### 508827818 10/23/2024

# PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1 Stylesheet Version v1.2 Assignment ID: PATI580301

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT

#### **CONVEYING PARTY DATA**

Name	Execution Date
Jean Pierre Lazzari and Jean Marc Lazzari	01/01/2024

### **RECEIVING PARTY DATA**

Company Name:	IDEMIA IDENTITY & SECURITY FRANCE	
Street Address:	2, Place Samuel de Champlain	
City:	Courbevoie	
State/Country:	FRANCE	
Postal Code:	92400	

#### **PROPERTY NUMBERS Total: 5**

Property Type	Number
Patent Number:	9035986
Patent Number:	9001173
Patent Number:	10046590
Patent Number:	10112429
Patent Number:	9266350

## **CORRESPONDENCE DATA**

Fax Number:

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:** +0(203)357-0957

Email: ahudson@anaqua.com

Correspondent Name: Andrew Hudson

Address Line 1: Spaces Victoria 25 Wilton Road

Address Line 4: London, UNITED KINGDOM SW1V 1LW

 NAME OF SUBMITTER:
 Mrs. JENNINGS Christine

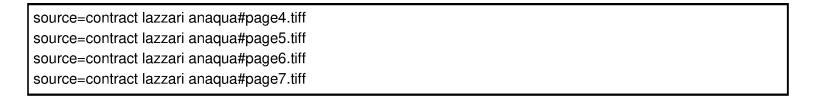
 SIGNATURE:
 Mrs. JENNINGS Christine

 DATE SIGNED:
 10/23/2024

**Total Attachments: 7** 

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PATENT 508827818 REEL: 068979 FRAME: 0544



### PATENT ASSIGNMENT CONTRACT

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The company **IDEMIA FRANCE**, formerly OBERTHUR TECHNOLOGIES, a simplified joint-stock company, registered in the Register of Companies of Nanterre under number 340 709 534, having its registered office at 2, Place Samuel de Champlain - 92 400 Courbevoie, hereinafter referred to as '**IDEMIA FRANCE**'; and

The company **IDEMIA IDENTITY & SECURITY FRANCE**, a simplified joint stock company, registered in the Register of Companies of Nanterre under number 440 305 282, having its registered office at 2, Place Samuel de Champlain - 92400 Courbevoie, France, hereinafter referred to as **'IDEMIA I&S**';

On the one hand,

AND:

Mr Jean-Pierre LAZZARI	
	and
Mr Jean-Marc LAZZARI,	

Acting jointly and severally, hereinafter referred to together as 'Messrs LAZZARI' or the 'Assignors';

On the other hand,

hereinafter individually referred to as a 'Party' and collectively as the 'Parties'.

#### **PREAMBLE**

- 1. IDEMIA FRANCE and IDEMIA I&S are companies specialising, *inter alia*, in the development and manufacture of smart cards, in particular electronic identity documents, as well as in the development and supply of software solutions and associated services.
- 2. The Assignors hold patents registered with the INPI. These patents, as well as all extensions, priority filings, divisions, continuations and entries in the national phase of international applications relating thereto, are hereinafter jointly referred to as the 'PATENTS' and are listed in Appendix 1.
- 3. By licence agreement dated 10 December 2012, Messrs LAZZARI granted IDEMIA FRANCE an irrevocable and exclusive licence to use the PATENTS (the 'Licence').
- 4. In May 2023, the Parties agreed to assign the PATENTS to IDEMIA I&S. This agreement formalises the price and terms of the transfer of ownership of the PATENTS to IDEMIA I&S (the 'Assignment Contract').

#### **ARTICLE 1 – ASSIGNMENT**

On the Effective Date, as defined in Article 4 below, Messrs LAZZARI assign and transfer to IDEMIA I&S, which accepts it, their respective co-ownership shares in the PATENTS for all countries and for the duration of the legal protection, and all the rights of enjoyment attached thereto, pursuant to Article L.613-8 of the French Intellectual Property Code.

As a result, IDEMIA I&S will be the sole owner of the PATENTS for all countries. IDEMIA I&S shall have all the necessary rights on the PATENTS for all countries to use them, directly or indirectly, and for any possible application, under the conditions defined in this Assignment Contract.

IDEMIA I&S shall, on the Effective Date, be subrogated to all the rights and actions of the Assignors relating to the PATENTS, and shall, consequently, be free to define the terms and the strategy for protecting the PATENTS by any type of protection that it, at its sole discretion, deems appropriate.

In this regard, the Assignors acknowledge that, as from the Effective Date, IDEMIA I&S will alone decide whether or not to maintain the international extensions as well as all other procedural acts having an impact, mainly, on the scope and validity of the PATENTS.

2

It is understood that IDEMIA I&S will freely decide this policy of modification, extension and maintenance in accordance with its own strategy, as owner of the PATENTS. The Assignors may not object in any way, even if these acts result in a limitation or modification of the scope of the PATENTS, or more generally, a loss of rights.

The Assignors undertake to provide, upon the simple request of IDEMIA I&S, any documents and signatures that may be necessary, including the signature, recognition and registration of specific transfers, certificates, declarations and other documents so that IDEMIA I&S can fully enjoy all the rights associated with the assignment, country by country.

#### ARTICLE 2 - FINANCIAL TERMS

In return for the assignment of the PATENTS, IDEMIA I&S agrees to pay a price, the amount and payment terms of which are explained in detail in **Appendix 2**.

