

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

Assignment ID: PATI846560

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
SEQUENCE:	3
CONVEYING PARTY DATA	
Name	Execution Date
ILLINOIS INSTITUTE OF TECHNOLOGY	09/16/2020
RECEIVING PARTY DATA	
Individual Name:	Hyun-Soon L Chong PhD.
Street Address:	10 W 35th St
City:	Chicago
State/Country:	ILLINOIS
Postal Code:	60616
PROPERTY NUMBERS Total: 6	
Property Type	Number
Patent Number:	9446995
Patent Number:	10842893
Patent Number:	10441695
Patent Number:	10556873
Patent Number:	9115094
Patent Number:	10189803
CORRESPONDENCE DATA	
Fax Number:	
<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:	(312)5673000
Email:	asutherland@iit.edu,yzhang147@iit.edu
Correspondent Name:	Ashley Marie L Sutherland
Address Line 1:	10 W 35th St
Address Line 4:	Chicago, ILLINOIS 60616
NAME OF SUBMITTER:	Ashley-Marie Sutherland
SIGNATURE:	/Ashley-Marie Sutherland/
DATE SIGNED:	02/27/2025
This document serves as an Oath/Declaration (37 CFR 1.63).	

Total Attachments: 20

source=Chong Portfolio Assignment to Inventors 20200916 FJH signed_JC[97]#page1.tiff

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September 16, 2020

Hyun-Soon Chong, Ph.D.
Illinois Institute of Technology
10 West 35th Street
Chicago, IL 60616

Ref: PCT/US Non-Provisional Patents/Patent Applications; Chong portfolio

(IIT-245, IIT-245-P, IIT-245-CIP, IIT-245-PCT; IIT-265, IIT-265-P, IIT-265-CIP; IIT-277, IIT-277-P, IIT-277-P-CON, IIT-277-PCT)

Dear Professor Chong:

On behalf of Illinois Institute of Technology ("IIT" or "University"), I would like to thank you for your research and scholarly endeavors, and to recognize and support your efforts toward commercialization of your research outcomes and work products. As you know:

- 1) Two United States non-provisional patent (Pat. No. 9,115,094 and Pat. No. 10,556,873) were issued, and one PCT application (App. No. WO2009US34902) were filed, all titled "Bimodal Ligands with Macrocyclic and Acyclic Binding Moieties, Complexes and Compositions Thereof, and Methods of Using", for the subject matter of your invention disclosure entitled " Bimodal Ligands with Macrocyclic and Acyclic Binding Moieties, Complexes and Compositions Thereof, and Methods of Using" (IIT reference No.: IIT-245, IIT-245-CIP, IIT-245-PCT);
- 2) two United States non-provisional patents (Pat. No. 9,446,995 and Pat. No. 10,189,803) were issued, titled "Synthesis of Therapeutic and Diagnostic Drugs Centered on Regioselective and Stereoselective Ring Opening of Aziridinium Ions", for the subject matter of your invention disclosure entitled " Synthesis of Therapeutic and Diagnostic Drugs Centered on Regioselective and Stereoselective Ring Opening of Aziridinium Ions" (IIT reference No.: IIT-265 and IIT-265-CIP);
- 3) one United States non-provisional patent (Pat. No. 10,441,669) was issued, one United States non-provisional patent application (App. No. 16/562,577), and one PCT patent application (App. No. WO2014US59276) were filed, titled "Multifunctional Chelators, complexes, and compositions thereof, and methods using same", for the subject matter of your invention disclosure entitled "



Multifunctional Chelators, complexes, and compositions thereof, and methods using same" (IIT reference No.: IIT-277-P, IIT-277-CON, and IIT-277-PCT).

Above all the patents and patent applications are referred herein as "Invention" or "Patent(s)".

