

## TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1  
Stylesheet Version v1.2

ETAS ID: TM625195

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT		
<b>NATURE OF CONVEYANCE:</b>	Trademark Assignment and License Back Agreement		
<b>CONVEYING PARTY DATA</b>			
<b>Name</b>	<b>Formerly</b>	<b>Execution Date</b>	<b>Entity Type</b>
Fisher Island Holdings, LLC		09/23/2020	Limited Liability Company: FLORIDA
<b>RECEIVING PARTY DATA</b>			
<b>Name:</b>	Fisher Island Club, Inc.		
<b>Street Address:</b>	One Fisher Island Drive		
<b>City:</b>	Fisher Island		
<b>State/Country:</b>	FLORIDA		
<b>Postal Code:</b>	33109		
<b>Entity Type:</b>	not-for-profit corporation: FLORIDA		
<b>PROPERTY NUMBERS Total: 2</b>			
<b>Property Type</b>	<b>Number</b>	<b>Word Mark</b>	
<b>Registration Number:</b>	2073672	FISHER ISLAND	
<b>Registration Number:</b>	2061165	FISHER ISLAND CLUB	
<b>CORRESPONDENCE DATA</b>			
<b>Fax Number:</b>			
<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>			
<b>Phone:</b>	305-604-2315		
<b>Email:</b>	dcuason@fisherislandclub.com		
<b>Correspondent Name:</b>	Fisher Island Club, Inc.		
<b>Address Line 1:</b>	One Fisher Island Drive		
<b>Address Line 2:</b>	Attn: General Counsel, Membership Dept.		
<b>Address Line 4:</b>	Fisher Island, FLORIDA 33109		
<b>NAME OF SUBMITTER:</b>	Desiree M. Cuason		
<b>SIGNATURE:</b>	/Desiree M. Cuason/		
<b>DATE SIGNED:</b>	02/08/2021		
<b>Total Attachments: 11</b>			
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**TRADEMARK ASSIGNMENT AND LICENSE BACK AGREEMENT**

This Trademark Assignment and License Back Agreement ("**Agreement**") is made this 23rd day of September, 2020 (the "**Effective Date**"), by and between Fisher Island Club, Inc., a Florida not-for-profit corporation (the "**Club**"), and Fisher Island Holdings, LLC, a Florida limited liability company ("**FIH**"). Each of the Club and FIH is referred to individually as a "**Party**" and both, collectively, as the "**Parties**." Capitalized terms used but not defined herein shall have the meanings ascribed to such terms in the Settlement Agreement (as defined below).

WHEREAS, FIH is the owner of the trademark registrations shown on the attached Schedule 1 (the "**Registrations**"), including the common law rights therein;

WHEREAS, FIH is the owner of common law trademark rights in and to the marks FISHER ISLAND and FISHER ISLAND CLUB for the services provided thereunder (together with the Registrations and the common law rights in the marks in the Registrations, collectively, the "**Fisher Island Trademarks**");

WHEREAS, FIH and its predecessors-in-interest and/or licensees have used one or more of the Fisher Island Trademarks in connection with residential real estate management services, real estate brokerages services, residential real estate development services, and/or hotel and health resort services since at least as early as 1984;

WHEREAS, the Club and FIH have entered into that certain Settlement Agreement, dated as of June 5, 2020 (the "**Settlement Agreement**"), pursuant to which, among other things, the Club and FIH have agreed to make certain modifications to permissible uses, height restrictions, and zoning entitlements on certain parcels within the Fisher Island private community, convey certain real property, effectuate the turnover of certain board of director positions, and release certain claims, as more fully described therein; and

WHEREAS, pursuant to the Settlement Agreement, FIH has further agreed to assign to the Club all of its right, title, and interest in and to the Fisher Island Trademarks and the Registrations, in exchange for the Club's grant to FIH of a non-exclusive, fully paid-up, royalty-free and right and license to use the Fisher Island Trademarks in the Territory in accordance with the terms set forth below.

