

12-05-2001

DEC 3 1997

Form PTO-1594 (Rev. 03/01) OMB No. 0651-0027 (exp. 5/31/2002) Tab settings ⇌ ⇌ ⇌ ▼



U.S. DEPARTMENT OF COMMERCE U.S. Patent and Trademark Office

101906566

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies): 12801 Athena Neurosciences Inc. [ ] Individual(s) [ ] Association [ ] General Partnership [ ] Limited Partnership [x] Corporation-State Delaware [ ] Other Additional name(s) of conveying party(ies) attached? [x] Yes [ ] No

2. Name and address of receiving party(ies) Name: Shire Laboratories Inc. Internal Address: Street Address: 7900 Tanners Gate Drive Suite 200 City: Florence State: KY Zip: 41042 [ ] Individual(s) citizenship [ ] Association [ ] General Partnership [ ] Limited Partnership [x] Corporation-State Delaware [ ] Other If assignee is not domiciled in the United States, a domestic representative designation is attached: [ ] Yes [ ] No (Designations must be a separate document from assignment) Additional name(s) & address(es) attached? [x] Yes [ ] No

3. Nature of conveyance: [x] Assignment [ ] Merger [ ] Security Agreement [ ] Change of Name [ ] Other Execution Date: December 23, 1997

4. Application number(s) or registration number(s): A. Trademark Application No.(s) B. Trademark Registration No.(s) 1,975,246 Additional number(s) attached [ ] Yes [x] No

5. Name and address of party to whom correspondence concerning document should be mailed: Name: Shire US Inc. Internal Address: Attn: Aaron P. Buda Street Address: 7900 Tanners Gate Drive Suite 200 City: Florence State: KY Zip: 41042

6. Total number of applications and registrations involved: 1 7. Total fee (37 CFR 3.41): \$ 40.00 [x] Enclosed [ ] Authorized to be charged to deposit account 8. Deposit account number: n/a (Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature. To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document. Kevin T. Anderson Name of Person Signing [Signature] Signature [ ] Date

Total number of pages including cover sheet, attachments, and document: 13

Mail documents to be recorded with required cover sheet information to: Commissioner of Patent & Trademarks, Box Assignments Washington, D.C. 20231

12/04/2001 LMUELLER 00000091 1975246 01 FC:481 40.00/OP

**Additional Conveying Party**

Elan Corporation plc

Other: A public limited company organized under the laws of Ireland

**Additional Receiving Party**

Shire Pharmaceuticals Group plc

Other: A public limited company organized under the laws of England and Wales

Athena File

RightFAX NT

12/23/1997 17:53

PAGE 3/51

RightFAX

DATED <sup>13</sup> DECEMBER 1997

ATHENA NEUROSCIENCES, INC.

and

ELAN CORPORATION PLC

and

SHIRE LABORATORIES INC.

and

SHIRE PHARMACEUTICALS GROUP PLC

---

SALE AND ASSIGNMENT AGREEMENT

---

Slaughter and May  
35 Basinghall Street  
London EC2V SDB  
(RCS/AJYT)

RightFAX NT

12/23/1997 17:53

PAGE 8/51

RightFAX

THIS AGREEMENT is made the 23<sup>rd</sup> day of December, 1997

## BETWEEN:

1. ATHENA NEUROSCIENCES, INC. of 800 Gateway Boulevard, South San Francisco, CA 94080, USA ("Athena")

AND

2. ELAN CORPORATION PLC of Lincoln House, Lincoln Place, Dublin 2, Ireland ("Elan")

AND

3. SHIRE LABORATORIES INC. of 1550 East Gude Drive, Rockville, MD 20850, USA ("Shire")

AND

4. SHIRE PHARMACEUTICALS GROUP PLC of East Anton, Andover, Hampshire SP10 5RG (registered in England No. 2883758) ("Issuer")

