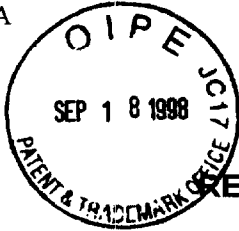


09-23-1998



100836006

**RECORDATION FORM COVER SHEET  
PATENTS ONLY**

TO: The Commissioner of Patents and Trademarks: Please record the attached original document(s) or copy(ies).

<b>Submission Type</b>		<b>Conveyance Type</b>	
<input checked="" type="checkbox"/> New	<b>MRD</b> 9-18-98	<input type="checkbox"/> Assignment	<input type="checkbox"/> Security Agreement
<input type="checkbox"/> Resubmission (Non-Recordation)	Document ID# _____	<input type="checkbox"/> License	<input type="checkbox"/> Change of Name
<input type="checkbox"/> Correction of PTO Error	Reel # _____ Frame # _____	<input type="checkbox"/> Merger	<input checked="" type="checkbox"/> Other <b>Confirmatory License</b>
<input type="checkbox"/> Corrective Document	Reel # _____ Frame # _____	<b>U.S. Government</b> (For Use ONLY by U.S. Government Agencies)	
		<input checked="" type="checkbox"/> Departmental File	<input type="checkbox"/> Secret File

**Conveying Party(ies)**  Mark if additional names of conveying parties attached

Name (line 1) SANDIA CORPORATION Execution Date 06/03/97  
Month Day Year

Name (line 2) \_\_\_\_\_

**Second Party** Execution Date \_\_\_\_\_  
Month Day Year

Name (line 1) \_\_\_\_\_

Name (line 2) \_\_\_\_\_

**Receiving Party**  Mark if additional names of receiving parties attached

Name (line 1) United States Department of Energy  If document to be recorded is an assignment and the receiving party is not domiciled in the United States, an appointment of a domestic representative is attached. (Designation must be a separate document from Assignment.)

Name (line 2) \_\_\_\_\_

Address (line 1) GC-62, MS 6F-067 (FORSTL)

Address (line 2) 1000 Independence Avenue, S.W.

Address (line 3) Washington D.C. 20585  
City State/Country Zip Code

**Domestic Representative Name and Address** Enter for the first Receiving Party only.

Name \_\_\_\_\_

Address (line 1) \_\_\_\_\_

Address (line 2) \_\_\_\_\_

Address (line 3) \_\_\_\_\_

Address (line 4) \_\_\_\_\_

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Public burden reporting for this collection of information is estimated to average approximately 30 minutes per Cover Sheet to be recorded, including time for reviewing the document and gathering the data needed to complete the Cover Sheet. Send comments regarding this burden estimate to the U.S. Patent and Trademark Office, Chief Information Officer, Washington, D.C. 20231 and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Paperwork Reduction Project (0651-0027), Washington, D.C. 20503. See OMB Information Collection Budget Package 0651-0027, Patent and Trademark Assignment Practice. DO NOT SEND REQUESTS TO RECORD ASSIGNMENT DOCUMENTS TO THIS ADDRESS.

**Correspondent Name and Address**

Area Code and Telephone Number

Name

Address (line 1)

Address (line 2)

Address (line 3)

Address (line 4)

**Pages** Enter the total number of pages of the attached conveyance document including any attachments. #

**Application Number(s) or Patent Number(s)**  Mark if additional numbers attached

Enter either the Patent Application Number or the Patent Number (DO NOT ENTER BOTH numbers for the same property).

**Patent Application Number(s)**

**Patent Number(s)**

<input type="text" value="08522202"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>

If this document is being filed together with a new Patent Application, enter the date the patent application was signed by the first named executing inventor. Month Day Year

**Patent Cooperation Treaty (PCT)**

Enter PCT application number only if a U.S. Application Number has not been assigned.

PCT <input type="text"/>	PCT <input type="text"/>	PCT <input type="text"/>
PCT <input type="text"/>	PCT <input type="text"/>	PCT <input type="text"/>

**Number of Properties** Enter the total number of properties involved. #

**Fee Amount** Fee Amount for Properties Listed (37 CFR 3.41): \$

Method of Payment: Enclosed  Deposit Account

Deposit Account

(Enter for payment by deposit account or if additional fees can be charged to the account.)

