

## PATENT ASSIGNMENT

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SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
The Texas A&M University System	05/06/2011
RECEIVING PARTY DATA	
Name:	Roberto Carrillo
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PROPERTY NUMBERS Total: 1	
Property Type	Number
Application Number:	12209115
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ATTORNEY DOCKET NUMBER:	C1330/20001
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Total Attachments: 8 source=C133020001Assignment#page1.tif source=C133020001Assignment#page2.tif source=C133020001Assignment#page3.tif source=C133020001Assignment#page4.tif source=C133020001Assignment#page5.tif source=C133020001Assignment#page6.tif source=C133020001Assignment#page7.tif source=C133020001Assignment#page8.tif	

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PATENT  
REEL: 026715 FRAME: 0190



**OFFICE OF TECHNOLOGY  
COMMERCIALIZATION**

The Texas A&M University System

**Release Agreement**

This Release Agreement ("Release") is between The Texas A&M University System ("System"), an agency of the State of Texas, and Robert Carillo ("Inventor"), an individual having an address at Hoyo Nueve #413, Col. Jardines del Campestre, San Pedro Garza Garcia 66264 Nuevo Leon, Mexico and is effective as of the date on which the last party executes this Agreement ("Effective Date").

WHEREAS, Inventor has provided a written disclosure to the System of the following technology:

Title: "Miniscrew Implant Placement Guide Kit"

Identified Inventor(s) : Robert Carillo

OTC File Number: TAMUS 2578

Originally Disclosed on: 08/16/2007

WHEREAS, the above referenced disclosure, a copy of which is attached hereto as Exhibit A, has been the subject of patent applications listed on Exhibit B hereto. For purposes of this Release, the above referenced disclosure and the related patent applications are together referred to as the "Disclosed Technology."

WHEREAS, Inventor has requested that the System's rights in the Disclosed Technology, which were assigned by Inventor to System, be released back to the Inventor. System has reviewed the circumstances of the creation, patentability, and commercial potential of the Disclosed Technology and has determined that a release of rights to Inventor under the terms of this Release is in the best interests of System and the public.

WHEREAS, Inventor avers that no funding has been utilized, in whole or in part, in development of the Disclosed Technology.

WHEREAS, to any extent that rights in the Disclosed Technology are subject to obligations to funding sponsors including the United States government under 35 U.S.C. §200, *et seq.* and/or 37 C.F.R. §401, *et seq.*, this Release is contingent upon approval from such sponsors and Inventor agrees to comply with obligations imposed by the sponsors.

NOW, THEREFORE, the parties agree as follows:

**1. Release and Transfer of Rights**

In accordance with System Policy 17.01.4.5 and subject to the contingencies and other obligations set out herein, System hereby releases and transfers to the Inventor, and to the heirs, executors, administrators and assigns of Inventor, all of the right and interest in and to the Disclosed Technology that is owned by System based on the obligations of assignment from Inventor. If the Disclosed Technology is jointly owned by System and a third party, this Release will apply only to System's undivided interest in the Invention. Upon request, System will execute a simple assignment document for recordation by the Inventor with relevant recordation authorities.

**PATENT**

**REEL: 026715 FRAME: 0191**

### Contingencies upon Release

1.1 In addition to any obligations that may be imposed by any sources of funding used in creation of the Disclosed Technology, the present Release is subject to the following contingencies:

(A) Inventor acknowledges and agrees that this Release is specific and limited to the technology described in the written Invention Disclosure submitted to OTC and any related patent application(s) and that System's relinquishment of rights is strictly limited to the metes and bounds of the written Disclosed Technology. System has not waived any rights in undisclosed aspects and applications, future improvements or modifications, related inventions, or background technology that may be necessary to practice the subject matter of patent claims. Undisclosed aspects and future improvements, modifications and applications must be the subject of further Invention Disclosures to the System Office of Technology Commercialization ("OTC") before any evaluation can be performed and any possible release effected;

(B) To any extent that this Release has been based on false, incomplete, or materially misleading information, this Release is void *ab initio* and System may assert its property rights in the Disclosed Technology;

(C) Inventor agrees to comply with any obligations and requirements originally imposed upon System and rights reserved in the Disclosed Technology by any sponsors of the research or technology that funded efforts leading to the Disclosed Technology; and

(D) As a condition of this Release, the System, including all of its member institutions and agencies, retains and is hereby granted a perpetual, nonexclusive, royalty-free, world-wide license to use the Disclosed Technology in educational, research, demonstration, patient care, and service activities. The following rights are specifically retained by System in consideration of this Release:

(1) The right to publish, and for its employees to publish, scientific findings from research related to the Disclosed Technology;

(2) The royalty-free right to manufacture, have manufactured, and use the Disclosed Technology for System's teaching, research, demonstration, public service, education, and other educationally related purposes;

