

08-31-1999

U.S. Department of Commerce  
Patent and Trademark Office

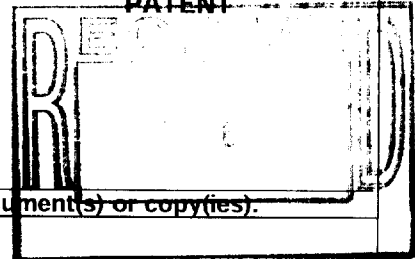
PATENT



101131144

RECORDATION FORM COVER SHEET  
PATENTS ONLY

8/26/99



TO: The Commissioner of Patents and Trademarks: Please record the attached original document(s) or copy(ies).

Submission Type

- ☒ New
- ☐ Resubmission (Non-Recordation)  
Document ID#
- ☐ Correction of PTO Error  
Reel #  Frame #
- ☐ Corrective Document  
Reel #  Frame #

Conveyance Type

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

U.S. Government

(For Use ONLY by U.S. Government Agencies)

- ☐ Departmental File ☐ Secret File

Conveying Party(ies)

- ☐ Mark if additional names of conveying parties attached
- Execution Date  
Month Day Year

Name (line 1) Union Special GmbH

08231999

Name (line 2)

Second Party

Name (line 1)

Execution Date  
Month Day Year

Name (line 2)

Receiving Party

- ☐ Mark if additional names of receiving parties attached

Name (line 1) Union Special Corporation

☐ If document to be recorded is an assignment and the receiving party is not domiciled in the United States, an appointment of a domestic representative is attached. (Designation must be a separate document from Assignment.)

Name (line 2)

Address (line 1) One Union Special Plaza

Address (line 2)

Address (line 3) Huntley

IL

60142

City

State/Country

Zip Code

Domestic Representative Name and Address

Enter for the first Receiving Party only.

Name M Travis

Address (line 1) Union Special Corporation

Address (line 2) One Union Special Plaza

Address (line 3) Huntley, IL 60142

Address (line 4)

08/31/1999 DMGUYEN 00000021 210185 5553563

01 FC:581 800.00 CH

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

REEL: 010188 FRAME: 0851

**Correspondent Name and Address**

Area Code and Telephone Number

847-668-4512

Name M Travis

Address (line 1) Union Special Corporation

Address (line 2) One Union Special Plaza

Address (line 3) Huntley, IL 60142

Address (line 4)

**Pages**

Enter the total number of pages of the attached conveyance document including any attachments.

# 6

**Application Number(s) or Patent Number(s)**

☒ Mark if additional numbers attached

Enter either the Patent Application Number or the Patent Number (DO NOT ENTER BOTH numbers for the same property).

Patent Application Number(s)

Patent Number(s)


5553563	5540162	5537943
5531174	5483908	5477796
5469798	5445091	5381745

If this document is being filed together with a new Patent Application, enter the date the patent application was signed by the first named executing inventor.

Month Day Year

**Patent Cooperation Treaty (PCT)**

Enter PCT application number

only if a U.S. Application Number has not been assigned.

PCT		PCT		PCT	
PCT		PCT		PCT	

**Number of Properties**

Enter the total number of properties involved.

# 20

**Fee Amount**

Fee Amount for Properties Listed (37 CFR 3.41): \$ \$800.00

Method of Payment:  
Deposit Account

Enclosed ☐ Deposit Account ☒

(Enter for payment by deposit account or if additional fees can be charged to the account.)

Deposit Account Number:

# 21-0185

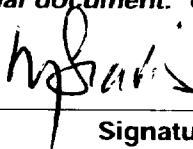
Authorization to charge additional fees:

Yes ☒ No ☐

**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. Charges to deposit account are authorized, as indicated herein.*

M Travis



August 23, 1999

Name of Person Signing

Signature

Date

RECORDATION FORM COVER SHEET  
CONTINUATION  
PATENTS ONLY

U.S. Department of Commerce  
Patent and Trademark Office  
PATENT

Conveying Party(ies)

☐ Mark if additional names of conveying parties attached

Enter additional Conveying Parties

Name (line 1)

Execution Date  
Month Day Year

Name (line 2)

Execution Date  
Month Day Year

Name (line 1)

Execution Date  
Month Day Year

Name (line 2)

Execution Date  
Month Day Year

Name (line 1)

Execution Date  
Month Day Year

Name (line 2)

Receiving Party(ies)

☐ Mark if additional names of receiving parties attached

Enter additional Receiving Party(ies)

Name (line 1)

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Name (line 2)

Address (line 1)

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Address (line 3)

City

State/Country

Zip Code

Name (line 1)

☐ If document to be recorded is an assignment and the receiving party is not domiciled in the United States, an appointment of a domestic representative is attached. (Designation must be a separate document from Assignment.)