NOW, THEREFORE, in consideration of the mutual promises set forth herein, and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, and intending to be legally bound, the Club and FIH hereby agree as follows:

1. **Assignment of Fisher Island Trademarks and Registrations.** FIH hereby irrevocably conveys, assigns and transfers (and hereby memorializes the same), to the Club, all of FIH's right, title, and interest in and to the Fisher Island Trademarks, including the Registrations therefor, and all goodwill associated with the Fisher Island Trademarks, including without limitation any legal claims, and choses in action, that FIH may now or hereafter possess relating to the Fisher Island Trademarks (the "**Assignment**").

FIH represents to Club that, subject to the terms hereof, it is assigning to the Club all of its all rights, title and interest in and to the Fisher Island Trademark; that, to the best of its knowledge, the Registrations are valid and are in full force and effect and there are no claims or encumbrances affecting the Fisher Island Trademarks or Registrations; that FIH has the company power and

authority to enter into, execute, deliver and perform the Assignment; and that the Assignment does not constitute a breach of or a default under any agreement to which FIH is a party or is otherwise bound and does not violate any judgment, decree or order of any court or administrative tribunal applicable to FIH.

2. **Non-Exclusive License Back Grant of the Fisher Island Trademarks.** The Club hereby grants to FIH a License (defined below) to use the Fisher Island Trademarks in the Territory, for the Term specified in paragraph 2.f., as more fully set forth below:
- a. **Post-Transfer Activities.** The Club hereby grants to FIH a non-exclusive fully paid-up, royalty-free right and limited sublicensable license (the "**License**") to use the marks FISHER ISLAND and FISHER ISLAND CLUB, whether in standard character format, stylized, or with a design, in connection with any and all goods and services associated with or involving in connection with FIH's development, marketing and brokerage activities in respect of the tower to be built on Parcel 7, the single family residences to be built on Parcel 9, and any unsold inventory in the Palazzo Della Luna tower or the Palazzo Del Sol tower, as well as equity memberships and yacht memberships in the Club held for issuance to original purchasers of residential units in such properties (the "**Post-Transfer Activities**"). To the extent of the License and pursuant thereto, FIH automatically, and without the requirement of any additional consideration, documentation, or agreement, shall have the same rights specified in this Agreement in relation to the Fisher Island Trademarks to use any future versions and modifications of the Fisher Island Trademarks (or any other logo or stylization of the Fisher Island Trademarks) that the Club may adopt and put into use during the Term.
  - b. **Ownership of Fisher Island Trademarks.** FIH acknowledges that the Club is the owner of all right, title, and interest in and to the Fisher Island Trademarks and the Registrations as set forth in Schedule 1 as of the Effective Date and that hereafter all use by FIH of the Fisher Island Trademarks in the Territory shall inure exclusively to the benefit of the Club.
  - c. **Quality Control.** Club shall have the right to set standards relating to the nature and quality of services to be rendered by FIH pursuant to the License, though the parties agree that FIH's continued operation of its business in substantial accordance with its past and present operation of its business shall satisfy such standards. FIH agrees that any and all marketing materials and other merchandise bearing and services offered under the Fisher Island Trademarks shall, at a minimum, meet the same quality level as was in place prior to the Effective Date so as to meet the reasonable expectations of the public. Both Parties agree that they and their respective affiliates shall not take any action, or cause or assist any other party, to disparage, diminish, injure, or damage the reputation and goodwill of the Fisher Island Trademarks or the Club's or FIH's uses thereof. FIH agrees to comply with all applicable laws and regulations and to obtain all required governmental approvals pertaining to the sale, distribution and advertising of goods or services offered under the Fisher Island Trademarks, including those pertaining to the proper use and designation of trademarks, corporate names and trade names.
  - d. **Enforcement and Protection of Trademark Rights.** If FIH becomes aware during the Term (as defined below) of any activities by third parties amounting to possible

infringement or unlawful interference with the Fisher Island Trademarks, FIH will notify the Club promptly of such possible infringement or unlawful interference and, at the Club's request, provide the Club with its reasonable assistance and cooperation in the enforcement of the Club's rights in and to the Fisher Island Trademarks. The Club will, in its sole discretion, determine the course of action to be taken with respect to enforcement of such trademark rights. The Club will reimburse FIH for all reasonable out-of-pocket costs and expenses, including reasonable attorneys' fees, incurred as a result of such assistance and cooperation.

