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10-17-2001



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Our Ref.: 267-1

Commissioner of Patents and Trademarks
Box Assignment, Washington, D.C. 20231

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

<p>1. Name of conveying party(ies): Optiscan Pty Ltd</p> <p>10/10/01</p> <p>Additional name/s of conveying party/ies attached? <input type="checkbox"/></p> <p>3. Nature of conveyance: <input type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Security Assignment <input type="checkbox"/> Change of Name <input checked="" type="checkbox"/> Other <u>License Agreement</u></p> <p>Execution Date: <u>March 29, 21 and April 10, 2000</u></p>	<p>2. Name and address of receiving party(ies):</p> <p>Name: <u>Bio-Rad Laboratories, Inc.</u> Internal Address: _____ Street Address: <u>1000 Alfred Nobel Drive</u> _____ City: <u>Hercules</u> State/Country: <u>California</u> Zip: _____</p> <p>Additional name/s & address/es attached? <input checked="" type="checkbox"/> Yes <input type="checkbox"/> No</p>
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4. Application number(s) or patent number(s):
If this document is being filed together with a new application, the execution date of the application is: _____

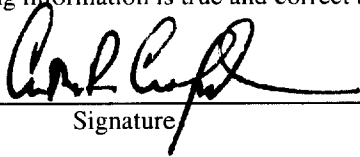
<p>A. Patent Application No(s). (1) _____ (2) _____ (-) _____</p>	<p>B. Patent No(s). (1) <u>5,161,053</u> (2) <u>5,120,953</u> (3) _____</p>
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Additional numbers attached ☐ Yes ☒ No

<p>5. Name and address of party to whom correspondence concerning document should be mailed:</p> <p>Name: <u>Arthur R. Crawford</u> Internal Address: _____ Street Address: <u>Nixon & Vanderhye P.C.</u> <u>1100 North Glebe Road</u> <u>8th Floor</u> City: <u>Arlington</u> State: <u>VA</u> Zip: <u>22201</u></p>	<p>6. Total number of applications & patents involved: <u>2</u></p> <p>7. Total fee (37 CFR 3.41) \$ <u>80.00</u> <input checked="" type="checkbox"/> Enclosed <input type="checkbox"/> Authorized to be charged to deposit account #14-1140</p> <p>8. The Commissioner is hereby authorized to charge any <u>deficiency</u> in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper thereafter filed in this application by this firm) to our Account No. 14-1140.</p>
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DO NOT USE THIS SPACE

9. Statements 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.

<p><u>Arthur R. Crawford</u> Name of Person Signing Reg. No. 25,327</p>	<p><u></u> Signature</p>	<p><u>October 10, 2001</u> Date</p>
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Total number of pages including **original** cover sheet, attachments, and document: [12]

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RECORDATION FORM COVER SHEET

PATENTS ONLY

Our Ref: 267-1

Commissioner of Patents and Trademarks
Box Assignment, Washington, D.C. 20231

1. Name of conveying party(ies):

2. Name: Bio-Rad Laboratories Pty Ltd
Street Address: 391 Park Road, Regents Park
City: New South Wales
Country: Australia
Zip: 2143

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

A. Patent Application No(s).

(4)
(5)
(6)
(7)
(8)
(9)

B. Patent No(s).

(4)
(5)
(6)
(7)
(8)
(9)

NON-EXCLUSIVE LICENSE AGREEMENT

Optiscan Pty Ltd ACN 060 658 764, a company incorporated in the state of Victoria, Australia, of Unit1/ 27 Normanby Road, Notting Hill VIC 3168, Australia (hereinafter "LICENSOR") and Bio-Rad Laboratories Inc of 1000 Alfred Nobel Drive, Hercules California USA, its subsidiaries and affiliates, including Bio-Rad Laboratories Pty Ltd ACN 001 843 803 of 391 Park Road, Regents Park, New South Wales, 2143 Australia (hereinafter referred to as the "LICENSEE") hereby agree to enter into this Agreement, as of March 16, 2000, (hereinafter, "the date of signing") under the terms and conditions as set forth below:

