

12-16-1999

Docket No.:



101223598

Tab settings → → → ▼ 12.2.99 ▼

To the Honorable Commissioner of Patents

Please return the attached original documents or copy thereof.

1. Name of conveying party(ies):

Imagyn Medical Technologies, Inc.

- Individual(s)
- General Partnership
- Corporation-State **Delaware**
- Other
- Association
- Limited Partnership

Additional names(s) of conveying party(ies) attached? Yes No

3. Nature of conveyance:

- Assignment
- Security Agreement
- Other **Trademark and License Security Agreement**
- Merger
- Change of Name

Execution Date: **October 29, 1999**

2. Name and address of receiving party(ies):

Name: **BT Commercial Corporation**

Internal Address:

Street Address: **233 South Wacker Drive, Suite 8400**

City: **Chicago** State: **IL** ZIP: **60606**

Individual(s) citizenship

Association

General Partnership

Limited Partnership

Corporation-State **Delaware**

Other

If assignee is not domiciled in the United States, a domestic representative designation is attached: Yes No

(Designations must be a separate document from Assignment)

Additional name(s) & address(es) attached? Yes No

4. Application number(s) or registration numbers(s):

A. Trademark Application No.(s)

B. Trademark Registration No.(s)

(2,265,633)

Additional numbers attached? Yes No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: **David J. Richter, Esq.**

Internal Address: **Piper Marbury Rudnick & Wolfe**

Street Address: **P.O. Box 64807**

City: **Chicago** State: **IL** ZIP: **60664**

6. Total number of applications and registrations involved:.....



7. Total fee (37 CFR 3.41):.....\$ **40.00**

Enclosed

Authorized to be charged to deposit account

8. Deposit account number:

18-2284

12/15/1999 DNGUYEN 00000102 2265633

DO NOT USE THIS SPACE

01 FC 481

40.00 DP

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

David J. Richter

Name of Person Signing

Signature

November 30, 1999

Date

Total number of pages including cover sheet, attachments, and document:

12

TRADEMARK AND LICENSE SECURITY AGREEMENT (GUARANTOR)

This **TRADEMARK AND LICENSE SECURITY AGREEMENT** ("**Agreement**") is entered into as of October 29, 1999, by and between **IMAGYN MEDICAL TECHNOLOGIES, INC.**, a Delaware corporation (together with its successors and assigns the "**Guarantor**"), and **BT COMMERCIAL CORPORATION**, having offices at 233 South Wacker Drive, Suite 8400, Chicago, Illinois 60606, as collateral agent (the "**Agent**"), for **CREDIT SUISSE FIRST BOSTON MANAGEMENT CORPORATION** (together with its successors and assigns the "**Holder**").

W I T N E S S E T H:

WHEREAS, **IMAGYN MEDICAL TECHNOLOGIES CALIFORNIA, INC.**, a California corporation ("**Imagyn California**"), **DACOMED CORPORATION**, a Minnesota corporation ("**Dacomed**"), **ALLSTATE MEDICAL PRODUCTS, INC.**, a Minnesota corporation ("**Allstate**"), **OSBON MEDICAL SYSTEMS, LTD.**, a Georgia corporation ("**Osbon**"), **MICROSURGE, INC.**, a Delaware corporation ("**Microsurge**") and **IMAGYN MEDICAL, INC.**, a Delaware corporation ("**Imagyn Delaware**") (together with their successors and assigns collectively referred to herein as "**Borrowers**") are indebted to the Holder pursuant to a certain promissory note of even date herewith in the original principal amount of \$19,792,000 (the "**Note**") and certain security agreements and other collateral documents executed in connection therewith pursuant to the Joint Amended Plan of Reorganization of Guarantor and Borrowers dated September 10, 1999, as amended (the "**Plan**"); and

WHEREAS, Guarantor has executed and delivered to Holder that certain Guaranty of even date herewith (the "**Guaranty**") guarantying the obligations of Borrowers under the Note and such other security documents; and

