

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

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SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
THE UNIVERSITY OF MANCHESTER	01/23/2017
RECEIVING PARTY DATA	
Name:	RUTGERS, THE STATE UNIVERSITY OF NEW JERSEY
Street Address:	83 SOMERSET STREET
City:	NEW BRUNSWICK
State/Country:	NEW JERSEY
Postal Code:	08901
PROPERTY NUMBERS Total: 1	
Property Type	Number
Application Number:	16542782
CORRESPONDENCE DATA	
Fax Number:	(609)896-1469
<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>	
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Correspondent Name:	FOX ROTHSCHILD LLP
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Address Line 2:	997 LENOX DRIVE, BLDG. #3
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ATTORNEY DOCKET NUMBER:	096747.00407
NAME OF SUBMITTER:	MAGALY FELICIANO
SIGNATURE:	/Magaly Feliciano/
DATE SIGNED:	10/07/2021
Total Attachments: 12	
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Dated 23rd January 2017

- (1) THE UNIVERSITY OF MANCHESTER
- (2) RUTGERS, THE STATE UNIVERSITY OF NEW JERSEY

Assignment of Intellectual Property

THIS ASSIGNMENT is made on

23rd January 2017

BETWEEN

- (1) The University of Manchester (a Royal Charter corporation registered under number RC000797, an exempt charity) of Oxford Road, Manchester, M13 9PL ("University")
- (2) Rutgers, the State University of New Jersey, a specially chartered New Jersey Educational Institution, having an administrative office at 33 Knightsbridge Rd, 2nd Floor – East Wing, Piscataway, New Jersey 08854 ("Institution") ("Assignee")

OPERATIVE PROVISIONS

1. INTERPRETATION

1.1 In this Assignment the following expressions have the following meanings unless inconsistent with the context:

"Affiliate" any person(s) which (i) Controls a party to this Agreement; or (ii) is Controlled by such party; or (iii) is Controlled by such party as is referred to in (i), but only whilst such person(s) so Controls or is so Controlled

"Assigned IP" the Intellectual Property specified in the **Schedule**

"Business Day" any day other than Saturday and Sunday or a bank or public holiday in England

"Claimant" has the meaning set out in **clause 4.6**

"Control" a person has control of another person if it has the power (whether by means of holding shares, possessing voting power or exercising contractual powers in or over that or any other person) to ensure that its affairs are conducted in accordance with the wishes of the person holding the power. **"Controls"** and **"Controlled"** shall be construed accordingly

"Effective Date" the last date of signature of this Assignment

"Intellectual Property" patents, trade marks, copyright, database rights, design rights, registered designs, know-how, and all other intellectual property rights,

in each case whether registered or unregistered and including applications or rights to apply for them and together with all extensions and renewals of them, and in each case all rights and forms of protection having equivalent and similar effect anywhere in the world

"Net Receipts"

the invoiced amount in respect of all licences or assignments of any of the Assigned IP, granted by the Assignee (or such other amount as is deemed to be the Net Receipts pursuant to clause 3.2) (excluding value added tax), including any of the following:

(a) upfront, milestone (whether at the stage of development, marketing or otherwise), success, bonus, maintenance and period (including annual) payments, royalty and minimum royalty payments;

(b) any premium paid over the nominal value of shares, options or other securities in respect of any share capital of the Assignee;

(c) any loan, guarantee or other financial benefit made or given other than on normal market terms;

dany shares, options or other securities obtained from a third party

less any unreimbursed, out-of-pocket expenses incurred by Assignee in the preparation, filing, prosecution, and maintenance of the patent application(s) or patents included in the Assigned IP.

"Year"

the period of 12 consecutive months ending on 28 February (such dates being "Year Days") or any shorter period either commencing on the Effective Date and ending on the next Year Day or commencing on the day after a Year Day and ending on the expiration or termination of this Agreement

- 1.2 References in this Assignment to a statute or statutory provision shall, unless the context otherwise requires include any statute or statutory provision which the referred to provision amends, re-enacts, extends, consolidates or replaces. References to a statutory provision also extend to any subordinate legislation made under it.
- 1.3 References in this Assignment to clauses and the Schedule are to clauses of and the Schedule to this Assignment.
- 1.4 The headings to the clauses are for ease of reference only and shall not be taken into account in its interpretation.