## WHEREAS:

- (A) By an agreement dated 1st July, 1996, Pharmavenc, Inc., the predecessor of Shire, and Athena entered into the Licence Agreement (as defined in this agreement).
- (B) Athena has agreed to sell and the Issuer has agreed to purchase the Transferred Assets (as defined in this agreement) and Athena has agreed to assign to the Issuer the Relevant Intellectual Property (as defined in this agreement) in respect of the Licence Agreement on the terms set out in this agreement and Athena has agreed to assign the Licence Agreement on the terms set out in this agreement.
- (C) As part of the consideration for the transfer of the Transferred Assets, the assignment of the Relevant Intellectual Property and the assignment of the Licence Agreement, the Issuer has agreed to constitute and allot the Loan Note and allot and issue the Shares (each as defined in this agreement) and on the terms set out in this agreement.
- (D) In consideration for the payment of US\$2,000,000 to Athena, the allotment by the Issuer to Athena of the Loan Note and the Shares, Elan has agreed to guarantee the performance of the payment obligations of Athena under this agreement.

RightFAX NT

12/23/1997 17:59

PAGE 7/51

RightFAX

2

NOW IT IS AGREED as follows:

**1. Interpretation****1.1 In this agreement and the schedules to it:**

- "Books and Records"** means those books and records containing or relating to Relevant Know-How or on which any Relevant Know-How is recorded described in Schedule 7 (Relevant Assets);
- "Business Day"** means a day (other than a Saturday) on which leading banks are open for business in New York and the City of London;
- "Completion"** means completion of the transfer of the Transferred Assets, the assignment of the Relevant Intellectual Property and the assignment of the Licence Agreement under this agreement which shall be effective on 31st December, 1997;
- "Completion Date"** means the date on which Completion takes place;
- "Contracts"** means the contracts listed in Schedule 5 (Contracts);
- "Group Company"** means, in respect of any company, that company or any Subsidiary or Holding Company of it or any Subsidiary of such Holding Company;
- "Holding Company"** has the meaning given in section 736 Companies Act 1985;
- "Intellectual Property"** means the Patent Rights, the Trademark Rights, the Know-How, the Relevant Know-How and the NDA;
- "Licence Agreement"** means the agreement dated 1st July 1996 between Pharmavenc, Inc. and Athena for the commercial manufacture, marketing and distribution of the Product, a complete and accurate copy of which is attached as Annex A (Licence Agreement);

RightFAX NT

12/23/1997 17:53

PAGE 8/51

RightFAX

3

- "Loan Note"** means the zero coupon unsecured convertible loan note issued at an issue price of US\$14,000,000 but with a face value of US\$15,780,375 to be issued in accordance with Clause 8.7, substantially in the form attached in Schedule 3 (Loan Note);
- "Product"** means extended release dosage forms of carbamazepine based on the Patent Rights, Trademark Rights and/or Know-How, together with any Improvements;
- "Promotion Agreement"** means the Promotion Agreement to be signed on Completion between Shire or a Group Company of Shire and Athena setting out the co-promotion arrangements relating to the marketing of the Product in the United States, substantially in the form attached as Schedule 9 (Promotion Agreement);
- "Relevant Assets"** means those assets, tangible or intangible, relating to the Product and/or any Improvements, including, without limitation, all inventory (including raw materials, work-in-progress and finished goods), all supplies, all equipment wherever located, including at NIRO, Purdue Frederick and Shire, and all purchase orders relating to MG-2 equipment (which to the extent that Athena and/or Elan has not paid for at Completion, will be paid for post-Completion by Athena and/or Elan if ordered or approved in writing in advance of Completion by Athena and/or Elan), which are set out or described in Schedule 7 (Relevant Assets);
- "Relevant Intellectual Property"** means the Intellectual Property of Athena or its Group Companies or licensed to Athena or its Group Companies relating to the Product and/or any of the Improvements, a list of which is set out in Schedule 4 (Relevant Intellectual Property);
- "Relevant Know-How"** means the Know-How and any additional Know-How relating to the Product and/or any Improvements (including, without limitation, marketing methods and procedures, advertising and promotional material and regulatory approvals) developed or produced by Athena or any of its Group Companies under the Licence Agreement and held

