

01-30-2004

Form PTO-1595
(Rev. 10/02)

REC



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

OMB No. 0651-0027 (exp. 6/30/2005)

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Tab settings →

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

1. Name of conveying party(ies):

United Technologies Corporation

1/26/04

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:



Assignment



Merger



Security Agreement



Change of Name



Other

Execution Date: 11/12/2003

2. Name and address of receiving party(ies)

Name: Arthur S. Kesten

Internal Address:

Street Address: 17 Morning Crest Drive

City: West Hartford State: CT Zip: 06117

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

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)

B. Patent No.(s) 6,497,749 and

6,539,731

Additional numbers attached? ☐ Yes ☒ No

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

Name: J. Cory Nielsen

Internal Address: Tyler Cooper & Alcorn, LLP

Street Address: 185 Asylum Street

CityPlace 1/35th Floor

City: Hartford State: CT Zip: 06103

6. Total number of applications and patents involved: 2

7. Total fee (37 CFR 3.41).....\$ 80.00



Enclosed



Authorized to be charged to deposit account

8. Deposit account number:

DO NOT USE THIS SPACE

9. Signature.

01/29/2004 METACHE 00000004 6497749

01 FC:0021

80.00 DP

J. Cory Nielsen

Name of Person Signing

Signature

January 22, 2004
Date

Total number of pages including cover sheet, attachments, and documents: 6

Mail documents to be recorded with required cover sheet information to:

Commissioner of Patents & Trademarks, Box Assignments
Washington, D.C. 20231

PATENT
REEL: 014920 FRAME: 0549

PATENT ASSIGNMENT AND LICENSE AGREEMENT

This **PATENT ASSIGNMENT AND LICENSE AGREEMENT** (this "Agreement") is entered into as of November 12, 2003, by and between **UNITED TECHNOLOGIES CORPORATION**, a corporation organized and existing under the laws of the State of Delaware, acting here through United Technologies Research Center, a wholly owned, unincorporated operating units of **UNITED TECHNOLOGIES CORPORATION** with a place of business in East Hartford, Connecticut ("UTC") and **ARTHUR S. KESTEN**, an individual residing at 17 Morningcrest Drive, West Hartford, Connecticut ("Kesten") (each a "Party", and collectively, the "Parties").

WITNESSETH:

WHEREAS, in conjunction with biomimetic technology research and development performed pursuant to a Cooperative Research and Development Agreement dated April 23, 1998 by and between the Parties, as amended July 7, 1999 (the "Collaboration Agreement"), the Parties jointly developed technology that has been granted two separate United States Patents, US Patents Numbers 6,497,749 and 6,539,731 (each a "Patent", and collectively, the "Patents");

WHEREAS, Kesten desires to own, develop, license, and otherwise use the Patents and the underlying technology for commercial purposes;

WHEREAS, UTC is willing to assign any ownership rights or other claims of interest it may have in the Patents for the consideration herein set forth.

NOW, THEREFORE, in consideration of the mutual promises and obligations herein set forth, and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Parties do hereby agree as follows:

ARTICLE I DEFINITIONS

"Affiliate" shall mean any legal entity, including its employees, agents, and representatives, which, directly or indirectly, is in control of, is controlled by, or is under common control with, another legal entity. For purposes of this definition, a legal entity shall be deemed to be controlled by another legal entity if such other legal entity possesses, directly or indirectly, power either (a) to vote a majority or more of the securities having ordinary voting power for the election of directors of such legal entity, or (b) to direct or cause the direction of the management and policies of such legal entity whether by contract or otherwise.

"Third Party" shall mean any person, entity, group, or association other than Kesten or UTC, its employees, agents, representatives, and Affiliates.

ARTICLE II. ASSIGNMENT OF PATENT RIGHTS

2.1 Assignment. UTC hereby sells, assigns, transfers, and sets over to Kesten, his successors, assigns, or other legal representatives, and Kesten, for himself, his successors, assigns, and other legal representatives, hereby assumes, any right, title, or interest held by UTC in and to the Patents, including, without limitation, all rights to license the Patents (all together, the "Patent Rights").

2.3 Royalty Sharing. Kesten shall pay to UTC ten percent (10%) of all royalties or compensation paid to Kesten his successors, assigns, and other legal representatives or Affiliates, by a Third Party for a license to the Patent Rights. Kesten may reduce the reported royalties or compensation paid to him by the amount of costs incurred by him or his Affiliates in the effective commercial development of the Patents and the prosecution of the applications therefore with the United States Patent and Trademark Office, up to a maximum of \$500,000. UTC acknowledges that commercial development of the Patents may continue long after initial marketing or licensing of the Patent Rights. Kesten shall maintain adequate documentation of all agreements to license the Patent Rights to Third Parties and shall keep financial records and receipts of all expenditures incurred by Kesten in the commercial development of the Patents, which agreements, records, and receipts may be requested and inspected by UTC at reasonable times, upon reasonable notice, and at the sole expense of UTC. In the absence of clear and convincing evidence to the contrary, the documented license agreements with Third Parties maintained by Kesten shall be presumed to accurately represent all existing license agreements between Kesten and any Third Party with respect to the Patent Rights, and the records and receipts kept by Kesten hereunder shall be presumed to accurately reflect the costs incurred by Kesten in the effective commercial development of the Patents.

ARTICLE III. LICENSE

3.1 Grant. In consideration of the assignment by UTC under Article II of this Agreement, Kesten hereby grants to UTC and its Affiliates a world-wide, non-exclusive irrevocable, fully paid license to make, have made, use, sell, offer for sale, and import under the Patents (the "License").

