

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

EPAS ID: PAT8314713

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
ÉCOLE POLYTECHNIQUE FÉDÉRALE DE LAUSANNE	07/20/2018
RECEIVING PARTY DATA	
Name:	MAX-PLANCK-GESELLSCHAFT ZUR FÖRDERUNG DER WISSENSCHAFTEN E.V.
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PROPERTY NUMBERS Total: 1	
Property Type	Number
Patent Number:	9952208
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ATTORNEY DOCKET NUMBER:	20885-2801
NAME OF SUBMITTER:	LIN J. HYMEL
SIGNATURE:	/Lin J. Hymel/
DATE SIGNED:	12/06/2023
Total Attachments: 6	
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PATENTS ASSIGNMENT TRANSFER AGREEMENT

between

Ecole Polytechnique Fédérale de Lausanne,
1015 Lausanne, Switzerland

represented by Matthias Glumann, Director of Research Affairs
and by Caroline Kuyper, Vice President for Finances CFO

hereinafter referred to as "EPFL"

and

Max-Planck-Gesellschaft zur Foerderung der Wissenschaften e.V.
Hofgartenstrasse 8, 80539 Muenchen, Germany

represented by Dr. Joern Erselius, Authorized Patent Representative

hereinafter referred to as "Assignee" or "MPG"

and

Max-Planck-Innovation GmbH
Amalienstrasse 33, 80799 Muenchen / Germany

represented by Dr. Joern Erselius, Managing Director

hereinafter referred to as "MI"

whereby the parties to this Agreement are also hereinafter collectively referred to as "Parties"
or individually as "Party".

Preamble

WHEREAS MPG is a German non-profit scientific research organization. MI is a 100% subsidiary of MPG, and is acting as the exclusive technology transfer organization of MPG. EPFL is a Swiss university, and one of the two Swiss Federal Institutes of Technology. EPFL is active in training, research and technology transfer.

WHEREAS EPFL is the owner of the two following patent applications (hereinafter collectively the "Patents"):



i) PCT/EP2013/065223, entitled "Means and methods for bioluminescence resonance energy transfer (BRET) analysis in a biological sample" claiming the priority date 18.07.2013, pursued in the national phase in the following territories: Australia, Canada, China, Belgium, Switzerland-Lichtenstein, Germany, France, Great Britain, Netherlands, India, United States of America ("Patent A"); and

ii) PCT/EP2018/064076, entitled "Sensors, methods and kits for detecting NADPH based on resonance energy transfer" claiming the priority date 30.05.2017 ("Patent B"). MI 5679 HSG

WHEREAS Prof. Kai Johnsson is one of the inventors of the Patents, and has, at that time, been an employee of EPFL and head of research group at EPFL. Prof. Kai Johnsson is now an employee of Assignee and head of research group at the Max Planck Institute for Medical Research. He is willing to pursue research activities related to the technology covered by the Patents as an employee of Assignee. Assignee is willing to assume the Patents, and to further prosecute the Patents in its name and costs. Further, MI is willing to commercially exploit the Patents by a license or a transfer in its name and costs, and will thereon share commercialization revenues with EPFL as set forth in the present agreement (herein after the "Agreement").

ARTICLE 1 - ASSIGNMENT OF PATENTS

EPFL hereby assigns to the Assignee, which hereby accepts, all its rights, title and interest in and to the Patents. EPFL agrees, upon Assignee's request, to execute any documents necessary for effecting the assignment of the Patents to the Assignee.

Assignee shall be free to prosecute, maintain, abandon, enforce or defend the Patents as it sees fit in its name and costs, without prejudice to commercial or legal legitimate interests of EPFL as defined hereunder. EPFL agrees, upon Assignee's request, to reasonably support Assignee in such prosecution, maintenance, enforcement or defense of the Patents, at Assignee's expense, i.e. EPFL shall provide access to data and material reasonably available to EPFL relating to the Patents prosecution and the invention covered by the Patents, provided that EPFL shall provide access to an inventor of the Patents (other than Prof. Kai Johnsson) only if such inventor is, at the time of Assignee's request, an employee of EPFL. Assignee acknowledges it has received a copy of the documents filed by EPFL for the priority application and the PCT extension of the Patents as reported by the agent mandated by the EPFL.

