

Form PTO-1595 (Rev. 03-09)  
OMB No. 0651-0027 (exp. 03/31/2009)

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

## RECORDATION FORM COVER SHEET PATENTS ONLY

To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.

### 1. Name of conveying party(ies)

Public Service Company of New Mexico

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

### 3. Nature of conveyance/Execution Date(s):

Execution Date(s) November 3, 2008

- ☒ Assignment ☐ Merger  
☐ Security Agreement ☐ Change of Name  
☐ Joint Research Agreement  
☐ Government Interest Assignment  
☐ Executive Order 9424, Confirmatory License  
☐ Other \_\_\_\_\_

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

Name: Gathen Garcia

Internal Address: \_\_\_\_\_

Street Address: 1708 34th Street SE

City: Rio Rancho

State: New Mexico

Country: USA Zip: 87124

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

### 4. Application or patent number(s):

A. Patent Application No.(s)

10/988,611

☐ This document is being filed together with a new application.  
B. Patent No.(s)

6,895,373  
6,912,487

Additional numbers attached? ☐ Yes ☒ No

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

Name: PNMR Services Company

Internal Address: Mail Stop 1020 HQ-10

Attn: Annabelle Quintana

Street Address: 414 Silver Ave. SW

City: Albuquerque

State: New Mexico Zip: 87158

Phone Number: (505) 241-0733

Fax Number: (505) 241-2819

Email Address: Annabelle.Quintana@pnmrresources.com

### 6. Total number of applications and patents involved: 3

### 7. Total fee (37 CFR 1.21(h) & 3.41) \$120

- ☐ Authorized to be charged to deposit account  
☒ Enclosed  
☐ None required (government interest not affecting title)

### 8. Payment Information

Deposit Account Number \_\_\_\_\_

Authorized User Name \_\_\_\_\_

### 9. Signature:

Annabelle Quintana  
Signature

April 30, 2009  
Date

Annabelle Quintana, Sr. Analyst  
Name of Person Signing

Total number of pages including cover sheet, attachments, and documents: 19

Documents to be recorded (including cover sheet) should be faxed to (571) 273-0140, or mailed to:  
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O. Box 1450, Alexandria, V.A. 22313-1450

OP \$120.00 10988611

## Restated Assignment and License Agreement

**THIS RESTATED ASSIGNMENT AND LICENSE AGREEMENT ("Agreement")** is made effective March 16, 2009 ("Effective Date"), by and between the Public Service Company of New Mexico, a New Mexico corporation having offices at 414 Silver Ave. SW, Albuquerque, NM 87158 (hereinafter "PNM"), and Gathen Garcia (hereinafter "Licensor") (collectively the "Parties").

### **W I T N E S S E T H:**

**WHEREAS**, Licensor, while employed by PNM, created certain intellectual property otherwise known as 3D-DASL (hereinafter "Technology") to which PNM retained all ownership rights and which is further described below;

**WHEREAS**, PNM desired to assign all its right, title, and interest in the Technology to Licensor and Licensor desired to acquire the Technology, to wit and the Parties entered into an assignment agreement dated November 3, 2008 which provided a grant of a non-exclusive license in the Technology to PNM in consideration for the assignment of same from PNM to Licensor ("Letter Agreement");

**WHEREAS**, the Letter Agreement incorrectly identified the Letters Patents issued for the Technology, did not identify a pending patent application and did not transfer the "Trademark" associated with the Technology; and

**WHEREAS**, the Parties desire to amend and restate the Letter Agreement to correct the errors and to transfer the additional rights in the Technology;

**NOW, THEREFORE**, in consideration of the promises and agreements set forth herein, the Parties, each intending to be legally bound hereby, do hereby restate the Letter Agreement in its entirety as follows:

1. **Definitions.** The following terms shall have the described meanings throughout this Agreement:

(a) "Patents" shall mean the following US patent applications, including all divisionals, continuations, continuations-in-part, reissues, extensions by law and all foreign counterparts of such applications and all Letters Patent issuing thereon:

<b><u>Serial No.</u></b>	<b><u>Application Filing Date</u></b>	<b><u>Letters Patent</u></b>	<b><u>Date of Issuance</u></b>
09/984,374	October 30, 2001	6,895,373	May 12, 2005 <sup>1</sup>
09/545,455	April 7, 2000	6,912,487	June 28, 2005 <sup>2</sup>
10/988,611	November 16, 2004 <sup>3</sup>		

