

MRD

8-12-98

RECORDED

08-17-1998

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

To the Honorable Commissioner of Patents

100795759

Original documents or copy thereof:

1. Name of conveying party(ies):

Richie Eye Research PTY Limited (formerly Cain Research PTY Limited)

Additional name(s) of conveying party(ies) attached?

☐ Yes☒ No

3. Nature of Conveyance:

☐ Assignment☐ Merger☐ Security Agreement☐ Change of Name☒ Other: Revocation of Assignment to Daphne Eye Instruments

Execution Date: 12 August 1998

2. Name and address of receiving party(ies):

Name: Daphne Eye Instruments

Internal Address: 1575 Kalaniiki Street

Street Address:

City: Honolulu

State: Hawaii Zip: 96821

Additional name(s) & address(es) attached?

☐ Yes☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s):

B. Patent No.(s): 5,329,322; 5,576,780; 5,684,561

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Greg T. Sueoka

Internal Address: Fenwick & West LLP

Street Address: Two Palo Alto Square

City: Palo Alto State: CA Zip Code: 94306

6. Total number of applications and patents involved: [3]

7. Total fee (37 CFR 3.41): \$120.00

☐ Enclosed☒ Fee Transmittal Enclosed

8. Deposit Account No.: 19-2555

DO NOT USE THIS SPACE

9. Statement and signature:

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Greg T. Sueoka, 33,800

Attorney, Reg No.

Signature

Date

Total number of pages including cover sheet, attachments, documents: [5]

Mail documents to be recorded with required cover sheet information to:

08/14/1998 TT011 00000050 192555 5329322

Box Assignee, Commissioner For Patents and Trademarks

01 FC:581

120.00 CH

Washington, D.C. 20231

PATENT
REEL: 9375 FRAME: 0401

CONFIRMATORY LICENSE AND RECTIFICATION DEED made at Sydney on 12/12
August 1998

BETWEEN **RICHIE EYE RESEARCH PTY LIMITED, ACN 066 749 684** an
Australian company incorporated in New South Wales, with offices at Suite
2505 National Mutual Centre, 44 Market Street, Sydney NSW 2000 Australia
(hereafter "**Richie Eye Research**"),

AND **ACN 067 589 977 PTY LIMITED, ACN 067 589 977**, of Level 12, 301
George Street, Sydney, New South Wales, 2000 Australia (hereafter "**TRD**")

AND a **JOINT VENTURE** between Richie Eye Research and TRD (hereafter
"**Joint Venture**")

AND **THAKRAL CORPORATION PTY LIMITED**, of Level 12, 301 George
Street, Sydney, New South Wales, 2000 Australia (hereafter "**Thakral**")

RECITALS

- A. Richie Eye Research was formerly known as Cain Research Pty Limited (hereafter "**Cain**"), an Australian corporation, having a place of business at ~~12/26~~ Macpherson Street, Warriewood NSW Australia. Cain changed its corporate name to Richie Eye Research Pty. Limited on or about June 1997. 47/28
- B. On December 30, 1994, Cain entered into a License, Research and Commercialisation Agreement (hereafter "**LRC Agreement**") with the Joint Venture. Pursuant to the LRC Agreement, Cain agreed to exclusively license to the Joint Venture core technology including certain patent applications and patents.
- C. On June 5, 1997, Cain, TRD and other parties entered into a Variation Deed. The grant and scope of said exclusive license were not changed by the Variation Deed.
- D. On March 24, 1998, Richie Eye Research, TRD and other parties entered into a Second Variation Deed. The grant and scope of said exclusive license were not changed by the Second Variation Deed.
- E. During the period August 14 1996 to February 6, 1997, Don Robert Yancey (hereafter "**Yancey**"), whose address is 1575 Kalaniiki Street, Honolulu, Hawaii 96821 U.S.A., was a non-executive director of Richie Eye Research, and Richie Eye Research had two other directors. As a non-executive director of Richie Eye Research, Don Robert Yancey did not have the requisite power and authority to bind Richie Eye Research with respect to assignment of any patent rights without the approval of the remaining Australian resident directors of Richie Eye Research. During the relevant time period, Don Robert Yancey, was also associated with a number of corporate entities in the United States, including Daphne Eye Instruments and Daphne Eye Technologies, a limited partnership with a place of business in Honolulu, Hawaii.
- F. A dispute concerning the ownership of intellectual property rights described below has arisen between Richie Eye Research and Daphne Eye Instruments.

