

## PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1  
Stylesheet Version v1.2

EPAS ID: PAT7294033

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT
<b>NATURE OF CONVEYANCE:</b>	ASSIGNMENT
<b>CONVEYING PARTY DATA</b>	
<b>Name</b>	<b>Execution Date</b>
UNIVERSITY OF ROCHESTER	10/23/2019
<b>RECEIVING PARTY DATA</b>	
<b>Name:</b>	JOHN R. MARCIANTE
<b>Street Address:</b>	780 SALT RD.
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<b>City:</b>	WEBSTER
<b>State/Country:</b>	NEW YORK
<b>Postal Code:</b>	14580-9709
<b>Name:</b>	WILLIAM R. DONALDSON
<b>Street Address:</b>	250 EAST RIVER ROAD
<b>City:</b>	ROCHESTER
<b>State/Country:</b>	NEW YORK
<b>Postal Code:</b>	14623
<b>Name:</b>	RICHARD ROIDES
<b>Street Address:</b>	250 EAST RIVER ROAD
<b>City:</b>	ROCHESTER
<b>State/Country:</b>	NEW YORK
<b>Postal Code:</b>	14623
<b>PROPERTY NUMBERS Total: 1</b>	
<b>Property Type</b>	<b>Number</b>
<b>Patent Number:</b>	8044655
<b>CORRESPONDENCE DATA</b>	
<b>Fax Number:</b>	
<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>	
<b>Email:</b>	payoung@kilpatricktownsend.com
<b>Correspondent Name:</b>	KILPATRICK TOWNSEND & STOCKTON LLP
<b>Address Line 1:</b>	1100 PEACHTREE STREET
<b>Address Line 2:</b>	SUITE 2800
<b>Address Line 4:</b>	ATLANTA, GEORGIA 30309

PATENT

<b>ATTORNEY DOCKET NUMBER:</b>	091569-0737786 (000000US)
<b>NAME OF SUBMITTER:</b>	PHOEBE YOUNG
<b>SIGNATURE:</b>	/Phoebe Young/
<b>DATE SIGNED:</b>	04/22/2022

**Total Attachments: 8**

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**AGREEMENT FOR RELEASE OF INVENTION RIGHTS  
AND ASSIGNMENT OF RIGHTS TO ROYALTIES**

WHEREAS, John R Marciante, William R Donaldson, Richard Roides ("Inventors") have conceived and disclosed to University of Rochester, an invention titled "Method and Apparatus for Measurement of Optical Pulses with Enhanced Dynamic-Range and Increased Bandwidth", UR Technology Number 3-11155-07026 ("Invention"); and

WHEREAS, the said Invention was conceived and/or first reduced to practice under the auspices of University of Rochester, a State of New York non-profit, tax-exempt, educational institution located in Rochester, New York (referred to herein as "Rochester"); and

WHEREAS, rights of the inventors and Rochester in the Invention are governed by the terms of the University of Rochester Policy on Intellectual Property and Technology Transfer dated February 1, 1997, and revised November 1, 2004, June 13, 2013 and October 21, 2013 and as may be further updated; and

WHEREAS, Faculty Inventor acknowledges the US Government has certain rights in the invention and that rights to the Invention are subject to certain terms and conditions imposed by US Government; and

WHEREAS, inventors assert they have made a full disclosure of the Invention and of all third party interest of which Inventors are aware.

WHEREAS, Rochester has incurred expenses in the filing of U.S. Patent Applications Serial No. 12/114,956, (US issued Patent no. 8,044,655) drawn to the Invention ("Patent Expenses"); and

WHEREAS, pursuant to the University of Rochester Policy on Intellectual Property and Technology Transfer, Rochester has determined that it does not wish to participate in the sale or licensing of the Invention, and that it is willing to release to the Faculty Inventors Rochester's interest therein, subject to Faculty Inventors' agreement to share revenue received as described in the Agreement;

**NOW, THEREFORE**, the parties hereto agree as follows:

1. Subject to DOE approval of Rochester's request to assign Invention rights to Inventors, Rochester hereby releases, conveys, assigns and transfers to the Faculty Inventors, and to their heirs, executors, administrators and assigns, and Faculty Inventors hereby accept the release, conveyance, assignment and transfer from Rochester of all of its right, title and interest in and to the Invention, including, without limitation, any patents (if filed) specifically covering said Invention (Technology ID 3-11155-07026) and any and all know how and materials in regards to said Invention, free and clear of any and all encumbrances held in favor of or by third parties thereto.