**Entitled (respectively):**

<sup>1</sup>UTILITY STATION AUTOMATED DESIGN SYSTEM AND METHOD,

<sup>2</sup>UTILITY STATION AUTOMATED DESIGN SYSTEM AND METHOD, and

<sup>3</sup>UTILITY STATION AUTOMATED DESIGN SYSTEM AND METHOD

(b) "Trademark" shall mean the following US Registered Trademark:

<u>Registration No.</u>	<u>Registration Date</u>	<u>Serial No.</u>	<u>Application Filing Date</u>
2800577	December 30, 2003	75718133	May 20, 1999

**Word Mark:** 3D-DASL

(c) "Copyrights" shall mean all copyrighted and copyrightable materials created by PNM in performance of the project that resulted in the Technology.

(d) "Technical Information" shall mean the ideas, designs, technical information, inventions, trade secrets, source code, software, know-how, show-how, data, models, prototypes, and documentation created by PNM in performance of the project that resulted in the Technology.

2. Assignment. PNM hereby sells, transfers, conveys and assigns to Licensor, and Licensor hereby accepts, and takes delivery of, all of PNM's rights, title and interest in, to and under the Patent, Trademarks, Copyrights and Technical Information. In furtherance of this Section, PNM shall execute the following agreements for filing with the U.S. Patent and Trademark Office: (i) the patent assignment agreements attached hereto as Exhibits A, B and C; and (ii) the trademark assignment attached hereto as Exhibit D.

3. License. Licensor hereby grants PNM and PNM accepts, subject to the terms and conditions hereof, a non-exclusive, royalty-free, fully paid assignable license to use the Patents, use, display, and distribute materials bearing the Trademark, use, display, distribute, and prepare derivative works of the Copyrights and use Technical Information, including the right to sublicense the same to affiliates, subsidiaries, its parent company and parent company's joint ventures, and to authorize third parties to do the same for PNM's benefit, until the last patent, trademark, and copyright, respectively, has expired; and, with respect to Technical Information, it has entered the public domain. Any improvements, modifications, adaptations, enhancements, upgrades, fixes, updates, and new versions of the Technology developed by Licensor not described in the Patents, Trademark, Copyrights, of Technical Information shall be automatically added and included in the appropriate definition in Section 1, and thereby added to the above nonexclusive licenses granted by Licensor to PNM in accordance with the terms and conditions of this Agreement.

4. Infringement and other Legal Actions.

4.1. Each Party shall immediately notify the other Party if it becomes aware of an infringement of the intellectual property rights in the Technology.

4.2. Licensor shall be solely responsible, but not obligated, to pursue against third parties infringement and any other actions having to do with the defense, validity, and enforceability of the patents and other intellectual property rights in the Technology.

4.3. PNM shall cooperate with Licensor, at Licensor's expense, in the defense of the aforementioned actions, including allowing employees to testify and providing relevant records if they are available.

5. Notices. Any notice required to be given pursuant to this Agreement shall be in writing and mailed by certified or registered mail, return receipt requested, or delivered by a national overnight express service to the following addressees:

To PNM:

Public Service Company of New Mexico  
414 Silver Ave. SW  
Albuquerque, NM 87158  
Attn: Legal Department

To: Licensor:

Gathen Garcia  
1708 34th Street SE  
Rio Rancho, NM 87124

Either party may change the address to which notice or payment is to be sent by written notice to the other party pursuant to the provisions of this paragraph.

6. Disclaimer of Warranties. THE PARTIES MAKE NO REPRESENTATIONS OR OFFER ANY WARRANTIES OF ANY KIND WITH RESPECT TO THE PATENTS, TRADEMARKS, COPYRIGHTS, AND OTHER INTELLECTUAL PROPERTY LICENSED HEREIN, AND EXPRESSLY DISCLAIM ANY MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE AND ANY OTHER IMPLIED WARRANTIES AS TO THE NON-INFRINGEMENT, SAFETY, UTILITY, OR COMMERCIAL APPLICABILITY OF THE TECHNOLOGY.

7. Miscellaneous.

(a) *Entire Agreement and Amendments.* This Agreement, which includes the Exhibits which are hereby incorporated and made a part of this Agreement, contains the entire understanding between the Parties, and revokes and supersedes all prior agreements between the Parties and is intended as a final expression of their Agreement. No amendment or modification shall be effective unless made in writing and signed by authorized representatives of both Parties. This Agreement shall take precedence over any other documents that may be in conflict therewith.