This letter serves as a formal notification to you that IIT has elected to withdraw from further involvement in the protection or commercial application of the Invention and is granting Patent Rights, defined below, to the Invention to you, pursuant to Article 1, Section E of Appendix K of the IIT Faculty Handbook. "Patent Rights" means any United States, foreign or international patents and/or patent applications covering the Invention (or its use or manufacture) as listed below:

IIT No.	Application No.	Patent No.	Application Date	Inventor	Title	Country
IIT-245	12/806,754	9,115,094	Aug 20, 2010	Hyun-Soon Chong	Bimodal Ligands with Macrocyclic and Acyclic Binding Moieties, Complexes and Compositions Thereof, and Methods of Using	United States
IIT-245-CIP	14/834,516	10,556,873	Aug 25, 2015	Hyun-Soon Chong	Bimodal Ligands with Macrocyclic and Acyclic Binding Moieties, Complexes and Compositions Thereof, and Methods of Using	United States
IIT-245-PCT*	WO2009US34902	n/n	Feb 23, 2009	Hyun-Soon Chong	Bimodal Ligands with Macrocyclic and Acyclic Binding Moieties, Complexes and Compositions Thereof, and Methods of Using	International
IIT-265	13/896,524	9,446,995	May 17, 2013	Hyun-Soon Chong	Synthesis of Therapeutic and Diagnostic Drugs Centered on Regioselective and Stereoselective Ring Opening of Aziridinium Ions	United States
IIT-265-CIP	15/270,651	10,189,803	Sep 20, 2016	Hyun-Soon Chong	Synthesis of Therapeutic and Diagnostic Drugs Centered on Regioselective and Stereoselective Ring Opening of Aziridinium Ions	United States
IIT-277-P	15/027,104	10,441,669	Oct 6, 2014	Hyun-Soon Chong	Multifunctional Chelators, complexes, and compositions thereof, and methods using same	United States
IIT-277-PCT*	WO2014US59276	n/n	Oct 6, 2014	Hyun-Soon Chong	Multifunctional Chelators, complexes, and compositions thereof, and methods using same	International
IIT-277-CON	16/562,577	n/n	Sep 6, 2019	Hyun-Soon Chong	Multifunctional Chelators, complexes, and compositions thereof, and methods using same	United States

*PCT application(s) expired and continued with U.S. application(s).



Accordingly, IIT hereby agrees to and does assign to Inventors the University's worldwide rights, title and interest in and to said Invention, **subject to the following terms and conditions listed below.**

1. This assignment is conditioned expressly on Inventors' prior compliance with all obligations under applicable IIT policy to adequately and accurately disclose in writing the Invention and all corresponding data that would assist IIT in identifying and negotiating with potential licensees. IIT reserves all rights not expressly granted herein.
2. IIT will only assign an equal, undivided interest in the Invention to all inventors who have a corresponding obligation to assign inventions to IIT and who have disclosed such interest to IIT pursuant to a written invention disclosure. You understand and agree that Inventors shall be and hereby are jointly and severally liable to IIT for any and all obligations set forth herein. It is your responsibility and that of your co-inventors (if any) to determine in a separate agreement, to which IIT is not a party, arrangements for commercialization and apportionment of royalties or revenues.
3. Effective Date, Sponsor Approval Date, Assignment Date and Recordation. (i) "Effective Date" shall be the date the Office of Technology Development ("OTD") receives this letter signed by the last of the Inventors; (ii) "Sponsor Approval Date" is the date the University obtained sponsor approval(s) if such approval(s) is required as specified in 4(a); (iii) "Assignment Date" is effective as of Effective Date if no sponsor approval(s) is required or Sponsor Approval Date if sponsor approval(s) is required as specified in 4(a); and (iv) IIT shall record the assignment with the U.S. Patent and Trademark Office within three months from Assignment Date.
4. You understand that IIT's assignment of Invention rights **shall be conditioned further as follows:**
 - a) Sponsor Approval. If the Invention was funded by either an industrial sponsor or a government agency, it is your sole responsibility to comply strictly with any government approval process, including completing, signing and submitting any necessary forms (for example, the Inventor Waiver Request Form), and abiding by any applicable governmental requirements. You understand and agree that there is never a guarantee that the sponsors will permit this required consent and that the process of obtaining such consent can take several months.
 - b) Government Reporting/Compliance Responsibility. If the Invention was funded by a government agency, after the Sponsor Approval Date you will be solely responsible for complying with any required reporting and notice obligations, including but not limited to iEdison reporting system.