2. Due to the imminent deadline for payment of the 8<sup>th</sup> year maintenance fee due for US 8,044,655, Inventors have requested and Rochester has agreed to instruct its Patent Annuity Service provider to pay the fee and Inventors have agreed to reimburse Rochester for the fee and associated costs in an amount not to exceed \$2,400.00 in full, within 30 days after Rochester this Agreement is executed.

3. Faculty Inventors shall pay Rochester [REDACTED] percent) of Faculty Inventors' share of revenue received from the commercialization of the invention toward reimbursement of Patent Expenses (as defined below) until such Patent Expenses have been completely reimbursed. As of the date hereof, patent expenses billed to and paid by Rochester equal [REDACTED] USD), (the "Patent Expenses").

4. Revenue Sharing. Once Patent Expenses have been fully paid and cumulative sales of products and services have reached a combined [REDACTED] USD), Faculty Inventors shall share with Rochester [REDACTED] percent) of revenue received by Faculty Inventors from the commercialization of the invention.

5. Faculty Inventors, on behalf of themselves and their heirs, executors, administrators and assigns, shall keep full, true, and accurate books of accounts containing all particulars that may be necessary for the purpose of showing the amounts payable to Rochester hereunder. Faculty Inventors shall provide to Rochester annual accountings concerning the patenting, use, licensing, sublicensing, sale, transfer or assignment of the invention, the terms thereof and the amounts due Faculty Inventors and Rochester therefrom and such other information as Rochester may reasonably request from time to time. Such Annual Accounting will be made within fifteen (15) days of each anniversary of the date of execution of this Agreement. All payments to Rochester will be distributed according to standard procedures, except that Faculty Inventors will not receive a share of payments to Rochester.

Within fifteen (15) days of the third anniversary of the date of execution of this Agreement, and each anniversary thereafter, the Faculty Inventors shall have the right to reassign the invention back to Rochester thereby releasing the Faculty Inventors from their obligations under this Agreement. Under such reassignment, Rochester will have the absolute right to any revenues received from the invention with no further obligation to the Faculty Inventors, except the Faculty Inventors, following such reassignment, shall be entitled to receive their portion of the inventors' share of any royalties Rochester distributes as a result of commercialization of the invention after the reassignment.

6. Faculty Inventors represent that, to their knowledge, they are the only inventors of the invention. Faculty Inventors further agree that if other individuals contribute to the invention, then those additional contributions will be contingent upon the Faculty Inventors obtaining agreements assigning full ownership and control of those additional contributions to the Faculty Inventors without cost to Rochester; provided, however, that if and to the extent any such rights are determined to have been assigned or are required to be assigned to Rochester, it shall assign or cause the same to be assigned to Faculty Inventors. The Faculty Inventors hereby grant to Rochester, a perpetual irrevocable, non-exclusive, non-transferable, royalty-free license to practice said invention internally for educational and research purposes only (the "Reservation of Rights"). Faculty Inventors hereby release, now and forever, any and all claims, known or unknown as of the Effective Date, they have or may have against Rochester that relate to Rochester's handling, management, or commercialization of the invention and any related Intellectual Property.

7. Faculty Inventors shall indemnify and hold Rochester and its trustees, directors, officers, employees and affiliates harmless from and against any and all claims, demands, losses or causes of action (together, "Claims") related in any way to the production, marketing or commercialization by Faculty Inventors of the invention; provided, however, that in no event shall Faculty Inventors have any obligation whatsoever for or on account of any such Claims based on or otherwise resulting from



negligent acts or misconducts or omission on the part of Rochester, including, without limitation, a breach of this Agreement or under its Reservation of Rights.

8. Payment checks shall be made payable to "University of Rochester" and payments and correspondence sent to:

University of Rochester  
UR Ventures  
Box URV  
601 Elmwood Avenue  
Rochester, NY 14642  
Attn: Contracts Administrator, UR Ventures

9. Faculty Inventors understand that said Invention is being assigned to them for their own personal activities. Rochester does not have any responsibility to further develop the Invention, and Rochester shall not be obligated to expend any additional funds (including without limits any further patent prosecution or maintenance payments), equipment, facilities or other resources. Faculty Inventors agree not to use any Rochester funds, equipment, facilities, or other resources to patent, market, license, sell or otherwise commercially develop said Invention after execution of this Agreement without Rochester's prior written approval and full reimbursement of the costs of such use. Faculty Inventor understands that rights being released to him or her cover only the present invention and not future related inventions or improvements to the present invention that may be subsequently conceived as research continues. The foregoing notwithstanding, Faculty Inventors are free to perform continued research at Rochester relating to the Invention. The rights of Faculty Inventors and Rochester in any improvements to the Invention or new inventions stemming from this continued research at Rochester will be governed by, to the extent applicable, the terms of the University of Rochester Policy on Intellectual Property and Technology Transfer current at that time.

