

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

EPAS ID: PAT6776505

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
NALCO HOLDING COMPANY	11/01/2020
RECEIVING PARTY DATA	
Name:	ECOLAB USA INC.
Street Address:	1 ECOLAB PLACE
City:	ST. PAUL
State/Country:	MINNESOTA
Postal Code:	55102
PROPERTY NUMBERS Total: 11	
Property Type	Number
Patent Number:	6790817
Patent Number:	7517846
Patent Number:	6260772
Patent Number:	7112559
Patent Number:	D601028
Patent Number:	7838484
Patent Number:	D629984
Patent Number:	D680701
Patent Number:	8671500
Patent Number:	8753453
Application Number:	12203998
CORRESPONDENCE DATA	
Fax Number:	(612)332-9081
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>	
Phone:	6123325300
Email:	cmanthie@merchantgould.com
Correspondent Name:	ANNELIESE MAYER
Address Line 1:	PO BOX 2910
Address Line 2:	MERCHANT & GOULD P.C.
Address Line 4:	MINNEAPOLIS, MINNESOTA 55402

PATENT

ATTORNEY DOCKET NUMBER:	163.1
NAME OF SUBMITTER:	CASEY J. MANTHIE
SIGNATURE:	/Casey J. Manthie/
DATE SIGNED:	06/23/2021

Total Attachments: 13

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page1.tif

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page2.tif

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page3.tif

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page4.tif

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page5.tif

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page6.tif

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page7.tif

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page8.tif

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page9.tif

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page10.tif

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page11.tif

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page12.tif

source=C.2 Ecolab - Contribution Agreement (IP)(Nalco Holding Company to Ecolab USA Inc.(179018039.2)#page13.tif

CONTRIBUTION AGREEMENT

This Contribution Agreement (this “**Agreement**”) is entered into as of January 25, 2021 and made effective as of November 1, 2020 between Nalco Holding Company, a Delaware corporation (“**Contributor**”), and Ecolab USA Inc., a Delaware corporation (“**Contributtee**”). Contributor and Contributtee are hereinafter individually referred to as the “**Party**” and hereinafter collectively referred to as the “**Parties**”.

Recitals

A. Contributtee and Contributor are part of the Ecolab Inc. group of companies (the “**Ecolab Group**”).

B. Contributor is the owner of certain intellectual property relating to the Kay and Pest divisions, whether registered or unregistered, including the registered assets set forth in Exhibit A attached hereto (the “**Kay/Pest IP**”).

C. The Ecolab Group previously completed a series of transactions to streamline its US trading model and centralize its supply chain structure (the “**2018 US Trading Model Transactions**”).

D. In connection with the 2018 US Trading Model Transactions, Contributor wishes to transfer the Kay/Pest IP to Contributtee as of the Effective Time (as defined below) as a contribution to additional paid in capital of the Contributtee pursuant to the terms and conditions set forth in this Agreement.

E. It is the express intention that, for all US Federal income tax and applicable state income and franchise tax purposes, the Transfer constitutes a transaction described in Section 351 of the Internal Revenue Code of 1986, as amended, and corresponding provisions of applicable state laws (and any successor provisions).

F. Capitalized terms used herein, but not otherwise defined shall have the meanings as set forth in Article 7.

Agreement

Therefore, the Parties agree as follows:

ARTICLE 1

Transfer and Assumption

Section 1.1 Effective Time. The transactions contemplated by this Agreement are effective as of 12:02 a.m., Central Time, on November 1, 2020 (the “**Effective Time**”).

Section 1.2 Transferred Assets. Subject to and upon the terms set forth in this Agreement, Contributor hereby contributes, conveys, transfers, assigns, and delivers to Contributtee, and Contributtee hereby accepts from Contributor, all right, title, and interest of every kind, nature, character, or description, whether tangible or intangible that Contributor possesses

and has the right to transfer in the Kay/Pest IP, including, without limitation, the business (within the meaning of 15 U.S.C. § 1060) and goodwill associated with the trademarks (collectively, the “**Transferred Assets**”).