1. DEFINITIONS

- 1.1 The term "LICENSED PRODUCT(S)" shall mean laser scanning microscope(s), or subassemblies supplied to third parties for construction into laser scanning microscope(s), not being adapted for endoscopic use, which utilize a single mode optical fiber to deliver a diffraction limited spot to a specimen ("a Delivery Optical Fibre") and which do not utilise a single mode fiber on the path which returns light emanating from the specimen whether or not separate from the Delivery Optical Fibre. The LICENSED PRODUCTS include but are not limited to current models MRC-1024 and Micro-Radiance and any improvements to these models.
- 1.2 The term "LICENSED PATENT" or "LICENSED PATENTS" shall mean U.S. Patent 5,161,053 issued 3 November 1992, U.S. Patent 5,120,953 issued 9 June 1992, Australian Patent 610,430, Australian Patent 652,713, Canadian Patent 1,325,537, any amendments, divisions, reexaminations, continuations, continuation - in - parts, reissues or extensions of the foregoing, and any patent or patent application which claims priority from the same basic of provisional applications as the above-mentioned patents or any other patent or patent application which claims essentially the same invention to the foregoing granted now or in the future in the United States of America ("USA"), Canada or Australia, together with any present or future patents of the LICENSOR in the USA, Canada or Australia covering improvements in the use of a Delivery Optical Fibre.
- 1.3 Territory means the United States of America, Canada and Australia.
- 1.4 "Retail Sale Price" means the arms length gross retail sales price excluding any sales tax, value added tax or goods and services tax.

2. LICENSE GRANT

- 2.1 Subject to the terms and conditions hereof, LICENSOR hereby grants a non-exclusive right and license under LICENSED PATENTS, for the term specified in paragraph 7, to make, offer to make, import, keep, hire, have made, use, offer for sale, advertise or promote for sale or supply, sell, supply and otherwise dispose of LICENSED PRODUCTS in the Territory. No sub-license right is granted hereunder.



- 2.2 The License granted under paragraph 2.1 only covers the use of the LICENSED PATENTS in non-endoscopic confocal microscopes.
- 2.3 At Licensee's request, at the sole expense of the Licensor, shall prepare and cause to be recorded the Licensee's interest as LICENSEE on the respective Register of Patents in the Territory.

3. ROYALTIES

- 3.1 In consideration of the license granted under paragraph 2, LICENSEE shall pay to LICENSOR fixed fees and royalties as follows:
- (i) a fixed fee of The fixed fee represents 75% of the royalties that would have accrued to the LICENSOR in respect of sales of units of the LICENSED PRODUCTS during the period October 1, 1997 to March 16, 2000, according to the formula provided in (ii) below. Annexure "A" sets out the number of units of the LICENSED PRODUCTS sold in the Territory in the period between October 1, 1997 and March 16, 2000 and the calculation of the fixed fee. The LICENSEE warrants that the information contained in Annexure "A" represents a true and accurate record of the sales of the LICENSED PRODUCTS in the Territory in the period between October 1, 1997 and March 16, 2000.
- (ii) a royalty based on the number of units of each LICENSED PRODUCT sold in the Territory, after March 16, 2000, according to the following formula:
1. per unit of each LICENSED PRODUCT for the first 50 units sold in each two year period;
2. 30 units sold in each two year period; and
3. For each unit of the LICENSED PRODUCT sold during the relevant two years in excess of 80 units, the lesser of
- (a) and
- (b) of the retail sale price of the complete confocal system comprising the LICENSED PRODUCTS and any laser and computer and optical microscope, if sold.)
- 3.2 The royalty payment shall be calculated at the end of each December and June quarter, which for the purpose of this paragraph shall end on the last day of the month of December and June, and cover royalties due for the preceding two quarters.
- 3.3 The LICENSEE shall provide the LICENSOR with each payment of the royalty, a statement of account which includes the following information:

- (i) the number of units of the LICENSED PRODUCTS sold during the relevant two quarters;
- (ii) if the royalty payment is based on the formulae referred to in paragraph 3.1(ii)3.(b) the retail sale price referable to each unit sold during the relevant two quarters.

