

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

EPAS ID: PAT7371043

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
THE GOVERNING COUNCIL OF THE UNIVERSITY OF TORONTO	03/02/2019
RECEIVING PARTY DATA	
Name:	FINISAR CORPORATION
Street Address:	1389 MOFFETT PARK DRIVE
City:	SUNNYVALE
State/Country:	CALIFORNIA
Postal Code:	94089
PROPERTY NUMBERS Total: 1	
Property Type	Number
Patent Number:	11119275
CORRESPONDENCE DATA	
Fax Number:	(202)420-2201
<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:	12024202200
Email:	WashingtonDocketing@BlankRome.com, judy.yeddo@blankrome.com
Correspondent Name:	BLANK ROME LLP - II-VI
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ATTORNEY DOCKET NUMBER:	150287-02902
NAME OF SUBMITTER:	JUDY YEDDO
SIGNATURE:	/Judy Yeddo/
DATE SIGNED:	06/08/2022
Total Attachments: 10	
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ASSIGNMENT OF RIGHTS AGREEMENT

THIS AGREEMENT is made and effective as of the 27th day of November, 2018 (the "Effective Date")

B E T W E E N:

THE GOVERNING COUNCIL OF THE UNIVERSITY OF TORONTO, a corporation vested with the government, management and control of the University of Toronto by the *University of Toronto Act, 1971* and having offices at Banting Institute, 100 College Street, Suite 413, Toronto, ON M5G 1L5, Canada

(hereinafter the "Assignor")

- and -

FINISAR CORPORATION, a manufacturer of optical communication components and subsystems with an office located at 1389 Moffett Park Drive, Sunnyvale, CA, U.S.A.

(hereinafter the "Assignee")

(individually a "Party", collectively the "Parties")

WHEREAS the University entered into a Sponsored Research and Collaboration Agreement ("SRA") with the Assignee, effective November 23, 2015, *as further amended October 23, 2016 and October 27, 2017*, for a project entitled "*Si photonic platform SiN for a low cost Course Wavelength Division Multiplexing (CWDM) solution*" (the "Project"); and

WHEREAS the Project sponsored by the Assignee was led by Prof. Joyce K. Poon of the Department of Electrical and Computer Engineering at the University, and

WHEREAS under the terms of the SRA and in the performance of the Project, Joyce Kai See Poon, Jared Carl Mikkelson, Antoine Bois, Zheng Yong ("University Inventors") while employed by the University of Toronto in collaboration with certain co-inventors from Finisar Corporation created a series of inventions as listed and more fully set forth in the Confidential Invention Disclosures under Schedule "A" appended hereto (collectively, the "Inventions"); and

WHEREAS pursuant to Section 2.2 (c) of the SRA, *herein incorporated by reference*, the

Parties understand that these Inventions developed under the joint collaboration are Jointly Owned with the Assignee on an equal and undivided basis; and

WHEREAS pursuant to Section 2.2 (f) of the SRA, the Assignee has been granted an exclusive option to purchase all right, title and interest in the Jointly Owned Inventions and related Intellectual Property Rights; and

WHEREAS the Assignee is desirous of acquiring all of the Assignor's right, title and interest, world-wide in the Jointly Owned Inventions and related Intellectual Property Rights for commercial exploitation; and

WHEREAS the University is willing to assign its entire right, title and interest in the Jointly Owned Inventions and related Intellectual Property Rights to the Assignee for the pre-approved purchase price set forth in the SRA; and

WHEREAS to facilitate this assignment of rights by the University to the Assignee, the University Inventors have assigned all of their rights, title and interest in and to their respective Inventions to the University by way of separate internal assignments to the University ("Inventors' Assignments"), appended hereto under Schedule "B".

