

8-3-01

08-03-2001

FORM PTO-1595

(Rev. 3/01)

OMD NO. 0651-0011 exp. 5/31/2002)

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

101797737

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

1. Name of conveying party(ies):

MEMSolutions, Inc.

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

☒ No ☐ Yes

3. Nature of Conveyance

☒ Assignment (Exhibit B) ☐ Merger☐ Security Agreement☐ Change of Name☒ Other: Patent Purchase Agreement

Execution Date(s): 04-10-01

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

Name: Intel Corporation

Internal Address:

Street Address: 2200 Mission College Blvd.

City: Santa Clara State/Province: CA Zip: 95052

Country:

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

4. Application Number(s) or patent number(s): 5,991,066

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)

Additional numbers attached? ☐ Yes ☒ No

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

Name: Blakely, Sokoloff, Taylor & Zafman LLP

Internal Address:

Street Address: 12400 Wilshire Boulevard, 7th Floor

City: Los Angeles State: California Zip: 90025

6. Total number of applications and patents involved: 1

6. Total Fee (37 CFR 3.41).....\$160.00

7. ☒ Enclosed☐ Authorized to be charged to deposit account

8. Deposit Account Number:

02-2666

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

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

James Y. Go

Name of Person Signing

Signature

8/1/01
Date

Total number of pages including cover sheet, attachments, and document: 13

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

Atty Docket No. 042390P11825

08/03/2001 DBYRNE 00000201 5991066

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PATENT PURCHASE AGREEMENT

This PATENT PURCHASE AGREEMENT ("Agreement") is entered into by and between Intel Corporation, a Delaware corporation, with an office at 2200 Mission College Blvd., Santa Clara, California 95052 ("Purchaser"), and MEMSolutions, Inc., a Delaware corporation, with an office at 5706 Corsa Avenue, Westlake Village, California 91362 ("Seller"). The parties hereby agree as follows.

1. BACKGROUND

- 1.1 Seller owns all right, title, and interest in and to the Patents (as defined below).
- 1.2 Seller wishes to sell the Patents to Purchaser.
- 1.3 Purchaser wishes to purchase the Patents.

2. DEFINITIONS

- 2.1 "Assignment Agreements" means any agreements assigning ownership of any part, portion, or all of the Patents from the inventors and/or prior owners to Seller, which agreements are listed on Schedule 2.1 hereto.
- 2.2 "Confidential Information" means the contents, nature, terms, conditions, results, form, existence, and parties to (a) this Agreement (including without limitation, the price(s) offered or paid for any Patents); (b) any licenses, agreements, discussions, or negotiations relating to the Patents (including without limitation, any licenses granted to the Patents prior to the Effective Date); (c) any disagreement, dispute, or litigation relating to the Patents or relating to any licenses, contracts, or agreements concerning the Patents; or (d) information regarding the inventor's invention, conception, or reduction to practice, in the case of clauses (c) and (d), excluding any information that is in the public domain.
- 2.3 "Effective Date" means the date on which all parties execute this Agreement.
- 2.4 "List of Prosecution Counsel" means the list to be supplied by Seller pursuant to Section 5.1 of the names and addresses of each counsel who prosecuted any patent application included in, or relating to any of, the Patents or who is handling any of the Patents.
- 2.5 "Patents" means the United States and/or foreign patents and/or patent applications listed in Exhibit A, and, whether or not specifically identified in Exhibit A, all reissues, reexaminations, extensions, continuations, continuations in part, continuing prosecution applications, and divisions of such patents and applications; provisional patent applications that are or will be continuations or continuations in part of such patents and applications; and foreign counterparts to any of the foregoing including, without limitation, utility models.

3. PAYMENT

Within thirty (30) days following the Effective Date, Purchaser shall pay to Seller the amount of two million U.S. dollars (\$2,000,000 USD).

