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Tab settings ⇨ ⇨ ⇨

Atty Docket: 45957-208730

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

1. Name of conveying party(ies):

BAE Systems Electronics Limited

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

2. Name and address of receiving party(ies)

Name: Marconi Caswell Limited

Internal Address:

Street Address: One Bruton Street

City: London

Country: United Kingdom

Zip: W1X 8AQ

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

3. Nature of conveyance:

☒ Assignment☐ Merger☐ Security Agreement☐ Change of Name☐ Other _____

Execution Date: March 29, 2001.

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 by the first named inventor is: _____

A. Patent Application No.(s)

B. Patent No.(s)

6,345,135 B1

Additional numbers attached? ☐ Yes ☒ No

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

26694

26694

PATENT TRADEMARK OFFICE

Name: VENABLE LLP

Address: P.O. Box 34385

City: Washington State: D.C. Zip: 20043-9998

6. Total number of applications and patents involved: 1

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

☐ Enclosed☒ Authorized to be charged to deposit account

8. Deposit account number:

22-0261

(Attach duplicate copy of this page 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.

Robert Kinberg, Reg. No. 26,924

Name of Person Signing

Signature

October 15, 2004

Date

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

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

Commissioner of Patents & Trademarks, Box Assignments

Washington, D.C. 20231

VENABLE
ATTORNEYS AT LAW

PC Docs No. 586828

PATENT
REEL: 015886 FRAME: 0290

6345135

22-0261

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40.00 DA

10/19/2004

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

Name: Interuniversitair Micro-Elektronica Centrum vzw

Internal Address:

Street Address: Kapeldreef 75

City: Leuven

Country: Belgium

Zip: B-3001

#586817

AGREEMENT

THIS AGREEMENT is made the day of 2000

BETWEEN

- (1) Marconi Caswell Limited, hereinafter called "Caswell", a company incorporated in England (Registration Number 3694360) whose registered office is at One Bruton Street, London, W1X 8AQ;
- (2) Interuniversitair Micro-Elektronica Centrum vzw, hereinafter called "IMEC", of Kapeldreef 75, B-3001 Leuven, Belgium;
- (3) Universiteit Gent, hereinafter called "the University", the administrative seat of which is located in 9000 Gent Sint-Pietersnieuwstraat 25, B-9000 Gent, Belgium represented here by the rector Professor J Willens, who entrusts execution of the present agreement to Professor R Baets of the Department of Information Technology;
- (4) BAE Systems Electronics Limited, formerly known as Marconi Electronic Systems Limited and formerly known as GEC-Marconi Ltd, hereinafter called "BAE", a company incorporated in England (Registration Number 53403) whose registered office is at The Grove, Warren Lane, Stanmore, Middlesex, HA7 4LY;
- (5) Douglas Charles John Reid of 2A Barby Lane, Hillmorton, Rugby, Warwickshire CV22 5QJ, United Kingdom;
- (6) David James Robbins of 4 Wappenham Road, Abthorpe, Towcester, Northamptonshire NN12 8QU, United Kingdom; and
- (7) Gert Jaak Anna Sarlet of Zwarte Leetouwers Straat 28/2, B-8000 Brugge, Belgium.

WHEREAS:

- A. An invention, hereinafter called "the Invention", has been made for which an initial patent application has been filed in the UK under the number 9809583.9, hereinafter called "the Application".
- B. The Invention was made jointly by Douglas Reid, David Robbins and Gert Sarlet.
- C. At the time of making the Invention Douglas Reid and David Robbins were employed by BAE and their rights in the Invention belonged to BAE by virtue of Section 39 of the Patents Act 1977.
- D. At the time of making the Invention Gert Sarlet was a postgraduate student of the University and was conducting work funded by IMEC under conditions which transferred his rights in the Invention jointly to IMEC and to the University.

- E. BAE and IMEC were agreed that the Invention and the Application are Foreground Information and Foreground Rights as defined in Annex II to a Contract dated 25 July 1995 to which they were signatories and that each party to that Contract is obliged under clause 14 of that Annex to grant such rights as are necessary to enable the other parties to exploit the Invention and the Application.
- F. As an emergency measure, to prevent loss of Patent Rights, BAE filed the Application in its former name GEC-Marconi Ltd.
- G. As agreed by IMEC and the University, BAE filed corresponding patent applications in the UK (number GB9910503.3), Europe (number EP9930355.9) and the USA (number 09/306449), hereinafter generally called "Patent Rights" in the joint names of BAE, IMEC and the University.
- H. In November 1999 BAE, and certain assets belonging to BAE, were acquired by British Aerospace Plc.
- I. The assets referred to in Clause H did not include the rights in the Invention, the Application nor the Patent Rights: accordingly to reflect this BAE wish to assign its rights in the Invention, the Application and Patent Rights to Caswell.
- J. At the time the Patent Rights were filed BAE, IMEC and the University had agreed certain obligations in relation to the Patent Rights and Caswell accepts these obligations.
- K. By way of confirmation, Caswell, IMEC and the University confirm their respective obligations by this agreement.
- L. By way of confirmation, Douglas Reid and David Robbins hereby assign their rights in the Invention to BAE; and Gert Sarlet hereby assigns his rights in the Invention jointly to the University and IMEC.