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

1. Definitions

The following terms have the following meanings in this Agreement:

"Affiliate" shall mean, with respect to any Person, any other Person directly or indirectly controlling, controlled by or under common control with the first Person. The term "control" means the ability to direct the management and policies of such Person, whether through ownership of equity, by contract or otherwise;

"Assigned Assets" mean the Inventions and related Intellectual Property Rights;

"Confidential Information" means the specific terms and conditions set forth in this Agreement, the know-how, and any information, which is non-public, confidential or proprietary in nature, including, without limitation, business information, trade secrets, and any information related to the Inventions, related technology, Patents or Intellectual Property Rights, whether written, oral or in electronic form, provided that tangible materials are marked as confidential, and provided that information given orally is identified as confidential at the time of disclosure, and confirmed as confidential in writing within fifteen (15) days, but shall not include information that: (i) is or becomes generally available to the public other than as a result of any act by a receiving Party to this Agreement; (ii) is rightfully received from a third party without similar restriction or

without breach of this Agreement; (iii) a receiving Party is able to demonstrate, in writing, was known to it on a non-confidential basis; or (iv) was independently developed by a receiving Party without the use of any of the Confidential Information;

"Patents" means the patents and/or patent applications listed in Schedule "C" and includes divisions, re-examination or renewals based on the foregoing patents and/or patent applications, any patents which may issue on, from or as a result of any of the foregoing and any reissue of said patents. The Parties hereto may, by mutual written agreement, amend Schedule "C" to include or update the details of any Patent filed for the Inventions. Any such amended Schedule "C" shall be appended to this Agreement and shall form an integral part of this Agreement;

"Patent Costs" means the legal and other fees incurred directly in the process of establishing and maintaining the legal protection of the rights in the Inventions;

"Intellectual Property Rights" means all Patents, copyrights, trade names and other intellectual property rights related to the Inventions, whether registered or not, owned by or licensed to the Assignor and further set forth under Schedule "C";

"Inventions" means the inventions listed and set forth under Schedule "A" hereof; and

"University" means the University of Toronto.

2. Assignment of Rights

Subject to the terms and conditions of this Agreement, the Assignor hereby assigns to the Assignee, all right, title and interest in and to the Assigned Assets (*but without any representation or warranty as to the nature, extent or validity thereof*), the right to apply for patents in every country, the right to sublicense to its Affiliates, receive any letters patent that may issue from any such applications, and the right to sell or license the Assigned Assets.

3. Retained Licenses

Notwithstanding the rights granted above, the Parties confirm, acknowledge and agree that the Assignor retains a royalty-free, non-exclusive, perpetual, irrevocable license to use the Assigned Assets for non-commercial, research, educational and administrative purposes, without cost and in perpetuity.

4. Patent Prosecution

- (a) **Patent Prosecution by Assignee:** Assignee shall continue to bear the responsibility to prosecute and maintain the Patents in accordance with its standard practices. Assignee shall have sole discretion with regard to patent filing and patent

prosecution matters. All Patent Costs associated with the prosecution, maintenance of any Patents filed for the Inventions and listed in Schedule "C" and any other patent applications filed thereon, including provisional, regular, continuation, continuation-in-part and divisional applications, patents issuing thereon and any reissue or extension thereof, occurring on or after the Effective date of this Agreement shall be the responsibility of the Assignee. Assignee shall also be responsible, at its own discretion for the costs associated with the enforcement and defense of any patents that issue for the Inventions.

- (b) **Patent Prosecution Support:** Assignor shall provide input and such assistance to Assignee, as Assignee may reasonably request, with regard to patent prosecution matters, and will also co-operate with Assignee on the signing of all patent and legal documents and such other matters without unreasonable delay to affect the transfer of Intellectual Property Rights to the Assignee.

