

PATENT ASSIGNMENT COVER SHEET

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Stylesheet Version v1.2

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SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
ERIC CHARLES REYNOLDS	05/14/2014
RECEIVING PARTY DATA	
Name:	THE UNIVERSITY OF MELBOURNE
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City:	PARKVILLE, VICTORIA
State/Country:	AUSTRALIA
Postal Code:	3010
PROPERTY NUMBERS Total: 1	
Property Type	Number
Application Number:	17169012
CORRESPONDENCE DATA	
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<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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NAME OF SUBMITTER:	KYLIE SEIDLER
SIGNATURE:	/Kylie Seidler/
DATE SIGNED:	12/27/2022
Total Attachments: 8	
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DEED OF ASSIGNMENT

THIS DEED is executed on the 12th day of May 2014

BETWEEN

THE UNIVERSITY OF MELBOURNE (ABN 84 002 705 224) a body politic and corporate established in 1853 and constituted under the *University of Melbourne Act 2009 (Vic)* of Melbourne, Vic, 3010

(University)

AND

Eric Reynolds of Melbourne Dental School

Email: e.reynolds@unimelb.edu.au

Address: 14 Walsh Street, Deepdene, Victoria 3103

(Assignor)

RECITALS

- A. The Assignor has contributed to the development of the Technology as an employee of the University.
- B. The Assignor wishes to acknowledge that any Intellectual Property Rights subsisting in the Technology, to the extent that the Assignor contributed to the development of the Technology, vest in the University pursuant to the Assignor's contract of employment and the University Statute in force at the relevant time.
- C. To the extent that the Assignor retains or continues to hold any right, title or interest in the Intellectual Property Rights subsisting in the Technology, the Assignor wishes to assign such Intellectual Property Rights to the University.
- D. The University and the Assignor wish to record their understanding in accordance with this Deed.

AGREED TERMS

1. DEFINITIONS AND INTERPRETATION

1.1 In this Deed:

Claim means any claim, demand, action or proceeding of any nature however it arises and whether it is present or future, fixed or unascertained, actual or contingent.

Commercialise, in relation to the Technology, means:

- (a) to use, manufacture, sell, hire, promote, import, or otherwise exploit a Product or to provide a service utilising any part of the Technology;
- (b) to use or disclose any Technical Information and other confidential information comprised in the Technology;
- (c) in respect of a copyright work or other subject matter in which copyright subsists, to exercise any of the rights of a copyright owner in relation to any work or other subject matter comprised in the Technology; or
- (d) to conduct clinical trials or any other research, development and testing required to establish commercial viability of a Product;

including licensing any person to do any of the above, or to assign to any person or otherwise dispose of the Technology, and **Commercialisation** has a corresponding meaning.

Deed means this Deed of Assignment.

Encumbrance means a mortgage, charge, pledge, lien or title retention arrangement, a right of set off or right to withhold payment of a deposit or other money, or any easement, restrictive covenant, caveat or similar restriction over property, or an agreement to create or to allow any of them to exist.

Intellectual Property Rights means all rights in the field of intellectual property and industrial property including:

- (a) copyright, rights in respect of inventions (including patents) registered and unregistered trademarks (including service marks), rights in designs plant varieties, circuit layouts and Know How and any right to have information kept confidential;
- (b) any application or right to apply for registration of the rights referred to in paragraph (a); and
- (c) all rights or forms of protection of a similar nature or having equivalent or similar effect to any of the rights in paragraph (a) or (b) which may subsist anywhere in the world.

Invention means the invention described in Schedule 1.

Know How means all information not in the public domain including inventions, drawings, design, circuit diagrams computer programs, data, formulae, specifications, methodologies and techniques, design procedures and procedures for experiments and test, results of experiments

and tests, and information relating to the design, assembly, manufacture, supply or use of any Products and Materials.

Materials, in relation to the Technology, means any chemical or biological substances including any: organic or inorganic element or compound; nucleotide or nucleotide sequence including DNA and RNA sequences; gene; vector or construct including plasmids, phages, bacterial vectors, bacteriophages and viruses; host organism including bacteria, fungi, algae, protozoa and hybridomas; eukaryotic or prokaryotic cell line or expression system or any development strain or product of that cell line or expression systems; protein including any peptide or amino acid sequence, enzyme, antibody or protein conferring targeting properties and any fragment of a protein or a peptide enzyme or antibody; drug or pro-drug; assay or reagent; any other genetic or biological material or micro-organism or any transgenic animal; and any physical property rights relating to any of the foregoing.

Moral Rights has the meaning ascribed in the *Copyright Act 1968* (Cth), as amended, and similar rights in jurisdictions outside Australia.

