

02-25-1999



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FORM PTO-1595
(Rev. 6-93)
OMB No. 0651-0011 (exp. 4/94)

U.S. Department of Commerce
Patent and Trademark Office

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original document or copy thereof.

1. Name of conveying party(ies):

DAVIDSON, Mark Date
January 31, 1999

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☐ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☒ Other ☐ License Agreement

Execution Date: January 31, 1999

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

Name: Optonics, Inc.

Internal Address:

Street Address: 2903 Bunker Hill Lane, Suite 105

City: Santa Clara State: CA Zip: 95054

Additional name(s) & address(es) attached? ☐ Yes ☒ No

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

If this document is being filed together with a new application, the execution date of the application is: _____ (Date of Filing)

A. Patent Application No.(s)

B. Patent No.(s) 5,282,088 Aplanatic Microlens and Method for Making Same

Additional numbers attached? ☐ Yes ☒ No

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

Name: Nader Pakdaman

Internal Address: Optonics, Inc.

6. Total number of applications and patents involved: 1

7. Total fee (37 C.F.R. 3.41)----- \$ 40.00

☒ Enclosed

☐ Authorized to be charged to deposit account

8. Deposit account number:

02/24/1999 SBURNS 00000039 5282088

01 FC:581 40.00 DP

Street Address: 2903 Bunker Hill Lane, Suite 105

City: Santa Clara State: CA Zip: 95054

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.

JOSEPH BACH Reg No. 37,771
Name of Person Signing

Signature

Date

FEB-18-99

Total number of pages including cover sheet, attachments and document: 5

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents & Trademarks, Box Assignments
Washington, D.C. 20231

PATENT LICENSE AGREEMENT

AGREEMENT made as of the 31 day of January, 1999, by and between Mark Davidson, an individual, residing at 807 Rorke Way, Palo Alto, California (the "Licensor"), and Optonics, Inc., a corporation organized under the laws of the State of California with its principal place of business located at 2903 Bunker Hill Lane, Suite 105, Santa Clara, California 95054 (the "Licensee").

WHEREAS, the Licensor is the owner all rights in United States Patent No. 5,282,088, relating to Aplanatic Microlens and Method for Making Same, issued on January 25, 1994 (the "'088 Patent"); and

WHEREAS, the Licensee wishes to obtain, and the Licensor is willing to grant to the Licensee, an exclusive license under the Patent on the terms and conditions set forth in this Agreement.

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, it is hereby agreed as follows:

1. License.

(a) License Grant. The Licensor grants to the Licensee and the Licensee accepts from the Licensor, an exclusive, paid-up, royalty-free, perpetual and irrevocable limited license under the '088 Patent and any foreign patents issuing on corresponding existing or future patent applications and any divisions, continuations, continuations-in-part, reissues or reexaminations of any such applications or patents (collectively, the "Patents") (i) to practice the inventions covered by the claims of the Patents in the fields of testing and inspection of fully-fabricated semiconductor devices in the electrically activated state (the "Field of Use"), throughout the world, to the full end of the term for which the Patents are issued, unless sooner terminated as provided in this Agreement (the "License") and (ii) to sublicense such rights without restriction. The License includes, without limitation, the right to make, have made, sell, rent, and/or lease apparatus or systems within the Field of Use which practice or embody, or are configured for use in practicing, the inventions covered by the claims of the Patents ("Licensed Products"), and the right to practice, and to authorize any other person to practice, any method covered by the claims of the Patents within the Field of Use. The rights conferred by the License shall extend to the Licensee's suppliers, fabricators or other contract partners with respect to their manufacture on behalf of the Licensee and sale to the Licensee of Licensed Products or of parts, components or accessories which are incorporated into or used as integral components of Licensed Products, and to the Licensee's customers, vendees, lessees or transferees with respect to their use or resale of Licensed Products.

(b) Limitation. The License does not confer any right to practice the inventions covered by the claims of the Patents outside of the Field of Use.

(c) Exclusivity. The Licensor shall not at any time during the term of this Agreement make, have made, sell, rent, and/or lease any apparatus or systems within the Field of Use which practice or embody, or are configured for use in practicing, the inventions covered by the claims of the Patents, or practice any method covered by the claims of the Patents within the Field of Use, or otherwise practice the inventions covered by the claims of the Patents within the Field of Use, or grant to any person any right, license or other authority to do any of the foregoing.

