

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT7017191

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	LICENSE

CONVEYING PARTY DATA

Name	Execution Date
JOHN J DANIELS	10/29/2021

RECEIVING PARTY DATA

Name:	DIAGMETRICS, INC.
Street Address:	30 RENEES WAY
City:	MADISON
State/Country:	CONNECTICUT
Postal Code:	06443

PROPERTY NUMBERS Total: 12

Property Type	Number
Application Number:	63233473
PCT Number:	US2124404
Application Number:	17189711
Application Number:	17065488
Application Number:	16882447
Application Number:	16876054
Application Number:	63019378
Application Number:	63012247
PCT Number:	US2127854
PCT Number:	US2127740
Application Number:	63026052
Application Number:	63245295

CORRESPONDENCE DATA

Fax Number: (617)523-6215

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: 6175893813

Email: dpowsner@davismalm.com

Correspondent Name: DAVID J. POWSNER / DAVIS MALM D'AGOSTINE P.C.

Address Line 1: ONE BOSTON PLACE

Address Line 2: 37TH FLOOR

PATENT

Address Line 4: BOSTON, MASSACHUSETTS 02108

ATTORNEY DOCKET NUMBER: 015520.0000

NAME OF SUBMITTER: DAVID J. POWSNER

SIGNATURE: /David J. Powsner/

DATE SIGNED: 11/10/2021

Total Attachments: 11

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LICENSE AGREEMENT

by and between

John J. Daniels and

DiagMetrics, Inc.

Dated as of 29 October 2021

LICENSE AGREEMENT

THIS LICENSE AGREEMENT is made as of the 29th day of October, 2021, by and between John J. Daniels, having a residence at 30 Renees Way, Madison, CT 06443 (“**Daniels**”) and DiagMetrics, Inc, a Delaware corporation with its principal place of business at 30 Renees Way, Madison, CT 06443 (“**DM**”). Daniels and DM may be collectively referred to as the “**Parties**” and each individually, as a “**Party**.”

RECITALS

1. Daniels is the owner of, and is developing, intellectual property that will be used to develop, and be incorporated into, sample collecting systems, devices, methods of manufacturing, algorithms and uses for bodily fluid diagnostic systems;

2. DM desires to obtain a license from Daniels under such intellectual property for making, using and selling of Products in the DM Field of Use on the terms and conditions set forth in this Agreement, and meanings set forth for such terms below:

(a) “Affiliate” means any entity or person that directly or indirectly controls, is controlled by or is under common control with a Party. For purposes of this definition, “control” shall mean the possession, directly or indirectly, of the power to direct or cause the direction of the management and policies of an entity, whether through the ownership of voting securities, by contract or otherwise.

(b) “Damages” means damages, liabilities, losses, judgments, settlements, costs and expenses, including, without limitation, all reasonable fees and disbursements of counsel actually incurred incident to the investigation or defense of any claim or proceeding or threatened claim or proceeding.

(c) “Improvements” means any findings, discoveries, inventions, additions, patents, know-how, modifications, formulations or changes that relate to the Daniels Technologies or would be useful in commercializing diagnostic devices and systems made by DM during the term of this Agreement.

(d) “Intellectual Property” means any and all (by whatever name or term known or designated) tangible and intangible (a) rights associated with works of authorship, including but not limited to copyrights and mask-works, (b) trademark

and trade name rights and similar rights, (c) trade secret rights, (d) patents, designs, algorithms and other industrial property rights, (e) other intellectual and industrial property rights of every kind and nature and however designated, whether arising by operation of law, contract, license, or otherwise, and (f) registrations, initial applications, renewals, extensions, continuations, divisions or reissues now or hereafter in force, including, without limitation, any rights in any of the foregoing.

(e) “Invention” means a finding, discovery, invention, addition, patent, know-how, modification, formulation or change that relates to the Daniels Technologies for bodily fluid diagnostic systems in the DM Field of Use.

(f) “Daniels Technologies” means the Patents and Know-how as applied to sample collecting systems, devices, methods of manufacturing, algorithms and uses for bodily fluid diagnostic systems in the DM Field of Use.

(g) “Know-how” means any and all technical information and know-how that is owned by Daniels as of the date of this Agreement that relates to or is useful in the development and manufacture of bodily fluid diagnostic systems in the DM Field of Use.

(h) “Net Sales” means DM’s gross revenues received by DM for sales of bodily fluid diagnostic systems in the DM Field of Use incorporating Daniels technology directly from DM, a DM Affiliate, or a Third Party sublicensee, less amounts repaid or credited by reason of rejections, defects or returns.

