

02-21-2002

WENMM-1595 (05/01)

Form PTO-1595

(Rev. 03/01)

OMB No. 0651-0027 (exp. 5/31/2002)

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

## 1. Name of conveying party(ies):

Eli Lilly and Company  
Lilly Corporate Center  
Indianapolis, IN 46285

2-12-02

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

Name: Disetronic Licensing AG

Internal Address: \_\_\_\_\_

Street Address: Brunnmattstrasse 6City: Burgdorf State: Switzerland Zip: CH-3401Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

## 3. Nature of conveyance:

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

Execution Date: December 5, 2001Additional name(s) & address(es) attached? ☐ Yes ☒ No

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

5,108,819; 5,166,063; 5,284,140; 5,299,5715,322,063; 5,403,700; 5,411,647; 5,476,094Additional number(s) attached? ☐ Yes ☒ No

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

Name: Thomas Q. Henry

Internal Address: \_\_\_\_\_

Woodard, Emhardt, Naughton, Moriarty & McNettStreet Address: 3700 Bank One TowerCity: Indianapolis State: Indiana Zip: 462046. Total number of applications and patents involved 8

7. Total fee (37 CFR 3.41).....\$320.00

☒ Enclosed☐ Authorized to be charged to deposit account

## 8. Deposit account number:

23-3030

(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 belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.*Thomas Q. Henry  
Name of Person Signing

Signature

Date

10

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

Mail documents to be recorded with required cover sheet information to:  
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7396-1: TQH:153513

02/20/2002 LMUELLER 00000126 5108819

01 FC:581

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PATENT  
REEL: 012581 FRAME: 0207

## ASSIGNMENT AND LICENSE AGREEMENT

**THIS ASSIGNMENT AND LICENSE AGREEMENT** (the "Agreement") is made as of the 1st day of November, 2001, by and between Eli Lilly and Company, an Indiana Corporation having a principal place of business at Lilly Corporate Center, Indianapolis, Indiana 46285 USA ("Assignor"), and Disetronic Licensing AG having a principal place of business at Brunnmattstrasse 6, CH-3401, Burgdorf, SWITZERLAND ("Assignee").

### Witnesseth

**WHEREAS**, Assignor is the owner of all right, title, and interest in, to and under the patent properties listed on Schedule A attached hereto; and

**WHEREAS**, on August 9, 1993, Assignor granted Disetronic Medical Systems AG, 3401 Burgdorf, Switzerland an exclusive, worldwide license, except as to Assignor, to make, have made, use and sell products under the patent properties listed in Schedule A ("Previous License Agreement"); and

**WHEREAS**, Disetronic Medical Systems AG has assigned all its Intellectual Property to Assignee, including the right to terminate the above-mentioned agreement and any and all amendments thereto; and

**WHEREAS**, Assignee is desirous of acquiring Assignor's interest in same.

**NOW, THEREFORE**, in consideration of the premises set forth herein and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Assignor and Assignee agree as follows:

1. **Termination of Previous License Agreement.** Except as stated otherwise herein, the Previous License Agreement is hereby terminated and superseded in its entirety by this Agreement. However, the confidentiality clause in the Previous License Agreement shall remain applicable during the term of this Agreement and thereafter.
2. **Assignment of Patents.** Assignor hereby grants, conveys, and assigns to Assignee all of Assignor's right, title, and interest in and to:
  - a. The U.S. and foreign patents and patent applications listed on Schedule A attached hereto, including without limitation, the inventions described and claimed therein;

- b. Any and all patents issuing on the patent applications listed on Schedule A, and any reissues, divisions, continuations, renewals, extensions or continuations-in-part of any of the assigned patents and patent applications;
- c. All income, royalties, damages, and payments now or hereafter due and/or payable under and with respect thereto, including, without limitation, damages and payments for past or future infringements thereof; and
- d. The right to sue and recover for past, present, and future infringements thereof.

