

04-11-2001



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### RECORDATION FORM COVER SHEET TRADEMARKS ONLY

TO: The Commissioner of Patents and Trademarks: Please record the attached original document(s) or copy(ies).

**Submission Type** 3-26-01

New

Resubmission (Non-Recordation)  
Document ID # \_\_\_\_\_

Correction of PTO Error  
Reel # \_\_\_\_\_ Frame # \_\_\_\_\_

Corrective Document  
Reel # \_\_\_\_\_ Frame # \_\_\_\_\_

**Conveyance Type**

Assignment  License

Security Agreement  Nunc Pro Tunc Assignment

Merger

Change of Name

Other \_\_\_\_\_

Effective Date  
Month Day Year  
04 11 2000

**Conveying Party**  Mark if additional names of conveying parties attached

Name Idaho Technology, Incorporated Execution Date  
Month Day Year  
11 10 2000

Formerly \_\_\_\_\_

Individual  General Partnership  Limited Partnership  Corporation  Association

Other \_\_\_\_\_

Citizenship/State of Incorporation/Organization Utah

**Receiving Party**  Mark if additional names of receiving parties attached

Name Roche Diagnostics GmbH

DBA/AKA/TA \_\_\_\_\_

Composed of \_\_\_\_\_

Address (line 1) Sandhofer StraBe 116

Address (line 2) \_\_\_\_\_

Address (line 3) Mannheim Germany D-68305  
City State/Country Zip Code

Individual  General Partnership  Limited Partnership  Corporation  Association

Other \_\_\_\_\_

Citizenship/State of Incorporation/Organization Germany

If document to be recorded is an assignment and the receiving party is not domiciled in the United States, an appointment of a domestic representative should be attached. (Designation must be a separate document from Assignment.)

FOR OFFICE USE ONLY

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04/10/2001 TDIAZ1 00000148 2247017

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Public burden reporting for this collection of information is estimated to average approximately 30 minutes per Cover Sheet to be recorded, including time for reviewing the document and gathering the data needed to complete the Cover Sheet. Send comments regarding this burden estimate to the U.S. Patent and Trademark Office, Chief Information Officer, Washington, D.C. 20231 and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Paperwork Reduction Project (0651-0027), Washington, D.C. 20503. See OMB Information Collection Budget Package 0651-0027, Patent and Trademark Assignment Practice. DO NOT SEND REQUESTS TO RECORD ASSIGNMENT DOCUMENTS TO THIS ADDRESS.

Mail documents to be recorded with required cover sheet(s) information to:  
Commissioner of Patents and Trademarks, Box Assignments, Washington, D.C. 20503

REEL: 002267 FRAME: 0593

**Domestic Representative Name and Address**

Enter for the first Receiving Party only.

Name

Address (line 1)

Address (line 2)

Address (line 3)

Address (line 4)

**Correspondent Name and Address**

Area Code and Telephone Number

Name

Address (line 1)

Address (line 2)

Address (line 3)

Address (line 4)

**Pages**

Enter the total number of pages of the attached conveyance document including any attachments. #

**Trademark Application Number(s) or Registration Number(s)**

Mark if additional numbers attached

Enter either the Trademark Application Number or the Registration Number (DO NOT ENTER BOTH numbers for the same property).

Trademark Application Number(s)

Registration Number(s)

<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>

<input type="text" value="2247017"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>

**Number of Properties**

Enter the total number of properties involved. #

**Fee Amount**

Fee Amount for Properties Listed (37 CFR 3.41): \$

Method of Payment: Enclosed  Deposit Account

Deposit Account

(Enter for payment by deposit account or if additional fees can be charged to the account.)

Deposit Account Number: #

Authorization to charge additional fees: Yes  No

**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. Charges to deposit account are authorized, as indicated herein.

Name of Person Signing

Signature

Date Signed

**Annex 1**  
**Products sold by LICENSOR under the Trademark(s)**

Products:

**MACHINES:**

LC24LightCycler®

LC32LightCycler®

**ACCESSORIES/Parts we still sell occasionally:**

1685 LightCycler® Start-Up Kit

1720 LightCycler® Composite Reaction Cuvettes

1750 LightCycler® Centrifuge Adapters

1802 LightCycler® Cleaning Tissues

1803 LightCycler® Cleaning Solution

4905 LightCycler® Blank Sample Tubes

**LC24 & LC32 LightCycler® MACHINE SUB COMPONENTS:**

4500 All mechanical sub components of both LightCycler® instruments

**LC24 & LC32 LIGHTCYCLER™ SOFTWARE:**

1863 All LightCycler® software written by Idaho Technology

LightCycler® Biochemicals

No part numbers yet - Products of this division will include oligonucleotides, probes, kits, product support. Contract research.