(b) *Compliance.* Each Party shall comply with all applicable laws and regulations relating to its license, manufacture, processing, production, use, advertising, marketing, sale and distribution of products created in whole or in part using the licensed Patents, Trademark, Copyrights, and/or Technical Information, and the Parties shall not at any time take action, authorize others to do so, or cause the other Party to be in violation of such applicable laws and regulations.

(c) *Independent Contractors.* The Parties are independent contractors. Neither Party shall be the agent of the other Party and shall have no authority to act for or on behalf of the other Party in any manner.

(d) *Use of Names.* Other than Trademark, neither Party shall use the marks, logos, and names of the other Party, its officers, directors, or employees without prior written authorization.

(e) *Governing Law.* This Agreement and all amendments, modifications, alterations, supplements hereto, and the rights of the Parties hereunder shall be construed under and governed by the laws of the State of New Mexico and the United States excluding its conflict of laws rules, but the scope and validity of each issuing patent shall be governed by the applicable laws of the country granting such patent.

(g) *Successors.* This Agreement shall be binding on and shall inure to the benefit of the Parties hereto, and their successors and assigns.

(h) *Waiver.* No waiver by either party of any default shall be deemed as a waiver of any prior or subsequent default of the same or other provisions of this Agreement.

(i) *Severability.* If any provision hereof is held invalid or unenforceable by a court of competent jurisdiction, such invalidity shall not affect the validity or operation of any other provision and such invalid provision shall be deemed to be severed from the Agreement.

IN WITNESS WHEREOF, the parties hereto, intending to be legally bound hereby, have each caused to be affixed hereto its or his/her hand and seal the day indicated.

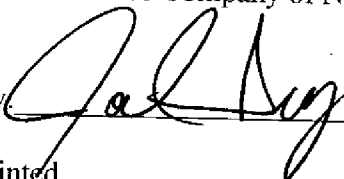
Public Service Company of New Mexico

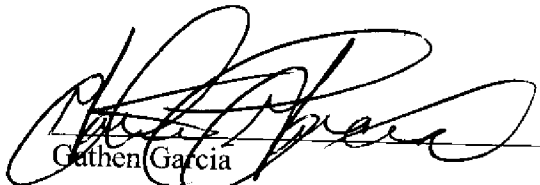
By

Printed

Name:

Title:

  
JOEL IVY  
VP, NM OPERATIONS

  
Catherine Garcia

**Exhibit A**

[INSERT Assignment for Serial No. 09/984,374]

## ASSIGNMENT

THIS ASSIGNMENT of Letters Patent is from the Public Service Company of New Mexico ("PNM" or "Assignor"), a New Mexico corporation, to Gathen Garcia ("Assignee"), whose addresses is set forth on the signature page hereof.

WHEREAS, PNM through its policies and agreements with its employees, was assigned certain inventions conceived and reduced to practice by its employees during the course of their employment, for which PNM filed patent applications with the United States Patent and Trademark Office, and for which Letters Patent were issued as described below:

<u>Patent Application</u>	<u>Application Filing Date</u>	<u>Letters Patent</u>	<u>Date of Issuance</u>
09/984,374	October 30, 2001	6,895,373	May 12, 2005

Title

**UTILITY STATION AUTOMATED DESIGN SYSTEM AND METHOD**

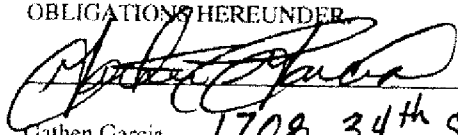
WHEREAS, PNM now desires to assign all its rights, title, and interests in the Patent Application and Letters Patent to Assignee;

NOW, THEREFORE, PNM and Assignee agree as follows:

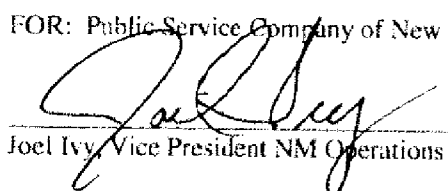
PNM does hereby assign and transfer unto Assignee all its right, title, and interest in and to: (a) the invention(s) described in the Patent Application(s) and Letters Patent described above; (b) any technical information, know-how, trade secret, process, procedure, composition, device, method, formula, protocol, technique, software, design, and data which is related to the aforesaid invention(s) and/or that is included in the Patent Application(s) and/or issued Letters Patent, whether or not covered by the Patent Application(s) or Letters Patent; (c) all rights in the Patent Application(s) including but not limited to all divisions, reissues, continuations, continuations-in-part, continuing patent applications, substitutions, renewals, extensions filed and all patent(s) issuing thereon in the United States and all foreign countries; and (d) to the extent PNM owns the same under its policies and practices, all improvements to the invention(s) described in the Patent Application(s) hereafter made or invented by PNM (all of the foregoing, (a), (b), (c), and (d) being collectively referred to hereafter as the "Invention"); and (e) the right to assert claims and bring lawsuits for any violation or infringement of any of the intellectual property rights assigned hereby, including all patents issuing on the Patent Applications.

For the purpose of enabling Assignee, its successors and assigns, to obtain, defend and enforce all United States and foreign intellectual property rights in the Invention, PNM shall timely communicate all information, execute all documents, testify in all legal proceedings and take all such other actions necessary or desirable to accomplish such purpose, at Assignee's expense.

THE ASSIGNEE ACKNOWLEDGE BY HIS SIGNATURE HERETO THAT HE HAS READ THE FOREGOING, UNDERSTANDS ITS CONTENTS AND HAS HAD THE OPPORTUNITY TO CONSULT LEGAL COUNSEL OF HIS CHOOSING CONCERNING HIS RIGHTS AND OBLIGATIONS HEREUNDER.

 1/8/2009  
Gathen Garcia, 1708 34<sup>th</sup> St SE, Rio Rancho, NM 87124  
address

FOR: Public Service Company of New Mexico

  
Joel Ivy, Vice President NM Operations

1/8/2009  
Date

**PATENT**  
**REEL: 022619 FRAME: 0271**

STATE OF NEW MEXICO       )  
  )  
COUNTY OF BERNALILLO    )     ss.

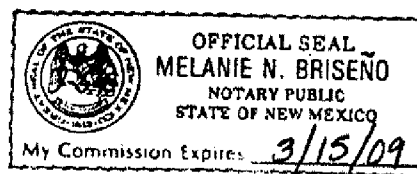
The foregoing instrument was subscribed and acknowledged before me, this 8<sup>TH</sup> day of January, 2009 by Joel Ivy, Vice President of NM Operations for the Public Service Company of New Mexico

Melanie N. Briseño  
Notary Public

My Commission Expires:

3/15/09

Seal:





**Exhibit B**

[INSERT Assignment for Serial No. 09/545,455]

## ASSIGNMENT

THIS ASSIGNMENT of Letters Patent is from the Public Service Company of New Mexico ("PNM" or "Assignor"), a New Mexico corporation, to Gathen Garcia ("Assignee"), whose addresses is set forth on the signature page hereof.

WHEREAS, PNM through its policies and agreements with its employees, was assigned certain inventions conceived and reduced to practice by its employees during the course of their employment, for which PNM filed patent applications with the United States Patent and Trademark Office, and for which Letters Patent were issued as described below:

<u>Patent Application</u>	<u>Application Filing Date</u>	<u>Letters Patent</u>	<u>Date of Issuance</u>
09/545,455	April 7, 2000	6,912,487	June 28, 2005

### Title

**UTILITY STATION AUTOMATED DESIGN SYSTEM AND METHOD**

WHEREAS, PNM now desires to assign all its rights, title, and interests in the Patent Application and Letters Patent to Assignee;

NOW, THEREFORE, PNM and Assignee agree as follows:

PNM does hereby assign and transfer unto Assignee all its right, title, and interest in and to: (a) the invention(s) described in the Patent Application(s) and Letters Patent described above; (b) any technical information, know-how, trade secret, process, procedure, composition, device, method, formula, protocol, technique, software, design, and data which is related to the aforesaid invention(s) and/or that is included in the Patent Application(s) and/or issued Letters Patent, whether or not covered by the Patent Application(s) or Letters Patent; (c) all rights in the Patent Application(s) including but not limited to all divisions, reissues, continuations, continuations-in-part, continuing patent applications, substitutions, renewals, extensions filed and all patent(s) issuing thereon in the United States and all foreign countries; and (d) to the extent PNM owns the same under its policies and practices, all improvements to the invention(s) described in the Patent Application(s) hereafter made or invented by PNM (all of the foregoing, (a), (b), (c), and (d) being collectively referred to hereafter as the "Invention"); and (e) the right to assert claims and bring lawsuits for any violation or infringement of any of the intellectual property rights assigned hereby, including all patents issuing on the Patent Applications.

