

07-23-2001

Packet No.: 6784-27768

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office



101786024

Tab settings

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

1. Name of conveying party(ies):
Xcalibre Equipment Ltd.

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

Name: **Diamant Boart SA**

Internal Address:

Additional names(s) of conveying party(ies) ☐ Yes ☒ No

3. Nature of conveyance:

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

Street Address: **74 avenue du Pont de Luttre, B-1190**

Brussels, Belgium

City: State: ZIP:

Execution Date: **May 10, 2001**

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

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

5,807,038

Additional numbers attached? ☐ Yes ☒ No

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

Name: **Richard A. Rezek**

Internal Address: **Barnes & Thornburg**

Street Address: **11 South Meridian Street**

City: **Indianapolis** State: **IN** ZIP: **46204**

6. Total number of applications and patents involved: **1**

7. Total fee (37 CFR 3.41):.....\$ **40.00**

☒ Enclosed - Any excess or insufficiency should be credited or debited to deposit account

☐ Authorized to be charged to deposit account

8. Deposit account number:

10-0435

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.

Richard A. Rezek

Name of Person Signing

Richard A. Rezek

Signature

July 11, 2001

Date

Total number of pages including cover sheet, attachments, and document: **8**

07/20/2001 6TON11 00000172 5807038

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40.00 DP

PATENT
REEL: 011987 FRAME: 0340

PATENTS TRANSFER AGREEMENT

BETWEEN

XCALIBRE EQUIPMENT Ltd, a company incorporated under the laws of Great Britain, with registered office at Unit 3 Starley Court, Brandon Road, UK-Coventry CV3 2RL, Great Britain, duly represented by Mr. Keith Th. SKINNER, managing director,

Hereinafter referred to as "**XCALIBRE**",

AND

DIAMANT BOART SA, a company incorporated under the laws of Belgium, with registered office at 74 avenue du Pont de Luttre, B-1190 Brussels, Belgium, duly represented by Mr. Bernard GOBLET, managing director, and Mr. Etienne Coumans, operation Manager.

Hereinafter referred to as "**DBSA**",

Whereas XCALIBRE is the owner of patents, short particulars of which are set forth in Schedule 1 hereto (hereinafter referred to as the "Patents"),

Whereas XCALIBRE has agreed, inter alia, to assign the Patents to the DBSA for a fixed and a variable price as set forth hereafter, and in consideration of the covenants by the DBSA hereinafter contained.

NOW IT IS HEREBY AGREED AS FOLLOWS:

1. Assignment of the Patents

- 1.1 XCALIBRE assigns to DBSA all and any of XCALIBRE's rights, title, and interests in the Patents, and all and any of XCALIBRE's rights, title, and interests to copyright interests directly or indirectly connected with the Patents.
- 1.2 XCALIBRE agrees to communicate and transfer to DBSA all and any technical knowledge, drawings, studies, and know-how directly or indirectly connected with the Patents and to instruct DBSA in the working processes directly or indirectly connected with the Patents.
- 1.3 XCALIBRE shall ensure a swift practical transfer by instructing DBSA technical and sales forces into its own plant, until full transfer is duly and actually accomplished. Such formation will be at the expense of

XCALIBRE. Travel and accommodation costs will however be at the expense of DBSA.

2. Completion

In order to make the transfer opposable to third parties, XCALIBRE shall at the cost of DBSA duly execute and do all documents, acts, and things necessary for assigning the Patents to DBSA and vesting the same in DBSA in the form and as and when will be requested by DBSA patent agents.

3. Covenants for Title

- 3.1 XCALIBRE warrants that neither it nor to the best of its knowledge and belief any of its predecessors in title has assigned to any third party or retained the rights agreed herein to be assigned.
- 3.2 XCALIBRE warrants that there was no use of, or publication in writing on a non confidential basis of the invention which is covered by the Patents before publication of the first of the Patents.

4. Price

- 4.1 The transfer of the Patents is agreed in consideration of the fixed price of 80.000 Euro (eighty thousand Euro) and 200.000 Euro (two hundred thousand Euro).
- 4.2 The price of 80.000 Euro is to be paid contemporaneously with the execution of this Agreement.
- 4.3 The price of 200.000 Euro is to be paid no later than 31 December 2011 under the form of royalties as set forth under clause 5 hereafter.

5. Royalties

- 5.1 If during a period commencing with the execution of this Agreement and terminating on 31 December 2011, DBSA or any of its licensees manufactures and sells any product incorporating a technology based upon the Patents, then DBSA shall pay a royalty on all such products equal to 1.5 Euro (one Euro and 50 cent) per sold item.
- 5.2 The royalties will be paid by DBSA to XCALIBRE no later than January 31st of each year, beginning with January 2002 and based upon the total number of items sold during the previous year.
- 5.3 The royalties will cease to be due when the total amount of royalties paid by DBSA to XCALIBRE accrues up to 200.000 Euro at any time before 31 December 2011.

- 5.4 If the total sales by DBSA or its licensees until 31 December 2011 have not caused a total of 200.000 Euro to accrue to XCALIBRE, then DBSA shall pay to XCALIBRE no later than 31st January 2012 an amount equal to the difference between 200.000 Euro and the total amount of royalties already paid under section 5.1 to XCALIBRE by DBSA.

