

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

Assignment ID: PATI758248

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
Abbott Ball Company	01/15/2025
RECEIVING PARTY DATA	
Company Name:	United States Government Administrator of NASA
Street Address:	300 E Street, SW
City:	Washington
State/Country:	DISTRICT OF COLUMBIA
Postal Code:	20546-0001
PROPERTY NUMBERS Total: 1	
Property Type	Number
Patent Number:	8182741
CORRESPONDENCE DATA	
Fax Number:	2164336790
<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:	2164333663
Email:	Robert.Earp@nasa.gov, Shawanda.Craven@nasa.gov
Correspondent Name:	Robert H. Earp, III
Address Line 1:	21000 Brookpark Rd.
Address Line 2:	M.S. 142-7
Address Line 4:	Cleveland, OHIO 44135
ATTORNEY DOCKET NUMBER:	ABT-0004US (LEW 18476-1)
NAME OF SUBMITTER:	Shawanda George
SIGNATURE:	Shawanda George
DATE SIGNED:	01/15/2025
Total Attachments: 4	
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Assignment to the Government and License to the Contractor (Previously Elected Invention)

WHEREAS, Abbott Ball Company (The Contractor) a corporation organized and existing under the Laws of the State of Connecticut, and having its principal place of business at 19 Railroad Place, West Hartford, CT 06110

, the Contractor having elected to retain title under the provisions of 35 U.S.C. § 202 to Subject Invention made in performance of work under a contract between the Contractor and the Government of the United States of America (The Government), the Subject Invention being identified as:

Serial No.: 12/544,742 Filed: 08/20/2009
Patent Number: 8,182,741 Issued: 05/22/2012
Application Executed on: 08/20/2009 Contract Number:
Title: Ball Bearings Comprising Nickel-Titanium and Methods of Manufacture Thereof

Inventor(s): Christopher Dellacorte (NASA GRC) and Glenn Glennon (Abbott Ball Company)

NASA Case No.: LEW-18476-1

WHEREAS, the Government as represented by the Administrator of the National Aeronautics and Space Administration (NASA), is desirous of acquiring an assignment of the invention disclosed in said application and other rights and benefits herein granted; and

NOW THEREFORE, in consideration of the contract and other benefits attributable to the contractual relationship, the Contractor hereby assigns and transfers to the Government the full and exclusive right in and to said invention within the United States of America, its territories and possessions, and the entire right, title and interest in and to said application, and any applications continuing therefrom and such Letters Patent as may issue therefrom.

The Contractor also grants to the Government, an assignment of the foreign rights in and to said invention, including rights of priority under the International Convention of Paris (1883) as amended.

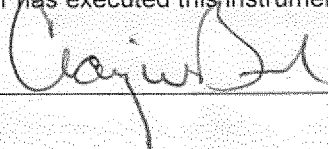
The Contractor hereby covenants that it has the right to grant the foregoing assignments.

The Contractor further agrees to make, execute and/or deliver to the Government, upon request, but at the expense of the Government, any and all data, drawings, notes, reports, information, papers, documents, affidavits, statements, or other items necessary in the prosecution of said application and of any applications continuing therefrom or applications for reissue or reexamination of said Letters Patent, or of any foreign patent application, continuing therefrom, and to assist the Government in every way in protecting said invention as may be required, provided that any expense arising through such assistance will be paid by the Government.

FURTHER, the Contractor hereby retains, pursuant to NASA FAR Supplement, Subpart 18-27.3, a revocable, nonexclusive, royalty-free license throughout the world in the Subject Invention in each patent application filed in any country on the invention and in any resulting patent in which the Government acquired title. The license extends to the Contractor's domestic subsidiaries and affiliates, if any, within the corporate structure of which the Contractor is a part and includes the right to grant sublicenses of the same scope to the extent the Contractor was legally obligated to do so at the time the contract was awarded. The license is transferable only with the approval of NASA, except when transferred to the successor of the part of the Contractor's business to which the invention pertains. The Contractor's domestic license may be revoked or modified by NASA to the extent necessary to achieve the expeditious practical application of the Subject Invention pursuant to an application for an exclusive license submitted in accordance with the Department of Commerce Patent Licensing Regulations. This license will not be revoked in that field of use or the geographical areas in which the Contractor has achieved practical application and continues to make the benefits of the invention reasonably accessible to the public. The license in any foreign country may be revoked or modified at the discretion of NASA to the extent the Contractor, its licensees, or its domestic subsidiaries or affiliates have failed to achieve practical application in that foreign country. Before revocation or modification of the license, NASA will furnish the Contractor a written notice of its intention to revoke or modify the license, and the Contractor will be allowed 30 days (Or such other time as may be authorized by NASA for good cause shown by the Contractor) after the notice to show cause why the license should not be revoked or modified. The Contractor has the right to appeal, in accordance with the procedures set forth in the Department of Commerce Patent Licensing Regulations, from any decision concerning the revocation or modification of its license.

