

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT4765575

SUBMISSION TYPE:	NEW ASSIGNMENT	
NATURE OF CONVEYANCE:	LICENSE	
CONVEYING PARTY DATA		
Name		Execution Date
EYETALK365 LLC		10/19/2017
RECEIVING PARTY DATA		
Name:	SKYBELL TECHNOLOGIES, INC.	
Street Address:	1 JENNER	
Internal Address:	SUITE 100	
City:	IRVINE	
State/Country:	CALIFORNIA	
Postal Code:	92618	
PROPERTY NUMBERS Total: 22		
Property Type	Number	
Patent Number:	8139098	
Patent Number:	7193644	
Patent Number:	8144183	
Patent Number:	8144184	
Patent Number:	8154581	
Patent Number:	8164614	
Patent Number:	9432638	
Patent Number:	9414030	
Patent Number:	9485478	
Patent Number:	9516284	
Patent Number:	9635323	
Patent Number:	9706178	
Patent Number:	9648290	
Patent Number:	9554090	
Application Number:	11929449	
Application Number:	11929457	
Application Number:	11929460	
Application Number:	15238393	
Application Number:	15238228	

PATENT

Property Type	Number
Application Number:	15237933
Application Number:	15237797
Application Number:	15237222

CORRESPONDENCE DATA

Fax Number:
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.

Phone: 651-428-9828
Email: wes@schwielaw.com
Correspondent Name: WES SCHWIE
Address Line 1: 1211 LAGOON AVE
Address Line 2: #202
Address Line 4: MINNEAPOLIS, MINNESOTA 55408

ATTORNEY DOCKET NUMBER:	SKYBELL.061L
NAME OF SUBMITTER:	WESLEY EDWARD SCHWIE
SIGNATURE:	/Wesley Edward Schwie/
DATE SIGNED:	01/08/2018
	This document serves as an Oath/Declaration (37 CFR 1.63).

Total Attachments: 13
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LICENSE AGREEMENT

This LICENSE AGREEMENT ("Agreement") is made and entered into as of the Effective Date, defined herein, by and among Eyetalk365, LLC ("Eyetalk"), a for profit limited liability corporation organized under the laws of North Carolina having its principal office at 9923 Willow Leaf Lane, Cornelius, NC 28031 and SkyBell Technologies, Inc. ("SkyBell"), a California corporation, having an office at 1 Jenner, Suite 100, Irvine, California 92618.

RECITALS

WHEREAS, Eyetalk is the owner to all rights, title, and interests to the Licensed Patents;

WHEREAS, SkyBell is interested in taking a license to the Licensed Patents;

WHEREAS, Eyetalk and SkyBell desire to enter into a mutually beneficial licensing agreement related to the Eyetalk Portfolio; and

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:

AGREEMENT

1. Definitions.

- a) **"Effective Date"** The Agreement is entered into and is effective as of the date that the last Party executes it.
- b) **"Affiliate"** of an Entity shall mean any and all Entities, past, present, or future, that are or were (1) Controlled by, directly or indirectly, the Entity, (2) under common Control, directly or indirectly, with the Entity, or (3) Controlling, directly or indirectly, the Entity.
- c) **"Control"** (including, with correlative meanings, "Controlled By" and "Controlling") means the power to direct or cause the direction of the management and policies, directly or indirectly, through ownership of voting securities, it being understood and agreed that with respect to a corporation, limited liability company, partnership, or other entity, "Control" will include direct ownership of at least fifty percent (50%) of the voting stock, limited liability company interest, partnership interest, or other voting interest (or equivalent interest) in any such corporation, limited liability company, partnership, or other entity.
- d) **"Dispose"** and its cognates (including "Disposed" and "Disposal") means make, have made, use, sell, offer to sell, import, export, distribute, offer to lease, lease, license, offer to license, transfer, copy, distribute, perform, or otherwise exploit or dispose of by an entity, and the exercise of all other activities giving rise to relief enumerated



under Title 35 of the United States Code and counterparts thereto (as the foregoing may be amended or superseded at any time and from time to time).

