

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT7209772

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
IOT AND M2M TECHNOLOGIES, LLC	10/04/2021
RECEIVING PARTY DATA	
Name:	FACEBOOK, INC.
Street Address:	1601 WILLOW ROAD
City:	MENLO PARK
State/Country:	CALIFORNIA
Postal Code:	94025
PROPERTY NUMBERS Total: 4	
Property Type	Number
Application Number:	16827681
Patent Number:	10621352
Patent Number:	10169587
Application Number:	62664057
CORRESPONDENCE DATA	
Fax Number:	(617)342-4001
<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:	6173424000
Email:	jadavis@foley.com, ipdocketing@foley.com
Correspondent Name:	FOLEY & LARDNER LLP
Address Line 1:	111 HUNTINGTON AVE.
Address Line 2:	SUITE 2500
Address Line 4:	BOSTON, MASSACHUSETTS 02199
ATTORNEY DOCKET NUMBER:	121439-3242
NAME OF SUBMITTER:	JENNIFER A. DAVIS
SIGNATURE:	/Jennifer A. Davis/
DATE SIGNED:	03/07/2022
Total Attachments: 14	
source=121439_Assignment_M2M_Facebook_Inc#page1.tif	
source=121439_Assignment_M2M_Facebook_Inc#page2.tif	

source=121439_Assignment_M2M_Facebook_Inc#page3.tif
source=121439_Assignment_M2M_Facebook_Inc#page4.tif
source=121439_Assignment_M2M_Facebook_Inc#page5.tif
source=121439_Assignment_M2M_Facebook_Inc#page6.tif
source=121439_Assignment_M2M_Facebook_Inc#page7.tif
source=121439_Assignment_M2M_Facebook_Inc#page8.tif
source=121439_Assignment_M2M_Facebook_Inc#page9.tif
source=121439_Assignment_M2M_Facebook_Inc#page10.tif
source=121439_Assignment_M2M_Facebook_Inc#page11.tif
source=121439_Assignment_M2M_Facebook_Inc#page12.tif
source=121439_Assignment_M2M_Facebook_Inc#page13.tif
source=121439_Assignment_M2M_Facebook_Inc#page14.tif



PATENT SALE AGREEMENT

This PATENT SALE AND LICENSE AGREEMENT (“**Agreement**”) is made and entered as of September __, 2021 (“**Effective Date**”) by and between IOT and M2M Technologies, LLC (“**IOT**”) and Facebook, Inc., a Delaware corporation (“**Facebook**”). IOT and Facebook are referred to in this Agreement individually as a “**Party**” and collectively as the “**Parties**.” For good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the Parties agree as follows.

1. DEFINITIONS.

As used in this Agreement, the terms below have the following meanings. Any such terms, unless the context otherwise requires, may be used in the singular or the plural or the present or past tense, depending on the reference.

I.1. “**Affiliate**” means, as to a particular Person, any other Person now or in the future that is Controlled By, Controlling, or under common Control with such particular Person, in each case only for so long as such other Person is Controlled By, Controlling or under common Control with such particular Person.

I.2. “**Control**” (including, with correlative meanings, “**Controlled By**” and “**Controlling**”) means, as to a particular Person, possession of the power directly or indirectly to direct or cause the direction of management or policies of an entity through the ownership of voting securities, contract, or otherwise. With respect to a corporation, limited liability company, partnership, or other entity, Control will include direct or indirect ownership of at least fifty percent (50%) of the voting stock, limited liability company interest, partnership interest or other voting (or equivalent) interest in (or other power to direct the affairs of) any such corporation, limited liability company, partnership or other entity. With respect to an asset, Control means possessing the power, directly or indirectly, to direct all of the activities and policies related to an asset, whether through ownership of, or by contract. As a non-limiting example relating to patents, “Control” includes, without limitation, the power, directly or indirectly, to direct the management, activities and policies of a person with respect to the right to assert a claim for infringement, grant licenses, grant covenants, grant assignments, or grant freedom from suit.

I.3. “**Foreign Patent Assignment**” means a patent assignment document for the IOT Transfer Patents that are not U.S. patents or patent applications that is reasonably necessary to record the assignment of IOT’s right, title, and interest in and to such non-U.S. patents or patent applications to Facebook pursuant to this Agreement.