RightFAX NT

12/23/1987 17:53

PAGE 10/51

RightFAX

5

**2. Sale and Transfer of the Transferred Assets**

2.1 Athena agrees to sell, assign and transfer (or, in the case of the MG-2 purchase orders described in sub-clause 2.2 below, procure the assignment of), and the Issuer agrees to purchase and accept as at and with effect from Completion:

- (A) the Relevant Assets;
- (B) the Books and Records;
- (C) the benefit, subject to the burden, of the Contracts; and
- (D) all Relevant Know-How.

2.2 (A) Athena confirms that it is the sole owner or licensee of the Transferred Assets (except for the MG-2 purchase orders listed in Schedule 7 (Relevant Assets) which were issued by a Group Company of Athena) and that the Transferred Assets are free from all liens, charges and encumbrances of, and from all other rights exercisable by or claims by, third parties claiming by, through or under Athena or any of its Group Companies.

(B) Except as provided in this agreement (including Schedule 2 (Representations and Warranties)), the Transferred Assets are sold "as-is, where-is", without other warranties of any kind, express or implied, and all other such warranties are hereby disclaimed, including any implied warranties of merchantability or fitness for any particular purpose.

2.3 (A) The Issuer shall not be liable for any liabilities, including without limitation any unpaid debts, incurred in respect of the Product by Athena or any of its Group Companies prior to Completion that have not been satisfied or discharged in full at or prior to Completion. For the avoidance of doubt, Athena shall be liable for all and any Product manufactured at NIRO and/or Purdue Frederick prior to Completion, regardless of whether such Product has been billed or delivered to or by Athena.

(B) Athena shall not be liable for any liabilities, including without limitation any unpaid debts, incurred in respect of the Product by the Issuer or any of its Group Companies on or after Completion.

2.4 The Issuer shall be responsible for and shall pay (or reimburse Athena if Athena is required to pay or withhold) all sales taxes or other applicable taxes (other than gross receipts or income taxes of Athena), normally paid by a purchaser on an acquisition of assets or a similar transaction of this type, on the transfer of



6

any of the Transferred Assets and the parties shall reasonably cooperate to minimise any such taxes.

**3. Assignment of Intellectual Property**

- 3.1 Athena agrees to assign to the Issuer (to the extent that such rights have not been assigned pursuant to sub-clause 4.1 below) all of its rights, title and interest in and to the Relevant Intellectual Property, together with all related goodwill and common law rights and all rights, privileges and advantages pertaining thereto (including, without limitation, the right to take proceedings and recover damages and to obtain all other remedies in respect of infringements of such rights) to hold unto the Issuer absolutely.
- 3.2 Any Relevant Intellectual Property, whether or not registered or the subject of an application for registration, shall be assigned to the Issuer pursuant to the assignments referred to in paragraph 1(B)(i) of Schedule 1 (Completion arrangements).

**4. Assignment of the Licence Agreement**

- 4.1 Athena agrees to assign to the Issuer, and Shire consents to such assignment of all of its rights, title and interests in and under the Licence Agreement and Athena and Shire shall have no further obligations to each other with respect therein, save that all sums accrued and due at the date of Completion shall be paid, including, without limitation the project development expense payments payable by Athena in respect of November 1997 and December 1997 and provided that Section 11 (Confidential Information) and Section 14 (Indemnities) of the Licence Agreement shall survive such assignment in respect of any relevant act, default or breach of the Licence Agreement occurring prior to Completion.
- 4.2 With effect from Completion, Athena shall have no right to use any Relevant Intellectual Property licensed to Athena and/or any Group Companies pursuant to the Licence Agreement, except as provided in the Promotion Agreement.

