

Università degli Studi

"La Sapienza"

Consiglio di  
Amministrazione

Seduta del

Nell'anno **duemilaotto**, addì **4 marzo** alle ore **15.40** si è riunito, nel Salone del Senato Accademico, il Consiglio di Amministrazione per l'esame e la discussione degli argomenti iscritti al seguente ordine del giorno:

.....**O M I S S I S**.....

Sono presenti: il **rettore**, prof. Renato Guarini; il **prorettore**, prof. Luigi Frati; i consiglieri: prof. Fabrizio Vestroni, prof. Adriano Redler, prof. Aldo Laganà, prof. Maurizio Saponara (entra alle ore 16.50), prof. Antonio Mussino, prof.ssa Rosa Concetta Farinato, prof. Marco Biffoni, prof. Raffaele Gentile, prof. Antonio Sili Scavalli, sig. Beniamino Altezza, dott. Roberto Ligia, sig. Ivano Simeoni, dott. Christian Bonafede, sig.ra Valentina Colozza, sig.ra Lorenza Falcone, sig. Gianluca Senatore, dott. Martino Trapani, dott. Gianluca Viscido; il **direttore amministrativo**, Carlo Musto D'Amore, che assume le funzioni di segretario.

**Assistono per il collegio sindacale:** dott. Domenico Oriani, dott. Giancarlo Ricotta.

Il **presidente**, constatata l'esistenza del numero legale, dichiara l'adunanza validamente costituita e apre la seduta.

.....**O M I S S I S**.....

Del. 45/08

Brevetti

8/1

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**BREVETTI ITALIANI NN. IT01262399, IT01271866, IT01276221 – BREVETTI USA NN. USA5841419, USA6052106, USA5864836 – BREVETTO EUROPEO N. EP0746839, DI PROPRIETÀ DELL'UNIVERSITÀ DI ROMA "LA SAPIENZA" - CONTRATTO DI LICENZA ESCLUSIVA DEI DIRITTI ALLA SOCIETÀ DEGDI RESEARCH LLC. -**

Il Presidente presenta per la discussione la seguente relazione predisposta dal Settore Trasferimento Tecnologico e Spin Off dell'Ufficio Valorizzazione Ricerca Scientifica e Innovazione.

L'Università "La Sapienza" è proprietaria dei seguenti brevetti:

- brevetti italiani nn. IT01262399 e IT01271866, intitolati "Metodo di comando di un pannello matriciale a cristallo liquido ferroelettrico" - inventore: Paolo Maltese, e relativi brevetti esteri nn. USA5841419, USA6052106 e EP0746839;
- brevetto italiano n. IT01276221, intitolato "Rete neurale cellulare optoelettronica programmabile otticamente" – inventori: Marco Balsi, Valerio Cimagalli, Fabrizio Galluzzi e relativo brevetto estero n. USA5864836.

Di tali diritti brevettuali l'Università è titolare al 100% in via originaria, in quanto rientranti nel regime normativo antecedente alla riforma attuata dalla L. n.383 del 2001 e, pertanto disciplinati dal precedente Regolamento Brevetti di Ateneo, approvato il 13.12.1999.

Recentemente, su presentazione da parte della N&G Consulting, l'U.V.R.S.I. è entrato in contatto con la Società americana Degdi Research LLC, controllata dalla Intellectual Ventures LLC.

Tale Società, interessata all'acquisizione di brevetti nel settore ICT e Software, si è resa immediatamente disponibile a negoziare per l'acquisizione delle privative di cui sopra.

La successiva trattativa condotta dall'Ufficio ha portato alla definizione di un contratto di licenza esclusiva dei diritti di sfruttamento (allegato quale parte integrante della presente relazione), che si sottopone all'approvazione di questo Consesso.

Tale accordo prevede la concessione dei diritti di sfruttamento esclusivo con facoltà di sublicenza dei diritti di proprietà industriale dei brevetti in oggetto, per una durata pari a quella dei brevetti d'origine.

Sono previsti a carico della Degdi Research LLC i seguenti obblighi:

- 1) pagamento di un corrispettivo iniziale pari a € 100.000,00 (centomila) a seguito di consegna, da parte dell'Università, dell'intera documentazione relativa agli iter brevettuali di tutti i brevetti su citati ivi comprese le domande di brevetto abbandonate;
- 2) rimborso dei costi sostenuti da parte dell'Università per l'ottenimento della documentazione di cui al punto precedente, prodotta dagli studi brevettuali competenti per un massimo di 5.000,00 dollari;
- 3) pagamento di un corrispettivo pari al 10% netto dei profitti derivanti dalla gestione del portfolio brevetti;
- 4) accollo di tutte le spese di mantenimento dei brevetti italiani ed esteri.

Si fa presente che, nel caso in oggetto, non ci sono utili da ripartire agli inventori, giacché il corrispettivo di euro 100.000,00 risulta integralmente assorbito dalle spese brevettuali sostenute dall'Università, che ad oggi ammontano a euro 115.296,76.

Relativamente al rimborso di cui al punto 2) si sottolinea che il limite di spesa rimborsabile dalla società Degdi risulta abbondantemente superiore al

UFFICIO VAL. R.S. e INNOVAZIONE  
Settore Trasferimento Tecnologico e Spin Off  
Ricerca Scientifica e Innovazione  
(dot. B. RICCIONI)

PERVENUTO IL  
28 FEB. 2008  
RIP. V - SETT. III

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"La Sapienza"

Consiglio di  
Amministrazione

Seduta del

preventivo acquisito dagli studi brevettuali attualmente competenti della tutela giuridica dei brevetti in licenza (preventivo complessivo pari a circa € 1000,00 + IVA).

Gli importi di cui al punto 3), incassati successivamente a titolo di *profit participation*, andranno a ripianare in primo luogo il residuo dei costi sostenuti (€ 15.296,76); gli utili netti saranno ripartiti in base al precedente Regolamento Brevetti di Ateneo:

- 30% agli autori dell'invenzione;
- 20% ai Dipartimenti di appartenenza;
- 50% all'Amministrazione Centrale.

Sarà cura dell'Ufficio predisporre gli atti necessari per la gestione contabile di tali importi al momento del loro effettivo incasso.

La Commissione Tecnica Brevetti, nella riunione del 19.9.07 ha espresso all'unanimità parere favorevole in merito al contratto di licenza ed al relativo profilo economico-finanziario.

In data 25.2.08 è stato richiesto il parere del Collegio dei Sindaci sulla variazione di bilancio necessaria all'introito del corrispettivo di cui sopra; tale parere è in corso di acquisizione.

#### Allegato parte integrante:

- 1) Contratto di licenza esclusiva Degdi Research LLC – La Sapienza.

#### Allegato in visione:

- 1) Verbale Commissione Tecnica Brevetti, seduta del 19.9.07.

UFFICIO VAL. R.S. e INNOVAZIONE  
Settore Trasferimento Tecnologico e Spin Off

Il Responsabile

(dott. Daniele Accoroni)

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..... O M I S S I S .....

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Amministrazione**DELIBERAZIONE N. 45/08**

Seduta del

**IL CONSIGLIO**

- Visto il Regolamento per l'Amministrazione, la Finanza e la Contabilità approvato il 28.5.2002;
- Visto il Regolamento Brevetti del 13.12.1999 in vigore anteriormente alla riforma attuata dalla Legge 383/2001 e applicabile alla fattispecie richiamata nella relazione;
- Visti i brevetti nn. IT01262399, IT01271866, IT01276221 – Brevetti USA NN. USA5841419, USA6052106, USA5864836 – Brevetto Europeo N. EP0746839 – titolarità in via originaria: La Sapienza 100%;
- Esaminato il contratto concordato con la Società Degdi Research LLC per la concessione in licenza esclusiva mondiale dei diritti di sfruttamento dei brevetti di cui al punto precedente a fronte di un corrispettivo immediato di € 100.000,00 (centomila);
- Preso atto del parere favorevole reso al riguardo dalla Commissione Tecnica Brevetti, nella riunione del 19.9.07;
- Considerata la necessità di adottare le variazioni di bilancio per i maggiori importi di entrata rispetto alle previsioni del B.U. 2008;
- Preso atto che, relativamente alle necessarie variazioni di bilancio, è in corso di acquisizione il parere del Collegio dei Sindaci;
- Presenti e votanti n. 16, maggioranza n. 9: con voto unanime espresso nelle forme di legge dal rettore, prorettore, dal direttore amministrativo e dai consiglieri: Altezza, Biffoni, Farinato, Gentile, Ligia, Saponara, Sili Scavalli, Simeoni, Vestroni, Bonafede, Senatore, Trapani, Viscido

**DELIBERA**

- di approvare il contratto di licenza concordato con la Società Degdi Research LLC avente ad oggetto i brevetti descritti in premessa;
- di autorizzare il Rettore alla relativa sottoscrizione;
- di autorizzare le necessarie variazioni di bilancio per i maggiori importi di entrata rispetto alle previsioni del B.U. 2008;
- di autorizzare la Ragioneria, subordinatamente al parere favorevole del Collegio dei Sindaci sulle variazioni di bilancio di cui al precedente punto 2), a introitare € 100.000,00 (centomila) sul conto E 1.3.1.4.5 "Royalties brevetti di Ateneo" B.U. – e.f. 2008 quale corrispettivo per la concessione in licenza esclusiva dei diritti di proprietà intellettuale individuati in premessa;
- di dare mandato agli Uffici competenti affinché procedano all'adozione di tutti i provvedimenti connessi e conseguenti, per introitare le successive somme corrisposte, a titolo di royalties, dalla Società Degdi Research LLC.