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- c) Liability for Future Patent Expenses. Following the Effective Date, any and all expenses related to prosecuting, securing and/or maintaining a patent or other protections for the Invention are now solely your responsibility.
- d) Exclusion of Related Inventions. This assignment covers only the Patent Rights based upon the specific Invention covered by the invention disclosure, and will not cover “future inventions” or “related inventions” which may arise out of your laboratory, or to any “background rights” that may be needed to practice the Invention. The only Patent Rights assigned are those expressly mentioned in this letter. This Assignment does not and will not cover any continuation-in-part applications, where new matter is added that is not covered by the Assignment.
- e) Protection of University from Liability. Upon execution by University of this Assignment, you agree to indemnify, hold harmless and defend the University, and each of its trustees, officers, directors, employees, students and agents, against any and all claims, suits, losses, damages, costs, fees, penalties and expenses, including reasonable attorneys’ fees, regardless of the theory or basis therefor, that may thereafter arise from, be related to or resulting from the Invention or the exercise of any rights granted herein, or your breach of this Assignment.
- f) Non-exclusive Right to University. IIT reserves and retains a world-wide, perpetual, fully paid up, royalty free, and transferrable to another research institution, license for the right to make, have made or use the Invention for its own research, including sponsored research and collaborations with other research institutions, and for educational purposes.
- g) Government Right. If the Invention was funded by a government agency, you acknowledge that the U.S. federal government may retain a royalty-free, non-exclusive, non-transferable license to practice any government-funded invention claimed in any Patent Rights as set forth in 35 U.S.C. §201 of the Bayh-Dole Act (35 U.S.C. §§200-212) and as implemented at 37 CFR 401 and the regulations promulgated thereunder, as amended, or any successor statutes or regulations. You understand and agree that you will take no action or cause a third party to take any action that would frustrate or impair the federal government’s exercise of this right in whole or part.
- h) Conflict of Interests. This Assignment does not release employees of the University from obligations under the University’s Policies and Regulations on Conflict of Interest, and/or relative to any other existing or future intellectual property.
- i) Notices. Send all reports, notices, change of address, payments to: (i) Office of Technology Development, 10 West 35th Street Suite 10F9-1 Chicago, IL 60616; and (ii) a copy to Office of General Counsel, 10 West 35th Street, 19th Floor, Chicago, IL 60616.

Your request for the immediate assumption of such rights and obligations as described herein shall be indicated by signing below, and returning a copy of the letter to technologydevelopment@iit.edu. If a signed copy of this letter is not returned within thirty (30) days, you will be deemed NOT to have requested rights to the Invention. We look forward to



assisting you with future inventions and creative works, and remain available if you have any questions regarding the foregoing.

Sincerely,

Fred J. Hickernell, Ph.D.
Professor of Applied Mathematics
Vice Provost for Research

cc: All inventors
Inventor's attorney (if known)

AGREED AND ACKNOWLEDGED BY INVENTOR(S)

Hyun-Soon Chong

10/1/20

Date



March 13, 2024

Dr. Hyun-Soon Chong
Professor
Department of Chemistry
Illinois Institute of Technology

VIA E-MAIL ONLY to: chong@itt.edu

Re: Inventor Waiver Request Decision

Grantee:	Illinois Institute of Technology
EIR Reference Number:	3553001-08-0001
Funding Agreement Numbers:	CA102637; CA112503
Subject Invention:	Bimodal ligands with macrocyclic and acyclic binding moieties, complexes, and compositions thereof, and methods of using
Inventor:	Hyun-Soon Chong
Patent Applications:	14/834,516 ¹
Patents:	10,556,873 ² ; 9,115,094 ³

Dear Dr. Chong:

I write on behalf of the National Institutes of Health (NIH) to respond to your request to permit title to the above-referenced Subject Invention made under an NIH Funding Agreement with the Illinois Institute of Technology to be transferred to the Dr. Hyun-Soon Chong.

NIH has evaluated your request under 35 U.S.C. §202(c), (d) and the regulations set forth at 37 C.F.R. § 401.9 and determined that the Government has insufficient interest to retain title and/or patent rights in or to the Subject Invention. Based on this review, NIH approves the assignment of ownership of the Subject Invention to you, conditioned on your agreement to the following guidelines, statutes, and regulations ("Conditions"), including reporting to, and receipt by, the NIH Office of Extramural Research of any reports and documentation required by these Conditions.

IMPORTANT NOTICE: Final NIH approval of your Inventor Waiver Request is not complete until:

¹ Non-Provisional Patent Application 14/834,516 filing date 08/25/2015.

² Patent Number 10,556,873 issued 02/11/20.

³ Patent Number 9,115,094 issued 08/25/2015.