Now it is hereby agreed as follows:

1. Steps shall be taken to name Caswell, IMEC and the University as co-applicants for any replacement or corresponding patent applications that may be made in the United Kingdom or elsewhere and any such patent applications shall be included as Patent Rights.
2. BAE hereby assigns its share of rights in the Invention to Caswell. Furthermore BAE agrees to assign its share in the Patent Rights to Caswell, and IMEC and the University consent to this assignment.

3. IMEC and Caswell and their Affiliates shall each have the right in respect of the Invention (by itself or through its agents) to do anything which would be an infringement of the Patent Rights and without any obligation to make payment to the other. For the purposes of this agreement an Affiliate shall include any present or future subsidiary (as defined in Section 736 of the Companies Act 1985), any company owning or controlling IMEC or Caswell and any present or future subsidiary of such a company. The University agrees not to do anything as mentioned above but shall be entitled to use the Invention for research purposes.
4. IMEC warrants that the University has granted IMEC the authority to represent the University in all patent application, grant and opposition proceedings and agreements with the co-owners related thereto. Moreover the University has granted IMEC the authority to represent the University in negotiations and agreements regarding the commercial exploitation in respect of all Patent Rights. Furthermore at the request of IMEC or Caswell the University will execute an assignment to IMEC and Caswell in respect of any patent granted pursuant to the Patent Rights and any associated patent applications.
5. Third parties, supplied with a product employing the Invention by IMEC or Caswell, shall have the same rights in respect of the Invention as if IMEC or Caswell, as appropriate, had been the sole owner of the Invention.
6. IMEC and Caswell shall each have the right to have products employing the Invention made by third parties for IMEC's or Caswell's own use.
7. Caswell shall, for the time being, prosecute and maintain the Patent Rights (including any resulting patents), on behalf of IMEC and Caswell, and shall extend the Patent Rights to all territories where IMEC and Caswell may agree to such extension and to additional territories selected solely by Caswell or IMEC. Caswell shall give reasonable notice to IMEC of any decision not to continue such activity and shall co-operate with IMEC in making alternative arrangements. Caswell shall have no responsibility for errors or omissions in the course of such activities.
8. IMEC agrees to pay half the cost of Caswell in pursuing the activities referred to in Clause 7 above except that Caswell and IMEC will respectively bear the full costs of obtaining and maintaining Patent Rights in territories selected solely by Caswell or IMEC as the case may be. Such cost will include out of pocket expenditure, the reasonable cost of professional services and any taxes required to be charged by law. IMEC may at any time give notice to Caswell that they do not wish to share future costs, such notice to have immediate effect. On giving such notice Caswell shall be released of its obligations under Clause 7 above.
9. Except as provided for in the Contract dated 25 July 1995 and a Consortium Agreement dated 20 May 1996 to which IMEC and BAE were parties, neither IMEC nor Caswell shall grant a licence to a third party without the agreement of both IMEC and Caswell. IMEC and Caswell agree that each of them shall not unreasonably withhold their consent to a third party licence. Under no circumstances may the University grant a licence to a third party without permission of IMEC and Caswell.

10. Except as part of a restructuring of its business neither IMEC nor Caswell may assign any of its rights in the Invention (including Patent Rights) or any of its rights under this agreement without the consent of the other, such consent not to be unreasonably withheld. Under no circumstances may the University assign its rights without permission of IMEC and Caswell.
11. IMEC and the University may enter into a further agreement with each other concerning the sharing of revenue resulting from the commercial exploitation of the Patent Rights.
12. The parties to this agreement are agreed that this agreement shall have an effective date of 5 May 1999.

Signed for and on behalf of Marconi Caswell Limited


..... 

Title Commercial Director

Date 12/7/00

in the presence of 

Signed for and on behalf of Interuniversitair Micro-Elektronica Centrum vzw


.....  Prof. Gilbert Declerck

Title President

Date June 26, 2000

in the presence of Christa Claes

Signed for and on behalf of the Universiteit Gent by Professor R Baets

..... 

Title Professor

Date 27th June 2000

in the presence of Ylse Meereman

BAC SYSTEMS ELECTRONICS

Signed for and on behalf of ~~Mareconi Electronic Systems~~ Limited

M. Jewen

Title DIRECTOR, GROUP INTELLECTUAL PROPERTY

Date 29 MARCH 2001

in the presence of

M. Macketh

Signed by Douglas Charles John Reid

D. Reid

Date

18th July '00

in the presence of

RUTH HIBBERSON R. Hibberson

Signed by David James Robbins

D. Robbins

Date

18th July '00

in the presence of

CHRIS HILL

CHILL

Signed by Gert Jaak Anna Sarlet

G. Sarlet

Date

28th June 2000

in the presence of

I. H. Newman