The statement of account shall be certified as correct by the LICENSEE'S accountant or financial controller.

- 3.4 For the purpose of calculating the fixed fee and royalty payments referred to in paragraph 3.1, the reference to "sale" or "sold" shall include sales, loans (except demo units loaned for the purposes of eliciting a sale), rentals, leases, licences or other forms of supply or disposition whether made by the LICENSEE or on its behalf by a related body corporate or authorised third party. A "related body corporate" shall have the same meaning as specified in the *Australian Corporations Law*.
- 3.5 The payment terms for the fixed fee and the royalties referred to in paragraph 3.1 are set out in paragraph 4 below.

4. PAYMENTS AND REPORTS

- 4.1 **Payment of Fixed Fee.** The fixed fee of _____ referred to in paragraph 3.1(i) shall be paid by the LICENSEE in 6 (six) installments payable as follows:

- (i) the first installment of _____ shall be paid on signing of this Agreement;
- (ii) the second installment of _____ shall be paid at the end of the June 2000 quarter;
- (iii) each subsequent installment of _____ shall be paid at the end of the calendar quarter, which for the purpose of this paragraph shall end on the last day of the months December and June.

Payment of Royalties. The royalty referred to in paragraph 3.1(ii) shall be paid as follows:

- (iv) the first payment for the period between March 16, 2000 and June 30, 2000 shall be paid within 60 days of the quarter ending June 2000;
- (v) each subsequent royalty payment shall be paid within 60 days of the end of each December and June quarter covering royalty payments due for the preceding two quarters. For the purpose of this paragraph, the end of the quarter shall be on the last day of the months of December and June.

- 4.2 **Forms of Payment.** All payments to LICENSOR under this agreement shall be paid to LICENSOR by mail or telegraphic transfer to a bank account nominated by LICENSOR in U.S. Dollars.
- 4.3 **Interest.** LICENSEE shall pay interest on any payment due under this Agreement which is not made by the due date and not the subject of a dispute between LICENSEE and LICENSOR. Any such overdue payment shall be subject to an interest charge at the rate prescribed from time to time pursuant to the *Penalty Interest Rates Act* 1983 (Vic).
- 4.4 **Reports.**
- 4.4.1 LICENSEE shall keep for a period of four (4) years from the end of the calendar year in which each sale of the LICENSED PRODUCT took place true, complete and accurate books of account and records of the manufacture and sales of the LICENSED PRODUCTS, the retail sale price of all LICENSED PRODUCTS sold. The accounts and records shall be in sufficient detail to enable the LICENSEE'S compliance with its obligations under this Agreement to be verified by the LICENSOR or on its behalf.
- 4.4.2 During the term of this Agreement and for a period of one (1) year following its termination, the LICENSEE shall give access to or arrange access to such books of account and records relating to the LICENSED PRODUCTS by an independent accountant or auditor engaged by the LICENSOR such that the independent accountant or auditor may verify the royalty payments made by the LICENSEE under this Agreement during ordinary business hours, upon receiving advance written request from LICENSOR and reasonable notice.
- 4.4.3 The independent accountant or auditor shall not disclose any of the LICENSEE'S information that he has access to for the purpose of the inspection and verification, to any third party and shall only disclose to LICENSOR information relating to the accuracy or completeness of the payments required under this Agreement.
- 4.4.4 The LICENSEE shall give the independent accountant or auditor reasonable assistance or information requested by the accountant or auditor for the purpose of the inspection or audit and to enable verification of the LICENSEE'S compliance with its obligations under this Agreement.
- 4.4.5 If the inspection or audit of the LICENSEE'S accounts or records by the independent accountant or auditor reveals that the LICENSEE has underpaid the royalties payable under this Agreement:
- (a) the LICENSOR shall provide the LICENSEE with a copy of the report from the independent accountant or auditor detailing the underpayment of royalties;

