

## PATENT ASSIGNMENT COVER SHEET

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<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT	
<b>NATURE OF CONVEYANCE:</b>	ASSIGNMENT	
<b>CONVEYING PARTY DATA</b>		
	<b>Name</b>	<b>Execution Date</b>
	VIACOR, INC.	12/10/2004
<b>RECEIVING PARTY DATA</b>		
<b>Name:</b>	MEDTRONIC, INC.	
<b>Street Address:</b>	710 MEDTRONIC PARKWAY	
<b>City:</b>	MINNEAPOLIS	
<b>State/Country:</b>	MINNESOTA	
<b>Postal Code:</b>	55432	
<b>PROPERTY NUMBERS Total: 2</b>		
<b>Property Type</b>	<b>Number</b>	
<b>Patent Number:</b>	6890330	
<b>Application Number:</b>	11115087	
<b>CORRESPONDENCE DATA</b>		
<b>Fax Number:</b>		
<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>		
<b>Phone:</b>	707 566 1375	
<b>Email:</b>	kim.grigg@medtronic.com	
<b>Correspondent Name:</b>	KIM S GRIGG	
<b>Address Line 1:</b>	3576 UNOCAL PLACE	
<b>Address Line 4:</b>	SANTA ROSA, CALIFORNIA 95403	
<b>ATTORNEY DOCKET NUMBER:</b>	P23700.01 & P23700.02	
<b>NAME OF SUBMITTER:</b>	MICHELLE H. SHEN	
<b>SIGNATURE:</b>	/Michelle H. Shen Reg. No. 48823/	
<b>DATE SIGNED:</b>	08/27/2019	
<b>Total Attachments: 9</b>		
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## ASSIGNMENT

THIS ASSIGNMENT (the "Agreement") is made and entered into as of December \_\_, 2004, (the "Effective Date") between Viacor, Inc. ("Assignor"), a Delaware corporation located at 260-B Fordham Road, Wilmington, MA 01887, and Medtronic, Inc. ("Assignee"), a Minnesota corporation located at 710 Medtronic Parkway, Minneapolis, MN 55432.

## RECITALS

WHEREAS, Assignor is the owner of the United States and foreign patents and patent applications identified on the attached Exhibit A ("Patents"); and

WHEREAS, Assignee desires to acquire the entire right, title and interest in and to the Patents and in and to the inventions described and claimed therein;

## AGREEMENTS:

NOW THEREFORE, in consideration of the representations, warranties, covenants and agreements contained herein, and for other valuable consideration, the receipt and adequacy of which is hereby acknowledged, the parties mutually agree as follows:

1. Specific Definitions. As used in this Agreement, the following definitions and terms shall have the designated meanings:

(a) "Net Sales" of Covered Products with respect to a particular period means the gross amounts that Assignee, any affiliate of Assignee, and any licensee of Assignee or of any affiliate of Assignee (as applicable, the "Seller") receives from third parties (eliminating sales from Assignee to an affiliate or licensee, unless such affiliate or licensee is the end user of the Covered Products) for sales, lease or other transfer (excluding reasonable quantities of promotional samples and sales for use in clinical trials or other testing) of Covered Products during such period, excluding (1) amounts that are separately invoiced for sales, use, occupation or excise taxes and outbound freight, duty or insurance actually paid by Seller, and (2) amounts credited or refunded to customers by Seller due to rejections, defects or returns; provided that if Seller sells at a single price or rate a packaged combination of products, not all of which if sold individually would be Covered Products, then of the amount received by Seller for the Covered Products with respect to such sales of packaged products shall equal the number of units of Covered Products sold as part of such packaged products (less rejections, defects and returns) multiplied by either (i) the respective average gross selling price during such period of the same Covered Products sold individually, or (ii) the average gross selling price during such period for Seller's most comparable product (if the same Covered Product is not sold individually), in either case less any applicable exclusions permitted above. Net Sales which are denominated in currencies other than U.S. Dollars shall be converted into U.S. Dollars according to Seller's standard accounting policy for conversion of foreign currencies, consistently applied. No deductions shall be made for commissions paid to employees or independent sales agents, or for any cost of collections. If a Covered Product is distributed at a discounted price that is substantially lower than the customary price charged by Seller, or distributed for non-cash consideration (whether or not at a discount), then Net Sales shall be calculated based on the non-discounted amount of the Covered Product charged to independent third parties during the same reporting period or, in the absence of such sales, on the fair market value of the Covered Product.