3. **Covenants and Warranties by Assignor.** Assignor represents, warrants, and covenants that:

- a. To the best of Assignor's knowledge, Assignor has the full right to convey the right, title and interest herein assigned; and
- b. To the best of Assignor's knowledge, the patent properties listed on Schedule A are free from any ownership rights of third parties.
- c. Assignor will not knowingly attack and not knowingly assist third parties in attacks on the assigned patents.
- d. Except as expressly stated herein, all other representations, covenants and warranties, express or implied, statutory or otherwise, are hereby excluded, and Assignor shall not be liable in contract, tort or otherwise for any loss, damage, expense or injury of any kind whatsoever arising out of or in connection with the assigned patents or the practice of the patented inventions.
- e. To the best of Assignor's knowledge, there is no opposition, no request for re-examination or invalidation trial ongoing or to be expected in the near future regarding any of the patents or applications listed in Schedule A.

4. **Covenants and Warranties by Assignee.** Assignee represents, warrants, and covenants that, as of the date of execution of this Agreement, neither


Assignee nor Disetronic Medical Systems AG has commercialized a product under the Previous License Agreement, and Assignee and Disetronic Medical Systems AG owes no royalties to Assignor under such agreement.

5. **Rights of the Assignee.** Assignee is free to maintain or abandon assigned patents. Assignor has no right of reassignment, nor any option of reinstating abandoned patents, nor any other such right related to the assigned patents.
6. **Royalty.** In consideration for this assignment, Assignee shall pay to Assignor an annual royalty of five percent (5%) on NET SALES (as defined in the Previous License Agreement) on any and all products made, used or sold which are covered by one or more claims of the patents listed on Schedule A. Such royalty shall be effective until expiration of the involved patent.
7. **Nonexclusive License Grant.** Assignee hereby grants Assignor an irrevocable, nonexclusive, royalty-free, worldwide license under the patents listed in Schedule A to make, have made, use and sell products covered by one or more claims of said patents for the full term thereof. Assignor shall have no right to sublicense others, except that the license granted in the foregoing sentence to have made products under the patents listed in Schedule A includes the right to a third party to make such products for sale exclusively to Assignor.
8. **Authorization and Request.** Assignor authorizes and requests the U.S. Commissioner of Patents and Trademarks to issue, in the name of the Assignee, any and all patents of the United States which hereafter issue from pending patent applications, or reissues, divisions, continuations, renewals, extensions, continuations-in-part or improvements resulting from Patents. Assignee shall be solely responsible for all expenses and costs relating to the registration and maintenance of the patents.
9. **Support by Assignor.** By way of derogation from section 7.06. of the Previous License Agreement, Assignee shall keep in its possession all data, materials, drawing, prototypes and equipment received from Assignor thereunder, which are required for the maintenance of the assigned patents listed in Schedule A. Assignor agrees to cooperate with and assist Assignee, including by execution of any additional documents that may reasonably be required, in order to perfect in Assignee the rights granted herein.
10. **Binding effect; Benefits.** This Assignment shall be binding upon Assignee and its respective successors and assigns and shall inure to the benefit of Assignee, its nominees, successors, and assigns.

11. **Complete Agreement.** The parties agree that this Agreement is the complete and exclusive statement of the agreement between the parties, which supersedes and merges all prior proposals, understandings and all other agreements, oral or written, between the parties relating to this Agreement.
12. **Amendment.** This Agreement may not be modified, altered or amended except by written instrument duly executed by both parties.
13. **Governing Law.** This agreement shall be governed by, and construed and enforced in accordance with the law of Switzerland with jurisdiction in the courts of Geneva, Switzerland.

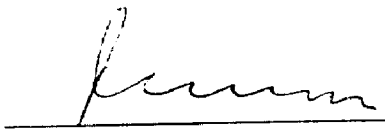
**WITNESS** the due execution hereof as follows:

ELI LILLY AND COMPANY

By:   
Dr. August Watanabe, Executive  
Vice President – Science/Technology

Date: December 5, 2001

DISETRONIC LICENSING AG

By:   
Dr. Beat Maurer, President

Date: December 10, 2001

By:   
Urs Steinemann, Vice President

Date: December 11, 2001



# SCHEDULE A

## Status Report of Active

### Disetronic Patent Matters

WENMM Case Number	Matter Description	Patent Number	Issue Date	Serial Number	Filing Date	Current Status
DMS-1 X8233 LLY-006	ALLEN, JOHNSON, NEVIN  HYDROPHILIC POLYURETHANE MEMBRANES FOR ELECTRO-CHEMICAL GLUCOSE SENSORS					
	*U.S.	007040-000027	5,322,063	06/21/1994	077771,658	10/04/1991  ISSUED. Maintenance fees due 12/21/97; 12/21/2001; 12/21/2005. Expires 10/4/2011.
	CANADA	007040-000109		2079748-7	10/02/1992	PENDING. Request for examination due 10/2/1999; reported to client 7/8/99; requested 10/1/99. Associate confirmed done 11/29/99. Maintenance Fees due 10/2 annually.
	EUROPE	007040-000014	0535898	02/05/1997	92308837.1	09/28/1992  ISSUED. Designating: France, Germany, Italy, Netherlands, Spain and United Kingdom. Annuities due 9/28 each year. Expires 9/28/2012.
	FRANCE	007040-000290	0535898	02/05/1997		ISSUED. Annuities due 9/28 each year. Expires 9/28/2012.
	GERMANY	007040-000291	0535898	02/05/1997		ISSUED. Annuities due 9/28 each year. Expires 10/4/2009.
	JAPAN	007040-000092		264668/1992	10/02/1992	PENDING. Request for examination due 10/2/1999; requested 6/3/99. Published 9/17/93 under #238960/93.
	NETHERLANDS	007040-000293	0535898	02/05/1997		ISSUED. Annuities due 9/28 each year. Expires 9/28/2012.
	UNITED KINGDOM	007040-000295	0535898	02/05/1997		ISSUED. Annuities due 9/28 each year. Expires 9/28/2012.

<i>WENMM Case Number</i>	<i>Matter Description</i>	<i>Matter Number</i>	<i>Patent Number</i>	<i>Issue Date</i>	<i>Serial Number</i>	<i>Filing Date</i>	<i>Current Status</i>
DMS-2:X7995 LLY-009	ALLEN, NEVIN ACRYLIC COPOLYMER MEMBRANES FOR BIOSENSORS						
	*U.S.	007040-000026	5,284,140	02/08/1994	07/834,002	02/11/1992	ISSUED. Maintenance Fees due 8/8/97; 8/8/2001; 8/8/2005.
	*U.S. - DIV	007040-000006	5,476,094	12/19/1995	08/152,185	11/15/1993	ISSUED. Maintenance Fees due 6/19/99; 6/19/2003; 6/19/2007. Expires 12/19/2012. 3 1/2 year maintenance fee paid 6/3/99 per Kart.
	CANADA	007040-000050			2,129,626	02/10/1993	PENDING. Request for examination filed 3/25/99. Maintenance Fees due 2/10 annually. Next annuity due 2/10/2001
	EUROPE	007040-000106	0625883	09/22/1999	93905863.2	02/10/1993	ISSUED 9/22/99 Patent No. 0625883 Designating: FR DE IT NL ES GB. Annuities due 2/10. Expires 2/10/2013 On CPA 8/14/00.
	FRANCE	007040-000346	0625883	09/22/1999	93905863.2	02/10/1993	ISSUED; national stage of EP 0625883  Annuity due 2/10/01. Expires 2/10/2013
	GERMANY	007040-000347	0625883	09/22/1999	93905863.2	02/10/1993	ISSUED; national stage of EP 0625883  Annuity due 2/10/01. Expires 2/10/2013
	GREAT BRITAIN	007040-000351	0625883	09/22/1999	93905863.2	02/10/1993	ISSUED; national stage of EP 0625883  Annuity due 2/10/01. Expires 2/10/2013
	JAPAN	007040-000097			514269/93	02/10/1993	PENDING. Request for examination due 2/10/2000; instruction to associate to request exam 8/31/99; associate confirmed receipt 11/02/99.