6. Maintaining of the Patents

- 6.1 DBSA shall at its own expense during the life of this Agreement pay all renewal fees and do all such acts and things as may be necessary to maintain and keep on foot the Patents, any further patent applications made in respect of the covered invention and any patents granted pursuant thereto and in default shall recognise the right of the XCALIBRE to pay the same and to be credited with the cost thereof.
- 6.2 DBSA undertakes during the life of this Agreement:
- 6.2.1 not to abandon or allow to lapse the Patents or any other patent application made in respect of the covered invention or any of them or any patent granted pursuant thereto;
- 6.2.2 not to amend or refile the specification relating to the Patents or any other patent application made in respect of the covered invention or any patent granted pursuant thereto without the consent of XCALIBRE, but such consent shall not be unreasonably withheld.
- 6.2.3 DBSA shall at its own cost give full consideration to the desirability of defending every proceeding or application opposing the Patents or any other patent application made in respect of the covered invention or for revocation of any patent or patents granted pursuant thereto and shall keep the XCALIBRE informed of the position from time to time. DBSA shall likewise at its own cost give full consideration to the desirability of defending every proceeding or application opposing any application for a patent for any modification, improvement or addition to the covered invention or for revocation of any such patent and shall likewise keep XCALIBRE informed of the position from time to time.
- 6.2.4 As a general rule, DBSA shall do all things in its power towards the maintenance of the validity and enforceability of the Patents, any other patent application made in respect of the Invention and any patent granted pursuant thereto and for the prevention of the infringement of the latter.

7. Assignment of the Patents

- 7.1 DBSA may not assign the Patents without prior consent of XCALIBRE, but such consent shall not be unreasonably withheld. In the event that DBSA intends to assign the Patent, and Xcalibre consents to such assignment,

DBSA shall, on or before the date of such assignment pay the balance of royalties due in accordance with clause 5.4 above.

- 7.2 DBSA remains free to assign one or more of the Patents to any company member of its group without consent of XCALIBRE, provided the assignee subscribes to the obligations herein subscribed by DBSA.

8. Future technology in connection with the Patents

- 8.1 All and any future technology developed by either party in connection with the invention covered by the Patents shall exclusively belong to DBSA, regardless whether or not it is or may be patented or otherwise protected towards third parties.
- 8.2 XCALIBRE will not directly or indirectly co-operate to the development of any technology in connection with the invention covered by the Patents with any one but DBSA.
- 8.3 XCALIBRE will not directly or indirectly co-operate to the development of any other product designed for small diameter drilling for the duration of this Agreement.

9. Duration

- 9.1 This Agreement shall commence forthwith and shall continue in force until 31 December 2011, without prejudice to possible prior termination of the obligation to pay royalties as stated under clause 5.3
- 9.2 The obligations under clauses 8.1, 8.2 and 11 shall survive this Agreement without limitation in time

10. Name of Products

DBSA may market products incorporating use of one or more of the Patents under any trade name of its choice.

11. Confidentiality

XCALIBRE undertakes to keep the technical knowledge in connection with the Patents confidential and not to communicate all or part of it to any third party without prior written consent by DBSA, unless such technical knowledge enters the public domain through no fault of Xcalibre.

12. Miscellaneous

- 12.1 Amendments to this Agreement shall be valid only if agreed upon by an instrument in writing duly signed by both parties and expressly called amendment.

- 12.2 In the event that any provision of this Agreement should be held to be invalid or unenforceable, the remaining provisions shall not be affected hereby. Should an individual provision of this Agreement be held invalid or unenforceable, the parties hereto shall agree on a new provision corresponding to the ineffective provision which it is replacing.
- 12.3 Each party stands for the other companies of its group as far as necessary.
- 12.4 This Agreement shall be governed and is construed in accordance with the laws of the Kingdom of Belgium.
- 12.5 Only the Courts of Brussels shall have jurisdiction over all and any litigation which may arise under or in connection with this Agreement.

IN WITNESS whereof the parties hereto have executed this Agreement the 11th day of April 2001, in two original copies, each party acknowledging receipt of its original copy.

For DBSA

For XCALIBRE:

Signed:

B. Goblet

Signed:

K. Skinner

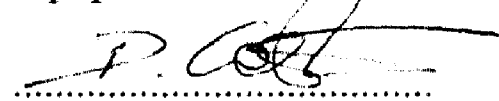
E. Coumans

Schedule 1Patents:

1. UK Patent GB 2 263 489 A (application n° 9201200.4, filed 21.01.1992, publication date 28.07.1993, inventor Keith Th. SKINNER) in connection with a core drilling system;
2. European Patent EP 0 771 933 A2 (application n° 96307879.6, publication date 07.05.1997, bulletin 1997/19, inventor Keith Th. SKINNER) in connection with a drill chuck;
3. US Patent US N°5807038 (application n° 96307879.6, publication date 07.05.1997, inventor Keith Th. SKINNER) in connection with a quick release drill bit;
4. All and any other patent or patent application, in any country or area of the world, which extends renews develops or relates to the invention(s) as reflected in patents under 1 through 3 here above.



I, David Croston, of Withers & Rogers, 75 Colmore Row, Birmingham, B3 2AP hereby certify that the attached copy is a true and accurate copy of the original Patents Transfer Agreement between Xcablibre Equipment Ltd and Diamant Boart SA.

A handwritten signature in black ink, appearing to read 'D. Croston', written over a dotted line.

David Croston

7 June 2001