Section 1.3 Assumed Liabilities. Subject to the terms set forth in this Agreement, at the Effective Time, Contributor hereby transfers to Contributor, and Contributor hereby assumes, pays, performs, and discharges when due, the Assumed Liabilities. “**Assumed Liabilities**” means all Liabilities existing or arising at any time, whether before, at, or after the Effective Time, relating to or arising out of the Transferred Assets, including all Liabilities under the agreements, contracts, indentures, mortgages, instruments, security interests, guaranties, licenses, and other arrangements related to the Transferred Assets.

Section 1.4 Retained Liabilities. Even though they may be included within the description of Assumed Liabilities in Section 1.3 above, Contributor will retain and not transfer, and Contributor will not assume, the following Liabilities, which are collectively referred to as the “**Retained Liabilities**”:

- (a) any Liability for taxes relating to, incurred in connection with, or arising from the Transferred Assets for any taxable period (or portion thereof) ending at or before the Effective Time; and
- (b) all Liabilities other than the Assumed Liabilities under Section 1.3 hereof.

Section 1.5 Consent of Third Parties.

(a) Notwithstanding anything to the contrary in this Agreement, this Agreement shall not constitute an agreement to assign or transfer, in whole or in part, any instrument, contract, lease, permit, or other agreement or arrangement or any claim, right, or benefit arising thereunder or resulting therefrom if an assignment or transfer or an attempt to make such an assignment or transfer without the consent of a third party would constitute a breach or violation thereof or affect adversely the rights of Contributor or Contributor thereunder; and any transfer or assignment to Contributor by Contributor of any interest under any such instrument, contract, lease, permit, or other agreement or arrangement that requires the consent of a third party shall only be made subject to such consent being obtained.

(b) Until such consent is obtained, or if an attempted assignment thereof would be ineffective or would adversely affect the rights and obligations of any Party hereto so that Contributor would not, in fact, receive all such rights and obligations, the Parties will cooperate with each other in any arrangement designed to provide for Contributor the benefits of, and to permit Contributor to assume Liabilities under, any such instrument, contract, lease, permit, or other agreement or arrangement and Contributor agrees to pay, perform and discharge when due all Liabilities under any such instrument, contract, lease, permit, or other agreement or arrangement even if such consent is not obtained.

Section 1.6 No Representations or Warranties; As Is, Where Is. The Transferred Assets are transferred hereunder in their “as is, where is” condition. No Party is making any

representation or warranty, express or implied, whatsoever as to the Transferred Assets (including the condition, or value of the Transferred Assets), the Assumed Liabilities, or as to any other matter, including with respect to merchantability or fitness for any particular purpose, and any such representations or warranties are hereby expressly disclaimed. Contributor shall not have any liability to Contributor for damages arising out of the contribution of the Transferred Assets or their use, whether based on warranty, contract, tort, or otherwise.

Section 1.7 Consideration for the Transferred Assets and Assumed Liabilities. Contributor shall contribute the Transferred Assets as well as the Assumed Liabilities to Contributor as a contribution as additional paid in capital in Contributor in the amount as set forth on Schedule 1.7.

ARTICLE 2

Beneficial Rights

Section 2.1 Transfer of Transferred Assets. As of the Effective Time, (a) Contributor conveys, assigns, transfers and delivers the Transferred Assets to Contributor and Contributor acquires and accepts, all of Contributor's economic rights and interest in and to the Transferred Assets, and (b) Contributor assumes all of Contributor's economic risk, encumbrances and obligations with respect to ownership of the Transferred Assets. For the avoidance of doubt, Contributor's economic rights and interest in and to the Transferred Assets include all other income, profits, and gains arising from, attributable to, or inuring to the benefit of the Transferred Assets after the Effective Time. For the avoidance of doubt, Contributor's economic risk, encumbrances and obligations with respect to the Transferred Assets include the Assumed Liabilities and include all risk of economic loss with respect to the Transferred Assets.

Section 2.2 Profits and Losses. Without limitation of the foregoing, (a) in the event Contributor receives any income, profits, or gains attributable to the Transferred Assets, or any property with respect to the Transferred Assets, on or after the Effective Time, it shall do so as custodian or, if possible under applicable law, in trust for and on behalf of Contributor and shall immediately transfer all such income, profits, gains or property to Contributor within ten (10) days of receipt (together with interest thereon at an arm's length rate from the date of receipt); and (b) Contributor shall indemnify Contributor from and against all losses attributable to ownership to the Transferred Assets within ten (10) days of Contributor's notification to Contributor of any such loss (together with interest thereon at an arm's length rate from the date of receipt).