4. TRANSFER OF PATENTS

4.1 Patent Assignment. Seller hereby sells, assigns, transfers, and conveys to Purchaser all of Seller's right, title, and interest in and to the Patents, including without limitation, all rights of Seller under the Assignment Agreements, and all rights of Seller to license and to collect royalties under such Patents.

4.2 Assignment of Causes of Action. Seller hereby sells, assigns, transfers, and conveys to Purchaser all of Seller's right, title, and interest in and to all causes of action and enforcement rights, whether currently pending, filed, or otherwise, for the Patents, including without limitation, all rights to pursue damages, injunctive relief, and other remedies for past, current and future infringement of the Patents.

5. ADDITIONAL OBLIGATIONS

5.1 Delivery. Within thirty (30) days following the Effective Date, Seller shall deliver to Purchaser (a) an executed copy of the Assignment of Patent Rights, a copy of which is attached as Exhibit B (the "Patent Assignment"); (b) originals of the Assignment Agreements; (c) the List of Prosecution Counsel; and (d) all files and original documents, including all copies thereof, owned or controlled by Seller (including without limitation Letters Patent) relating to the Patents including, without limitation, all invention disclosures, laboratory notebooks, and prosecution files for pending patent applications included in the Patents, and Seller's own files relating to the issued Patents.

5.2 Prosecution of Applications. Seller agrees that, by virtue of the sale and assignment by Seller to Purchaser of the Patents and the other rights described in Sections 4.1 and 4.2, Purchaser has and at all times hereafter will have all rights to control the prosecution of all patent applications included in the Patents, including those listed in Exhibit A hereto or in the Patent Assignment. Seller shall cooperate in the prosecution of such patent applications by providing any technical consultations that may reasonably be requested by Purchaser in writing, and by making reasonable efforts to make the inventor(s) and any counsel listed on the List of Prosecution Counsel available and accessible to Purchaser for such consultation to the extent that Seller is able to do so without unreasonably interfering with Seller's business operations, and shall comply with all other obligations set forth in the Patent Assignment, without receiving additional compensation, except that the inventor(s) shall be paid a reasonable amount for time so expended in excess of ten hours in the aggregate and shall be reimbursed for all reasonable traveling and subsistence expenses incurred in performing such technical consultations so requested. Purchaser shall pay any fees or expenses arising out of such consultations with any counsel listed on the List of Prosecution Counsel in excess of five hours in the aggregate.

- 5.3. Further Cooperation. At the reasonable request of Purchaser, Seller shall execute and deliver any instruments, and do and perform any 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 any papers, and Seller shall use best efforts to obtain the same from the respective inventors, as necessary or desirable for fully perfecting and conveying unto Purchaser the benefit of the transactions contemplated hereby. In the event a foreign counterpart, continuation, or divisional is omitted from the definition of Patents, Seller shall take prompt steps to include the omitted foreign counterpart, continuation, or divisional within the scope and coverage of this Agreement with no additional payment by Purchaser. Seller shall, at Purchaser's reasonable expense, fully cooperate in any litigation or proceeding (including but not limited to interference proceedings) relating to the Patents (such cooperation including, but not limited to, making witnesses available and providing evidence of invention dates) to the extent that Seller is able to do so without unreasonably interfering with Seller's business operations.
- 5.4. Technical Assistance. Seller will, promptly following the date hereof, transfer to Purchaser copies of all of the then existing technical documentation and other tangible materials (the "Technical Materials") relating to or embodying, and provide to Purchaser technical assistance, training and consultation services reasonably requested by Purchaser for any purpose whatsoever (collectively, "Technology Implementation Services") related to or embodying, the inventions that are covered by any of the claims of the Patents, including the implementation of such inventions. The Technical Materials and the Technology Implementation Services shall be provided by the Seller to the Purchaser at no charge; provided the number of man-hours does not exceed ten (10) man-hours. In the event Purchaser requests Technology Implementation Services in excess of ten man hours, Seller shall be paid a reasonable amount for time so expended not to exceed an additional twenty (20) man hours and shall be reimbursed for any reasonable traveling and subsistence expenses incurred in providing such services. Notwithstanding anything contained in this Agreement, Purchaser may use any Technical Materials or other information that is disclosed by Seller to Purchaser in the course of Seller providing Technology Implementation Services to Purchaser hereunder for any purpose whatsoever, including without limitation use in development, manufacture, promotion, sale and maintenance of Purchaser's products and services; provided that the right to use such technical documentation or other information does not confer upon Purchaser a license under any Patents of Seller.
- 5.5. Payment of Fees. Seller shall (i) pay any maintenance fees, annuities, and the like that become due on the Patents prior to the end of the thirty (30) day period following the Effective Date; (ii) provide within thirty (30) days after the Effective Date a list (the "Maintenance Fees List") to Purchaser of the dates on which any such fees, annuities and the like will become due during the six (6) month period following the Effective Date; and (iii) shall otherwise use its best efforts to assist Purchaser in preventing abandonment of the Patents.

