

PATENT ASSIGNMENT COVER SHEET

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SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
VANDERBILT UNIVERSITY	03/06/2014
RECEIVING PARTY DATA	
Name:	MARCUS MENDENHALL
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PROPERTY NUMBERS Total: 1	
Property Type	Number
Application Number:	13125132
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ATTORNEY DOCKET NUMBER:	FBD-003 #2B-VANDERBILT
NAME OF SUBMITTER:	JAY P. SBROLLINI
SIGNATURE:	/Jay P. Sbrollini/
DATE SIGNED:	04/23/2015
Total Attachments: 4	
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CONDITIONAL ASSIGNMENT AGREEMENT

THIS AGREEMENT, by and between VANDERBILT UNIVERSITY, a non-for-profit corporation, organization and existing under the laws of the State of Tennessee ("Vanderbilt"), and Marcus Mendenhall of 3189 Parthenon Avenue, Unit 1, Nashville, TN 37203 (collectively, the "Inventor(s)"), is effective as of March 10, 2014 (the "Effective Date").

RECITALS

WHEREAS, in the course of their employment by Vanderbilt, the Inventor invented the following invention entitled "System and Methods for Accelerating Simulations of Radiation Treatment" known by the internal reference number VU0911, which is covered by the U.S. patent application serial number 13/125,132 filed on April 20, 2011, and corresponding patent applications WO2010/048074, EP2355708, and CA2741173 entitled "System and Methods for Accelerating Simulations of Radiation Treatment", (hereinafter the "Invention");

WHEREAS, the Inventors disclosed the Invention pursuant to Vanderbilt University's Policy on Technology, Literary and Artistic Works (the "Policy"), and assigned to Vanderbilt his inventor's rights, including patent rights in the Invention;

WHEREAS, to the best of Vanderbilt's knowledge, federal government support was used in the conception or first actual reduction to practice of this Invention;

WHEREAS, the Inventors desire to obtain ownership of the rights in the Invention in order to further develop and commercialize the Invention on their own; and

WHEREAS, Vanderbilt's Center for Technology Transfer and Commercialization ("CTTC") has determined that it will not continue prosecution of patent applications on said Invention and, instead, has agreed to conditionally assign the rights to the Invention to Inventors and grant the Inventors the right to file and prosecute U.S. and foreign patent applications and to obtain Letters Patent thereon in their own names, at their own expense, and to sue and recover for all past infringements, using patent counsel of their own choice, under the following terms and conditions in the Agreement.

NOW, THEREFORE, in consideration of the mutual promises and commitments set forth herein, the Parties hereto agree as follows:

1. Vanderbilt hereby assigns and transfers to the Inventors all of its right, title, and interest in and to the Invention, subject to Inventors' grant to Vanderbilt of a perpetual, royalty-free, worldwide, non-exclusive license to Vanderbilt to:

- (a) allow its employees (faculty and staff) and students to use the Invention for research, education, and patient care purposes, and to make improvements thereto, even if such improvements constitute new inventions; and

- (b) grant a non-transferable, non-sublicensable license to other academic, government or not-for-profit research institutions or foundations for the same uses as above stated in (a);

AND, subject to the below stated additional conditions,

Vanderbilt and Inventors acknowledge and agree that the assignment of the Invention provided hereunder does not include assignment of improvements to the Invention, related inventions, or other intellectual property or proprietary information or know-how that has been or may be made or created by the Inventors or others pursuant to the grant back of rights set forth in Article 1 or to any other background intellectual property of Vanderbilt. In addition, Inventor hereby agrees that he shall not use any rights in or to the Invention, or permit its further assignees and/or licensees to use such rights, to block Vanderbilt or others from commercializing future improvement inventions made pursuant to the grant back of rights stated in this paragraph.

2. The Inventors agree not to use the name of Vanderbilt in any manner related to the commercial development of the Invention except for statements of fact that the Invention was originally invented at Vanderbilt. The Inventors agree to obtain written approval by Vanderbilt prior to making or authorizing any other use of Vanderbilt's name.

3. In consideration of Vanderbilt's Assignment and transfer of the rights in the Invention, the Inventors agree to pay to Vanderbilt two percent (2%) of any consideration (including licensing payments, assignment fees and other transfer fees, royalties from sales of products covered by the Invention, equity liquidations, and other net revenues) received by the Inventors for the licensing, transfer, or other utilization or exploitation of the Invention or products covered by the Invention, after subtracting out-of-pocket expenses incurred in such utilization or exploitation.

