

05-30-2001

TO: Honorable Commissioner of Patents
BOX ASSIGNMENT/FEE
Washington, DC 20231



MAY 2001

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Please record the attached original document(s) or copy(ies) thereof.

1. NAME OF PARTY(IES) CONVEYING AN INTEREST:

E.I. du Pont de Nemours and Company
and
The University of Houston System

Additional name(s) of conveying party(ies)
attached?

☐ Yes ☒ No

2. NAME AND ADDRESS OF RECEIVING PARTY(IES):

NAME: University of Houston System
INTERNAL ADDRESS:
STREET ADDRESS: 4800 Calhoun Road
CITY: Houston
STATE/ZIP CODE: Texas, 77204

Additional name(s) and address(es)
attached?

☐ Yes ☒ No

3. NATURE OF CONVEYANCE:

☒ Donation Agreement

☒ Date of Execution: January 2, 2001

med
5-22-01

4. APPLICATION NUMBER(S) OR PATENT NUMBER(S): If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s):

Additional numbers attached?

☐ Yes ☒ No

B. Patent Registration No.(s):

4,444,989 issued 04/24/1984
4,452,909 issued 06/05/1984
4,843,057 issued 06/27/1989
4,935,574 issued 06/19/1990

Additional numbers attached?

☐ Yes ☒ No

168E

5. NAME AND ADDRESS OF PARTY TO WHOM CORRESPONDENCE CONCERNING DOCUMENT SHOULD BE MAILED:

William B. Nash
Jackson Walker, LLP
112 E. Pecan, Suite 2100
San Antonio, Texas 78205

6. TOTAL NUMBER OF APPLICATIONS AND PATENTS INVOLVED: 4 (\$40.00/each)**7. TOTAL FEE (37 CFR 3.41):** \$160.00

☒ Enclosed

☐ Authorized to Charge Account No. 07-2400.

8. DEPOSIT ACCOUNT NUMBER 07-2400.

(Attach duplicate copy of this form 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.

William B. Nash

WILLIAM B. NASH

May 18, 2001
DATE

INTELLECTUAL PROPERTY DONATION AGREEMENT

This Agreement, effective as of the last date of execution hereof between the parties (the "Effective Date"), is by and between:

E. I. du Pont de Nemours and Company, a corporation of the State of Delaware having its principal place of business at 1007 Market Street, Wilmington, Delaware 19808 (hereinafter "DuPont"),

and

the University of Houston System, an agency of the State of Texas, pursuant to Chapter 111, Texas Education Code, having its principal offices at 4800 Calhoun Road, Houston, Texas, 77204 (hereinafter "UH").

Article 1—Background

- 1.1 DuPont is the owner of certain patents, patent applications, and incidental Know-How pertaining to the conversion of toluene and methanol into paraxylene (the "Toluene Methylation Technology", or "Technology"), which has utility in the chemical industry. UH is engaged in the research, development, and dissemination of technologies related to the chemical industry.
- 1.2 DuPont is willing to donate its patents, patent applications, and Know-How pertaining to the Technology to UH. In turn, UH is willing to accept the DuPont donation, further develop the Technology, and maintain the Patent Rights for a minimum period of at least two (2) years following the Effective Date. Accordingly, DuPont and UH agree to the donation, subject to the terms and conditions set forth in this Agreement.

Article 2—Definitions

As used herein, the term:

- 2.1 "Patent Rights" means the patents and patent applications listed in **Appendix A**.
- 2.2 "Know-How" means DuPont's trade secrets related to the Technology, including technical information in DuPont's possession on the Effective Date that it is free to disclose to UH. The Know-How is summarized in the reports listed in **Appendix B**.

Article 3—Assignment of Rights

- 3.1** DuPont hereby assigns its entire right, title and interest in the Patent Rights to UH. Such assignment to UH includes DuPont's right to enforce Patent Rights and to recover damages for any infringement retroactively to the issue date of any patent included in Patent Rights. DuPont shall execute such further documentation as may be reasonably furnished by UH to record title of the Patent Rights in UH, at UH's expense.
- 3.2** DuPont further conveys to UH its entire right, title, and interest in Know-How disclosed to UH hereunder. Accordingly, DuPont will neither use the Know-How, nor disclose the Know-How to others for use, after the Effective Date.