6. **REPRESENTATIONS AND WARRANTIES**

- 6.1 Authority. Seller represents and warrants to Purchaser that Seller has the right and authority to enter into this Agreement and to carry out its obligations hereunder, and covenants that Seller will not enter into any agreements that would interfere with these obligations. Seller further represents and warrants that no assignments or agreements exist that could prevent, delay, or interfere with the sale of Patents to Purchaser.
- 6.2 Title and Contest. Seller represents and warrants to Purchaser that (a) Seller is the sole and exclusive legal and beneficial owner of all rights, title, and interest in and to the Patents, and Seller has received no notice or claim challenging Seller's complete and exclusive ownership of any of the Patents or suggesting that any person has any claim of legal or beneficial ownership with respect thereto; (b) Seller has the exclusive, unrestricted right to sue for past, present, and future infringement of the Patents; (c) the Patents are free and clear of any and all liens, mortgages, security interests, or other encumbrances or imperfections of title, and restrictions on transfer; and (d) there are no actions, suits, investigations, claims, or proceedings threatened, pending, or in progress relating in any way to the Patents. The list of Assignment Agreements in Schedule 2.1 is accurate and complete in all respects.
- 6.3 No Existing Agreements or Licenses. Seller represents and warrants to Purchaser that there are no existing contracts, agreements, options, commitments, proposals, bids, offers, or rights with, to, or in any person to acquire any of the Patents or any interest therein or to grant any right or license therein or thereunder.
- 6.4 Restrictions on Rights. Seller represents, warrants and covenants to Purchaser that Purchaser is not and will not hereafter be subject to any covenant not to sue or similar restrictions on its enforcement or enjoyment of the Patents as a result of any action taken or not taken by Seller or any prior owner of any of the Patents or any part thereof.
- 6.5 Conduct. Seller represents and warrants to Purchaser that Seller and its representatives (and any prior owner of any of the Patents) 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 their enforcement, including but not limited to, misrepresenting Seller's patent rights to a standard-setting organization or failing to disclose material prior art in connection with the prosecution of any Patent.
- 6.6 Enforcement. Seller represents and warrants to Purchaser that Seller has not (a) put a third party on notice of actual or potential infringement of any of the Patents; or (b) considered enforcement action(s) with respect to any of the Patents.
- 6.7 Patent Office Proceedings. Seller represents and warrants to Purchaser that none of the Patents have been or are currently involved in any reexamination, reissue, or interference proceeding, or any similar proceeding, and that no such proceedings are pending or threatened.