THIS DEED WITNESSES:

For good and valuable consideration, the receipt of which is acknowledged, the parties acknowledge, represent and agree as follows:

1. On December 28, 1994, Richie Eye Research, owned all rights, title and interests in and to:
 - (a) U.S. Patent Application Serial Number 888,166 filed May 26, 1992 that issued as U.S. Patent Number 5,329,322;
 - (b) U.S. Patent Application Serial Number 888,166 filed May 26, 1992 and Serial Number 267,123 filed June 27, 1994 that issued as U.S. Patent Number 5,684,561;
 - (c) U.S. Patent Application Serial Numbers 888,166 filed May 26, 1992, Serial Number 267,123 filed June 27, 1994, and Serial Number 490,604 filed June 6, 1995 that issued as U.S. Patent Number 5,576,780

and all continuation, divisional, reissue patent granted thereof, including the subject matter of any and all claims which may be obtained in every such patent and all foreign counterparts (hereafter collectively "the Patents"), and the records in the United States Patent and Trade mark Office reflected such ownership at reel 7340, frame 294-295.

2. Richie Eye Research hereby confirms that Richie Eye Research has and continues to exclusively license to the Joint Venture, Richie Eye Research's right, title, and interest, to the Patents to carry out its obligations and to receive its rights and benefits according to the LRC Agreement, Variation Deed and Second Variation Deed ("License"). The License has been made for good and valuable consideration, receipt of which is hereby acknowledged. The License has been made and is effective as of December 30, 1994.
3. On October 11, 1996, Yancey, without the knowledge or consent of remaining directors of Richie Eye Research, attempted to assign the Patents, all reissue patents granted thereof, and all foreign patents containing claims corresponding to the subject matter of the Patents on behalf of Richie Eye Research (under the then name of that corporation, Cain Research Pty Limited) to Daphne Eye Instruments. Exhibit A attached hereto contains a copy of the assignment agreement.
4. In late 1996, Daphne Eye Instruments recorded with the United States Patent and Trade mark Office at reel 8194, frames 0206-0207 the assignment agreement. Attached hereto in Exhibit A.
5. Yancey lacked actual and ostensible authority to assign the Patents or any related reissue and foreign patents, on behalf of Richie Eye Research to Daphne Eye Instruments.
6. The Patents could only be assigned by Richie Eye Research pursuant to a resolution of the board of directors of Richie Eye Research duly passed in accordance with its memorandum and articles of association and no such resolution has ever been passed.

7. Because Yancey lacked actual and apparent authority and because Daphne Eye Instruments at no time had reason to believe Yancey had apparent authority to assign the Patents, the assignment was invalid despite the recordation of the assignment with the United States Patent and Trade mark Office.
8. Subject to the grant of rights described in paragraph 2 above, the parties acknowledge and agree that Richie Eye Research owns and has continuously owned since October 10, 1996 all rights, title and interests in and to: (a) the Patents and all continuations, continuations-in-part, divisionals, reissues and reexaminations thereof; and (b) all foreign patents containing claims corresponding to the subject matter of the Patents.
9. Each covenant in this Deed is also given for the benefit of Thakral and TRD.
10. Each undersigned represents that he or she is a duly authorized representative of the party on whose behalf the undersigned has signed this Agreement, with authority to bind such party.
11. This Deed may be signed in any number of counterparts and all such counterparts taken together shall be deemed to constitute one and the same document.

IN WITNESS WHEREOF, the parties attest to the truthfulness of the above recitals, acknowledgments and representations on this 12th day of August, 1998.

EXECUTED as a deed.

SIGNED SEALED AND DELIVERED)
for and on behalf of RICHIE EYE)
RESEARCH PTY LIMITED, ACN 066)
749 684 by authority of Jan Svenoy its)
Sole Director and Sole Secretary)


.....
(Signature)

THE COMMON SEAL of
ACN 067 589 977 PTY LIMITED, ACN
067 589 977 was affixed by the authority
of the Board of Directors in the presence
of:



W. L. Gill

(Signature of Secretary/Director)

MANJIT SINGH GILL
(Name of Secretary/Director in Full)

(Signature of Director)

MICHAEL FRANCIS WHITE
(Name of Director in Full)

THE COMMON SEAL of
THAKRAL CORPORATION PTY
LIMITED, ACN 056 566 253 was affixed
by the authority of the Board of Directors
in the presence of:



W. L. Gill

(Signature of Secretary/Director)

MANJIT SINGH GILL
(Name of Secretary/Director in Full)

(Signature of Director)

MICHAEL FRANCIS WHITE
(Name of Director in Full)