- i. **Enforcement Actions.** In furtherance of the Assignment, and subject to the conditions set forth hereinafter, FIH hereby specifically and exclusively grants to and assigns to Club any and all of FIH's rights and choses-in-action, including without limitation, the right to commence, direct, maintain, defend, settle, and compromise any and all legal claims or choses-in-action by or against third parties (including but not limited to claims of infringement), relating to or arising from FIH's rights in and use of any one or more of the Fisher Island Trademarks (the "**Enforcement Actions**"). Club shall not be obligated to pursue any Enforcement Actions.
  - ii. **Scope.** Enforcement Actions shall include any action or proceeding (including proceedings to oppose or cancel third party trademark applications and/or registrations) which may be brought in state or federal court or before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office. Enforcement Actions shall further include prosecution of state and federal trademark and service mark applications in one or more of the Fisher Island Trademarks.
- e. **Breach of Agreement.** Prior to seeking any remedy for breach of this Agreement, if a Party becomes aware of a breach or default on the part of the other Party of any terms of this Agreement, rather than immediately terminating this Agreement, such Party shall provide notice in accordance with Paragraph 4.m below and allow the other Party sixty (60) business days to cure the breach or default from the date on which the Party gives notice of such breach or default in accordance with Paragraph 4.m, below. The prevailing party in any legal action taken to enforce one or more terms of this Agreement shall recover all of its costs and expenses, including reasonable attorney's fees, incurred in connection with any such legal action.
  - f. **Term.** This Agreement shall take effect on the Effective Date and remain in effect until the consummation of the sale of the last land parcel or residential unit owned by FIH to an original purchaser and FIH has otherwise concluded the Post-Transfer Activities (the "**Term**").
  - g. **Territory, Limitations and Exclusions.** The terms of this License shall be effective in the United States of America only (the "**Territory**"). The Club reserves all rights not expressly granted herein, including but not limited with respect to use and registration of, and other activities relating to, the Fisher Island Trademarks outside the Territory. Club does not object to FIH's use of the Fisher Island Trademarks outside the Territory in connection with the Post-Transfer Activities during the Term; however, except as expressly set forth herein, nothing in this License shall be construed as: (i) a warranty

or representation by Club as to the validity or scope of any of the Fisher Island Trademarks outside of the Territory; (ii) a warranty or representation by Club that any use of the Fisher Island Trademarks under any license granted under this License is or will be free from infringement of any trademarks or tradenames of third persons outside the Territory; or (iii) conferring a right to use in advertising, publicity, or otherwise any other trademark or tradename of Club. FIH shall not use any name or mark that is confusingly similar to the Fisher Island Trademarks both during and after the Term anywhere in the world including the Territory.

