

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT3856755

SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNMENT		
CONVEYING PARTY DATA			
Name			Execution Date
N.V. NUTRICIA			03/01/2016
RECEIVING PARTY DATA			
Name:	AJINOMOTO CO., INC.		
Street Address:	15-1, KYOBASHI IT-CHOME, CHUO-KU		
City:	TOKYO		
State/Country:	JAPAN		
Postal Code:	104-8315		
PROPERTY NUMBERS Total: 1			
Property Type	Number		
Patent Number:	7288570		
CORRESPONDENCE DATA			
Fax Number:	(671)720-9601		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
Phone:	6177209640		
Email:	jiwanicki@bannerwitcoff.com, itocci@bannerwitcoff.com, bwptopat@bannerwitcoff.com		
Correspondent Name:	JOHN P. IWANICKI - BANNER & WITCOFF, LTD		
Address Line 1:	28 STATE STREET		
Address Line 2:	SUITE 1800		
Address Line 4:	BOSTON, MASSACHUSETTS 02109		
ATTORNEY DOCKET NUMBER:	005032.00026		
NAME OF SUBMITTER:	JOHN P. IWANICKI		
SIGNATURE:	/John P. Iwanicki/		
DATE SIGNED:	05/03/2016		
Total Attachments: 8			
source=Patent Assignment_Nutricia to Ajinomoto#page1.tif			
source=Patent Assignment_Nutricia to Ajinomoto#page2.tif			
source=Patent Assignment_Nutricia to Ajinomoto#page3.tif			
source=Patent Assignment_Nutricia to Ajinomoto#page4.tif			

source=Patent Assignment_Nutricia to Ajinomoto#page5.tif

source=Patent Assignment_Nutricia to Ajinomoto#page6.tif

source=Patent Assignment_Nutricia to Ajinomoto#page7.tif

source=Patent Assignment_Nutricia to Ajinomoto#page8.tif

PATENT ASSIGNMENT AGREEMENT

deleted twelve letters, inserted ten letters

March 14th,

This patent assignment agreement (hereinafter "Agreement"), as of ~~February 1st~~, 2016 (hereinafter "Effective Date"), is made effective by and between

Ajinomoto Co., Inc., a company organised and existing under the laws of Japan, having its registered office at 15-1, Kyobashi, It-chome, Chuo-ku, Tokyo 104-8315, Japan, represented by *Hiroshi Fukushi, General Manager, Health & Wellness Business Dept.*, hereinafter referred to as the "Ajinomoto"

and

N.V. Nutricia, a company organised and existing under the laws of The Netherlands, having its principal office at Eerste Stationstraat 186, 2712 HM Zoetermeer, The Netherlands, Legally represented by F.G.J. te Hennepe, Global Director Patent Platform, hereinafter referred to as "Nutricia".

The foregoing entities are solely referred to individually as a "Party" and collectively as the "Parties".

RECITALS

- A. **WHEREAS** N.V. Nutricia, holds a US patent with reference code US7,288,570 ("Patent Right");
- B. **WHEREAS** Ajinomoto wishes to acquire the entire rights, title and interest in and to the Patent Right;

NOW, THEREFORE THE PARTIES AGREE AS FOLLOWS:**Article 1 ASSIGNMENT**

- 1.1 By signing this Agreement, Nutricia hereby irrevocably assigns to Ajinomoto, and Ajinomoto hereby accepts, all rights, title, and interest in and to the Patent Right as per the Effective Date.
- 1.2 Notwithstanding article 1.1 Effective as of the Effective Date Ajinomoto agrees to grant and Nutricia hereby accepts a royalty free, irrevocable, sub-licensable, (limited to Nutricia's Affiliates), license under the Patent Right permitting Nutricia and its Affiliates to make, have made, use, offer for sale, and sell products and services covered by the Patent Rights.