## UNITED STATES TRADEMARK LICENSE AGREEMENT

This Agreement is made and entered into this 11th day of April, 2000, by and between Idaho Technology, Incorporated., a Utah corporation, having a place of business at 390 Wakara Way, Salt Lake City, Utah 84108, USA (hereinafter, "Idaho"), and Roche Diagnostics GmbH, a German corporation, having a place of business at Sandhofer Straße 116, D-68305 Mannheim, Germany, (hereinafter, "Roche").

WHEREAS, Roche is the owner by assignment of U.S. trademark no. 2247017 for the mark LIGHTCYCLER, as well as other trademarks around the world and common law rights in the U.S., and has the exclusive right to license the Trademark in the United States;

WHEREAS, the parties have entered into a World-wide Assignment and License-Back agreement dated April 11, 2000, in which Roche has granted a license to Idaho to use the LIGHTCYCLER trademark in various countries around the world,

WHEREAS, Idaho desires to acquire a limited license from Roche to use the Trademark on and in connection with certain Goods in the United States, as defined below,

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the parties agree:

### 1. Definitions

- a. "Idaho" shall include its Affiliates, as defined below.
- b. "Roche" shall include its Affiliates, as defined below.
- c. "Affiliates" shall mean any corporation, firm, partnership or other entity, whether de jure or de facto, which directly or indirectly owns, is owned by or is under common ownership with a party to this Agreement of at least fifty percent (50%) of the equity (or such lesser percentage which is the maximum allowed to be owned by a foreign corporation in a particular jurisdiction) having the power to vote on or direct the affairs of the entity and any person, firm, partnership, corporation or other entity actually controlled by, controlling or under common control with a party to this Agreement, with the exception of Genetech, Inc., 1 DNA Way, South San Francisco, California 94080-4990, USA, which shall not be an Affiliate under this Agreement unless Roche explicitly opts for such inclusion by giving written notice.
- d. "Goods" shall mean any product covered by the License and Distribution Agreement July 10, 1997 and other Idaho product sold under the Trademark as specified in Annex 1;

- e. "Trademark" shall mean U.S. trademark no. 2247017.
- f. "Agreement" shall mean this Licensing Agreement.

2. Scope

As of the date of execution of this Agreement, the Trademark License Agreement of April 29, 1999 shall be considered to be terminated and replaced by this Agreement.

This Agreement is intended to supplement the Worldwide Trademark Assignment and License Back Agreement dated April 11, 2000, pursuant to paragraph 6.02 of that Agreement.

**LICENSE**

1. Grant of License

Upon the terms and conditions of this Agreement, Roche grants to Idaho a royalty-free, non-exclusive, and limited license to use the Trademark solely on and in connection with the manufacture, sale, and distribution of the Goods in the United States. Idaho shall not use the Trademarks or similar marks, in whole or in part, on or in connection with any other goods or services or permit or authorize others to use the Trademark or similar makes, in whole or in part, in any manner without the prior express written approval of Roche. Idaho shall not grant a sub-license without the express written permission of Roche, which shall not be unreasonably withheld.

2. Ownership of Trademarks and Validity of Roche's Marks

Idaho acknowledges that Roche owns the Trademark and all registrations thereof and that the Trademarks and registrations are valid. Idaho shall do nothing inconsistent with Roche's ownership of the Trademark and registrations thereof. All use of the Trademark by Idaho shall inure to the benefit of and be on behalf of Roche. Nothing in this Agreement shall give Idaho any right, title, or interest in the Trademarks other than the license to use the Trademark in accordance with this Agreement. Idaho shall not contest Roche's title to or the validity of the Trademark. Idaho further acknowledges that the Trademark is owned by Roche, that Idaho is being permitted to use the Trademark for a limited period of time to avoid confusion in the trade; and that Idaho should do nothing to detract from Roche's goodwill in the Trademark

3. Term and Termination

- a. This Agreement and the license granted by the Agreement are effective as of April 11, 2000, and shall continue in force until the termination of the License and