The Contractor has executed this instrument by its legally authorized representative on

SIGNED _____



NAME (Type or print)

CRAIG W. BOND

TITLE (Of Corporate Officer)

President.

NOTE - This instrument conveys title to NASA after application has been filed by SB, CU or NP contractors.

From: [Craig Bond](#)
To: [Earp, Robert Harris. \(GRC-G000\); drodrigues@cantorcolburn.com](#)
Cc: [Craven, Shawanda \(GRC-G000\); Craig Bond](#)
Subject: [EXTERNAL] RE: URGENT - Abbott Ball assignment to govt needed for Maintenance Fee Payments
Date: Wednesday, January 15, 2025 3:33:46 PM
Attachments: [image001.png](#)
[Abbott Nitinol011525.pdf](#)

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Sorry, this took longer than anticipated. We wanted to continue to keep these patents longer however the cost without any benefit forced us to not renew. I have signed the release to you. All three were scanned together and are attached.

Craig W. Bond
President/CEO
The Abbott Ball Company
+1 860-236-5901

From: Earp, Robert Harris. (GRC-G000) <robert.earp@nasa.gov>
Sent: Tuesday, January 14, 2025 4:16 PM
To: Craig Bond <cbond@abbottball.com>; drodrigues@cantorcolburn.com
Cc: Craven, Shawanda (GRC-G000) <shawanda.craven@nasa.gov>
Subject: URGENT - Abbott Ball assignment to govt needed for Maintenance Fee Payments
Importance: High

You don't often get email from robert.earp@nasa.gov. [Learn why this is important](#)

Dear Craig and Dr. Rodrigues:

NASA and Abbott Ball co-own three U.S. patents: 8,182,741; 8,377,373; and 9,393,619. NASA recently became aware that Abbott decided NOT to pay the maintenance fees for these cases. In such situations, NASA sometimes determines that it would like to pay the maintenance fees and keep the patents in force. NASA has decided to do so in this case. It is my understanding that Abbott has been paying the Small Entity maintenance fees for these cases. Payments made by NASA must be made under the Large Entity schedule.

For NASA to pay these maintenance fees, it is my understanding that NASA needs to enter the Patent Office record and change the correspondence address to NASA and change the fee payment to the Large Entity charge. To do this, we must file an assignment from Abbott to NASA for each of these cases. In consideration for these assignments, NASA's standard practice is to enable our partner to retain a royalty-free license to practice the patents. Attached are the Assignments to the government (after previously election) forms for each case.

Unfortunately, time is of the essence as the increase in Maintenance Fee charges is set to go

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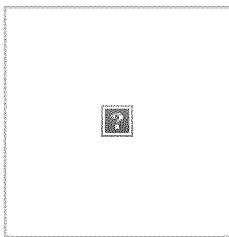
into effect 1/19/25. As such, NASA would greatly appreciate Abbott's urgent return of these executed Assignments so NASA can handle these matters immediately.

I'm also sending this email to Dr. Rodrigues, your identified outside counsel, to ensure proper transmission if you are no longer receiving emails. As such, NASA would greatly appreciate an immediate response indicating that at least this email transmission has been properly received by either you or Dr. Rodrigues. I am happy to discuss this situation in greater detail if necessary.

If you have any questions, please contact me.

Regards,

Bob Earp



Robert H. Earp, III
Patent Counsel
Office of the General Counsel
NASA Glenn Research Center
Desk: 216.433.3663 || Legal Office (Main Line): 216.433.4322
EM: Robert.Earp@nasa.gov

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