

PATENT ASSIGNMENT COVER SHEET

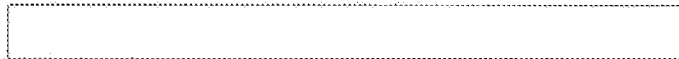
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EPAS ID: PAT6506932

SUBMISSION TYPE:	NEW ASSIGNMENT	
NATURE OF CONVEYANCE:	ASSIGNMENT	
CONVEYING PARTY DATA		
Name		Execution Date
GLASER GMBH SURGICAL INSTRUMENTS (GLASER GMBH)		09/29/2016
RECEIVING PARTY DATA		
Name:	MEDACTA INTERNATIONAL S.A.	
Street Address:	STRADA REGINA, CASTEL, SAN PIETRO	
City:	TICINO	
State/Country:	SWITZERLAND	
Postal Code:	6874	
PROPERTY NUMBERS Total: 1		
Property Type	Number	
Patent Number:	9693768	
CORRESPONDENCE DATA		
Fax Number:	(203)865-0297	
<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:	2037776628	
Email:	docket@bachlap.com	
Correspondent Name:	BACHMAN & LAPOINTE, P.C.	
Address Line 1:	900 CHAPEL ST, SUITE 1201	
Address Line 2:	SUITE 1201	
Address Line 4:	NEW HAVEN, CONNECTICUT 06510-2802	
ATTORNEY DOCKET NUMBER:	13-278	
NAME OF SUBMITTER:	GEORGE A. COURY	
SIGNATURE:	/george a. coury/	
DATE SIGNED:	01/21/2021	
Total Attachments: 10		
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CONFIDENTIAL



PATENT PURCHASE AGREEMENT

This Patent Purchase Agreement (hereafter the "**Agreement**"), entered into as of the 01 day of September, 2016 (hereafter the "**Effective Date**"), is by and between **Medacta International S.A.**, a Swiss company with a principal place of business at Strada Regina, 6874 Castel San Pietro, Ticino, Switzerland (hereafter "**MEDACTA**") and **GLASER GmbH**, (hereafter "**Seller**"), whose address is Gänsäcker 46, D-78532 Tuttlingen, Deutschland.

MEDACTA and Seller hereinafter collectively referred to as the "**Parties**" and severally referred to as a "**Party**".

PREAMBLE

WHEREAS, MEDACTA is a Swiss company active, among the others, in the field of orthopaedic implants, instrumentations and devices;

WHEREAS, Seller has declared that it is the owner of all rights, title and interest in and to the inventions as described herein and claimed in all of Seller's national and foreign patents and patent applications listed on **Exhibit I**; and, moreover, Seller has declared that it is the owner of know-how covering the above-mentioned inventions;

WHEREAS, Seller wishes to sell, transfer, assign and set over to MEDACTA, and MEDACTA shall purchase, accept and assume all rights, title and interest in and to the above-mentioned inventions, patents and know-how;

NOW THEREFORE, in consideration of the premises and of the mutual covenants and conditions contained herein, the Parties hereto have agreed and do hereby agree that Seller transfers to MEDACTA all the rights to the inventions, the patents and the know-how under the following terms and conditions:

1. Definitions

Inventions: Shall mean all ideas and information in relation to and in connection with Meniscus Reattachment Device as protected internationally by the Patents and Patent Applications.

Know How: Shall mean all knowledge and information regarding and/or in connection with the Inventions which is not already protected by the Patents and Patent Applications which is available to Seller at the Effective Date; in particular all information which is necessary for MEDACTA to manufacture, sell and distribute the Products in the Territory.

Patents and Patent Applications: Shall mean all of Seller's national and foreign patents and patent applications and utility models and utility model applications listed on **Exhibit I** and including without limitation, all extensions, continuations, continuation-in-part, provisional, divisional, derivatives and related applications thereof whether or not such applications are listed in Exhibit I to this Agreement. In the following the term "patent" includes patents and utility models"; the term "patent application" includes patent and utility model applications.

Technology: Shall mean any invention, patent and patent application, modification, discovery, design rights, development, improvement, process, software program, work of authorship, documentation, formula, data, technique, know-how, trade secrets, trade dress, trademarks, 3D-trademarks and/or any other intellectual property right whatsoever regarding the Inventions.

Territory: Shall mean worldwide.

Valid Claim: A claim of a Patent that has not expired or been held invalid or unenforceable by a court competent jurisdiction in a final and non-appealable judgement.