- h. **Limitation on FIH Registrations that use FISHER ISLAND.** FIH owns (1) U.S. Trademark Registration No. 5291401, for the trademark PALAZZO DEL SOL FISHER ISLAND, in connection with the following services: (a) real estate brokerage, leasing and management of condominiums, in class 036, (b) residential condominium and mixed use real estate development, in class 037, (c) providing fitness and exercise facilities to residents of luxury condominiums and their guests, in class 041, (d) Providing limited menu food and drink to residents of luxury condominiums and their guests, in class 043, and (e) concierge services for others comprising making requested personal arrangements and reservations and providing customer-specific information to meet individual needs rendered together in a condominium complex, in class 045; and (2) U.S. Registration No. 5885564, for the trademark PALAZZO DELLA LUNA FISHER ISLAND, in connection with the following services: (a) real estate brokerage, leasing and management of condominiums, in class 036, (b) residential condominium and mixed use real estate development, in class 037, (c) providing fitness and exercise facilities to residents of luxury condominiums and their guests, in class 041, (d) Providing limited menu food and drink to residents of luxury condominiums and their guests, in class 043, and (e) concierge services for others comprising making requested personal arrangements and reservations and providing customer-specific information to meet individual needs rendered together in a condominium complex, in class 045 (hereinafter, the "**PALAZZO Trademarks**"). FIH acknowledges and agrees that (1) it has used the PALAZZO Trademarks exclusively in connection with the promotion of the identified services for the benefit of the current and prospective members of the Fisher Island private community, and (2) it will continue to use the PALAZZO Trademarks solely for the promotion of the identified services for the benefit of the current and prospective members of the Fisher Island private community, and that upon the sale of the last residential unit owned by FIH in Palazzo Della Luna and Palazzo Della Sol, it will not continue to use or maintain the PALAZZO Trademarks.
- i. **Exclusions for the use of PALAZZO DELLA LUNA and PALAZZO DEL SOL .** Notwithstanding the limitations of paragraph 2(h), FIH is free to use and register the words "PALAZZO DELLA LUNA" and "PALAZZO DEL SOL," without limitation, apart from the words "FISHER ISLAND," as trademarks. Club consents to FIH using and seeking to register the words PALAZZO DELLA LUNA and/or PALAZZO DEL SOL as trademarks so long as FIH does not include the words FISHER ISLAND (or anything confusingly similar to FISHER ISLAND). Nothing contained in this License shall prohibit Club from continuing to identify the buildings within the Fisher Island private community by their current designations, including, inter alia, the Palazzo Della Luna tower and the Palazzo Del Sol tower, even after the expiry of the Term.

- j. **Limitations on Sublicensing.** The right and license granted herein shall include a limited right of FIH to grant sublicenses to its brokers, agents, marketing representatives and independent contractors (collectively "Permitted Sublicensees") for use solely in connection with the Post-Transfer Activities of FIH. Any such limited sublicense for Post-Transfer Activities granted by FIH hereunder shall be (i) in writing, with a copy provided to Club; and (ii) expressly subject to the terms and conditions of this Agreement, the License granted herein, and all of the rights of Club hereunder. FIH shall be responsible for any breach of this Agreement by any of its respective sublicensees.
3. **Indemnity.** Except as otherwise provided in Paragraph 2, the Club agrees to defend, indemnify, and hold FIH and any of its affiliates, subsidiaries, related companies, agents, predecessors, successors, and assigns harmless against any and all claims, demands, causes of action liability, loss, damage, judgments or expenses (including reasonable attorneys' fees and court costs) arising out of or from any use of the Fisher Island Trademarks by the Club (or its affiliates or licensees other than FIH).

FIH agrees to defend, indemnify, and hold Club and any of its affiliates, subsidiaries, related companies, agents, predecessors, successors, and assigns harmless against any and all claims, demands, causes of action liability, loss, damage, judgments or expenses (including reasonable attorneys' fees and court costs) arising out of or from any use of the Fisher Island Trademarks by FIH (or its affiliates or licensees other than Club).

4. **Miscellaneous.**

- a. **Remedies.** In the event of a default or breach by either Party under this Agreement, the non-defaulting Party shall, after reasonable cure periods, be entitled to all damages available at law resulting in whole or part due to the breach, and all other remedies available at law and in equity, including specific performance and injunctive relief; *provided*, that neither Party nor any other person shall be required to provide any bond or other security in connection with its seeking specific performance or injunction or in connection with any related suit, action or other legal proceeding. For purpose of the foregoing sentence, the Parties agree that a default by the Club or FIH under this Agreement shall result in irreparable harm for which an adequate remedy at law will not be sufficient or available.
- b. **Jurisdiction and Venue for Enforcement of Agreement and Disputes.** The Parties agree that jurisdiction and venue lie solely in the state and federal courts in Miami-Dade, County, Florida, to which the Parties consent to the jurisdiction, for any dispute arising between or among the Parties regarding the application, interpretation, enforceability, validity, performance, or breach of this Agreement or matters arising therefrom or relating thereto. The Parties knowingly and intentionally waive, to the fullest extent permitted by law, any objection which they may have now or later to the exclusive jurisdiction and laying of venue or any judgment entered by any such court and further knowingly and intentionally waive any claim that any action or proceeding brought in any such court has been brought in an inconvenient forum or improper forum. The prevailing Party of any such legal action is entitled to fees and costs, including reasonable attorneys' fees for any such legal action or related appeals. This Agreement and the rights, duties, and obligations of the Parties to this Agreement shall be interpreted, construed, performed, and enforced in accordance

with, and shall be governed by, the laws of the state of Florida without reference to any conflict-of-laws, rules, or principles that may or would require the application of any other jurisdiction's laws.