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"La Sapienza"

Consiglio di  
Amministrazione

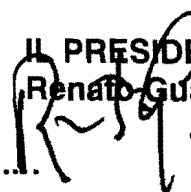
Seduta del

**Letto, approvato seduta stante per la sola parte dispositiva.**

**IL SEGRETARIO**  
**Carlo Musto D'Amore**



**IL PRESIDENTE**  
**Renato Guarini**



..... O M I S S I S .....

**PATENT LICENSE AGREEMENT**

**Licensor agreement ID:** \_\_\_\_\_

**Licensee agreement ID:** \_\_\_\_\_

**Licensor name:** Universita Degli Studi di Roma La Sapienza

**Licensor address:** Piazzale Aldo Moro 5

Roma, Italy

**Licensee name:** Degdi Research Limited Liability Company

**Licensee address:** 2711 Centerville Road, Suite 400

Wilmington, DE 19808

**License issue fee:** €100,000 (One Hundred Thousand Euros)

**Profit Participation percentage:** 10%, ten percent

In witness whereof, intending to be legally bound, the parties have signed below to enter the attached Patent License Agreement and Exhibits (this "Agreement") as of the Effective Date with the terms and conditions that follow. Capitalized terms not otherwise defined are set forth in Section 9 of this Agreement.

LICENSOR:

**UNIVERSITA DEGLI STUDI DI ROMA  
LA SAPIENZA**

By: \_\_\_\_\_

Name: \_\_\_\_\_

Title: \_\_\_\_\_

LICENSEE:

**DEGDI RESEARCH LIMITED  
LIABILITY COMPANY**

By: Pat Mathews

Name: Pat Mathews

Title: Authorized Person

**Effective Date: February 25, 2008**

## **PATENT LICENSE AGREEMENT**

The parties to this Patent License Agreement listed on the previous page hereby agree as follows:

### **1. GRANT OF EXCLUSIVE LICENSE**

#### **1.1 Exclusive Patent License**

Licensor hereby grants to Licensee the exclusive, worldwide, transferable, sublicensable license of all rights of any kind conferred by the Patents, including, without limitation, the rights of any kind to, or conferred by, the Patents to (a) use or otherwise practice any art, methods, processes, and procedures covered by the Patents, (b) make, have made, use, offer to sell, sell, import, and otherwise distribute or dispose of any inventions, discoveries, products, services, or technologies covered by the Patents, (c) otherwise exploit any rights granted in the Patents and/or any invention or discovery described in the Patents, and (d) exclude other Persons from exercising any of such rights.

#### **1.2 Sublicenses**

The exclusive license rights granted Licensee under the Patents include the right to grant and authorize, from time to time and in Licensee's sole and absolute discretion, one or more sublicenses. No sublicense granted to any Person pursuant to the terms of this Agreement will be terminable as a result of the termination of the Term.

#### **1.3 Assignment of Causes of Action and Other Rights**

Licensor hereby assigns, transfers and conveys to Licensee all right, title and interest in and to:

(a) Rights to apply in any or all countries of the world for patents, certificates of invention, utility models, industrial design protections, design patent protections, or other governmental grants or issuances of any type related to any of the Patents and the inventions and discoveries therein;

(b) All causes of action and enforcement rights of any kind (whether such claims, causes of action or enforcement rights are known or unknown; currently pending, filed, to be filed; or otherwise) under the Patents and/or under or on account of any of the Patents for past, current and future infringement of the Patents, including without limitation, all rights to (i) pursue and collect damages, profits and awards of whatever nature recoverable, (ii) injunctive relief, (iii) other remedies, and (iv) compromise and/or settle all such claims, causes of action and enforcement rights for such infringement by granting an infringing party a sublicense or otherwise; and

(c) Rights to collect royalties or other payments under or on account of any of the Patents or any of the foregoing.

### **2. PAYMENT**

#### **2.1 License Issue Fee**

At the Closing, Licensee will pay to Licensor a combined license issue fee and past patent reimbursement (collectively, the "**License Issue Fee**") in the amount set forth on the

cover page of this Agreement. The payment will be made by wire transfer. Prior to the Closing, Licensor will furnish Licensee with all necessary information to make a wire transfer to a designated bank account of Licensor. In addition to the License Issue Fee, at Closing Licensee will reimburse Licensor for Licensor's outside attorney fees, up to a maximum of Five Thousand U.S. Dollars (US \$5,000), related to Licensor obtaining from their outside attorneys the Initial Deliverables called for under paragraph 3.1. In order to receive reimbursement, Licensor must provide to Licensee, prior to Closing, complete, true, and accurate invoices from the outside attorney(s) providing the Initial Deliverables on behalf of Licensor. In addition, the attorney fees eligible for reimbursement shall pertain only to work after the Effective Date of this Agreement.

## **2.2 Profit Participation**

Licensor will receive the percentage of the Profit (the "**Profit Participation**") set forth set forth on the cover page of this Agreement. The Profit Participation will be payable on the due dates for the reports required by paragraph 2.7 for Revenue received during the respective Reporting Period.

## **2.3 Portfolio Monetization; Allocation of Portfolio Profit to IP Groups**

Licensor acknowledges and agrees that Licensee and/or its Affiliates may from time to time sublicense, assert, litigate or otherwise exploit the Patents with other patents or patent applications held or controlled by Licensee and/or its Affiliates (a "**Portfolio Monetization**"). The parties acknowledge and agree that, unless a Portfolio Monetization specifies a particular royalty for one or more of the patents or patent applications (including the Patents), the Portfolio Profit will be determined according to the following methodology.

Licensee and/or its Affiliates will rank each of the patents and patent applications included in the Portfolio Monetization as of the date of the applicable Portfolio Monetization in one of the following four categories:

Category R1: patents and patent applications actually asserted against the licensee and discussed in detail during the discussions leading to the Revenue (i.e., named, analyzed and discussed in the assertion materials and negotiations);

Category R2: patents and patent applications specifically mentioned but not discussed in detail in the discussions leading to the Revenue (i.e., listed as one of the patents that the licensee might infringe or need to license);

Category R3: patents and patent applications in the same patent class code as one or more R1 or R2 patents and patent applications (i.e., not asserted or specifically mentioned, but, as evidenced by its class code, may have been infringed or needed to be licensed by the licensee); and

Category R4: all other patents and patent applications included in the Portfolio Monetization.

Portfolio Profit will be allocated among the patents and patent applications included in the Portfolio Monetization according to the following formula (except, and to the extent, a Portfolio Monetization specifically assigns allocations otherwise):

$$P = R * (VA/P_N)$$



Where:

P = Portfolio Profit allocated to each patent and/or patent application included in a Portfolio Monetization in one of the four categories

R = Portfolio Profit

VA = Value Allocation for that patent category (see below)

P<sub>N</sub> = Aggregate number of patents or patent applications from that category included in the Portfolio Monetization

The Value Allocations for the four categories are:

R1 = 55%

R2 = 27.5%

R3 = 13.75%

R4 = 3.75%

## **2.4 Adjustments to Value Allocations**

Notwithstanding the foregoing Value Allocations, for any given Portfolio Monetization, in the event that the formula set forth above results in allocated per item Portfolio Profit in category R1 being less than the allocated per item Portfolio Profit in category R2, R3 or R4, or the allocated per item Portfolio Profit in category R2 being less than the allocated per item Portfolio Profit in category R3 or R4, or the allocated per item Portfolio Profit in category R3 being less than the allocated per item Portfolio Profit in category R4, then, in each such event, Licensee and/or its Affiliates will appropriately adjust the formula such that the allocated per item Portfolio Profit for each category is equal to or higher than the allocated per item Portfolio Profit for each higher numbered category (for example, the allocated per item Portfolio Profit in category R1 should be equal to or higher than allocated per item Portfolio Profit in categories R2, R3 and R4, after the adjustment). Furthermore, in the event that any patent category has no patents or patent applications, then Licensee and/or its Affiliates will adjust the Value Allocations to allocate the null category's Value Allocation pro rata (based on relative Value Allocations) among the other categories. For purposes of this paragraph, an "item" will be a patent or a patent application included in the given Portfolio Monetization.

## **2.5 Good-Faith Allocations Final**

In allocating patents or patent applications among categories for purposes of allocating Portfolio Profits, adjusting Value Allocations, and determining Portfolio Profits, Licensee and its Affiliates will exercise their reasonable business judgment, in good faith, without inequitable discrimination for or against patents or patent applications held or controlled by Licensee or any of its Affiliates. Any allocation or adjustment that is not clearly and materially inconsistent with the foregoing will be final, binding, and conclusive.

## **2.6 Pre-existing Agreements**

Licensor understands, acknowledges and agrees that (a) certain pre-existing agreements have been entered into under which sublicensees may receive sublicense rights to the Patents without Licensee recognizing Revenue or generating Profit under the terms of this Agreement and (b) no additional Profit Participation or other monetary obligation will be due to Licensor as a result of rights granted pursuant to such pre-existing agreements.

## **2.7 Reports and Records**

As of each March 15 during the Term of this Agreement, Licensee will provide to Licensor a report reasonably detailing its sublicensing activities with respect to the Patents for the preceding twelve (12) month period ending as of December 31 (each, a "**Reporting Period**") when there has been Revenue with respect to the Patents in such Reporting Period.

