

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

ETAS ID: TM858291

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|---|--|-----------------------|-------------------------------------|
| SUBMISSION TYPE: | NEW ASSIGNMENT | | |
| NATURE OF CONVEYANCE: | ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL | | |
| CONVEYING PARTY DATA | | | |
| Name | Formerly | Execution Date | Entity Type |
| ECLIPSE.ORG FOUNDATION, INC. | | 11/01/2023 | Non-Profit Corporation: DELAWARE |
| RECEIVING PARTY DATA | | | |
| Name: | Eclipse Foundation AISBL | | |
| Street Address: | Rond Point Schuman 11 | | |
| City: | 1040 Brussels | | |
| State/Country: | BELGIUM | | |
| Entity Type: | international not-for-profit association: BELGIUM | | |
| PROPERTY NUMBERS Total: 1 | | | |
| Property Type | Number | Word Mark | |
| Registration Number: | 2876771 | OSGI | |
| CORRESPONDENCE DATA | | | |
| Fax Number: | 2129692900 | | |
| <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: | 212-969-3000 | | |
| Email: | trademark@proskauer.com | | |
| Correspondent Name: | Lori E. Harrison | | |
| Address Line 1: | Proskauer Rose LLP | | |
| Address Line 2: | Eleven Times Square | | |
| Address Line 4: | New York, NEW YORK 10036-8299 | | |
| ATTORNEY DOCKET NUMBER: | 26499-081 | | |
| NAME OF SUBMITTER: | Lori E. Harrison | | |
| SIGNATURE: | /Lori E. Harrison/ | | |
| DATE SIGNED: | 12/04/2023 | | |
| Total Attachments: 8 | | | |
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Trademark Assignment & License back Agreement

(1) Eclipse.org Foundation, Inc.

(2) Eclipse Foundation AISBL

Dated

1 November 2023

This Agreement is made on

1 November 2023 (the "Effective Date")

Between

- (1) **Eclipse.org Foundation, Inc.** a United States section 501(c)(6) nonprofit trade association incorporated in the State of Delaware, having registered office at 2934 Baseline Road, Suite 202, Ottawa, ON, Canada, K2H 1B2, duly represented by Steven Michael Milinkovich in his capacity of Executive Director;

Hereinafter the "**Assignor**"

- (2) **Eclipse Foundation AISBL** a Belgian international not-for-profit association (AISBL/IVZW) incorporated under the laws of Belgium, which is also designated for United States tax purposes as a United States section 501(c)(6) not-for-profit, having its registered office at Rond Point Schuman 11, 1040 Brussels, Belgium, having registered number 0760.624.114 in the Crossroads Banks for Enterprises, duly represented by Steven Michael Milinkovich in his capacity of Executive Director;

Hereinafter the "**Assignee**"

Hereby jointly referred to as the "**Parties**" or individually as a "**Party**".

Background:

It is agreed as follows:

1. **DEFINITIONS**

1.1 In this Agreement, unless the context otherwise requires, the following definitions shall apply:

- "**Agreement**" means this agreement (including any schedule or annex to it and any document in agreed form);
- "**Representative**" means as to each Party, its directors, officers, employees, agents, consultants, advisers (including, without limitation, financial advisers, legal counsel, and accountants);
- "**Registered Trademarks**" means the Trademarks that are registered in any official register at the national, regional, or international level;
- "**Trademarks**" means the Trademarks that are listed in Schedule 1.

2. **ASSIGNMENT**

2.1 **Full Assignment.** The Assignor hereby assigns and transfers to the Assignee all rights, titles, and interests in and to the Trademarks, together with the goodwill of the business connected with the use of, and symbolized by, the Trademarks, for the full period of protection including any renewals, reversions, revivals or extensions and all related rights, including all statutory and common law rights in and to the Trademarks under applicable laws.

The Parties hereby agree that the entire Trademark portfolio of the Assignor shall be the subject of this Agreement and, therefore, in the event that one or more of the Assignor's Trademark(s) is not listed in Schedule 1 of this Agreement, such Assignor's Trademark(s) shall nonetheless by default be subject to this Agreement in the same manner as the Trademarks.