For the purpose of enabling Assignee, its successors and assigns, to obtain, defend and enforce all United States and foreign intellectual property rights in the Invention, PNM shall timely communicate all information, execute all documents, testify in all legal proceedings and take all such other actions necessary or desirable to accomplish such purpose, at Assignee's expense.

THE ASSIGNEE ACKNOWLEDGE BY HIS SIGNATURE HERETO THAT HE HAS READ THE FOREGOING, UNDERSTANDS ITS CONTENTS AND HAS HAD THE OPPORTUNITY TO CONSULT LEGAL COUNSEL OF HIS CHOOSING CONCERNING HIS RIGHTS AND OBLIGATIONS HEREUNDER.

Gathen Garcia,

1708 34<sup>th</sup> St SE  
address Rio Rancho, NM 87124

FOR: Public Service Company of New Mexico

Joel Ivy  
Joel Ivy, Vice President NM Operations

1/8/2009  
Date

**PATENT**  
**REEL: 022619 FRAME: 0274**

STATE OF NEW MEXICO       )  
  )  
COUNTY OF BERNALILLO    )       ss.

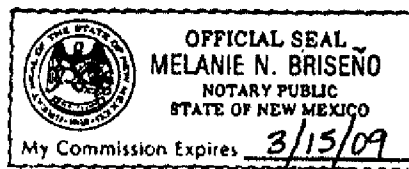
The foregoing instrument was subscribed and acknowledged before me, this 8<sup>TH</sup> day of January, 2009 by Joel Ivy, Vice President of NM Operation for the Public Service Company of New Mexic

Melanie N. Briseño  
Notary Public

My Commission Expires:

3/15/09

Seal:



**Exhibit C**

[INSERT Assignment for Serial No. 10/988,611]

## ASSIGNMENT

THIS ASSIGNMENT of a Patent Application is from the Public Service Company of New Mexico ("PNM" or "Assignor"), a New Mexico corporation, to Gathen Garcia ("Assignee"), whose addresses is set forth on the signature page hereof.

WHEREAS, PNM through its policies and agreements with its employees, was assigned certain inventions conceived and reduced to practice by its employees during the course of their employment, for which PNM filed patent applications with the United States Patent and Trademark Office, which are described below:

<u>Patent Application</u>	<u>Application Filing Date</u>	<u>Entitled</u>
10/988,611	November 16, 2004	UTILITY STATION AUTOMATED DESIGN SYSTEM AND METHOD

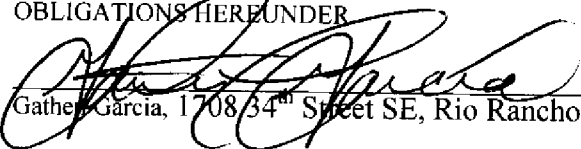
WHEREAS, PNM now desires to assign all its rights, title, and interests in the Patent Application to Assignee;

NOW, THEREFORE, PNM and Assignee agree as follows:

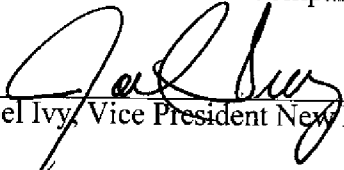
PNM does hereby assign and transfer unto Assignee all its right, title, and interest in and to: (a) the invention(s) described in the Patent Application described above; (b) any technical information, know-how, trade secret, process, procedure, composition, device, method, formula, protocol, technique, software, design, and data which is related to the aforesaid invention(s) and/or that is included in the Patent Application, whether or not covered by the Patent Application(s); (c) all rights in the Patent Application(s) including but not limited to all divisions, reissues, continuations, continuations-in-part, continuing patent applications, substitutions, renewals, extensions filed and all patent(s) issuing thereon in the United States and all foreign countries; and (d) to the extent PNM owns the same under its policies and practices, all improvements to the invention(s) described in the Patent Application(s) hereafter made or invented by PNM (all of the foregoing, (a), (b), (c), and (d) being collectively referred to hereafter as the "Invention"); and (e) the right to assert claims and bring lawsuits for any violation or infringement of any of the intellectual property rights assigned hereby, including all patents issuing on the Patent Applications.

For the purpose of enabling Assignee, its successors and assigns, to obtain, defend and enforce all United States and foreign intellectual property rights in the Invention, PNM shall timely communicate all information, execute all documents, testify in all legal proceedings and take all such other actions necessary or desirable to accomplish such purpose, at Assignee's expense.

