

5A-01

05-10-2001



Tab settings

101713116

To the Honorable Commissioner of Patents and Trademarks, attached original documents or copy thereof.

1. Name of conveying party(ies):
**UNITED STATES AIR FORCE
DEFENSE MICROELECTRONICS ACTIVITY
4234 -- 54TH STREET (BLDG. 620)
McCLELLAN AIR FORCE BASE, CA 95652**

Additional names(s) of conveying party(ies) Yes No

2. Name and address of receiving party(ies):

Name: **SACRAMENTO MUNICIPAL UTILITY DISTRICT**
Internal Address: **c/o DANA APPLING,
GENERAL COUNSEL**

3. Nature of conveyance:
 Assignment Merger
 Security Agreement Change of Name
 Other _____

Execution Date: **MAY 15, 2000**

Street Address: **6201 "S" STREET**

City: **SACRAMENTO** State: **CA** ZIP: **95852**

Additional name(s) & address(es) attached? Yes No

4. Application number(s) or registration numbers(s):
If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s)
08/690,581

B. Patent No.(s)
5,994,892

Additional numbers attached? Yes No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: **JOHN P. O'BANION, REG. NO. 33,201**
Internal Address: **O'BANION & RITCHEY LLP**

05/10/2001 GTOM11 00000128 08690581
01 FC:581 40.00 DP

Street Address: **400 CAPITOL MALL, SUITE 1550**

City: **SACRAMENTO** State: **CA** ZIP: **95814**

6. Total number of applications and patents involved: **1**

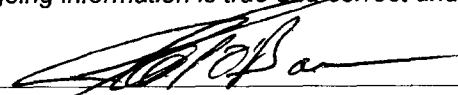
7. Total fee (37 CFR 3.41):.....\$ **40.00**

Enclosed - Any excess or insufficiency should be credited or debited to deposit account
 Authorized to be charged to deposit account

8. Deposit account number:
07-1137

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.

JOHN P. O'BANION  **5/1/01**
Name of Person Signing Signature Date

Total number of pages including cover sheet, attachments, and document: **7**

ASSIGNMENT AGREEMENT

This Assignment Agreement ("Agreement") is by and between the Government of the United States of America, as represented by the Director of Defense Microelectronics Activity, (hereinafter referred to as "DMEA"), and the Sacramento Municipal Utility District ("SMUD").

WITNESSETH THAT:

WHEREAS, The United States Air Force ("USAF") entered a Cooperative Research Development Agreement number 94-SM-15 (hereafter "CRDA"), a copy of which is attached hereto as Exhibit A and, by this reference, made a part hereof, on or about September 8, 1994 and it is the intent of the parties that this Agreement be construed to be consistent with said CRDA;

WHEREAS, the interests of the USAF in the aforementioned CRDA were fully assumed by DMEA in or about April 1997;

WHEREAS, Keith Bergevin, Daniel Opperman and Anthony Werner while employed by the USAF's Sacramento Air Logistics Center and its successor entity, DMEA, with the collaboration of SMUD and its then-employee, Thomas R. Turino, jointly made and/or created, pursuant to the CRDA, an invention entitled an INTEGRATED CIRCUIT DESIGN AUTOMATIC UTILITY METER: APPARATUS & METHOD, described in U.S. Patent Serial No. 08/690,581 and filed 31 July 1996;

WHEREAS, Keith Bergevin, Daniel Opperman and Anthony Werner, independently created certain intellectual property (including, without limitation, certain "source codes") in conjunction with the invention;

WHEREAS, the entire right, title and interests of Keith Bergevin, Daniel Opperman and Anthony Werner in and to said invention and related intellectual property, including foreign rights, are assigned to DMEA;

WHEREAS, the entire right, title and interests of Thomas R. Turino in and to said invention, including foreign rights, are assigned to SMUD;

WHEREAS, pursuant to the terms and conditions of the CRDA, SMUD elected to retain title in and to said invention, and to the interests of Keith Bergevin, Daniel Opperman and Anthony Werner;