10. EXCEPT AS OTHERWISE EXPRESSLY SET FORTH IN THIS AGREEMENT, ROCHESTER, ITS TRUSTEES, DIRECTORS, OFFICERS, EMPLOYEES, AND AFFILIATES MAKE NO REPRESENTATIONS AND EXTEND NO WARRANTIES OF ANY KIND, EITHER EXPRESS OR IMPLIED, INCLUDING BUT NOT LIMITED TO WARRANTIES OF MERCHANTABILITY, FITNESS FOR A PARTICULAR PURPOSE, VALIDITY OF PATENT RIGHTS CLAIMS, ISSUED OR PENDING, AND THE ABSENCE OF LATENT OR OTHER DEFECTS, WHETHER OR NOT DISCOVERABLE. NOTHING IN THIS AGREEMENT SHALL BE CONSTRUED AS A REPRESENTATION MADE OR WARRANTY GIVEN BY ROCHESTER THAT THE PRACTICE BY FACULTY INVENTORS OF THE INVENTION GRANTED HEREUNDER SHALL NOT INFRINGE THE PATENT RIGHTS OF ANY THIRD PARTY OR OTHER PATENT RIGHTS OF ROCHESTER. NO LICENSE IS PROVIDED OR IMPLIED TO FACULTY INVENTORS TO OTHER PATENT RIGHTS OF ROCHESTER, INCLUDING BUT LIMITED TO OTHER PATENT RIGHTS OF ROCHESTER NECESSARY TO PRACTICE THE INVENTION. IN NO EVENT SHALL EITHER PARTY BE LIABLE TO THE OTHER PARTY (AND IN THE CASE OF ROCHESTER, ITS TRUSTEES, DIRECTORS, OFFICERS, EMPLOYEES) OR ANY AFFILIATE THEREOF FOR INCIDENTAL OR CONSEQUENTIAL DAMAGES OF ANY KIND, INCLUDING ECONOMIC DAMAGE OR INJURY TO PROPERTY AND LOST PROFITS, REGARDLESS OF WHETHER ROCHESTER SHALL BE ADVISED, SHALL HAVE OTHER REASON TO KNOW, OR IN FACT SHALL KNOW OF THE POSSIBILITY.

11. This Agreement may not be assigned without the prior written mutual consent of the parties.

12. This Agreement shall be governed by the laws of the State of New York.



IN WITNESS WHEREOF, this release and assignment has been duly executed by Rochester and the Faculty Inventors as of the date set forth below.

FACULTY INVENTOR

By: John R. Marciante

Name: *John R. Marciante*

Date: 23 Oct 2019

UNIVERSITY OF ROCHESTER

By: *[Signature]*

Name: *Robert Cunningham*

Date: 10/23/2019

NON-PETITIONING INVENTOR STATEMENT

Grantee/Contractor Organization: University of Rochester

UR Ventures Case Number: 3-11155-07026

Disclosure Title: Method and Apparatus for Measurement of Optical Pulses with Enhanced Dynamic-Range and Increased Bandwidth

Inventor(s) John R Marciante; William R Donaldson; Richard Roides

Grant Number: DE-FC52-92SF19460

EIR Number: 7047101-07-0011 Text

I am a co-inventor of the above referenced invention disclosure. It is my understanding that the University of Rochester has elected not to retain title to this invention and that University of Rochester may permit one or more of the inventors to request a title waiver from the U.S. Government.

I hereby certify that I do not wish to request a waiver of title from the U.S. Government for the above referenced invention.

  
Inventor

Date: 10-9-2019

  
Inventor

Date: 10-10-2019

## Patent Report

The report you requested is displayed below.

Click on the Invention Report Number to go directly to the selected invention report record.

Click on the Patent Docket Number to go directly to the selected patent record.