- (b) subject to paragraph 4.4.5(d), the LICENSEE shall pay to LICENSOR the amount of the underpayment of the royalties and interest in accordance with paragraph 4.3, within fourteen (14) days of receiving a copy of the report of the independent accountant or auditor;
- (c) the LICENSEE shall pay the costs of the inspection or audit where there is underpayment of royalties within fourteen (14) days of receiving a demand for payment from the LICENSOR.
- (d) if the LICENSEE disputes the report of the independent accountant or auditor, it must notify the LICENSOR within fourteen (14) days of receiving the report and unless the matter can be resolved through negotiations between LICENSOR and LICENSEE within thirty (30) days, refer the matter to dispute resolution in accordance with paragraph 14.

4.5 **Failure of Patent Rights.** If any claim of the LICENSED PATENTS is finally held invalid by a court or governmental agency of competent jurisdiction, then the definition of LICENSED PATENTS in paragraph 1.2 hereof shall thereafter be amended as though such invalid claim were not included within the LICENSED PATENTS. In such event, LICENSEE's obligation to pay royalties in respect of such invalid claim pursuant to Paragraph 3.1(ii) shall cease.

4.6 **Taxes.** LICENSEE will pay, on LICENSOR's behalf, any tax (except tax on income) imposed in the Territory on LICENSOR in connection with the royalty payments made under this Agreement. Withholding tax in relation to any tax imposed on LICENSOR pursuant to a law of the Territory will be withheld and paid to the relevant taxation office in the Territory by LICENSEE. LICENSEE will provide a certificate of payment of tax sufficient for LICENSOR to properly claim Australian tax credit for any such tax imposed on LICENSOR pursuant to a law of the Territory.

5. REPRESENTATIONS, WARRANTIES AND ACKNOWLEDGMENTS .

- 5.1 LICENSOR represents and warrants that it is the owner of rightful title of the LICENSED PATENTS in the countries of the Territory in which the LICENSED PATENTS are registered and has full legal authority to grant to LICENSEE the license granted herein.
- 5.2 LICENSOR represents and acknowledges that the sale in the Territory of confocal microscopes made by LICENSEE as at the date of this Agreement for non-endoscopic applications does not infringe any patent granted or pending in Territory of LICENSOR other than the LICENSED PATENTS.
- 5.3 Each party shall notify the other in writing within thirty (30) days of any assertion by a third party that the making, using or selling of the technology described in the LICENSED PATENTS infringes or may infringe the intellectual property rights of any third party.

5.4 LICENSOR represents and warrants that the list of LICENSED PATENTS identified in Paragraph 1.2 is complete and accurate and that LICENSOR does not own or control the rights in any other patent or intellectual property under which LICENSEE requires a license to exercise its rights under Paragraphs 1 and 2 of this Agreement.

6. RELEASE

6.1 Subject to payments of the amounts specified in 3 (i) above, LICENSOR irrevocably releases LICENSEE and all companies that are a related body corporate of the LICENSEE and their customers, from any and all claims of infringement of the LICENSED PATENTS, with respect to any LICENSED PRODUCTS made, used, offered for sale, advertised or promoted for sale or supply, sold, supplied, or otherwise disposed of by or for LICENSEE before February 1, 2000, in the Territory.

7. TERM

The term of this Agreement and the licenses granted hereunder shall commence on the date of signing this Agreement and shall expire when the last LICENSED PATENT expires, unless earlier terminated as herein provided.

8. TERMINATION

8.1 If LICENSEE fails to make any payment provided for in paragraph 3 of this agreement within the time specified therefor, or challenges the validity of any of the LICENSED PATENTS in a Court or Patent Office or any other forum having jurisdiction, LICENSOR may then, or at any time thereafter during which such conduct continues, at its option, terminate this Agreement by giving LICENSEE at least thirty (30) days written notice of such termination. Unless LICENSEE makes the payment or discontinues the challenge to the validity of the LICENSED PATENTS (as the case may be) within thirty (30) days after the notice is given, termination shall be effective thirty (30) days after giving such notice by LICENSOR. LICENSEE is entitled to terminate this Agreement without cause, effective at the end of each calendar year, by giving Licensor at least 60 days written notice of such termination.