- e) **"Entity"** shall mean a corporation, association, partnership, business trust, joint venture, limited liability company, proprietorship, unincorporated association, individual, or other entity that can exercise legal standing.
- f) **"Including"** means including, without limitation.
- g) **"Patents"** shall mean (1) all classes or types of domestic or foreign patents, including utility patents, utility models, design patents, invention certificates, reexaminations, reissues, reviews, extensions, and renewals; (2) all applications (including provisional and non-provisional applications), continuations, divisionals, continuations-in-part, and rights to inventions for which applications may be filed in the United States or any other country; and (3) any and all patents and patent applications that, in whole or in part, claim priority to, or the benefit of the filing date of, any of the patents or patent applications described in (1) or (2) of this definition, including any and all child, continuation, continuation-in-part, continuing prosecution, divisional, provisional, non-provisional, reissue, reexamination, substitution, extension and counterpart patents and patent applications of any of the patents or patents applications described in (1) or (2) of this definition.
- h) **"Licensed Patents"** shall mean (1) all past, present, and future Patents that have been, are presently, or will be owned, under obligation to assign, or exclusively licensed by Eyetalk, any of its past, current, or future Affiliates, or any acquirer of Eyetalk or Eyetalk's assets (including but not limited to the Patents and applications identified in Schedule 1) and (2) all Patents that, in whole or in part, claim priority to, or claim the benefit of, the filing date of any Patent described in (1) hereinabove (or the filing date of any other Patent to which any of the foregoing Patents directly or indirectly claims priority).
- i) **"Licensed Products"** shall mean any past, present, or future apparatus, method, process, system, data, content, material, functionality, product, equipment, or service Disposed of by SkyBell or its Affiliates or that are incorporated, integrated, or Disposed of by a third party whether such Disposition is on a stand-alone basis as a single point solution, or as part of that third party's proprietary system or service offering, but excludes any portions of such third party's system or service offering that are not provided or Disposed of by SkyBell or its Affiliates, including, but not limited to, monitoring, security systems, security system integrators, archival, and other services. For example, if products are provided by SkyBell to a third-party security system integrator (e.g., AT&T, Vivint, etc.), such products are Licensed Products, even if they are integrated into the third party's system or service offering, such that the Licensed Product can be operated through the third party's web interface, mobile application or the like. Any other product or service Disposed of by the third party which is not provided by SkyBell shall not be a Licensed Product.



- j) **"Lawsuits"** shall mean the civil actions styled as Eyetalk365, LLC v. SkyBell Technologies, Inc., 3:16-cv-00702-FDW-DCK (W.D.N.C.) and Eyetalk365, LLC v. SkyBell Technologies, Inc., 8:17-cv-01415-JLS-JDE (C.D. Cal.), as well as any other pending litigation between the Parties.

2. **Grant of Licenses.** In consideration of the payment provided for in Section 4 herein, and other valuable consideration received, Eyetalk and its Affiliates hereby grant to SkyBell and its Affiliates a worldwide, irrevocable, nonexclusive, non-assignable, license under the Licensed Patents to Dispose of Licensed Products.

3. **Covenant Not to Sue.** In consideration of the payment provided for in Section 4 herein, Eyetalk covenants and agrees that it will not assert any claim against Skybell or its Affiliates for direct, induced, indirect, or contributory infringement of any of the Licensed Patents.

4. **Consideration.**

- a) In full payment to Eyetalk for the Licensed Patents, SkyBell hereby agrees to pay the following:

i) A paid up license amount of \$2,000,000.00 USD ("License Payments") to be paid as follows:

i. First Payment: \$500,000.00 USD on or before November 15, 2017 ("First Payment");

ii. Second Payment: \$100,000.00 USD on or before February 15, 2018 ("Second Payment");

iii. Third Payment: \$200,000.00 USD on or before May 1, 2018 ("Third Payment"); and

iv. Fourth Payment: \$1,200,000.00 USD on or before November 1, 2018 ("Fourth Payment").

- b) The License Payments described in Section 4 are to be made by wire transfer into the following account:

Name: Klemchuk, LLP

Bank: Texas Capital Bank

ABA#: 111017979

Address: 2350 Lakeside Blvd., Ste. 800

Richardson, TX 75082

Beneficiary: Klemchuk LLP

Account: IOLTA Account

Address: 8150 North Central Expressway, 10th Floor, Dallas, TX 75206

Account #: 1111073506

- c) Upon receipt of the First Payment as outlined in Section 4(a), herein, Eyetalk with

dismiss the Lawsuits with prejudice within one business day.