Patents mean the patents and patent applications claiming and/or relating to the Invention, including **Australia 2013905081 filed on 24/12/2013 entitled Stabilized stannous compositions**, and all applications and granted patents or other similar forms of protection anywhere in the world claiming priority with or from such patents including utility model and design patents and certificates of invention and all divisionals, continuations, continuations-in-part, reissues, renewals, extensions, additions, supplementary protection certificates or equivalent to any such patent applications and patents.

Product means any material, product, kit, method or use which:

- (a) uses or is manufactured using or otherwise incorporates any part of the Technology; and/or
- (b) the manufacture, sale, method or use of which, is the subject of or falls within any claim of any of the Patents.

Technical Information means Know How developed by the Assignor which is necessary for or useful to the Commercialisation of the Technology.

Technology has the meaning given to it in Schedule 1.

University Statute means The University of Melbourne Statutes.

1.2 In this Deed:

- (a) a reference to the Technology includes a reference to any part of the Technology;
- (b) the singular includes the plural and vice versa;
- (c) a reference to a clause, paragraph or schedule is to a clause, paragraph or schedule to this Deed;
- (d) a reference to a party is to a party to this Deed;
- (e) a reference to a person includes a natural person, partnership, body corporate, association, governmental or local authority or agency or other entity;
- (f) a reference to a statute or other law includes regulations and other instruments under it and consolidations, amendments, re-enactments or replacements of any of them;

- (g) the meaning of general words is not limited by specific examples introduced by *including, for example* or similar expressions;
- (h) nothing in this Deed is to be interpreted against a party solely on the ground that the party prepared or put forward the Deed or any part of it; and
- (i) headings are for reference only and do not affect interpretation.

2. COMMENCEMENT

- 2.1 This Deed will take effect on and from the date on which the last party signs this Deed.

3. ACKNOWLEDGEMENT AND ASSIGNMENT OF INTELLECTUAL PROPERTY RIGHTS

- 3.1 The Assignor acknowledges that any Intellectual Property Rights subsisting in the Technology, to the extent that the Assignor contributed to the development of the Technology, vest in the University pursuant to the Assignor's contract of employment and the University Statute in force at the relevant time (including Statute 14.1 of the University Statute).
- 3.2 To the extent that the Assignor retains or continues to hold any right, title or interest in the Intellectual Property Rights subsisting in the Technology notwithstanding the acknowledgment in clause 3.1, the Assignor assigns to the University such right, title and interest in those Intellectual Property Rights (including future Intellectual Property Rights) subsisting in the Technology, including:
- (a) the Patents;
 - (b) Technical information;
 - (c) copyright in the Technology;
 - (d) the Materials;
 - (e) the absolute right to apply for registration as the proprietor of any Intellectual Property Rights subsisting in the Technology anywhere in the world; and
 - (f) the absolute right to do anything in relation to ownership, protection and use of any Intellectual Property Rights subsisting in the Technology anywhere in the world.
- 3.3 The Assignor must do all things and execute all documents necessary to give effect to this Deed and render all assistance reasonably required by the University for the purpose of confirming, recording or perfecting the assignment under clauses 3.2.
- 3.4 The Assignor acknowledges that the University owns all physical property rights in the Materials.

4. CONSIDERATION

- 4.1 The University agrees and acknowledges that:
- (a) upon the assignment of the Intellectual Property Rights subsisting in the Technology to the University; and

- (b) to the extent that the Intellectual Property Rights subsisting in the Technology is licensed, or assigned by the University, to a third party in which the Assignor does not have a shareholding interest,

the University will pay to the Assignor a share of the net royalties received by the University derived from Commercialisation of the Intellectual Property Rights subsisting in the Technology or otherwise reward the Assignor for the Assignor's contribution to the development of the Technology (as the case may be) in accordance with Statute 14.1 of the University Statute and any applicable policies pursuant to the University Statute in force at the time this Deed is executed.