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Invention Report Number: [7047101-07-0011](#)  
Grantee/Contractor Organization: UNIVERSITY OF ROCHESTER  
Grantee/Contractor Organization Code: 7047101  
DOE S Number: T-103338  
Confirmatory License Accepted Date:  
Confirmatory License Reject Date:  
Government Support Clause Accepted Date:  
Government Support Clause Reject Date:  
Patent Docket Number: [07-0011-01](#)  
Provisional Patent Application Number: 60/916,059  
Filing Date of the Provisional Patent Application: 05/04/2007  
Non-Provisional Patent Application Number: 12/114,956  
Filing Date of the Non-Provisional Patent Application: 05/05/2008  
PCT Patent Application Number:  
Filing Date of PCT Patent Application:  
Patent Number: 8044655  
Patent Issue Date: 10/25/2011  
Patent Expiration Date: 11/14/2028  
Type of Patent Application: ORD  
U.S. Patent Title: Method and Apparatus for Measurement of Optical Pulses with Enhanced Dynamic-Range and Increased Bandwidth  
Patent Keyword(s):

### Patent Inventor(s):

- Richard G Roides
- William R Donaldson
- John R Marciante

### Foreign Filings:

Patent Status: ASSIGN TO INVENTOR(S)  
Third Party Name:  
Parent Patent Docket Number:  
Parent Patent Organization Code:  
Other Related Inventions:

### Other Organizations to View Patent:

Patent Creation Date: 05/22/2007 01:13 PM  
Patent Last Updated Date: 10/24/2019 11:28 AM  
Confirmatory License Document: [Confirmatory License](#)  
Confirmatory License Rejection Comment:  
Final Patent Rights Determination:  
Government Support Clause Document: [Government Support Clause](#)  
Government Support Clause Rejection Comment:  
Patent Other Documents:

[Waiver - RIR](#)

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## Young, Phoebe

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**From:** Piasso, Jooba <jooba.piasso@[REDACTED].gov>  
**Sent:** Tuesday, April 12, 2022 11:23 AM  
**To:** Young, Phoebe  
**Subject:** RE: RESPONSE REQUESTED FW: EIR 7047101-07-0011/ DOE DE-FC52-92SF19460

\*\*CAUTION: External Email\*\*

Phoebe,

The acknowledgment of rights have been confirmed and approved. Please continue to keep our office updated on licensing and maintenance fee payments.

Thank you,

Jooba

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**From:** Young, Phoebe <PAYoung@kilpatricktownsend.com>  
**Sent:** Tuesday, April 12, 2022 9:48 AM  
**To:** Piasso, Jooba <jooba.piasso@[REDACTED].gov>  
**Cc:** Largent, Craig <clargent@kilpatricktownsend.com>  
**Subject:** [EXTERNAL] FW: RESPONSE REQUESTED FW: EIR 7047101-07-0011/ DOE DE-FC52-92SF19460

Good morning, Jooba –

As a reminder to the email below, we await your confirmation that that DOE has approved of the assignment of the University of Rochester's rights to the inventors as stated in Section 1 of the Agreement for Release of Invention Rights and Assignment of Rights to Royalties.

Please provide confirmation at your earliest opportunity.

Thank you,  
Phoebe

### Phoebe Young

Patent Specialist  
Kilpatrick Townsend & Stockton LLP  
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**From:** Young, Phoebe  
**Sent:** Monday, April 11, 2022 9:41 AM  
**To:** 'Piasso, Jooba' <jooba.piasso@[REDACTED].gov>  
**Cc:** Largent, Craig <clargent@kilpatricktownsend.com>; John Marciante <[john.marciante@ramphotonics.com](mailto:john.marciante@ramphotonics.com)>  
**Subject:** RE: RESPONSE REQUESTED FW: EIR 7047101-07-0011/ DOE DE-FC52-92SF19460

Good morning, Jooba –

Please see the attached email acknowledgements from each inventor regarding their understanding of government use rights in the patent and promise to keep your office updated on licensing and maintenance fee payments.

Please confirm that DOE has approved of the assignment of the University of Rochester's rights to the inventors as stated in Section 1 of the Agreement for Release of Invention Rights and Assignment of Rights to Royalties (also attached).

Thank you,

Phoebe

**Phoebe Young**

Patent Specialist

Kilpatrick Townsend & Stockton LLP

Suite 600 | 1400 Wewatta Street | Denver, CO 80202

office 303 607 3289 | fax 303 571 4321

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