MI hereby agrees to enter in good faith negotiations with any third party, presented by EPFL and interested to commercially use the Patents, for the granting to such third party of a license on the Patents. MI shall not unduly refuse to grant such license; it may however refuse in the case that its commercial or legal legitimate interests would be harmed by the granting of such license. In all other cases, MI shall be free to commercialize the Patents (by license, transfer or otherwise) as it sees fit in its name and costs, provided that EPFL shall receive a share of MI's revenues as described in Article 2.



Notwithstanding the assignment of the Patents, EPFL reserves in all cases the right to use the Patents and the related technology for its own scientific non-commercial purposes (internal research, teaching and academic collaborations), and MI shall cause any licensee or transferee of the Patents to respect such retained right. This right is not transferable and does not include the right to sublicense.

Any Patents license and or transfer agreement made by MI shall contain financial and other terms and conditions which are customary for a license agreement granted by an academic institution for the type of technology involved in the Patents. In addition, any Patents license and or transfer agreement shall stipulate that nothing in the agreement confers by estoppel, implication or otherwise, any license or right under any of the patents owned by EPFL other than the Patents, regardless of whether such patents are dominant or subordinate to the Patents.

ARTICLE 2 -- CONSIDERATION FOR ASSIGNMENT

Of any Revenues (as defined below) generated by MI from the licensing or other exploitation or transfer of the Patents ("Exploitation"), MI shall first reimburse the external Patent costs incurred (i) by EPFL until the date of execution of this Agreement to EPFL, and (ii) by Assignee after the date of execution of this Agreement to Assignee. Then, MI shall pay to EPFL, on a yearly basis, after the deduction of a MI management fee of 20%, a share of the revenues ("EPFL Share") it receives by licensing, exploiting otherwise or transferring the Patents, by direct or indirect sale of products which are covered in whole or in part by the Patents in the country in which any such products are made, used or sold, or by direct or indirect sale of a process covered in whole or in part by the Patents as follows ("Revenues");

For Revenues made upon Exploitation of Patent A alone, or made upon Exploitation of Patent A and B MI 5678 MSG

50% (fifty percent) of any Revenues made by MI from the execution date of this Agreement and onwards until the tenth (10th) anniversary of the execution date of this Agreement;

30% (thirty percent) of any Revenues made by MI after this tenth (10th) anniversary and onwards.

For Revenues made upon Exploitation of Patent B alone MI 5678 MSG

50% (fifty percent) of any Revenues made by MI from the execution date of this Agreement and onwards until the fifth (5th) anniversary of the execution date of this Agreement;

30% (thirty percent) of any Revenues made by MI after this fifth (5th) anniversary and onwards.

For clarity, if MI commercializes the Patents as a package consisting of Patent A and Patent B, the above distinction shall be made based on the reasonable allocation of the respective Revenues to either the package, or to Patent A or to Patent B (e.g. a license initiation fee will be allocated to the package, and royalties on net sales will be allocated according to whether

the product is covered by the package or Patent A or Patent B).

In the event MI commercializes the Patents (by license, transfer or otherwise), and receives non-cash consideration (e.g. shares, or an option to receive shares) from its commercialization partner, then such non-cash consideration shall not qualify as Revenues, and only in the event MI receives cash for such non-cash consideration (e.g. MI sells such shares, or receives dividends), such cash shall qualify as Revenues.

MI shall notify EPFL as soon as it receives a first Revenue, and MI shall then pay to EPFL the EPFL Share once per year on the 31st of March of each year for the previous calendar year. MI's report on Revenues shall be sent to EPFL by the 31st of March of each year. If no Revenue is made, MI shall so report. Payment shall be made in Euro.

The report on Revenues and EPFL Share shall be sent to:

Ecole Polytechnique Fédérale de Lausanne (EPFL)
Technology Transfer Office (TTO)
EPFL Innovation Park - J
CH-1015 Lausanne, Switzerland
Ref 6.1287/6.1718

The Parties may communicate in writing any change of their respective addresses at any time by mail, email or by facsimile.