2. Purchase and Assignment

2.1 Seller hereby sells and assigns to MEDACTA

(a) all right, title and interest in and to the Patents and Patent Applications, including without limitation,

- (i) the Patents listed in **Exhibit I** including the inventions that are the subject of those Patents; and
- (ii) the Patent Applications listed in **Exhibit I** and, where patents are granted in respect of such Patent Applications, such granted patents including the inventions that are the subject of those Patent Applications and patents;
- (iii) any and all patents or patent applications which claim priority from the Patents or the Patent Applications listed in Exhibit I as far as such right, title and interest exists for the Seller;
- (iv) any applications for divisional applications, continuations, continuations-in-part, re-examinations, reissues, PCT applications, convention applications all foreign counterparts, and patents resulting from those applications, where the applications are made in respect of the inventions that are the subject of the Patents

and Patent Applications described in (i), (ii) and (iii) immediately above as far as such right, title and interest exists for the Seller;

(v) all claims for damages or other remedies in respect of any infringement of any of the Patents before as well as after the date of this Agreement with the right to sue and collect for its own use and benefit and for the use and benefit of its successors and assigns, and

(vi) all right, title and interest in and to the Patent Applications and all rights, powers and privileges arising or accrued there from to the intent that the grant of patents pursuant to the Patent Applications shall be in the name of and shall vest in MEDACTA, and

(b) all right, title and interest of the Seller in and to the Inventions;

(c) all right, title and interest of the Seller in and to the Know How;

(d) all right, title and interest of the Seller in and to the Technology;

(all the aforementioned together: the "**Assignment**").

2.2 MEDACTA hereby accepts the sale and assignment according to article 2.1.

2.3 As of the effectiveness of the Assignment, Seller will deliver and transfer to MEDACTA all technical documents related to the Patents, Patent Applications and Inventions, Know How and Technology, including but not limited to research papers, field reports, spread sheets, test reports, prototypes, samples and models which are in the possession of the Seller and not subject to any applicable confidentiality agreements.

3. **Purchase Price**

3.1 The purchase price for all Patents and Patent Applications, Inventions, Know How and Technology is due as follows:

(i) Medacta will pay 40'000 Euro to the Seller as immediate down payment to secure the Technology at the signature of the agreement;

(ii) Medacta will pay 45'000 Euro to the Seller when the patents listed in Exhibit I are granted.

- (iii) Medacta is committed, in the first eighteen (18) months following the signature of this agreement, to order services to Seller for a Service Amount up to 130'000 Euro. Services could include engineering, prototyping, production of samples, etc. Seller shall provide the above services at fair market price and shall issue specific invoices, for the mentioned services, explicitly referring to this 3.1 (iii) provision.
- (iv) Fair market price will be defined by Medacta providing to the Seller two alternative quotations for the same requested service.

3.2 The Purchase Price shall be transferred to the following account:

Bank: Kreissparkasse Tuttlingen
BIC: SOLADES1TUT
IBAN: DE 70643500700000047850
Ust.ID.-Nr. DE262849300

or to such other bank account of which Seller notifies MEDACTA in writing at least three (3) business days prior to any instructions for the respective wire transfer being given. Any payments under this Agreement shall be made, upon receipt of related invoice, by wire transfer in immediately available funds, value as of the relevant due date set out in this Agreement, free of bank and other charges.

4. Assistance of Seller

Seller hereby agrees to cooperate with MEDACTA to give full effect to the Assignment and to perfect the rights of MEDACTA in the Patents and Patent Applications. For that purpose:

- 4.1 Seller hereby explicitly consents to (i) the registration, recordal or other filing of the Assignment with the competent authorities and (ii) the registration of MEDACTA as current legal and beneficial right holder of the Patents and Patent Applications with the relevant patent offices and/or other competent authorities, as applicable.
- 4.2 Upon MEDACTA's reasonable request, Seller shall do all acts and execute and deliver any and all additional documents, declarations and other documentation that are reasonably necessary (i) for the registration, recordal or other filing of the Assignments with the competent authority and/or the registration of MEDACTA as current legal and beneficial right holder of the Patents and Patent Applications with the relevant patent offices and/or other competent authorities, as applicable (ii) to give full effect to the Assignments and to perfect the rights of MEDACTA in the Patents and Patent Applications.

- 4.3 Seller shall promptly notify MEDACTA in writing of any infringement of any Valid Claims of Patents of which it becomes aware.

5. Warranties, Guaranties

Seller hereby represents, warrants and guaranties at Effective Date of this Agreement that:

- 5.1 Seller is the sole legal and beneficial owner of the Patents and Patent Applications and has full power to enter into the Agreement.
- 5.2 There are no licenses with respect to Patents and/or Patent Applications and/or Inventions and/or Know-How and/or Technology nor are Patents and/or Patent Applications and/or Inventions and/or Know-How and/or Technology subject to any security interest or other encumbrances.
- 5.3 All annuity, maintenance fees and fees in general that are necessary in order to keep the Patents in force and to keep the Patent Applications pending as of the Effective Date have been paid by Seller, and no payment of annuities or fees, or papers to be filed in patent offices, are required to be made within the three-month period after the Effective Date.
- 5.4 Seller is not aware of any facts or circumstances based on which validity of Patents could successfully be challenged (e. g. nullity proceedings, opposition).
- 5.5 Seller is not aware of any grounds for refusing the grant of patents pursuant to the Patent Applications in substantially the form applied for.
- 5.6 Exhibit I contains a complete list of all Patents and Patent Applications in relation to the Inventions.