#### **ARTICLE 3 - INFRINGEMENT**

IDEMIA I&S, as the sole owner of the PATENTS, shall decide at its discretion and at its sole risk and benefit, to claim and receive all damages and/or royalties owed by any third-party infringers of the PATENTS for infringement or usurpation actions prior and/or subsequent to the Effective Date.

If infringement proceedings (or more broadly, any claim based on an infringement of an intellectual property right) are initiated against IDEMIA I&S or its licensees in connection with the PATENTS, the Assignors shall provide, at their own expense, to IDEMIA I&S and/or its licensees with their technical assistance for their defence. In this respect, the Assignors undertake to provide IDEMIA I&S with all documents, powers and signatures that IDEMIA I&S may require in connection with the aforementioned proceedings.

#### **ARTICLE 4 – TRANSFER OF OWNERSHIP**

The transfer of ownership of the PATENTS will take place on 1st January 2024 (the 'Effective date').

The Licence, concluded between Messrs LAZZARI and IDEMIA FRANCE, will be terminated automatically at midnight on 31 December 2023.

On the Effective Date, Messrs LAZZARI's ownership of the PATENTS will be transferred automatically to IDEMIA I&S.

#### **ARTICLE 5 – ENTRY INTO FORCE - TERM**

The Assignment Contract shall come into force on the date of its signature. It expires on 31 Decen

#### ARTICLE 6 - FEES AND REGISTRATIONS

All costs, duties, taxes and fees due for all formalities relating to the assignment of the PATENTS shall be borne by IDEMIA I&S.

This Assignment Contract shall be registered at the request and expense of IDEMIA I&S with the industrial property offices of the countries in which the PATENTS are registered.

In order to register the Assignment Contract with the said offices and to have it mentioned wherever necessary, full powers are given to the bearer of a copy of this document.

#### <u>ARTICLE 7 – CONFIDENTIALITY</u>

The technical information provided for in Article 3 of the Assignment Contract, as well as Appendix 2 and the related financial information, is considered to be confidential information. Consequently, it may not be communicated to third-parties (other than IDEMIA I&S's parent companies, subsidiaries and sister companies and its statutory auditors) without the prior and written consent of the other Party, with the exception of communications to their intellectual property advisors and tax authorities.

This undertaking will remain in force for a period of ten (10) years after the expiry date of the Assignment Contract stipulated in Appendix 2.

#### ARTICLE 8 - APPLICABLE LAW AND SETTLEMENT OF DISPUTES

The Assignment Contract is governed by French law.

The Parties shall endeavour to resolve any dispute, relating to the Assignment Contract, in an amicable manner. In the absence of an amicable agreement, the Paris Court of Justice shall have jurisdiction.

Place: Paris, Date: 23 May 2023 Prepared in four (4) original copies,

4

DocuSigned by:  Advice Ladieux  87D82CE5E0FC44D	DocuSigned by:  Alvien Cadiens  87DB2CE5E0FC44D
Mr Adrien CADIEUX, For IDEMIA FRANCE	Mr Adrien CADIEUX, For IDEMIA IDENTITY & SECURITY FRANCE
DocuSigned by:  Jean-Pierre WELIKI  61A205DE47024BF	Docusigned by:  Jean-Mare Lazzari  CDDCC50A4C9F4A7
Mr Jean-Pierre LAZZARI	Mr Jean-Marc LAZZARI

## Appendices:

Appendix 1: List of PATENTS that are the subject of the Assignment Contract

Appendix 2: Financial terms

# **APPENDIX 1**

# LIST OF ASSIGNED PATENTS

country	Filing no.	Publi no.
EP(FR, FI, DE CH)	EP20110714352	EP2580065
EP (AT, BE, BG, CH, CZ, DE, DK, EE, ES, FI, FR, GB, HR, IE, IT, LT, LU, LV, NL, NO, PL, PT, SE, SI, SK, TR)	EP12709903	EP2681053
ВН	BP 108/2013	
BR		
	BR112013021719	BR1120130217197
CA	CA2827804	CA2827804
JP	JP2013555916	JP6007195 JP2014508058
RU	RU2013142276	RU2584670 RU2013142276 US9035986
US -	US14/001,662	US20130328995
CN	CN201280010731.3	CN103442899
MX	MX/a/2013/009857	MX/a/2013/009857
FR	FR1100578	FR2971972
QA	QA/201308/00190	
PH	1-2013-501748	1-2013-501748
PE	1985.13	
ОМ	OM/P/2013/00210	
GT	A-2013000210	5875
DZ (Algeria)	130 57	75
AE	908/2013	1791
EP (FR, DE, GB, NL)	EP12709675	EP2681052
US	US14/002,564	US9001173 US20140028775
FR FR	FR1100606	FR2972136
FR	FR1100712	FR2972388

ıie.	JIC14/004 1F7	US10046590
US	US14/004,157	
		KR10-1592077
KR	KR10-2013-7023819	KR10-2013-0131435 JP6069227
JP	JP2013557149	JP2014511294
EP (PL, NL, MT, IT, HU, GB, FR, FI, E	S, DE)	
	EP12710770	EP2684178
BR BR	BR 11 2013 022852 0	BR 11 2013 022852 0
FR	FR1100713	FR2972553
US	US14/367,013	US10112429
<b>CN</b>	CN201280067978.9	CN104066589
FR	FR1103919	FR2984217
EP (TR, HU, FR, EE, CZ, BE)	EP13710478	EP2817156
US	US14/380,336	US9266350
	0311/300/330	US20150024174
FR	FR1200511	FR2987156
EP (FR)	EP13723846	EP2877347
FR	FR1201192	FR2989627
FR+L(-2L(-39)C:LC(3)	FR1201191	FR2989626

7