## **2.8 Books of Account**

Licensee will keep accurate books of account containing all particulars that may reasonably be deemed necessary for the purpose of showing the Amounts payable to Licensor hereunder. Any Monetization Expenses or IP Group Expenses for Reporting Periods that exceed Revenue for that Reporting Period will be carried forward to the next Reporting Period such that Profit will not be deemed to have occurred for any Reporting Period until cumulative Revenues exceed cumulative Monetization Expenses (whether of a Portfolio Monetization or a monetization event involving solely the Patents) and cumulative IP Group Expenses in the current Reporting Period and all prior Reporting Periods. Said books of account will be kept at Licensee's or its Affiliates' principal place of business or, if notice thereof is given to Licensor, the principal place of business of the appropriate division of Licensee to which this Agreement relates. Not more than once during every twenty-four (24) month period and upon Licensor's advance request of at least thirty (30) days, Licensee will make said books and the supporting data available for inspection by Licensor or its agents during normal business hours for the two (2) most recent Reporting Periods for the sole purpose of verifying Licensee's calculations of the Profit Participation under this Agreement. Should such inspection lead to the discovery of a greater than ten percent (10%) discrepancy in reporting to Licensor's detriment, Licensee agrees to pay the reasonable fees and expenses of Licensor's agents who conducted the inspection. Licensee will promptly pay to Licensor all amounts appropriately determined by any audit to be due to Licensor. Any and all disputes with respect to the Profit Participation due under this Agreement or the calculation of Profit must be (a) raised within ninety (90) days after completion of the associated audit, and (b) resolved solely and exclusively pursuant to the provisions of paragraph 10.7.

## **2.9 Nondivison**

No Person will anticipate, alienate, hypothecate, divide, pledge, exchange, encumber, or charge any right to payment of Profit Participation (if any) under this Agreement, and any attempt to anticipate, alienate, hypothecate, divide, pledge, exchanges, encumber, or charge any right to payment of Profit Participation under this Agreement will be void. No right or benefit hereunder shall in any manner be liable for or subject to the debts, contracts, liabilities or torts of the Person entitled to such benefit (if any such benefit arises).

### **3. CLOSING**

#### **3.1 Deliverables**

Within twenty (20) calendar days following the later of the Effective Date or the date Licensee receives a Transmitted Copy of this Agreement executed by Licensors, Licensors will send to Licensee, or its legal counsel, the items identified on Exhibit D (the "Initial Deliverables"). Licensors acknowledge and agree that Licensee may request, and Licensors will promptly deliver to Licensee or its legal counsel, as directed by Licensee, additional documents based on Licensee's review of the Initial Deliverables (such additional documents and the Initial Deliverables are, collectively, the "Deliverables"), and that as a result of Licensee's review, the lists of Live Assets on Exhibits A and B and the list of Abandoned Assets on Exhibit C, may be revised by Licensee both before and after the Closing to conform these lists to the definition of Patents (and these revisions may therefore require the inclusion of additional provisional patent applications, patent applications, and patents on Exhibit A and B or Exhibit C). To the extent any of the Live Assets are removed for any reason, the payment in paragraph 3.4 may be reduced by mutual agreement of the parties. If originals of the Deliverables are not available and delivered to Licensee prior to Closing, Licensors will cause (i) such originals of the Deliverables to be sent to Licensee or Licensee's representative promptly if and after such originals are located and (ii) Licensors will deliver to Licensee a declaration, executed under penalty of perjury, detailing Licensors' efforts to locate such unavailable original documents and details regarding how delivered copies were obtained.

#### **3.2 Closing**

Licensors and Licensee will use reasonable efforts to complete the review of the Deliverables and satisfy the conditions to closing described in paragraph 3.3 within thirty (30) calendar days following the later of the Effective Date or the date the last of the Deliverables was received by Licensee. Licensee will thereafter pay Licensors the License Issue Fee on the closing (the "**Closing**"), and Licensee may then record Memoranda of Exclusive License/Rights.

#### **3.3 Closing Conditions**

The Closing will occur when Licensee determines that all the following conditions have been satisfied or waived:

- (a) Signature by Licensors. Licensors timely executed this Agreement and delivered a Transmitted Copy of this Agreement to Licensee's representatives by not later than March 10, 2008 at 5:00 p.m., Pacific time and promptly delivered one (1) executed original of this Agreement to Licensee's representatives.
- (b) Transmittal of Documents. Licensors will have delivered to Licensee all the Deliverables (defined below).
- (c) Compliance With Agreement. Licensors performed and complied in all respects with all of the obligations under this Agreement that are to be performed or complied with by it on or prior to the Closing.

(d) Representations and Warranties True. Licensee is satisfied that, as of the Effective Date and as of the Closing, the representations and warranties of Licensors contained in Section 6 are true and correct.

(e) Patents Not Abandoned. Licensee is satisfied that, as of the Effective Date and as of the Closing, none of the assets that are included in the Patents have expired, lapsed, been abandoned, or deemed withdrawn.

(f) Delivery of Executed Memorandum. Licensors will have delivered to Licensee executed and notarized Memoranda of Exclusive License/Rights.

The preceding conditions are conditions precedent to the Closing and to Licensee's obligation to make the payments contemplated pursuant to this Agreement.

### **3.4 Further Cooperation**

At the reasonable request of Licensee, Licensors will execute and deliver such other instruments and do and perform such other acts and things as may be reasonably necessary or desirable for effecting completely the consummation of the transactions contemplated hereby, including, without limitation, execution, acknowledgment and recordation of other such papers, and using reasonable efforts to obtain the same from the respective inventors, as necessary or desirable for fully perfecting and conveying unto Licensee the benefit of the transactions contemplated hereby, including, without limitation, providing and assisting in obtaining execution of any assignments, confirmations, powers of attorney, inventor declarations, and other documents that Licensee may request for prosecuting, maintaining, filing, obtaining issuance of, registering, enforcing, defending, or bringing any proceeding relating to the Patents. To the extent any attorney-client privilege or the attorney work-product doctrine applies to any portion of the Prosecution History Files, Licensors will ensure that, if any such portion of the Prosecution History File remains under Licensors' possession or control after the Closing, it is not disclosed to any third party unless (a) disclosure is ordered by a court of competent jurisdiction, after all appropriate appeals to prevent disclosure have been exhausted, and (b) Licensors gave Licensee prompt notice upon learning that any third party sought or intended to seek a court order requiring the disclosure of any such portion of the Prosecution History File. In addition, Licensors will continue to prosecute, maintain, and defend the Patents at its sole expense until the Closing.

## **4. FILING, PROSECUTION AND MAINTENANCE OF PATENT RIGHTS**

### **4.1 Costs**

After the Closing, Licensee will be solely entitled and responsible for the preparation, filing, prosecution, maintenance and defense of all Patents (except to the extent of any portion of the Patents abandoned pursuant to the terms of this Agreement). Licensee may, but is not obliged to consult with Licensors regarding execution of its responsibility.

### **4.2 Copies of Prosecution Documents**

Licensee will, upon Licensors' reasonable written request, provide Licensors with a copy of documents received or filed by Licensee pertaining to the filing, prosecution, maintenance or defense of Patents, including, without limitation, each patent application, office action, response to office action, request for terminal disclaimer, and request for reissue or reexamination of any patent issuing from such patent application.

#### **4.3 Conduct of Prosecution**

Licensor will execute and deliver to Licensee one or more memoranda in the form of the Memoranda of Exclusive License/Rights and will execute at least one such memorandum prior to the Closing. The conduct of the preparation, filing, prosecution, maintenance, and defense of the Patents will be under Licensee's exclusive control and discretion. Licensee is authorized to execute and record, on Licensor's behalf, any document submitted to the USPTO or other governmental patent office that pertains to filing, prosecution, maintenance, or defense of the Patents, including, without limitation, statements under 37 C.F.R. § 3.73(b), consents to reissue applications, and declarations. Licensee will consult with Licensor on such matters from time to time on Licensor's reasonable request. At the reasonable request of Licensee, Licensor will execute and deliver to Licensee such other documents, and do and perform such other acts and things, as may be reasonably necessary or desirable for confirming in Licensee exclusive right to prosecute, maintain, defend, file, obtain issuance, register, enforce, defend, or bring any proceeding relating to the Patents including, without limitation, execution, acknowledgment and recordation of such documents necessary to convey to Licensee any right or power of attorney in the USPTO or other governmental patent office, in respect to prosecution, maintenance, defense, filing, issuance, or registration of the Patents.

#### **4.4 Abandonment of License to Patents**

Licensee will at any time be entitled to abandon its license and other rights to all or any part of the Patents by providing at least thirty (30) days' advance written notice of such intention to Licensor; provided, Licensee will give such notice not less than sixty (60) days prior to the last allowable date for filing or taking any other action required with respect to such portion of the Patents. From and after providing such notice of abandonment, Licensee will have no further obligation with respect to such abandoned portion of the Patents. Any sublicense granted with respect to any Patents abandoned hereunder will not be terminated or altered as a result of such abandonment, provided that such sublicense was granted prior to the effectiveness of such abandonment.

#### **4.5 Licensor's Assistance**

Licensor will provide Licensee with such advice and assistance as Licensee will reasonably request in connection with the filing, prosecution, maintenance, or defense of the Patents. Licensee will not be responsible for any costs incurred by Licensor without Licensee's prior written agreement to bear such costs.

### **5. ENFORCEMENT OF PATENTS**

#### **5.1 Enforcement**

Licensee will have the exclusive right, but not the obligation, to institute, prosecute, and control any action or proceeding with respect to infringement of the Patents, using counsel of its choice, including any declaratory judgment action arising from such infringement. In the event Licensee exercises its right to commence such action or proceeding, Licensee will use reasonable efforts to advise Licensor prior to such commencement. Thereafter, on Licensor's written request no more frequently than every two (2) months, Licensee will report to Licensor reasonable, nonprivileged information on the status of the action or proceeding commenced by Licensee. Licensor does not have and/or retain any right to, and will not, institute any case, action or other enforcement proceeding with respect to infringement of the Patents.