(b) "Covered Product" means any product (or part thereof), any product manufactured using a process or any product that when used practices a process which, in the country of its sale, manufacture, import or use, is covered by any Valid Claim within the Patent Rights. No payments for Covered Products shall be payable after the last to expire or termination of all of the patents within the Patent Rights.

(c) "Valid Claim" means an issued claim of an unexpired patent, which shall not have been withdrawn, canceled or disclaimed, or held invalid, unpatentable or unenforceable by a court of competent jurisdiction or an administrative agency having authority over patents, in an unappealed or unappealable decision, or which has not been admitted to be invalid, unpatentable or unenforceable by the patent holder through reissue proceedings, disclaimer or otherwise.

(d) "Patent Rights" means, collectively, all of the Patents and rights related thereto contemplated in Section 2.

2. Assignment. Assignor hereby irrevocably sells, assigns, and transfers to Assignee, and its successors and assigns:

(a) The entire right, title and interest to the Patents including the inventions described or claimed therein, and to each U.S. and foreign patent application and patent from which the Patents claim priority to or from in whole or in part;

(b) The entire right, title and interest to any United States or foreign patents that may issue with respect to the inventions described or claimed in the Patents;

(c) The entire right, title and interest to any renewals, reissues, extensions, substitutions, continuations, continuations-in-part, or divisions of the Patents, and all foreign applications based thereon or foreign counterparts thereof;

(d) The right to apply for patents in foreign countries in its own name and to claim any priority rights to which such foreign applications are entitled under international conventions, treaties or otherwise; and

(e) The right to enforce rights to such Patents as fully and entirely as the same would have been held and enjoyed by the Assignor if this assignment had not been made; together with all claims by Assignor for damages by reason of past infringement or for provisional rights and including the right to sue for, and collect the same for its own use and benefit, and for the use and benefit of its successors, assigns, and other legal representatives.

3. Acknowledgement. Assignor agrees that all Patents shall belong exclusively to Assignee, with Assignee having the right to obtain and to hold in its own name such registrations, patents, or such other perfection, registration, certification, or protection as may be obtained or applicable to the subject matter, and any extensions and renewals thereof. Assignor hereby authorizes and requests the Commissioner of Patents to issue to Assignee any patents that may be granted in accordance with this Assignment. Assignee shall have the sole and exclusive right, in Assignee's absolute discretion and at its sole cost and expense, to exercise complete control over the Patents, including, but not limited to, the right to (a) prosecute any alleged infringement, misappropriation or misuse of the Patents, and (b) apply for, prosecute, or cause the issuance, amendment, abandonment, maintenance, re-examination or reissue of any

patents patent applications included within the Patents. Assignor acknowledges that Assignee has no obligation whatsoever to exploit the Patents or commercialize the underlying inventions or any Covered Products.

4. Further Assurances. Assignor further agrees, for itself and for its successors and assigns, to give Assignee and any person designated by Assignee, at Assignor's expense, reasonable assistance required to perfect, register, certify, and protect the rights defined in this Agreement, to execute and deliver any further applications, assignments or other documents, and to perform such other lawful acts as Assignee its successors and assigns may deem necessary to fully secure, maintain and enforce its rights, title or interest as outlined herein.