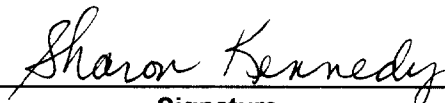
Deposit Account Number: #

Authorization to charge additional fees: Yes  No

**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. Charges to deposit account are authorized, as indicated herein.

Sharon Kennedy



SEP 18 1998

Name of Person Signing

Signature

Date

ASSIGNMENT AND CONFIRMATORY LICENSE

TITLE: Holographic Correlation Spectrometer  
INVENTOR(s): Michael A. Butler, et al  
SERIAL NO.: 08/522,202  
DOMESTIC FILING DATE: 0830/95  
DOE CONTRACT: DE-AC04-76DP00789  
CONTRACTOR: AMERICAN TELEPHONE & TELEGRAPH COMPANY  
and SANDIA CORPORATION

PATENT NO.: Unknown  
ISSUE DATE: Unknown  
WAIVER NO.: W(C)91-004  
WAIVER DATE: September 29, 1995

Foreign applications filed in or intended to be filed in (countries): None

Having elected to obtain rights in the subject invention and having complied with the requirements of Class Waiver W(C)91-004, Sandia Corporation can now acquire title to said invention. Now, therefore,

Assignment: The United States Government, as represented by the Department of Energy (the Assignor), co-owner of an undivided interest in and to the subject invention, hereby assigns and transfers to Sandia Corporation (the Assignee) its entire right, title and interest in and to said invention, patent applications, and resulting patents, except for a paid-up license to the U.S. Government (first Licensee) and such other rights required to be retained and reserved for the U.S. Government by operation of 41 C.F.R. 9-9.109-6, and a license to American Telephone and Telegraph Company (second Licensee) provided for under the above-identified contract.

Licenses: This document also confirms the paid-up license reserved to the U.S. Government (first Licensee) mentioned in the preceding paragraph. The license reserved for the American Telephone and Telegraph Company (second Licensee) by operation of the above-identified contract is described in Section (10) of this document.

Based on 41 C.F.R. 9-9.106-6, the rights reserved by the U.S. Government are the following:

(1) Government License and Inspection Rights

The Government retains an irrevocable, nonexclusive, nontransferable, paid-up license to practice or have practiced the subject invention throughout the world by or on behalf of the Government (including any Government agency).

The Government is hereby granted the irrevocable power to inspect and make copies of the above-identified patent application and any continuation or division thereof.

(2) Conveyance Terms and Conditions - Domestic

Subject to the minimum rights reserved to it in Section (9) below, Assignee (Sandia Corporation) agrees to reconvey to the Government, upon request, the entire domestic right, title, and interest in the subject invention when it:

- a) Decides not to continue prosecution of the patent application filed on the subject invention; or
- b) at any time, no longer desires to retain title in the subject invention.

(3) Conveyance Terms and Conditions - Foreign

a) Assignee (Sandia Corporation) agrees to reconvey to the DOE, upon request and subject to the minimum right reserved to it in Section (9) below, the entire right, title, and interest in and to the subject invention in any foreign country, in the event that Assignee:

(i) does not elect pursuant to Section (5) below to retain such rights in the foreign country; or

(ii) fails to have a patent application filed in the foreign country on said invention in accordance with Section (4) below, or decides not to continue prosecution or not to pay any maintenance fees covering the subject invention. To avoid forfeiture of the patent application of patent, the Assignee shall, not less than 60 days before the expiration period for any action required by the foreign Patent Office, notify the DOE Patent Counsel of such failure or decision, and deliver to the DOE Patent Counsel the executed instruments necessary for the conveyance specified in this section.

b) Conveyances requested pursuant to the above subparagraphs (3)(a)(i) and (3)(a)(ii) shall be made by delivering to the DOE Patent Counsel duly executed instruments and such other papers as are deemed necessary to vest in the Government the entire right, title, and interest in the invention to enable the Government to apply for and prosecute patent applications covering the subject invention in this or the foreign country, respectively, or otherwise establish its ownership of the invention.

(4) Filing of Patent Applications - Domestic

a) For every patent application, e.g., continuations, divisionals or reissues, filed by:

(i) Within 2 months after said filing, deliver to the DOE Patent Counsel a copy of the application as filed including the filing date and serial number;

(ii) include the following statement at the beginning of the specification of the application and any patents issued on the subject invention, "The Government has rights in this

invention pursuant to Contract No. DE-AC04-76DP00789 awarded by the U.S. Department of Energy";

(iii) provide the DOE Patent Counsel with a copy of any patent issued on the application within 2 months after such patent issues; and

(iv) not less than 30 days before the expiration of the response period for any action required by the Patent and Trademark Office, notify the DOE Patent Counsel of any decision not to continue prosecution of the application and deliver to the DOE Patent Counsel executed instruments granting the Government a power of attorney.

b) In the event that Assignee at any time prior to the filing of an application elects not to retain the rights waived, it shall inform the DOE Patent Counsel promptly and in writing of the date and nature of any existing or contemplated sale, placement on sale, public use, or public disclosure of the invention, such as may constitute a statutory bar under 35 U.S.C. 102.