**5. Conditions**

- 5.1 The agreement to transfer the Transferred Assets, assign the Relevant Intellectual Property and assign the Licence Agreement pursuant to this agreement are in all respects conditional upon those matters listed in Schedule 6 (Conditions to Completion).
- 5.2 The Issuer, Shire and Athena (but only the Issuer in respect of Condition 3) will each use all reasonable endeavours to fulfil or procure the fulfilment of Condition 1 and Condition 3 listed in Schedule 6 (Conditions to Completion) as soon as possible and in any event before 19th January, 1998.

315172/10077 C0975340.001 A19T 23/12/97:1850

RightFAX NT

12/23/1997 18:20

PAGE 13/39

RightFAX

20

Schedule 1  
(Completion arrangements)

1. **Matters to be dealt with by Athena and Elan**

On the Completion Date, Athena shall:

(A) Transfer of Transferred Assets capable of delivery

Deliver to the Issuer at Shire's direction and expense all the Transferred Assets which are capable of transfer by delivery, with the intent that legal and beneficial title to these Transferred Assets shall pass by and upon delivery.

(B) Other Matters

Deliver to the Issuer at Shire's direction and expense:

- (i) assignments of all Relevant Intellectual Property and the Licence Agreement;
- (ii) duly executed agreements for the assignment of the benefit of the Contracts if required;
- (iii) those Books and Records, Relevant Know-How and Relevant Assets transferred under sub-clause 2.1 (Transfer of the Transferred Assets); and
- (iv) a copy of the minutes of a meeting of the directors of Athena authorising the execution of this agreement and the Promotion Agreement endorsed with a certificate by the secretary of Athena that these copy minutes are a true and accurate record of the meeting and that the authority conferred remains valid and outstanding.

(C) Promotion Agreement

Execute and deliver to Shire or its designated Group Company the Promotion Agreement.

2. **Matters to be dealt with by the Issuer and Shire**

Simultaneously with compliance by Athena with its obligations under paragraph 1 above:

RightFAX NT

12/23/1997 18:20

PAGE 35/39

RightFAX

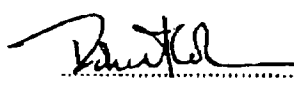
Signed by  
for and on behalf of  
ATHENA NEUROSCIENCES, INC.

.....  
(Signature of named signatory)

Signed by  
for and on behalf of  
ELAN CORPORATION PLC.

.....  
(Signature of named signatory)

Signed by  
for and on behalf of  
SHIRE LABORATORIES INC.

  
.....  
(Signature of named signatory)

Signed by  
for and on behalf of  
SHIRE PHARMACEUTICALS GROUP PLC

  
.....  
(Signature of named signatory)

0297540.DM1

Signed by  
for and on behalf of  
ATHENA NEUROSCIENCES, INC.

*Lyndale F. Murphy*  
.....  
(Signature of named signatory)

Signed by  
for and on behalf of  
ELAN CORPORATION PLC.

.....  
(Signature of named signatory)

Signed by  
for and on behalf of  
SHIRE LABORATORIES INC.

.....  
(Signature of named signatory)

Signed by  
for and on behalf of  
SHIRE PHARMACEUTICALS GROUP PLC


.....  
(Signature of named signatory)

858 875 3528

Signed by  
for and on behalf of  
ATHENA NEUROSCIENCES, INC.

.....  
(Signature of named signatory)

Signed by  
for and on behalf of  
ELAN CORPORATION PLC.

  
.....  
(Signature of named signatory)

Signed by  
for and on behalf of  
SHIRE LABORATORIES INC.

.....  
(Signature of named signatory)

Signed by  
for and on behalf of  
SHIRE PHARMACEUTICALS GROUP PLC

.....  
(Signature of named signatory)

12/23/97 12:00 FAX 858 875 3528