I.4. “**IOT Transfer Patents**” means (a) the issued patents and patent applications listed on Schedule B attached hereto (“**Listed IOT Transfer Patents**”), (b) any patents that may issue on any patent applications included in the Listed IOT Transfer Patents, (c) any patents that directly or indirectly claim priority to an Listed IOT Transfer Patents or for which any of the Listed IOT Transfer Patents directly or indirectly forms a basis for priority; (d) any continuations, continuations-in-part, divisionals, worldwide counterparts, reissues, extensions, and renewals of any Listed IOT Transfer Patents, (e) any results of oppositions, reexaminations, supplemental examinations and other review procedures with respect to any Listed IOT Transfer Patents, and (f) foreign patents, patent applications and counterparts relating to any item in any of the foregoing categories (a) through (e).



I.5. **“Person”** means an individual or firm, trust, corporation, partnership, joint venture (whether entity-based or by contract), limited liability company, association, unincorporated organization or other legal or governmental entity.

I.6. **“Personnel”** means, with respect to a Person, officers, directors, managing members, employees, attorneys, and agents (but only insofar as they were or are acting in their capacities as such) of such Person.

I.7. **“Protected Communications”** means communications, work product and other documents and information related to any of the IOT Transfer Patents that are protected by or subject to any attorney-client privilege, work product doctrine, or any other similar professional privileges, rights, or immunities.

I.8. **“Sell”** means sell, distribute, lease, license, offer, provide, or otherwise make available. **“Sale,” “Sold,”** and other forms of the term **“Sell”** have the correlative meaning.

I.9. **“Third Party”** means a Person other than a Party to this Agreement.

I.10. **“U.S. Patent Assignment”** means a patent assignment document for IOT Transfer Patents that are U.S. patents and patent applications in the form set forth in Schedule A attached hereto.

2. SALE AND ASSIGNMENT OF IOT TRANSFER PATENTS.

2.1 Assignment. Effective on the Effective Date, IOT hereby sells and assigns to Facebook all of IOT’s right, title, and interest in and to the IOT Transfer Patents, including any rights to (a) maintain, further prosecute, and renew the IOT Transfer Patents (in each case where possible under applicable laws), (b) transfer, and grant licenses and other rights under, the IOT Transfer Patents and (c) enforce, bring actions and collect damages for all past, present and future infringement of, the IOT Transfer Patents.

2.2 Assignment Documents.

(a) With respect to the IOT Transfer Patents that are U.S. patents or patent applications, IOT will execute, and deliver to Facebook, within thirty (30) days after the Effective Date, the U.S. Patent Assignment.

(b) With respect to the IOT Transfer Patents that are non-U.S. patents or patent applications, Facebook will deliver to IOT, within ninety (90) days after the Effective Date, (i) a form of Foreign Patent Assignment for each patent office where the non-U.S. patents or patent applications are pending as of the Effective Date and (ii) an English translation thereof. IOT will then execute, and deliver to Facebook, each such Foreign Patent Assignment within thirty (30) days after receipt from Facebook, provided that each such Foreign Patent Assignment is in a form ready for execution by IOT and conforming to the terms and conditions of this Agreement.

(c) Facebook will be solely responsible for all actions and costs associated with the transfer and recordation of Facebook’s right, title, and interest in and to each of the IOT Transfer Patents in any



jurisdiction (including any related attorneys' fees, patent office fees, taxes, and other costs). IOT will take all actions reasonably requested by Facebook with regard to the IOT Transfer Patents prior to the date the (i) deliveries contemplated in (a) and (b) above have been effectuated, and (ii) the transfer of files as contemplated by Section 2.3 below have been completed.

(d) The recordation of Facebook's right, title, and interest in and to each of the IOT Transfer Patents in any jurisdiction shall be only after the payment specified in Section 3.

INB2478676
CONFIDENTIAL



INB2478676
CONFIDENTIAL



INB2478676
CONFIDENTIAL



INB2478676
CONFIDENTIAL



INB2478676
CONFIDENTIAL



INB2478676
CONFIDENTIAL





IN WITNESS WHEREOF, the Parties have caused this Agreement to be signed below by their respective duly authorized officers as of the Effective Date.

FACEBOOK, INC.