- (1) The Inventor (Dr. Dr. Hyun-Soon Chong), registers in iEdison (<http://www.iEdison.gov>) for continued required reporting to NIH of this Subject Invention;
- (2) A copy of this Decision Letter signed by Dr. Chong agreeing to the terms and conditions of this NIH Inventor Waiver decision and is returned to the NIH at <http://www.nist.gov/iedison> ; and
- (3) The Subject Invention is transferred by the NIH from the ILLINOIS INSTITUTE OF TECHNOLOGY to the new iEdison account established by Dr. Chong. This transfer will occur within 3 business days of the completion of the above two tasks.

Following thirty (30) days of the date of this NIH Invention Decision letter if items (1) and (2) above have not been finalized, this NIH Invention Decision letter is rescinded, and Dr. Chong and the ILLINOIS INSTITUTE OF TECHNOLOGY will need to submit a new application for the transfer of this Subject Invention.

The Conditions of this waiver:

- (A) You agree that the Subject Invention and you will be bound by, and remain subject to, 35 U.S.C. §§ 200-212 and 37 C.F.R. Part 401 and the provisions cited therein, and any other Federal Government rights reserved under applicable laws and regulations as if you were the original NIH Grantee. In particular, but not limited thereto:
 - (1) You agree to the Government's retained non-exclusive, non-transferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the Subject Invention worldwide for the Government;
 - (2) You agree to provide a confirmatory license and statement of government interest for all patent applications and any issued patents claiming the Subject Invention;
 - (3) You agree to the obligations and conditions set forth and required by 37 C.F.R. Part 401, including:
 - (a) Filing, within one (1) year of the date of this letter, a patent application on each of the Subject Inventions or earlier than one (1) year, if necessary, prior to the end of any statutory period wherein valid patent protection can be obtained within the United States;
 - (b) Providing the NIH with documentation of any patent application numbers, confirmatory licenses, filing and/or application dates and inclusion of the Federal Support Clause, as provided in 37 C.F.R. §401.14(f)(4), within the text of the issued patent and any patent applications or their equivalents;
 - (c) Submitting annual utilization reports detailing utilization-related activities related to the Subject Inventions; and
 - (d) Maintaining any patents and/or patent applications covering the Subject Inventions, unless notice is provided to NIH of any decisions not to continue the prosecution of a patent application, pay maintenance fees, or defend in a reexamination or opposition proceeding on a patent, in any country, not less than thirty (30) days before the expiration of the response period required by the relevant patent office.

- (B) You agree that the use and licensing of the Subject Invention will be in compliance with both the NIH's "Sharing Biomedical Research Resources: Principles and Guidelines for Recipients of NIH Grants and Contracts" 64 Fed. Reg. Page 72090, (23 Dec 1999) and the NIH's "Best Practices for the Licensing of Genomic Inventions: Final Notice" 70 Fed. Reg. Page 18413 (11 Apr 2005);
- (C) You are bound by the Inventor Certification submitted as part of the request for retention of rights in these Subject Invention; and specifically agree that:
- a. You will be bound by any conditions imposed on the above-referenced institution and at least those conditions that would apply to a small business firm under paragraphs (d)(1) and (3), (f)(4), (h), (i) and (j) of the clause at 37 CFR 401.14(a), referred to as "Standard patent rights clauses."
 - b. "Rights to the subject invention in the United States **may not be assigned to any third party without the approval of the Federal agency**, except where such assignment is made to an organization which has as one of its primary functions the management of inventions, provided that such assignee will be subject to the same provisions as the contractor." 35 U.S.C §202 and 37 C.F.R 401.14.
 - c. The Co-Inventors must submit a separate request for NIH's approval to assign rights to any third party following the NIH Procedures for Requests for Approval of Third Party Assignment available at: <https://www.nist.gov/iedison>
- (D) You further agree that within thirty (30) days from the date of this NIH Decision Letter Dr. Rabinowitz will register in iEdison for continued reporting and Dr. Rabinowitz will sign this NIH Decision Letter and it will be returned to NIH at <https://www.nist.gov/iedison> . If previously registered in iEdison, an additional registration is not needed. The iEdison web site permits the named Inventor to make the required reports noted above on the Subject Invention. This site also provides messages for your needed compliance actions. After you have registered at the iEdison web site, please contact our office. The transfer by NIH of the Subject Invention to the new iEdison registered Inventor account finalizes the transfer of ownership of the Subject Invention to the Inventor as outlined in this letter.

