

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

ETAS ID: TM669852

SUBMISSION TYPE:	RESUBMISSION		
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
RESUBMIT DOCUMENT ID:	900634908		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
The Board of Trustees of the Leland Stanford Junior University		06/02/2021	Non-Profit Organization:
RECEIVING PARTY DATA			
Name:	Foldscope Instruments, Inc.		
Street Address:	2625 Middlefield Rd.		
Internal Address:	#938		
City:	Palo Alto		
State/Country:	CALIFORNIA		
Postal Code:	94306		
Entity Type:	Corporation: CALIFORNIA		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Serial Number:	86042206	FOLDSCOPE	
CORRESPONDENCE DATA			
Fax Number:	6503277433		
<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:	650-380-0850		
Email:	christine@foldscope.com		
Correspondent Name:	Christine Kurihara		
Address Line 1:	2625 Middlefield Rd.		
Address Line 2:	#938		
Address Line 4:	Palo Alto, CALIFORNIA 94306		
ATTORNEY DOCKET NUMBER:	S11-473 SE		
NAME OF SUBMITTER:	Christine Q. kurihara		
SIGNATURE:	/Christine Q. Kurihara/		
DATE SIGNED:	08/24/2021		
Total Attachments: 6			

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TRADEMARK ASSIGNMENT AGREEMENT

This Trademark Assignment Agreement (the “Agreement”) is made as of June 1, 2021 (the “Effective Date”) by and between THE BOARD OF TRUSTEES OF THE LELAND STANFORD JUNIOR UNIVERSITY (“Assignor”), an institution of higher education having powers under the laws of the State of California, and Foldscope Instruments, Inc. (“Assignee”), a Delaware corporation with its principal place of business at 1086 Folsom St., San Francisco, CA 94103 (referred to collectively as the “Parties” and individually as a “Party”).

WHEREAS, Assignor owns certain rights in the FOLDSCOPE trademark, including the domain names listed in Exhibit A, (“Mark”);

WHEREAS, Assignor wishes to assign to Assignee its ownership rights in the Mark, and Assignee wishes to accept such assignment on an as-is and where-is basis;

NOW, THEREFORE, in consideration of the mutual agreements, provisions and covenants contained herein, the Parties agree as follows:

1. ASSIGNMENT

Assignor hereby assigns to Assignee all of Assignor’s ownership interest throughout the world in the Mark, together with Assignor’s ownership interest in (a) national, foreign and state trademark registrations, applications for registration and renewals and extensions thereof; (b) all common law rights related thereto; (c) all goodwill associated therewith, and (d) and all benefits, privileges, causes of action and remedies relating to any of the foregoing, whether before or hereafter accrued (including, without limitation, the exclusive rights to apply for and maintain all such registrations, renewals and/or extensions; to sue for all past, present or future infringements or other violations of any rights in the Mark; and to settle and retain proceeds from any such actions) (collectively, the “Rights”). Assignor agrees not to challenge the validity of Assignee’s ownership interest in the Marks.

2. DEFINITIONS

2.1 **License to Mark.** Assignee hereby grants to Assignor a non-exclusive, non-transferable, non-sublicensable, royalty-free, perpetual right and license to use the Mark only with respect to Assignee’s products supplied by Assignee and in connection with Assignor’s exercise, on behalf of itself and Stanford Health Care, of its retained rights under Section 3.3 of the Exclusive (Equity) Agreement between the Parties, dated June 1, 2016 (“Exclusive Agreement”). Assignor will include an appropriate trademark indicator (“™” or “®”) with the first prominent use of the FOLDSCOPE mark and will include the following legend: “FOLDSCOPE is the trademark of Foldscope Instruments, Inc. and is

being used by permission.” Assignor agrees that all use of the Mark, and all goodwill arising out of such use, will inure to the sole benefit of Assignee. Subject to Assignee’s approval, if Assignor believes that the need should arise for Assignor to substitute alternative marks for the Mark used under this section 2.1 (e.g., potential third party infringement claims), Assignor has the right to make such substitutions.

- 2.2 **Restrictions.** Assignor will not reproduce or use the Mark in any manner whatsoever other than as expressly authorized by Section 2.1, and all uses of the Mark will comply with any trademark guidelines that Assignee may provide from time to time. Assignor acknowledges that it has not acquired, and will not acquire, any right, title or interest in or to the Mark except the limited right to use the Mark as expressly set forth in Section 2.1. Assignor agrees not to register or attempt to register the Mark, and as between Assignor and Assignee, Assignee will retain the exclusive right to apply for and obtain registrations for the Mark throughout the world.

3. COOPERATION

Assignor shall execute any written instruments necessary to effectuate the assignments made under this Agreement.

4. PAYMENT

As full payment for the assignment of the Rights, Assignee will pay to Assignor the noncreditable, nonrefundable assignment price of \$9,000, which will be due on the Effective Date of this Agreement.