8.2 If either party fails to perform and comply with any material obligation, covenant, term and condition set forth in this Agreement, other than the obligation to make payments, the remedy for which is provided for in paragraph 8.1 above, the other party may then, or at any time thereafter during which such default or condition continues, at its option, terminate this Agreement by giving the defaulting party at least ninety (90) days prior written notice of such termination. The notice shall state whether the default is capable of correction, and if so, in what way it can be corrected. Termination shall be effective ninety (90) days after giving of such notice by the other party if said default is not corrected within such ninety (90) days period.

9. INFRINGEMENT AND COMPETITORS

LICENSOR will conscientiously pursue any infringement of the LICENSED PATENTS in respect of products sold by other parties ("Competitors") in competition with the LICENSED PRODUCTS of the LICENSEE. Any royalties or other license fees negotiated with Competitors in respect of equivalent technology to that of the LICENSEE will be no more favorable to the Competitors than the LICENSEE enjoys under this Agreement.

10. OPTION

LICENSOR grants LICENSEE an option expiring 30 April 2000 to enter into an agreement granting LICENSEE a non-exclusive licence to manufacture and market worldwide the Optiscan F900e confocal microscope (and any improvements thereto) for non-endoscopic applications, or a similar low cost benchtop confocal microscope of Optiscan or Bio-Rad design for a period of a term equivalent to the term of this Agreement. Royalties shall be calculated as provided in paragraph 3.1(ii) above. Upon written exercise of the option, LICENSEE must pay LICENSOR an upfront fee of _____ of which 50% will be treated as an advance on royalties. A formal agreement will be entered into reflecting these terms.

If LICENSEE does not exercise the option set out above, LICENSOR agrees that between 1 May 2000 and 31 October 2000, it will not enter into an agreement with a third party by which the third party is licensed to manufacture and market worldwide the Optiscan F900e confocal microscope for non-endoscopic applications, unless:

- (a) LICENSOR has delivered a notice to LICENSEE setting out the terms of the proposed Agreement; and
- (b) LICENSEE has failed to deliver a notice to LICENSOR within a period of thirty (30) days of delivery of the notice described in paragraph (a) offering to enter into an agreement with LICENSOR in the same terms or substantially the same terms as the proposed Agreement.

11. NOTICE

Any notice required to be given under this Agreement shall be in writing and shall be sent by registered airmail, return receipt requested, or its equivalent, postage prepaid, or by facsimile or by personal service upon an officer of the corporation, or by hand delivery to any person upon the premises at the relevant address who reasonably appears to be authorised to receive post or other messages on behalf of the relevant party addressed to each party or sent to the facsimile number as follows:

LICENSOR: Optiscan Pty Ltd
27 Normanby Road,
Notting Hill Vic 3168, Australia
Attention: Licensing Manager
Fax Number +61 3 9562 7742

LICENSEE: Bio-Rad Laboratories Inc
1000 Alfred Nobel Drive,
Hercules, California USA 94547
Attention: General Counsel
Fax Number: +1 510 741 5815

Notices sent by post shall be treated as delivered seven (7) days after the date upon the registration receipt provided by the relevant postal authority.

Notices sent by facsimile shall be treated as delivered when the addressee actually receives it in full and legible form.

12. ASSIGNMENT

12.1 Neither this Agreement nor any rights or benefits hereunder shall be assignable or transferable by LICENSEE without the written consent of LICENSOR, unless the assignment or transfer by LICENSEE is pursuant to an agreement to sell all or substantially all of the assets of the business to which the subject matter of this license pertains. In any event, such consent shall not be unreasonably withheld. LICENSOR may assign the benefit of this Agreement without the consent of LICENSEE.

12.2 LICENSOR must not assign the LICENSED PATENTS or otherwise deal with the LICENSED PATENT in a way inconsistent with this Agreement unless the proposed assignee or other party to the dealing ("the Assignee") agrees to execute, at the time of assignment or dealing, a novation agreement with LICENSOR and LICENSEE, by which the Assignee assumes the rights and obligations of LICENSOR under this Agreement, and LICENSOR is released from its obligations under this Agreement. LICENSEE must execute such a novation agreement within thirty (30) days of receiving a request from LICENSOR to do so.