WHEREAS, the Holder has required, as a condition to its agreeing to the Plan, that Guarantor (i) grant to the Agent a security interest in and to the collateral described in Section 2 hereof and (ii) execute and deliver this Security Agreement in order to secure the payment and performance by Guarantor of Guarantor's obligations under the Guaranty (hereinafter the "**Obligations**"); and

WHEREAS, the Borrowers are all wholly-owned Subsidiaries of Guarantor;

NOW, THEREFORE, in consideration of the premises and in order to induce the Holder to agree to the Plan, and for other good and valuable consideration, the receipt and adequacy of which are hereby acknowledged, Guarantor and the Agent hereby agree as follows:

I. **Defined Terms**

A. Capitalized terms used herein shall have the meanings set forth in this Section. Terms used herein and not defined shall have the meanings assigned to them under the Uniform Commercial Code.

Bank Agent - BT Commercial Corporation in its capacity as Agent for the Lenders under the Credit Agreement.

Credit Agreement - that certain Credit Agreement of even date herewith entered into among Borrowers, Guarantor, BT Commercial Corporation, Credit Suisse First Boston Management Corporation and the Bank Agent.

Event of Default - means a failure to make any payment of principal or interest under the Note when due or an Event of Default under, and as defined in, the Credit Agreement.

Guarantor - Imagyn Medical Technologies, Inc., a Delaware corporation (together with its successors and assigns).

Senior Credit Documents - the Credit Agreement, the Subordination Agreement, of even date herewith, by Holder in favor of the holders of the obligations arising out of the Credit Agreement, the Intercreditor and Collateral Agency Agreement, of even date herewith, by and among the Bank Agent, Agent and Holder, and all documents securing the obligations of the Borrower or the Guarantor which arise under the Credit Agreement.

B. The words "hereof," "herein" and "hereunder" and words of like import when used in this Agreement shall refer to this Agreement as a whole and not to any particular provision of this Agreement, and section and schedule references are to this Agreement unless otherwise specified.

C. All terms defined in this Agreement in the singular shall have comparable meanings when used in the plural, and vice versa, unless otherwise specified.

II. **Security Interest in Trademarks**. To secure the complete and timely payment, performance and satisfaction of all of the Obligations, Guarantor hereby grants to the Agent, for the benefit of the Holder, a security interest in, as and by way of a mortgage and security interest having priority over all other security interests, with power of sale to the extent permitted by applicable law, all of Guarantor's now owned or existing and hereafter acquired or arising:

1. trademarks, registered trademarks and trademark applications, trade names, trade styles, service marks, registered service marks and service mark applications including, without limitation, the registered trademarks, trademark applications, regis-

tered service marks, service mark applications and unregistered trademarks listed on Schedule A attached hereto and made a part hereof, and (a) all renewals thereof, (b) all accounts receivable, income, royalties, damages and payments now and hereafter due and/or payable with respect thereto, including, without limitation, payments under all licenses entered into in connection therewith and damages and payments for past or future infringements or dilutions thereof, (c) the right to sue for past, present and future infringements and dilutions thereof, and (d) all of Guarantor's rights corresponding thereto throughout the world (all of the foregoing trademarks, registered trademarks, trademark applications, trade names, trade styles, service marks, registered service marks and service mark applications, together with the items described in clauses (a)-(d) in this paragraph 2(i), being sometimes hereinafter individually and/or collectively referred to as the "**Trademarks**");

2. the goodwill of Guarantor's business connected with and symbolized by the Trademarks; and

3. license agreements with any other party in connection with any Trademarks or such other party's trademarks, registered trademarks and trademark applications, trade names, service marks, registered service marks and service mark applications, whether Guarantor is a licensor or licensee under any such license agreement, including, but not limited to, the license agreements listed on Schedule B attached hereto and made a part hereof, and the right upon the occurrence and during the continuance of an Event of Default to use the foregoing in connection with the enforcement of the Agent's and the Holder's rights (all of the foregoing being hereinafter referred to collectively as the "**Licenses**"). Notwithstanding the foregoing provisions of this Section 2, the Licenses shall not include any license agreement which by its terms prohibits the grant of the security interest contemplated by this Agreement.

