

## 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>
	ROCKLEY PHOTONICS LIMITED	03/01/2019
<b>RECEIVING PARTY DATA</b>		
<b>Name:</b>	HENGTONG ROCKLEY TECHNOLOGY CO., LTD.	
<b>Street Address:</b>	88 HENGTONG ROAD, WUJIANG DISTRICT	
<b>City:</b>	SUZHOU, JIANGSU PROVINCE	
<b>State/Country:</b>	CHINA	
<b>PROPERTY NUMBERS Total: 1</b>		
	<b>Property Type</b>	<b>Number</b>
	<b>Patent Number:</b>	9627851
<b>CORRESPONDENCE DATA</b>		
<b>Fax Number:</b>	(626)577-8800	
<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>	626-795-9900	
<b>Email:</b>	pto@lrrc.com	
<b>Correspondent Name:</b>	LEWIS ROCA ROTHGERBER CHRISTIE LLP	
<b>Address Line 1:</b>	PO BOX 29001	
<b>Address Line 4:</b>	GLENDALE, CALIFORNIA 91209	
<b>ATTORNEY DOCKET NUMBER:</b>	079016/RPAT17US/MWR/RAV	
<b>NAME OF SUBMITTER:</b>	RACHEL A. VILLALOBOS	
<b>SIGNATURE:</b>	/Rachel A. Villalobos/	
<b>DATE SIGNED:</b>	12/05/2019	
<b>Total Attachments: 10</b>		
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**ROCKLEY PHOTONICS LIMITED**

**- and -**

**HENG TONG ROCKLEY TECHNOLOGY CO., LTD.**

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**ASSIGNMENT AND LICENCE OF PATENTS**

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## ASSIGNMENT AND LICENCE OF PATENTS

### PARTIES

- (1) **ROCKLEY PHOT ONICS LIMITED** (a company incorporated in England and Wales with company registration number 08683015) whose registered office is at Cooley (UK) LLP, 10th floor, Dashwood, 69 Old Broad Street, London, England, EC2M 1QS (the "**Assignor**"); and
- (2) **HENG TONG ROCKLEY TECHNOLOGY CO., LT D.** (a sino-foreign equity joint venture incorporated in the People's Republic of China ("PRC")) whose registered office is at 88 Hengtong Road, Wujiang District, Suzhou, Jiangsu Province, China (the "**Assignee**");

Together the "**parties**" or each a "**party**" as the context may indicate.

### BACKGROUND:

- (A) The Assignor is a technology company that has developed certain intellectual property relating to the design and manufacture of photonic technology, including silicon photonic chipsets.
- (B) Assignor has agreed to assign the Assigned Patents to the Assignee, and the Assignee has agreed to grant to the Assignor a licence under the Assigned Patents, on the terms set out in this Agreement.

### AGREED TERMS

#### 1. DEFINITIONS & INTERPRETATION

##### 1.1 In this Agreement:

"**Affiliate**" means, with respect to a party, any person that, directly or indirectly, through one or more intermediaries, controls, is controlled by or is under common control with such Party. For purposes of this definition, "control" and, with correlative meanings, the terms "controlling", "controlled by" and "under common control with" means: (a) the possession, directly or indirectly, of the power to direct the management or policies of a person, whether through the ownership of voting securities, by contract relating to voting rights or corporate governance, or otherwise; or (b) the ownership, directly or indirectly, of more than fifty percent (50%) of the voting securities or other ownership interest of a person (or, with respect to a limited partnership or other similar entity, its general partner or controlling entity). The parties acknowledge that in the case of certain entities organized under the laws of certain countries, the maximum percentage ownership permitted by law for a foreign investor may be less than fifty percent (50%), and that in such case such lower percentage shall be substituted in the preceding sentence, provided that such foreign investor has the power to direct the management or policies of such entity.

"**Agreement**" means this agreement and its schedules and annexes, and any document expressly referred to in it.

**"Assigned Patents"** means the granted patents listed in the table in the Schedule.

**"Infringement"** means (a) any actual or threatened infringement, unauthorised use, or misappropriation by a third party of, one or more of the Assigned Patents; or (b) any claim by a third party regarding the ownership of, or otherwise opposing or challenging the validity of, one or more of the Assigned Patents.

