

Patent Assignment

This **PATENT ASSIGNMENT AGREEMENT**, is made and agreed to as of this 15th day of November, 2021, by and between the **University of Florida Research Foundation, Inc.**, (“**UFRF**” or “**Assignor**”) a nonstock, nonprofit Florida corporation, having an address of, 223 Grinter Hall, Gainesville, Florida 32611 Gainesville, Florida, 32611, and **Alachua County Board of County Commissioners**, (“**INSTITUTION**” or “**Assignee**”) a charter county, through its Department of Public Works, an institution having an address of 5620 NW 120 Lane, Gainesville, Florida, 32653. Assignor and Assignee, collectively the “**Parties**”.

WHEREAS, on November 15 2021, Assignor and Assignee executed a certain Amended and Restated Interinstitutional Agreement (“**IA Agreement**”), in and through which UFRF agreed to transfer to Institution a portion, but less than the whole, of UFRF’s ownership interest in certain patents and patent applications as identified in Appendix A (“**Patents and Patent Applications**”) which Patents and Patent Applications and associated patent rights are owned jointly by UFRF and INSTITUTION.

WHEREAS, pursuant to the IA Agreement, Assignor assigned and agrees to assign a portion of their interest in and to the Patents and Patent Applications (“**Assignor’s Interest**” as defined below) and Assignee is desirous of acquiring the a joint and shared interest in Assignor’s Interest in the Patents and Patent Applications;

WHEREAS, Assignee is desirous of recording the assignment with any US or foreign government entity responsible for issuing patents.

NOW THEREFORE, in consideration of the Agreement and the mutual covenants and promises contained herein, and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Parties hereto agree as follows:

1. **Patent Rights.** For this Patent Assignment, “**Patent Rights**” refer to and mean the certain Patents and Patent Applications identified on Appendix A of this Patent Assignment Agreement and all right title and interest in and to the certain Patents and Patent Applications, including all right, title and interest for the United States, its territories and possession, and all foreign countries in and to the Patents and Patent Applications and all rights, claims and privileges pertaining thereto, including without limitation, all inventions and discoveries disclosed therein, certificates of invention and applications for certificates of invention, and any substitutions, reissues, reexaminations, divisionals, renewals, extensions, provisionals, continuations, continuations-in-part, continued prosecution applications, and corresponding foreign patents and patent applications and foreign counterparts thereof, and any and all rights to sue and recover for claims and remedies against and collect damages and other recoveries for past, present and future infringements of any or all of the foregoing, and rights for priority and protection of interests therein under the laws of any jurisdiction and the rights to apply, obtain and hold in its own name as an owner for patents or inventor’s certificates and related rights heretofore or hereafter filed in any and all countries, including, without limitation, the right to prosecute and maintain the same and all rights to claim priority based thereon, all patents granted thereon and all reissues, extensions and renewals thereof.
2. **Assignment of a Portion of Assignor’s Interest in the Patents.** Assignor and Assignee jointly own undivided interests in the Patent Rights. Assignor’s right, title and interest in and to the Patent Rights is referred to as “**Assignor’s Interest.**”
3. **Assignment of a Portion of Assignor’s Interest to Assignee.** Assignor agrees to and does hereby assign to Assignee a partial interest of Assignor’s Interest in the Patent Rights, such assignment being sufficient for Assignee and Assignor to jointly own and each own a joint and undivided interest in Assignor’s Interest in the Patent Rights. Assignor and Assignee are the sole owners of the Patent Rights in the Patents and Patent Applications.