6. No-Challenge Clause, no competition

- 6.1 Seller will not attack the Patents and/or Patent Applications and will not assist third parties in attacks on the Patents and/or Patent Applications.
- 6.2 Seller warrants not to set up in business as a direct competitor of MEDACTA in the field of Meniscus reattachment devices as defined in paragraph 1 "the Inventions" nor to be in any other way involved in any business related to any such products to be manufactured under the Patents, Patent Applications, Technology and/or Inventions as from now up to a period of 5 (five) years after the last Patent has expired.

7. Improvements

Seller shall inform MEDACTA by a transfer of all relevant technical data about any improvement and further development of the Inventions underlying the Patents, Patent Applications and Know-How ("**Improvements**") and is obliged to offer MEDACTA at MEDACTA's choice

- (i) to transfer and assign any or all registered and unregistered rights pertaining in such Improvements at no charge to MEDACTA,

and/or

- (ii) to grant MEDACTA a free license for the exclusive, worldwide, unlimited and unrestricted use of any or all such rights.

For the avoidance of doubt, MEDACTA will be under no obligation to buy any of the Improvements or take a license thereunder.

8. Prosecution and Maintenance

Upon request of MEDACTA, Seller shall cooperate in the prosecution of Patent Rights to obtain valid patents in the name of MEDACTA pursuant to each of the Patent Applications listed in Exhibit I.

9. Confidentiality

- 9.1 The terms and conditions of this Agreement shall remain confidential. Excluded there from are only notices prescribed under applicable law; in the latter case, the Purchase Price must expressly be treated as confidential and as business secrets.
- 9.2 The confidentiality clause under paragraph 9 will last for 5 years after the expiration of the last patent in force.

10. MISCELLANEOUS

10.1 Preparation.

- (a) Each Party hereto agrees to execute such additional documents or instruments or to take any further action hereto reasonably requested by the other Party in order to achieve the purpose of this Agreement.
- (b) Each Party shall bear its own taxes, costs and fees relating to the preparation and the implementation of this Agreement.

- 10.2 Any agreements, changes, amendments or supplements to this Agreement - also on collateral agreements - are required to be in written form in order to be valid and binding unless otherwise stipulated in this Agreement. The same applies to the waiver of this stipulation requiring written form.
- 10.3 This Agreement and any Exhibits constitute the entire understanding between the Parties and supersede any prior communication, representations or agreements whether oral or in writing.
- 10.4 If any provision of this Agreement is invalid or becomes void due to subsequent circumstances, or if the Agreement is incomplete, the validity of the other provisions of the Agreement shall not be affected thereby. The Parties are obliged to replace any invalid or unenforceable provision with a valid provision which - as far as permitted by law - economically comes closest to what the Parties had intended with respect to the purpose under the invalid or void provision. The same applies in the case of an omission.
- 10.5 Unless provided otherwise in this Agreement, all notifications, requests or other correspondence shall be made in writing and delivered personally or sent by telefax, registered letter or courier. The service is deemed to have occurred in case of personal delivery or telefax transmission upon completion (in case of telefax, the transmission is evidenced by the transmission confirmation), in case of mail (registered letter) delivery three days after posting and in case of express or night courier delivery after one business day and the corresponding transmission of the declarations to the copy recipients listed in sub-paragraph (b). Each Party may change the address for service (also copy recipient) at any time by written declaration to the other respective Party.

The Parties agree on the following addresses for service:

For Seller:

Glaser GmbH
Gänsäcker 46
D-78532 Tuttlingen
Tel.: +49 7462 923 083

For MEDACTA:

Mr. **Francesco Siccardi**
Strada Regina
6874 Castel San Pietro

Switzerland

Email: **fsiccardi@medacta.ch**

Telephone: **+41 91 6966060**

Faxcimilie: **+41 91 6966066**

The above-mentioned authorised recipients are hereby expressly authorised by the respective parties to accept service of documents.

- 11.6 Neither Party is authorized to use the name(s) and/or logo(s) of the other Party for publicity and marketing without the written consent of such Party. The use of the name of the other Party to mention factually the collaboration is not authorized without the written consent of the other Party.
- 11.7 The present Agreement is governed by the law of Switzerland and is construed and interpreted accordingly, with the principles and provisions of the private international law and the UN Sales Convention not being applicable. The district court in Lugano shall have exclusive jurisdiction for all disputes arising from or in connection with this Agreement, provided that such a jurisdictional clause can be agreed upon effectively. Place of performance shall be Castel San Pietro.


IN WITNESS THEREOF the parties have caused this agreement to be executed by their duly representatives in 2 (two) originals as of the Effective Date

Castel San Pietro, 29.09.16

Place, Date

Tuttlingen, den 23.09.2016

Place, Date



Francesco Siccardi, Executive Vice President

Medacta International S.A.



Glaser GmbH

CEO and owner Mr Valentin Leiber

Exhibit I

MENISCUS REATTACHMENT DEVICE Patents:

- PCT number *WO2012072244*
- European Patent number: *EP2645941*
- United States Patent number: *US2014018827*
- Priority number: *DE102010060899*