4. To the extent the Invention was conceived or reduced to practice with Federal funds, the Inventor agrees to comply with all regulations required by the Federal Government as the second assignee of the Invention. The Inventors acknowledge that the assignment made by Vanderbilt under this Agreement shall be null and void if the Federal Government determines that the Federal Government shall retain title to the Invention. The Inventors shall promptly notify CTTC upon receipt of the decision by the Federal Government to retain title or release title to the Inventors. Inventors agree that Vanderbilt shall have no obligation to refund any amounts of income, fees, or royalties paid to Vanderbilt should the Federal Government retain title to the Invention.

5. Inventors shall provide annually to Vanderbilt, through CTTC, progress reports on the patenting, licensing and development activities for the Invention and reports on any third party use or license of the Invention. Inventors shall provide royalty revenue reports and remit payment of royalties to Vanderbilt on an annual basis beginning at the end of the calendar year of the first commercial sale. Records of such revenue and royalty payments shall be retained by Inventors for five (5) years and be subject to reasonably scheduled audit by Vanderbilt upon its request.

6. As applicable, those Inventors subject to the Vanderbilt University Conflict of Interest and Commitment Policy shall report his activities related to the Invention, on no less than an annual basis and more often if required, and comply with all of Vanderbilt's Conflicts of Interest policies and any conflict management plans the Conflicts of Interest Committee deems necessary.

7. The Inventors agree to indemnify and hold harmless Vanderbilt, including its trustees, officers, faculty, staff, students, agents and representatives, and their respective successors, heirs and assigns, against any liability, damage, loss or expenses incurred by or imposed upon Vanderbilt in connection with any claims, suits, actions, demands or judgments arising out of any theory of law (including, but not limited to, actions in the form of tort, warranty, or strict liability) concerning any product, process or service made, used or sold pursuant to any right granted under this Agreement. The Inventors also agree to include this indemnification obligation in any licenses, transfers or assignments of the Invention to third parties. Failure to observe the condition in the immediately preceding sentence of this paragraph shall make any such license, transfer, or assignment null and void. Inventors and any subsequent licensees, transferees or assignees shall also be required to maintain adequate insurance prior to product sales, naming Vanderbilt as an additional insured, to fulfill the indemnity obligation of this paragraph.

8. Inventors hereby represent and warrant that, as of the Effective Date, he has disclosed in writing to CTTC any and all (i) companies of which he is aware, that have or previously expressed an interest in licensing or otherwise acquiring rights to the Invention; (ii) start-up companies that he has founded, is in the process of founding, or plans to found; (iii) companies in which the he and/or immediate family members own or has the right to acquire equity (other than via an individual retirement account) that cumulatively exceeds 5% of the company's total equity, or exceeds a value of \$10,000; and Inventor confirms that while he was an employee of Vanderbilt he was in compliance with disclosures of these business interests as required by the Conflict of Interest policy. Inventors hereby agree not to license or assign any of the rights in the Invention to any company falling within categories (i), (ii) or (iii) above which was not disclosed to Vanderbilt on or before the Effective Date, as required above.

9. Inventor hereby agrees to continue prosecution of any patent applications in the U.S. describing the Invention and will, at a minimum, take reasonable action with regard to the currently outstanding US office action issued by the USPTO.

10. In the event of a breach of this Agreement by an Inventor, upon fifteen (15) days' notice from Vanderbilt, this Agreement shall automatically terminate and all rights assigned hereby shall revert to Vanderbilt. If a third party has acquired rights in the Invention from an Inventor, he shall be obligated to notify such third party of this paragraph and of the reversion of rights to Vanderbilt.

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Signatures to Follow on Next Page

IN WITNESS WHEREOF, this Agreement has been duly executed by Vanderbilt and the Inventors as of the last date set forth on the following signature page.

AGREED TO AND ASSIGNED
On behalf of VANDERBILT UNIVERSITY:

CBH
Alan Bentley, Assistant Vice Chancellor
Center for Technology Transfer and Commercialization

3/6/14
Date

AGREED TO BY Inventors:

Marcus A. Mendenhall
Marcus Mendenhall

3/11/2014
Date

UNDERSTOOD AND RECOMMENDED:

Daniel M. Fleetwood
Daniel M. Fleetwood
Chair, Electrical Engineering and Computer Science

3/5/14
Date