

4/16/08

Form PTO-1595 (Rev. 07/05)  
OMB No. 0651-0627 (exp. 6/30/2008)

U.S. DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

04-18-2008



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FINANCE SECTION

and documents on the new address(es) below.

To the Director of the U.S. Patent & Trademark Office

1. Name of conveying party(ies)

BSML, Inc.

Additional name(s) of conveying party(ies) attached?  Yes  No

3. Nature of conveyance/Execution Date(s):

Execution Date(s) February 1, 2008

- Assignment  Merger
- Security Agreement  Change of Name
- Joint Research Agreement
- Government Interest Assignment
- Executive Order 9424, Confirmatory License
- Other License

2. Name and address of receiving party(ies)

Name: Oraceutical, LLC

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

Street Address: 815 Pleasant St.

City: Lee

State: MA

Country: USA Zip: 01238

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

4. Application or patent number(s):

This document is being filed together with a new application.

A. Patent Application No.(s)

B. Patent No.(s)

6,331,292  
5,922,307  
6,488,914  
7,094,393

Additional numbers attached?  Yes  No

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

Name: David M. Quinlan

Internal Address: Suite 300

Street Address: 32 Nassau Street

City: Princeton

State: NJ Zip: 08542

Phone Number: 609 921 8660

Fax Number: 609 921 8651

Email Address: david@quinlanpc.com

6. Total number of applications and patents involved: 4

7. Total fee (37 CFR 1.21(h) & 3.41) \$ 160.00

- Authorized to be charged by credit card
- Authorized to be charged to deposit account
- Enclosed
- None required (government interest not affecting title)

8. Payment Information

a. Credit Card Last 4 Numbers \_\_\_\_\_  
Expiration Date \_\_\_\_\_

b. Deposit Account Number \_\_\_\_\_

Authorized User Name 00000065 6331292

9. Signature:

*David M. Quinlan*

Signature

Apr. 16, 2008

Date

David M. Quinlan  
Name of Person Signing

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

13

Documents to be recorded (including cover sheet) should be faxed to (571) 273-0140, or mailed to: Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

**ASSIGNMENT AND AMENDMENT  
OF PATENT LICENSE AGREEMENT**

This Assignment and Amendment, dated effective as of the date signed by both parties below, is between BSML, Inc., with its principal place of business at 460 N. Wiget Lane, Walnut Creek, CA 94598 ("Assignor"), and Oraceutical LLC, with its principal place of business at 815 Pleasant Street, Lee, MA 01238 ("Assignee"). Assignor (formerly known as BriteSmile, Inc.) is the licensee under that certain Patent License Agreement (the "License Agreement") between Assignor and BriteSmile Development, Inc., dated on or about December 29, 2005. Assignor and Assignee desire that Assignor's rights and obligations under the License Agreement be assigned to Assignee, on the terms and conditions set forth herein.

The parties hereby agree as follows:

1. Assignor hereby assigns and transfers all of its rights and licenses under the License Agreement to Assignee, and Assignee hereby accepts such assignment. Assignor further assigns to Assignee, and Assignee hereby agrees to assume, all responsibility and liability for Assignor's duties and obligations under the License Agreement, arising after the execution of this Assignment and Amendment. To the extent necessary, Assignor will cooperate with Assignee to execute such additional documents as may be reasonably required to establish that all rights and responsibilities under the License Agreement have been assigned to Assignee.
2. Pursuant to Section 10.5 of the License Agreement, BDI's consent to this Assignment is not required.
3. The parties agree that the License Agreement is hereby amended to replace all references therein to Assignor's name and address with Assignee's name and address.
4. All benefits of the License Agreement, including, but not limited to licensing fees and Recoveries (as defined in the Oraceutical APA), if any, shall inure solely to the benefit of the Assignee.

Except as amended hereby, all terms and conditions of the License Agreement shall remain in full force and effect.