(i) “Patents” means all patents and patent applications currently owned by Daniels anywhere in the world that relate to or are useful in the manufacture of bodily fluid diagnostic systems in the DM Field of Use, and any continuations, continuations-in-part, divisions, patents of addition, reissues, renewals or extensions thereof, a current list of which is Appendix A to this Agreement.

(j) “Products” means sample collecting systems, devices, methods of manufacturing, algorithms and uses for bodily fluid diagnostic systems.

(k) “DM Field of Use” means the use of Daniels Technology in the medical device market for sample collecting systems, devices, methods of manufacturing, algorithms and uses for bodily fluid diagnostic systems, excluding the use of Daniels Technology used for a sweat chemistry sensor combined with a wearable electronic garment with electrical signals applied to a user to cause involuntary muscle contractions and/or haptic sensations, i.e., the License Agreement from Kinaptic, LLC to DiagMetrics, Inc. dated March 26, 2021.

(l) “Retained access to IP” means the use of Daniels Technology used for a

sweat chemistry sensor combined with a wearable electronic garment with electrical signals applied to a user to cause involuntary muscle contractions and/or haptic sensations according to the License Agreement from Kinaptic, LLC to DiagMetrics, Inc., dated March 26, 2021.

- (m) "Third Party(ies)" means any person or entity, other than DM, Daniels and their respective Affiliates.
- (n) "Preexisting License Agreement with Kinaptic, Inc." means the license agreement between Kinaptic, LLC and Kinaptic, Inc., dated June 1, 2020.
- (o) "Preexisting License Agreement with John Daniels" means the license agreement between John Daniels and Kinaptic, LLC dated January 30, 2017.

2. LICENSE.

(a) *Grant.* Daniels hereby grants to DM: an exclusive license under the Intellectual Property to use and practice the Intellectual Property within the DM Field of Use (the "License"), subject to the royalty and minimum royalty as provided in this Agreement and subject to the Preexisting License Agreement with Daniels, Inc. and the Preexisting License Agreement with John Daniels. The License granted herein includes the right for DM to use, make, have made, sell, offer for sale, and import Products incorporating Daniels Technologies, and to sublicense such rights to other third parties, all subject to the other terms and conditions of this Agreement. The License shall be irrevocable, perpetual, worldwide, and exclusive within the DM Field of Use, unless otherwise specifically provided herein or hereafter mutually agreed by the Parties.

3. ROYALTY.

Royalties and Fees.

3.1 As royalties, DM agrees to pay the Daniels (a) 1.7% of the gross selling price for each unit of a device sold by DM using the Intellectual Property; and (b) 1.7% of the net income derived by DM from any sublicensee of the DM using the Intellectual Property pursuant to a sublicense granted under this Agreement.

3.2 DM shall make any royalty payments owed to Daniels hereunder in arrears, within thirty (30) days from the end of each quarter in which such payment accrues. For purposes of determining when a sale occurs under this Agreement, the sale shall be deemed to occur on the earlier of (a) the date the product is shipped or (b) on the date of the invoice to the purchaser. Each royalty payment shall be accompanied by a report specifying the aggregate net selling price of all products sold by DM or any sublicensee during the applicable period using the Intellectual Property and the royalties payable thereon.

4. OWNERSHIP OF INTELLECTUAL PROPERTY.

4.1 Termination

This Agreement shall automatically terminate in the event that (i) DM becomes insolvent, is ordered or adjudged bankrupt or is placed in receivership, or otherwise enters into any scheme or composition with creditors or makes an unauthorized assignment for the benefit of creditors; or (ii) the DM ceases its operations.

4.2 This Agreement shall automatically terminate in the event that the royalties paid to Daniels by DM pursuant to Section 3 hereof as of the end of any calendar year beginning on or after January 1, 2022 do not equal or exceed \$50,000.

5. OWNERSHIP OF INTELLECTUAL PROPERTY.

(a) *Daniels Technologies.* Except for the license granted to DM hereunder, Daniels retains all right, title and interest in and to the Daniels Technologies and the Improvements. DM may at its option pay the costs to prepare, prosecute and maintain patents and patent applications that include claims that would be infringed by the Product.

(b) *Developed by DM.* Any Invention that is made, created or developed by DM in the DM Field of Use shall be owned by DM with automatic license to Daniels for the Retained Access to IP.

(c) *Power of Attorney.* Each Party hereby irrevocably grants to the other a power of attorney for the purpose of effectuating the assignments contemplated by this Section.