- 1.3 If requested by Nutricia, Ajinomoto shall register the license as described under Article 1.2 at the USPTO, such at Nutricia's expenses. Ajinomoto will provide its support as to all the necessary actions needed to register the license.
- 1.4 As of the Effective Date and thereafter until this Agreement expires or is otherwise terminated earlier, Ajinomoto shall be responsible for the prosecution and maintenance of such Patent Right, including any and all costs related thereto, for example but not limited to costs related to the registration of the assignment at the USPTO.
- 1.5 It is hereby confirmed that Ajinomoto may grant a right and license to use the Patent Right, with the right to sublicense, to its Affiliates. Ajinomoto may grant a right or a license to third parties with a prior to written notice to Nutricia as per clause 6.1 below.
- 1.6 Ajinomoto shall not transfer the Patent Right to any third party, without the prior written consent of Nutricia.
- 1.7 The "Effective Date" of this Agreement is the date first above written.
- 1.8 For the purpose of this Agreement,
- a. "Affiliate" means any company, which controls, controlled by, or under common control with a party. A party shall be regarded as in control of another company, for the purpose of this Agreement, if it owns or directly or indirectly controls more than fifty percent (50%) of the voting share capital of said other company or, in the absence of ownership of more than fifty percent (50%) of the voting share capital of the company, if it has the power to control the composition or activities of the said other company's board of directors,
 - b. "Licensee" means an Ajinomoto's Affiliate and/or a third party who is granted a right and license to use the Patent Right as shown in Article 1.3 above.
 - c. "Net Sales" means the gross invoice price invoiced by Ajinomoto or Licensee, less (i) discounts including but not limited to cash discounts, trade discounts, quantity discounts, sales rebates and allowances, (ii) accepted returns and buybacks from Ajinomoto's or Licensee's customers, (iii) excise or other sales taxes to the extent that they are included in the gross invoice price, and (iv) sales reduction due to uncollectable receivables,
 - d. "Agreement Term" means the term from the Effective Date as to December 20, 2022,
 - e. "Products" means nutritional food product, including but not limited to meal replacer, food supplement, and medical food, the sale of which in the Territory, but for the assignment herein, would infringe the granted claims of the Patent Right,
 - f. "Territory" means the United States.

Article 2 CONSIDERATION AND AUDITING

- 2.1 Ajinomoto shall pay Nutricia a non-refundable one-time fee of thirty thousand (30.000) USD ("Initial Fee") within sixty (60) days after the Effective Date.
- 2.2 Furthermore, each time the cumulative Net Sales (i.e. not annual sales) of the Products sold by Ajinomoto and any of its Licensees in the Territory reaches 1.5 million USD or the multiples thereof (i.e. 3 million USD, 4.5 million USD and more) during the Patent Term ("Milestone Event"), Ajinomoto will pay Nutricia a milestone payment of fifty thousand (50,000) USD ("Milestone"), which is considered to be equivalent to three and three tenths percent (3.3%) on the incremented Net Sales of the Products from the commencement of the sales of the

Product, or from the immediately preceding Milestone Event, which is 1.5 million USD each. For the avoidance of doubt, with respect to each of the Milestone Event, the Milestone will be paid only once.

- 2.3 For the avoidance of doubt, any kind of "Withholding tax" applicable will be on the account of Ajinomoto.
- 2.4 Ajinomoto shall make the payment of each Milestone within forty-five (45) days after receipt by Ajinomoto of the written request for the payment thereof from Nutricia. Nutricia Research BV shall be the beneficiary entity on behalf of NV Nutricia. Ajinomoto shall make such payment by remittance to the bank account as follows ("Bank Account"):

Name of the bank account holder	Nutricia Research BV
Name of the bank	ING Bank Amsterdam
City/County related to the bank	Amsterdam The Netherlands
IBAN Number	NL91INGB0655076824
Swift Code	INGBNL2A

- 2.5 Without any undue delay, upon closure of each calendar year, Ajinomoto shall provide Nutricia with a written statement prepared in accordance with generally accepted accounting principles and setting forth the amount of Net Sales of the Product sold by Ajinomoto or any of Licensees in the calendar year, and the occurrence of Milestone Event, if any ("Sales Reports"), during the Patent Term.
- 2.6 Sales Reports to be send by registered letter with acknowledgement of receipt to
Nutricia Research BV
Attn. Finance Department
Uppsalalaan 12,
3584 CT Utrecht
The Netherlands
- 2.7 Ajinomoto shall prepare complete and accurate accounting records in accordance with generally accepted accounting principles in sufficient detail to enable any Milestone which shall have accrued hereunder to be determined, and shall maintain and keep the same for three (3) years thereafter. The provision of this Article 2.5 shall survive the expiration of this Agreement for three (3) years.
- 2.8 Upon the request of Nutricia, Ajinomoto shall permit an independent accountant, selected by Nutricia, and reasonably acceptable to Ajinomoto, to have access during normal business hours to all such accounting records of Ajinomoto prepared for the previous three (3) years as may be necessary to verify the accuracy of the Sales Reports and payments submitted to Nutricia ("Audit").
- 2.9 Any of the Audit shall be at the expense of Nutricia, except that if any such Audit reveals a deficiency in Milestone actually paid to Nutricia hereunder in any year of ten percent (10%) or more of the amount of the Milestone actually due to Nutricia hereunder, then the expense of such Audit plus any shortfall amounts shall be refunded to Nutricia *mutatis mutandis* to Article 2.3.
- 2.10 If such audit reveals a surplus in Milestone actually paid to Nutricia by Ajinomoto, Nutricia shall refund to Ajinomoto the surplus amount within ninety (90) days after such audit.