WHEREAS, SMUD, on or about 31 July 1996, filed a patent application for the invention in the U.S. Patent and Trademark Office and the Patent Cooperation Treaty Countries;

WHEREAS, SMUD, in December 1998, permitted Thomas R. Turino to pursue such patent protection of THE ASSIGNED INVENTION, and said action was acceptable to DMEA;

WHEREAS, U.S. Patent No. 5,994,892 was issued by the United States Patent and Trademark Office, naming Thomas R. Turino, Keith Bergevin, Daniel Opperman, and Anthony Warner [sic] as Inventors of an INTEGRATED CIRCUIT DESIGN AUTOMATIC UTILITY METER: APPARATUS & METHOD, and naming SMUD as the Assignee;

WHEREAS, DMEA filed but later withdrew patent applications for the aforementioned "source codes" in the U.S. Patent and Trademark Office;

WHEREAS, it is the goal of DMEA and SMUD through this Agreement to promote the utilization of said invention, which arose from federally supported research or development;

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

WHEREAS, this Agreement is authorized by law including P.L. 96-5 17, P.L. 98-620, P.L. 99-502 and 35 USC 202(e);

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

I. DEFINITIONS

- a. "THE ASSIGNED INVENTION" means U.S. Patent No. 5,994,892 entitled an INTEGRATED CIRCUIT DESIGN AUTOMATIC UTILITY METER: APPARATUS & METHOD, as well as the invention described in U.S. Patent Application Serial No. 08/690,581 filed 31 July 1996, and any U.S. or foreign patent or patents issued thereon, including all divisions, continuations, continuations-in-part (subject to any intervening rights), if any, reissues or extensions thereof. It also includes any other process or device conceived of, reduced to practice or developed by DMEA or its predecessor entities related to said apparatus and method, including any "source codes" and all items listed in Exhibit B attached hereto which, by this reference, is made a part hereof.
- b. "COLLABORATOR" shall mean SMUD or its successor or a DMEA-approved assign.
- c. "Effective date of the Agreement" means the later of the dates of execution of this Agreement by the authorized representative of DMEA and SMUD.

II. ASSIGNMENT GRANT

DMEA hereby assigns to SMUD its entire right, title and interest throughout the world 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 throughout the world.

III. COSTS AND CONDITIONS OF REASSIGNMENT

- a. DMEA shall not be required to pay any U.S. or foreign fees or costs, including patent application filing fees, prosecution fees, maintenance fees, licensing fees or any other costs incurred relating to patenting of THE ASSIGNED INVENTION.
- b. SMUD filed a patent application on THE ASSIGNED INVENTION, for which U.S. Patent No. 5,994,892 issued on November 30, 1999.
- c. COLLABORATOR will not cease to pay maintenance fees on any patent on THE ASSIGNED INVENTION without providing DMEA written notice at least sixty (60) days before the expiration of any time period in which a maintenance fee must be paid without extra fee or surcharge. COLLABORATOR further agrees, upon request and at no cost to DMEA, to assign to DMEA, or other party whom DMEA directs, the entire right, title and interest in THE ASSIGNED INVENTION if the COLLABORATOR announces its intention to cease to maintain any patent based on THE ASSIGNED INVENTION.

IV. CONSIDERATION

- a. On or before 31 December of each year following the effective date of this Agreement, COLLABORATOR will pay to DMEA one dollar (\$1.00) for each utility meter sold, leased, or used by the COLLABORATOR in the preceding twelve-month period that utilizes the invention claimed in U.S. Patent No. 5,994,892.
- b. All payments to DMEA under this Article shall be made by check payable to "Defense Microelectronics Activity" and mailed to DMEA/MEOP Funding, 4234 54th Street, BLDG 620, McClellan AFB, CA 95652-1521.
- c. Each payment shall include an accounting and description of all royalties or other income received, and, if no payment is owing, the accounting shall so state. COLLABORATOR shall maintain for five years, books of account showing all royalties or other income

received or receivable. DMEA may inspect the books during normal business hours upon reasonable request.