- 6.8 Fees. Seller represents and warrants to Purchaser that all maintenance fees, annuities, and the like due on the Patents have been timely paid through the Effective Date. The Maintenance Fees List is accurate and complete in all respects.
- 6.9 Consents. Seller represents and warrants to Purchaser that Seller has obtained all third party consents, approvals, and/or other authorizations required to sell and assign to Purchaser the Patents and related causes of action pursuant to Section 4.
- 6.10 Validity and Enforceability. Seller represents and warrants to Purchaser that (a) none of the Patents has ever been found invalid, unenforceable or misused for any reason in any administrative, arbitration, judicial or other proceeding; and (b) Seller has not received any notice or information of any kind from any source suggesting that the Patents may be invalid, unenforceable or misused or that a claim to such effect may be brought by any person. To the knowledge of Seller, the Patents are valid and enforceable without any material qualification, limitation or restriction on their use, and Seller is unaware of any facts that may cause the Patents to be found unenforceable or invalid.
- 6.11 No Governmental Sponsorship, Grants, Etc. No inventor of any Patent at any time during the conception of or reduction to practice of any invention disclosed therein was operating under a grant from any governmental entity or agency or private source, performing research sponsored by any governmental entity or agency or private source or subject to any invention assignment or other agreement or obligation that could adversely affect Seller's rights and interest in the Patents.

7. MISCELLANEOUS

- 7.1 Limitation of Liability. PURCHASER'S TOTAL LIABILITY UNDER THIS AGREEMENT SHALL BE THE PAYMENT OF FUNDS AS REQUIRED PURSUANT TO SECTION 3 AND THE PAYMENT OF FEES AND/OR EXPENSES PURSUANT TO SECTION 5. THE PARTIES ACKNOWLEDGE THAT THIS LIMITATION ON PURCHASER'S TOTAL LIABILITY WAS AN ESSENTIAL ELEMENT IN SETTING CONSIDERATION UNDER THIS AGREEMENT.
- 7.2 Compliance with Laws. Notwithstanding anything contained in this Agreement to the contrary, the obligations of the parties 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.
- 7.3 Confidentiality of Terms. The parties hereto shall keep confidential and will not now or hereafter divulge any Confidential Information to any third party, except:
- (a) with the prior written consent of the other party;
 - (b) as may be required by law or legal process (e.g., litigation), including in confidence to legal and financial advisors in their capacity of advising a party in such matters, so long as the disclosure of Confidential Information is restricted at

least in the same manner, and to the same degree, as is the disclosure of confidential information of other parties involved, and provided that

- (i) the disclosing party shall provide the other party with at least ten (10) days prior written notice of such disclosure requirement and shall assist the other party in its efforts to maintain the confidentiality of the Confidential Information; and
 - (ii) the disclosing party shall first use all legitimate and legal means available to minimize the disclosure of Confidential Information to third parties, including without limitation, seeking a confidential treatment request or protective order whenever appropriate or available.
- (c) Neither party will be liable for the disclosure of any Confidential Information that is, at least six (6) months prior to the date of such disclosure, rightfully in the public domain, other than by a breach of this Agreement by the disclosing party or its employees or former employees.

Subject to the foregoing exceptions for disclosure of Confidential Information, Seller will not knowingly divulge any information that may be used or construed to undermine the validity of any of the Patents. Seller may not use or disclose to any third party Purchaser's name, or the names of any of Purchaser's employees or representatives, without the prior, written consent of Purchaser. Notwithstanding the foregoing provisions of this Section 7.3, nothing in this Agreement restricts or limits Purchaser's ability to disclose that it is the owner of all right, title, and interest in the Patents and the fact that Purchaser acquired the Patents from Seller. Nothing in this confidentiality provision limits the applicability of any confidentiality obligations imposed under any other confidentiality agreement between the parties to this Agreement, each of which remains in full force and effect.

7.4 Governing Law. This Agreement will be governed by the laws of the State of Delaware, without reference to conflict of law principles.