Article 3 REPRESENTATIONS AND WARRANTIES

- 3.1 Each Party represents and warrants to the other Party that it has the full right, power and authority to enter into this Agreement.
- 3.2 Nutricia represents to Ajinomoto that it owns full legal and equitable title to the Patent Right and that no third party has any ownership interest in or any license to the Patent Right.
- 3.3 Except as otherwise provided in this Agreement, the Patent Right are provided "as is" with no warranties or representations of any kind, and Nutricia expressly disclaims all other warranties or representations, express or implied, including, but not limited to, the implied warranties of merchantability, non-infringement or fitness for a particular purpose, or that the use of the Patent Right will not infringe any patent or other rights.
- 3.4 Nutricia agrees to defend, indemnify and holds harmless Ajinomoto from direct damages solely that Ajinomoto may incur arising out of breach of the warranty made by Nutricia in Article 3.2 of this Agreement. Such direct damages capped at a maximum of the milestone payment paid by Ajinomoto as a result of Article 2.2 of the present Agreement.

Article 4 PATENT MAINTENANCE AND INFRINGEMENT

- 4.1 Nutricia shall cooperate fully in the assignment of the Patent Right and shall execute all papers and instruments or requiring Affiliates of Nutricia to execute such papers and instruments so as to enable Ajinomoto to prosecute and to maintain the Patent Right in its own name.
- 4.2 Each party shall provide to the other prompt notice as to all matters which come to its attention and which may affect the prosecution or maintenance of any such Patent Rights or patents, if necessary.
- 4.3 Ajinomoto shall have the right to bring and control any action or proceeding with respect to infringement or enforcement of the Patent Rights. Such at its own expense. In case Nutricia is requested to provide support, Ajinomoto agrees that it shall pay Nutricia its standard labor rates, costs and other expenses as necessary for Nutricia staff to support Ajinomoto's enforcement of the Patent Rights. For the avoidance of doubt Nutricia may at its sole discretion decide whether or not to provide its support.

Article 5 CONFIDENTIALITY

- 5.1 The Parties will keep the existence, nature and content of this Agreement confidential. The obligation of such confidentiality shall survive any termination or expiration of this Agreement for three (3) years.

Article 6 NOTICES

- 6.1 Written notices required to be given under this Agreement shall be addressed as follows:

N.V. Nutricia

Attn. Head of the Patent Department
p/a P.O. Box 80141
3508 TC Utrecht

Ajinomoto

Attn. General Manager, Health&Wellness Business Dept.
15-1, Kyobashi It-chome, Chuo-ku, Tokyo 104-8315, Japan