Distribution Agreement of July 10, 1997, unless earlier terminated as provided for herein (the "Term"). This Agreement may be terminated forthwith by either party if it is determined that:

- (1) The Agreement dated July 10, 1997 has expired or has been terminated for any reason whatsoever; or
- (2) Either party commits a substantial breach of any of the terms of this Agreement; or
- (3) The parties mutually agree in writing to modify or terminate this Agreement

4. Quality Standards For Goods

- a. Idaho acknowledges the current quality standards of the Goods sold under the Trademark, and agrees to maintain the current quality of the Goods sold under the Trademark. Idaho acknowledges that Roche has the right and duty to ensure that the Goods sold by Idaho under the Trademarks meet the current quality standards.
- b. To assure that the Goods sold by Idaho under the Trademarks meet the current quality standards, from time to time Roche may request that Idaho ship to Roche at least one (1) sample of each of its Goods with which the mark is used.
- c. Idaho shall comply with all applicable laws and regulations and obtain all appropriate government approvals pertaining to the manufacturing, sale, distribution, and advertisement of the Goods.
- d. If Idaho shall, at any time during the Term of this Agreement, breach any of its obligations hereunder, and such breach shall not be cured within ninety (90) days after written notice from Roche to Idaho specifying the nature of the breach, Roche may immediately terminate the license granted under this Agreement by giving written notice of such termination. Upon termination of this Agreement Idaho shall immediately cease all use of the Trademark.

5. Form of Use

Idaho shall use the Trademarks only in the form and manner approved by Roche. After the form and manner of use have been approved by Roche, Idaho shall not depart therefrom without Roche's written approval.

6. Trademark Maintenance and Defense

- a. Idaho hereby indemnifies Roche and undertakes to defend Roche and hold it harmless from occurrences after the Term resulting in any claims, suits, loss, damage, and costs (including reasonable attorney fees and expenses) arising out of Idaho's advertisement, offer for sale, sale, distribution, or use of the Goods, arising out of any alleged defects in the Goods which are manufactured by Idaho or by a third party manufacture who manufactures any of the Goods for Idaho.
- b. Roche hereby represents that it has the right to grant the License as provided in this Agreement. Roche shall file, register, maintain and defend the Trademark, in order to maintain their legal validity for the duration of this Agreement.
- c. In case a claim is made by a third party against either party, the other party shall to the best of its abilities cooperate in the defense of such claim and shall make all reasonable efforts to secure the testimony of its employees.

7. Use of Trademarks After Termination

Upon termination of this Agreement, Idaho shall have the right to continue using the Trademark under the terms and conditions of this Agreement, including paragraph 4.

8. Independent Relationship

Nothing in this Agreement shall be construed to create a partnership or joint venture between Roche and Idaho. This Agreement does not make either party the agent or legal representative of the other except as expressly set forth herein. The parties further agree that no representation shall be made by either party that shall create an apparent agency, employment, partnership or joint venture relationship. Neither party shall have the power, express or implied, to obligate or bind the other in any manner whatsoever.

9. Severability

If any provision of this Agreement is found invalid or ineffective, such provision shall be null and void and shall be deemed deleted from this Agreement, and all the remaining provisions of this Agreement shall remain in full force and effect.

10. Notices

Notices provided herein shall be given by certified mail. Return receipt requested, to Roche and Idaho at the following addresses, or such other addresses as may be specified by notice given:

Roche: Roche Diagnostics GmbH

Legal Department, GL-M  
Sandhofer Straße 116  
D-68305 Mannheim  
Germany

Idaho Randy Rasmussen, Ph.D.  
Idaho Technology, Inc.  
390 Wakara Way  
Salt Lake City, UT 84108  
USA

with copies to:  
Mark A. Cotter  
Switter Axland  
175 South West Temple  
Salt Lake City, UT 84101-1480  
USA

11. Applicable Law

This Agreement shall in all respects be interpreted and construed in accordance with and governed by the laws of the United States of America and the State of Indiana.



12. Binding and Assignment

This Agreement shall be binding upon and inure to the benefit of the heirs, successors, and assigns of the parties hereto.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed by their respective authorized representatives and agree that the effective date of this Agreement shall be the date first above written.

Roche Diagnostics, GmbH  
ppa.

Idaho Technology, Inc.