(3) The right to grant rights in the Disclosed Technology to other academic or non-profit research institutions for the purposes outlined in clauses D.1 and D.2 above; and

(4) In consideration of the System's investment in development of the Disclosed Technology and in consideration for this Release without an otherwise retained royalty, the Inventor hereby grants to System a retained interest that arises only in the event of overwhelming commercial success as follows:

In the first full calendar year, and each succeeding year, in which Proceeds (as defined in Section 3.3, below) exceed USD 50,000,000 (fifty million US dollars) (the "Threshold"), the System shall be owed a lump sum payment of 1% of the total gross sales above the Threshold accrued during that year. The amount to be paid to System will be due within ninety (90) days of the end of the calendar year during which gross sales first reached the Threshold.

i. The cumulative payments due University under this Article 2.1.D.4. shall not exceed \$5,000,000 USD (five million US dollars) for all Disclosed Technology subject to this Release. The Inventor agrees that this obligation shall attach to subsequent owners of the Disclosed Technology.

1.2 This Release and assignment of rights is made personally to the named Inventor. Any rights of any other inventors in the Disclosed Technology are unaffected by this Release and are not transferred by this Release to Inventor. In the case of multiple inventors, the Inventor shall be responsible to determine arrangements, if any, amongst inventors concerning ownership, commercialization and patent prosecution matters.

## **2. Reimbursement of Patent Procurement Costs**

2.1 As of the Effective Date of this Release, Inventor shall be fully responsible for any future patent prosecution, including expenses, relating to the Disclosed Technology.

2.2 Inventor shall reimburse System's documented legal expenses incurred for management of the Disclosed Technology as of the Effective Date as follows:

(A) Following execution of this Release and within thirty (30) days of receipt of invoice from System, payment of up to \$3,000 for reimbursement of System's legal expenses incurred for the response to office action dated August 16, 2010, for U. S. Full Utility Application No. 12/209,115, "System and Processes for Dental Implant Placement," filed 09/11/2008;

(B) Once Proceeds are received, all other of System's past documented legal expenses (current recorded expenses total \$12,222) to be reimbursed from Proceeds (as defined in Section 3.3, below) at an annual rate of no less than 2% of Proceeds, less "Allowed Deductions." Inventor may first deduct from Proceeds the reasonable and documented annual expenses for filing, prosecuting, and maintaining patents and patent applications covering the Disclosed Technology ("Allowed Deductions").

2.3 For purposes of this Release, "Proceeds" means all monies and all other consideration received by Inventor for:

(1) The sale, use, lease, transfer, or other disposition of any product or component whose manufacture, use, sale, offer for sale, or import is covered by any valid claim of any patent covering the Disclosed Technology, or which are made using a method or process whose practice or use is covered by a valid claim of any patent covering the Disclosed Technology;

(2) The performance of a service for customers for a fee or other consideration using a product or component described in clause (1) above, or the practice of a

method or process whose practice or use is covered by a valid claim of any patent covering the Disclosed Technology; or

(3) Consideration of the grant of a license to the Disclosed Technology or any patent covering the same.

2.4 Inventor shall keep full and accurate books of accounts containing all particulars that may be necessary for the purpose of showing the amounts payable to System under this Release. Inventor shall provide to System annual accountings concerning the patenting, use, licensing, sublicensing, sale, transfer, or assignment of the Disclosed Technology, the terms of those transactions and the amounts due Inventor and System, and such other information as System may reasonably request from time to time. Inventor shall make this annual accounting and any payments due within 15 days of each anniversary of the Effective Date. All payments to System will be distributed according to System's standard procedures, except that Inventor will not receive a share of payments to System.

2.5 Inventor shall send payments, annual accountings, and other correspondence to:

Office of Technology Commercialization  
The Texas A&M University System  
3369 TAMU  
College Station, Texas 77843-3369

2.6 Inventor's obligations under this Article 3 will expire upon either of the following, whichever occurs first:

(A) Full reimbursement by Inventor of System's total legal expenses concerning Invention, as described above;

(B) The expiration of the last to expire of any patent covering the Disclosed Technology, abandonment of all patent applications concerning the Disclosed Technology, or final and unappealable determination by a court of competent jurisdiction that any patent claim covering the Disclosed Technology is invalid or any patent unenforceable; or

(C) The expiration of this Release as set forth in Article 8.

### **3. Use of System Resources and Improvements.**

Inventor acknowledges that System has no responsibility to further develop the Disclosed Technology, and System is not obligated to expend any additional funds, equipment, facilities, or other resources towards the development of the Disclosed Technology. Nothing herein prohibits Inventor from continuing to perform research in the field of the Disclosed Technology; however, Inventor may not use any System personnel, students, laboratories, equipment, facilities, funds, or other resources of System or its member institutions to develop, commercialize, patent, market, license, sell, or otherwise commercially develop the Disclosed Technology after the Effective Date without prior written approval from the relevant System member CEO.