III. **Restrictions on Future Agreements.** Guarantor will not, without the Agent's prior written consent, enter into any agreement, including, without limitation, any license agreement, or other agreement which is inconsistent with this Agreement, and Guarantor further agrees that it will not take any action, and will use its best efforts not to permit any action to be taken by others subject to its control, including licensees, or fail to take any action, such as the timely filing of maintenance documents and fees, which would in any material respect affect the validity or enforceability of the rights transferred to the Agent under this Agreement or the rights associated with those Trademarks which are necessary or desirable in the operation of Guarantor's business.

IV. **New Trademarks.** Guarantor represents and warrants that the Trademarks and Licenses listed on Schedules A and B, respectively, include all of the trademarks, trademark registrations, trademark applications, trade names, trade styles, service marks, service mark registrations, service mark applications and license agreements now owned or held by Guarantor. Notwithstanding the generality of the foregoing, Guarantor further represents and warrants

(i) that the Trademarks listed on Schedule A are owned by Guarantor free and clear of any liens or encumbrances and all registrations therefor are valid, subsisting and enforceable and all applications therefor are in good standing and (ii) that the Licenses listed on Schedule B are owned by Guarantor free and clear of any liens and encumbrances and are in full force and effect. Except as stated on Schedule A, Guarantor further represents and warrants that there are no pending lawsuits or other proceedings with respect to the Trademarks, that there have been no claims or threatened claims of infringement or dilution with respect to the Trademarks and that there has been no breach or threatened breach with respect to the Licenses. If, prior to the termination of this Agreement, Guarantor shall (i) create or obtain rights to any new trademarks, trademark registrations, trademark applications, trade names, trade styles, service marks, service mark registrations, service mark applications or license agreements or (ii) become entitled to the benefit of any trademark, trademark registration, trademark application, trade name, service mark, service mark registration or service mark application, the provisions of Section 2 shall automatically apply thereto and Guarantor shall give to the Agent prompt written notice thereof. Regardless of whether or not such notice from Guarantor has been given or received, Guarantor hereby authorizes the Agent to modify this Agreement by (i) amending Schedules A or B, as the case may be, to include any future trademarks, trademark registrations, trademark applications, trade names, trade styles, service marks, service mark applications and license agreements that are Trademarks or Licenses under Section 2, or under this Section 4, and (ii) filing, in addition to and not in substitution for, this Agreement, a duplicate original of this Agreement containing on Schedules A or B thereto, as the case may be, such future trade marks, trademark applications, trade names, trade styles, service marks, service mark applications and license agreements which are Trademarks or Licenses under Section 2 or this Section 4 and to take any action Agent otherwise deems appropriate to perfect or maintain the rights and interests of the Agent under this Agreement with respect to such Trademarks and Licenses. Agent agrees to provide Guarantor notice after taking such action but the failure to do so shall not impair any rights of Agent or the Holder. Guarantor hereby irrevocably appoints the Agent as Guarantor's attorney-in-fact, with full authority in the place and stead of Guarantor and in the name of Guarantor or otherwise to carry out the acts described above. Guarantor hereby ratifies all that such attorney-in-fact shall lawfully do or cause to be done by virtue hereof. This power of attorney is coupled with an interest and shall be irrevocable until this Agreement shall have been terminated pursuant to Section 6.

V. **Royalties.** Guarantor hereby agrees that the use by the Agent of the Trademarks and Licenses as authorized hereunder shall be co-extensive with Guarantor's rights thereunder and with respect thereto and without any liability for royalties or other related charges from the Agent or the Holder to Guarantor or anyone.

VI. **Nature and Continuation of the Agent's Security Interest.** This Agreement is made for collateral security purposes only. This Agreement shall create a continuing security interest in the Trademarks and Licenses and shall remain in full force and effect until the Obligations have been paid in full.