By: *R. Rutsch*  
Dr. Rutsch

By: *[Signature]*

Printed Name

*KIRK RIRIE*  
Printed Name

SVP Legal  
SVP Legal  
Title

*PRESIDENT*  
Title

*October 23, 2000*  
Date

*Nov 10, 00*  
Date

STATE OF \_\_\_\_\_ )  
                                      ) SS:  
COUNTY OF \_\_\_\_\_ )

On the *26* th day of *Oktober*, 2000, before me, a Notary Public in and for said County and State, personally appeared \_\_\_\_\_ and acknowledged that he/she is the \_\_\_\_\_ of \_\_\_\_\_; that he/she is authorized by said Corporation to execute the foregoing Assignment on behalf of said Corporation; and that he/she did execute the foregoing Assignment on behalf of said Corporation, pursuant to such authority.



*[Signature]*  
Notary Public

Printed Name

My Commission Expires: \_\_\_\_\_  
County of Residence: \_\_\_\_\_

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NUNC PRO TUNC TRADEMARK ASSIGNMENT

Effective April 11, 2000, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, Idaho Technology, Incorporated., a Utah corporation, having a place of business at 390 Wakara Way, Salt Lake City, Utah 84108, USA (ASSIGNOR), hereby assigns, sells, conveys and transfers to Roche Diagnostics GmbH, a German corporation, having a place of business at Sandhofer Straße 116, D-68305 Mannheim, Germany, (ASSIGNEE), all rights, title and interests in and to U.S. Trademark Registration No. 2247017 for the mark LIGHTCYCLER, the registration thereto, including all common law rights and the goodwill of the business with which the Mark is used, together with all claims for damages by reason of infringement, with the right to sue for and collect the same for its own use and for the use of its successors and assigns.

ASSIGNOR: Idaho Technology, Inc.

Signed: [Signature]

Printed: KIRK RIRIE

Title: PRESIDENT

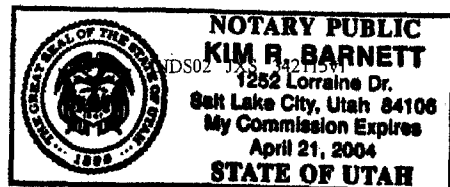
Date: NOV 10, 00

STATE OF Utah )  
 ) SS:  
COUNTY OF Salt Lake )

On the 10 day of November, 2000, before me, a Notary Public in and for said County and State, personally appeared Kirk Ririe and acknowledged that he/she is the Pres of Idaho Technology that he/she is authorized by said Corporation to execute the foregoing Assignment on behalf of said Corporation; and that he/she did execute the foregoing Assignment on behalf of said Corporation, pursuant to such authority.

[Signature]  
Notary Public  
Kim R. Barnett  
Printed Name

My Commission Expires: 4-21-2004  
County of Residence: Salt Lake



STATE OF UTAH  
April 27, 2004  
My Commission Expires  
Bell Lake City, Utah 84108  
1250 Lorraine Dr.  
KIM R. BARNETT  
NOTARY PUBLIC



Certification/Beglaubigung

I hereby certify, that the forgoing are the true signatures acknowledged in my presence of  
Hiermit beglaubige ich, daß vorseitige Unterschriften vor mir vollzogen wurden durch

1. Mr./Herrn Klaus Gilow, Senior Vice President,  
2. Mr./Herrn Dr. Claus-Jörg Rütsch, Senior Vice President  
both with business adress Sandhofer Str. 116, 68305 Mannheim  
personally known.  
beide geschäftsansässig  
persönlich bekannt.

From todays Inspection of the Commercial Register of the Local Court of Mannheim, I hereby certify, that  
Gemäß heutiger Einsicht in das Handelsregister des Amtsgerichts Mannheim, bescheinige ich, daß die

**Roche Diagnostics GmbH**

having its principal place of business at Mannheim is registered in Section B No. 3962 and furthermore that Mr. Gilow and Dr. Rütsch are general proxy holders (Prokuristen) and are authorized to jointly represent the company.  
mit Sitz in Mannheim unter Nr. HRB 3962 eingetragen ist und ferner, daß die Herren Gilow und Dr. Rütsch als Prokuristen gemeinsam zur Vertretung der Gesellschaft berechtigt sind.

Mannheim, this 26th day of Oktober 2000 Mannheim, den 26. Oktober 2000

*D. Schwenger*  
(Dr. Schwenger) Notary public  
*D. Schwenger*  
(Dr. Schwenger) Notar



1 UR 4761 /2000  
Kosten bei Zweitschrift  
Der Kostenbeamte