

PATENT ASSIGNMENT

Electronic Version v1.1

Stylesheet Version v1.1

SUBMISSION TYPE:

NEW ASSIGNMENT

NATURE OF CONVEYANCE:

ASSIGNMENT

CONVEYING PARTY DATA

Name	Execution Date
Commonwealth Scientific and Industrial Research Organisation	06/01/2006

RECEIVING PARTY DATA

Name:	University of Dayton
Street Address:	300 College Park
City:	Dayton
State/Country:	OHIO
Postal Code:	45469

PROPERTY NUMBERS Total: 3

Property Type	Number
Application Number:	09979792
Patent Number:	6811957
Patent Number:	6866801

CORRESPONDENCE DATA

Fax Number: (937)449-6405

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Address Line 4: Dayton, OHIO 45402-2023

ATTORNEY DOCKET NUMBER:

40815.552

NAME OF SUBMITTER:

Patricia L. Prior

Total Attachments: 7

PATENT

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ASSIGNMENT AND ENTITLEMENT DEED

THIS DEED is made on the day of 2006.

PARTIES

1. **COMMONWEALTH SCIENTIFIC AND INDUSTRIAL RESEARCH ORGANISATION (ABN 41 687 119 230)**, a body corporate established by the Science and Industry Research Act 1949 (Cth) acting through its Division of Molecular and Health Technologies, Ian Wark Laboratory, Bayview Avenue, Clayton, Victoria (**CSIRO**).
2. **UNIVERSITY OF DAYTON** of 300 College Park, Dayton, Ohio 45469-0102 (**Dayton**).

RECITALS

- A. CSIRO is the owner of the Patents.
- B. CSIRO wishes to transfer to Dayton all of CSIRO's right, title and interest in and to the Patents.
- C. This Deed sets out the terms of the agreement between the parties for the assignment of the Patents.

IT IS AGREED BY THE PARTIES

- ## 1. DEFINITIONS AND INTERPRETATION

- 1.1 In this Deed:**

Deed means this deed and the Schedule.

Effective Date means 1 June 2006.

Entitlement Term means the period commencing on the Effective Date and ending on the date of the lapsing, cessation or expiry of the last to lapse, cease or expire of the Patents in any country.

Exploit has the same meaning as given to that term in the *Patents Act* 1990 (Cth) and **Exploitation** will have a similar meaning.

IP Costs means all costs and expenses, including legal and patent attorney fees incurred in obtaining and maintaining the Patents or any one of them.

Net Exploitation Revenue means

- (a) the gross revenue received by Dayton from the Exploitation of the Patents (including without limitation signing fees, royalties, licence and sub-licence fees and milestone payments), but does not include monies received to carry out research and development, less the following costs, if any, attributable to the Exploitation:
- (i) returned goods;
 - (ii) any amount shown separately on invoices for transportation costs;
 - (iii) trade and quantity discounts; and
 - (iv) sales, use or turnover taxes or other government taxes, import, export and excise duties, charges or imposts actually incurred and paid.

Patents means those of the patents granted, and any application for patents in relation to the inventions embodied in those patents, listed in the Schedule (and includes all continuations, continuations in part or divisions of the foregoing and any substitute applications) and **Patent** means any one of them.

1.2 Unless the context does not permit:

- (a) the expression "person" includes an individual, a corporation, a statutory corporation (including any corporation sole) and any other entity, whether or not resident in Australia or formed or existing under the laws in force in Australia;
- (b) references to clauses, parts of clauses and schedules are references to the clauses, parts of clauses and schedules of this Deed;
- (c) the singular shall include the plural and vice versa and expressions inferring a gender shall include any other gender;
- (d) references to legislation or parts of legislation include the legislation or part as amended or substituted from time to time; and
- (e) a reference to a party to this Deed includes the party's successors and permitted assigns.

1.3 Headings shall not be used as an aid to interpretation. The Recitals form part of this Deed.

2. ASSIGNMENT

2.1 CSIRO assigns to Dayton, and Dayton accepts the assignment from CSIRO, of all CSIRO's right, title and interest in and to the Patents.