13. GOVERNING LAW

The validity, performance and construction of this Agreement shall be construed in accordance with and governed by the laws of the state of Victoria, and the Commonwealth of Australia.

14. ARBITRATION

All disputes, controversies or differences ("disputes") which may arise between the parties hereto, out of or in connection with this Agreement or for breach thereof, other than disputes of the kind set out below, shall be finally settled by arbitration in

Melbourne, Australia in accordance with the rules of the Australian Commercial Disputes Center. Judgment upon the award rendered by the arbitrators may be entered in any court having jurisdiction.

The following disputes need not be submitted to arbitration, unless the parties agree to do so:

- (a) claims by LICENSOR against LICENSEE for non-payment of royalties or by LICENSEE against LICENSOR for overpayment of royalties;
- (b) claims in which the relief sought by either party includes urgent equitable relief.

15. ENTIRE AGREEMENT

This Agreement cancels and supersedes all prior oral or written representations, agreements, and understandings between the parties and embodies all of the understandings and obligations between the parties with respect to the subject matter hereof. No modification of this Agreement shall be binding upon any of the parties unless made in writing and signed by both parties.

16. RELATIONSHIP OF PARTIES

Nothing in this Agreement shall be construed to create between the parties a partnership, association, joint venture or agency.

17. NON - WAIVER

Failure of either party to require strict performance of any term of this Agreement shall not affect that party's right to enforce the same nor shall any waiver or a default be construed to be a waiver of any succeeding default or a waiver of this paragraph.

18. LEGALITY

If any term or provision, other than royalty provisions, of this Agreement shall be held or adjudged by any court, arbitrator, or other authority having jurisdiction over the parties or over this Agreement or over the subject matter hereof to be illegal, invalid, or unenforceable, such determination shall not affect the validity of any other terms or provisions hereof. Any illegal, invalid, or unenforceable term or provision of this Agreement shall be severed and deleted from this Agreement.

19. CONFIDENTIALITY

Both parties agree to keep the terms of this Agreement confidential except insofar as any information is required to be disclosed to comply with any law or with the rules of the Australian Stock Exchange, or in order to obtain professional advice concerning this Agreement, or enforce its terms.

20. LIABILITY OF LICENSEE

The liability of Bio-Rad Laboratories Inc. and Bio-Rad Laboratories Pty Ltd pursuant to this Agreement is joint and several.

21. CAPTIONS

The captions of the paragraphs of this Agreement are for reference only and are not to be construed in any way as part of this Agreement.

22. COUNTERPARTS

This Agreement may be executed as two or more counterparts, all of which taken together shall constitute a single original.

23. AUTHORITY TO EXECUTE

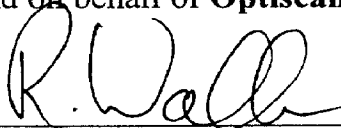
23.1 Each of the parties warrants its power to enter into this Agreement.

23.2 Any individual executing this Agreement on behalf of a party represents and warrants that he or she has been fully empowered to execute this Agreement and that all necessary action to authorize the execution of this Agreement has been taken.

IN WITNESS WHEREOF, the parties have entered into this Agreement as of the date first hereinabove written.

LICENSOR

For and on behalf of **Optiscan Pty Ltd**



Roger Wallis
General Manager

Date: MARCH 29, 2000

LICENSEE

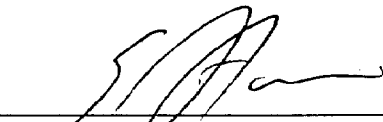
For and on behalf of **Bio-Rad Laboratories, Inc**



Sanford S. Wadler
Vice President and General Counsel

Date: March 21, 2000

For and on behalf of **Bio-Rad Laboratories Pty Ltd (ACN 001 843 803)**



Edward Stauber
Managing Director

Date: April 10th 2000