THE ASSIGNEE ACKNOWLEDGE BY HIS SIGNATURE HERETO THAT HE HAS READ THE FOREGOING, UNDERSTANDS ITS CONTENTS AND HAS HAD THE OPPORTUNITY TO CONSULT LEGAL COUNSEL OF HIS CHOOSING CONCERNING HIS RIGHTS AND OBLIGATIONS HEREUNDER

  
Gathen Garcia, 1708 34<sup>th</sup> Street SE, Rio Rancho, NM 87124

FOR: Public Service Company of New Mexico

  
Joel Ivy, Vice President New Mexico Operations

4/7/09  
Date

STATE OF NEW MEXICO       )  
  )  
COUNTY OF BERNALILLO    )    ss.

The foregoing instrument was subscribed and acknowledged before me, this 7<sup>TH</sup> day  
of April, 2009 by Joel Ivy, Vice President for New Mexico Operation for the Public Service  
Company of New Mexico

Melanie N. Briseño  
Notary Public

My Commission Expires:

3/19/13

Seal:



**Exhibit D**

[INSERT Assignment for Registration No. 2800577]

## ASSIGNMENT

**THIS ASSIGNMENT** of trademark is from the Public Service Company of New Mexico ("PNM" or "Assignor"), a New Mexico corporation, to Gathen Garcia ("Assignee"), whose addresses is set forth on the signature page hereof (collectively PNM and Assignee the "Parties" and singly "Party").

**WHEREAS**, PNM through its policies and agreements with its employees and contracts with contractors, owns certain trademarks created by its employees and/or contractors during the course of their work on a PNM project, for which PNM sought trademark registration with the United States Patent and Trademark Office, and for which registration was granted as described below:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Registration No.</u>	<u>Registration Date</u>
75718133	May 20, 1999	2800577	December 30, 2003

**Service and Word Mark:** 3D-DASL (hereinafter "Mark"), a copy of which is attached as Attachment A, which is hereby incorporated and made a part of this Assignment.


**WHEREAS**, PNM now desires to assign all its rights, title, and interests in the Mark and any goodwill associated with the use of the Mark to Assignee;

**NOW THEREFORE**, for good and valuable consideration, receipt of which is hereby acknowledged, the Parties agree as follows:

Assignor hereby assigns, sells, and transfers to Assignee all right, title, and interest in and to the Mark and the registration therefore for the United States and throughout the world together with the goodwill associated with the use of the Mark and which is symbolized by the Mark, along with the right to recover for damages and profits for past infringement thereof.

Assignor shall execute and deliver at the request of the assignee all papers, instruments and assignments, and shall perform any other reasonable acts the Assignee may require in order to vest all Assignor's rights, title, and interest in and to the Mark in Assignee and/or to provide evidence to support any of the foregoing in the event such evidence is deemed necessary by the Assignee, to the extent such evidence is in the possession or control of Assignor.

THE ASSIGNEE ACKNOWLEDGE BY HIS SIGNATURE HERETO THAT HE HAS READ THE FOREGOING, UNDERSTANDS ITS CONTENTS AND HAS HAD THE OPPORTUNITY TO CONSULT LEGAL COUNSEL OF HIS CHOOSING CONCERNING HIS RIGHTS AND OBLIGATIONS HEREUNDER.

  
Gathen Garcia

1708 34<sup>th</sup> Street SE  
Rio Rancho, NM 87124



FOR: Public Service Company of New Mexico

Joel Ivy  
Joel Ivy, Vice President New Mexico Operations

4/7/09  
Date

STATE OF NEW MEXICO  
COUNTY OF BERNALILLO

}  
ss.

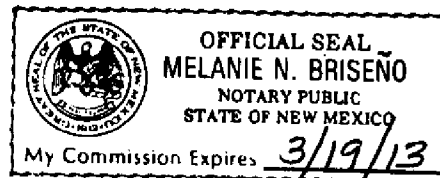
The foregoing instrument was subscribed and acknowledged before me, this  
7<sup>TH</sup> day of April, 2009 by Joel Ivy, Vice President for New Mexico Operation for  
the Public Service Company of New Mexico

Melanie N. Briseño  
Notary Public

My Commission Expires:

3/19/13

Seal:



ATTACHMENT A  
(Sample Image of Mark)

3D-DASL