5. Payment.

- (a) Assignee shall pay to Assignor a payment equal to two percent (2%) of Net Sales of Covered Products. No more than one (1) payment calculated in accordance with this Section 5(a) shall be paid on any single product covered by the Patent Rights even though such product is manufactured in accordance with or incorporates inventions covered by more than one of the Patent Rights.
- (b) If Assignee sells the Patent Rights, in whole or in part, at any time during which royalties remain payable to Assignor under Section 5(a), then Assignee will, at its option, (i) cause such buyer of the Patent Rights to agree in writing to fulfill all obligations (including without limitation, Section 5) under this Agreement or (ii) pay Assignor a lump-sum amount that Assignor agrees, in its discretion, to accept in fulfillment of all remaining payment obligations hereunder.
- (c) All amounts due hereunder shall be paid in US dollars at Assignor's address (or, at its option, to an account specified by Assignor), in full. Any amount not paid when due shall bear a late payment charge until paid at the rate of 1.5% per month or the maximum amount permitted by law, whichever is less. Payment of late charges shall not foreclose any other right that Assignor may have as a consequence of late payment. Assignee agrees to reimburse Assignor for all reasonable costs (including attorneys' fees) incurred in collecting payments.

6. Offset. If Licensee reasonably determines that sales of Covered Products would be impractical or impossible without obtaining a royalty-bearing license from a third party (a "Necessary License"), then Assignee may enter into a license with such third party. In such event, Assignee shall be permitted to offset fifty percent (50%) of any license fees paid by it to such third party pursuant to the Necessary License against any payments due Assignor under this Agreement; *provided*, in no event shall the payment due Assignor in a quarter be less than fifty percent (50%) of the amount otherwise owed, absent such offset.

7. Report. Within sixty (60) days after the end of each fiscal quarter of Assignee, Assignee shall provide Assignor with a written report indicating the amount of Net Sales of Covered Products during such preceding quarter and the calculation of the amount of the payments due for such quarter. If there are none, Assignee shall so report. Assignee's report shall be in a format reasonably acceptable to Assignor. Simultaneously with making such report, Assignee shall pay to Assignor the payment then due.

8. Records. Assignee shall maintain, and shall cause its affiliates and licensees to maintain,

true, complete and accurate records (in accordance with generally accepted accounting principles) relating to the rights and obligations under this Agreement and any amounts payable to Assignor in relation to this Agreement, which records shall contain sufficient information to permit Assignor to confirm the accuracy of any reports delivered to Assignor and compliance in other respects with this Agreement. The relevant party shall retain such records for at least four (4) years following the end of the calendar year to which they pertain. Upon reasonable notice and during regular business hours, Assignee shall from time to time (but no more frequently than twice annually) make available such records for audit at Assignor's expense by independent representatives selected by Assignor and reasonably acceptable to Assignee to verify the accuracy of the reports provided to Assignor. Such representatives shall execute a suitable confidentiality agreement reasonably acceptable to Assignee prior to conducting such audit. Such representatives may disclose to Assignor only their conclusions regarding the accuracy and completeness of royalty payments and reports, and of records related thereto, and shall not disclose Assignee's confidential business information to Assignor without the prior written consent of Assignee. In the event that any audit performed under this Section 8 reveals an underpayment in excess of five percent (5%), Assignee shall bear the full cost of such audit and shall remit all amounts due to Assignor (including without limitation, late charges pursuant to Section 5(c)) within thirty (30) days after receiving notice thereof from Assignor.

9. Reassignment. In the event that Assignee intends to abandon the maintenance or prosecution of any U.S. patent or U.S. patent application within the Patents as well as all corresponding patents or patent applications claiming priority to such U.S. patent or U.S. patent application in the Major Markets, then Assignee shall give timely notice (in light of any applicable filing or payment deadlines) to Assignor in writing of such intention and shall offer to assign ownership of any such patent or patent application to Assignor without additional consideration, in which case the costs of controlling, filing, prosecuting and maintaining such patents and patent applications shall be borne by Assignor. For purposes of this Section 9, "Major Markets" shall mean Japan and the countries of the European Union.