Section 2.3 Remedies. Contributor and Contributor hereby acknowledge that, as of the Effective Time, no conditions (including, without limitation, regulatory approvals) exist that could prevent Contributor from transferring the Transferred Assets to Contributor and Contributor hereby grants to Contributor an equitable remedy of specific performance, or any comparable remedy as may be available in any applicable jurisdictions, to enforce the terms of this Agreement to transfer ownership to the Transferred Assets to Contributor.

Section 2.4 Tax Matters. It is the intent of the Parties to treat the contribution as a complete conveyance of tax ownership of the Transferred Assets for United States federal and state income tax purposes. Each of the Parties hereby agree to such treatment, agree not to take a position contrary to such position for any United States federal or state income tax purposes, and

agree not to take (or fail to take) any action which could preclude such treatment for United States federal or state income tax purposes. The Parties further intend for the contribution to be afforded non-recognition treatment for United States federal income tax purposes under Section 351 of the Internal Revenue Code of 1986, as amended, and the regulations promulgated thereunder.

ARTICLE 3

Covenants

Section 3.1 Taking of Further Action. If, at any time after the Effective Time, any further action is necessary or desirable to carry out the purposes of this Agreement, the Parties hereto will take such lawful action, including to sign such additional documentation, as is reasonably requested by any other Party to fully carry out the transactions contemplated by this Agreement.

Section 3.2 Litigation Services. At all times from and after the Effective Time, each of Contributor and Contributor will use its commercially reasonable efforts to make available to the other, upon reasonable written request, its and its subsidiaries' officers, directors, employees, and agents as witnesses or for providing litigation assistance (such as cooperating in a factual background investigation) to the extent that (a) such persons may reasonably be required in connection with the prosecution or defense of any Action in which the requesting Party may from time to time be involved and (b) there is no conflict in the Action between Contributor and Contributor. A Party providing witness or litigation services to the other Party under this Section 3.2 will be entitled to receive from the recipient of such services, upon the presentation of invoices therefore, payments for amounts relating to disbursements and other out-of-pocket expenses (which shall be deemed to exclude the costs of salaries and benefits of employees who are witnesses), that are reasonably incurred in providing such witness services.

ARTICLE 4

Survival

Section 4.1 Survival of Covenants and Agreements. All covenants and agreements herein shall survive the Effective Time and shall be binding upon and inure to the benefit of the successors and permitted assigns of the Parties.

ARTICLE 5

Representations and Warranties

Section 5.1 Representations and Warranties of Contributor. Contributor hereby represents and warrants to Contributor as follows:

- (a) Contributor is duly organized and validly existing under the laws of the jurisdiction of its formation;
- (b) Contributor is the owner of all rights and interests in and to the Transferred Assets;
- (c) Contributor is fully authorized to transfer the Transferred Assets;

(d) No party has any right to claim the contribution and transfer of the Transferred Assets;

(e) The Transferred Assets are free of all liens and charges and are not encumbered by any security or beneficial right;

(f) Contributor has the requisite corporate or similar power to execute and deliver this Agreement, to perform its obligations hereunder and to consummate the transactions contemplated hereby. The execution and delivery by Contributor of this Agreement, the performance by Contributor of its obligations hereunder and the consummation by Contributor of the transactions contemplated hereby have been duly and validly authorized by all necessary organizational action with respect to Contributor, each such authorization remains in full force and effect and no other corporate proceedings on the part of Contributor are necessary therefor;

(g) This Agreement has been duly executed and delivered by Contributor and, assuming the due execution hereof by Contributor, this Agreement constitutes a legal, valid and binding obligation of Contributor, enforceable against Contributor in accordance with its terms, except to the extent enforceability may be limited by any applicable bankruptcy, reorganization, insolvency, moratorium or other similar applicable laws affecting the rights of creditors generally; and

(h) There is no litigation, governmental proceeding, or investigation pending or, to the knowledge of Contributor, threatened against Contributor, which may call into question the validity, or materially hinder the enforceability or performance, of this Agreement.