Finally, in addition to any other remedy afforded to the Federal Government for any breach by the Inventor under 35 U.S.C. §§ 200-212 or 37 C.F.R. Part 401, upon any material breach of these foregoing Conditions (as determined by NIH at its sole discretion), you shall cure the breach within thirty (30) days of notice by NIH, or any other timeframe determined solely by NIH ("the Cure Period"). If after the Cure Period the material breach has not been cured, title to all Subject Inventions will revert to the Federal Government immediately upon NIH's issuance of notice to you of the reversion of title to the Subject Invention.

This determination will be effective upon your signing and returning the attachment, with this letter, within **thirty (30) days** from the date of this notification and the transfer of the Subject Invention within iEdison to you.

Dr. Hyun-Soon Chong
EIR 3553001-08-0001
March 13, 2024
Page 4 of 5

Sincerely,



Scott Cooper
Senior Policy Analyst
FIRM-H, OPERA, OER, NIH

Cc: Fred Hickernell, Vice Provost for Research, Professor, Department of Applied Mathematics,
Center for the Interdisciplinary Scientific Computation (CISC), Illinois Institute of Technology,
hickernell@itt.edu

Yi Zhang, Manager, Technology Management and Licensing, Illinois Institute of Technology,
yzhang147@iit.edu

Attachment 1: Inventors' Signature

Please direct all correspondence to:

Scott Cooper

E-mail: Scott.Cooper@nih.gov

Accepted:



3/27/2024

Inventor Signature

Date

Hyun-Soon Chong

Professor

Print Name

Title



March 13, 2024

Dr. Hyun-Soon Chong
Professor
Department of Chemistry
Illinois Institute of Technology

VIA E-MAIL ONLY to: chong@itt.edu

Re: Inventor Waiver Request Decision

Grantee:	Illinois Institute of Technology
EIR Reference Number:	3553001-12-0003
Funding Agreement Numbers:	CA112503
Subject Invention:	Regioselective and stereoselective ring opening reactions of aziridinium ions for synthesis of therapeutic and diagnostic drugs
Inventor:	Hyun-Soon Chong
Patent Applications:	61/649,437 ¹ ; 13/896,524 ² ; 15/270,651 ³
Patents:	9,446,995 ⁴ ; 10,189,803 ⁵

Dear Dr. Chong:

I write on behalf of the National Institutes of Health (NIH) to respond to your request to permit title to the above-referenced Subject Invention made under an NIH Funding Agreement with the Illinois Institute of Technology to be transferred to the Dr. Hyun-Soon Chong.

NIH has evaluated your request under 35 U.S.C. §202(c), (d) and the regulations set forth at 37 C.F.R. § 401.9 and determined that the Government has insufficient interest to retain title and/or patent rights in or to the Subject Invention. Based on this review, NIH approves the assignment of ownership of the Subject Invention to you, conditioned on your agreement to the following guidelines, statutes, and regulations ("Conditions"), including reporting to, and receipt by, the NIH Office of Extramural Research of any reports and documentation required by these Conditions.

1 Provisional Patent Application filed 05/21/2012

2 Non-Provisional Application filed 05/17/2013

3 Non-Provisional (CIP) Application filed 09/20/2016

4 Patent issued 09/20/2006

5 Patent issued 01/29/2019

IMPORTANT NOTICE: Final NIH approval of your Inventor Waiver Request is not complete until:

- (1) The Inventor (Dr. Dr. Hyun-Soon Chong), registers in iEdison (<http://www.iEdison.gov>) for continued required reporting to NIH of this Subject Invention;
- (2) A copy of this Decision Letter signed by Dr. Chong agreeing to the terms and conditions of this NIH Inventor Waiver decision and is returned to the NIH at <http://www.nist.gov/iedison> ; and
- (3) The Subject Invention is transferred by the NIH from the ILLINOIS INSTITUTE OF TECHNOLOGY to the new iEdison account established by Dr. Chong. This transfer will occur within 3 business days of the completion of the above two tasks.

Following thirty (30) days of the date of this NIH Invention Decision letter if items (1) and (2) above have not been finalized, this NIH Invention Decision letter is rescinded, and Dr. Chong and the ILLINOIS INSTITUTE OF TECHNOLOGY will need to submit a new application for the transfer of this Subject Invention.