2.2 **Progressive Assignment.** The transfer of the Trademarks and the completion of the necessary formalities relating thereto shall be progressive and the actual transfer of the Trademarks and the completion of the necessary formalities relating thereto shall be carried out over time and may include the processing of batches of Trademarks with one or more governing authorities.

The Parties agree to maintain a shared registry that tracks the status of each Trademark and agree that this registry will be authoritative as to the status of each Trademark.

- 2.3 **Definitive Assignment.** The assignment of the Trademarks is effective and final upon signing of this Agreement.

For the Registered Trademarks, the assignment becomes enforceable against third parties once the necessary formalities have been completed in the relevant registers.

3. LICENSE BACK

- 3.1 Assignee hereby grants to Assignor, and Assignor accepts from Assignee, a non-exclusive, sublicensable, irrevocable, assignable, royalty-free, fully-paid-up, perpetual (or at least for as long as the protection by the applicable law is lasting), worldwide right and license to use all the Trademarks in any manner it determines, to the greatest extent possible and, at a minimum, such that Assignor continues to manage the exploitation of all Trademarks in accordance with the Eclipse Foundation Trademark Usage Policy of 19 May 2021 or as further amended as the case may be.

- 3.2 For each of the Registered Trademarks, the license back as provided under Section 3.1 of this Agreement, will become effective without further notice, as soon as the necessary formalities with respect to each relevant Registered Trademark have been completed in the relevant registers by Assignee, which Assignee shall complete as soon as possible following the transfer.

4. CONSIDERATION

- 4.1 As a consideration for the assignment contemplated herein, Assignee shall pay a lump sum of USD 5,000.00 to Assignor, payable by wire transfer within 7 days of the Effective Date.
- 4.2 Assignee further agrees to bear all ongoing costs relating to the assignment and license back of the Trademarks provided under this Agreement, including the go-forward maintenance costs associated with the Trademarks.

5. ENFORCEMENT

- 5.1 As a result of this Agreement, the Assignee is subrogated to all the rights of the Assignor in the Trademarks, subject to the license back granted under Section 3 and subject to Section 5.2, and the Assignee becomes the owner of the Trademarks and is therefore by default responsible for the protection and enforcement of the Trademarks and has, among other, the right to bring, make, oppose, defend, appeal proceedings, claims or actions and obtain relief (and to retain any damages recovered) in respect of any infringement, or any other cause of action (including passing off) arising from ownership, of any of the Trademarks whether occurring before, on or after the date of this Agreement. The Parties shall cooperate in good faith to make all necessary filings to record this Agreement in the United States Patent and Trademark Office and the United States Copyright Office, and in the corresponding offices or agencies in any and all countries where it may be required under applicable law, including as a prerequisite to enforcement of this Agreement in the courts of such countries, and any recordation fees and related costs and expenses will be at Assignee's expense.
- 5.2 Notwithstanding Section 5.1, the Assignor, as the licensee under the license back provided under Section 3, has decision-making power regarding the Trademarks to the same extent as the Assignor had before the assignment provided for in this Agreement and must therefore, in particular, be able to manage the exploitation of the Trademarks in accordance with the Eclipse Foundation Trademark Usage Policy of 19 May 2021 or as further amended as the case may be.

6. WAIVER

No failure or delay by a Party to exercise any right or remedy provided under this Agreement or by law shall constitute a waiver of that or any other right or remedy, nor shall it prevent or restrict the further

exercise of that or any other right or remedy. No single or partial exercise of such right or remedy shall preclude or restrict the further exercise of that or any other right or remedy.

7. ENTIRE AGREEMENT

7.1 This Agreement constitutes the entire agreement between the Parties and supersedes and extinguishes all previous agreements, promises, assurances, warranties, representations, and understandings between them, whether written or oral, relating to its subject matter.

7.2 Each Party agrees that it shall have no remedies in respect of any statement, representation, assurance, or warranty (whether made innocently or negligently) that is not set out in this Agreement.