If any of the License Payments are not timely made, SkyBell has 30 days to cure any such breach, if the breach is not cured within the 30-day period, SkyBell shall assign any and all interests to U.S. Patent No. 7,429,924; U.S. Patent No. 7,477,134; and U.S. Patent No. 8,193,919 (the "Langer Patents") as collateral for the breach to Eyetalk. SkyBell represents and warrants that Eyetalk shall have an unencumbered lien on SkyBell's interest in the Langer patents within five (5) days of the Effective Date of this Agreement including obtaining within five (5) days of the Effective Date a fully-executed lien waiver from Arrow Electronics, Inc., which shall be included as Appendix B to this Agreement. In the event of an uncured default by SkyBell such that SkyBell assigns to Eyetalk all right, title, and interest in and to the Langer Patents, SkyBell shall retain a limited, non-exclusive license to the Langer Patents that will extend to and be transferrable to any Entity that acquires SkyBell.

5. **Term of License.** The license granted by this Agreement shall remain in full force and effect until the expiration of the last to expire of the Licensed Patents.
6. **Change of Control.** In the event that, after the Effective Date, SkyBell is acquired or otherwise comes under the Control of a third party, this License Agreement shall continue and run to SkyBell, its Affiliates, the Licensed Products, or the acquiring Entity with any such change of Control.
7. **Waiver of Challenge to Validity.** As part of this Agreement, and as one condition thereof, SkyBell agrees not to challenge the validity or enforceability of the Licensed Patents and not to assist others in doing so except as may be permitted by law or to comply with a subpoena or discovery order issued by a court or panel. Notwithstanding the foregoing, SkyBell reserves the right to contest the validity and enforceability of the Licensed Patents solely to the extent any claim or allegation is made that SkyBell, its Affiliates, or their products or services are or may be infringing the Licensed Patents, or that SkyBell, its Affiliates, or their products or services ("Assertion") may need a further license to the Licensed Patents. In the event of such Assertion, Eyetalk shall pay attorney fees and costs of SkyBell related to any Assertion after receipt of written notice from SkyBell to Eyetalk and a fifteen (15) business day period after such notice is received. Absent such Assertion against SkyBell, its Affiliates, their products, or services, if SkyBell or its Affiliates challenges any of the Licensed Patents, then SkyBell shall pay attorney fees and costs of Eyetalk for any validity challenge brought by SkyBell or its agents.
8. **Marking.** SkyBell or its Affiliates may mark through its website or its products the patent numbers listed in Schedule 1 and any such patents owned or acquired by Eyetalk in the future. The decision regarding whether to mark the products or list the patents on the website is at the full discretion of SkyBell. Eyetalk must update the list as other assets are developed or purchased in the future.
9. **Miscellaneous.**



- a) Confidentiality. The existence of this Agreement (including the identification of the parties and the Licensed Patents) is not confidential. The terms of this agreement are confidential.
- i. General Confidentiality Provisions: The parties agree not to disclose the terms and conditions of this Agreement except (a) as may be required by law (including without limitation documents for SEC requests, required filings, or requirements and/or as ordered by any court), (b) during the course of litigation unless disclosure of such terms and conditions are restricted in the same manner as is the confidential information of the litigating party; (c) in confidence to the professional legal and financial counsel representing such party; (d) in confidence to any party covered by the releases, licenses, or covenants granted herein; in confidence in connection with any reorganization or sale of substantially all of the assets of the disclosing party; or (e) as agreed by the parties.
- b) Representations and Warranties. Eyetalk represents and warrants to SkyBell, as of the Effective Date, that:
- i. Eyetalk is the sole and lawful owner of all right, title and interest in and to the Licensed Patents (including all rights to enforce and license them, and all claims or causes of action relating thereto) and, thus, the right to enter into this Agreement.
- ii. Eyetalk has no ownership or financial interest in any Patents as of the Effective Date other than the Licensed Patents and no rights to grant a license to any patents as of the Effective Date that are excluded from the definition of Licensed Patents.
- iii. As of the Effective Date, Eyetalk has not granted any licenses in the Licensed Patents to any Entity other than those Entities identified in Appendix A to this Agreement, and all such licenses are nonexclusive and non-sublicensable. As of the Effective Date, Eyetalk is not aware of any third parties that have granted any licenses in the Licensed Patents.
- iv. Eyetalk shall not grant a license to the Licensed Patents to any third parties unless (1) the payment amount is equal to or greater than the amount of the total License Payments paid by SkyBell whether for cash or equivalent compensation and (2) the total payment is paid to Eyetalk within one year of the grant of the license. In the event Eyetalk provides a license to a third party licensee and receives a payment amount less than paid by SkyBell under the terms of this Agreement and/or the full payment is not made within one year from the grant of the license, then SkyBell shall be entitled to receive cash reimbursement from Eyetalk in an amount equal to the difference between the License Payments paid by SkyBell for this license, and the payments paid by the third party licensee (the, "Reimbursement Amount"). By way of example, if a third party pays a total license fee of \$1,500,000, SkyBell shall be entitled to a refund of \$500,000. By way of further example, if a third party agrees to pay a total of \$2,000,000, but