BSML, Inc. ("Assignor")

Oraceutical LLC ("Assignee")

By:  \_\_\_\_\_

By: \_\_\_\_\_

Title: CEO \_\_\_\_\_

Title: \_\_\_\_\_

Date: 2/1/08 \_\_\_\_\_

Date: \_\_\_\_\_

**ASSIGNMENT AND AMENDMENT  
OF PATENT LICENSE AGREEMENT**

This Assignment and Amendment, dated effective as of the date signed by both parties below, is between BSML, Inc., with its principal place of business at 460 N. Wiget Lane, Walnut Creek, CA 94598 ("Assignor"), and Oraceutical LLC, with its principal place of business at 815 Pleasant Street, Lee, MA 01238 ("Assignee"). Assignor (formerly known as BriteSmile, Inc.) is the licensee under that certain Patent License Agreement (the "License Agreement") between Assignor and BriteSmile Development, Inc., dated on or about December 29, 2005. Assignor and Assignee desire that Assignor's rights and obligations under the License Agreement be assigned to Assignee, on the terms and conditions set forth herein.

The parties hereby agree as follows:

1. Assignor hereby assigns and transfers all of its rights and licenses under the License Agreement to Assignee, and Assignee hereby accepts such assignment. Assignor further assigns to Assignee, and Assignee hereby agrees to assume, all responsibility and liability for Assignor's duties and obligations under the License Agreement, arising after the execution of this Assignment and Amendment. To the extent necessary, Assignor will cooperate with Assignee to execute such additional documents as may be reasonably required to establish that all rights and responsibilities under the License Agreement have been assigned to Assignee.
2. Pursuant to Section 10.5 of the License Agreement, BDI's consent to this Assignment is not required.
3. The parties agree that the License Agreement is hereby amended to replace all references therein to Assignor's name and address with Assignee's name and address.
4. All benefits of the License Agreement, including, but not limited to licensing fees and Recoveries (as defined in the Oraceutical APA), if any, shall inure solely to the benefit of the Assignee.

Except as amended hereby, all terms and conditions of the License Agreement shall remain in full force and effect.

**BSML, Inc. ("Assignor")**

By: \_\_\_\_\_

Title: \_\_\_\_\_

Date: \_\_\_\_\_

**Oraceutical LLC ("Assignee")**

By:  \_\_\_\_\_

Title: MANAGER \_\_\_\_\_

Date: FEBRUARY 1, 2008 \_\_\_\_\_

**PATENT LICENSE AGREEMENT (BDI to BSML)**

This Agreement, effective as of the last date signed below (hereinafter, "Effective Date") is made by and between BRITESMILE DEVELOPMENT, INC., a Delaware corporation having an office and a place of business at 460 North Wiget Lane, Walnut Creek, California 94598 (hereinafter, "LICENSOR") and BRITESMILE, INC., a Utah corporation having an office and place of business at 460 North Wiget Lane, Walnut Creek, California 94598 (hereinafter "LICENSEE").

Whereas, LICENSOR owns certain patents and patent applications relating to human oral care and teeth whitening; and

Whereas, LICENSEE is desirous of obtaining an exclusive license to such patents and patent applications in selected fields of use.

**NOW, THEREFORE**, in consideration for the mutual promises and covenants contained herein, the Parties hereby agree as follows:

**1. DEFINITIONS**

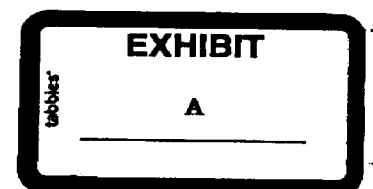
1.1 "LICENSEE" means BRITESMILE, INC. and all its divisions and subsidiaries in which it has an ownership or controlling interest of more than fifty percent (50%).

1.2 "Parties" means LICENSOR and LICENSEE. "Party" means LICENSOR or LICENSEE individually.

1.3 "Term of this Agreement" means the time from the Effective Date of this Agreement until either the termination or expiration of this Agreement, whichever occurs first, pursuant to Article 4 herein.

1.4 "Licensed Patents" means the patents and patent application listed in Appendix A of this Agreement including any patent applications, continuations, divisionals, foreign counterparts, reissues, or reexaminations corresponding thereto, together with any patents anywhere issuing from applications claiming priority to any patent or application listed on attached Appendix A or any application identified as a basis for priority by any patent or application listed on attached Appendix A.