5. ASSIGNOR'S WARRANTIES AND CONSENT

5.1 To the best of the Assignor's knowledge, the Assignor warrants to the University that:

- (a) the Assignor contributed to the creation, implementation or development of the Technology in the performance of the Assignor's role and duties as an employee of the University;
- (b) to the extent that the Assignor assigns any right, title or interest in or to Intellectual Property Rights in clause 3.2, the Assignor is a legal and beneficial owner of the Intellectual Property Rights subsisting in the Technology (including the Patents, Technical Information and any copyright in the Technology);
- (c) the Intellectual Property Rights subsisting in the Technology (including the Patents, Technical Information and any copyright in the Technology) do not infringe the Intellectual Property Rights of any other person;
- (d) the Assignor has not knowingly granted any licences or Encumbrances in relation to the Intellectual Property Rights subsisting in the Technology;
- (e) the Assignor has not received any notice of any Claim in respect of the Technology or the Intellectual Property Rights subsisting in the Technology;
- (f) the Assignor has disclosed all agreements and arrangements, whether or not formal or informal with third parties, including but not limited to material transfer agreements, collaboration agreements, consultancies and all sources of funding contributions pertaining to the Technology and its development;
- (g) the Assignor has notified the University of all public disclosures, either written or oral, including but not limited to publications, abstracts, articles, presentations, journal submissions, thesis (including final PhD oration presentation) containing or describing the Technology of which the Assignor is aware;
- (h) the Assignor has notified the University of any other person or party that contributed to the development of the Technology; and
- (i) the Assignor has not done or failed to do anything whereby the whole or any part of the rights assigned under this Deed might be invalidated or registration of them refused.

5.2 The Assignor consent to acts or omissions that would otherwise infringe the Assignor's Moral Rights in any copyright subsisting in the Technology including as a result of any use of such copyright in the Patent.

- 5.3 To the extent that the Technology is not in the public domain as at the effective date of this Deed, the Assignor agrees to maintain the confidentiality of the Technology (including the Technical Information) until the Technology becomes part of the public domain other than as a result of a breach of confidence by the Assignor.
- 5.4 If, at any time on or after the date of this Deed, the Assignor becomes aware of any fact, matter or circumstance which may materially affect the University's Intellectual Property Rights subsisting in the Technology, the Assignor must promptly notify the University in writing of the relevant particulars.

6. ASSIGNOR'S INDEMNITY

- 6.1 The Assignor indemnifies the University against any losses, costs, actions, claims, demands, expenses, judgements, court orders or other liabilities arising out of or in connection with any negligent or deliberate breach by the Assignor of the warranties or undertakings contained in clause 5.

7. GENERAL

- 7.1 This Deed contains the entire agreement between the parties with respect to its subject matter and supersedes all prior agreements and understandings between the parties.
- 7.2 This Deed can only be amended or replaced or novated by another document signed by the parties.
- 7.3 Any provision of this Deed which is unenforceable or partly unenforceable is, where possible, to be severed to the extent necessary to make this Deed enforceable, unless this would materially change the intended effect of this Deed.
- 7.4 A provision of or a right created under this Deed may not be:
- (a) waived except in writing signed by the Party granting the waiver; or
 - (b) varied except in writing signed by the Parties.
- 7.5 The rights provided in this Deed are cumulative with and not exclusive of the rights provided by law independently of this Agreement.
- 7.6 Each Party must pay its own costs in connection with the entry into this Deed and compliance with its terms.
- 7.7 This Deed may be signed in counterparts each of which are an original and together constitute the same Deed.
- 7.8 This Deed is governed by the law of the State of Victoria, Australia, and the parties submit to the jurisdiction of the courts of that State.

Executed as a Deed

Signed sealed and delivered as a Deed by)
and on behalf of The University of)
Melbourne by its authorised officers pursuant)
to Statute 1.5.6 of The University of Melbourne)
Statutes:

Signature of ~~ACTING VICE~~ PROFESSOR MARGARET SH
CHANCELLOR
THE UNIVERSITY OF MELBOURNE

Name:

Date: 14/5/2014

Signature of Authorised Officer

Name: Dr Christopher Stewardson
University Secretary

Date: 13/5/2014

Signed sealed and delivered as a Deed by)
Eric Reynolds)

Signature of Assignor

Name: ERIC REYNOLDS

Date: 18/3/14

Signature of Witness

Name: KATE FLETCHER

Date: 18/3/14

SCHEDULE 1

Invention

UoM Commercial Tech ID 2013-121

The invention provides a stannous-associated stabilized amorphous calcium phosphate (ACP) and/or amorphous calcium fluoride phosphate (ACFP) complex. The stannous may be bound to the stabilized amorphous calcium phosphate (ACP) and/or amorphous calcium fluoride phosphate (ACFP). The invention also includes a method of mineralizing a dental surface or sub-surface comprising contacting the dental surface or subsurface with (a) a composition including a stannous compound and stabilized ACP or ACFP, or (b) a stannous-associated stabilized ACP or ACFP.

Technology

- (a) any Intellectual Property Rights in the Invention;
- (b) any Patents;
- (c) Technical Information existing as at the effective date of this Deed that is not in the public domain; and
- (d) the Materials.