2. Patent Marking. The Licensee agrees to mark all products manufactured under the License with the statement "Licensed under United States Patent No.5,282,088," to the extent required by applicable law.

3. Infringement by Third Parties; Defense of Patent.

(a) The Licensee shall have the sole right to enforce the Patents within the Field of Use, and the Licensor shall have the sole right to enforce the Patents outside of the Field of Use. Each party shall use its reasonable efforts to notify the other of any infringement taking place within the field of enforcement of the other party. The right to enforce the Patents as provided herein shall include the right to bring legal action for infringement and to seek and receive any available remedies on account of such infringement, and to negotiate any settlement of such claims and to receive any amounts paid in settlement thereof, provided that no such settlement shall affect the rights of the other party within its field of enforcement or otherwise under this Agreement. In the case of any legal claim brought or proposed by the Licensee to enforce the Patents within the Field of Use, the Licensor shall, to the extent requested by the Licensee, commence or join in such action as a party plaintiff.

(b) In the event that any person shall assert against either party any claim that any of the Patents are invalid or enforceable, or seeking to limit the scope of enforcement thereof, whether in defense against an enforcement action brought by a party, by a separate action for declaratory judgment, or otherwise, the party receiving notice of such claim shall promptly notify the other party. The parties agree to cooperate fully with each other to protect and defend the Patents against any such assertions, and each party, to the extent not already party to any legal or other proceedings or negotiations related to any such assertion, shall be entitled to participate and intervene therein, either directly or through counsel of such party's choosing.

4. Abandonment of Patents. If the Licensor intends to abandon any of the Patents, the Licensor shall notify the Licensee in writing of such intention. If the Licensee elects to take over maintenance of such Patents in writing within sixty (60) days after such notification, the Licensor shall assign to the Licensee all rights in such Patents.

5. Relationship of Parties. The relationship of the parties hereto shall be that of buyer and seller. Nothing herein shall be construed to create any partnership,

joint venture, agency or similar relationship, or to subject the parties to any implied duties or obligations respecting the conduct of their affairs which are not expressly stated herein. Neither party shall have any right or authority to assume or create any obligation or responsibility, either express or implied, on behalf of or in the name of the other party, or to bind the other party in any matter or thing whatsoever.

6. Entire Agreement. Each party acknowledges that it has read this Agreement, fully understands it, and agrees to be bound by its terms and further agrees that it is the complete and exclusive statement of the agreement between the parties, which supersedes and merges all prior proposals, understandings and all other agreements, oral and written between the parties relating to the subject matter of this Agreement. This Agreement cannot be modified or altered except by a written instrument duly executed by both parties. The failure of either party to exercise in any respect any right provided for herein shall not be deemed a waiver of any right hereunder.

7. Severability. If any provision of this Agreement shall be held to be invalid, illegal or unenforceable, the validity, legality and enforceability of the remaining provisions shall in no way be affected or impaired thereby. Further, the provision that is held to be invalid, illegal or unenforceable shall remain in effect as far as possible in accordance with the intention of the parties.

8. Construction. This Agreement is to be construed in accordance with the laws of the State of California.

9. Binding Effect and Assignment. This Agreement shall be binding upon and inure to the benefit of the parties hereto and their respective heirs, executors, administrators, legal representatives, successors and permitted assigns. The Licensee may assign this Agreement and the License without restriction. The Licensor may assign this Agreement only in connection with a transfer of all his rights in the Patents, free and clear of any liens, pledges and encumbrances.

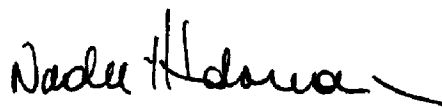
10. Notices. Notices to either party under or relating to this Agreement shall be in writing to the address indicated on the first page of this Agreement, or to such subsequent address as either party may specify by notice to the other, and shall be deemed effective when received, or on the second day following the date of postmark if sent by prepaid certified mail, return receipt requested.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed in duplicate by their duly authorized representatives as an instrument under seal as of the date first above written.

MARK DAVIDSON

Signature: 

OPTONICS, INC.

By: 
President

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