10. General Provisions.

- (a) Entire Agreement. This Agreement (including the exhibits) constitutes the entire agreement, and supersedes all prior negotiations, understandings or agreements (oral or written), between the parties about the subject matter of this Agreement. This Agreement may be executed in one or more counterparts, each of which shall be an original, but taken together constituting one and the same instrument. Execution of a facsimile copy shall have the same force and effect as execution of an original, and a facsimile signature shall be deemed an original and valid signature. No waiver, consent or modification of this Agreement shall bind either party unless in writing and signed by the party against which enforcement is sought. The failure of either party to enforce its rights under this Agreement at any time for any period will not be construed as a waiver of such rights. If any provision of this Agreement is determined to be illegal or unenforceable, that provision will be limited or eliminated to the minimum extent necessary so that this Agreement will otherwise remain in full force and effect and enforceable.
- (b) Governing Law. This Agreement shall be governed by and construed in accordance with the laws of the Commonwealth of Massachusetts, without regard to its conflicts of law provisions. In any action or proceeding to enforce or interpret this Agreement, the prevailing party will be entitled to recover from the other party its costs and expenses (including reasonable attorneys' fees) incurred in connection with such action or proceeding and enforcing any judgment or order obtained.


- (c) Notices. Any notice or communication hereunder shall be in writing and either personally delivered or sent via confirmed facsimile, recognized express delivery courier or certified or registered mail, prepaid and return receipt requested, addressed to the other party at its address specified above, or at such other address designated in a subsequent notice. All notices shall be in English, effective upon receipt.
- (d) Binding Effect. This Agreement shall be binding upon, and inure to the benefit of, the successors, representatives and permitted assigns of the parties.
- (e) Independent Contractors. The parties shall be independent contractors under this Agreement, and nothing herein will constitute either party as the employer, employee, agent or representative of the other party, or both parties as joint venturers or partners for any purpose.

12/10/2004 FRI 11:16 FAX 1 978 657 0020 Viacor Inc.

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IN WITNESS WHEREOF, each of the parties has caused this Assignment Agreement to be executed in the manner appropriate to each.

VIACOR, INC.

  
Its: CEO

MEDTRONIC, INC.

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

Its: \_\_\_\_\_



DEC 10 2004 7: 08AM

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IN WITNESS WHEREOF, each of the parties has caused this Assignment Agreement to be executed in the manner appropriate to each.

VIACOR, INC.

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

Its: \_\_\_\_\_

MEDTRONIC, INC.

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

Its: \_\_\_\_\_

## EXHIBIT A

U.S. Patent No. 6692513

U.S. Patent No. 6769434

U.S. Patent Application Publication No. 20040034380

U.S. Patent Application Publication No. 20020095166

U.S. Patent Application Publication No. 2002005577

U.S. Patent Application Publication No. 20040044406

U.S. Patent Application Publication No. 20020138044

U.S. Patent Application Publication No. 20020042651A; Method And apparatus for Performing a Procedure on a Cardiac Valve.

U.S. Patent Application Publication No. 200200951A1; Apparatus and Method for Replacing Aortic Valve.

U.S. Patent Application Serial No. 09/700,167; Cardiac Valve Procedure Methods and Devices.

U.S. Patent Application Serial No. 10/014,699; Intracardiovascular Access (ICVA) System.

U.S. Patent Application Serial No. 10/713,386

U.S. Patent Application Serial No. 10/894,677

U.S. Patent Application Serial No. 10/895,272

PCT Patent Application Publication No. WO 03088873

PCT Patent Application Publication No. WO 04043293

PCT Patent Application Publication No. WO 0308809

PCT Patent Application Publication No. WO 00/44313; Cardiac Valve Procedure Methods and Devices.

PCT Patent Application Publication No. WO 02/01999; Method And apparatus for Performing a Procedure on a Cardiac Valve.

PCT Patent Application Publication No. WO 02/47539; Apparatus and Method for Replacing Aortic Valve.

PCT Patent Application Serial No. US00 02126; Intracardiovascular Access (ICVA) System.

U.S. Provisional Patent Application entitled Cardiac Valve Procedures and Mechanisms.

U.S. Provisional Patent Application entitled Fixation Band for Affixing a Prosthetic Valve to Tissue.

U.S. Provisional Patent Application entitled Method and Apparatus for Resecting and Replacing an Aortic Valve (filed April 16, 2002).

U.S. Provisional Patent Application entitled Method and Apparatus for Resecting and Replacing an Aortic Valve (filed Nov 13, 2002).