VII. **Subject to Senior Credit Documents.** Whether or not explicitly so stated, all rights and remedies of the Agent created by this Agreement shall be subject to the rights and remedies of the Bank Agent under the Senior Credit Documents and in case of any conflict, the terms of the Senior Credit Documents shall prevail.

VIII. **Right to Inspect; Further Assignments and Security Interests.** The Agent shall have the right, at any reasonable time and from time to time, to inspect Guarantor's premises and to examine Guarantor's books, records and operations relating to the Trademarks, including, without limitation, Guarantor's quality control processes; provided, that in conducting such inspections and examinations, the Agent shall use its best efforts not to disturb unnecessarily the conduct of Guarantor's respective ordinary business operations. From and after the occurrence of an Event of Default, Guarantor agrees that the Agent or a conservator appointed by the Agent, shall have the right to establish such reasonable additional product quality controls as the Agent or such conservator, in its sole judgment, may deem necessary or desirable to assure maintenance of the quality of products sold by Guarantor under the Trademarks. Guarantor agrees (i) not to sell or assign its respective interests in, or grant any material license under, the Trademarks without the prior written consent of the Agent, (ii) to maintain the quality of any and all products in connection with which the Trademarks are used, consistent with the quality of said products as of the date hereof, and (iii) not to reduce the quality of such products in any material respect without the prior written consent of the Agent, which consent shall not be unreasonably withheld.

IX. **Duties of the Guarantor.** Guarantor shall have the duty (i) to prosecute diligently any trademark application or service mark application that is part of the Trademarks pending as of the date hereof or thereafter until the termination of this Agreement, (ii) to make application for trademarks and service marks as Guarantor deem appropriate, and (iii) to preserve and maintain all of Guarantor's rights in the trademark applications, service mark applications and trademark registrations and service mark registrations that are part of the Trademarks and Licenses. Any expenses incurred in connection with the foregoing shall be borne by the Guarantor. Guarantor shall not abandon any trademark or service mark which is the subject of a registered trademark, service mark or application therefor and which is or shall be necessary or economically desirable in the operation of Guarantor's business. Guarantor agrees to retain an experienced trademark attorney reasonably acceptable to the Agent for the filing and prosecution of all such applications and other proceedings which are material to the business of Guarantor and Guarantor's current counsel is so acceptable for such purposes at this time. Neither the Agent nor the Holder shall have any duty with respect to the Trademarks. Without limiting the generality of the foregoing, neither the Agent nor the Holder shall be under any obligation to take any steps necessary to preserve rights in the Trademarks and Licenses against any other parties, but may do so at their option during the continuance of an Event of Default, and all reasonable expenses incurred in connection therewith shall be for the sole account of Guarantor and added to the Obligations secured hereby. Any recovery from such action taken pursuant to Section 10 shall be credited to Guarantor with respect to the Obligations secured hereby but only after reimbursement of all of Agent's reasonable costs and expenses.

X. **The Agent's Right to Sue.** From and after the occurrence and during the continuance of an Event of Default, the Agent shall have the right, but shall not be obligated, to bring suit or take any other action to enforce the Trademarks and Licenses and, if the Agent shall commence any such suit or take any such action, the Guarantor shall, at the request of the Agent, do any and all lawful acts and execute any and all proper documents required by the Agent in aid of such enforcement. Guarantor shall, upon demand, promptly reimburse and indemnify the Agent for all costs and reasonable expenses incurred by the Agent in the exercise of its rights under this Section 10 (including, without limitation, all attorneys' and paralegals' fees). If, for any reason whatsoever, the Agent is not reimbursed with respect to the costs and expenses referred to in the preceding sentence, such costs and expenses shall be added to the Obligations secured hereby.

XI. **Waivers.** No course of dealing between Guarantor, the Agent and the Holder, and no failure to exercise or delay in exercising on the part of the Agent any right, power or privilege hereunder shall operate as a waiver of any of the Agent's rights, powers or privileges. No single or partial exercise of any right, power or privilege hereunder shall preclude any other or further exercise thereof or the exercise of any other right, power or privilege.