<i>WENMM</i>	<i>Matter Description</i>	<i>Patent</i>	<i>Issue</i>	<i>Serial</i>	<i>Filing</i>	<i>Current Status</i>
<i>Case Number</i>	<i>Country</i>	<i>Matter Number</i>	<i>Number</i>	<i>Number</i>	<i>Date</i>	
	NETHERLANDS	007040-000349	0625883	93905863.2	02/10/1993	ISSUED; national stage of EP 0625883
						Annuity due 2/10/01. Expires 2/10/2013
LDMS-3 X885/X8856 LLY-015	JOHNSON, MASTROTOTARO					
	TECHNIQUES TO IMPROVE THE PERFORMANCE OF ELECTROCHEMICAL SENSORS					
	*U.S. - CON	007040-000024	5,411,647	08/187,121	01/25/1994	ISSUED. Second maint. fee due 11/2/2002; Final maint. fee due 11/2/2006. Expires 11/23/2012.
	CANADA	007040-000108		2,103,325	11/17/1993	PENDING. Request for examination due 11/17/2000; Published 5/24/94. Maintenance Fees due 11/17 annually.
	EUROPE	007040-000136		93309154.8	11/17/1993	PENDING. Notice of Oral Hearing rec'd; hearing date 12/20/00. Written submissions and/or amendments due by 11/20/00. See also Divisional app'n filed (3/15/99). Designating: Austria, Belgium, Switzerland, Germany, Denmark Spain, France, GB, Greece, Ireland, Italy, Liechtenstein, Luxembourg, Monaco, Netherlands, Portugal, Sweden
	EUROPE	007040-000319		99105287.9	11/17/1993	PENDING. This app'n. is a DIV of EP 93309154.8. Awaiting examination.
	JAPAN	007040-000098		293458/93	11/24/1993	PENDING. Request for examination due 11/24/2000. Published 9/2/94 under #242055/94. Exam requested 6/1/00



<i>WENMM</i> <i>Case Number</i>	<i>Matter Description</i> <i>Country</i>	<i>Matter Number</i>	<i>Patent</i> <i>Number</i>	<i>Issue</i> <i>Date</i>	<i>Serial</i> <i>Number</i>	<i>Filing</i> <i>Date</i>	<i>Current Status</i>
LDMs-4 X8386 LLY-030	MASTROTOTARO						
	APPARATUS AND METHOD FOR IMPLANTATION OF SENSORS						
	*U.S.	007040-000035	5,299,571	04/05/1994	08/008,611	01/22/1993	ISSUED. Maintenance Fees due 10/5/97; 10/5/2001; 10/5/2005. Expires
	CANADA	007040-000039			2,111,897	12/20/1993	PENDING. Disetronic instructed us to proceed with exam 11/29/00; associate authorized to proceed with annuity and request exam 11/29/00. Published 7/23/94. Maintenance Fees due 12/20 annually.
	EUROPE	007040-000051	0607682	09/29/1999	93310113.1	12/15/1993	ISSUED; annuities due; Expires 12/15/2013.
	FRANCE	007040-000330	0607682	09/29/1999	93310113.1	12/15/1993	ISSUED. Annuities due 12/15. National Stage of EP patent.
	GERMANY	007040-000329	0607682	09/29/1999	93310113.1	12/15/1993	ISSUED. Annuities due 12/15. National Stage of EP patent.
	GREAT BRITAIN	007040-000331	0607682	09/29/1999	93310113.1	12/15/1993	ISSUED. Annuities due 12/15. National Stage of EP patent.
	JAPAN	007040-000094			334718/93	12/28/1993	PENDING. Request for examination due 12/28/2000; reported 7/12/00; reminder 11/27/00; associate authorized to proceed 11/29/00.
	NETHERLANDS	007040-000333	0607682	09/29/1999	93310113.1	12/15/1993	ISSUED. Annuities due 12/15. National Stage of EP patent.
DMS-5 X7579 LLY-043	HELLER, LIPSON, JOHNSON						
	THIN FILM ELECTRICAL COMPONENT						
	*U.S.	007040-000134	5,108,819	04/28/1992	07/479,897	02/14/1990	ISSUED. Maintenance Fees due 10/28/95; 10/28/99; 10/28/2003. Expires 2/14/2010. 7 1/2 year maintenance fee paid 10/14/99 per Kari.