7.5 Entire Agreement and Miscellaneous Terms. The terms and conditions of this Agreement, including its exhibits, constitutes the entire agreement between the parties with respect to the subject matter hereof, and, except where explicitly stated otherwise, merges and supersedes all prior and contemporaneous agreements, understandings, negotiations and discussions. Neither of the parties shall be bound by any conditions, definitions, warranties, understandings, or representations with respect to the subject matter of this Agreement other than as expressly provided herein. The section headings contained in this Agreement are for reference purposes only and shall not affect in any way the meaning or interpretation of this Agreement. No oral explanation or oral information by either party hereto shall alter the meaning or interpretation of this Agreement. No amendments or modifications will be effective unless in a writing signed by an authorized representative of each party. These terms and conditions will prevail notwithstanding any different, conflicting, or additional terms and conditions which may

appear on any purchase order, acknowledgment, or other writing not expressly incorporated into this Agreement. This Agreement may be executed in two (2) or more counterparts, all of which, taken together, shall be regarded as one and the same instrument. The following exhibits and schedules are attached hereto and incorporated fully herein: Exhibit A (entitled "Transferred Patents and Patent Applications"); Exhibit B (entitled "Assignment Of Patent Rights") ; and Schedule 2.1 (entitled "Assignment Agreements").

- 7.6 Notices: All notices required or permitted to be given hereunder must be in writing, make reference to this Agreement, and be delivered by hand, or dispatched by prepaid air courier or by registered or certified airmail, postage prepaid, addressed as follows:

If to Seller

MEMSolutions, Inc.
5706 Corsa Avenue, Suite 100
Westlake Village, CA 91362
Attn: General Counsel

If to Purchaser

Intel Corporation
2200 Mission College Blvd.
Santa Clara, CA 95052
Attn: General Counsel

Such notices will be deemed served 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 and, after notice of the change has been received, any notice or request must thereafter be given to that party at that changed address.

- 7.7 Relationship of Parties. The parties hereto are independent contractors. Neither party has any express or implied right or 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. Nothing in this Agreement shall be construed to create a partnership, joint venture, employment, or agency relationship between Seller and Purchaser.

- 7.8 Severability. The terms and conditions stated herein are declared to be severable. If any paragraph, provision, or clause in this Agreement is found or held to be invalid or unenforceable in any jurisdiction in which this Agreement is being performed, the remainder of this Agreement will remain valid and enforceable and the parties shall use good faith to negotiate a substitute, valid and enforceable provision which most nearly effects the parties' intent in entering into this Agreement.

- 7.11 Waiver. Failure by either party to enforce any term of this Agreement shall 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.

- 7.12 Assignment. The terms and conditions of this Agreement shall inure to the benefit of Purchaser, its successors, assigns and other legal representatives, and are binding upon Seller, its successor, assigns and other legal representatives. Seller may not assign any rights or delegate any duties under this Agreement.
- 7.13 Survival. The representations and warranties of Seller herein survive the sale and assignment by Seller to Purchaser of the Patents and other rights described in Sections 4.1 and 4.2 remain in effect in accordance with their terms indefinitely thereafter.

INTEL CORPORATION

MEMSOLUTIONS, INC.

F. Thomas Dunlap, Jr.
Signature

J. Terry Bailey
Signature

F. THOMAS DUNLAP, JR.
Printed Name

J. Terry Bailey
Printed Name

SR. VP, GENERAL COUNSEL
Title

President & CEO
Title

4/18/01
Date

April 10, 2001
Date

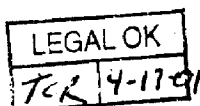


EXHIBIT A**Transferred Patents and Patent Applications**

Patent/Application Number	Title	Status	Hunton & Williams Docket No.
US 5,768,009	Light Valve Target Comprising Electrostatically- Repelled Micro- Mirrors	Issued June 16, 1998	58026.000026
US 5,926,309	Light Valve Target Comprising Electrostatically- Repelled Micro- Mirrors	Issued July 20, 1999	58026.000027
US 5,991,066	Membrane-Actuated Charge Controlled Mirror	Issued November 23, 1999	58026.000023
US 6,028,696	Charge Controlled Mirror with Improved Frame Time Utilization and Method of Addressing the Same	Issued February 22, 2000	58026.000019
US 6,034,810	Field Emission Charge Controlled Mirror (FEA-CCM)	Issued March 7, 2000	58026.000020
US 6,038,058	Grid-Actuated Charge Controlled Mirror and Method of Addressing the Same	Issued March 14, 2000	58026.000022
US 6,031,657	Membrane-Actuated Charge Controlled Mirror (CCM) Projection Display	Issued February 29, 2000	58026.000025
US 6,123,985	Method of Fabricating a Membrane-Actuated Charge Controlled Mirror (CCM)	Issued September 26, 2000	58026.000029