5. Consideration

- (a) **Payment.** As consideration for the assignment of the Assigned Assets to the Assignee, the Assignee shall pay the Assignor a purchase price (the "Fee") of One hundred and fifty thousand United States dollars (US\$150,000.00) within ninety (90) days from the date of last signature on the Agreement. For greater certainty, the Fee shall not include any liens or encumbrances, or any deductions for third party payments, disbursements, patent expenses, legal costs, or taxes.
- (b) **Payment to Assignor.** The Fee set out herein shall be made via a cheque made payable to *"The Governing Council of the University of Toronto"*.
- (c) **Payment to University Inventors.** Assignor shall be solely responsible for calculating and distributing to the University Inventors their share of income in accordance with Assignor's own policy. The Assignee shall not be responsible for any payment to the University Inventors under or in connection with this Agreement.

6. Confidential Information

It is contemplated that, from time to time during the course of the performance of this Agreement, either Party may disclose its Confidential Information to the other Party. Each Party shall not: (a) use or disclose Confidential Information received from the other Party for any purpose other than the performance of the receiving Party's obligations hereunder; or (b) disclose Confidential Information to any third party. Each Party shall take such reasonable measures to maintain the other Party's Confidential Information as confidential as it takes to protect its own proprietary and confidential information, and in any event no less than a reasonable degree of care. Each Party shall be responsible for

the imposition of the confidentiality provisions provided for herein upon its own staff, consultants and other advisors prior to disclosing any Confidential Information to such representatives.

7. Disclaimers

The Assigned Assets are assigned to the Assignee by the Assignor on an "as is" basis, and the Assignor disclaims all representations, warranties and conditions of any kind, whether express or implied, statutory or otherwise, including without limitation:

- (a) all representations, warranties and conditions as to the patentability, validity, scope or enforceability of the Assigned Assets;
- (b) all representations, warranties and conditions that any use of the Assigned Assets will be free from infringement of intellectual property rights of any third party; and
- (c) all representations, warranties and conditions as to quality, merchantable quality, merchantability or fitness of the Assigned Assets for any particular purpose.

8. Termination

- (a) In the event that the Assignee fails to pay the Fee as outlined under Section 5 and is not able to cure the breach within ninety (90) days of notification of the failure to pay by the Assignor, the Parties hereto acknowledge and agree that any portion of the Fee which has been paid to the Assignor shall be forfeited by the Assignee and shall remain the property of the Assignor. Further, any rights granted herein by the Assignor to the Assignee shall immediately terminate.
- (b) Termination of this Agreement shall not relieve any of the Parties of obligations accrued under this Agreement prior to the date of termination.

9. Indemnity

The Assignee shall indemnify and save the Assignor harmless from and against any loss arising out of or pursuant to any claims or demands in connection with the Assigned Assets and all costs, damages and expenses (including reasonable legal fees) incurred by the Assignor and in connection therewith, except where such claims are caused by the Assignor's use of the Assigned Assets contemplated under Section 3 herein.

10. Release

Save and except for the right to enforce the terms of this Agreement, the Assignor releases the Assignee from any and all claims that the Assignor may now have or may in

future have in respect of the Assigned Assets.

11. Further Assurances

The Assignor agrees to do all acts necessary and to execute all documents necessary or desirable, at the Assignee's cost and expense, to fulfill the provisions of this Agreement, to give the Assignee the full benefit of this Agreement and to secure and evidence ownership of the Assigned Assets in favour of the Assignee.

12. Notices

Notices under this Agreement will be sent to the Parties as follows or to such other person as a Party may designate in writing:

(a) **In the case of a notice to the Assignor:**

The Governing Council of the University of Toronto
Innovations & Partnerships Office
Banting Institute, 413-100 College Street,
Toronto, ON M5G 1L5, Canada

Attention: Jennifer Fraser
Title: Director, Innovations
Tel: 416.946-5515
E-mail: jen.fraser@utoronto.ca

(b) **In the case of a notice to the Assignee:**

For Technical/Scientific Matters:

Finisar Corporation
1389 Moffett Park Drive
Sunnyvale, CA 94089, U.S.A.