1.2 In this Agreement, except where the context otherwise requires:

1.2.1 a reference to an enactment or statutory provision will include a reference to any subordinate legislation made under the relevant enactment or statutory provision and is a reference to that enactment, statutory provision or subordinate legislation as from time to time amended, consolidated, modified, re-enacted or replaced;

1.2.2 a reference to a clause, sub-clause, paragraph, Schedule (other than to a schedule to a statutory provision) will be a reference to a clause, sub-clause, paragraph, Schedule (as the case may be) of or to this Agreement;

1.2.3 references to any English legal term for any action, remedy, method of judicial proceeding, legal document, legal status, court, official or any legal concept or thing will in respect of any jurisdiction other than England be deemed to include what most nearly approximates the English legal term in that jurisdiction and references to any English statute or enactment will be deemed to include any equivalent or analogous laws or rules in any other jurisdiction; and

1.2.4 references in this Agreement to any agreement or other instrument (other than an enactment or statutory provision) will be deemed to be references to that agreement or instrument as from time to time amended, varied, supplemented, substituted.

## 2. **ASSIGNMENT**

In consideration of the sum of \$1 (receipt and sufficiency of which is hereby acknowledged by the Assignee), the Assignor hereby assigns to Assignee all its rights, title and interest in, to and arising from the Assigned Patents, including (without limitation and subject to clause 5) the right to bring, make, oppose, defend, appeal proceedings, claims or actions and obtain relief (and to retain any damages recovered) in respect of any infringement, or any other cause of action arising from ownership of any of the Assigned Patents occurring on or after the date of this Agreement. Such payment to be made following receipt of the necessary approvals from all applicable Governmental bodies.

## 3. **LICENCE**

In further consideration of the assignment to the Assignee of the Assigned Patents under Clause 2, the Assignee hereby grants to the Assignor in those countries covered by the Assigned Patents a perpetual, irrevocable, sub-licensable (through multiple levels of sub-licensees), fully paid-up, royalty-free, non-exclusive licence under the Assigned Patents for any and all purposes.

## 4. **MAINTENANCE OF THE PATENTS**

4.1 The Assignee will maintain the Assigned Patents and will pay all costs and expenses of their maintenance.

4.2 If the Assignee elects to discontinue the maintenance of any of any of the Assigned Patents (each an "**Abandoned Patent**"), the Assignor will have the right (but not the obligation) to demand the assignment back to the Assignor of the Abandoned Patent for a nominal value.

## 5. **INFRINGEMENT**

5.1 If either party gains knowledge of an Infringement with respect to an Assigned Patent, such party will promptly notify the other party in writing and will promptly provide such other party with details and information available to it of such Infringement. Subject to Clause 5.3, the parties will, within two (2) weeks of providing or receiving such notice, discuss how to co-operatively deal with the Infringement.

5.2 If the parties are unable to agree on how to deal with an Infringement in accordance with Clause 5.1, the Assignor may (at its sole discretion) decide whether to institute Infringement actions in respect of the relevant Infringement, provided that:

(a) it will keep the Assignee fully informed as to the status of such Infringement action; and

(b) the Assignee will not make (i) any admissions regarding the Assigned Patents, (ii) agree to any claims affecting the scope of the Assigned Patents, or (iii) agree any settlement to the Infringement action, without the prior written consent of the Assignor.

5.3 If the Assignee chooses not to institute Infringement actions pursuant to Clause 5.2, the Assignor will have the right (but not the obligation) to institute such Infringement actions in its own name. Should the Assignor wish to institute Infringement actions, the Assignor will keep the Assignee regularly informed of the progress of the Infringement action, including (without limitation) any claims affecting the scope of the Assigned Patents.

5.4 If either party recovers monetary damages from any third party in an Infringement action brought under this Clause 5, or any royalties, milestones or other payments from a licence agreement with a third party related to any alleged infringement related to the Assigned Patents, such recovery will be allocated first to the reimbursement of any expenses incurred by the parties in such litigation, action or license negotiations. Any remaining amounts will be allocated:

(a) to according to any agreement between the parties agreed under Clause 5.1; or

(b) absent any such agreement, to the party dealing with such Infringement action under Clauses 5.2 or 5.3, unless and to the extent that any such payments are in respect of the Assignor's lost profits, in which case such corresponding amount will be paid to the Assignor.