only agrees to pay \$1,500,000 within one year of the license grant, SkyBell shall be entitled to a refund of \$500,000. Eyetalk shall self-report any event which triggers payment to SkyBell under this Section 9(b)(iv) within thirty (30) business days of Eyetalk's receipt of cash consideration from the third-party licensee (the, "Triggering Event"), and Eyetalk shall reimburse SkyBell within sixty (60) business days of the Triggering Event. Eyetalk reserves the right to license the Licensed Patents for a running royalty rate based upon gross product sales, provided that the running royalty rate on any settlement or license agreement is at least five percent (5%) of gross product sales. If any remuneration is due to SkyBell, it shall be based upon the difference in the License Payment and the license payment of another third party that is below the License Payment. For example, if two license payments of \$1.5 million are obtained by Eyetalk, SkyBell would only be entitled to the first reduction of \$500,000 but not an additional \$500,000.

- v. Failure to remunerate to SkyBell within sixty (60) business days of the Triggering Event shall entitle SkyBell to receive damages equal to the amount of cash paid to Eyetalk by SkyBell in accordance with this Agreement, plus any fees incurred by SkyBell as the result of recouping cash proceeds under this provision.
 - vi. Upon receiving notice, Eyetalk shall have 30 business days to address any reasonable request for information necessary for SkyBell to validate that a Triggering Event has not occurred. Such information, if necessary, will be provided Attorneys' Eyes Only (AEO) to SkyBell's outside counsel. SkyBell's outside counsel shall not share the specific information with SkyBell after Eyetalk provides such information to SkyBell's counsel, but nothing shall prevent SkyBell's outside counsel from advising SkyBell whether a Triggering Event has occurred and the monies owed to SkyBell.
- c) Mutual Representations and Warranties. Each party and each person signing this Agreement on behalf of a party represents and warrants to the other that:
- (1) Such party has not entered this Agreement in reliance upon any promise, inducement, agreement, statement, or representation other than those contained in this Agreement.
 - (2) Such party has the full right and power to enter into this Agreement, and the person executing this Agreement has the full right and authority to enter into this Agreement on behalf of such party and the full right and authority to bind such party to the terms and obligations of this Agreement.

10. Notices. All notices and requests which are required or permitted to be given in connection with this Agreement shall be deemed given as of the day they are received either by messenger, delivery service, or in the United States of America mails, postage prepaid, certified or registered, return receipt requested, and addressed as follows, or to such other



address as the party to receive the notice or request so designates by written notice to the other:

To Eyetalk:

Ross Helfer
Managing Member of Eyetalk365
9923 Willow Leaf Lane
Cornelius, NC 28031

with a copy to:

Gary Sorden
Klemchuk LLP
8150 North Central Expressway, 10th Floor
Dallas, TX 75206

To SkyBell:

Joe Scalisi
1 Jenner, Suite 100
Irvine, California 92618

with a copy to:

Ben Sidbury
BRYAN CAVE LLP
One Wells Fargo Center
301 S. College Street, Suite 3900
Charlotte, NC 28202-0902

11. Governing Law. This Agreement shall be construed and controlled by the internal laws of the State of North Carolina (excluding conflict of laws principles) and applicable federal laws, and all parties consent to exclusive jurisdiction and venue in the federal courts sitting in the state of North Carolina, unless no federal subject matter jurisdiction exists, in which case each party consents to exclusive jurisdiction and venue in the state courts located in the state of North Carolina, for any disputes arising out of this Agreement. Each party waives all defenses of lack of personal jurisdiction and forum nonconveniens for any disputes arising out of this Agreement. Process may be served on all parties in the manner authorized by applicable law or court rule.

12. Costs. Each party shall bear his or its own costs, expenses and attorneys' fees incurred in connection with the Agreement, the making of this Agreement, and its performance under this Agreement.

13. Taxes. All taxes shall be the financial responsibility of the party obligated to pay such taxes as determined by the applicable law and neither party is or shall be liable at any time for the other party's taxes incurred in connection with or related to amounts paid under this Agreement.