Section 5.2 Representations and Warranties of Contributor. Contributor hereby represents and warrants to Contributor as follows:

(a) Contributor is duly organized and validly existing under the laws of the jurisdiction of its formation;

(b) Contributor has the requisite corporate or similar power to execute and deliver this Agreement, to perform its obligations hereunder and to consummate the transactions contemplated hereby. The execution and delivery by Contributor of this Agreement, the performance by Contributor of its obligations hereunder and the consummation by Contributor of the transactions contemplated hereby have been duly and validly authorized by all necessary organizational action with respect to Contributor, each such authorization remains in full force and effect and no other corporate proceedings on the part of Contributor are necessary therefor;

(c) This Agreement has been duly executed and delivered by Contributor and, assuming the due execution hereof by Contributor, this Agreement constitutes a legal, valid and binding obligation of Contributor, enforceable against Contributor in accordance with its terms, except to the extent enforceability may be limited by any applicable bankruptcy,

reorganization, insolvency, moratorium or other similar applicable laws affecting the rights of creditors generally; and

(d) There is no litigation, governmental proceeding, or investigation pending or, to the knowledge of Contributor, threatened against Contributor, which may call into question the validity, or materially hinder the enforceability or performance, of this Agreement.

ARTICLE 6

Other Provisions

Section 6.1 Amendment and Modification. This Agreement may be amended, modified, or supplemented only by written agreement of Contributor and Contributor.

Section 6.2 Waiver of Compliance; Consents. Any failure of a Party to comply with any obligation, covenant, agreement, or condition herein, to the extent legally allowed, may be waived in writing by the others, but any such waiver or failure to insist upon strict compliance with the obligation, covenant, agreement, or condition shall not operate as a waiver of, or estoppel with respect to, any subsequent or other failure. Whenever this Agreement requires or permits consent by or on behalf of any Party hereto, such consent shall be given in writing in a manner consistent with the requirements for a waiver of compliance as set forth in this Section 6.2.

Section 6.3 Transfer and Sales Tax. Notwithstanding any provisions of applicable law, (i) all sales, use, and transfer taxes, and (ii) all governmental charges, if any, payable as a result of the transfer of any of the Transferred Assets hereunder shall be borne equally by Contributor and Contributor. Contributor and Contributor shall cooperate in timely making all filings, returns, reports and forms as necessary or appropriate to comply with the provisions of all applicable laws in connection with the payment of such transfer taxes, and shall cooperate in good faith to minimize, to the fullest extent possible under such laws, the amount of any such transfer taxes payable in connection therewith.

Section 6.4 Existing Liabilities. Notwithstanding anything to the contrary in this Agreement, this Agreement shall not constitute an agreement under which the Transferred Assets shall be regarded, in whole or in part, as payment with respect to any amount of outstanding principal or accrued interest on indebtedness between Contributor and Contributor, nor shall the Transfer affect the rights of the Contributor and Contributor as to any such indebtedness. The Parties acknowledge that as of the Effective Time there is no outstanding indebtedness between the Contributor and the Contributor.

Section 6.5 Notices. All notices, requests, demands, and other communications under this Agreement shall be in writing and shall be deemed to have been duly given (a) on the date of service if served personally on the Party to whom notice is to be given, (b) on the Business Day after delivery to Federal Express or similar overnight courier or the Express Mail service maintained by the United States Postal Service, or (c) on the fifth day after mailing, if mailed to the Party to whom notice is to be given, by first-class mail, registered or certified, return-receipt requested, postage prepaid and properly addressed, to the Party as follows:

(1) If to Contributor:

Ecolab Inc.
Attn: General Counsel
1 Ecolab Place
St. Paul, Minnesota 55102

(2) If to Contributor:

Nalco Holding Company
Attn: General Counsel
1 Ecolab Place
St. Paul, Minnesota 55102

Section 6.6 Assignment. This Agreement shall be binding upon and inure to the benefit of the Parties hereto and their respective successors and permitted assigns. Except as set forth below, neither this Agreement nor the rights or obligations of any Party hereunder shall be assignable or transferable by such Party without the prior written consent of the other Parties hereto; provided, however, that (a) Contributor and Contributor shall each have the right to assign any of its rights under this Agreement to any of its Affiliates and to any purchaser of a material portion of its assets, so long as Contributor or Contributor, as applicable, remains liable for its obligations hereunder notwithstanding such assignment and (b) Contributor and Contributor may each assign its rights hereunder for collateral security purposes to any lenders or agent of lenders or to any assignees of any such lenders or agent.