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1.5 "Licensed Product" means any product that would otherwise infringe a claim of a BDI Licensed Patent absent a license hereunder.

1.6 "Licensed Service" means any procedure that would otherwise infringe a claim of a BDI Licensed Patent absent a license hereunder.

## 2. LICENSE

2.1 LICENSOR hereby grants to LICENSEE, an exclusive (even as to LICENSOR), world-wide, paid up, irrevocable license, with the right to sublicense, under the Licensed Patents to make, have made, use, offer for sale, and sell Licensed Products and Licensed Services in the "teeth whitening strip" field, including specifically LICENSEE's right to prosecute and enforce the Licensed Patents. Such grant includes LICENSEE's entitlement to all past, present and future damages and any other awards incident thereto and as a result of enforcement(s) by LICENSEE. It is understood that "teeth whitening strip" means any strip comprising one or more tooth whitening agents that is formed as a monolayer or a plurality of layers. A strip may include one or more of the following features:

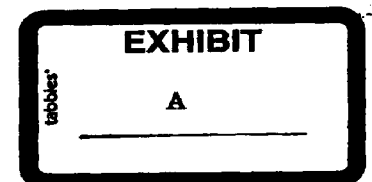
- i. One or more backing layers. The backing layers may be of any shape or size. The backing layers may be flat, curved, permanently deformable, flexible, dissolvable, erodible, textured, dimpled or perforated;
- ii. One or more tooth whitening composition layers; or
- iii. One or more webbings, meshes, or scrim.

## 3. LICENSE FEE

3.1 Ten dollars U.S. (\$10.00) and other good and value consideration.

## 4. TERM, TERMINATION, AND EXPIRATION

4.1 This Agreement shall become effective on the Effective Date and shall expire when the last of the Licensed Patents expires.



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**5. WARRANTY, LIABILITY, INDEMNITY**

5.1 LICENSOR warrants to LICENSEE that it has the authority to grant the licenses herein to LICENSEE.

5.2 THE PARTIES FURTHER AGREE THAT LICENSOR DOES NOT MAKE ANY REPRESENTATION OR WARRANTY OF ANY KIND WITH RESPECT TO THE ACCURACY, USEFULNESS, NOVELTY, VALIDITY, SCOPE, OR ENFORCEABILITY OF THE LICENSED PATENTS, LICENSED PRODUCTS, OR LICENSED SERVICES AND THAT LICENSOR EXPRESSLY DISCLAIMS ANY IMPLIED WARRANTY OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE WITH RESPECT TO THE LICENSED PATENTS.

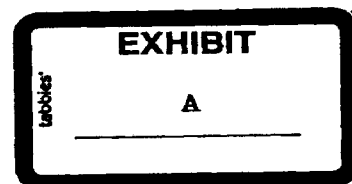
5.3 In no event shall one Party be liable to the other Party for any incidental or consequential damages relating to or arising out of this Agreement.

5.4 LICENSEE, its successors and assigns, shall defend, indemnify and hold LICENSOR harmless from any claim, demand, lawsuit, loss, cost, expense, obligation, liability, action, proceeding, agreement, contract, judgment, or debt (including court costs and reasonable fees of attorneys and other professionals) of any nature whatsoever, whether or not well founded in fact or in law, whether in law or equity or otherwise, in connection with or related to use of the Licensed Patents by LICENSEE, its customers, sub-contractors, agents, or employees (collectively, "LICENSEE's Representatives") or in connection with or related to LICENSEE's or LICENSEE's Representatives' manufacture, use, sale or service of any Licensed Product or Licensed Services.

5.5 LICENSEE, its successors and assigns, shall have no recourse against LICENSOR, whether by way of any suit, demand, proceeding, claim, or action, whether in law or equity or otherwise, for any loss, liability, damage, expense, debt, judgment, or cost that LICENSEE may suffer or incur at any time, in connection with or related to use by LICENSEE or LICENSEE's Representatives of the Licensed Patents or LICENSEE's or LICENSEE's Representatives' manufacture, use, sale or service of Licensed Products or Licensed Services.