The Conditions of this waiver:

- (A) You agree that the Subject Invention and you will be bound by, and remain subject to, 35 U.S.C. §§ 200-212 and 37 C.F.R. Part 401 and the provisions cited therein, and any other Federal Government rights reserved under applicable laws and regulations as if you were the original NIH Grantee. In particular, but not limited thereto:
- (1) You agree to the Government's retained non-exclusive, non-transferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the Subject Invention worldwide for the Government;
 - (2) You agree to provide a confirmatory license and statement of government interest for all patent applications and any issued patents claiming the Subject Invention;
 - (3) You agree to the obligations and conditions set forth and required by 37 C.F.R. Part 401, including:
 - (a) Filing, within one (1) year of the date of this letter, a patent application on each of the Subject Inventions or earlier than one (1) year, if necessary, prior to the end of any statutory period wherein valid patent protection can be obtained within the United States;
 - (b) Providing the NIH with documentation of any patent application numbers, confirmatory licenses, filing and/or application dates and inclusion of the Federal Support Clause, as provided in 37 C.F.R. §401.14(f)(4), within the text of the issued patent and any patent applications or their equivalents;
 - (c) Submitting annual utilization reports detailing utilization-related activities related to the Subject Inventions; and
 - (d) Maintaining any patents and/or patent applications covering the Subject Inventions, unless notice is provided to NIH of any decisions not to continue the prosecution of a patent application, pay maintenance fees, or defend in a reexamination or opposition proceeding on a patent, in any country, not less than thirty (30) days before the expiration of the response period required by the relevant patent office.

- (B) You agree that the use and licensing of the Subject Invention will be in compliance with both the NIH's "Sharing Biomedical Research Resources: Principles and Guidelines for Recipients of NIH Grants and Contracts" 64 Fed. Reg. Page 72090, (23 Dec 1999) and the NIH's "Best Practices for the Licensing of Genomic Inventions: Final Notice" 70 Fed. Reg. Page 18413 (11 Apr 2005);
- (C) You are bound by the Inventor Certification submitted as part of the request for retention of rights in these Subject Invention; and specifically agree that:
- a. You will be bound by any conditions imposed on the above-referenced institution and at least those conditions that would apply to a small business firm under paragraphs (d)(1) and (3), (f)(4), (h), (i) and (j) of the clause at 37 CFR 401.14(a), referred to as "Standard patent rights clauses."
 - b. "Rights to the subject invention in the United States **may not be assigned to any third party without the approval of the Federal agency**, except where such assignment is made to an organization which has as one of its primary functions the management of inventions, provided that such assignee will be subject to the same provisions as the contractor." 35 U.S.C §202 and 37 C.F.R 401.14.
 - c. The Co-Inventors must submit a separate request for NIH's approval to assign rights to any third party following the NIH Procedures for Requests for Approval of Third Party Assignment available at: <https://www.nist.gov/iedison>
- (D) You further agree that within thirty (30) days from the date of this NIH Decision Letter Dr. Rabinowitz will register in iEdison for continued reporting and Dr. Rabinowitz will sign this NIH Decision Letter and it will be returned to NIH at <https://www.nist.gov/iedison> . If previously registered in iEdison, an additional registration is not needed. The iEdison web site permits the named Inventor to make the required reports noted above on the Subject Invention. This site also provides messages for your needed compliance actions. After you have registered at the iEdison web site, please contact our office. The transfer by NIH of the Subject Invention to the new iEdison registered Inventor account finalizes the transfer of ownership of the Subject Invention to the Inventor as outlined in this letter.

Finally, in addition to any other remedy afforded to the Federal Government for any breach by the Inventor under 35 U.S.C. §§ 200-212 or 37 C.F.R. Part 401, upon any material breach of these foregoing Conditions (as determined by NIH at its sole discretion), you shall cure the breach within thirty (30) days of notice by NIH, or any other timeframe determined solely by NIH ("the Cure Period"). If after the Cure Period the material breach has not been cured, title to all Subject Inventions will revert to the Federal Government immediately upon NIH's issuance of notice to you of the reversion of title to the Subject Invention.

This determination will be effective upon your signing and returning the attachment, with this letter, within **thirty (30) days** from the date of this notification and the transfer of the Subject Invention within iEdison to you.

