

02-26-2001

Substitute Form PTO-1595
Attorney Docket No.: 10964-003001
Client's Ref. No.: Case 471

RECORDED



101620915

Commissioner for Patents: Please record the attached original document(s) or copy(ies).	
1. Name of conveying party(ies): Advanced Energy Systems, Inc. 2-16-01 Additional name(s) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	2. Name and address of receiving party(ies): PLUG POWER INC. 968 Albany-Shaker Road Latham, NY 12110 Additional names/addresses attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No
3. Nature of conveyance: <input type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name <input checked="" type="checkbox"/> Other: Patent Assignment and License-Back Agreement Execution Date: September 29, 2000	
4. Application number(s) or patent number(s): If this document is being filed with a new application, the execution date of the application is: A. Patent Application No(s): 09/198,919 B. Patent No(s): Additional numbers attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	
5. Name/address of party to whom correspondence concerning document should be mailed: ERIC L. PRAHL Fish & Richardson P.C. 225 Franklin Street Boston, MA 02110-2804	6. Total number of applications/patents involved: 1 7. Total fee (37 CFR §3.41): \$40 <input checked="" type="checkbox"/> Enclosed <input type="checkbox"/> Authorized to charge Deposit Account. 8. Deposit Account No.: 06-1050 Please apply any additional charges, or any credits, to our Deposit Account No. 06-1050.
DO NOT USE THIS SPACE	
9. Statement and Signature: <i>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.</i> Eric L. Prahl Reg. No. 32,590 Name of Person Signing Signature Date February 14, 2001	
Total number of pages including coversheet, attachments and document: 7	

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CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner of Patents, Washington, D.C. 20231.

2/14/01
Date of DepositLinda Vega
SignatureLinda Vega
Typed Name of Person Signing CertificatePATENT
REEL: 011527 FRAME: 0456

PATENT ASSIGNMENT AND LICENSE-BACK AGREEMENT

This Agreement is by and between Advanced Energy Systems, Inc. ("AES"), a New Hampshire corporation having its principal offices at 28 Riverview Mill, Wilton, New Hampshire 03086, and Plug Power Inc. ("PPI"), a Delaware corporation having its principal offices at 968 Albany-Shaker Road, Latham, New York 12110.

WITNESSETH:

WHEREAS AES has developed certain anti-islanding technology for which AES has filed a provisional and a utility patent application in the United States, and has also filed a corresponding international patent application under the Patent Cooperation Treaty (listed in the Annex attached hereto, and collectively referred to as "the Patent Family");

WHEREAS AES desires to assign all right, title and interest in and to the Patent Family to PPI in return for an exclusive license to the Patent Family as specified herein for fields of use not associated with fuel cell systems; and

WHEREAS PPI desires to acquire the entire right, title and interest in and to the Patent Family;

NOW THEREFORE, for and in consideration of good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:

ARTICLE 1

ASSIGNMENT

1.1 Assignment Grant. AES does hereby acknowledge the sale, assignment, and transfer to PPI, its lawful successors and assigns of the entire right, title and interest in and to the Patent Family described in the attached Annex (hereby incorporated by reference as if fully set forth herein), together with the inventions described therein, and any extensions, reissues, substitutes, divisions, renewals, continuations, and continuations-in-part thereof, the same to be held and enjoyed by PPI for its own use and enjoyment, and for the use and enjoyment of its successors, assigns or other legal representatives, to the end of the term or terms for which said patents are granted or reissued, as fully and entirely as the same would have been held and enjoyed by AES, if this Assignment had not been made; together with the right to apply for foreign patents or other forms of protection, and all claims for damages by reason of past infringement of any said patent, with the right to sue for, and collect the same for, its own use and benefit and for the use and benefit of its successors, assigns or other legal representatives.

1.2 PTO Authorization. AES hereby authorizes the Commissioner of Patents and Trademarks of the United States of America and the empowered officials of all other governments to issue any and all patents on said inventions or resulting from said applications, or any divisions thereof, to PPI as assignee thereof.