## **5.2 Joinder; Cooperation in Litigation**

This Agreement transfers to Licensee all substantial rights under the Patents and, as a result, Licensee has the right to bring any future action or proceeding to enforce claims under the Patents in its own name, without naming Licenser as a party thereto. However, if necessary or desirable in Licensee's sole discretion, Licensee may name Licenser as a party in any action or proceeding to enforce the Patents. If Licensee finds it necessary or desirable, Licenser will execute all papers or perform any other acts or provide any assistance, at Licensee's expense, toward pursuing such action or proceeding, as reasonably required by Licensee. Licenser will use its best efforts to ensure that any Licenser personnel will be available to cooperate, at Licensee's expense, toward pursuing such action.

## **5.3 Damages for Breach**

In the event of a material breach of this Agreement by Licensee, subject to the terms and conditions of this Agreement, Licenser may seek exclusively money damages pursuant to the terms and conditions of this Agreement. In no event, however, will Licenser be entitled to take any action or direct any proceeding with respect to the Patents without Licensee's express consent and direction unless and until there has been a termination of the Term because of Licensee's proven, continuing and uncured breach.

## **6. REPRESENTATIONS AND WARRANTIES OF LICENSOR**

Licenser represents and warrants to Licensee as of the Effective Date and as of the Closing:

### **6.1 All Substantial Rights**

Licenser intends by this Agreement to transfer to Licensee all substantial rights under the Patents.

### **6.2 Authority**

Licenser is a company duly formed, validly existing, and in good standing under the laws of the jurisdiction of its formation. Licenser has the full power and authority and has obtained all third party consents, approvals, and/or authorizations required to enter into this Agreement and to carry out its obligations hereunder, including, without limitation, the assignment to Licensee of all causes of action with respect to the Patents.

### **6.3 Title and Contest**

Licenser owns, and as of the Closing Licensee will hold, all right, title and interest to each right conferred under this Agreement with respect to the Patents, including, without limitation, all rights, title, and interest in and to the causes of action assigned by this Agreement. Licenser has obtained and properly recorded previously executed assignments for the Patents as necessary to fully perfect its rights and title therein in accordance with governing law and regulation in each jurisdiction. Each right conferred under this Agreement with respect to the Patents is free and clear of all liens, mortgages, security interests, and restrictions on transfer. There are no actions, suits, investigations, claims, or proceedings threatened, pending or in progress relating in any way to any right conferred under this Agreement with respect to the Patents. There are no existing contracts, agreements, options, commitments, proposals, bids, offers, or rights with, to or in any Person to acquire any Patents.

#### **6.4 Existing Licenses and Restrictions on Rights**

No license under the Patents has been granted by Licensor, any prior owner, or inventors. After Closing, none of Licensor, any prior owner, or any inventor will retain any rights or interest in the Patents or the related causes of action. Licensee will not be subject to any covenant not to sue or similar restrictions on its enforcement or enjoyment of any of Patents or the related causes of action as a result of the transactions contemplated in this Agreement or any prior transaction related to the Patents or the Abandoned Assets.

#### **6.5 Validity and Enforceability**

None of the Patents or the Abandoned Assets (other than Abandoned Assets for which abandonment resulted solely from unpaid fees and/or annuities) has been found invalid, unpatentable, or unenforceable for any reason in any administrative, arbitration, judicial or other proceeding, and, with the exception of publicly available documents in the applicable patent office recorded with respect to Patents, Licensor does not know, has not received any notice or claim from any source suggesting that, the Patents are invalid, unpatentable, or unenforceable. If any of the Patents is terminally disclaimed to another patent or patent application, all patents and patent applications subject to such terminal disclaimer are included in this transaction. To the extent "small entity" fees were paid to the United States Patent and Trademark Office for any of the Patents, such reduced fees were then appropriate because the payor qualified to pay "small entity" fees at the time of such payment and specifically had not licensed rights in the any of the Patents to an entity that was not a "small entity."

#### **6.6 Conduct**

Licensor and its representatives have not engaged in any conduct, or omitted to perform any necessary act, the result of which would invalidate any of the Patents or hinder its enforcement, including, without limitation, misrepresenting Licensor's patent rights to a standard-setting organization. There is no obligation imposed by a standards-setting organization on Purchaser to license any of the Patents on particular terms or conditions.

#### **6.7 Enforcement**

Licensor has not (a) put a third party on notice of actual or potential infringement of any of the Patents or the Abandoned Assets or (b) initiated enforcement action(s) with respect to any of the Patents or the Abandoned Assets.

#### **6.8 Patent Office Proceedings**

None of the Patents or the Abandoned Assets has been or is currently involved in any reexamination, reissue, interference proceeding, or any similar proceeding, and no such proceedings are pending or threatened.

## **6.9 Fees**

All maintenance fees, annuities and the like due or payable on each of the Patents have been timely paid. For the avoidance of doubt, Licensors shall pay any maintenance fees for which the fee is payable (e.g., the fee payment window opens) on or prior to the Closing even if the surcharge date or final deadline for payment of such fee would be after the Closing.

## **6.10 Abandoned Patents**

According to each applicable patent office, each of the Abandoned Assets has expired, lapsed, or been abandoned or deemed withdrawn.

## **7. REPRESENTATIONS AND WARRANTIES OF LICENSEE**

Licensee represents and warrants to Licensors as of the Effective Date and the Closing:

### **7.1 LLC Power**

Licensee is duly organized and validly existing under the laws of the jurisdiction of its formation and has full power and authority to enter into this Agreement and to carry out the provisions hereof.

### **7.2 Due Authorization**

Licensee is duly authorized to execute and deliver this Agreement and to perform its obligations hereunder. The individual executing this Agreement on Licensee's behalf has been duly authorized to do so by all requisite corporate action.

## **8. DISCLAIMER OF REPRESENTATIONS AND WARRANTIES; LIMITATION OF LIABILITY; EXCLUSIONS FROM DAMAGES**

### **8.1 Disclaimer of Representations and Warranties**

NEITHER PARTY MAKES ANY REPRESENTATION OR WARRANTY EXCEPT FOR THEIR RESPECTIVE REPRESENTATIONS AND WARRANTIES SET FORTH IN SECTIONS 6 AND 7, AND EACH PARTY DISCLAIMS ALL IMPLIED WARRANTIES, INCLUDING, WITHOUT LIMITATION, THE IMPLIED WARRANTIES OF MERCHANTABILITY AND FITNESS FOR A PARTICULAR PURPOSE. LICENSEE GIVES LICENSOR NO ASSURANCE THAT ANY PROFIT (EITHER FROM A MONETIZATION EVENT INVOLVING SOLELY THE PATENTS OR AS PART OF A PORTFOLIO MONETIZATION) WILL BE GENERATED FOR LICENSOR OR THAT ANY PROFIT PARTICIPATION WILL BE PAYABLE TO LICENSOR. EXCEPT AS EXPRESSLY SET FORTH IN SECTION 6, NEITHER PARTY GIVES THE OTHER PARTY ANY ASSURANCE (A) REGARDING THE PATENTABILITY OF ANY CLAIMED INVENTION IN, OR THE VALIDITY, OF ANY PATENT; OR (B) THAT MANUFACTURE, USE, SALE, OFFERING FOR SALE, IMPORTATION, EXPORTATION OR OTHER DISTRIBUTION OF ANY PRODUCT OR METHOD DISCLOSED AND CLAIMED IN ANY PATENT BY LICENSEE, ANY SUBLICENSEE OR ANYONE ELSE WILL CONSTITUTE AN INFRINGEMENT OF THE INTELLECTUAL PROPERTY RIGHTS OF OTHERS.



## **8.2 Limitation of Liability**

EXCEPT IN THE EVENT OF BREACH OF ANY OF THE PRIMARY WARRANTIES BY LICENSOR OR LICENSOR'S INTENTIONAL MISREPRESENTATION, NEITHER PARTY'S TOTAL LIABILITY UNDER THIS AGREEMENT WILL EXCEED THE PAYMENT AMOUNT SET FORTH IN PARAGRAPH 2.1. THE PARTIES ACKNOWLEDGE THAT THE FOREGOING LIMITATION ON POTENTIAL LIABILITY WAS AN ESSENTIAL ELEMENT IN SETTING CONSIDERATION UNDER THIS AGREEMENT.

## **8.3 Exclusion of Certain Damages**

NEITHER PARTY WILL HAVE ANY OBLIGATION OR LIABILITY (WHETHER IN CONTRACT, WARRANTY, TORT (INCLUDING NEGLIGENCE) OR OTHERWISE, AND NOTWITHSTANDING ANY FAULT, NEGLIGENCE (WHETHER ACTIVE, PASSIVE OR IMPUTED), REPRESENTATION, STRICT LIABILITY OR PRODUCT LIABILITY), FOR COVER OR FOR ANY INCIDENTAL, INDIRECT OR CONSEQUENTIAL, MULTIPLIED, PUNITIVE, SPECIAL, OR EXEMPLARY DAMAGES OR LOSS OF REVENUE, PROFIT, SAVINGS OR BUSINESS ARISING FROM OR OTHERWISE RELATED TO THIS AGREEMENT, EVEN IF A PARTY OR ITS REPRESENTATIVES HAVE BEEN ADVISED OF THE POSSIBILITY OF SUCH DAMAGES. LICENSOR UNDERSTANDS AND CONFIRMS THAT THERE MAY NOT BE ANY PROFIT PARTICIPATION DISTRIBUTED UNDER THIS AGREEMENT. THE PARTIES ACKNOWLEDGE THAT THESE EXCLUSIONS OF POTENTIAL DAMAGES WERE AN ESSENTIAL ELEMENT IN SETTING CONSIDERATION UNDER THIS AGREEMENT.