5.6 Nothing in this Agreement, or otherwise, shall be construed as:

5.6.1 granting LICENSEE any right or license under any LICENSOR patent other than those specifically identified as Licensed Patents as set forth herein; or



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5.6.2 a warranty or representation by either Party that any manufacture, sale, lease, or use of any tangible or intangible property covered under this Agreement will be free from infringement of any patents, except for Licensed Patents and only to the extent set forth herein; or

5.6.3 requiring either Party to defend, enforce, or otherwise assert any intellectual property right or other cause of action against a third party; or

5.6.4 conferring to anyone by implication, estoppel, or otherwise any license or other right under any patent, except as expressly provided herein; or

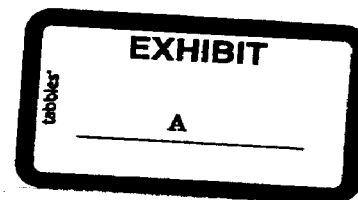
5.6.5 conferring to anyone any right to use in any way, any of LICENSOR's trademarks or trade names or any contraction, abbreviation, or simulation thereof.

## 6. ENFORCEMENT OF PATENTS

6.1 LICENSEE shall have the sole discretion to decide whether to assert the Licensed Patents within the scope of rights granted to LICENSEE under this Agreement. Any assertion or defense of the Licensed Patents shall be at LICENSEE's sole expense and under LICENSEE's control. LICENSEE shall regularly keep LICENSOR informed as to the activity related to any enforcement efforts. If LICENSEE asserts or defends any of the Licensed Patents for any reason, LICENSEE shall be entitled to retain all damages, attorney fees, and other costs awarded in its favor as a result of such assertion or defense. LICENSOR agrees to voluntarily join, to the extent necessary, at LICENSEE's request any enforcement proceeding pursued by LICENSEE. In that event, LICENSEE shall reimburse LICENSOR its reasonable costs incurred incident to joining any enforcement proceeding brought by LICENSEE.

## 7. CHOICE OF LAW

7.1 This Agreement shall be governed by the laws of the State of Illinois, USA, without regard to the conflicts of law principles of such State.



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**8. CONTACT POINTS FOR NOTICES AND PAYMENTS**

8.1 Any notice, request, demand, waiver, consent, approval, or other communication not listed in Section 8.2 herein which is required or permitted to be given by a Party hereunder shall be given in writing and addressed to the appropriate Party at its address set forth below, or transmitted by facsimile:

If to LICENSEE, to:

**Nhat H. Ngo  
BRITESMILE, INC.  
460 North Wiget Lane  
Walnut Creek, CA 94598  
FAX: (925) 941-6266**

**Anthony M. Pilaro  
BRITESMILE INTERNATIONAL  
36 Fitzwilliam Place  
Dublin 2, Ireland  
353-1-661-4433  
FAX: 353-1-661-4162**

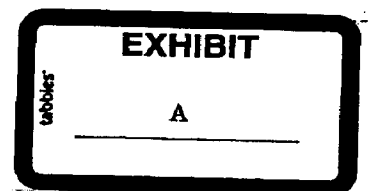
with copy to:

**Timothy J. Haller  
Niro, Scavone, Haller & Niro  
181 West Madison Street  
Suite 4600  
Chicago, IL 60602  
FAX: (312) 236-1471**

If to LICENSOR, to:

**Nhat H. Ngo  
BRITESMILE, INC.  
460 North Wiget Lane  
Walnut Creek, CA 94598  
FAX: (925) 941-6266**

**Anthony M. Pilaro  
BRITESMILE, INC.  
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Anthony M. Pilaro  
BRITESMILE, INC.  
Chalet San Antonio  
Gstaad, Switzerland 3780  
011 41 33 744 7282

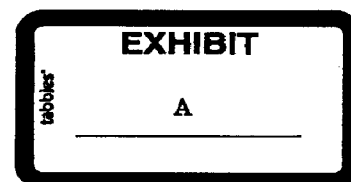
with copy to:

Timothy J. Haller  
NIRO, SCAVONE, HALLER & NIRO  
181 West Madison Street, Suite 4600  
Chicago, IL 60602  
FAX: (312) 236-1471

**9. DISPUTE RESOLUTION (negotiation, mediation, arbitration)**

9.1 The Parties shall attempt in good faith to resolve any dispute of whatever nature arising out of the making or performance of, or otherwise relating to this Agreement or the breach, termination, enforceability, arbitrability or validity thereof (hereinafter, "Dispute"), promptly by negotiations between the Parties in the normal course of business. If such good faith attempts do not resolve the Dispute, either Party may give the other party written notice of any such Dispute and request formal negotiations between the Parties. Such written notice shall be sent to the other Party via the applicable Contact Points identified in Article B of this Agreement and shall include the specific provision(s) of this Agreement involved in such Dispute, any facts or arguments in support of the matter, and a specific description of the relief or remedy sought. Within thirty (30) days from the date of mailing of such written notice, representatives of both Parties, having the authority to settle the Dispute, shall agree to meet at a mutually acceptable time and place, and thereafter as often as they reasonably deem necessary, to

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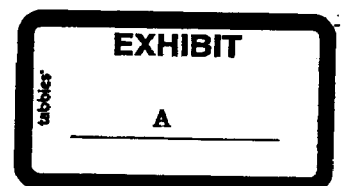


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attempt to resolve the Dispute. If the Dispute has not been resolved within sixty (60) days from the date of mailing of such written notice or a mutually agreed upon extension thereof, or if the Parties fail to meet within such thirty (30) days or a mutually agreed upon extension thereof, the Parties shall initiate mediation of the Dispute pursuant to Section 9.2 herein. All negotiations pursuant to this Section 9.1 are deemed confidential and shall be treated as compromise and settlement negotiations for the purposes of Rule 408 of the Federal Rules of Evidence and any comparable law provision. Either Party may seek a preliminary injunction, attachment or other similar remedy available to it pending the outcome of negotiation, mediation, or arbitration hereunder, or a suit to compel compliance with this Article 9 dispute resolution process, in a U.S. court of competent jurisdiction.

9.2 Each Party shall provide the other Party with a written offer of terms of settlement that are acceptable as a minimum, if the Parties are still unable to resolve such Dispute by negotiation within the time limits set by Section 9.1. The Parties shall, within thirty (30) days thereafter, select a mediator and begin a good faith attempt to settle the Dispute by mediation, to be conducted at their joint cost. Unless the parties agree otherwise, the mediation shall be conducted in accordance with the Commercial Mediation Rules of the American Arbitration Association ("AAA") then in effect by a mediator selected by mutual agreement of the Parties. If the Parties are unable to agree on a mediator within such thirty (30) days, or a mutually agreed extension thereof, the mediator will be selected by the AAA. Within thirty (30) days after the mediator has been selected, both Parties and their respective attorneys shall meet with the mediator for one mediation session of at least four hours, it being agreed that each Party representative attending such mediation session shall be senior to the representatives designated in Section 9.1 herein, with the authority to settle the Dispute. If the Dispute cannot be settled at such mediation session or at any mutually agreed continuation thereof, either Party may give the other Party and the mediator a written notice declaring the mediation process at an end, in which event the Dispute shall be resolved by arbitration as provided in Section 9.3 herein.

9.3 Upon completion of mediation pursuant to Section 9.2 herein, if no resolution of the Dispute has been reached, the Parties shall, within thirty (30) days thereafter, select an arbitrator and begin arbitration proceedings to be conducted in Chicago, Illinois. Unless the parties agree otherwise, the arbitration shall be conducted in accordance with the applicable Arbitration Rules of the American Arbitration Association (AAA) then in effect, by a single arbitrator selected by mutual agreement of the Parties. If the Parties are unable to agree on an arbitrator within such thirty (30) days, or a mutually agreed extension