By: Jeremiah Chan
Jeremiah Chan, Director and Associate General Counsel, Patents

Name: Jeremiah Chan

Title: Director and Associate General Counsel, Patents

IOT AND M2M TECHNOLOGIES, LLC

By: John A. Nix

Name: John Nix

Title: President and CEO

**RULE A****Form of U.S. Patent Assignment**

The undersigned assignor ("Assignor") have invented and wishes to assign inventions and improvements (the "Invention(s)") disclosed in

US Patent number _____ filed _____, entitled _____

Now, therefore, for valuable consideration, the receipt and sufficiency of which the Assignor acknowledges, Assignor hereby irrevocably and unconditionally confirms the conveyance, assignment, and transfer to Facebook, Inc., ("Assignee"), Assignor's full extent of the right, title, and interest in and to any and all of the following (the "Rights"):

- The Invention(s) and all rights in any country of the world with respect to the Invention(s);
- The patents listed above and all letters patents, United States patents or other governmental grants or issuances that may be granted or issued with respect to the Invention(s) (the "Patent(s)");
- Any patent applications and all divisions, continuations (in whole or in part), substitutions, renewals, and other applications claiming priority rights directly or indirectly from the Patents and/or any such applications (the "Application(s)");
- All reissues, requests for continuing examinations, reexaminations, extensions or registrations of the Application(s) and/or the Patent(s);
- All non-United States patents, patent applications, and counterparts with respect to the Invention(s), the Application(s), and the Patent(s) including, without limitation, certificates of invention, utility models, industrial design protection, design patent protection, and other governmental grants or issuances, and including the right to file foreign applications directly in the name of Assignee;
- The right to claim priority rights deriving from the Patent(s) and/or Application(s) and for Assignee to otherwise avail itself of the provisions of the international conventions governing the protection of inventions;
- All causes of action, remedies and other enforcement rights related to the Application(s), the Invention(s), and the Patent(s), including, without limitation, the right to sue for past, present or future infringement, misappropriation or violation of rights related to the Application(s), the Invention(s), and/or the Patent(s);
- All rights to collect royalties and other payments under or on account of any of the Application(s), the Invention(s), and the Patent(s);
- Any and all other rights and interests arising out of, in connection with, or in relation to the Application(s), the Invention(s), and the Patent(s); and



- All documents related to the conception, diligence and reduction to practice of the Invention(s) and all domestic and international patent filing documents.

Assignor will not execute any writing or do any act conflicting with this Assignment, and, without further compensation, will execute all documents and do such additional acts as Assignee deems necessary or desirable to: perfect enjoyment of the Rights; conduct proceedings regarding the Rights, including any litigation or interference proceedings; or perfect or defend title to the Rights. Assignor will render any requested assistance in making application for and obtaining original, divisional, continuing (in whole or in part), reissued or extended letters patent on the Invention(s) throughout the world. Assignor requests the respective patent office or governmental agency in each jurisdiction to grant or issue any and all letters patents, certificates of invention, utility models or other governmental grants or issuances that may be granted upon any of the Rights in the name of the Assignee, as the assignee to the entire interest therein.

Assignor authorizes and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known, and to correct clerical mistakes in this assignment if necessary.

A copy of this Assignment will be deemed a full legal and formal equivalent of any document that may be required in any country as proof of the right of Assignee to apply for patent or other protection for any Invention(s) and to claim the benefit of the right of priority thereto. Assignor grants to Assignee the right, power and authority to insert in this Assignment any further information or identification that may be necessary or desirable to comply with the applicable rules and procedures for recordation of this Assignment, or perfecting its benefit, throughout the world.

The terms and conditions of this Assignment will inure to the benefit of Assignee, its successors or assigns, and anyone properly designated by them and will be binding upon Assignor, its successors or assigns, and anyone properly designated by them. This Assignment may be executed in counterparts.

ASSIGNOR:

John A. Mier

IOT and M2M Technologies, LLC

Date: Oct 4, 2021



SCHEDULE B

Listed IOT Transfer Patents

Family - Cipher	Family - DOCDB	Application Number - SPIF	Publication Number - SPIF	Filing Date - SPIF	Status
C0055017058	64739803	US62664057	N/A	2018-04-27	Expired
C0061025863	68533133	US62672977	N/A	2018-05-17	Expired
C0055017058	64739803	US16033996	US10169587B1	2018-07-12	Granted
C0055017058	64739803	US16186150	US10621352B2	2018-11-09	Granted
C0055017058	64739803	CA3110641	CA3110641A1	2019-04-17	Pending
C0055017058	64739803	WO2019US027968	WO2019209598A1	2019-04-17	Expired
C0055017058	64739803	US16827681	US20200226258A1	2020-03-23	Pending
C0061025863	68533133	US16406325	US10958425B2	2019-05-08	Granted
C0061025863	68533133	CA3110468	CA3110468A1	2019-05-15	Pending
C0061025863	68533133	WO2019US032371	WO2019222319A1	2019-05-15	Expired
C0061025863	68533133	US17198166	US20210194681A1	2021-03-10	Pending
C0061025863	68533133	EP19803936	EP3874385A1	2019-05-15	Pending

INB2478676
CONFIDENTIAL