1.3 Authority. AES hereby covenants that it had full right to convey the entire interest herein assigned, and that it has not executed any agreements in contravention of this Assignment.

1.4 Assistance with Prosecution. AES hereby binds itself, its legal representatives, and assigns, to do, upon PPI's request and at PPI's expense, but without additional consideration to AES, all acts reasonably serving to assure that the said inventions and discoveries, the said patent applications and the said patents listed in the annex attached hereto, shall be held and enjoyed by PPI as fully and entirely as the same could have been held and enjoyed by AES, its legal representatives, and assigns if this Assignment had not been made; and particularly to execute and deliver to PPI all lawful application documents including petitions, specifications, and oaths, and all Assignments, disclaimers, and lawful affidavits in form and substance as may be requested by PPI; to communicate to PPI all facts known to AES relating to said inventions and discoveries or the history thereof; to furnish PPI with any and all documents, photographs, models, samples, and other physical exhibits in the control of AES, its legal representatives, or assigns which may be useful for establishing the facts of AES's conception, disclosures, and reduction to practice of said inventions and discoveries; and to testify as to the same in any interference or other litigation.

1.5 Abandonment. PPI agrees to pursue the issuance of patents at PPI's sole expense for the Patent Family in the United States, Japan, Australia, Germany and Great Britain. Should PPI decide to abandon patent registration for a patent in the Patent Family by failing to pay any required fees, at least 60 days before any effective abandonment PPI shall notify AES of such intention, and AES shall be given the option to receive an assignment from PPI of such patent in return for reimbursing PPI for all fees ever incurred in pursuing such patent. Such assignment shall be limited to the abandoned patent within the Patent Family.

ARTICLE 2

LICENSE

2.1 License Grant. PPI hereby grants and agrees to grant to AES an exclusive, perpetual, irrevocable, transferable, royalty free license under the Patent Family to manufacture, have manufactured, use, offer for sale, sell, lease, sublicense and otherwise dispose of products covered by the Patent Family anywhere in the world in the field limited to non-fuel cell applications. AES shall have no rights under the Patent Family to produce products or designs intended for use with fuel cell systems. The License granted to AES hereby is exclusive and prohibits PPI and any third party from manufacturing, using, offering for sale, selling, leasing, sublicensing and otherwise disposing of products covered by the Patent Family anywhere in the world in the field limited to non-fuel cell applications.

2.2 Patent Infringement.

2.2.1 Except as otherwise provided in Section 2.2.2, PPI shall retain the sole right and standing to sue against patent infringements in all applications of the Patent Family. Nothing in this License shall be construed as an obligation of PPI to bring or prosecute actions or suits against third parties for patent infringement. PPI shall be solely

entitled to any proceeds resulting from legal actions initiated by PPI, *provided*, however, PPI shall only be entitled to the proceeds related to fuel cell applications, as well as recovery of all litigation costs, and AES shall be entitled to any proceeds, net of litigation costs and attorneys' fees to which PPI may be entitled, related to non-fuel cell applications.

2.2.2 In cases where there is reasonable evidence of an infringement of the Patent Family by a third party using a non-fuel cell application of the Patent Family, and PPI declines upon a request in writing from AES to initiate a patent infringement suit against the third party, AES, in its sole discretion, shall have the right but not the obligation, at its own expense and without expense to PPI, to prosecute claims for any such infringement of the Patent Family in its own name or in the name of PPI, as may be legally necessary or desirable under the circumstances. AES shall control the conduct of such litigation. AES shall bear the full cost of any such legal action, and shall be solely entitled to any proceeds resulting from such legal action.

2.3 Right to File Derivative Patents. Subject to the Stock Purchase Agreement between AES and PPI dated March 13, 2000, AES and PPI shall each have the right to file patents on future inventions relating to the subject matter of the Patent Family.

