

FORM PTO-1619A
Expires 08/30/99
OMB 0651-0027

04-26-2000



101333340

U.S. Department of Commerce
Patent and Trademark Office
PATENT

RECORDATION FORM COVER SHEET

PATENTS ONLY

MRD 4.3.00

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

Submission Type

- ☒ New
☐ Resubmission (Non-Recordation)
Document ID#
☐ Correction of PTO Error
Reel # Frame #
☐ Corrective Document
Reel # Frame #

Conveyance Type

- ☒ Assignment ☐ Security Agreement
☐ License ☐ Change of Name
☐ Merger ☐ Other
U.S. Government
(For Use ONLY by U.S. Government Agencies)
☐ Departmental File ☐ Secret File

Conveying Party(ies)

☐ Mark if additional names of conveying parties attached Execution Date
Month Day Year

Name (line 1) Sandia Corporation

3 22 00

Name (line 2)

Second Party

Name (line 1)

Execution Date
Month Day Year

Name (line 2)

Receiving Party

☐ Mark if additional names of receiving parties attached

Name (line 1) The University of Dayton

Name (line 2)

☐ 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.)

Address (line 1) 300 College Park

Address (line 2)

Address (line 3) Dayton

OH

45469

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)

FOR OFFICE USE ONLY

04/26/2000 JSHARRAZZ 000000:9 19410885

01 FC:581

06.00 111

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 Practices. DO NOT SEND REQUESTS TO RECORD ASSIGNMENT DOCUMENTS TO THIS ADDRESS.

Mail documents to be recorded with required cover sheet(s) information to:
Commissioner of Patents and Trademarks, Box Assignments, Washington, D.C. 20231

PATENT

REEL: 010721 FRAME: 0153

Correspondent: Name and Address

Area Code and Telephone Number **(937) 223-2050**

Name **Killworth, Gottman, Hagan & Schaeff, L.L.P.**

Address (line 1) **One Dayton Centre, Suite 500**

Address (line 2) **One South Main Street**

Address (line 3) **Dayton, Ohio 45402-2023**

Address (line 4)

Pages

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

7

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)

09/410,885

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

PCT

PCT

PCT

PCT

PCT

Number of Properties

Enter the total number of properties involved.

1

Fee Amount

Fee Amount for Properties Listed (37 CFR 3.41): \$ **40.00**

Method of Payment:

Deposit Account

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

Enclosed ☒

Deposit 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.

James E. Beyer

Name of Person Signing

Signature

3/30/00

Date

PATENT
REEL: 010721 FRAME: 0154

ASSIGNMENT AGREEMENT

This Agreement, by and between Sandia Corporation (hereinafter referred to as "SANDIA"), a Delaware corporation and the University of Dayton, a non-profit corporation of the State of Ohio, with a place of business at 300 College Park, Dayton, Ohio 45469 (hereinafter referred to as "CONTRACTOR").

WITNESSETH THAT:

WHEREAS, Thomas J. Kulp, while employed by SANDIA, and Peter E. Powers, while employed by CONTRACTOR, and working under SANDIA contract LG-3773, jointly made an invention relating to optical parametric amplification;

WHEREAS, the undivided right, title, and interest of Thomas J. Kulp in and to said invention was assigned on 5/26/99 to SANDIA in accordance with DOE class waiver W (c) 93-012;

WHEREAS, pursuant to the terms and conditions of contract LG-3773, CONTRACTOR elected to retain title to the undivided right, title, and interest of Peter E. Powers in and to said invention;

WHEREAS, CONTRACTOR has filed a patent application in the U.S. Patent and Trademark Office on said invention;

WHEREAS, it is the goal of SANDIA and CONTRACTOR to promote the utilization of inventions arising from federally supported research or development;

WHEREAS, to achieve the mutual goal of SANDIA and CONTRACTOR, SANDIA desires to assign and CONTRACTOR desires to acquire the entire right, title, and interest of SANDIA in and to said invention; and

WHEREAS, this Agreement is authorized by law including P.L. 96-517, P.L. 98-620, and P.L. 99-502.

NOW, THEREFORE, in consideration of the premises, and the agreements, covenants and conditions herein contained, the parties agree as follows:

I. DEFINITIONS

a. "THE ASSIGNED INVENTION" means the invention described and claimed in U.S. patent application Serial No. 09/410,885, filed 10/04/99, entitled "Tunable Pulsed Narrow Bandwidth Light Source," and any patent or patents issued thereon, including all divisions, continuations, reissues or extensions thereof.

b. "ROYALTIES OR OTHER INCOME" means gross royalties or other income resulting from the ownership, assignment, licensing, or other commercialization of THE ASSIGNED INVENTION, less the attorney fees, patent application and patent fees incurred by CONTRACTOR in filing, prosecuting and maintaining THE ASSIGNED INVENTION, fees,

PATENT
REEL: 010721 FRAME: 0155

commissions or payments paid by CONTRACTOR to any third party as a direct cost of assigning or licensing THE ASSIGNED INVENTION and costs incurred by CONTRACTOR directly related to the enforcement of THE ASSIGNED INVENTION, provided that none of the above fees, commissions, payments or costs are paid for or are reimbursed by SANDIA.