Article 4—DuPont Assistance

- 4.1** DuPont will make its employees familiar with the Technology available to UH during calendar year 2000 and the first six (6) months of calendar year 2001, at times and locations to be agreed upon that are convenient for both parties, in order to assist UH in the transmission of the Know-How.
- 4.2** DuPont shall cooperate with UH in the preparation, filing, and prosecution of (i) patent application(s) relying in whole or in part on the filing dates of the Patent Rights for priority, and (ii) such other patent application(s) as UH may elect to file on inventions contained in the Know-How. UH shall have sole discretion in the preparation, filing, and prosecution of these patent applications, and shall bear all costs associated therewith, as of the Effective Date. UH shall reimburse DuPont for any out-of-pocket costs incurred by DuPont, at UH's request, pursuant to this **Article 4.2**.
- 4.3** Prior to or promptly after execution of this Agreement, UH shall inform DuPont of the individual or law-firm assuming responsibility for administration of the Patent Rights. DuPont shall deliver files pertaining to the Patent Rights in a timely manner in order that UH can (i) prepare such documents it desires to evidence the assignment and (ii) undertake orderly administration of the Patent Rights, including, without limitation, prosecution of pending patent applications as UH deems appropriate.
- 4.4** DuPont shall cooperate with UH to the extent that DuPont's cooperation may be required in the enforcement or defense of any Patent Rights, or of any patents obtained pursuant to the preceding paragraph. Such assistance shall be provided at times and in a manner that is not unduly disruptive of DuPont's normal course of business. UH shall reimburse DuPont for the time spent by DuPont employees in these activities requested by UH, and for DuPont's out-of-pocket costs including any necessary travel expenses or accommodation.

Article 5—Warranties and Liability

- 5.1** DuPont warrants that it owns and has good title to the Patent Rights. DuPont is not aware of any claim, or written threat of claim, that the practice of the Patent Rights would infringe third party patents or other intellectual property rights. Except as set forth above, DuPont makes no warranties with respect to freedom from alleged infringement of third party patents, or freedom from third party infringers. DuPont shall not be under any obligation to hold UH or future licensees, assignees or transferees of UH harmless against alleged infringement of third party patents.
- 5.2** DuPont assumes no responsibility whatsoever with respect to the practice of the Know-How and/or Patent Rights by UH or UH's licensees, assignees, or transferees. To the extent authorized by law, UH hereby indemnifies and holds DuPont harmless from any loss, claim, lawsuit, damage to property or the environment, illness or injury (including death), to any person or property, whatever the cause, arising out of or pertaining to the use or practice of the Know-How and/or Patent Rights by UH, its officers, employees and agents after the Effective Date. UH also agrees to require all of UH's future licensees, assignees or transferees to indemnify UH and DuPont for any loss, claim, lawsuit, damage to property or the environment, illness or injury (including death), to any person or property, whatever the cause, arising out of or pertaining to the use or practice of the Know-How and/or Patent Rights donated to UH by DuPont.

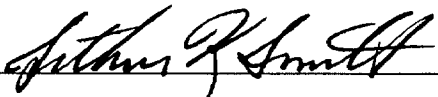
Article 6—Miscellaneous

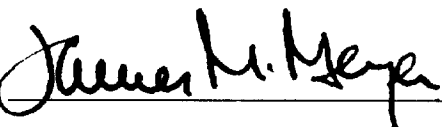
- 6.1** This Agreement shall be governed by the laws of the State of Texas, which shall also be the forum for any disputes arising hereunder.
- 6.2** This Agreement supersedes the confidentiality agreement between the parties dated November 2, 2000, which hereby is null and void.
- 6.3** This Agreement constitutes the entire agreement between the parties concerning the subject matter hereof. No amendment shall be effective unless in writing, signed by both parties hereto.

