

Docket No. : 1513-B02.PCT.US

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

RECORDATION FORM COVER SHEET **PATENTS ONLY**

Via Fax No.: (571) 273-0140

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

1. Name of conveying party(ies):

Greg Naterer
Zhaolin (Forest) WANG

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

3. Nature of conveyance:

- (x) **Assignment** () Merger
 () Security Agreement () Change of Name
 () Other: _____

Execution Date: 2012-07-31-2012-08-01-2012-08-09

2. Name and address of receiving party(ies)

Name: **UNIVERSITY OF ONTARIO**
Institute of Technology
 Street Address: **2000, Simcoe Street North**
Oshawa, Ontario
L1H 7K4 Canada

Internal Address: _____

City: _____ State: _____ ZIP: _____

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

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 is:

A. Patent application No.(s) 14/442,007

Patent application Filed on 5/11/2015

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

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

Name: **Franz Bonsang, Patent Agent**
Sc. Registration No. 56638

Street Address: **EQUINOX INC.**
1500, Du Collège St, suite 410
Saint-Laurent, QBC CANADA
H4L 5G6

6. Total number of applications and patents involved: **[1]**

7. Total fee (37 CFR 3.41)..... **\$40.00**
 (x) Enclosed (Form PTO-2038)
 () Authorized to be charged to deposit account

8. Deposit account number: _____

(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.

Franz Bonsang, Patent Agent

Name of Person Signing

/Franz Bonsang/

Signature

Aug. 31, 2016

Date

Total number of pages including cover sheet, attachments, and document: **[10]**

Mail documents to be recorded with required cover sheet information to:
 Commissioner of Patents & Trademarks, Box Assignments
 Washington, D.C. 20231

700519503

PATENT
REEL: 039921 FRAME: 0128

OP \$40.00 14442007

ASSIGNMENT OF RIGHTS

THIS ASSIGNMENT is made and effective as of the date of the last signature

BETWEEN:

Greg Naterer Residing at 700 Garden St, Whitby, ON

Zhaolin (Forest) Wang Residing at 72 Teddington Cres., Whitby ON

(Each an "**Assignor**" and collectively the "**Assignors**"); and

UNIVERSITY OF ONTARIO INSTITUTE OF TECHNOLOGY

2000 Simcoe Street North,
Oshawa, Ontario
L1H 7K4

(the "**Assignee**")

(Each a "**Party**" and collectively the "**Parties**")

WHEREAS the Assignors, while engaged in research at the University of Ontario Institute of Technology ("**UOIT**") have made an Invention (as hereinafter defined);

AND WHEREAS by the UOIT *Intellectual Property Policy*, the Assignors own all right, title and interest in and to the Invention;

AND WHEREAS the Assignee maintains an Office of Technology Transfer and Commercialization ("**OTTC**") whose purpose is to commercialize inventions arising from research at UOIT;

AND WHEREAS the Assignors desire to assign the Invention to the Assignee so that the Invention may be included in one or more of the OTTC knowledge or technology mobilization programs;

NOW THEREFORE in consideration of the terms and mutual covenants hereinafter contained and other good and valuable consideration the sufficiency of which is hereby acknowledged, the Parties hereto agree as follows:

1. Definitions

In this Assignment, unless there is something in the subject matter or context inconsistent therewith, the following expressions have the following meanings:

- a. **"Licensing Agreement"** shall mean a option and/or license agreement between the Assignee and a third party in relation to the Invention or an agreement pursuant to which a third party agrees to purchase from the Assignee all right, title and interest in and to the Invention;
- b. **"Intellectual Property Rights"** shall mean any and all proprietary rights provided under, (i) patent law, (ii) copyright law, (iii) trade-mark law, (iv) design patent or industrial design law, (v) integrated circuit topography or mask work law, or (vi) any other statutory provision or common law principle applicable to this Agreement, including trade secret law, which may provide a right in either ideas, formulae, algorithms, concepts, inventions or know-how generally, or the expression or use of such ideas, formulae, algorithms, concepts, inventions or know-how and any and all applications, registrations, licenses, sub-licenses, franchises, agreements or any other evidence of a right in any of the foregoing;
- c. **"Invention"** shall mean the invention titled "Capture and Hydrogenation of Carbon Dioxide with Thermochemical Cu-Cl and Mg-Cl-Na/K-CO₂ Cycles", as more fully described in the UOIT Confidential Intellectual Property Disclosure attached hereto as Appendix "A";
- d. **"Effective Date"** shall mean the date of last signature on this Assignment; and
- e. **"Net Revenue"** shall mean Gross Revenue less Development Expenses
- f. **"Gross Revenue"** shall mean the proceeds from the sale, lease, transfer, assignment, license, grant of right of access, or other conveyance or grant of rights in respect of intellectual property or intellectual property Rights therein, including without limitation, any license issue fees, option fees, royalties, and equity interests, except that any equity interests, or portion thereof, received by the university shall not be included in "Gross Revenue" unless and until such time as the equity interests, or portion thereof, are sold by the university. The Gross Revenue in a transaction between affiliated parties, or any parties that are otherwise associated with each other or acting in concert, or in any other non-arm's length transaction, will be the greater of: (i) the actual amount paid, and (ii) the amount that would have been paid in a similar transaction at arm's length.
- g. **"Development Expenses"** shall mean all moneys paid to protect, develop, and/or enhance the marketability or any other aspect of intellectual property, including, but not limited to, the drafting, filing, prosecution, maintenance and enforcement of patent or other registrations, marketing expenses, consulting fees, expenses incurred in dealing with equity interests, travel, legal fees, and market research costs. Salaries and general operating expenses of administrative personnel are not included within development expenses.