II. ASSIGNMENT GRANT

SANDIA hereby assigns to CONTRACTOR its entire right, title and interest in and to THE ASSIGNED INVENTION, reserving to the Government of the United States a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced on behalf of the United States THE ASSIGNED INVENTION throughout the world.

III. COSTS

a. CONTRACTOR shall pay all fees or costs, including patent application filing fees, prosecution fees and patent maintenance fees, licensing fees or commissions, and any other costs incurred by CONTRACTOR relating to THE ASSIGNED INVENTION.

b. CONTRACTOR agrees not to abandon any patent application or cease to pay maintenance fees on any patent on THE ASSIGNED INVENTION without providing SANDIA written notice at least ninety (90) days before the expiration of any time period in which action must be taken to prosecute the patent application or in which a maintenance fee must be paid without extra fee or surcharge. CONTRACTOR further agrees, upon request and at no cost to SANDIA, to assign to SANDIA or other party whom SANDIA directs the entire right, title and interest in and to any such patent application or patent in which CONTRACTOR intends to abandon or to cease to maintain.

IV. CONSIDERATION

CONTRACTOR agrees to pay SANDIA fifty percent (50%) of any ROYALTIES OR OTHER INCOME received by CONTRACTOR. CONTRACTOR will pay within sixty (60) days after June 30, 2000 the share of ROYALTIES OR OTHER INCOME accruing to SANDIA based upon monies received by CONTRACTOR as of that date, and CONTRACTOR at the conclusion of each twelve (12) month interval thereafter will pay within sixty (60) days after June 30 the share of ROYALTIES OR OTHER INCOME accruing to SANDIA from monies received by CONTRACTOR during the period from July 1 - June 30 immediately past. Each payment shall include an accounting and description of all ROYALTIES OR OTHER INCOME received. If no payment is owing, the accounting shall so state. CONTRACTOR shall maintain for five years, books of account showing all ROYALTIES OR OTHER INCOME received or receivable. SANDIA may inspect the books during normal business hours upon reasonable request.

All checks for payments shall be made out to "SANDIA CORPORATION-Assistant Treasurer, Org. 1057" and mailed to:
Sandia Corporation, Attention M. A. Freudendahl, Org. 8709, 7011 East Avenue, MS: 9017,
Livermore, CA 94550.

V. TERM

This Agreement will have force and effect until all patents on THE ASSIGNED INVENTION have expired, except, however, that CONTRACTOR's obligation to pay ROYALTIES OR OTHER INCOME under Article IV shall continue for as long as ROYALTIES OR OTHER INCOME are received by CONTRACTOR.

VI. ADDITIONAL REQUIRED PROVISIONS UNDER 35 U.S.C. 202(c)

This Agreement is made subject to the policies, rights and obligations of the parties set forth in Title 35, United States Code, Chapter 18, including, but not limited to, the following:

a. CONTRACTOR may not assign its right in THE ASSIGNED INVENTION without prior written approval of SANDIA, except to an organization which has as one of its primary functions the management of inventions, provided that such assignee shall be subject to the terms and conditions of this Agreement.

b. CONTRACTOR will share ROYALTIES OR OTHER INCOME with the CONTRACTOR employee co-inventor. The balance of any ROYALTIES OR OTHER INCOME earned by CONTRACTOR with respect to THE ASSIGNED INVENTION, after payment of expenses (including payments to inventors) incidental to the administration of THE ASSIGNED INVENTION, shall be utilized for the support of scientific research or education.

c. CONTRACTOR will make efforts that are reasonable under the circumstances to attract licensees of THE ASSIGNED INVENTION that are small business firms as set forth in Federal Acquisition Regulation 52.227-11(k)(4).

d. The assignment grant of Article I is made subject to the march-in rights of DOE under 35 U.S.C. 203.

e. Unless waived by DOE under the provisions of 35 U.S.C. 204, an exclusive right to make, use or sell THE ASSIGNED INVENTION shall not be granted to any person or entity unless such person or entity agrees that any products embodying THE ASSIGNED INVENTION or produced through the use of THE ASSIGNED INVENTION will be manufactured substantially in the United States.

f. DOE Prime Contract Mandates: See Attachment A.