XII. **The Agent's Exercise of Rights and Remedies upon Default.** Notwithstanding anything set forth herein to the contrary, it is hereby expressly agreed that upon the occurrence and during the continuance of an Event of Default, the Agent may exercise any of the rights and remedies provided in this Agreement or any other agreement executed in connection herewith. Without limiting the generality of the foregoing, Guarantor acknowledges and agrees that from and after the occurrence and during the continuance of an Event of Default, the Agent or its nominee may use the Trademarks and Licenses to complete the manufacture of, assemble, package, distribute, prepare for sale and sell the Inventory, or otherwise in connection with the conduct of Guarantor's business.

XIII. **Severability.** The provisions of this Agreement are severable, and if any clause or provision shall be held invalid and unenforceable in whole or in part in any jurisdiction, then such invalidity or unenforceability shall affect only such clause or provision, or part thereof, in such jurisdiction, and shall not in any manner affect such clause or provision in any other jurisdiction, or any other clause or provision of this Agreement in any jurisdiction.

XIV. **Modification.** This Agreement cannot be altered, amended or modified in any way, except as specifically provided in Sections 2 and 4 hereof or by a writing signed by the parties hereto.

XV. **Cumulative Remedies; Power of Attorney.** All of the Agent's rights and remedies with respect to the Trademarks and Licenses, whether established hereby, by any other agreements or by law, shall be cumulative and may be exercised singularly or concurrently. Guarantor hereby irrevocably appoints the Agent as Guarantor's attorney-in-fact, with full

authority in the place and stead of Guarantor and in the name of Guarantor or otherwise to carry out the acts described below. Upon the occurrence and during the continuance of an Event of Default and the giving by the Agent of written notice to the Guarantor of the Agent's intention to enforce its rights and claims against Guarantor, Guarantor hereby authorizes the Agent to, in its sole discretion, (i) endorse Guarantor's name on all applications, documents, papers and instruments necessary or desirable for the Agent in the use, maintenance or transfer of the Trademarks and the Licenses, (ii) take any other actions with respect to the Trademarks and the Licenses as the Agent deems is in its or the Holder's best interest, (iii) grant or issue any exclusive or nonexclusive license under the Trademarks to anyone on commercially reasonable terms, and (iv) assign, pledge, convey or otherwise transfer title in or dispose of the Trademarks to anyone on commercially reasonable terms. The Agent shall take no action pursuant to subsection (i), (ii), (iii) or (iv) of this Section 15 without taking like action with respect to the entire goodwill of Guarantor's business connected with the use of, and symbolized by, such Trademarks. Guarantor hereby ratifies all that such attorney-in-fact shall lawfully do or cause to be done by virtue hereof. This power of attorney is coupled with an interest and shall be irrevocable until this Agreement shall have been terminated pursuant to Section 6. Guarantor acknowledges and agrees that this Agreement is not intended to limit or restrict in any way the rights and remedies of the Agent and the Holder, but rather is intended to facilitate the exercise of such rights and remedies. The Agent shall have, in addition to all other rights and remedies given it by the terms of this Agreement, all rights and remedies allowed by law and the rights and remedies of a secured party under the Uniform Commercial Code as enacted in any jurisdiction in which the Trademarks may be located or deemed located.

XVI. **Binding Effect; Benefits**. This Agreement shall be binding upon Guarantor and its respective successors and assigns, and shall inure to the benefit of the Agent, the Holder and their respective nominees, successors and assigns. Guarantor's successors and assigns shall include, without limitation, a receiver, trustee or debtor-in-possession of or for Guarantor; provided, however that Guarantor shall not voluntarily assign its obligations hereunder without the prior written consent of the Agent.

XVII. **Governing Law**. This Agreement shall be governed by, construed and interpreted in accordance with the internal law (as distinguished from the conflicts of law rules) of the State of New York.