2. Assignment of Rights

- a. The Assignors hereby assigns to the Assignee all right, title and interest, whatever the same may be (but without any representation or warranty as to the nature, extent or validity thereof) which the Assignors now have or may in the future have in the Invention including without limitation all copyrights, trade secrets and the right to apply for patents in Canada, the United States of America and any other country as well as any divisional, re-examination, reissue or continuation applications which may be filed relating to the Invention and any and all letters patent to be granted and issued therefore, the same to be held and enjoyed by the Assignee to the full end of term for which the said letters patent are granted, as fully and entirely as the same would have been held and enjoyed by the Assignors had this assignment not been made.
- b. The Assignors agree to do all things necessary, including signing of documents where requested, to facilitate, assist, and aid the Assignee in acquiring registration of the Assignee's interest in the Invention.
- c. The Assignors agree to make full and complete disclosure of the Invention to the Assignee, and shall make available to the Assignee any physical embodiments of the Invention and other data that will be or that may be useful to the Assignee in (i) applying for, prosecuting and maintaining Intellectual Property Rights in relation to the Invention; and (ii) its knowledge or technology mobilization program.
- d. If a License Agreement has not been executed within two (2) years following the Effective Date, the Assignee, at any time thereafter, shall have the right, at its sole discretion, to abandon the prosecution and/or maintenance of Intellectual Property Rights. In the event that the Assignee elects to abandon the Intellectual Property Rights in relation to the Invention, the Assignee will give the Assignors at least sixty (60) days prior written notice of its election and offer the Assignors the option to take assignment of all right, title and interest in and to the same Intellectual Property rights. Should the Assignors either elect not to take assignment of the Intellectual Property Rights in relation to the Invention or should the sixty (60) days elapse without an Assignor responding to the notice by the Assignee, the Assignors shall be deemed to have rejected this option to take assignment of the Intellectual Property Rights.
- e. If the Assignors elect to take reassignment of the Intellectual Property Rights in relation to the Invention the Assignee that within thirty (30) days reassign the Invention to the Assignors. The Assignors will assume full legal and financial responsibility for Intellectual Property including all patents, issued or filed in existence at the time of reassignment. The Assignors will at the time of

reassignment reimburse the Assignee for all Development Expenses, as defined above, spent by the Assignees. The Assignors shall also pay to the University 25% of Net Revenues arising from the intellectual Property or 10% of Gross revenue, whichever is greater, on an annual basis no later than the end of the University's fiscal year.

3. Reserved Rights

Notwithstanding the rights granted above, the Assignors shall retain a royalty-free, non-exclusive licence to use the Invention for research and educational purposes, and the Assignors may publish or disclose information relating to the Invention provided that the Assignors provide the Assignee with a draft copy of any proposed publication or disclosure for its review at least thirty (30) days before submission for publication or disclosure.

4. Improvements

In the event that an Assignor develops any modifications, enhancements, upgrades or additions to the Invention (which are owned and controlled solely by an Assignor) ("**Improvements**"), then the Assignor shall promptly inform, in confidence, the Assignee of the Improvements and the Assignee shall have a first right of refusal to take assignment of all right, title and interest in and to such Improvements on terms and conditions to be negotiated in good faith between the Parties.