VII. EXCLUSIONS

a. Enforcement of any patent on THE ASSIGNED INVENTION against third party infringers shall solely be the responsibility of CONTRACTOR and not SANDIA or the United States Government. The extent of enforcement, if any, shall be at the sole discretion of CONTRACTOR.

b. Neither CONTRACTOR nor SANDIA warrants the validity of any patent on THE ASSIGNED INVENTION or scope of the claims, or that practice of THE ASSIGNED INVENTION will not result in infringement of any existing patent.

c. This Agreement shall not be construed to confer on CONTRACTOR any immunity from the antitrust laws or from a charge of patent misuse.

d. CONTRACTOR agrees not to create the appearance that SANDIA or the Government of the United States endorses or warrants THE ASSIGNED INVENTION or any resulting product or service. SANDIA and the Government of the United States shall not be connected directly or impliedly with any advertising or promotional program for THE ASSIGNED INVENTION or any resulting product or service, except that it may be generally stated that THE ASSIGNED INVENTION has been obtained in part by assignment from SANDIA.

VIII. ADDRESSES

The address for SANDIA for receiving payments, notices, reports and for any other purpose under this Agreement is:

Sandia Corporation
Attention: M. A. Freudendahl
Organization 8709
Reference: License #00-C00853
701 East Avenue, MS: 9017
Livermore, CA 94550
Telephone: (925) 294-3065
Facsimile: (925) 294-1339

The address for CONTRACTOR for this Agreement is:

University of Dayton
Technology Partnerships Office
300 College Park
Dayton, OH 45469-0102

IX. EFFECTIVE DATE

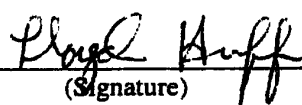
This Agreement shall have an effective date of the later of the dates of the following signatures by the authorized representatives of CONTACTOR and SANDIA.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed by their duly authorized representatives.

FOR SANDIA CORPORATION

By 
(Signature)Name T. Michal DyerTitle Director, Materials &
Engineering Sciences CenterDate 3/22/00

THE UNIVERSITY OF DAYTON

By 
(Signature)Name Lloyd Huff, Ph.D.
Associate Director/Title Authorized RepresentativeDate 3-27-00

ATTACHMENT A**SANDIA PRIME CONTRACT MANDATES**

- 1.1 Compulsory Licensing (I-57(c)(1)(ii)) - The parties acknowledge DOE has certain march-in rights to any ASSIGNED INVENTION in accordance with 10 CFR Part 784.
- 1.2 Reports (I-57(c)(1)(iii)) - Upon request, CONTRACTOR agrees to submit annually a report on the utilization of ASSIGNED INVENTIONS. The report shall include the status of development of products embodying Inventions, date of first commercial sale or use, royalties received on sales or use of Inventions, and such other data as SANDIA may reasonably specify. CONTRACTOR shall provide additional reports as requested by DOE in connection with Compulsory Licensing herein above.
- 1.3 Government Sales (I-57(c)(1)(iv)) - With respect to sales to the Government or government contractors, CONTRACTOR agrees, and shall require its assignees and sublicensees to agree (a) not to charge royalties based on ASSIGNED INVENTIONS; and (b) to refund to the Government any royalties received based on ASSIGNED INVENTIONS.
- 1.4 Government License (I-57(c)(1)(v)) - The U.S. Government shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced ASSIGNED INVENTIONS throughout the world by or on behalf of the Government of the United States (including any Government agency).
- 1.5 Government Disclaimer (I-57(o)) - The U.S. Government is neither a party to nor assumes any liability for activities of SANDIA in connection with licenses under this Assignment Agreement.
- 1.6 Substantial Manufacture in the U.S. (I-130(f), I-57(c)(1)(ii)(d)).
 - 1.6.1 CONTRACTOR agrees any products embodying a ASSIGNED INVENTION that are used, offered for sale or sold by CONTRACTOR, its licensees, or assignees will be substantially manufactured in the United States.
 - 1.6.2 CONTRACTOR agrees any products produced through the use of an ASSIGNED INVENTION that are used, offered for sale or sold by CONTRACTOR, its licensees, or assignees will be substantially manufactured in the United States.
 - 1.6.3 DOE may waive these requirements upon such terms as it may establish in its sole discretion.
- 1.7 Indemnity (I-130(g) non-CRADA version) - If CONTRACTOR, its sublicensees or assignees makes, uses or sells a product, process or service covered by a claim of a patent application corresponding to the ASSIGNED INVENTION, CONTRACTOR shall indemnify SANDIA and the U.S. Government for all damages, costs, and expenses, including attorneys' fees, arising from personal injury or property damage occurring as a result of making, using or selling said product, process or service.