3.2 No Assignment or Sublicense. UTC shall not assign or sublicense any right, interest, or privilege arising from the License to a Third Party, and shall not attempt to assign or sublicense any right, or privilege arising from the License to a Third Party without the express written consent of Kesten. UTC may assign the License to an Affiliate without the prior written consent of Kesten.

3.3 Patent Infringement. In the event that UTC becomes aware of any possible infringement or challenge of the Patent Rights, UTC may at UTC's sole discretion notify Kesten, whereupon Kesten may, in his sole discretion and at his own expense, undertake to litigate, settle, or otherwise restrain such infringement. UTC shall hold harmless and indemnify Kesten from and against any and all challenges, claims, liabilities, damages, and expenses arising from UTC's use of the Patent Rights. UTC shall not assert any claim or action whatsoever against Kesten arising from UTC's use of the Patent Rights.

ARTICLE IV. REPRESENTATIONS AND WARRANTIES

4.1 Authority.

- a) UTC is a corporation duly organized and in good standing under the laws of the State of Delaware, qualified to do business in various states, including the State of Connecticut. UTC has all requisite legal and organizational authority to enter into and bind itself, its successors and assigns, according to the terms and provisions of this Agreement.
- b) Kesten is an individual having all requisite legal capacity and authority to enter into and bind himself, his successors and assigns, according to the terms and provisions of this Agreement.

4.2 The Patents and the Patent Rights. Notwithstanding any registration or recognition by the United States Patent and Trademark Office, and except with respect the transaction, relationship, and relative rights and obligations of parties herein set forth or otherwise contemplated by this Agreement, neither Party makes any representation or warranty hereunder with respect to the validity of the Patents or the ultimate enforceability of the Patent Rights against any Third Party.

ARTICLE V. TERMINATION

5.1 Automatic. The License granted in Article III of this Agreement shall automatically terminate with respect to a Patent upon the expiration of its registration term or upon denial of a petition to appeal or failure to initiate an appeal for one (1) year after the entry of a federal judicial decree declaring the invalidity of such Patent or the unenforceability of the Patent Rights related thereto.

5.2 Continuation of Duties and Obligations. Upon termination of the License for any reason, the duties and obligations imposed by Article 3 hereof shall remain in full force and effect.

ARTICLE VI. MISCELLANEOUS

6.1 Complete Agreement. This Agreement contains the entire agreement and understanding of the Parties and supersedes all prior agreements and understandings between the Parties, both written and oral, with respect to its subject matter, including, but not limited to the Collaboration Agreement and any rights, interests, duties, obligations, understandings, or arrangements ancillary to or otherwise arising in conjunction or association with the Collaboration Agreement.

6.2 Further Assurances. Each of the Parties shall execute and deliver to the other Party such additional instruments, documents, consents, and assurances as may be reasonably requested or required in order to carry out the purposes and intent of this Agreement.

6.3 Expenses. Except as may otherwise be agreed to hereunder or in other writing by the Parties, all legal and other costs and expenses incurred in connection with this Agreement and the transactions contemplated hereby shall be paid by the Party incurring such costs and expenses. Moreover, each of the Parties shall bear its own costs for its use, development, or exploitation of the Patents or the Patent Rights as provided hereunder.

6.4 Relationship of the Parties. Nothing in this Agreement shall be interpreted or construed as creating or establishing a partnership, employment, or representative relationship between the Parties. Nothing in this Agreement shall be deemed to confer on either Party any express, implied, or apparent authority or agency to incur any obligation or liability on behalf of, or to speak for, the other party, and neither party shall make any representation or take any action inconsistent with such absence of authority or agency.

6.5 Notices. Any notices to be given hereunder by either Party to the other may be effected by mail, registered or certified, postage prepaid with return receipt requested. Mailed notices shall be addressed to the Parties at the addresses appearing in the introductory paragraph of this Agreement, but each party may change the address by written notice in accordance with this paragraph. Mailed notices will be deemed communicated as of three (3) days after mailing.

6.6 Amendments. This Agreement may not be amended, changed, or supplemented, unless such amendment, change, or supplement has been memorialized in writing and signed by both of the Parties.

6.7 Severability. In the event that any one or more provisions of this Agreement shall for any reason be held invalid, illegal, or unenforceable in any respect, by any court of competent jurisdiction, such invalidity, illegality or unenforceability shall not affect any other provisions of this Agreement and the Parties shall use their best efforts to substitute a valid, legal and enforceable provision which, insofar as practicable, implements the purposes and intents of this Agreement.

6.8 Non-Waiver. No failure, forbearance, or delay by either of the Parties in enforcing any right, power, or privilege hereunder shall be construed as a waiver thereof, nor shall any single or partial exercise thereof preclude any other or further exercise thereof or of any other right, power, or privilege under this Agreement.

6.9 Governing Law. This Agreement shall be governed by the laws of the State of Connecticut, without regard to conflicts of laws principles that would require the application of any other law.

6.10 Counterparts. This Agreement may be executed in counterparts, all of which shall be considered one and the same agreement and each of which shall be deemed to be an original and shall become effective when a counterpart has been signed by each of the Parties and delivered to each of the other Party.

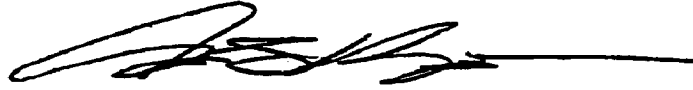
IN WITNESS WHEREOF, the Parties have caused this Agreement to be executed as of the date first set forth above.

UNITED TECHNOLOGIES CORPORATION

By: 

Name: William M. Sisson

Title: Director, Carrier Program UTRC



ARTHUR S. KESTEN