(5) Filing of Patent Applications - Foreign

a) With respect to waived foreign rights to the above-identified invention, Assignee (Sandia Corporation) shall have patent applications filed on the invention in selected countries, in accordance with applicable statutes and regulations, and within one of the following periods:

(i) Eight (8) months from the date of the corresponding United States application;

(ii) Six (6) months from the date a license is granted by the Commissioner of Patents and Trademarks to file foreign applications where such filing has been prohibited by security reasons; or

(iii) such longer period as may be approved by the DOE Patent Counsel.

b) Assignee shall notify the DOE Patent Counsel promptly of each foreign application filed and upon written request shall furnish an English language version of the application without additional compensation.

(6) Other Terms and Conditions of Waived Rights

a) Assignee (Sandia Corporation) shall attempt to commercialize the subject invention within five years of the effective date of the election.

b) Assignee shall, three years after the aforesaid effective date of the waived rights to the invention, and at three-year intervals thereafter, and when specifically requested by DOE, furnish DOE a report setting forth:

(i) The commercial use that is being made, or is intended to be made, of the invention, and

(ii) the steps taken to bring the invention to the point of practical application or to make the invention available for licensing.

c) March-In Rights. Sandia Corporation agrees with respect to the subject invention in which it has acquired title, the DOE has the right, in accordance with procedures in 35 U.S.C. 203, 48 C.F.R. 27.304-1(g), 37 C.F.R. 401.6 and any supplemental regulations of the DOE, to require the Sandia National Laboratory (SNL), a further assignee or exclusive licensee of the subject invention to grant a nonexclusive, partially exclusive, or exclusive license in any field of use to a responsible applicant or applicants, upon terms that are reasonable under the circumstances; and if the SNL, its further assignee or exclusive licensee refuses such a request, the DOE has the right to grant such a license itself if the DOE determines that:

(i) Such action is necessary because Sandia or its assignee has not taken or is not expected to take, within a reasonable time, effective steps to achieve practical application of the subject invention in such field of use;

(ii) such action is necessary to alleviate health or safety needs which are not reasonably satisfied by the SNL, its assignee, or licensees;

(iii) such action is necessary to meet requirements for public use specified by Federal regulations and such requirements are not reasonably satisfied by the SNL, its assignee, or licensees; or

(iv) such action is necessary because the agreement required by 35 U.S.C. 204 has not been obtained or waived or because a licensee of the exclusive right to use or sell any subject invention in the United States is in breach of such agreement.

Sandia Corporation agrees with respect to the subject invention, the DOE has the right at the end of the 5 year period in which Sandia Corporation has agreed to attempt to commercialize the invention to require it to grant a nonexclusive, partially exclusive, or exclusive license in any field of use to a responsible applicant(s) upon terms that are reasonable under the circumstances, provided such grant does not cause a termination of licensee's right to use the invention; and, if Sandia refuses such request, the DOE has the right to grant such a license itself, if it determines that Sandia Corporation has not made a satisfactory demonstration that it or its licensee(s) is actively pursuing such commercialization.

Before requiring licensing under the above paragraph, DOE shall furnish Sandia Corporation a written notice of its intentions to require Sandia Corporation to grant the stated license, and Sandia Corporation shall be allowed 30 days (or such longer period as may be authorized by the Contracting Officer for good cause shown in writing by the SNL) after such notice to show cause why the license should not be required to be granted.

(7) Preference for United States Industry.

In the interest of enhancing U.S. competitiveness, Assignee (Sandia Corporation) shall, in its licensing of the subject invention, give preference in such a manner as to enhance the accrual of economic and technological benefits to the U.S. domestic economy. Assignee shall consider the following factors in all its licensing decisions:

- (a) Whether any resulting design and development will be performed in the U.S. and whether resulting products, embodying parts, including components thereof, will be substantially manufactured in the U.S.; or
  - (i) whether the proposed licensee has a business unit located in the U.S. and whether significant economic and technical benefits will flow to the U.S. as a result of the license agreement; and, further
  - (ii) whether in licensing an entity subject to the control of a foreign company or government, such foreign company and government permit U.S. agencies, organizations, or other persons to enter into cooperative R&D agreements and licensing agreements, and have policies to protect U.S. intellectual property rights.