2. ASSIGNMENT

- 2.1 The University assigns to the Assignee:
- 2.1.1 all such right, title and interest as the University has in the Assigned IP absolutely;
- 2.1.2 all the University's rights and powers arising or accrued from the Assigned IP up to the Effective Date including any right to sue for damages and other remedies including without limitation any right to have the benefit of any remedy obtained on any supposed infringement of all or any of its rights in the Assigned IP before the Effective Date; and
- 2.1.3 all the University's rights (if any) to apply for prosecution to obtain patent or similar or other registered protection throughout the world in relation to all or any of the Assigned IP, including any right it has to file patent applications, prosecute such patent applications before national patent offices, take all actions necessary to obtain and maintain patents arising from such patent applications, apply for renewals and extensions and the right to claim priority from earlier applications so that the grant of any patent or similar or other registered protection shall be in the name of and vest in the Assignee.
- 2.2 The Assignee grants to the University a non-exclusive, world-wide, irrevocable, royalty-free licence for the life of the Assigned IP to use the Assigned IP solely for teaching and research purposes and to sub-license the Assigned IP to wholly-owned subsidiaries of the University solely for teaching and research purposes.
- 2.3 The University agrees that it will, at the Assignee's request and cost, execute all documents, take all such actions, do all such things and provide all reasonable assistance as the Assignee may reasonably require in order to secure the right, title and interest in the Assigned IP assigned to the Assignee by this Assignment.

3. **PAYMENTS**

3.1 In consideration of the rights granted under **clause 2**, the Assignee agrees to pay to the University:

3.1.1 as set out in **clause 3.4** a royalty of:

3.1.1.1 5% of the Net Receipts.

3.2 If the Assigned IP is licensed or assigned to an Affiliate of the Assignee, then the Net Receipts from such licence or assignment will be deemed to be equivalent to the Net Receipts which would have been applicable under this Agreement had such Assigned IP been licensed or assigned to an independent arm's length licensee or assignee on its own unconnected in any way with any other licence or assignment and if any of the Net Receipts is non-monetary it shall be given its equivalent monetary value for the purposes of calculating Net Receipts.

3.3 Any dispute between the parties about the monetary value of any non-monetary Net Receipts will, at the request of either party, be referred to an expert under **clause 3.3**.

3.4 The expert will be a single, independent chartered accountant to be agreed between the parties ("**Expert**"). Any dispute to be referred to the Expert will be decided upon in a final and binding manner by the Expert acting as a technical expert and not as an arbitrator. Any actions, decisions, awards or payments to be made or taken pursuant to the determination of the Expert will be made or taken within 30 Business Days of notification of the same to the relevant parties. The costs of the Expert will be borne by the parties as determined by the Expert.

3.5 All sums due under this Agreement:

3.5.1 will be made in pounds sterling to the credit of a bank account to be designated in writing from time to time by the University. Where the sum upon which payment is to be based is in a currency other than pounds sterling such sum will be converted into pounds sterling at the spot rate of exchange offered by National Westminster Bank Plc (or such other bank which the University nominates from time to time in writing) to the University for that conversion ("**Spot Rate**") on the last day of the Year in respect of which the payment is due provided that if such bank is not open for business on the relevant day, then the applicable Spot Rate will be the Spot Rate on the next day such bank is open for business. Where any payment is made after the date required in this Agreement, conversion will be at the Spot Rate at the date of payment if this is more favourable to the University;

- 3.5.2 are exclusive of any value added tax which will be payable in addition by the Assignee on the rendering by the University of an appropriate value added tax invoice. The Assignee will pay any costs, interest and penalties due and incurred by the University whether directly or indirectly by reason of late payment of any such value added tax; and
- 3.5.3 will be made in full without deduction of taxes, charges and other duties (including any withholding or other income taxes) that may be imposed, except where the Assignee is required by law to make such deduction or withholding, in which event the Assignee will:
- 3.5.3.1 ensure that the deduction or withholding does not exceed the minimum amount legally required;
- 3.5.3.2 pay to the applicable taxation or other authorities within the period for payment permitted by law the full amount of the deduction or withholding (including, but without prejudice to the generality of the foregoing, the full amount of any deduction or withholding from any additional amount paid pursuant to this **clause 3.5.3**);
- 3.5.3.3 furnish to the University, within the period for payment permitted by law, either an official receipt of the applicable taxation or other authorities for all amounts deducted or withheld as aforesaid or, if such receipts are not issued by the taxation or other authorities concerned on payment to them of amounts so deducted or withheld, a certificate of deduction or equivalent evidence of the relevant deduction or withholding.
- 3.6 The Assignee will send the University a report within 30 days of the end of each Year showing the Net Receipts accrued in such Year, and a calculation of the royalties due for that Year.
- 3.7 Upon receipt of the report supplied under **clause 3.5**, the University will invoice the Assignee for the royalties due for the Year as set out in such report and the Assignee shall settle such invoice within 60 days.
- 3.8 If any sum payable under this Agreement is not paid when due, then that sum shall bear interest from the due date until payment is made at 4 per cent per annum over LIBOR from time to time, both before and after judgement, where "LIBOR" means the three month Sterling BBA LIBOR as quoted on page 3750 of the Teletate screen or if such page is unavailable the interest rate at which Sterling deposits are perceived to be generally available by leading banks in the London Interbank Market at or about 11.00 a.m. on the first day of that period for delivery on that day.