- c. **Waiver of Jury Trial.** To the extent not prohibited by applicable legal requirements that cannot be waived, the Parties hereby waive, and covenant that they shall not assert (whether as plaintiff, defendant, or otherwise), any right to trial by jury in any action rising in whole or in part under or in connection with this Agreement, the negotiation, terms, and performance hereof, the rights of the Parties hereunder, or any of the transactions contemplated hereby, and whether sounding in contract, tort, or otherwise. The Parties agree that any of them may file a copy of this paragraph with any court as written evidence of the knowing, voluntary, and bargained-for agreement among the Parties. The Parties further agree to irrevocably waive their right to a trial by jury in any such proceeding and any such proceeding shall instead be tried in a court of competent jurisdiction, in accordance with Paragraph 4.b., by a judge sitting without a jury.
- d. **Fees and Costs.** Each Party shall bear its own fees and costs in connection with its performance of this Agreement, except as set forth in Paragraph 4.b..
- e. **Construction; Headings.** The titles and headings of the various paragraphs of this Agreement are intended solely for convenience of reference and shall not be construed as an explanation, modification or intended construction of any terms or provisions of this Agreement. For all purposes of and under this Agreement, (a) the words "include," "includes," and "including" shall be deemed to be immediately followed by the words "without limitation," (b) words (including defined terms) in the singular shall be deemed to include the plural and vice versa, (c) words of one gender shall be deemed to include the other gender as the context requires, and (d) the terms "hereof," "herein," "hereto," "herewith" and any other words of similar import shall, unless otherwise stated, be construed to refer to this Agreement as a whole (including the schedules and exhibits) and not to any particular term or provision of this Agreement, unless otherwise specified.
- f. **Comprehension of Terms.** The Parties hereby acknowledge that they have entered into this Agreement freely and voluntarily and without coercion or undue influence. The Parties have each retained their own counsel, who have reviewed and participated in the drafting of this Agreement. Accordingly, this Agreement is deemed to have been jointly drafted by the Parties, and any uncertainty or ambiguity shall not be construed for or against any Party as an attribution of drafting by any Party.
- g. **Amendment.** This Agreement may be amended only by a subsequent agreement, in writing, signed by the Parties hereto.
- h. **No Third Party Beneficiaries.** This Agreement is for the sole benefit of the Parties, and nothing herein expressed or implied shall give or be construed to give any person, other than the Parties, any legal or equitable rights hereunder.
- i. **Assignability.** This Agreement is binding upon and shall be for the benefit of the Club and FIH, and their respective successors and assigns (including any construction lender) and, notwithstanding any other provision hereof, shall be assignable only pursuant to a transfer of all or substantially all of the assigning Party's related assets; however, in order for an



assignment by either Party to be valid, the assignee/transferee must assume all rights, duties, liabilities, and obligations, as a whole and in their entirety, of the assignor/transferor as specified in this Agreement, including an express agreement relating to the provisions of Paragraph 4.k. In the event either Party assigns or otherwise transfers its rights, title and interests under this Agreement to another Party, it shall promptly notify the other Party of such and provide full contact information for the assignee/transferee.