- d. SMUD's payment obligation shall cease upon the assignment of its entire right, title and interest to THE ASSIGNED INVENTION to a person or entity approved by DMEA, which approval shall not be unreasonably withheld.

V. TERM

This Agreement will have force and effect until all patents on THE ASSIGNED INVENTION have expired, except, however, that a COLLABORATOR's obligations to pay royalties or other income shall continue for so long as royalties or other income are received by that COLLABORATOR.

VI. EXCLUSIONS

- a. Enforcement of any patent on THE ASSIGNED INVENTION against third-party infringers shall solely be the responsibility of COLLABORATOR and not DMEA or the United States Government. The extent of enforcement, if any, shall be at the sole discretion of COLLABORATOR. Any recoveries made as a result of said enforcement shall be shared with DMEA consistent with the terms set forth in Article IV.
- b. Neither COLLABORATOR nor DMEA 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 COLLABORATOR any immunity from the antitrust laws or from a charge of patent misuse.
- d. COLLABORATOR agrees not to create the appearance that DMEA or the Government of the United States endorses or warrants THE ASSIGNED INVENTION or any resulting product or service. DMEA 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 DMEA.

VII. ADDRESSES

The address for DMEA for receiving notices, reports and for any other purposes under this Agreement is:

DMEA Office of Research and Technology Application
4234 54th Street, Building 620
McClellan AFB, CA 95652-1521

The address for SMUD for this Agreement is:

Sacramento Municipal Utility District
c/o Dana Appling, General Counsel
6201 "S" Street
Sacramento, CA 95852-1830

The address for any party may be changed upon written notice from a party to the other party.

VIII. EFFECTIVE DATE

This Agreement shall have an effective date of the later of the following signatures by DMEA and SMUD.

IX. MISCELLANEOUS PROVISIONS

- a. As used in this Agreement, words in the singular include the plural and words in the plural include the singular; words in the masculine or neutral genders include the masculine, feminine and neutral.
2. The descriptive heading for each Article herein shall not affect the interpretation or legal efficacy of this Agreement.
3. This Agreement shall be administered, construed and enforced according to, and governed by, the laws of the United States of America.
4. If any term or provision of this Agreement, or the application thereof to any person or circumstance shall, to any extent, be invalid or unenforceable, the remainder of this Agreement, or the application of such term or provision to persons or circumstances other than those as to which it is held invalid or unenforceable, shall not be affected thereby,

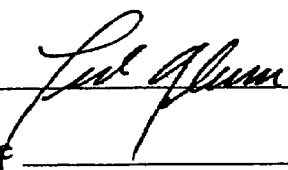
and each term and provision of this Agreement shall be valid and enforced to the fullest extent permitted by law.

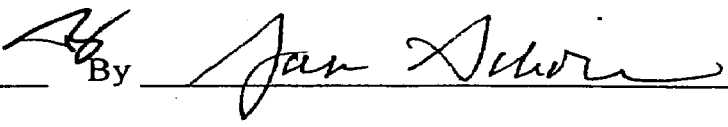
- e This Agreement shall, to the greatest extent possible, be read to give effect to all of its provisions.
- f This Agreement constitutes the sole and entire understanding of the parties hereto with respect to its subject matter and supersedes any previous agreements entered into with respect to these topics.
- g. There are no intended third-party beneficiaries to this Agreement.
- h. This Agreement may be executed in two or more counterparts, with the same effect as if all signatures on such counterparts appeared on one document, each of which will be deemed an original, but all of which together shall constitute one and the same instrument.

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

FOR THE GOVERNMENT OF THE
UNITED STATES

FOR THE SACRAMENTO MUNICIPAL
UTILITY DISTRICT

By 
Title _____

By 
Title Jan Schori, General Manager

Date MAY 04 2000

Date May 15, 2000

TED J. GLUM
Director
Defense Microelectronics Activity