If Assignee determines that neither of the above two sets of conditions is likely to be fulfilled, Assignee, prior to entering into such an agreement, must obtain the approval of the appropriate Department of Energy contracting officer. The contracting officer shall act on any such request for approval within thirty (30) days.

- b) Furthermore, as provided by 35 U.S.C. 210 and 35 U.S.C. 204, Assignee or any of its licensees shall not grant to any person the exclusive right to use or sell said subject invention in the United States unless such person agrees that any products embodying the subject invention or produced substantially through the use of the subject invention will be manufactured substantially in the United States. However, the requirement for such an agreement may be waived by DOE upon a showing by the entity or assignee that reasonable but unsuccessful efforts have been made to grant licenses on similar terms to potential licensees that would be likely to manufacture substantially in the United States or that under the circumstances domestic manufacture is not commercially feasible.

(8) Terminations

- a) Any right waived to Assignee (Sandia Corporation) in connection with the subject invention, or retained by Assignee may, subject to the minimum rights reserved in Section (9) below, be terminated, in whole or in part, at the discretion of the Secretary of Energy, if the request for the obtention or retention of the rights has not disclosed material facts or is found to contain false material statements specifically relied upon in granting the waiver or reaching the agreement for the retention of rights by Assignee.

- b) Any waiver of rights to the subject invention, may be terminated, in whole or in part, at the discretion of the DOE Secretary or his designee, if Assignee fails to comply with the provisions set forth in Sections (4), (6), and (7), herein, and such failure is determined by the Secretary or his designee to be material and detrimental to the interests of the United States and the general public.
- c) Prior to terminating any waived rights under Section (8)(a) or (8)(b) of this document, Assignee will be given written notice by Assignor of the intention to terminate said rights, the extent of such proposed termination, and the reasons therefor, and a period of 30 days, or such longer period as the Secretary or his designee shall determine for good cause shown in writing, shall be set by Assignor for Assignee to show cause why waived rights should not be so terminated.
- d) All terminations of waived rights under Section (8)(a) shall be subject to the rights granted in Section (9) below, and termination shall normally be partial in nature, requiring the Assignee to grant non-exclusive or partially exclusive licenses to responsible applicants upon terms reasonable under the circumstances.

(9) Minimum License

In the event that rights, title, and interest in and to the subject invention are reconveyed to the U.S. Government pursuant to Sections (2) and (3) above, Assignee shall retain an irrevocable, nonexclusive, paid-up license in each patent application filed in any country on the and in any resulting patent in which the Government acquires title. The license shall extend to the Assignee's domestic subsidiaries and affiliates, if any, within the corporate structure of which the Assignee is a part and shall include the right to grant sublicenses of the same scope to the extent the Assignee was legally obligated to do so at the time the contract was awarded. The license shall be transferable only with approval of DOE except when transferred to the successor of that part of the Assignee's business to which the invention pertains.

It is understood and agreed that this license does not preclude the Government from asserting rights under the provisions of said contract or of any other agreement between the Government and the Assignee, or any other rights of the Government with respect to the above-identified invention.

(10) The American Telephone and Telegraph Company License

The American Telephone and Telegraph Company (second licensee) has a nonexclusive, nontransferable, irrevocable, paid-up license under each patent application or patent in any country, to practice or have practiced the subject invention for or on behalf of any of the companies in its corporate family. This license exists by virtue of contract DE-AC04-76DP00789 and is not affected by any transaction that may occur according to the present document.



APPROVED AND GRANTED on behalf of the Government of the United States on this  
\_\_\_\_ day of \_\_\_\_\_, 1997.

UNITED STATES DEPARTMENT OF ENERGY  
(Assignor)

\_\_\_\_\_  
Paul A. Gottlieb  
Assistant General Counsel for Patents

WITNESS: \_\_\_\_\_

APPROVED, ACCEPTED, AND CONSENTED TO this 3<sup>RD</sup> day of JUN, 1997.

SANDIA CORPORATION (Assignee)

\_\_\_\_\_  
Timothy D. Stanley  
Patent Counsel  
Patent and Licensing Office, 11500  
Sandia National Laboratories  
Albuquerque, NM 87185-0161

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