in the United States or any other jurisdiction on the inventions, including the right to apply for patent rights in each foreign country and all rights to priority, including the right to claim priority for China, Japan and Korea, as well as the right to sue in its own name and recover damages for past infringement of any United States Letters Patent and foreign patents; and (2) the right to apply for and receive Letters Patent and utility model and industrial design registrations for the inventions in its own name and to require Dr. Khvorova to undertake activities related to the inventions and applications that are the subject of the Phio Filing, including executing applications and other papers and communicating with Phio.

D. Phio acknowledges and agrees that pursuant to the UMass Assignments, UMass is the true and correct assignee of all right, title and interest in and to the Inventions and, specifically and for avoidance of doubt, of all Inventions identified in the UMass Assignments, namely, the full and exclusive right, title and interest, throughout the world, in, to and under the following:

- a) the Inventions as fully set forth and described in the specifications prepared, and executed by Dr. Khvorova preparatory to obtaining Letters Patent of the United States therefor;
- b) the Application;
- c) any and all re-filings, divisions, continuations and continuations-in-part of the Application;
- d) any and all Letters Patent of the United States of America which may issue from said Application, re-filings, divisions, continuations and continuations-in-part;
- e) any and all reissues and reexaminations of said Letters Patent of the United States of America;
- f) any and all applications for Letters Patent upon said Inventions which may hereafter be filed in any and all countries foreign to the United States of America;
- g) any and all re-filings, divisions and continuations of said foreign-filed applications;
- h) all claims, causes of action and damages for past infringement, if any, of said Application;
- i) any and all Letters Patent of countries foreign to the United States of America which may issue from the said foreign-filed applications, re-filings, divisions and continuations; and

j) any and all extensions of, and additions to, said Letters Patent of countries foreign to the United States of America.

k) ALL of the above is held and enjoyed by UMass, for its own use and benefit, and for its successors, legal representatives and assigns, to the full end of the term for which said Letters Patent may be granted.

E. From and after the Effective Date, Phio shall not directly or indirectly challenge or call into question UMass's sole and exclusive ownership of the Inventions or solicit, encourage, or assist a third party to do so.

F. Phio shall make, execute, acknowledge and deliver, all such instruments and documents, and take all such action as may be reasonably necessary or may reasonably be requested by UMass to carry out the intent and purposes of this Agreement. UMass may record this Agreement, an abstract thereof, or any other document describing UMass' ownership in the Inventions with the relevant patent and trademark office.

-----Signature Page Follows-----

IN WITNESS WHEREOF Phio has executed this Agreement by its duly authorized representative.

PHIO PHARMACEUTICALS, CORP.

By: 

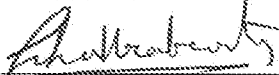
Name: Gerrit Dispersyn

Title: President & CEO

Date: 6-May-2021

ACKNOWLEDGED AND AGREED:

UNIVERSITY OF MASSACHUSETTS

By: 

Name: PARTHA CHAKRABARTI

Title: EVC - Innovation & Business Dev.

Date: May 11, 2021

JURAT

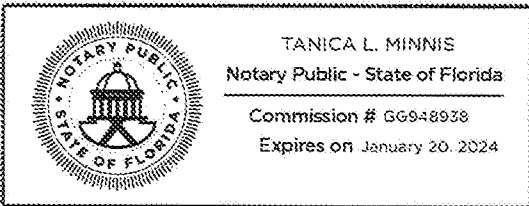
State/Commonwealth of FLORIDA)
)
 City County of Seminole)

On 05/06/2021, before me, Tanica L. Minnis
Date *Notary Name*

the foregoing instrument was subscribed and sworn (or affirmed) before me by:

Gerrit Dieter Dispersyn
Name of Affiant(s)

- Personally known to me -- OR --
- Proved to me on the basis of the oath of _____ -- OR --
Name of Credible Witness
- Proved to me on the basis of satisfactory evidence: U.S. Passport
Type of ID Presented



WITNESS my hand and official seal.

Notary Public Signature: Tanica L. Minnis

Notary Name: Tanica L. Minnis

Notary Commission Number: GG948938

Notary Commission Expires: 01/20/2024

Notarized online using audio-video communication

DESCRIPTION OF ATTACHED DOCUMENT

Title or Type of Document: INVENTION OWNERSHIP AGREEMENT 423

Document Date: 05/06/2021

Number of Pages (including notarial certificate): 5

COMMONWEALTH OF MASSACHUSETTS

SUFFOLK, ss.

SUPERIOR COURT DEPARTMENT OF THE TRIAL COURT

UNIVERSITY OF MASSACHUSETTS and ANASTASIA KHVOROVA,
 Plaintiffs,
 v.
 PHIO PHARMACEUTICALS CORP. f/k/a RXI PHARMACEUTICALS CORPORATION,
 Defendant.

NO. 19-2455-BLS1

BUSINESS LITIGATION SESSION

Notice sent 5/21/21
 LMT
 SLW
 CC
 SP4
 FN
 DEW
 UIU
 SB
 BTG
 DSG
 JEC
 LSN
 GNF
 ANZ
 RAY

CONSENT JUDGMENT

UPON CONSIDERATION of the Plaintiffs' claim for declaratory judgment (Count I) and Defendant's counterclaim for declaratory judgment (Count XII) it is hereby:

ORDERED, DECLARED AND ADJUDGED, as follows:

1. The University of Massachusetts ("UMass") is the sole and exclusive owner of Professor Anastasia Khvorova's rights in:

- (a) U.S. Patent Application Nos. 15/089,423, 15/089,319, 15/089,437, and 15/236,051;
- (b) patent applications that are related to any of patent applications of (a);
- (c) foreign counterparts to any patents applications of (a) or (b); and
- (d) patents that issue from any of the patent applications of (a), (b), or (c).

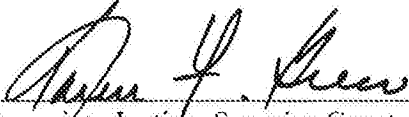
2. Defendant Phio Pharmaceuticals Corp. f/k/a RXi Pharmaceuticals Corp. ("Phio") does not have any ownership rights or interests in the intellectual property identified in Paragraph 1 of this Judgment.

JUDGMENT ENTERED ON DOCKET *May 21 2021*
 PURSUANT TO THE PROVISIONS OF MASS. R. CIV. P. 85(b)
 AND NOTICE SEND TO PARTIES PURSUANT TO THE PROVISIONS OF MASS. R. CIV. P. 77(d) AS FOLLOWS

3. Phio shall take any and all actions reasonably necessary to abrogate and rescind any assignment(s), recordation(s) or notice(s) of ownership recorded in the U.S. PTO and referencing any of the intellectual property listed in Paragraph 1 of this Judgment, including assignments filed in the United States Patent and Trademark Office, and to confirm UMass' exclusive ownership of Professor Khvorova's rights in the intellectual property listed in Paragraph 1.

It is so ORDERED, ADJUDGED and DECREED.

Dated: 5/17/21


Associate Justice, Superior Court