Dr. Hyun-Soon Chong
EIR 3553001-12-0003
March 13, 2024
Page 4 of 5

Sincerely,



Scott Cooper
Senior Policy Analyst
FIRM-H, OPERA, OER, NIH

Cc: Fred Hickernell, Vice Provost for Research, Professor, Department of Applied Mathematics,
Center for the Interdisciplinary Scientific Computation (CISC), Illinois Institute of Technology,
hickernell@itt.edu

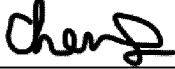
Yi Zhang, Manager, Technology Management and Licensing, Illinois Institute of Technology,
yzhang147@iit.edu

Attachment 1: Inventors' Signature

Please direct all correspondence to:

Scott Cooper

E-mail: Scott.Cooper@nih.gov

Accepted:		3/27/2024
	_____ Inventor Signature	_____ Date
	Hyun-Soon Chong	Professor
	_____ Print Name	_____ Title



March 13, 2024

Dr. Hyun-Soon Chong
Professor
Department of Chemistry
Illinois Institute of Technology

VIA E-MAIL ONLY to: chong@itt.edu

Re: Inventor Waiver Request Decision

Grantee:	Illinois Institute of Technology
EIR Reference Number:	3553001-13-0001
Funding Agreement Numbers:	CA112503; CA136695
Subject Invention:	Multifunctional chelators, complexes, and compositions thereof, and methods of using same.
Inventor:	Hyun-Soon Chong
Patent Applications:	61/866,992 ¹ ; PCT/US2014/059276 ² ; 15/027,104 ³ ; 16/562,577 ⁴
Patents:	10,441,669 ⁵ ; 10,842,893 ⁶

Dear Dr. Chong:

I write on behalf of the National Institutes of Health (NIH) to respond to your request to permit title to the above-referenced Subject Invention made under an NIH Funding Agreement with the Illinois Institute of Technology to be transferred to the Dr. Hyun-Soon Chong.

NIH has evaluated your request under 35 U.S.C. §202(c), (d) and the regulations set forth at 37 C.F.R. § 401.9 and determined that the Government has insufficient interest to retain title and/or patent rights in or to the Subject Invention. Based on this review, NIH approves the assignment of ownership of the Subject Invention to you, conditioned on your agreement to the following guidelines, statutes, and regulations ("Conditions"), including reporting to, and receipt by, the NIH Office of Extramural Research

1 Provisional Patent Application filed 10/04/2013

2 PCT Patent Application filed 10/06/2014

3 Non-Provisional Patent Application filed 04/04/2016

4 Non-Provisional Patent Application filed 09/06/2019

5 Patent issued 10/15/2019

6 Patent issued 11/24/2020

of any reports and documentation required by these Conditions.

IMPORTANT NOTICE: Final NIH approval of your Inventor Waiver Request is not complete until:

- (1) The Inventor (Dr. Dr. Hyun-Soon Chong), registers in iEdison (<http://www.iEdison.gov>) for continued required reporting to NIH of this Subject Invention;
- (2) A copy of this Decision Letter signed by Dr. Chong agreeing to the terms and conditions of this NIH Inventor Waiver decision and is returned to the NIH at <http://www.nist.gov/iedison> ; and
- (3) The Subject Invention is transferred by the NIH from the ILLINOIS INSTITUTE OF TECHNOLOGY to the new iEdison account established by Dr. Chong. This transfer will occur within 3 business days of the completion of the above two tasks.

Following thirty (30) days of the date of this NIH Invention Decision letter if items (1) and (2) above have not been finalized, this NIH Invention Decision letter is rescinded, and Dr. Chong and the ILLINOIS INSTITUTE OF TECHNOLOGY will need to submit a new application for the transfer of this Subject Invention.

The Conditions of this waiver:

- (A) You agree that the Subject Invention and you will be bound by, and remain subject to, 35 U.S.C. §§ 200-212 and 37 C.F.R. Part 401 and the provisions cited therein, and any other Federal Government rights reserved under applicable laws and regulations as if you were the original NIH Grantee. In particular, but not limited thereto:
 - (1) You agree to the Government's retained non-exclusive, non-transferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the Subject Invention worldwide for the Government;
 - (2) You agree to provide a confirmatory license and statement of government interest for all patent applications and any issued patents claiming the Subject Invention;
 - (3) You agree to the obligations and conditions set forth and required by 37 C.F.R. Part 401, including:
 - (a) Filing, within one (1) year of the date of this letter, a patent application on each of the Subject Inventions or earlier than one (1) year, if necessary, prior to the end of any statutory period wherein valid patent protection can be obtained within the United States;
 - (b) Providing the NIH with documentation of any patent application numbers, confirmatory licenses, filing and/or application dates and inclusion of the Federal Support Clause, as provided in 37 C.F.R. §401.14(f)(4), within the text of the issued patent and any patent applications or their equivalents;
 - (c) Submitting annual utilization reports detailing utilization-related activities related to the Subject Inventions; and
 - (d) Maintaining any patents and/or patent applications covering the Subject Inventions, unless notice is provided to NIH of any decisions not to continue the prosecution of a patent application, pay maintenance fees, or defend in a reexamination or opposition proceeding on a patent, in any country, not less than thirty (30) days before the