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Address (line 1)

Address (line 2)

Address (line 3)

City

State/Country

Zip Code

Application Number(s) or Patent Number(s)

☐ Mark if additional numbers attached

Enter either the Patent Application Number or the Patent Number (DO NOT ENTER BOTH numbers for the same property).

Patent Application Number(s)

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Patent Number(s)

5251557	5222989	5188047
5027728	4970977	4922843
4777891	4754722	4512268
4479447	4467734	

# **TRANSFER AGREEMENT**

This Agreement, made and entered into on this 30<sup>th</sup> day of June, by and between Union Special Corporation, a corporation organized and existing under the laws of the State of Delaware, and having a place of business at One Union Special Plaza, Huntley, IL 60142, U.S.A. (herein after referred to "USC") and Union Special GmbH, a corporation organized and existing under the laws of the Federal Republic of Germany, and having a place of business at Raiffeisenstrasse 3, Möglingen, Germany (herein after referred to "USG"):

## **WITNESSETH:**

WHEREAS, USG has or controls certain Intellectual Property Right as defined in Article 1 hereof relating to the Products as defined in Article 1 hereof: and

WHEREAS, USC desires to acquire and to continue to acquire said Intellectual Property Right and USG is willing to disclose, impart and transfer to USC such Intellectual Property right, all upon and subject to the terms and conditions herein set forth:

NOW, THEREFORE, the parties hereto agree as follows:

## **Article 1. Definitions**

1. "Products" mean the industrial-use sewing machines developed, manufactured or sold by USG prior to the Effective Date of this Agreement, which are the product style numbers specified in the Exhibit A hereto.
2. "Intellectual Property Right" means any and all intellectual property right including designs, copyrights, inventions, and know-how (processes, engineering and manufacturing skills and other technical information) relating to the Products, and trade secrets used in the manufacture, sale, distribution and use of the Products which are presently owned by USG including:

Engineering and technical data, calculations and information,

Design data, calculations and information,

Specifications, drawings, sketches, photographs,

Details of layout of the works, including details and specification of machinery,

All other forms of recorded information, technique and design with respect to jigs, tools, molds and dies.

Intellectual Property Right also means those specific United States patents as listed on Exhibit B hereto and all corresponding foreign patents.

3. "Effective Date" means the day on which any and all transfer documents, approvals and licenses will have been obtained from the competent government authorities (Agencies, Departments, etc).

## **Article 2. Transfer**

1. Transfer of Intellectual Property Right:

USG agrees to disclose and impart any and all Intellectual Property Right immediately after the Effective Date, and transfer any and all rights in the Intellectual Property Right to USC and USC shall have the exclusive ownership of such rights. It is expressly agreed by both

parties that USG may not use any and all Intellectual Property Right on and after the Effective Date, and that USC may use, improve, modify and otherwise dispose of such Intellectual Property Right for any purpose, and USG may manufacture, sell and otherwise dispose of the Products and those modified/improved by USC throughout the world.

2. Change of registration:

Upon the conclusion of this Agreement, USG shall file the application for the change of the registration (transfer of the ownership) with regard to the Intellectual Property Right to the competent government authorities (Agencies, Departments, etc) at its own expense. USG shall immediately notify USC if the registration of the change in the ownership is completed and shall give USC the documents issued by such competent authorities with respect to the change in the ownership (including but not limited to patent certificates).

### **Article 3. Engineering Assistance, etc.**

1. Upon the requests of USC, USG shall render engineering assistance to USC at USC's place of business in connection with the actual use of Intellectual Property Right furnished to USC.
2. Upon the request of USC, USG shall dispatch its technically qualified specialists to supply USC with technical services relating to the manufacture of the Products and such Products as modified/improved by USC.