8. VARIATION

No variation of this Agreement shall be effective unless it is in writing and signed by the Parties or their authorised Representatives.

9. SEVERANCE

9.1 If any provision or part-provision of this Agreement is or becomes invalid, illegal, or unenforceable, it shall be deemed modified to the minimum extent necessary to make it valid, legal, and enforceable. If such modification is not possible, the relevant provision or part-provision shall be deemed deleted. Any modification to or deletion of a provision or part-provision under this clause shall not affect the validity and enforceability of the rest of this Agreement.

9.2 If one Party gives notice to the other of the possibility that any provision or part-provision of this Agreement is invalid, illegal, or unenforceable, the Parties shall negotiate in good faith to amend such provision so that, as amended, it is legal, valid and enforceable, and, to the greatest extent possible, achieves the intended commercial result of the original provision.

10. COUNTERPARTS

10.1 This Agreement may be executed in any number of counterparts, each of which when executed shall constitute a duplicate original, but all the counterparts shall together constitute the one agreement.

10.2 No counterpart shall be effective until each Party has executed at least one counterpart.

11. GOVERNING LAW

This Agreement and any dispute or claim (including non-contractual disputes or claims) arising out of or in connection with it or its subject matter or formation shall be governed by and construed in accordance with the laws of Belgium.

12. JURISDICTION

Each Party irrevocably agrees that the French-speaking courts of Brussels, Belgium shall have exclusive jurisdiction to settle any dispute or claim (including non-contractual disputes or claims) arising out of or in connection with this Agreement or its subject matter or formation.


This Agreement has been entered into on the date stated at the beginning of it.


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IN WITNESS WHEREOF, the Parties have signed this Agreement in two original counterparts by the officers duly authorised for this purpose.

Assignor

Assignee

Signature: 

Signature: 

Name: Steven Michael Milinkovich

Name: Steven Michael Milinkovich

Title: Executive Director

Title: Executive Director

Date: November 1 2023

Date: November 1 2023

SCHEDULE 1: The Trademarks

1. Registered Trademarks

- Adoptium®
- AsciiDoc®
- Che®
- Eclipse®
- Eclipse Enterprise for Java®
- Eclipse Keyple®
- EclipseCon®
- GlassFish®
- Jakarta®
- Jetty®
- MicroProfile®
- OSGi®
- PolarSys®
- Sparkplug®
- Tangle®
- The Eclipse "Orb" Logo®
- The Eclipse Foundation Logo®
- The Sparkplug Logo®

2. Other Trademarks

- Built on Eclipse™
- Eclipse Foundation Member™
- Eclipse Galileo™
- Eclipse Ganymede™
- Eclipse Indigo™
- Eclipse Kepler™
- Eclipse Luna™
- Eclipse Mars™

- Eclipse Neon™
- Eclipse Oxygen™
- Eclipse Photon™
- Eclipse Ready™
- Eclipse Simultaneous Release™
- Eclipse Summit™
- Eclipse Callisto™
- Zest™

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|-------------------------|--|
| Title | 2023.11.01 Trademark Assignment and License Back Agreement |
| File name | 2023.11.01 Tradem...ack Agreement.pdf |
| Document ID | cebedb04d75865a0e416ac1babde46c642f6304b |
| Audit trail date format | MM / DD / YYYY |
| Status | ✳ Signed |

Document History



SENT

11 / 01 / 2023
12:11:59 UTC

Sent for signature to Mike Milinkovich
(mike.milinkovich@eclipse-foundation.org) from
gesine.freund@eclipse-foundation.org
IP: 57.134.6.253



VIEWED

11 / 01 / 2023
13:14:37 UTC

Viewed by Mike Milinkovich
(mike.milinkovich@eclipse-foundation.org)
IP: 97.111.192.140



SIGNED

11 / 01 / 2023
13:16:21 UTC

Signed by Mike Milinkovich
(mike.milinkovich@eclipse-foundation.org)
IP: 97.111.192.140



COMPLETED

11 / 01 / 2023
13:16:21 UTC

The document has been completed.