2.4 Termination.

2.4.1 Should AES transfer or sublicense any rights granted under this Agreement, AES will condition such transfer or sublicense on the transferee's or sublicensee's use of the Patent Family remaining within the field limited to non-fuel cell applications. Should AES fail to enforce this field of use condition on any transferee or sublicensee, or should AES itself violate this field of use restriction, then PPI shall notify AES of AES's failure to comply with this Section 2.4. Within thirty (30) days of AES's receipt of notice from PPI, AES shall be given the opportunity to cure such breach of this Section 2.4. In the event that AES fails to cure such breach within thirty (30) days, PPI shall have the immediate right to terminate all rights to the Patent Family granted to AES under this Article 2.

2.4.2 Upon the occurrence of a Triggering Event, as defined below, AES shall be given the option, upon written notice to PPI, to receive an assignment from PPI of the applicable patent, in return for reimbursing PPI for all fees incurred from prosecuting such patent. A Triggering Event, for purposes of this Section 2.4.2 shall include (a) failure to properly prosecute or notify AES of its refusal to a patent in the Patent Family; or (b) if PPI grants any third party a license to use a patent within the Patent Family in contravention of the license granted AES in Article 2. Within thirty (30) days of PPI's receipt of notice from AES, PPI shall be given the opportunity to cure such Triggering Event. In the event that PPI fails to cure such Triggering Event within thirty (30) days, AES shall have the immediate right to exercise its rights under this Section 2.4.2. Such assignment shall be limited to the applicable patent within the Patent Family. Neither the option granted herein nor its exercise, is in lieu of any damages or other remedies to which AES may be entitled. All rights granted in this Section 2.4.2 are in addition to those granted in Section 1.5 in case of abandonment.

ARTICLE 3
MISCELLANEOUS

3.1 Governing Law. This Agreement shall be governed by and construed in accordance with the laws of the State of New Hampshire and the United States of America without giving effect to principles of conflicts of laws that would cause the application of the laws of any jurisdiction other than the State of New Hampshire and the United States of America.

3.2 Entire Agreement; Amendment. This Agreement supersedes all previous and contemporaneous communications, transactions and understandings, whether oral or written, and constitutes the sole and entire agreement between the parties pertaining to the subject matter hereof. No modification, deletion of, or addition to the terms of this Agreement shall be binding on any party hereto unless made in writing and signed by a duly authorized representative of each party hereto.

3.3 Counterparts. This Agreement may be executed in one or more counterparts, all of which shall be considered one and the same agreement, and shall become a binding agreement when one or more counterparts have been signed by each party and delivered to the other party.

3.4 Severability. If any provision of this Agreement is held invalid by a court of competent jurisdiction, the remaining provisions shall nonetheless be enforceable according to their terms. Further, if any provision is held to be overbroad as written, such provision shall be deemed amended to narrow its application to the extent necessary to make the provision enforceable according to applicable law and shall be enforced as amended.

3.5 Confidentiality. The confidentiality provisions of Section 6.12 of the Stock Purchase Agreement between AES and PPI, dated March 13, 2000, are hereby incorporated by reference.

[Remainder of page intentionally left blank]

IN WITNESS WHEREOF, AES and PPI have caused this instrument to be executed on the date hereafter indicated.

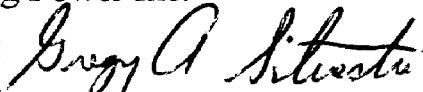
Advanced Energy Systems, Inc.

By: 

Title: *President*

Date: *9-29-00*

Plug Power Inc.

By: 

Title: *C.O.O.*

Date: *9-29-00*

ANNEX

- (1) United States Provisional Patent Application 60/066,460, filed on November 24, 1997;
- (2) United States Utility Patent Application 09/198,919, filed on November 24, 1998;
- (3) International Patent Application PCT/US98/25094, filed on November 24, 1998;
- (4) The national phase application for the EPO for PCT/US98/25094, filed on May 19, 2000;
- (5) The national phase application for Japan for PCT/US98/25094, filed on May 19, 2000; and
- (6) The national phase application for Australia for PCT/US98/25094, filed on May 19, 2000.