2.2 The assignment is deemed to have taken effect on the Effective Date.

2.3 From the Effective Date, Dayton is responsible for the maintenance of the Patents and for all IP Costs.

3. RELEASE AND INDEMNITY

Dayton:

- (a) assumes responsibility for, and releases and discharges CSIRO from, all liabilities, losses or damages CSIRO or Dayton incurs arising out of or in connection with Dayton's use or Exploitation of the Patents; and
- (b) indemnifies CSIRO against all costs (including all reasonable legal expenses) incurred by CSIRO in defending any proceedings, suits, claims and demands which may be brought or made against CSIRO by a third party and against any liabilities, losses or damages for which CSIRO is held liable arising out of or in connection with Dayton's use or Exploitation of the Patents;

regardless of whether such liabilities, losses or damages arise from events which occurred before the Effective Date.

4. CONSIDERATION

4.1 In consideration for the assignment in clause 2 Dayton must pay CSIRO:

- (a) the amount of US\$5,000, payable within 45 days of the Effective Date; and

- (b) throughout the Entitlement Term, 15% of all Net Exploitation Revenue.

5. REPRESENTATIONS AND WARRANTIES

- 5.1 Dayton acknowledges that it has not relied on any representations or warranties about the Patents.
- 5.2 CSIRO makes no representation or warranty (express or implied):
 - (a) as to the utility of the Patents;
 - (b) as to the prospects of the successful Exploitation of the Patents; or
 - (c) that the use or Exploitation of the Patents will not infringe the intellectual property rights or any other rights of any person.
- 5.3 To the fullest extent permitted by law, all terms, conditions or warranties implied by law (including statute), custom or usage are excluded.

6. REPORTING AND AUDITS

- 6.1 Dayton will provide CSIRO with a report within 30 days of the end of each financial year, in which Net Exploitation Revenue received by Dayton, if any, and the share of that Net Exploitation Revenue to which CSIRO is entitled, are calculated. If Dayton does not receive any Net Exploitation Revenue in a financial year, then the report will state that no Net Exploitation Revenue were received for that financial year.
- 6.2 Dayton must keep and maintain reasonable accounts and records for at least seven (7) years in relation to its Exploitation of the Patents, including:
 - (a) any agreements entered into which relate to Exploitation of the Patents; and
 - (b) documentation verifying Net Exploitation Revenue
- 6.3 CSIRO may within three (3) years of receipt of the report referred to in clause 6.1 use an independent auditor to inspect and audit a copy of the records referred to in clause 6.2. If such inspection or audit identifies a five percent (5%) or greater deviation in any continuous twelve month period from the amounts identified as payable to CSIRO in reports provided by Dayton pursuant to clause 6.1, then Dayton will pay CSIRO's reasonable inspection and audit costs provided such costs do not exceed the amount of the deviation identified, and shall remit any amounts due to CSIRO within thirty (30) days of receiving notice thereof from CSIRO. The audit can take place no more than once every twelve (12) months and CSIRO must provide reasonable notice in relation to each audit and in any case no less than twenty one (21) days.

7. DISPUTE RESOLUTION

- 7.1 If a dispute arises between the parties out of or relating to this Deed (the **Dispute**), any party seeking to resolve the Dispute must do so strictly in accordance with the provisions of this clause.
- 7.2 A party seeking to resolve the Dispute must notify the existence and nature of the Dispute to the other party (the **Notification**). Upon receipt of a Notification the parties must refer resolution of the Dispute to their respective Chief Executive Officers or their nominees.
- 7.3 If the Dispute has not been resolved within thirty (30) days of receipt of the Notification then any party may refer the Dispute to mediation and must do

so before initiating proceedings in a court to resolve the Dispute. Any Dispute referred to mediation must be referred to the Australian Commercial Dispute Centre Limited (ACDC) and be conducted in accordance with the Conciliation Rules of ACDC. If the Dispute has not been resolved within sixty (60) days of referral to ACDC either party is free to initiate proceedings in a court.