## **8.4 Compliance With Laws**

Notwithstanding anything contained in this Agreement to the contrary, the obligations of the parties with respect to the consummation of the transactions contemplated by this Agreement shall be subject to all laws, present and future, of any government having jurisdiction over the parties and this transaction, and to orders, regulations, directions or requests of any such government.

## **8.5 Confidentiality of Terms**

The parties hereto will keep the terms and existence of this Agreement and the identities of the parties hereto and their affiliates confidential and will not now or hereafter divulge any of this information to any third party except (a) with the prior written consent of the other party; (b) as otherwise may be required by law or legal process, including, without limitation, in confidence to legal and financial advisors in their capacity of advising a party in such matters; (c) during the course of litigation, so long as the disclosure of such terms and conditions is restricted in the same manner as is the confidential information of other litigating parties; (d) in confidence to its legal counsel, accountants, banks and financing sources and their advisors solely in connection with complying with its obligations under this Agreement; (e) by Licensee, in order to perfect Licensee's interest in the Patents or the Abandoned Assets with any governmental patent office (including, without limitation, recording Memoranda of Exclusive License/Rights in any governmental patent office); or (f) to enforce Licensee's rights and interest in the Patents, the causes of action transferred under this Agreement, or the Abandoned Assets; provided, in (b) and (c) above, (i) to the extent permitted by law, the disclosing party will use all legitimate and legal means available to minimize the disclosure to third parties, including, without limitation, seeking a confidential treatment request or protective order whenever appropriate or available; and (ii) the disclosing party will provide the other party with at least ten (10) days' prior written

notice of such disclosure. Without limiting the foregoing, Licensor will cause its agents involved in this transaction to abide by the terms of this paragraph, including, without limitation, ensuring that such agents do not disclose or otherwise publicize the existence of this transaction with actual or potential clients in marketing materials or industry conferences. In the event of any breach or default, threatened or otherwise, under this paragraph, the parties acknowledge and agree that damages alone would be insufficient to compensate for any such breach or default and that irreparable harm would result from such breach or default. Consequently, in the event of any such breach or default, or any threat of such breach or default by either party, the other party will be entitled to temporary or permanent injunctive relief, specific performance and such other equitable relief as may be appropriate in the circumstances in order to restrain or enjoin such breach or default. These remedies will not be the exclusive remedies for violation of the terms of the confidentiality obligations contained in this paragraph but will be in addition to all other remedies available to the parties at law or in equity.

## **9. DEFINITIONS**

Capitalized terms used in this Agreement that are not otherwise defined have the meanings set forth in this Section.

**"Abandoned Assets"** means those specific provisional patent applications, patent applications, patents and other governmental grants or issuances listed on Exhibit C (as such list may be updated based on Licensee's review pursuant to paragraph 3.1).

**"Affiliate"** means, with respect to any Person, any Entity in whatever country organized that controls, is controlled by or is under common control with such Person. The term "control" means possession, direct or indirect, of the power to direct or cause the direction of the management and policies of an Entity, whether through the ownership of voting securities, by contract or otherwise.

**"Amounts"** as generally used in this Agreement refers to cash amounts, and amounts that are not cash will be valued by Licensee at their cash equivalent under customary valuation techniques.

**"Assignment Agreements"** mean the agreements assigning to Licensor ownership of the Patents and the Abandoned Assets from the inventors and/or any prior owners to Licensor.

**"Closing"** has the meaning set forth in paragraph 3.2.

**"Common Interest Agreement"** means an agreement, in the form set forth on **Exhibit E**, setting forth the terms under which Licensor and Licensee will protect certain information relating to the Patents under the common interest privilege.

**"Docket"** means Licensor's, or its agents', list or other means of tracking information relating to the prosecution or maintenance of the Patents throughout the world, including, without limitation, the names, addresses, email addresses and phone numbers of prosecution counsel and agents, and information relating to deadlines, payments, and filings, which list or other means of tracking information is current as of the Effective Date.

**"Effective Date"** means the date set forth as the Effective Date on the cover page of this Agreement.

**"Entity"** means any corporation, partnership, limited liability company, association, joint stock company, trust, joint venture, unincorporated organization, governmental entity (or any department, agency, or political subdivision thereof) or any other legal entity.

**"IP Group Expenses"** means the Amounts paid, incurred, accrued, or allocated by or on behalf of Licensee in respect of acquiring, holding, prosecuting, maintaining, managing, protecting, or enhancing, including, without limitation, all such Amounts (other than Profit Participation) paid under this Agreement to Licensors and all fees, costs, commissions and expenses for legal, technical, advisory, and consulting services and filing, issuance, annuity and maintenance payments. "IP Group Expenses," as used in this Agreement refers to IP Group Expenses of the Patents.

**"License Issue Fee"** has the meaning set forth in paragraph 2.1.

**"Live Assets"** means the provisional patent applications, patent applications, and patents listed on Exhibits A (as such lists may be updated based on License's review pursuant to paragraph 3.1).

**"Memoranda of Exclusive License/Rights"** means one or more documents in substantially the form of **Exhibit B**, which form may be adjusted for the requirements of the particular government patent office, that memorialize the license and other rights transferred to Licensee by this Agreement

**"Monetization Expenses"** means the Amounts paid, incurred, accrued, or allocated by or on behalf of Licensee in respect of commercializing, asserting, litigating, licensing, managing, or otherwise capturing value, including, without limitation, fees, costs, commissions and expenses for legal, technical, advisory, consulting and licensing services. "Monetization Expenses," as used in this Agreement, may refer to Monetization Expenses of either a monetization event involving solely the Patents or a Portfolio Monetization.

**"Patents"** means, excluding the Abandoned Assets, all (a) Live Assets; (b) patents or patent applications (i) to which any of the Live Assets directly or indirectly claims priority, (ii) for which any of the Live Assets directly or indirectly forms a basis for priority, and/or (iii) that were co-owned applications that incorporate by reference, or are incorporated by reference into, the Live Assets; (c) reissues, reexaminations, extensions, continuations, continuations in part, continuing prosecution applications, requests for continuing examinations, divisions, and registrations of any item in any of the foregoing categories (a) and (b); (d) foreign patents, patent applications and counterparts relating to any item in any of the foregoing categories (a) through (c), including, without limitation, certificates of invention, utility models, industrial design protection, design patent protection, and other governmental grants or issuances; and (e) items in any of the foregoing categories (b) through (d) whether or not expressly listed as Live Assets and whether or not claims in any of the foregoing have been rejected, withdrawn, cancelled, or the like.

**"Person"** means any individual or Entity.

**"Portfolio Monetization"** has the meaning set forth in paragraph 2.3.

**"Portfolio Profit"** means Revenue from, minus Monetization Expenses of, a Portfolio Monetization.

**"Primary Warranties"** means, collectively, the representations and warranties of Licensor set forth in paragraphs 6.1, 6.2, 6.3, 6.4, and 6.5 hereof.

**"Profit"** means

the total of the Portfolio Profit that is allocated under paragraphs 2.3 through 2.5 to the patents and patent applications among the Patents included in a Portfolio Monetization;

plus Revenue from, minus remaining Monetization Expenses of, monetization events involving solely the Patents and which are not a Portfolio Monetization;

minus any remaining IP Group Expenses.

**"Profit Participation"** has the meaning set forth in paragraph 2.2.

**"Prosecution History Files"** means all files, documents and tangible things, as those terms have been interpreted pursuant to rules and laws governing the production of documents and things, constituting, comprising or relating to the investigation, evaluation, preparation, prosecution, maintenance, defense, filing, issuance, registration, assertion or enforcement of the Patents.

**"Reporting Period"** has the meaning set forth in paragraph 2.7.

**"Revenue"** means Amounts received by or on behalf of Licensee and recognized as revenue under generally accepted accounting principles from (a) licensing and/or (b) damages awarded in litigation or other proceedings, and/or (c) sale of the rights granted to Licensee under this Agreement. "Revenue," as used in this Agreement, may refer to Revenue from either a monetization event involving solely the Patents or a Portfolio Monetization.

**"Term"** has the meaning set forth in paragraph 10.3.

**"Transmitted Copy"** has the meaning set forth in paragraph 10.13.

## **10. MISCELLANEOUS**

### **10.1 Relationship of Parties**

The parties hereto are independent contractors. Nothing in this Agreement will be construed to create a partnership, joint venture, franchise, fiduciary, employment or agency relationship between the parties. Neither party has any express or implied authority to assume or create any obligations on behalf of the other or to bind the other to any contract, agreement or undertaking with any third party.

### **10.2 Assignment; Successors**

The terms and conditions of this Agreement will inure to the benefit of Licensee, its successors, assigns and other legal representatives, and will be binding upon Licensor, its successors, assigns, and other legal representatives. Without Licensor's consent, Licensee may assign, in whole or in part, this Agreement, and/or any license or other rights Licensee acquires hereunder, to its Affiliates. Licensor will not unreasonably withhold or delay its

consent to any other assignment requested by Licensee of this Agreement, in whole or in part, or of any license or other rights Licensee acquires hereunder.