### **Article 4. Consideration**

1. USC shall pay the amount of \$1,105,294 to USG in consideration of USG's transfer of Intellectual Property Right to USC and USG's performance of such obligations as provided for hereunder. USC shall not be obligated to give USG any other consideration than provided for in the preceding sentence.
2. The payment of the amount of \$1,105,294 to be made by USC to USG shall be due and payable in four equal installments of \$276,323.50. The first installment will be due within two weeks following the date of the registration of change in the ownership of Intellectual Property Rights. The final three installments will be paid on the three subsequent six-month anniversary dates of the effective date. USC will remit such amount to USG's designated bank account as specified in the Exhibit C hereto.
3. USC shall be entitled to set off any counter-claims (including but not limited to its account receivables) against its obligations to pay the amount pursuant to the Paragraph 2 of this Article regardless of whether USG's debt becomes due.

### **Article 5. Termination of prior agreements**

This Agreement supercedes all prior agreements with regard to the payment of license fees for the use of manufacturing rights for the product groups listed in Exhibit A. Effective with this Agreement, the previous license agreement is hereby terminated.

### **Article 6. Taxes, Duties, etc.**

Any taxes, duties, etc. of whatsoever nature that may be levied or imposed by any government on such payment made according to the Article 4 hereof are included in all the amount as provided for in the Article 4 hereof, and shall be borne by USG.

## Article 7. Warranty

1. USG warrants that any and all Intellectual Property Right to be transferred or furnished by USG to USC are owned by USG.
2. USG warrants that USC's use and any disposition of Intellectual Property Right for any purpose shall not infringe any rights of third parties (including but not limited to patent, design, copyright).

## Article 8. Arbitration

In the event of any disagreement or dispute arising in the interpretation or conclusion of this Agreement or any of its provisions or otherwise in connection with this Agreement, including any dispute over the validity or invalidity of this Agreement or any of its provisions, the parties hereto shall use their best efforts to settle the same amicably. Any failure to agree on a matter where the agreement of the parties is called for under this Agreement, shall be treated as a dispute under this Article. Failing an amicable settlement, the matter shall be submitted to arbitration to be conducted by American Arbitration Association in accordance with the rules of such Association. Award given under the arbitration shall be final and binding upon the parties hereto.

## Article 9. Governing Law

This agreement shall be governed by the laws of the United States of America as to all matters including but not limited to its effectiveness, interpretation and performance.

## Article 10. Termination for Non Performance

In the event that such transfer documents, approvals or licenses that are required to be obtained by USG to fulfill this Agreement, if any, have not been obtained within two (2) months of June 30, 1999, this Agreement may be terminated at any time by USC by mailing written notice of termination to USG. If such termination occurs, USG is required to return to USC all consideration paid by USC up to the date of termination plus a penalty of 10%.

In the event that USC fails to make scheduled payments to USG, this Agreement may be terminated by USG by written notification to USC. In this event, any previous payments made by USC with respect to this Agreement will be forfeited by USC to USG.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be concluded by their proper officers duly authorized the day and year first written above.

Union Special Corporation

By Terence A. Hitpas  
Terence A. Hitpas, President

Union Special GmbH

By Arno Briegel  
Arno Briegel, Managing Director

## **EXHIBIT A**

### **PRODUCT STYLE NUMBERS**

31100, 31200

53100, 53400

80200, 80700, 80800

81200, 81300, 81500

BC100

92800, 93800, 94800

## **EXHIBIT B**

### **US PATENT NUMBERS:**

4,467,734  
4,479,447  
4,512,268  
4,754,722  
4,777,891  
4,922,843  
4,970,977  
5,027,728  
5,188,047  
5,222,989  
5,251,557  
5,381,745  
5,445,091  
5,469,798  
5,477,796  
5,483,908  
5,531,174  
5,537,943  
5,540,162  
5,553,563



## **EXHIBIT C**

**UNION SPECIAL GERMANY DESIGNATED BANK AND  
ACCOUNT NUMBER:**

**Baden Württembergische Bank  
Stuttgart, Germany**

**Account number: 100 1700 200**