6.4 The parties have caused this Agreement to be signed in duplicate by their duly authorized representatives on the dates set forth below.

University of Houston System

E. I. du Pont de Nemours and Company

By: 

By: 

Printed Name: Dr. Arthur K. Smith

Printed Name: Dr. James M. Meyer

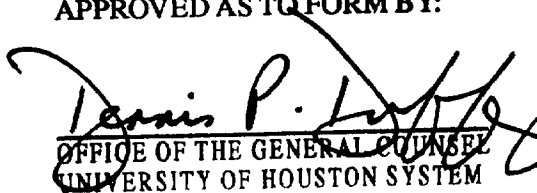
Title: Chancellor, University of Houston System
and President, University of Houston

Title: Vice President, CR & D

Date: 12-7-00

Date: 01-02-01

APPROVED AS TO FORM BY:

 12-7-2000
OFFICE OF THE GENERAL COUNSEL
UNIVERSITY OF HOUSTON SYSTEM

**APPENDIX A
UNIVERSITY OF HOUSTON
INTELLECTUAL PROPERTY
DONATION AGREEMENT**

I. United States Patent 4,444,989 Process for making p-xylene using promoted silica catalyst. Issued April 24, 1984. Expiry Date April 24, 2001.

II. United States Patent 4,452,909 Process for preparing silica catalyst. Issued June 5, 1984. Expiry Date September 13, 2002.

III. United States Patent 4,843,057 Preparation of promoted silica catalysts. Issued June 27, 1989. Expiry Date March 29, 2008.

Foreign Equivalents

<u>Country and patent number</u>	<u>Expiry date</u>
Belgium	3/09
Germany	3/09
United Kingdom	3/09
France	3/09
Italy	3/09
S. Korea	9/11
Japan	3/09
Canada	11/11
Taiwan	10/05

IV United States Patent 4,935,574 Process for making p-xylene using silica catalyst. Issued June 19, 1990. Expiry Date March 29, 2008

**APPENDIX B
UNIVERSITY OF HOUSTON
INTELLECTUAL PROPERTY
DONATION AGREEMENT**

I. Progress Reports

<u>Report No.</u>	<u>Report Name</u>	<u>Author</u>	<u>Date</u>
PD-ESL-79-12	Chemical Feedstocks-Synthesis of Para-Xylene	Frank E. Herkes	30 Oct 79
PD-ESL-82-1	Para-Xylene by Toluene Methylation: Process Studies	David A. Jackisch	1 Feb 82
PD-ESL-84-9	Steam Effects on Catalyst Deactivation in Toluene Methylation	Benjamin D. Herzog	4 Sep 84
PD-ESL-85-2	Toluene Methylation: Catalyst Regeneration	Benjamin D. Herzog	9 Apr 85
PD-ESL-85-3	Steam Requirements for Toluene Methylation	Benjamin D. Herzog	10 Apr 85
PD-ESL-85-1	Para-Xylene by Toluene Methylation: Kinetics of Reaction	C.F. King	26 Apr 85
PD-88E-5	Para-Xylene by Toluene Methylation: Catalyst Synthesis	Edward F. Moran	6 Apr 88
PD-88E-26	Para-Xylene by Toluene Methylation: Integral Reactor Performance	Nutan K. Pande	29 Jun 88
PD-88E-27	Para-Xylene by Toluene Methylation: Catalyst Deactivation	Nutan K. Pande	8 Jul 88
PD-88E-27	Para-Xylene by Toluene Methylation: Catalyst Development	Michael B. D'Amore	27 Jul 88
PD-88E-28	Para-Xylene by Toluene Methylation: Bench Scale Unit Operation	Erik J. Schaumann	28 Jul 88

II. Toluene Methylation Bench Scale Unit Diagrams

Distillation P&I (3)	ESI-336-15078
Feed System P&I (2)	ESI-336-15079
Reaction P&I (2)	ESI-336-15080
Unit Schematic (7)	ESI-154356c-t249
Mylar Overlay #2 (1)	ESI-336-15436

III. Operating Instructions (1984, 1986)

IV. Economical Studies