### **10.3 Term and Termination**

The term of this Agreement (the "**Term**") will commence on the Effective Date and will continue in effect until the last of the Patents expires, or such longer time as may be necessary, as determined at Licensee's sole and absolute discretion, to permit Licensee to fully enforce and protect its rights under the Patents for any action or proceeding for infringement arising before such expiration. Subject to the provisions of paragraph 10.9, in the event of a material breach of this Agreement, the nonbreaching party will be entitled to terminate the Term by written notice to the breaching party, if such breach is not cured within ten (10) business days (for monetary defaults) and sixty (60) days (for non-monetary defaults) after written notice specifying the breach is given to the breaching party.

### **10.4 Survival/Effect of Termination**

No termination of the Term will relieve a breaching party of its obligations arising prior to such termination.

### **10.5 Export Controls**

It is understood and agreed that to the extent Licensor is subject to United States laws and regulations controlling the export of technical data, computer software, laboratory prototypes, and other commodities (including the Arms Export Control Act, as amended, and the Export Administration Act of 1979), and that its obligations hereunder are contingent on compliance with applicable United States export laws and regulations. The transfer of certain technical data and commodities may require a license from the cognizant agency of the United States Government and/or written assurances by Licensee that Licensee will not export data or commodities to certain foreign countries without prior approval of such agency. Licensor neither represents that a license will not be required nor that, if required, it will be issued.

### **10.6 Governing Law**

Any claim arising under or relating to this Agreement will be governed by the laws of England, without regard to choice of law principles to the contrary.

### **10.7 Dispute Resolution**

Except as provided under paragraph 8.5, the parties hereby waive their respective rights to seek remedies in court, and will resolve any and all claims, disputes, or controversies relating in any way to, or arising out of, this Agreement, including, without limitation, any breach or threatened breach of this Agreement, the amount of the Profit Participation due under this Agreement, or the calculation of Profit ("Disputes"), as follows:

(a) The party raising the Dispute shall promptly provide the other party with a written notice describing the nature of the Dispute in reasonable detail (a "Dispute Notice"). During the thirty (30) day period after a party's receipt of a Dispute Notice, the parties will commence discussions to attempt to resolve the Dispute.

(b) If the parties cannot timely resolve the Dispute through negotiation, before resorting to arbitration the parties will try in good faith to settle the Dispute by mediation before a mutually agreed mediator in Philadelphia, Pennsylvania. The mediation will be conducted in English and administered by the American Arbitration Association ("AAA") under its Commercial Mediation Procedures. If the parties are unable to agree upon a mutually acceptable mediator, the AAA will appoint a qualified mediator. The mediation proceeding shall take place on the earliest practicable date following the submission of a request for mediation by either party, which request shall be submitted within sixty (60) days after a party's receipt of a Dispute Notice.

(c) If the Dispute is not resolved through mediation within thirty (30) days after the mediation hearing, the parties will submit the Dispute to final and binding arbitration administered by the AAA under its Commercial Arbitration Rules. The arbitrator may enter a default decision against any party who fails to participate in the arbitration proceedings.

(i) The arbitration will be conducted before a mutually agreed panel of three neutral (3) arbitrators in Philadelphia, Pennsylvania. If the parties are unable to agree upon a mutually acceptable panel of three (3) arbitrators, the panel will be selected by the AAA.

(ii) The arbitration hearing will be conducted in English, and under no circumstances will the arbitration hearing extend for more than one (1) business day. The award shall be rendered within one hundred twenty (120) days of the demand and the arbitrators shall agree to comply with this schedule before accepting appointment. The parties have included these time limits to expedite the proceeding, but they are not jurisdictional, and the arbitrator may for good cause permit reasonable extensions which shall not affect the validity of the award.

(iii) All documents and information relevant to the Dispute in the possession of any party shall be made available to the other party not later than sixty (60) days after the demand for arbitration is served, and the arbitrator may permit such depositions or other discovery deemed necessary for a fair hearing.

(iv) The parties agree that the arbitration method to be employed by the parties will be "baseball arbitration," in which case each party will submit to the arbitrators and exchange with each other in advance of the hearing their last, best offers and the arbitrators will be limited to awarding only one or the other of the two figures submitted.

(v) The arbitrators' award may be entered and enforced in any court with competent jurisdiction and will be nonappealable. Such decision may be used in a court of law only for the purpose of seeking enforcement of the arbitrator's decision permitted under this Agreement.

(vi) The costs of the arbitration proceeding, including reasonable attorneys' fees and costs, will be determined by the arbitrators, who may apportion costs equally, or in accordance with any finding of fault or lack of good faith of either party.

(vii) To the fullest extent permitted by law, no arbitration under this Agreement shall be joined to any other arbitration, and no class arbitration proceedings shall be permitted.

(viii) Except as may be required by law, neither a party nor any arbitrator may disclose the existence, content, or results of any arbitration hereunder without the prior written consent of both parties.

Notwithstanding the foregoing, nothing in this paragraph 10.7 will be construed to waive any rights of timely performance of any obligations existing under this Agreement through the Closing.

#### **10.8 Notices and Payment Delivery**

All notices required or permitted to be given hereunder will be in writing, will make reference to this Agreement and will be delivered by hand, or dispatched by prepaid air courier to the addresses set forth on the cover page of this Agreement. Such notices will be deemed given when received by addressee or, if delivery is not accomplished by reason of some fault of the addressee, when tendered for delivery. Either party may give written notice of a change of address to the other. After notice of such change has been received, any notice or request will thereafter be given to such party at such changed address.

#### **10.9 Remedies**

Licensor's sole and exclusive remedy in the event of any claim, dispute, or controversy under this Agreement will be the recovery of money damages, subject to the disclaimer and limitations set forth in this Agreement, including, without limitation, those in paragraphs 8.1 through 8.3.

#### **10.10 Severability**

If any provision of this Agreement is found to be invalid or unenforceable, then the remainder of this Agreement will have full force and effect, and the invalid provision will be modified, or partially enforced, to the maximum extent permitted to effectuate the original objective.

#### **10.11 Waiver**

Failure by either party to enforce any term of this Agreement will not be deemed a waiver of future enforcement of that or any other term in this Agreement or any other agreement that may be in place between the parties.

#### **10.12 Miscellaneous**

This Agreement, including its exhibits, constitutes the entire agreement between the parties with respect to the subject matter hereof and merges and supersedes all prior and contemporaneous agreements, understandings, negotiations, and discussions. Neither of the parties will be bound by any conditions, definitions, warranties, understandings, or representations with respect to the subject matter hereof other than as expressly provided herein. The section headings contained in this Agreement are for reference purposes only and will not affect in any way the meaning or interpretation of this Agreement. This Agreement is not intended to confer any right or benefit on any third party (including, but not limited to, any employee or beneficiary of any party), and no action may be commenced or prosecuted against a party by any third party claiming as a third-party beneficiary of this Agreement or any of the transactions contemplated by this Agreement. No oral explanation or oral information by either party hereto will alter the meaning or interpretation of this Agreement. No amendments or modifications will be effective unless in a writing signed by

authorized representatives of both parties; provided, however, that, both prior to and after the Closing, Licensee may update **Exhibits A** and **B** to include any patents or patent applications within the definition of Patents, based on its review of the Deliverables as defined in paragraph 3.1, by providing updated **Exhibits A and B** to Licensor. The terms and conditions of this Agreement will prevail notwithstanding any different, conflicting or additional terms and conditions that may appear on any letter, email or other communication or other writing not expressly incorporated into this Agreement. The following exhibits are attached hereto and incorporated herein: **Exhibit A** (entitled "Patents Being Licensed"); **Exhibit B** (entitled "Memorandum of Exclusive License/Rights"); and **Exhibit C** (entitled "Transfer of Rights in Certain Assets"); **Exhibit D** (entitled "List of Initial Deliverables"); and **Exhibit E** (entitled "Common Interest Agreement).

#### ***10.13 Counterparts; Electronic Signature***

This Agreement may be executed in counterparts, each of which will be deemed an original, and all of which together constitute one and the same instrument. Each party will execute and promptly deliver to the other parties a copy of this Agreement bearing the original signature. Prior to such delivery, in order to expedite the process of entering into this Agreement, the parties acknowledge that a Transmitted Copy of this Agreement will be deemed an original document. "Transmitted Copy" means a copy bearing a signature of a party that is reproduced or transmitted via email of a .pdf file, photocopy, facsimile, or other process of complete and accurate reproduction and transmission.

#### ***10.14 Language***

The official language of this Agreement exclusively shall be, and all communications and agreements between the parties exclusively shall be made in, the English language. The parties hereto waive any rights they may have under any other law to have this Agreement written in another language, and any translation of this Agreement will be solely for the convenience of the parties hereto.

[Remainder of page left blank intentionally.]