- 14. Successors and Assigns.** The terms, covenants, conditions, provisions and benefits of this Agreement shall be binding upon and inure to the benefit of the parties and their respective successors and any assign who acquires all or substantially all the assets of SkyBell or one of its Affiliates. Eyetalk hereby agrees that any transfer of any interest in any patent shall be made subject to the license granted herein.
- 15. No Construction Against Drafter.** This Agreement results from negotiations between the parties and each party acknowledges that he or it has had the opportunity to negotiate modifications to the language of this Agreement. Accordingly, each party agrees that in any dispute regarding the interpretation or construction of this Agreement, no statutory, common law or other presumption shall operate in favor of or against any party hereto by virtue of his or its role in drafting or not drafting the terms and conditions set forth herein.
- 16. Construction.** If any provision of this Agreement shall be held by a court of competent jurisdiction to be illegal, invalid or unenforceable or otherwise in conflict with law, and the remaining provisions shall remain in full force and effect. If any provisions of this Agreement are deemed not enforceable, they shall be deemed modified to the extent necessary to make them enforceable.
- 17. Counterparts.** This Agreement may be executed in any number of counterparts and by the different parties on separate counterparts and each such counterpart shall be deemed to be an original, but all such counterparts shall together constitute but one and the same Agreement. Execution of this Agreement may be accomplished by signing this Agreement and transmitting the signature page to opposing counsel by facsimile or email.
- 18. Waiver.** No waiver of any provision of this Agreement shall be deemed or shall constitute a waiver of any other provision, whether or not similar, nor shall any waiver constitute a continuing waiver unless expressly stated in writing by the party making the waiver. No waiver of any provision shall be binding in any event unless executed in writing by the party making the waiver.
- 19. Entire Agreement.** This Agreement constitutes the entire agreement between the parties with respect to the subject matter hereof, and supersedes all prior and contemporaneous written or oral agreements or communications as to such subject matter, all of which are merged and fully integrated into this Agreement. It shall not be modified except by a written agreement dated subsequent to the date of this Agreement and signed on behalf of Eyetalk and SkyBell by their respective duly authorized representatives.



IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be made and executed by duly authorized representatives.

Eyetalk365, LLC

Signature: 

Name (print): Ross Helfer

Title: Manager

Date: 10/19/2017

SkyBell Technologies, Inc.

Signature: 

Name (print): Joseph Salis

Title: CEO

Date: 10/19/2017

Schedule 1: Licensed Patents

1. U.S. Patent No. 8,139,098
2. U.S. Patent No. 7,193,644
3. U.S. Patent No. 8,144,183
4. U.S. Patent No. 8,144,184
5. U.S. Patent No. 8,154,581
6. U.S. Patent No. 8,164,614
7. U.S. Patent No. 9,432,638
8. U.S. Patent No. 9,414,030
9. U.S. Patent No. 9,485,478
10. U.S. Patent No. 9,516,284
11. U.S. Patent No. 9,635,323
12. U.S. Patent No. 9,706,178
13. U.S. Patent No. 9,648,290
14. U.S. Patent No. 9,554,090
15. U.S. Patent No. 7,429,924 (partial interest)
16. U.S. Patent No. 7,477,134 (partial interest)
17. U.S. Patent No. 8,193,919 (partial interest)
18. U.S. Patent Application No. 11/929,449
19. U.S. Patent Application No. 11/929,457
20. U.S. Patent Application No. 11/929,460
21. U.S. Patent Application No. 15/238,393
22. U.S. Patent Application No. 15/238,228

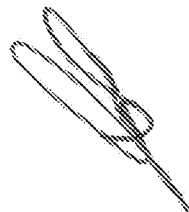


- 23. U.S. Patent Application No. 15/237,933
- 24. U.S. Patent Application No. 15/237,797
- 25. U.S. Patent Application No. 15/237,222



Appendix A – Licensees

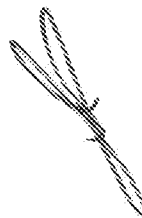
1. BotHome Automation, Inc. (“Ring”)
2. The Chamberlain Group
3. HeathCo, LLC
4. CPI Security Systems, Inc.
5. Livewatch Security, LLC
6. Alarmforce NC, Inc. and Alarmforce LP
7. Revolutionary Concepts, Inc.
8. Bird Home Automation, LLC
9. Bird Home GmbH
10. ~~August Home, Inc.~~



Appendix B – Arrow Lien Waiver

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6701435.3

13

A handwritten signature, possibly reading "Arrow", is written in dark ink. The signature is stylized with a large, looped initial 'A' and a trailing flourish.

RECORDED: 01/08/2018

PATENT
REEL: 044565 FRAME: 0257