3.9 The Assignee will keep complete and accurate records and accounts of all Net Receipts and on an annual basis will permit the University or its agents during the Agreement and for 12 months afterwards to audit those records and accounts solely for the purpose of determining the accuracy of the royalty reports and payments. If any audit reveals a discrepancy of more than 5% in any report supplied under **clause 3.5** to the detriment of the University, the Assignee will reimburse the University for the reasonable costs of that audit and pay any accrued underpayment together with any interest accrued under **clause 3.8**.

4. WARRANTIES AND LIABILITY

4.1 Each of the parties acknowledges that, in entering into this Assignment, it has not relied on any warranty, representation or undertaking except those expressly set out in this Assignment and each party waives any claim for breach of any representation (unless made fraudulently) which is not specifically contained in this Assignment as a warranty.

4.2 The University does not give any warranty, representation or undertaking:

4.2.1 as to the efficacy or usefulness of the Assigned IP; or

4.2.2 that any of the Assigned IP is or will be valid or subsisting or (in the case of an application) will proceed to grant; or

4.2.3 that the use of any of the Assigned IP, the manufacture, sale or use of any products using any of Assigned IP or the exercise of any of the rights granted under this Assignment will not infringe any Intellectual Property or other rights of any other person.

4.3 The Assignee will indemnify the University, and keep it fully and effectively indemnified, against each and every third party claim made against the University to the extent arising from the Assignee's use of the Assigned IP.

4.4 Subject to **clause 4.7**, and except under the indemnity in **clause 5.3**, the liability of either party to the other for any breach of this Assignment, for any negligence or liability arising in any other way out of the subject matter of or in connection with this Assignment will not extend to any indirect damages or losses, or any loss of profits, loss of revenue, loss of data, loss of contracts or opportunity, whether direct or indirect, even if the party bringing the claim has advised the other of the possibility of those losses or if they were within the other party's contemplation.

4.5 Subject to **clause 5.7**, the aggregate liability of the University to the Assignee for all and any breaches of this Assignment, any negligence or liability arising in any other way out of the Assigned IP or the subject matter of or in connection

with this Assignment, will not exceed in total the payment received by the University from the Assignee under **clause 3.1** aggregate (excluding VAT).

4.6 Subject to **clause 4.7**, any claim under or arising in any other way out of the Assigned IP or the subject matter of or in connection with this Assignment must be notified in writing by the party making the claim ("Claimant") within 12 months of the date when the Claimant became aware or ought reasonably to have become aware of such claim and in any event within 2 years of the date of this Assignment, and proceedings in respect of such claim must be issued and served on the other party within 12 months of the date of such notification.

4.7 Nothing in this Assignment limits or excludes either party's liability for:

4.7.1 death or personal injury; or

4.7.2 any fraud or for any sort of liability that, by law, cannot be limited or excluded.

5. **NOTICES**

5.1 Any demand, notice or other communication given or made under or in connection with this Assignment shall be in writing and shall be given to the University or to the Assignee, as the case may be, either personally, by post, by facsimile appropriately addressed and marked for the attention of the relevant individual as follows:

University

The University of Manchester
c/o UMI³
Core Technology Facility
Grafton Street
Manchester
M13 9NT

0161 603 7307

For the attention of: Chief
Executive, UMI³

Assignee

Rutgers, the State University of New Jersey
Rutgers, The State University of New Jersey
Office of Research Commercialization
33 Knightsbridge Rd, Piscataway, NJ 08854

Fax #: 732-932-0146

For the attention of : Director of Licensing

or to such other address or facsimile number and marked for the attention of such other individual as the prospective recipient may from time to time designate by notice to the other.