Section 6.7 Rules of Interpretation. As used in this Agreement:

- (a) “including” means “including without limitation”;
- (b) all dollar amounts are expressed in United States dollars; and
- (c) all references to statutes are deemed to refer to such statutes as amended from time to time or as superseded by comparable successor statutory provisions.

Section 6.8 Headings; Internal References. The Article and Section headings contained in this Agreement are solely for the purpose of reference, are not part of the agreement of the Parties, and shall not affect the interpretation hereof.

Section 6.9 Entire Agreement. This Agreement, including the Schedules and the Annexes hereto, contain the entire agreement among the Parties hereto pertaining to the subject matter hereof and supersedes all prior and contemporaneous agreements and understandings, except those contemplated hereunder and not inconsistent herewith. There are no restrictions, promises, representations, warranties (express or implied), covenants, agreements, or undertakings of the Parties, other than those expressly set forth or referred to in this Agreement.

Section 6.10 Severability. If any provision hereof is held by a court of competent jurisdiction to be invalid, void, or unenforceable, the remainder of the provisions hereof shall continue in full force and effect and shall in no way be affected or invalidated.

Section 6.11 Governing Law and Jurisdiction. This Agreement shall be governed by, and construed in accordance with, the laws of the State of Delaware. Any dispute, controversy or claim arising out of or in relation to this Agreement, including the validity or invalidity thereof, shall be resolved exclusively by the competent courts of the State of Delaware or the United States District Court for the District of Delaware.

Section 6.12 Counterparts. This Agreement may be executed in two or more counterparts and delivered by e-mail or facsimile, all of which taken together shall constitute one instrument.

ARTICLE 7

Certain Definitions

“Action”: any action, suit, arbitration, inquiry, proceeding, or investigation by or before any court, governmental body or agency, or arbitrator.

“Affiliate”: has the meaning set forth in Rule 12b-2 of the regulations promulgated under the Securities Exchange Act of 1934.

“Agreement”: as defined in the Preamble above.

“Assumed Liabilities”: as defined in Section 1.3 above.

“Business Day”: any day other than a Saturday, Sunday, or a day that is a statutory holiday under the laws of the United States or the State of Minnesota.

“Contributtee”: as defined in the Preamble above.

“Contributor”: as defined in the Preamble above.

“Effective Time”: as defined in Section 1.1 above.

“Kay/Pest IP”: as defined in the Preamble above.

“Liabilities”: all losses, claims, judgments, lawsuits, damages (including punitive damages), penalties, fines, liabilities (including strict liability), obligations, encumbrances, liens, taxes, costs, interest, expenses (including reasonable legal and accounting fees), defense costs, or other amounts due, whether known or unknown, asserted or unasserted, absolute or contingent, accrued or unaccrued, liquidated or unliquidated, and due or to become due.

“Retained Liabilities”: as defined in Section 1.4 above.

“Transfer”: as defined in the Recitals above.

“Transferred Assets”: as defined in Section 1.2 above.

(Signature Page Follows)

The Parties have executed this Agreement as of the date first written above.

CONTRIBUTOR:

NALCO HOLDING COMPANY

By: David F. Duvick
Name: David F. Duvick
Title: Assistant Secretary

CONTRIBUTE:

ECOLAB USA INC.

By: Michael C. McCormick
Name: Michael C. McCormick
Title: Executive Vice President, General
Counsel and Secretary

(Signature Page to Contribution Agreement)

PATENT
REEL: 056631 FRAME: 0950

Exhibit A
Kay/Pest IP

(see attached)

Schedule Section 1.7
Consideration for Transferred Assets and Assumed Liabilities

Contributor shall contribute the Transferred Assets as well as the Assumed Liabilities to Contributor as a contribution of additional paid in capital in the amount of [●]¹.

¹ NTD: Ecolab/EY to provide amount based on book value.