PCT/US99/21457	Membrane-Actuated Charge Controlled Mirror (CCM)	National Phase due 4/15/01	58026.000024
PCT/US99/21455	Field Emission Charge Controlled Mirror (FEA-CCM)	National Phase due 4/15/01	58026.000021
US 6,034,807	Bistable Paper White Direct View Display	Issued March 7, 2000	58026.000031
PCT/US99/21456	Bistable Paper White Direct View Display	National Phase due 4/28/01	58026.000032
US 09/466,886	Bistable Paper White Direct View Display	Pending, Cont. of US 6,034,807	58026.000082
US 09/546,285	Paper White Direct View Display	Pending, CIP of US 6,034,807	58026.000033
US 60/129,336 PR	Bistable Direct View Display with Stall Compensation for Free-Hinge Mirror	Expired Provisional, substance incorporated in 09/546,285	58026.000040
US 60/129,335 PR	Direct-View Display with Stress Curled Mirrors	Expired Provisional, substance incorporated in 09/546,285	58026.000041
US 6,031,656	Beam-Addressed Micromirror Direct-View Display	Issued February 29, 2000	58026.000030
US 09/433/062	Low-Voltage High-Resolution Einzel Gun	Pending	58026.000056
US 09/433,063	Electron Gun with Improved Cathode Venting	Pending	58026.000058
US 09/433,369	Electron Gun for Addressing Secondary Emission Targets	Pending	58026.000057

EXHIBIT B

Assignment of Patent Rights

Whereas, MEMSolutions, Inc., a Delaware corporation, with an office at 5706 Corsa Avenue, Suite 100, Westlake Village, California 91362 (hereinafter MEMSOLUTIONS) is the sole and exclusive owner of certain United States and/or foreign patents and/or patent applications listed in Exhibit A annexed hereto (collectively referred to as the "Patents"); and

Whereas Intel Corporation, a Delaware corporation, with an office at 2200 Mission College Blvd., California 95052, (hereinafter INTEL) is desirous of acquiring the right, title and interest in, to and under the said Patents (and all foreign counterparts and related foreign patents).

Now, Therefore,

For good and valuable consideration, the receipt of which is hereby acknowledged, MEMSOLUTIONS does hereby sell, assign, transfer and set over to INTEL, the Patents aforesaid, and any inventions claimed in said Patent, any reissue or reissues of said Patents already granted and which may be granted, any certificates of reexamination already granted and which may be granted the same to be held and enjoyed by INTEL 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 or may be granted, reissued or extended as fully and entirely as the same would have been held and enjoyed by MEMSOLUTIONS, if this assignment and sale had not been made; together with all claims for damages by reason of past infringement of said Patents, with the right to sue for, and collect the same for its own use and behalf, and for the use and behalf of its successors, assigns or other legal representatives.

And, MEMSOLUTIONS, hereby authorizes and requests the Commissioner of Patents and Trademarks to issue any and all Letters Patents of the United States on said inventions to INTEL as assignee of the entire interest, and hereby covenants that MEMSOLUTIONS has full right to convey the entire interest herein assigned, and that, except as otherwise provided between the parties, MEMSOLUTIONS has not executed, and will not execute, any agreements in conflict therewith.

In Witness Whereof, the parties, by their duly authorized representatives, have executed this Assignment.

DATE: April 10, 2001

By: J. Terry Bailey
Printed/Typed Name

Title: President & CEO

J. Terry Bailey
Signature