Attention: Daniel Mahgerefteh
Title: Director of Technology

Tel: 310-721-1955
Email: daniel.mahgerefteh@finisar.com

With a copy to (for Patent/Legal Matters):

Finisar Corporation
1389 Moffett Park Drive
Sunnyvale, CA 94089, U.S.A.

Attention: Christopher E. Brown
Title: Executive Vice President and Chief Counsel

Tel: 781-453-8948
Email: chris.brown@finisar.com

Any notice given by personal delivery shall be conclusively deemed to have been given on the day of actual delivery thereof and, if given by registered mail, on the second business day following the deposit thereof in the mail.

13. Miscellaneous

- (a) Titles used in this Agreement are for the purposes of convenience only and shall not be used in the interpretation of this Agreement. The attached schedules form part of this Agreement.
- (b) This Agreement supersedes any discussions or other agreements between the Parties and is the entire agreement of the Parties with respect to its subject matter. No change or modification will be valid unless it is in writing and signed by both Parties.
- (c) The Parties are independent contractors, and there is no joint venture or partnership formed hereby.
- (d) This Agreement will be governed by and construed in accordance with the laws of the Province of Ontario in Canada. In the event that a court of competent jurisdiction holds any provision of this Agreement to be invalid, such holding will have no effect on the remaining provisions of this Agreement, which will continue in full force and effect.
- (e) This Agreement binds and inures to the benefit of the Parties hereto and their respective heirs, successors and permitted assigns.
- (f) This Agreement may be executed by signatures delivered by facsimile transmission or delivered electronically in optically scanned form; and/or it may be simultaneously executed by the Parties in multiple counterparts, each of which will be considered to be an original instrument, and all of which taken together, where each Party has executed at least one counterpart, will constitute one and the same instrument.

- (g) In the event that any terms or any part of any term of this Agreement is determined to be void or unenforceable by a court of competent jurisdiction, such term or part of a term shall be considered separate and severable from this Agreement and the remaining terms shall continue in full force and effect.

[REMAINDER OF PAGE LEFT INTENTIONALLY BLANK;
SIGNATURE PAGE FOLLOWS]

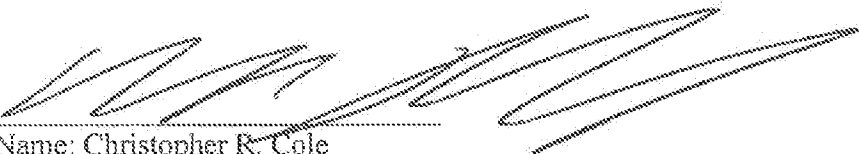
IN WITNESS WHEREOF, the Parties have caused this Agreement to be executed as of the Effective Date.

**THE GOVERNING COUNCIL OF THE
UNIVERSITY OF TORONTO**

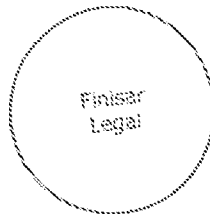
Per: 
Name: Jennifer Fraser
Title: Director, Innovations

Date: 2 March 2019

FINISAR CORPORATION

Per: 
Name: Christopher R. Cole
Title: Vice President, Advanced Development

Date: 1 March 2019



SCHEDULE "A"

LIST OF CONFIDENTIAL INVENTION DISCLOSURES

(See attached for copies of Disclosures)

Disclosure ID	Invention Title	Disclosure Date
10003189	High Efficiency Grating-to-Grating Optical Coupling for Multi-chip Integration	Jul 28, 2016
10003194	Birefringence Control of Silicone Nitride-on-Silicon Optical Waveguides and Photonic Circuits	Aug 3, 2016
10003215	Birefringence Compensation by Serially Varying the Waveguide Width	Aug 29, 2016
10003351	Wavelength Filtering and Polarization (de)multiplexing via Non-Adiabatic Transitions	May 5, 2017
10003606	Adiabatic Polarization Rotator-Splitter	May 10, 2018
10003607	Adiabatic Polarization Rotator Combiner	May 10, 2018