6. REPRESENTATIONS AND WARRANTIES.

(a) *Mutual* Each of Daniels and DM hereby represents and warrants to the other that (i) it has full right, power and authority to enter into and perform its obligations under this Agreement, (ii) the performance of its obligations under this Agreement will not result in a violation or breach of, and will not conflict with or constitute a default under any agreement, contract, commitment or obligation to which such Party or any of its Affiliates is a party or by which it or any of its Affiliates is bound and (iii) neither it nor any of its Affiliates has granted or will grant during the term of this Agreement any right, license, consent or privilege in violation hereof.

(b) *Intellectual Property.* Daniels hereby represents and warrants to DM that:

(i) Daniels owns all right, title and interest in and to the Daniels Technologies and has not granted, and will not grant, during the term of this Agreement, to any Third Party any rights or licenses to the Daniels Technologies or Improvements that are inconsistent with the rights and licenses granted to DM under

this Agreement.

(ii) There is no pending litigation, notice or claim that Daniels does not own the Daniels Technologies or that Daniels does not have the right to grant the rights and licenses granted herein, nor to the best of Daniels's knowledge, is there any reasonable basis for any such litigation, notice or claim.

7. **TERM AND TERMINATION.**

(a) *Term.* This Agreement shall commence on the date first set forth above and shall remain in effect unless and until it is terminated in accordance with the terms of this Agreement.

(b) *Termination.* This Agreement shall terminate automatically in the event that DM files a voluntary petition for bankruptcy or reorganization, is the subject of an involuntary petition for bankruptcy that is not dismissed within 60 days, has its affairs placed in the hands of a receiver, enters into a composition for the benefit of creditors, or is deemed insolvent by a court of competent jurisdiction.

(c) *Effects of Termination.*

(i) Termination of this Agreement for any reason shall be without prejudice to either Party's right to receive all payments accrued and unpaid on the effective date of termination and shall not release either Party from any liability which at such time has already accrued or which thereafter accrues from a breach or default prior to such expiration or termination, or affect in any way the survival of any other right, duty or obligation of either Party which is expressly stated elsewhere in this Agreement to survive such termination.

(ii) *Survival.* Any provisions of this Agreement that by their terms survive termination, and any remedies for the breach thereof, shall survive the termination of this Agreement.

8. **LIMITATION OF DAMAGES.** IN NO EVENT WILL EITHER PARTY BE LIABLE FOR SPECIAL, INCIDENTAL, CONSEQUENTIAL OR TORT DAMAGES, INCLUDING, WITHOUT LIMITATION, ANY DAMAGES RESULTING FROM LOSS OF USE, LOSS OF PROFITS OR LOSS OF BUSINESS ARISING OUT OF OR IN CONNECTION WITH THE OBLIGATIONS RELATING TO THIS AGREEMENT EVEN IF SUCH PARTY HAS BEEN ADVISED OF THE POSSIBILITY OF SUCH DAMAGES, EXCEPT FOR DAMAGES CAUSED BY GROSS NEGLIGENCE OR WILLFUL ACTION OF SUCH PARTY OR ITS REPRESENTATIVES.

9. **NOTICE.** Any notice hereunder shall be in writing, and may be given by person-

al delivery, express courier or by facsimile at the address set forth below or at such other address or number as may be provided in written notice by either Party.

If to DM:

30 Renees Way
Madison, Connecticut 06443
Telephone: (860-424-1228)
Facsimile: (860-200-7464)
Attention: Chief Executive
Officer

If to Daniels:

30 Renees Way
Madison, Connecticut 06443
Telephone: (860-424-1228)
Facsimile: (860-200-7464)
Attention: Chief Executive
Officer

10. **GOVERNING LAW; JURISDICTION.** This Agreement shall be governed as to all matters, including the validity, construction and performance by and under the laws of the State of Connecticut, U.S.A. without regard to conflict of laws principles. Each of DM and Daniels hereby absolutely and irrevocably consents and submits to the jurisdiction of the courts in The State of Connecticut, U.S.A. and of any Federal court located in said State in connection with any actions or proceedings brought against any of them (or each of them) arising out of or relating to this Agreement. In any such action or proceeding, each of DM and Daniels hereby absolutely and irrevocably (i) waives any objection to jurisdiction or venue, (ii) waives personal service of any summons, complaint, declaration or other process, and (iii) agrees that the service thereof may be made by certified or registered first-class mail directed to such Party, at its respective address set forth herein.
11. **COMPLIANCE WITH LAWS.** Each Party agrees that it shall comply with all applicable international, national and local laws, ordinances, and codes in performing its obligations hereunder, including without limitation, the procurement of permits, certificates, registrations and any other requirements necessary to comply with this Agreement. If at any time during the term of this Agreement, a Party is informed, or information comes to its attention, that it is or may be in violation of any law, ordinance, regulation or code with respect to its activities hereunder, that Party shall immediately take all appropriate steps to attempt to remedy such violation and comply with such law, regulation, ordinance or code in all respects. Further, each Party shall establish and maintain all proper records

required by any law or code of practice applicable to it from time to time.