5.2 Notices and communications so designated, shall be deemed to have been duly given or made:

- 5.2.1 If delivered by hand, upon delivery at the address of the relevant party;
- 5.2.2 If sent by prepaid, first class post, 2 Business Days after posting;
- 5.2.3 If sent by fax, at the time of transmission (provided a confirmatory letter is sent by prepaid, first class post).

Where in accordance with the above provisions any notice or communication would otherwise be deemed to be given or made on a day which is not a Business Day or after 4.00 pm on a Business Day such notice or other communication shall be deemed to be given or made at 9.00am on the next Business Day.

6. CONFIDENTIALITY

During the term of this Assignment, it may be necessary or desirable for one party to provide to the other party pre-existing information which it considers to be confidential or proprietary (hereafter "Confidential Information"). Such Confidential Information will be so marked in writing before delivery, where possible. Each party agrees to make a good faith effort to hold Confidential Information of the other party in confidence during this Agreement, and for one year beyond the termination of this Agreement. The standards observed by the receiving party in its good faith effort are to be the same as would apply to the maintenance of its own confidential records. The parties are not obliged to treat as confidential any information which is (i) already in the public domain or later enters the public domain, (ii) already known to the receiving party's personnel, (iii) independently developed at a later time by the receiving party's personnel without knowledge of the disclosing party's Confidential Information, (iv) provided by a third party without breaching any obligation to the disclosing party, or (v) required to be disclosed by court order. Each party further agrees to destroy or return any such Confidential Information and any and all copies thereof to the other party upon request. For the avoidance of doubt, information relating to the Assigned IP shall not be considered Confidential Information of University and may be used by Assignee as it deems necessary to commercialize the Assigned IP.

7. MISCELLANEOUS

- 7.1 Each of the parties shall bear its own legal, accountancy and other costs, charges and expenses connected with the negotiation, preparation and execution of this Assignment.
- 7.2 Neither party may use the other's name or logo in any press release or product advertising, or for any other promotional purpose, without first obtaining the

other's written consent.

- 7.3 This Assignment constitutes the entire agreement between the parties relating to the subject matter of this Assignment and supersedes all prior communications, drafts, agreements, representations, warranties, stipulations, undertakings and agreements of whatsoever nature, whether oral or written, between the parties and all implied conditions and warranties are excluded so far as permitted by law.
- 7.4 The failure to exercise or delay in exercising a right or remedy under this Assignment shall not constitute a waiver of the right or remedy or a waiver of any other rights or remedies, and no single or partial exercise of any right or remedy under this Assignment shall prevent any further exercise of the right or remedy or the exercise of any other right or remedy.
- 7.5 The parties to this Assignment do not intend that any of its terms will be enforceable by virtue of the Contracts (Rights of Third Parties) Act 1999 by any person who is not a party to it.
- 7.6 The performance of this Agreement shall be governed by the laws of England for any action brought by the Assignee against the University, and any proceedings instituted against the University by the Assignee must be brought in the English Courts, which shall have exclusive jurisdiction in all such proceedings. The performance of this Agreement shall be governed by the laws of the State of New Jersey for any action against the Assignee brought by the University, and any proceedings instituted against the Assignee by the University must be brought in the New Jersey courts, which shall have exclusive jurisdiction in all such proceedings.

SCHEDULE

Assigned IP

Patents derived from:

PCT Application No. US2007/02043 Publication No: WO2008063370 - Assays for Fungal Infection

SIGNED by
for and on behalf of
THE UNIVERSITY OF MANCHESTER
in the presence of:

)
)
)
)
)
Clare Sullivan

Witness signature:

Clare Sullivan

Name:

CLARE AKWRIGHT

Address:

THE INCUBATOR BUILDING

Occupation:

48 GRAFTON ST
MANCHESTER M13 9XX
HEAD OF IP SERVICES

SIGNED by
for and on behalf of
RUTGERS, THE STATE UNIVERSITY
OF NEW JERSEY
in the presence of:

)
)
)
)
)

Witness signature:

S. David Kimball

Name:

S. David Kimball, Ph.D.

Address:

Associate Vice President

Occupation:

Research Commercialization

01/26/2017