XVIII. **Notices**. Any notice or other communication herein required or permitted to be given shall be in writing and may be personally served, telecopied, or sent by courier service or United States mail and shall be deemed to have been given when delivered in person or by courier service, upon receipt of a telecopy or three (3) Business Days after being deposited in the United States mail (registered or certified mail, with postage prepaid and properly addressed). For the purposes hereof, the addresses of the parties hereto (until notice of change thereof is delivered as provided in thisSection) shall be as set forth below each party's name on the signature pages hereof, or, as to each party, at such other address as may be designated by such party in written notice to all of the other parties.

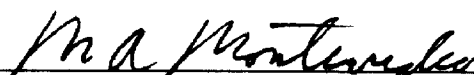
XIX. **Section Headings.** The section headings herein are for convenience of reference only, and shall not affect in any way the interpretation of any of the provisions hereof.

XX. **Execution in Counterparts.** This Agreement may be executed in any number of counterparts and by different parties hereto in separate counterparts, each of which when so executed shall be deemed to be an original and all of which taken together shall constitute one and the same agreement.

IN WITNESS WHEREOF, the parties hereto have duly executed this Agreement as of the day and year first above written.

GUARANTOR:

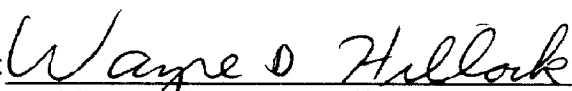
IMAGYN MEDICAL TECHNOLOGIES, INC.

By: 
Name: Michael A. Montevideo
Title: Chief Financial Officer

Notice Address:
1 Park Plaza, Suite 1100
Irvine, California 92614-5925
Fax: (949) 719-6441

AGENT:

BT COMMERCIAL CORPORATION, as
collateral Agent for Holder

By: 
Name: Wayne D. Hillock
Title: Director

Notice Address:
BT Commercial Corporation
233 South Wacker Drive, Suite 8400
Chicago, Illinois 60606
Attn: Credit Department, Wayne D. Hillock
Fax: (312) 993-8096

SCHEDULE A to Trademark and License Security Agreement (Guarantor)

Dated October 29, 1999

United States Trademark owned by: Imagyn Medical Technologies, Inc.

<u>Mark</u>	<u>Registration No.</u>	<u>Ref.</u>
AEROVIEW	2,265,633	119

United States Unregistered Trademarks owned by: Imagyn Medical Technologies, Inc.

<u>Mark</u>	<u>Ref.</u>
IRRIGATORR	841
FLOWGUN	840
ACCESS 2	
ACCESS 3	
ARTICULATOR	
ARTICULATOR 35	
DETACHAPORT	
ECOM	
ENDOCAP	
ENDOPROBE	
ENDOWEAVE	
EV2	
ISOSTAR	
MICROCAP	
OAC	
PERMACLIP	
REFLEX ONE	
REFLEX TL	
SMARTSHIELD	
TIP TRACKER	
TISSUE-LOCK	
UCS	
UCSII	

**Schedule B
to
Trademark and License Security Agreement**

Dated October 29, 1999,

Guarantor: Imagyn Medical Technologies, Inc.

License Agreements

None.

SCHEDULE B

to

Trademark and License Security Agreement (Guarantor)

Dated October 29, 1999

License Agreement

Imagyn entity:	Imagyn Medical Technologies, Inc.(Urohealth Systems, Inc.)
Date of Agreement:	March 12, 1997
Other Parties:	Charles Klieman, M.D. 15141 E. Whittier Blvd., Suite 250 Whittier, CA 90603 John Stiggelbout 89 Girard Ave. Sausalito, CA 94965 J.A. Shafran, Esq. Sonnenschein Nath & Rosenthal 601 South Firgueroa St., Suite 1500 Los Angeles, CA 90017
Description:	License Agreement

LicensedTrademarkImagynMedTechInc102999

RECORDED: 12/02/1999

**TRADEMARK
REEL: 001999 FRAME: 0590**