Each Party shall solely be responsible to remunerate their own inventors according to their respective applicable rules. The present Agreement shall not confer any obligation for MI (or for Assignee) to take over EPFL's duty to do so towards its inventors regarding the EPFL Share.

ARTICLE 3 -- NO WARRANTIES - INDEMNIFICATION

EPFL represents and warrants that it is the sole owner of all rights, title and interest in and to the Patents, and that it has the unrestricted power to assign the Patents hereunder. Apart from this, EPFL makes no warranty as to the Patents and/or its commercial exploitation. Nothing in this Agreement shall be construed as implied warranties, including but not limited to warranties of merchantability or fitness for a particular purpose of the Patents. Nothing in this Agreement shall be construed as warranty given by EPFL that the use or exploitation of the Patents shall not infringe intellectual property rights of third parties.

EPFL shall not be liable for any direct, consequential, or other damages suffered by the Assignee or MI, any licensees or sublicensee, or any others resulting from the use of the Licensed Products and/or Processes.

Before the commercialization of any product and/or service using directly or indirectly the Patents, it is the sole responsibility of MI or its licensees or transferees to undertake or have undertaken such investigations and tests as are necessary for the development of such product and/or service. MI will decide at its own discretion to grant licenses on the Patents or make a



transfer of it. MI shall be solely responsible for any claims of third parties in connection with such actions. MI agrees to obligate any licensee to indemnify, defend, and hold EPFL harmless against any such claim brought against EPFL.

ARTICLE 4 - ASSIGNMENT

In case the Patents and this Agreement shall be assigned by the Assignee and MI to a natural or legal person whose sole business is solely related to the trade with and the enforcement of patents (so called patents trolls), prior written consent of EPFL is required. This clause is enforceable towards any third party, including persons or entities which have control over the Assignee or MI. In all other cases, Assignee and MI are free to transfer the Patents and/or this Agreement in their sole discretion.

ARTICLE 5 - DURATION AND TERMINATION

This Agreement shall become effective upon signature by the Parties, and shall remain effective until the expiration of all payment obligations hereunder.

ARTICLE 6 - APPLICABLE LAW AND PLACE OF JURISDICTION

This Agreement shall be governed by the substantive laws of Switzerland. The place of jurisdiction shall be Lausanne.

ARTICLE 7 - MISCELLANEOUS

7.1 Sole Agreement

This Agreement is the sole agreement between the Parties on the subject matter herein, and supersedes and replaces all previous oral or written agreements and understandings.

7.2 Amendments

This Agreement may only be modified by an amendment in writing executed by duly authorized officers of the Parties.

7.3 No Agency

Nothing herein shall be deemed to constitute either Party as the agent or representative of the other Party, or the Parties as joint venturers or partners for any purposes. Each Party shall be an independent contractor, not an employee or partner of the other. No Party shall be responsible for the acts or omissions of the other Party, and neither Party will have authority to speak for, represent or obligate the other Party in any way without prior written authority from the other Party.

7.4 Use of Name

Neither Party shall use the name of the other Party without the prior written consent of the other Parties.



This Agreement is executed in two originals and duly signed by the authorized representatives of the Parties hereto, as printed below:

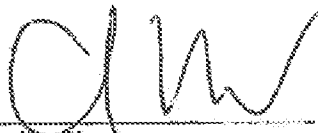
Ecole Polytechnique Fédérale de Lausanne (EPFL)

Place: Lausanne, 20/7/18

Date: _____

Signatures :


Matthias Glumann
Director of Research Affairs


Caroline Kuyper
Vice President for Finances CFO
24.7.18

Max-Planck-Gesellschaft zur Foerderung der Wissenschaften e.V.

Place: Munich

Date: 19 July 2018

Signature :

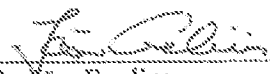

Dr. Jörn Erselius
Authorized Patent Representative

Max-Planck-Innovation GmbH

Place: Munich

Date: 19 July 2018

Signature :


Dr. Jörn Erselius
Managing Director

CONFIDENTIAL

EPFL ref.6.1287, 6.1718

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