<i>WENMM</i> <i>Case Number</i>	<i>Matter Description</i>	<i>Country</i>	<i>Matter Number</i>	<i>Patent Number</i>	<i>Issue Date</i>	<i>Serial Number</i>	<i>Filing Date</i>	<i>Current Status</i>
		*U.S. - DIV	007040-000022	5,403,700	04/04/1995	07/823,798	01/22/1992	ISSUED. Maintenance Fees due 10/4/96; 10/4/2002; 10/4/2006.
		CANADA	007040-000054			2,036,241	02/13/1991	PENDING. Published 8/15/91. Requested examination 12/2/97. Maintenance Fees due 2/13 annually. Foreign Associate instructions sent 04/27/98.
		EUROPE	007040-000013	0442674	03/27/1996	91301057.5	02/11/1991	ISSUED. Designating: France, Germany, Italy, Netherlands, Spain, United Kingdom, Austria, Belgium, Denmark, Greece, Luxembourg, Sweden, Switzerland/Liech.
		FRANCE	007040-000144	0442674	03/27/1996		02/11/1991	ISSUED. Annuities due 2/11 each year. Expires 2/11/2011.
		GERMANY	007040-000141	0442674	03/27/1996		02/11/1991	ISSUED. Annuities due 2/11 each year. Expires 2/11/2011.
		JAPAN	007040-000093	305446	10/24/2000	042474/91	02/13/1991	PENDING. granted, issue fee and first 3 years' annuities due by 11/23/00; associate will pay fee automatically by 11/20/00.
		NETHERLANDS	007040-000149	0442674	03/27/1996		02/11/1991	ISSUED. Annuities due 2/11 each year. Expires 2/11/2011.
		UNITED KINGDOM	007040-000145	0442674	03/27/1996		02/11/1991	ISSUED. Annuities due 2/11 each year. Expires 2/11/2011.
DMS-6 X7831 LLY-044	JOHNSON							
	IMMOBILIZATION OF BIOMOLECULES BY ENHANCED ELECTROPHORETIC PRECIPITATION	*U.S.	007040-000132	5,166,063	11/24/1992	07/546,101	06/29/1990	ISSUED. Maintenance Fee due 5/24/2000; pay per client standing instruction. 3rd maint. fee due 5/24/2004. Expires 6/29/2010. 7 1/2 year Maintenance fee paid 5/2/00

<i>WENMM Case Number</i>	<i>Matter Description Country</i>	<i>Matter Number</i>	<i>Patent Number</i>	<i>Issue Date</i>	<i>Serial Number</i>	<i>Filing Date</i>	<i>Current Status</i>
	CANADA	007040-000075	2,045,200	05/30/2000	2,045,200	06/21/1991	ISSUED; expires 6/21/2011. Maintenance Fees due 6/21/01 and annually thereafter.
	EUROPE	007040-000078	0463859	05/17/1995	91305739.4	06/25/1991	ISSUED. Designating France, Germany, Italy, Netherlands, Spain and United Kingdom. ISSUED. Annuities due 6/21 annually. Expires 6/21/2001.
	FRANCE	007040-000154	0463859	05/17/1995			ISSUED. Annuities due 6/25 annually. Expires 6/25/2011.
	GERMANY	007040-000153	0463859	05/17/1995			ISSUED. Annuities due 6/25 annually. Expires 6/25/2011.
	JAPAN	007040-000071	3100422		158326/1991	06/28/1991	ISSUED. Patent sent to Lilly by associate 9/7/00. Published for 6 mo. oppr. period 10/16/00. Expires 6/28/2011. Annuities due beginning with 4th annuity due 8/18/2003. On CPA 10/00 per Kari.
	UNITED KINGDOM	007040-000155	0463859	05/17/1995	91308739.4	06/25/1991	ISSUED. Annuities due 6/25 annually. Expires 6/25/2011.

**PATENT**

**REEL: 012581 FRAME: 0217**

**RECORDED: 02/12/2002**