- 7.4 Nothing in this clause shall prevent a party from seeking interlocutory relief through courts of appropriate jurisdiction.

8. NOTICES

- 8.1 Any notice to be given by any party must be in writing or by facsimile transmission.

- 8.2 A notice in writing may be given or served either personally or by transmitting the same by ordinary prepaid mail to the other party's address and for the attention of the Chief of the Division of Molecular and Health Technologies in the case of CSIRO or the Chief Executive Officer in the case of Dayton or such other address and personnel as the recipient party may from time to time notify in writing for the service of notices. If sent by ordinary prepaid mail notice will be deemed to have been given three days after it was posted.

- 8.3 Notwithstanding clause 8.2, the date of service of a notice transmitted by facsimile will be the date and time of transmission of the facsimile as evidenced by the dispatch slip issued by the transmitting facsimile apparatus unless it can be proved by competent evidence to the contrary.

9. AMENDMENT

- 9.1 This Deed accurately reflects the agreement between the parties as to its subject matter and supersedes all prior representations and agreements about that subject matter.

- 9.2 This Deed may be altered only by a written instrument signed by the parties.

10. COSTS, STAMP DUTY AND GST

- 10.1 Each party is responsible for its own legal and other costs and expenses in relation to the preparation, negotiation and execution of this Deed.

- 10.2 Dayton must pay all stamp duty in relation to this Deed.

- 10.3 Unless otherwise stated, all amounts payable or the value of other consideration provided in respect of supplies made in relation to this Deed are exclusive of GST (if any). When a supply is taxable supply, the amounts payable or the value of the consideration provided for that supply shall be increased by the amount of GST payable in relation to the supply. The GST will be payable within 10 days of a tax invoice being issued.

- 10.4 Where any amount is payable as a reimbursement, indemnification or similar payment calculated by reference to a loss, cost, expense or other amount incurred, then that amount must be reduced by any input tax credit available to that party and, if a taxable supply, must be increased by the GST payable in relation to the supply and a tax invoice will be provided by the party being reimbursed or indemnified.

- 10.5 All GST shall be payable at the time any payment to which it relates is payable. Where any GST payable is not referable to an actual payment

10.6 Terms defined in *A New Tax System (Goods and Services Tax) Act 1999* (Cth) have the same meaning when used in clauses 10.3 to 10.5.

Each party must promptly at its own cost do all things (including executing and if necessary delivering all documents) reasonably necessary or desirable to give full effect to this Deed.

This Deed is governed by the laws of the state of Victoria, Australia and the parties submit to the exclusive jurisdiction of the courts of Victoria in respect of all matters relating to this Deed.

This Deed may consist of a number of counterparts and the counterparts taken together form one and the same document.

Signed sealed and delivered by
**COMMONWEALTH SCIENTIFIC AND
INDUSTRIAL RESEARCH ORGANISATION**

By G.C. Woodman
(print name)
Title Chief CMHT
(print title)
a duly authorised officer of **CSIRO** in the
presence of: [Signature]

Witness Signature

.....
(print) Name of Witness

Signature

The Common Seal of **UNIVERSITY OF DAYTON**
was affixed in the presence of:

Signature of Director/Secretary

...Danita Hart.....
(print) Name of Director/Secretary

Signature of Director

.....Larrell B. Walters.....
(print) Name of Director

REEL: 018061 FRAME: 0465

Schedule - Patents

Title	Priority date	International Filing Number	Granted Patent Numbers	Patent Applications pending
Substrate-supported aligned carbon nanotube films	28 th May 1999	PCT/AU00/00550 (WO00/73204)	AU759314	EP1198414 JP 2003500325 US 09/979792
Patterned Carbon Nanotube films	28 th May 1999	PCT/AU00/00550 (WO00/73203)	AU753177 US6811957	EP1200341 JP 2003500324
Patterned Carbon Nanotubes/ Process for making aligned Carbon nanotubes	22 nd September 1999	PCT/AU00/01180 WO01/21863	AU776402 US6866801 EP1230448	JP 2003510236