## **EXHIBIT A**

### **PATENTS BEING LICENSED**

All right, title, and interest that exist today and may exist in the future in and to any and all of the following:

(a) the provisional patent applications, patent applications and patents listed in the table below (the "*Patents*");

<b><u>Patent or Application No.</u></b>	<b><u>Country</u></b>	<b><u>Filing Date</u></b>	<b><u>Title of Patent and First Named Inventor</u></b>
IT1262399 (IT93RM00567)	IT	6/19/1996 (8/20/1993)	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY  MALTESE PAOLO
AU19940075080	AU	8/18/1994	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY  MALTESE PAOLO
5,841,419 (08/596,187)	US	11/24/1998 (2/13/1996)	CONTROL METHOD FOR FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY  MALTESE PAOLO
IT1276221 (IT93RM00567)	IT	10/27/1997 (10/12/1995)	OPTICALLY PROGRAMMABLE OPTOELECTRONIC CELLULAR NEURAL NETWORK  BALSI MARCO; CIMAGALLI VALERIO; GALLUZZI FABRIZIO
5,864,836 (08/721,600)	US	1/26/1999 (9/26/1996)	OPTICALLY PROGRAMMABLE OPTOELECTRONIC CELLULAR NEURAL NETWORK  Balsi, Marco; Cimagalli, Valerio; Galluzzi, Fabrizio
IT1286331 (IT96RM00661)	IT	7/8/1998 (9/27/1996)	A LOW VOLTAGE CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY PANEL  MALTESE PAOLO
AU19970046369	AU	9/25/1997	A LOW VOLTAGE CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY PANEL  MALTESE PAOLO
CN1236465	CN	9/25/1997	A LOW VOLTAGE CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY PANEL  MALTESE PAOLO
IT1271866 (IT94RM00102 )	IT	6/9/1997 (2/25/1994)	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL  MALTESE PAOLO
AU19950018229	AU	2/22/1995	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL

<u>Patent or Application No.</u>	<u>Country</u>	<u>Filing Date</u>	<u>Title of Patent and First Named Inventor</u>
			MALTESE PAOLO
CN95191771	CN	2/22/1995	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL MALTESE PAOLO
DE69523444 (DE19956023444)	DE	6/27/2002 (2/22/1995)	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL MALTESE PAOLO
FR0746839 (FR95909948.2)	FR	10/24/2001 (7/20/1996)	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL MALTESE PAOLO
6,052,106 (08/693,315)	US	4/18/2000 (8/16/1996)	CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL Maltese, Paolo

(b) all patents and patent applications (i) to which any of the Patents directly or indirectly claims priority, (ii) for which any of the Patents directly or indirectly forms a basis for priority, and/or (iii) that were co-owned and that directly or indirectly incorporate by reference the Patents;

(c) all reissues, reexaminations, extensions, continuations, continuations in part, continuing prosecution applications, requests for continuing examinations, divisions, and registrations of any item in the foregoing categories (a) and (b);

(d) all foreign patents, patent applications, and counterparts relating to any item in the foregoing categories (a) through (c), including, without limitation, certificates of invention, utility models, industrial design protection, design patent protection, and other governmental grants or issuances;

(e) all items in any of the foregoing in categories (b) through (d), whether or not expressly listed as Patents below and whether or not claims in any of the foregoing have been rejected, withdrawn, cancelled, or the like; and

(f) all inventions, invention disclosures, and discoveries described in any item in any of the foregoing categories (a) through (e) and all other rights arising out of such inventions, invention disclosures, and discoveries.

## **EXHIBIT B**

### **MEMORANDUM OF EXCLUSIVE LICENSE/RIGHTS**

Universita Degli Studi di Roma La Sapienza, an Italian educational institution having offices at Piazzale Aldo Moro 5, Roma, Italy, ("*Licensors*"), has granted to Degdi Research Limited Liability Company, a Delaware limited liability company, having an office at 2711 Centerville Road, Suite 400, Wilmington, DE 19808 ("*Licensee*"), the exclusive, worldwide, transferable, sublicensable, license of all rights of any kind conferred by the patents, patent applications, and provisional patent applications listed in the table below:

<b><u>Patent or Application No.</u></b>	<b><u>Country</u></b>	<b><u>Filing Date</u></b>	<b><u>Title of Patent and First Named Inventor</u></b>
IT1262399 (IT93RM00567)	IT	6/19/1996 (8/20/1993)	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY  MALTESE PAOLO
AU19940075080	AU	8/18/1994	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY  MALTESE PAOLO
5,841,419 (08/596,187)	US	11/24/1998 (2/13/1996)	CONTROL METHOD FOR FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY  MALTESE PAOLO
IT1276221 (IT93RM00567)	IT	10/27/1997 (10/12/1995)	OPTICALLY PROGRAMMABLE OPTOELECTRONIC CELLULAR NEURAL NETWORK  BALSÌ MARCO; CIMAGALLI VALERIO; GALLUZZI FABRIZIO
5,864,836 (08/721,600)	US	1/26/1999 (9/26/1996)	OPTICALLY PROGRAMMABLE OPTOELECTRONIC CELLULAR NEURAL NETWORK  Balsi, Marco; Cimagalli, Valerio; Galluzzi, Fabrizio
IT1286331 (IT96RM00661)	IT	7/8/1998 (9/27/1996)	A LOW VOLTAGE CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY PANEL  MALTESE PAOLO
AU19970046369	AU	9/25/1997	A LOW VOLTAGE CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY PANEL  MALTESE PAOLO
CN1236465	CN	9/25/1997	A LOW VOLTAGE CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY PANEL  MALTESE PAOLO
IT1271866 (IT94RM00102 )	IT	6/9/1997 (2/25/1994)	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL  MALTESE PAOLO
AU19950018229	AU	2/22/1995	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL

<u>Patent or Application No.</u>	<u>Country</u>	<u>Filing Date</u>	<u>Title of Patent and First Named Inventor</u>
			MATRIX PANEL MALTESE PAOLO
CN95191771	CN	2/22/1995	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL MALTESE PAOLO
DE69523444 (DE19956023444)	DE	6/27/2002 (2/22/1995)	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL MALTESE PAOLO
FR0746839 (FR95909948.2)	FR	10/24/2001 (7/20/1996)	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL MALTESE PAOLO
6,052,106 (08/693,315)	US	4/18/2000 (8/16/1996)	CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL Maltese, Paolo

including, without limitation, the rights of any kind to, or conferred by, the Patents (defined below) to (a) use or otherwise practice any art, methods, processes, and procedures covered by the Patents, (b) make, have made, use, offer to sell, sell, import, and otherwise distribute or dispose of any inventions, discoveries, products, services, technologies or services covered by the Patents, (c) otherwise exploit any rights granted in the Patents and/or any invention or discovery described in the Patents, and (d) exclude other Persons from exercising any of such rights.

The "Patents" include all right, title, and interest that exist today and may exist in the future in and to any and all of the following:

- (a) the provisional patent applications, patent applications and patents listed in the table set forth above;
- (b) all patents and patent applications (i) to which any of the Patents directly or indirectly claims priority, (ii) for which any of the Patents directly or indirectly forms a basis for priority, and/or (iii) that were co-owned and that incorporate by reference, or are incorporated by reference into the Patents;
- (c) all reissues, reexaminations, extensions, continuations, continuations in part, continuing prosecution applications, requests for continuing examinations, divisions, and registration of any item in the foregoing categories (a) and (b);
- (d) all foreign patents, patent applications, and counterparts relating to any item in the foregoing categories (a) through (c), including, without limitation, certificates of invention, utility models, industrial design protection, design patent protection, and other governmental grants or issuances;

(e) all items in any of the foregoing in categories (b) through (d), whether or not expressly listed as Patents below and whether or not claims in any of the foregoing have been rejected, withdrawn, cancelled, or the like; and

(f) all inventions, invention disclosures, and discoveries described in any item in any of the foregoing categories (a) through (e) and all other rights arising out of such inventions, invention disclosures, and discoveries.

Licensor has also assigned, transferred and conveyed to Licensee all right, title, and interest in and to:

(x) rights to apply in any or all countries of the world for patents, certificates of invention, utility models, industrial design protections, design patent protections, or other governmental grants or issuances of any type related to any of the Patents and the inventions and discoveries therein;

(y) all causes of action and enforcement rights of any kind (whether such claims, causes of action or enforcement rights are known or unknown; currently pending, filed, to be filed, or otherwise) under the Patents and/or under or on account of any of the Patents for past, current and future infringement of the Patents, including without limitation, all rights to (i) pursue and collect damages, profits and awards of whatever nature recoverable, (ii) injunctive relief, (iii) other remedies, and (iv) compromise and/or settle all such claims, causes of action and enforcement rights, for such infringement by granting an infringing party a sublicense or otherwise; and

(z) rights to collect royalties or other payments under or on account of any of the Patents or any of the foregoing.

The preparation, filing, prosecution, maintenance and defense of the Patents will be under Licensee's exclusive control and discretion, in all pertinent governmental patent offices anywhere in the world.

Licensor hereby irrevocably grants Licensee the exclusive power to grant one or more powers of attorney with respect to the Patents and the exclusive discretion to transfer that right to Licensee's agent(s) or representative(s) that Licensee may designate one or more time, now or in the future. Licensor understands that execution of this document confers on any attorney(s) or agent(s) to whom Licensee may grant a power of attorney the exclusive right to correspond with any patent office with respect to the Patents, and that this document does not create an attorney -

client relationship with such practitioners to whom Licensee grants powers of attorney pursuant to this paragraph.

IN WITNESS WHEREOF this Memorandum of Exclusive License/Rights is executed at \_\_\_\_\_ on \_\_\_\_\_.

LICENSOR:

**UNIVERSITA DEGLI STUDI DI ROMA  
LA SAPIENZA**

By: \_\_\_\_\_

Name: \_\_\_\_\_

Title: \_\_\_\_\_

**ATTESTATION OF SIGNATURE PURSUANT TO 28 U.S.C. 1746**

The undersigned witnessed the signature of \_\_\_\_\_ to the above Assignment of Patent Rights on behalf of [Seller] and makes the following statements:

1. I am over the age of 18 and competent to testify as to the facts in this Attestation block if called upon to do so.
2. \_\_\_\_\_ is personally known to me (or proved to me on the basis of satisfactory evidence) and appeared before me on \_\_\_\_\_, 20\_\_ to execute the above Assignment of Patent Rights on behalf of [Seller].
3. \_\_\_\_\_ subscribed to the above Assignment of Patent Rights on behalf of [Seller].