4. **Further Assurances.** Assignor will cooperate with Assignee and to follow Assignee's instructions in order to effectuate the transfer of the portion of Assignor's Interest in the Patents and Patent Applications in a timely manner. Assignor agrees, at the Assignee's expense and request: (i) to assign, deliver and communicate to Assignee, its representatives, agents, successors and assigns any facts and materials relating to the Patents and Patent Applications, including evidence for interference purposes or for other legal proceedings whenever requested and all files, documents and communications pertaining to the Patents and Patent Applications, including all communications to and from the U.S. Patent and Trademark Office and any and all legal counsel advising on or assisting with the Patents; (ii) to testify in any interference or other legal proceedings whenever requested; (iii) to execute and deliver whenever requested all lawful papers required to make any of the foregoing provisions effective; and (iv) to generally provide all further cooperation, including taking such further action and executing such additional documents, which Assignee, its successors and assigns requests to secure, obtain or enforce proper protection for the Patents and Patent Applications and all associated rights in this or any foreign country.
5. **Rights and Privileges.** All rights and privileges, including the right to sue for and receive all damages from past infringements of the Patents and Patent Applications, will be held and enjoyed by Assignor and Assignee and their successors, assigns and other legal representatives.
6. **Representations and Warranties.** Assignor represents and warrants to Assignee, its successors and assigns that on the date hereof that Assignor is the exclusive owner of all right, title and interest in and to the Assignor's Interest in the Patents and Patent Applications and has the right to assign the portion of Assignor's Interest in the Patents and Patent Applications, and that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment.
7. **Authorization.** Assignor authorizes and requests the Commissioner of Patents and Trademarks of the United States, and any other official throughout the world whose duty is to register and record ownership in patent registrations and applications for registration of patents, to record Assignee as the assignee of a portion of Assignor's Interest and Assignor and Assignee as the joint owners of any and all right in the Patents and Patent Applications.
8. **General Provisions.** This Assignment will be construed in accordance with and governed by the laws of the state of Florida, without giving effect to the conflict of law principles. In the event that any provision of this Assignment is held to be unenforceable under applicable law, this Assignment will continue in full force and effect without such provision and will be enforceable in accordance with its terms. This Assignment and any of the terms contained herein may be amended or modified by Assignor and Assignee only in writing. This Assignment may be executed in one or more counterparts, each of which shall be deemed an original, but all of which together shall constitute one and the same instrument.

[SIGNATURES ON THE FOLLOWING PAGE]

IN WITNESS WHEREOF, this Assignment has been executed on behalf of Assignor as of the date first above written.

“Assignor”

University of Florida Research Foundation, Inc.,

By: Jim O'Connell

Name: Jim O'Connell

STATE OF FLORIDA
COUNTY OF Alachua

THE FOREGOING INSTRUMENT was acknowledged before me by means of physical presence or online notarization, this 3rd day of November, 2021, by Jim O'Connell, as Jim O'Connell of UFRF, a Director, on behalf thereof, who is personally known to me, or produced _____ as identification.

Adrienne Pennell
Notary Public Signature

Print Notary Name: Adrienne Penne11

My commission expires: 12/12/2022

[AFFIX NOTARY SEAL]

ADRIENNE LAUREN PADGETT
Notary Public-State of Florida
Commission # GG 331220
Commission Expires 12/12/2022

Acknowledged by “Assignee”

Alachua County Board of County Commissioners

By: _____

Name: _____

Title: _____

Appendix A – Patents and Patent Applications

Ref #	Title	Filing Date	Serial #	Type	Inventors	Status
T13915	Membrane System to Treat Leachate and Methods of Treating Leachate	May 3, 2013	9,540,254	US Utility	Timothy Townsend, James Lloyd, Ronald Bishop, David Wood	Issued on January 10, 2017
T13915 (T16476US001)	Membrane System to Treat Leachate and Methods of Treating Leachate	December 2, 2016	10,300,436	US Utility	Timothy Townsend, James Lloyd, Ronald Bishop, David Wood	Issue on May 28, 2019 Continuation of 13915
T13915 (T16476US002)	Membrane System to Treat Leachate and Methods of Treating Leachate	May 28, 2019	16/423,812		Timothy Townsend, James Lloyd, Ronald Bishop, David Wood	Continuation of 16476

Update: “Patent Rights” shall mean the following: (i) United States Patent No. 9,540,254 (“ ‘254 Patent”) “Membrane System to Treat Leachate and Methods of Treating Leachate” with identified inventors, Timothy Townsend, Ronald Bishop, David Wood, and James Lloyd; (ii) United States Patent Number 10,300,436 (“ ‘436 Patent”) “Membrane System to Treat Leachate and Methods of Treating Leachate” with identified inventors, Timothy Townsend, Ronald Bishop, David Wood, and James Lloyd, (iii) United States Patent Application Number 16/423,812 (“ ‘812 Application”) with identified inventors, Timothy Townsend, Ronald Bishop, David Wood, and James Lloyd, and (iv) any continuation, continuation-in-part divisional, reexaminations, reissues, and/or foreign patents or patent applications filed based on priority from the ‘254 Patent, ‘436 Patent or ‘812 Application thereof.