5.5 Each party will, at the other party's reasonable request and cost, cooperate with the other party and will execute all necessary documents, take such actions as will be appropriate to allow the other party to institute and prosecute such Infringement actions under the Clause 5, and will otherwise cooperate in the institution and prosecution of such actions.

## 6. **WARRANTY AND LIMITATION OF LIABILITY**

6.1 Except as expressly provided in this Agreement, neither party gives any warranties or makes any representations with respect to the Assigned Patents. In particular, but without limiting the foregoing, the Assignor gives no warranty and makes no representation in or pursuant to this Agreement that the use of any of the Assigned Patents does not or will not infringe the rights of others.

6.2 Except as provided by Clause 6.3, neither Party will be liable to the other Party for indirect loss of profits, incidental or consequential damages, whether in contract, warranty, negligence, tort, strict liability or otherwise, arising out of any breach of or failure to perform any of the provisions of this Agreement.

6.3 Nothing in this Agreement will limit the liability of either party for:

6.3.1 personal injury or death arising out of that party's negligence or wilful misconduct; or

6.3.2 fraud or fraudulent misrepresentation or wilful misconduct

## **7. RECORDAL AND FURTHER ASSURANCE**

7.1 The Assignee undertakes to the Assignor to record the assignment of the Assigned Patents with each relevant patent office at the Assignee's cost and expense.

7.2 The Assignor may (at its sole discretion) decide to record its licence under the Assigned Patents with one or more of the relevant patent office at its cost and expense.

7.3 Each party will execute and deliver all further documents, required by law or which the other party reasonably requests, to vest in each party the full benefit of the right, title and interest assigned or licensed to it under this Agreement, including documents required by a party for registration as the proprietor or licensee (whichever is applicable) of the Assigned Patents.

## **8. INVALIDITY**

If any provision of this Agreement will be held to be illegal, void, invalid or unenforceable under the laws of any jurisdiction, the legality, validity and enforceability of the remainder of this Agreement in that jurisdiction will not be affected, and the legality, validity and enforceability of the whole of this Agreement in any other jurisdiction will not be affected.

## **9. ENTIRE AGREEMENT**

This Agreement constitutes the whole agreement between the Parties relating to its subject matter and supersedes and extinguishes any prior drafts, agreements and understandings, whether in writing or oral, relating to such subject matter, or those to the extent that the same are repeated in this Agreement. Each Party hereto acknowledges that it has not been induced to enter into this Agreement by any representation, warranty promise or assurance (whether made innocently or negligently) by any Party or any other person save for those contained in this Agreement.

## **10. VARIATIONS**

No variation of this Agreement will be effective unless made in writing and signed by each of the Parties.

## 11. NOTICES

All notices will be in writing and sent by hand, electronic mail, or recorded delivery and will be deemed to be properly served (i) if sent by hand, when delivered at the relevant address; (ii) if sent by recorded delivery, three (3) Business Days after posting; (iii) if sent by Electronic Mail, when transmitted, provided a confirmatory copy is sent by post within twenty four (24) hours of transmission, and will be sent to the following addresses or email address as may be amended by the relevant Party in writing:

### ASSIGNOR:

#### **Rockley Photonics Limited**

Cooley (UK) LLP, 10th floor, Dashwood, 69 Old Broad Street, London, EC2M 1QS

Electronic Mail: [ciaran.rooney@rockleyphotonics.com](mailto:ciaran.rooney@rockleyphotonics.com) with a copy to  
[Andrew.rickman@rockleyphotonics.com](mailto:Andrew.rickman@rockleyphotonics.com) (email to be headed "For the urgent attention of the General Counsel")

For the attention of: Ciaran Rooney

### ASSIGNEE:

#### **Hengtong Rockley Technology Co., Ltd**

88 Hengtong Road, Wujiang District, Suzhou, Jiangsu Province, China.

Electronic Mail: [yangym@htgd.com.cn](mailto:yangym@htgd.com.cn)

For the attention of: Yang Yuming

## 12. FURTHER ASSIGNMENT

12.1 Subject to Clause 12.2, neither party will, without the prior written consent of the other party assign, transfer, convey or declare a trust over this Agreement or make any other disposition (whether in whole or in part) of any of its rights and obligations hereunder to any third party, including by novation. Any such attempted assignment, transfer, conveyance or trust thereof will be void and have no force or effect.