I declare under penalty of perjury under the laws of the United States of America that the statements made in the three (3) numbered paragraphs immediately aboveforegoing are is true and correct.

EXECUTED on \_\_\_\_\_(date)

Print Name: \_\_\_\_\_

**EXHIBIT C**

**TRANSFER OF RIGHTS IN CERTAIN ASSETS MEMORANDUM OF EXCLUSIVE  
LICENSE/RIGHTS**

<b><u>Patent or Application No.</u></b>	<b><u>Country</u></b>	<b><u>Filing Date</u></b>	<b><u>Title of Patent and First Named Inventor</u></b>
PCT/IT94/00138	WO	8/18/1994	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY  MALTESE PAOLO
EP94924990.8	EP	8/18/1994	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY  MALTESE PAOLO
PCT/IT97/00232	WO	9/25/1997	A LOW VOLTAGE CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY PANEL  MALTESE PAOLO
EP97945078.0	EP	9/25/1997	A LOW VOLTAGE CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY PANEL  MALTESE PAOLO
6,388,650 (09/269,308)	US	5/14/2002 (3/29/1999)	LOW VOLTAGE CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX DISPLAY PANEL  Maltese, Paolo
PCT/IT95/00029	WO	2/22/1995	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL  MALTESE PAOLO
EP0746839 (EP95909948.2)	EP	10/24/2001 (2/22/1995)	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL  MALTESE PAOLO
ES0746839 (ES95909948.2)	ES	10/24/2001 (7/20/1996)	A CONTROL METHOD FOR A FERROELECTRIC LIQUID CRYSTAL MATRIX PANEL  MALTESE PAOLO

*Exhibit D*

LIST OF INITIAL DELIVERABLES

Licensor will cause the following to be delivered to Licensee, or Licensee's representative, within the time provided in paragraph 3.1 of the attached Patent Purchase Agreement:

(a) U.S. Patents. For each item of the Patents that is an issued United States patent, and for each Abandoned Asset to which any Live Asset claims priority to such issued U.S. patent (whether a patent or similar protection has been issued or granted),

- (i) the original
  - (A) Assignment Agreement(s),
  - (B) conception and reduction to practice materials, and
- (ii) a copy of
  - (A) ribbon copy issued by the United States Patent and Trademark Office,
  - (B) the publicly available file history (to be obtained in both electronic disk image and hard copy, at Licensee's option, by Licensee or by Licensor through a vendor designated by Licensee, in all cases for delivery directly to Licensee's representative),
  - (C) the Docket,
  - (D) each relevant license and security agreement;

(b) U.S. Patent Applications. For each item of the Patents that is a U.S. patent application,

- (i) a copy of the patent application, as filed,
- (ii) if unpublished, a copy of the filing receipt and the non-publication request, if available,
- (iii) the original Assignment Agreement(s),
- (iv) the Docket,
- (v) all available conception and reduction to practice materials,
- (vi) evidence of foreign filing license (or denial thereof),
- (vii) a copy of each relevant license and security agreement, and
- (viii) the Prosecution History Files;

(c) Common Interest Agreement. Licensor will deliver any Initial Deliverables to be delivered by Licensor under paragraph (b) above to Licensee's legal counsel, together with two (2) executed originals of the Common Interest Agreement.

(d) Non-U.S. for each Live Asset for which a non-United States patent or similar protection has been issued or granted,

- (i) the copy of the certificate for patent prosecution issued by the applicable government, if available
- (ii) copy of each pending foreign application
- (iii) the Docket,
- (iv) the Assignment Agreement(s),
- (v) a copy of applicant name change, if necessary, and
- (vi) a copy of each relevant license and security agreement.

(e) Thorough Search/Declaration. If originals of the Initial Deliverables are not available and delivered to Licensee prior to Closing, Licensor will cause (i) such originals of the Initial Deliverables to be sent to Licensee or Licensee's representative promptly if and after such originals are located and (ii) an appropriate executive officer of Licensor to deliver to Licensee an declaration, executed by such officer under penalty of perjury, detailing Licensor's efforts to locate such unavailable original documents and details regarding how delivered copies were obtained; and

Capitalized terms used in this Exhibit D are defined in the Patent License Agreement to which this Exhibit D is attached.



**COMMON INTEREST AGREEMENT**

THIS COMMON INTEREST AGREEMENT ("Agreement") is entered into between the undersigned legal counsel ("Counsel"), for themselves and on behalf of the parties they represent (as indicated below).

**1. Background.**

1.1 Degdi Research Limited Liability Company, a Delaware limited liability company ("Licensee") and Università Degli Studi di Roma La Sapienza, an Italian educational institution ("Licensor") (Licensee and Licensor are sometimes hereafter referred to herein as a "party" or the "parties"), have entered into an agreement under which Licensee will acquire all substantial rights of Licensor in certain patent applications filed or to be filed throughout the world (the "Patent Matters").

1.2 The parties have a common interest in the Patent Matters and have agreed to treat their communications and those of their Counsel relating to the Patent Matters as protected by the common interest privilege. Furtherance of the Patent Matters requires the exchange of proprietary documents and information, the joint development of legal strategies and the exchange of attorney work product developed by the parties and their respective Counsel.

**2. Common Interest.**

2.1 The parties have a common, joint and mutual legal interest in cooperating with each other, to the extent permitted by law, to share information protected by the attorney-client privilege and by the work product doctrine with respect to the Patent Matters. Any counsel or consultant retained by a party or their Counsel to assist in the Patent Matters shall be bound by, and entitled to the benefits of, this Agreement.

2.2 In order to further their common interest, the parties and their Counsel shall exchange privileged and work product information, orally and in writing, including, without limitation, factual analyses, mental impressions, legal memoranda, source materials, draft legal documents, prosecution history files and other information (hereinafter "Common Interest Materials"). The sole purpose for the exchange of the Common Interest Materials is to support the parties' common interest with respect to the prosecution and enforcement of the Patent Matters. Any Common Interest Materials exchanged shall continue to be protected under all applicable privileges and no such exchange shall constitute a waiver of any applicable privilege or protection.

**3. Nondisclosure.**

3.1 The parties and their Counsel shall use the Common Interest Materials solely in connection with the Patent Matters and shall take appropriate steps to protect the privileged and confidential nature of the Common Interest Materials. Neither client nor their respective Counsel shall produce privileged documents or information unless or until directed to do so by a final order of a court of competent jurisdiction, or upon the prior written consent of the other party. No privilege or objection shall be waived by a party hereunder without the prior written consent of the other party. The obligations under this paragraph will not apply either to Licensee after closing of the acquisition of the Patent Matters or to Licensor with respect to any dispute with Licensee related to such potential acquisition.

3.2 Except as herein provided, in the event that either party or their Counsel is requested or required in the context of a litigation, governmental, judicial or regulatory investigation or other similar proceedings (by oral questions, interrogatories, requests for information or documents, subpoenas,

civil investigative demands or similar process) to disclose any Common Interest Materials, the party or their Counsel shall immediately inform the other party and their Counsel and shall assert all applicable privileges, including, without limitation, the common interest doctrine, the joint prosecution privilege.

**4. Relationship; Additions; Termination.**

4.1 This Agreement does not create any agency or similar relationship among the parties. Through the Closing (as defined in the Patent Purchase Agreement executed by Licensee and Licensor), neither party nor their respective Counsel has the authority to waive any applicable privilege or doctrine on behalf of any other party.

4.2 Nothing in this Agreement affects the separate and independent representation of each party by its respective Counsel or creates an attorney client relationship between the Counsel for a party and the other party to this Agreement.

4.3 This Agreement shall continue until terminated upon the written request of either party. Upon termination, each party and their respective Counsel shall return any Common Interest Materials furnished by the other party. Notwithstanding termination, this Agreement shall continue to protect all Common Interest Materials disclosed prior to termination. Sections 3 and 5 shall survive termination of this Agreement.

**5. General Terms.**

5.1 This Agreement is governed by the laws of the State of Delaware, without regard to its choice of law principles to the contrary. In the event any provision of this Agreement is held by any court of competent jurisdiction to be illegal, void or unenforceable, the remaining terms shall remain in effect. Failure of either party to enforce any provision of this Agreement shall not be deemed a waiver of future enforcement of that or any other provision.

5.2 The parties agree that a breach of this Agreement would result in irreparable injury, that money damages would not be a sufficient remedy and that the disclosing party shall be entitled to equitable relief, including injunctive relief, as a non-exclusive remedy for any such breach.

5.3 Notices given under this Agreement shall be given in writing and delivered by messenger or overnight delivery service to a party and their respective Counsel at their last known address, and shall be deemed to have been given on the day received.

5.4 This Agreement is effective and binding upon each party as of the date it is signed by or on behalf of a party and may be amended only by a writing signed by or on behalf of each party. This Agreement may be executed in counterparts. Any signature reproduced or transmitted via email of a .pdf file, photocopy, facsimile or other process of complete and accurate reproduction and transmission shall be considered an original for purposes of this Agreement.

This Agreement is being executed by each of the undersigned Counsel with the fully informed authority and consent of the respective party it represents.

Counsel for Degdi Research Limited Liability Company

Counsel for Università Degli Studi di Roma La Sapienza

By: \_\_\_\_\_  
Date: \_\_\_\_\_

By: \_\_\_\_\_  
Date: \_\_\_\_\_