expiration of the response period required by the relevant patent office.

- (B) You agree that the use and licensing of the Subject Invention will be in compliance with both the NIH's "Sharing Biomedical Research Resources: Principles and Guidelines for Recipients of NIH Grants and Contracts" 64 Fed. Reg. Page 72090, (23 Dec 1999) and the NIH's "Best Practices for the Licensing of Genomic Inventions: Final Notice" 70 Fed. Reg. Page 18413 (11 Apr 2005);
- (C) You are bound by the Inventor Certification submitted as part of the request for retention of rights in these Subject Invention; and specifically agree that:
- a. You will be bound by any conditions imposed on the above-referenced institution and at least those conditions that would apply to a small business firm under paragraphs (d)(1) and (3), (f)(4), (h), (i) and (j) of the clause at 37 CFR 401.14(a), referred to as "Standard patent rights clauses."
 - b. "Rights to the subject invention in the United States **may not be assigned to any third party without the approval of the Federal agency**, except where such assignment is made to an organization which has as one of its primary functions the management of inventions, provided that such assignee will be subject to the same provisions as the contractor." 35 U.S.C §202 and 37 C.F.R 401.14.
 - c. The Co-Inventors must submit a separate request for NIH's approval to assign rights to any third party following the NIH Procedures for Requests for Approval of Third Party Assignment available at: <https://www.nist.gov/iedison>
- (D) You further agree that within thirty (30) days from the date of this NIH Decision Letter Dr. Rabinowitz will register in iEdison for continued reporting and Dr. Rabinowitz will sign this NIH Decision Letter and it will be returned to NIH at <https://www.nist.gov/iedison> . If previously registered in iEdison, an additional registration is not needed. The iEdison web site permits the named Inventor to make the required reports noted above on the Subject Invention. This site also provides messages for your needed compliance actions. After you have registered at the iEdison web site, please contact our office. The transfer by NIH of the Subject Invention to the new iEdison registered Inventor account finalizes the transfer of ownership of the Subject Invention to the Inventor as outlined in this letter.

Finally, in addition to any other remedy afforded to the Federal Government for any breach by the Inventor under 35 U.S.C. §§ 200-212 or 37 C.F.R. Part 401, upon any material breach of these foregoing Conditions (as determined by NIH at its sole discretion), you shall cure the breach within thirty (30) days of notice by NIH, or any other timeframe determined solely by NIH ("the Cure Period"). If after the Cure Period the material breach has not been cured, title to all Subject Inventions will revert to the Federal Government immediately upon NIH's issuance of notice to you of the reversion of title to the Subject Invention.

This determination will be effective upon your signing and returning the attachment, with this letter, within **thirty (30) days** from the date of this notification and the transfer of the Subject Invention within iEdison to you.

Dr. Hyun-Soon Chong
EIR 3553001-12-0003
March 13, 2024
Page 4 of 5

Sincerely,



Scott Cooper
Senior Policy Analyst
FIRM-H, OPERA, OER, NIH

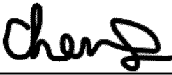
Cc: Fred Hickernell, Vice Provost for Research, Professor, Department of Applied Mathematics,
Center for the Interdisciplinary Scientific Computation (CISC), Illinois Institute of Technology,
hickernell@itt.edu

Yi Zhang, Manager, Technology Management and Licensing, Illinois Institute of Technology,
yzhang147@iit.edu

Attachment 1: Inventors' Signature

Please direct all correspondence to:

Scott Cooper
E-mail: Scott.Cooper@nih.gov

Accepted:		<u>3/27/2024</u>
	Inventor Signature	Date
	<u>Hyun-Soon Chong</u>	<u>Professor</u>
	Print Name	Title