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thereof, the arbitrator will be selected by the AAA. The arbitrator shall be an attorney-at-law having at least ten (10) years experience in handling patent license disputes similar to the Dispute hereunder, shall complete arbitration proceedings within ninety (90) days after appointment, shall provide a written opinion of any decision, and shall base such decision on the terms of this Agreement and on applicable law and judicial precedent. The arbitrator may award applicable interest on any monetary damages. Each party shall be responsible for its respective attorney's fees and costs with the fees for arbitration and fees for a mediator and/or arbitrator being apportioned equally to each party. The findings of the arbitrator shall be final, binding, and enforceable as between the Parties and judgment on any award rendered by the arbitrator may be entered in any court having jurisdiction thereof. The Parties agree to submit to the jurisdiction of the State of Illinois for purposes of implementing this Article 9 including without limitation the enforcement of any award obtained through the arbitration proceedings of Section 9.3.

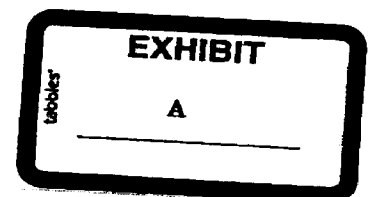
## 10. GENERAL PROVISIONS

10.1 This Agreement represents the entire understanding between the Parties about the subject matter contained herein and supersedes all prior oral and/or written agreements, communications, and documents between the Parties with respect thereto.

10.2 No amendment or modification of this Agreement shall be valid or binding upon the Parties unless made in a writing specifically identifying this Agreement and executed by authorized representatives of both Parties.

10.3 Any failure of either Party to exercise a right granted by the terms or conditions of this Agreement shall not be construed as a waiver of such right or of any other rights under this Agreement by that Party and shall in no way effect that Party's exercise of such right or any other rights under this Agreement at a later date. No term or provision hereof shall be deemed waived and no breach consented to unless such waiver or consent shall be in writing and signed by the party claimed to have waived or consented.

10.4 The provisions of this agreement shall be deemed separable. If any provision of this Agreement shall be adjudged wholly or partially invalid, illegal, unenforceable or void by an arbitrator appointed under Article 9 or a court or tribunal of competent jurisdiction, such provision shall be deemed modified to the extent necessary to make it valid, legal, enforceable, or not void, if such



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modification does not materially alter the intention of the Parties or substantially impair the value of this Agreement as to any Party. If such provision cannot be so modified, such provision shall be stricken from this Agreement and the validity, legality, and enforceability of the remaining provisions or parts thereof shall not in any way be affected or impaired.

10.5 LICENSEE shall have the right to assign, sell, or otherwise transfer any right or benefit hereunder without the consent of LICENSOR.

10.6 LICENSOR shall the right to assign, sell, or otherwise transfer any right or benefit hereunder without the consent of LICENSEE.

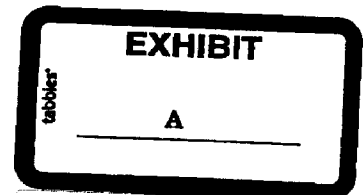
BY SIGNING BELOW, the Parties have executed this Agreement by their duly authorized representatives, effective as of the last date signed below.

**BRITESMILE DEVELOPMENT, INC.**

By: \_\_\_\_\_  
Typed Name: \_\_\_\_\_  
Title: \_\_\_\_\_  
Date: \_\_\_\_\_

**BRITESMILE, INC.**

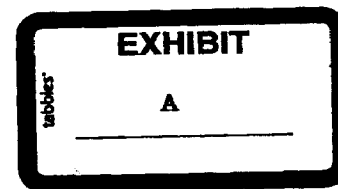
By: [Signature]  
Typed Name: \_\_\_\_\_  
Title: [Signature]  
Date: \_\_\_\_\_



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APPENDIX A

Country	Status	Application Number	Publication Number	Patent Number	Title
U.S.	Granted	09/192609		6331292	Tooth Bleaching Compositions
U.S.	Granted	09/719569		5922307	Tooth Bleaching Compositions
U.S.	Granted	10/003210	02-064564	6488914	Tooth Bleaching Compositions
U.S.	Monitored	10/219,965	03-089886		Tooth Bleaching Compositions



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