### **4. Inventorship**

The Inventor affirms that, according to knowledge and belief, the Identified Inventor(s) are completely and correctly listed. In the event that it is determined that an additional inventor of

the Disclosed Technology exists, all parties to this Release will make the other parties immediately aware of the determination by notifications in writing.

## **5. Indemnification, Representations, Disclaimers, and Limit of Liability**

5.1 Inventor warrants and represents that Inventor has complied with the obligation to fully disclose to System the description and usefulness of the Disclosed Technology.

5.2 Inventor shall indemnify and hold System and its regents, members, officers, employees, students, and agents harmless from and against any and all claims, demands, losses or causes of action related in any way to the production, marketing, or commercialization of the Disclosed Technology, including any determinations of inventorship.

5.3 Inventor shall indemnify and hold System and its regents, members, officers, employees, students, and agents harmless from and against any and all claims, demands, losses or causes of action brought by any inventor(s) listed on any patents or patent applications pertaining to the Disclosed Technology that have not been located or have otherwise refused to join in execution of this Release or including any causes of action related in any way to the development of the Disclosed Technology and to any matters relating to this Release.

5.4 System and its members, regents, officers, employees, students, and agents make no representations and extend no warranties of any kind, express or implied, including but not limited to warranties of merchantability, fitness for a particular purpose, safety, efficacy, approvability by regulatory authorities, time and cost of development, patentability, and breadth of patent rights. System makes no representation as to whether any patent is valid, or as to whether there are any patents now held, or which will be held, by others or by System that might be required for use of the Disclosed Technology. Nothing in this Release confers by implication, estoppel, or otherwise any license or rights to any patents or technology of System other than the Disclosed Technology, whether those patents are dominant or subordinate to the Disclosed Technology. System has no obligation to furnish to Inventor any know-how, technology, or technological information.

5.5 In no event shall System or its regents, members, officers, employees, students, or agents be liable for any indirect, special, consequential, incidental, exemplary, or punitive damages (including, without limitation, damages for loss of profits or revenue) arising out of, or in connection with, this Release or the Disclosed Technology, regardless of whether any party knows or should know of the possibility of those damages.

## **6. General Provisions**

6.1 This Release contains the entire understanding of the parties as to the matters contained herein, and supersedes all other written and oral agreements between the parties as to those matters. The parties may execute other contracts, but those will not change or alter this Release unless expressly stated in writing.

6.2 The laws of the State of Texas govern and determine the validity of this Release and all matters related to this Release, including but not limited to matters of performance, non-performance, breach, remedies, procedures, rights, duties, and interpretation or construction.

6.3 This Release does not create a partnership or joint venture between System and Inventor. Inventor has no right to obligate or bind System in any manner.

6.4 Headings are included for convenience only and will not be used to construe this Release.

6.5 If any provision of this Release is held to be invalid, illegal, or unenforceable in any jurisdiction, the parties shall negotiate in good faith a valid, legal, and enforceable substitute provision that most nearly reflects the original intent of the parties. All other provisions of this Release will remain in full force and effect in that jurisdiction and will be construed in order to carry out the intentions of the parties as nearly as may be possible. The invalidity, illegality, or unenforceability will not affect the validity, legality, or enforceability of any other provisions in any other jurisdiction, so long as the essential essence of the Release remains enforceable.

6.6 Neither party will waive any of its rights under this Release unless the waiver is in writing and signed by that party. No delay or omission of a party in exercising or enforcing a right or remedy under the Release will waive that right or remedy.

## 7. Term of Release

This Release shall expire upon the earliest of (a) twenty (20) years from the Effective Date, (b) the date of the expiration of the last to expire patent filed on Disclosed Technology, or (c) the date of the abandonment of the last patent or patent application filed on Disclosed Technology.

IN WITNESS WHEREOF, this Release has been duly executed by Inventor and System as of the date set forth below.

### SYSTEM REPRESENTATIVES:

Approval Recommended

By: Brett Cornwell  
Brett Cornwell  
Assoc. Vice Chancellor for  
Commercialization  
Office of Technology Commercialization  
The Texas A&M University System

Dated: 5-6-2011

By: James R. Joyce  
James Joyce  
Assoc. VP for Research &  
Commercialization  
Office of Research & Graduate Studies  
Texas A&M Health Science Center

Dated: 5/3/11

### INVENTOR:

By: Roberto Carrillo  
Roberto Carrillo

Dated: 5/21/2011

**Exhibit A: Invention Disclosure**

(cover page; invention disclosure follow)



**Exhibit B: Patents and Patent Applications**

1. **U. S. Provisional Application No. 60/971,522, "System and Processes for Dental Implant Placement," filed 09/11/2007.**
2. **U. S. Full Utility Application No. 12/209,115, "System and Processes for Dental Implant Placement," filed 09/11/2008.**