12. **FORCE MAJEURE.** Neither Party to this Agreement shall be held responsible for the damages caused by any delay or failure to perform under this Agreement which is the result of any happenings or events beyond the Party's reasonable control. Such happenings or events shall include, but not be limited to, fire, flood, explosion, action of the elements, acts of God, accidents, epidemics, inability to obtain or shortage of material or equipment, riots, or other civil commotion, war or enemy action (including terrorist activity). In the event that either Party is unable to perform any of its obligations under this Agreement or to enjoy any of its benefits because of an event of force majeure as described above, the Party who has been so affected shall immediately notify the other Party and shall make all reasonable efforts to resume performance. Upon receipt of such notice, all obligations under this Agreement shall be immediately suspended. If the period of nonperformance exceeds thirty (30) days from the receipt of notice of the force majeure event, the Party whose ability to perform has not been affected may, by giving written notice, immediately terminate this Agreement.
13. **SUCCESSORS AND ASSIGNS.** This Agreement shall be binding on and inure to the benefit of the Parties and their permitted successors and assigns. Notwithstanding the foregoing to the contrary, neither this Agreement nor any right or obligation hereunder shall be assignable in whole or in part, whether by operation of laws or otherwise, by either DM or Daniels without the prior written consent of the other Party; provided, however, that either Party shall have the right to assign any or all of its rights or obligations under this Agreement to a successor to that part of its business to which this Agreement relates, without such prior written consent as long as such successor is not a competitor of the non-assigning Party.
14. **ENTIRE AGREEMENT.** This Agreement constitutes the entire agreement between the parties and supersedes all prior negotiations, statements, memoranda of understanding and agreements of the parties with respect to the subject matter hereof.
15. **AMENDMENT.** No amendment or supplement hereto shall be effective or binding on either Party hereto unless reduced to writing and executed by duly authorized representatives of each Party.
16. **SEVERABILITY.** In the event that any one or more of the provisions (or any part thereof) contained in this Agreement shall, for any reason, be held to be invalid, illegal or unenforceable in any respect, then to the maximum extent permitted by law, such invalidity, illegality or unenforceability shall not affect any other provision of this Agreement; provided, however, that if the deletion of any provision hereof frustrates an essential purpose of this Agreement or material rights of a

Party, the Parties shall seek in good faith alternative provisions or arrangements to achieve the same purposes as the invalid, illegal or unenforceable provision.

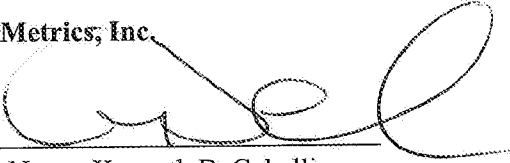
17. **COUNTERPARTS.** This Agreement may be executed simultaneously in any number of counterparts, each of which shall be deemed an original, but all such counterparts shall together constitute one and the same instrument.
18. **CONSTRUCTION.** The Parties have participated jointly in the negotiation and drafting of this Agreement. In the event an ambiguity or question of intent or interpretation arises, this Agreement shall be construed as if drafted jointly by the parties and no presumption or burden of proof shall arise favoring or disfavoring any Party by virtue of the author- ship of any of the provisions of this Agreement.
19. **NO WAIVER.** The failure of either Party to enforce at any time the provisions of this Agreement, or the failure to require at any time performance by the other Party of any of the provisions of this Agreement, shall in no way be constituted to be a present or future waiver of such provisions, nor in any way affect the right of either Party to enforce each and every such provision thereafter. The express waiver by either Party of any provision, condition or requirement of this Agreement shall not constitute a waiver of any future obligation to comply with such provision, condition or requirement.

IN WITNESS WHEREOF, the parties, through their authorized representatives, have executed this Agreement as of the date first written above.

John J. Daniels

BY: John Daniels
Name: John Daniels

DiagMetrics, Inc.

BY: 
Name: Kenneth DeCubellis
Its: Chairman

APPENDIX A INTELLECTUAL PROPERTY

Patent Applications as of September 2, 2021

Country	Application Number	Type	Filing Date
US	US 63233473	Provisional	8/16/21
PCT	PCT/US21/24404	PCT	3/27/21
US	US 17189711	Utility	3/2/21
US	US 17065488	Utility	10/7/20
US	US 16882447	Utility	5/23/20
US	US 16876054	Utility	5/17/20
US	US 63019378	Provisional	5/3/20
US	US 63012247	Provisional	4/19/20