5. Consideration

- a. In consideration of the rights granted to the Assignee pursuant to this Assignment, the Assignee agrees to pay (subject to subsections 3(b) and 3(c) below) the Assignors fifty percent (50%) of the Net Revenues (the "**Assignors' Share of Revenue**") as set forth in Appendix B hereof.
- b. The Assignors' Share of Revenue shall be paid to the Assignors on or within ninety (90) days following March 31st of each year and such payments will be accompanied by a statement of the Net Revenues received by the Assignee during the previous year along with a computation of the Assignors' Share of Revenue.
- c. In the event that the Assignee receives any payment (in lieu of Net Revenue) other than in cash, then the Assignee shall deliver to the Assignors his/her/their entitlement arising from such payment in the form of consideration received by the Assignee, subject to any transfer restrictions which the Assignee is subject to. If the Assignee is prohibited from distributing such non-cash consideration, then such entitlement shall be held in trust by the Assignee for the Assignors until such time as the Assignee distributes such consideration to the Assignors, which the Assignee will do as soon as reasonably practicable after it is legally entitled to do so.

6. Indemnity

The Assignee agrees to indemnify and save the Assignors harmless from and against any loss arising out of or pursuant to any claims or demands in connection with the Invention and all costs, damages and expenses (including reasonable legal fees) incurred by the Assignors in connection therewith. However, the Assignee shall not be obliged to indemnify an Assignor against any liability or expense that the Assignor may suffer or incur as a result of or based upon any admitted or established wilful misconduct or fraudulent action by the Assignor.

7. Release

Save and except for the right to enforce the terms contained in this Assignment, the Assignors release the Assignee from any and all claims that the Assignors may now have or may in future have in respect of the Invention.

8. Representations & Warranties

- a. Each Assignor represents and warrants that the Assignor has all necessary rights to assign the Invention under this Assignment and that he/she/they has not previously granted any rights that would conflict with such assignment hereunder.
- b. The Assignors represent and warrant that the Assignors are the sole inventors of the Invention.
- c. Except for representations, warranties or conditions expressly made in this Agreement, the Invention and Intellectual Property Rights therein are assigned on an "as is" basis and there are no representations, warranties or conditions, whether expressed or implied, under statute, common law or contract, including without limitation, any with respect to: (a) market readiness, merchantability or fitness for any use or purpose; (b) operational state, character, quality or freedom from defects; or (c) non-infringement of rights of third parties under present or future patents.

9. Notice

All notices required and permitted under this Assignment shall be in writing, and service of all such notices shall be sufficient and complete if and when delivered personally or sent by prepaid registered mail addressed to the Party to be notified, at the address given above or at other addresses of which the Parties have notice in writing.

10. Governing Law

This Assignment shall be governed by and construed in accordance with the laws of the Province of Ontario and the laws of Canada applicable therein.

11. Headings

Headings of Articles and Sections are inserted for convenience of reference only and shall not affect the construction or interpretation of this Assignment.

12. Severability

In the event any term or any part of any term of this Assignment is determined to be void or unenforceable, such term or part of a term shall be considered separate and severable from this Assignment and the remaining terms shall continue in full force and effect.

13. Execution & Delivery

This Assignment may be executed by the Parties in counterparts and may be executed and delivered by facsimile and all such counterparts and facsimiles shall together constitute one and the same assignment.

14. Enurement

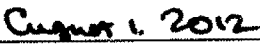
This Assignment shall enure to the benefit of and be binding upon the Parties and their respective successors and assigns.

IN WITNESS WHEREOF the Parties have caused this Assignment to be executed in a legally binding manner.

ASSIGNEE: UNIVERSITY OF ONTARIO INSTITUTE OF TECHNOLOGY



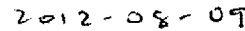
Michael Owen
Associate Provost, Research



DATE



Richard Marceau
Provost



DATE

I/we have authority to bind the university

Assignor:**Witness:**

I hereby declare that I was personally present and did see Greg Naterer, who is personally known to me to be the person named in the above assignment duly sign and execute the same.

SIGNATURE



Greg Naterer

TITLE

Professor and Associate Dean

DATE May 29, 2012

SIGNATURE

PRINT NAME


TITLE

DATE

Assignor:**Witness:**

I hereby declare that I was personally present and did see Forest Wang who is personally known to me to be the person named in the above assignment duly sign and execute the same.

SIGNATURE



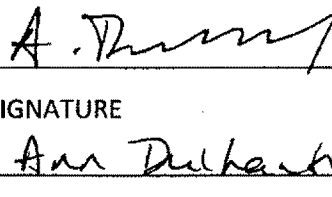
Forest Wang

TITLE

Assistant Research Professor

DATE July 31, 2012

SIGNATURE



PRINT NAME

TITLE

Manager, OTIC

DATE

**APPENDIX A
INVENTION**