Article 7 MISCELLANEOUS

- 7.1 **Term:** This Agreement shall take effect from the Effective Date and terminates December 20, 2022. However in the event the Patent Right becomes unenforceable by being revoked by court decision or by reexamination proceedings of the USPTO this Agreement may be terminated by Ajinomoto. In this case, Ajinomoto will notify Nutricia of its decision by registered letter with acknowledgement of receipt. Termination of the Agreement will take effect immediately on the date of receipt of the said notification. Within one (1) month after the aforementioned date of receipt of the notification, Ajinomoto will deliver to Nutricia a written report including accurate accounting records, as per article 2.6. Ajinomoto will be bound to pay the fees as described in article 2.2 up to and including the date of termination.
- 7.2 **Incorporation of Recitals:** The foregoing recitals constitute an integral part of this Agreement and are incorporated herein by this reference with the same force and effect as if set forth herein as agreements of the Parties.
- 7.3 **Force Majeure:** Neither Nutricia nor Ajinomoto shall be considered in default in the performance of its respective obligations hereunder if such performance is prevented or delayed as a result of war, hostilities, revolution, civil commotion, strike, epidemic, accident, fire, wind, flood or because of any law, order, proclamation, regulation or ordinance, or any act of God or any other similar cause beyond the reasonable control of the Party affected (hereinafter referred to as "Force Majeure"). If a Party is prevented from fulfilling its contractual obligations by Force Majeure, the Parties shall consult with each other regarding the compliance with and implementation of this Agreement. Each party shall have up to six (6) months to recover from the Force Majeure, after which either Party may terminate this Agreement.
- 7.4 **Entire Agreement:** This Agreement constitutes the entire agreement between the Parties relating to the subject hereof and supersedes all prior agreements and understandings, written and/or oral, between the Parties with respect to such subject matter. In case of any discrepancy between this Agreement and any of its exhibits, this Agreement shall prevail. Nothing in this Agreement shall be construed as a grant of any license not stipulated herein, and neither Party shall by means of this Agreement be obligated to enter into any further discussions or agreement, unless explicitly set out herein.
- 7.5 **Partial Cancellation/Severability:** The Parties hereto agree that should any provision of this Agreement be invalid or unenforceable, then the Parties shall forthwith enter into good faith negotiations in order to amend such provision in such a way that, as amended, it is valid and enforceable and to the maximum extent possible reflects the original intent of the Parties in entering into this Agreement as to the provision or provisions in question. However the invalidity or unenforceability of any particular provision in this Agreement shall not affect any

other provision therein. This Agreement shall be construed in all respects as if such invalid or unenforceable provision were omitted.


- 7.6 **Amendment/Modification/Waiver:** No amendment, modification, or waiver of or addition to any condition, provision or term of this Agreement shall be valid or of any effect unless made in writing, specifying with particularity the nature and extent of such amendment, modification, waiver or addition, and signed by the Parties to be bound. No omission or delay on the part of either Party hereto in exercising its rights hereunder or in requiring due and punctual fulfillment by the other Party hereto of the obligations of such other Party as set forth in this Agreement shall be deemed to constitute a waiver of any remedy it might have hereunder. No waiver by either Party hereto of any breach or default by the other Party shall operate as a waiver of any other default or breach by such other Party.
- 7.7 **Rights of assignees:** This Agreement shall inure to the benefit of and be binding on the Parties and their respective successors, assignees and Affiliates.
- 7.8 **No Partnership:** Nothing in this Agreement shall be construed as creating a partnership, contract of employment or relationship of principal and agent between the Parties.
- 7.9 **Meaning of Headings:** The headings of articles of this Agreement are to facilitate reference only, do not form a part of this Agreement, and shall not in any way affect or be considered in the interpretation thereof.
- 7.10 **Language:** Each document, notice or other communication referred to herein or to be given in connection herewith shall be in the English language which language shall govern this Agreement between the Parties

Article 8 DISPUTE RESOLUTION AND GOVERNING LAW

- 8.1 Any dispute, controversy or claim arising out of or in connection with this Agreement which the Parties fail to settle amicably shall be settled by arbitration in Amsterdam, Netherlands, if requested by Ajinomoto, and in Tokyo, Japan, if requested by Nutricia, in accordance with the Rules of the International Chamber of Commerce. The award thus rendered shall be final and binding upon both Parties.
- 8.2 This Agreement shall be interpreted and governed by Dutch Law.


IN WITNESS WHEREOF, the Parties hereto have caused this Agreement to be executed in duplicate originals by their duly legally authorized representatives.

Ajinomoto Co., Inc.


Hiroshi Fubeshi

Name:

~~Shinji Suzuki~~

deleted twelve letters, inserted fourteen letters 

Title:

General Manager, Health&Wellness Business Dept.

Place:

Tokyo, Japan

Date:

25.03.2016

**NUTRICIA
RESEARCH**



N.V. Nutricia

A large, stylized handwritten signature in black ink, likely belonging to F.G.J. te Hennepe.

Name: F.G.J. te Hennepe

Title: Global Director Patent Platform

Place: Utrecht, The Netherlands

Date: 7.03.2016

For seen and approved

Nutricia Research B.V

A stylized handwritten signature in black ink, likely belonging to J.J. Cappon.

Name: J.J. Cappon PhD

Title: VP R&D Advanced Medical Nutrition

Place: Utrecht, The Netherlands

Date: 18.02.2016