12.2 The Assignor may assign the Assigned Patents, in whole or in part, without the Assignee's consent to: (i) any Affiliate, or (ii) to a successor to all or a relevant part of the business of the Assignor whether in a merger, sale of stock, sale of assets or otherwise, provided that (a) the Assignor giving written notice to the Assignee and (b) such third party agrees to be bound to the Assignor by rights and obligations equivalent to those set out in this Agreement in respect of the Assignee. The Assignee will not, without the prior written consent of the Assignor, assign, convey or otherwise transfer any one or more of the Assigned Patents (whether in whole or in part) to any other person. Any such attempted assignment, conveyance, or transfer thereof will be void and have no force or effect.

## 13. CUMULATIVE RIGHTS

The rights, powers, privileges and remedies provided in this Agreement are cumulative and are not exclusive of any rights, powers, privileges or remedies provided by law or otherwise.

## 14. NO WAIVER



No failure to exercise nor delay in exercising any right, power, privilege or remedy under this Agreement will in any way impair or affect the exercise thereof or operate as a waiver thereof in whole or in part. No single or partial exercise of any right, power, privilege or remedy under this Agreement will prevent any further or other exercise thereof, or the exercise of any other right, power, privilege or remedy.

**15. COUNTERPARTS**

This Agreement may be executed in any number of counterparts, which will together constitute one agreement. Any party may enter into this Agreement by signing any such counterpart.

**16. COSTS**

Each party will bear their own costs arising out of or in connection with the preparation, negotiation and implementation of this Agreement and the documentation referred to herein.

**17. NO PARTNERSHIP**

Nothing in the Agreement and no action taken by the parties pursuant to this Agreement will constitute or be deemed to constitute a partnership association, joint venture or other co-operative entity between the parties and none of the parties will have any authority to bind any of the others in any way except as provided in this Agreement.

**18. CONTRACTS (RIGHTS OF THIRD PARTIES) ACT 1999**

A person who is not a Party to this Agreement will have no rights under the Contracts (Rights of Third Parties) Act 1999 to enforce any term of this Agreement.

**19. ANNOUNCEMENTS, PUBLICATIONS AND USE OF NAMES**

19.1 Save as expressly provided in this Agreement, neither party will make, or procure or permit the making of, any press release or other public announcement (including on any website or in any company publication) in relation to this Agreement without first obtaining the written approval of the other party to any such release or announcement, which will not unreasonably be withheld, conditioned or delayed.

19.2 Any party may make an announcement with respect to this Agreement or any ancillary matter if required by law or the regulations of any stock exchange to which it is subject, without the other party's consent provided it has used reasonable endeavours in the time available to consult with the other Party on the terms of any such announcement beforehand.

19.3 No party will use the name or marks of any other, except as provided in Clause 19.1 and 19.2 without the prior written consent of that Party which will be at that Party's sole discretion.

**20. GOVERNING LAW & ARBITRATION**

This Agreement is to be governed by, and construed in accordance with, English law. Any dispute or claim arising out of or relating to this Agreement which cannot be amicably resolved by the parties, including the existence, validity, interpretation, performance, breach or termination thereof, will be referred by the parties to and finally resolved by arbitration

administered by the Hong Kong International Arbitration Centre (HKIAC) under the HKIAC Administered Arbitration Rules in force when the Notice of Arbitration is submitted. The law of this arbitration Clause will be English law. The seat of the arbitration will be Hong Kong. The number of arbitrators will be three. The arbitration proceedings will be conducted in English.

**SCHEDULE: THE ASSIGNED PATENTS**

<b>Patent Number</b>	<b>Grant Date</b>	<b>Title</b>
GB2543122	18 July 2018	An optoelectronic component
ZL201580002672.9	19 September 2017	Tunable SOI laser
US9627851	18 April 2017	Discrete wavelength tunable laser

The parties hereby execute this Agreement by their duly authorised representatives with effect from the last date below:

EXECUTED by )  
ROCKLEY PHOTONICS LIMITED )  
)  
)  
)  
)

Name of director MAHESH KARANTH  
Date 2019.3.1

Signature Maheesh Karanth

EXECUTED by )  
HENG TONG ROCKLEY )  
TECHNOLOGY CO., LTD )  
)  
)  
)

Name of director Weiming Shi, 施伟明  
Date 2019.3.28

Signature W. Shi