- j. **Severability.** If any provision or term of this Agreement is deemed to be illegal or unenforceable in any respect, such provision or term, to the extent illegal or unenforceable shall not affect any other provision or term hereof, and this Agreement shall be construed as if such provision or term had never been contained herein.
- k. **Merger and Integration.** This Agreement, the Settlement Agreement and the documents specifically contemplated hereby and thereby incorporate, embody, express, and supersede all prior agreements and understandings between the Parties relating to any issue between and among them addressed or referenced herein or in the documents specifically contemplated hereby. Notwithstanding the foregoing, this Agreement does not act to replace any existing agreements among the Parties unless specifically stated herein or in the documents contemplated hereby. The Parties agree and represent that there are no representations upon which they relied in entering into this Agreement that are not set forth in writing in this Agreement and the documents specifically contemplated hereby.
- l. **Existing License Agreement.** That certain License Agreement dated as of June 1, 1993 by and between Club, as licensee, and Island Developers, Ltd., a Florida limited partnership, as licensor, pertaining to the Fisher Island Trademarks is hereby extinguished as of the Effective Date and simultaneously with the Assignment.
- m. **Counterparts; Signatures.** This Agreement may be executed in counterparts, all of which taken together shall constitute one and the same instrument. The facsimile or electronic signatures of the Parties shall be deemed to constitute original signatures.
- n. **Notice.** All notices under this Agreement shall be sent via e-mail to the following:

For the Club:

Fisher Island Club, Inc.  
One Fisher Island Drive  
Fisher Island, FL 33109  
Attn: Desiree M. Cuason, General Counsel E-mail: dcuason@fisherislandclub.com

With a copy (which shall not constitute notice) to:

Katz Barron  
901 Ponce de Leon Blvd  
10<sup>th</sup> Floor  
Coral Gables, FL 33134  
Attn: Michael D. Katz  
E-mail: MDK@katzbarron.com

For FIH:

Fisher Island Holdings, LLC  
One Fisher Island Drive  
Fisher Island, FL 33109  
Attn: Heinrich von Hanau  
E-mail: hvh@fisherisland.com

With copies (which shall not constitute notice) to:

Hogan Lovells US LLP  
600 Brickell Avenue, Suite 2700  
Miami, FL 33131  
Attn: John O'Sullivan  
E-mail: john.osullivan@hoganlovells.com

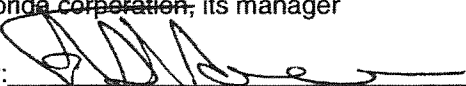
Hogan Lovells US LLP  
1601 Wewatta Street, Suite 900  
Denver, CO 80202  
Attn: Timothy Aragon  
E-mail: timothy.aragon@hoganlovells.com

*[Remainder of page intentionally blank. Signature page follows.]*

IN WITNESS WHEREOF, the Parties have caused this Agreement to be executed as of the Effective Date.

FISHER ISLAND HOLDINGS, LLC,  
a Florida limited liability company

By: FISHER ISLAND INVESTMENTS, INC., a  
Florida corporation, its manager

By:   
Heinrich von Hanau, President

FISHER ISLAND CLUB, INC., a Florida not for  
profit corporation

By: \_\_\_\_\_  
Name: \_\_\_\_\_  
Title: \_\_\_\_\_

[Signature Page to Trademark Assignment and License Back Agreement]

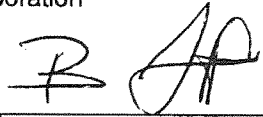
IN WITNESS WHEREOF, the Parties have caused this Agreement to be executed as of the Effective Date.

FISHER ISLAND HOLDINGS, LLC,  
a Florida limited liability company

By: FISHER ISLAND INVESTMENTS, INC., a  
Florida corporation, its manager

By: \_\_\_\_\_  
Heinrich von Hanau, President

FISHER ISLAND CLUB, INC., a Florida not for  
profit corporation



By:  \_\_\_\_\_  
Name: BERNARD LACKNER  
Title: CEO

[Signature Page to Trademark Assignment and License Back Agreement]

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**TRADEMARK**  
**REEL: 007184 FRAME: 0476**

Schedule 1

Mark	U.S. Reg. No.	Services
 The logo for FISHER ISLAND features the words "FISHER ISLAND" in a bold, serif font, enclosed within a decorative, ornate frame with scrollwork and a central crest.	2073672	<b>Class 36:</b> residential real estate management and real estate brokerage services.  <b>Class 37:</b> residential real estate development; planning and laying out of residential communities.
 The logo for FISHER ISLAND CLUB features the words "FISHER ISLAND CLUB" in a bold, serif font, enclosed within a decorative, ornate frame similar to the one above, with scrollwork and a central crest.	2061165	<b>Class 42:</b> hotel and health resort services.

Schedule 1

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