5. INDEMNITY; LIABILITY; REPRESENTATIONS; AND INSURANCE

- 5.1 **Indemnification.** Assignee will indemnify, hold harmless, and defend all Stanford Indemnitees against any claim of any kind arising out of or related to the exercise of any rights granted or assigned to Assignee under this Agreement or the breach of this Agreement by Assignee. As used in this section, "Stanford Indemnitees" means Assignor, Stanford Health Care, Lucille Packard Children’s Hospital, and their respective trustees, officers, employees, students, agents, faculty, representatives, and volunteers.
- 5.2 **Limitation of Liability, No Indirect Liability.** Assignor is not liable for (1) any direct damages in excess of the assignment price and (2) any special, consequential, lost profit, expectation, punitive or other indirect damages in connection with any claim arising out of or related to this Agreement, whether grounded in tort (including negligence), strict liability, contract, or otherwise.
- 5.3 **Workers’ Compensation.** Assignee will comply with all statutory workers' compensation and employers' liability requirements for activities performed under this Agreement.
- 5.4 **Insurance.** During the term of this Agreement, Assignee will maintain Comprehensive General Liability Insurance, including Product Liability Insurance, with a reputable and

financially secure insurance carrier to cover the activities of Assignee and its sublicensees. The insurance will provide minimum limits of liability of \$2,000,000 and will include all Stanford Indemnitees as additional insureds. Insurance must cover claims incurred, discovered, manifested, or made during or after the expiration of this Agreement and must be placed with carriers with ratings of at least A- as rated by A.M. Best. Within 15 days of the Effective Date of this Agreement, Assignee will furnish a Certificate of Insurance evidencing primary coverage and additional insured requirements. Assignee will provide to Assignor 30 days prior written notice of cancellation or material change to this insurance coverage. Assignee will advise Assignor in writing that it maintains excess liability coverage (following form) over primary insurance for at least the minimum limits set forth above. All insurance of Assignor will be primary coverage; insurance of Stanford Indemnitees will be excess and noncontributory.

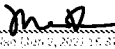
- 5.5 **No Representations.** The Rights are assigned by Assignor on an as-is and where-is basis. No representations or warranties are made under this Agreement regarding the Mark or Rights. Assignor disclaims all express, implied, statutory and other warranties, including the warranty of merchantability, fitness for purpose, title and non-infringement.

6. MISCELLANEOUS


This Agreement and all claims arising from it shall be construed in accordance with the laws of the State of California, without giving effect to any choice of law rule that would cause the application of the laws of any jurisdiction other than the internal laws of the State of California to the rights and duties of the Parties. The Parties consent to the exclusive jurisdiction of State and Federal Courts located in San Jose, California. The Parties hereto shall not be considered as joint venturers, partners, employers or agents of each other, and neither shall have the power to bind or obligate the other except as set forth in this Agreement. This Agreement may be executed in two (2) or more copies, each of which shall be deemed an original, but all of which together shall constitute one and the same instrument. If any provision or provisions of this Agreement are held to be invalid, illegal or unenforceable, in whole or in part, under any law or regulation, by a court of competent jurisdiction, then such provision or portion of such provision, as appropriate, shall remain in effect only to the extent that it is valid, and the validity, legality and enforceability of the remaining provisions of this Agreement shall remain in full force and effect and shall in no way be affected, impaired or invalidated thereby. This Agreement constitutes the entire agreement between the Parties relating to the subject matter hereof and supersedes all prior agreements, understandings and representations concerning such subject matter. No amendment or modification to any of the terms hereof shall be valid or binding upon the Parties unless made in writing and signed by duly authorized representatives of the Parties.

The Parties execute this Agreement in duplicate originals by their duly authorized officers or representatives.

THE BOARD OF TRUSTEES OF THE LELAND
STANFORD JUNIOR UNIVERSITY

Signature: 
Name: Mona Wan
Title: Associate Director
Date: Jun 2, 2021

FOLDSCOPE INSTRUMENTS, INC

Signature: 
Name: James S Cybulski
Title: CEO of Foldscope Instruments, Inc.
Date: Jun 2, 2021

I acknowledge that I have read this Agreement in its entirety and will use reasonable efforts to uphold my obligations and responsibilities under this Agreement.

DR. MANU PRAKASH


Signature: 
Name: Manu Prakash
Title: Associate Professor
Date: Jun 2, 2021

Exhibit A

Mark

1. Foldscope
2. <http://microcosmos.foldscope.com>
3. www.foldscope.com


Foldscope - Trademark Assignment - FINAL


Final Audit Report


2021-06-02


Created:	2021-06-02
By:	Office of Technology Licensing Stanford University (otl@stanford.edu)
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"Foldscope - Trademark Assignment - FINAL" History

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 Agreement completed.
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TRADEMARK

RECORDED: 08/06/2021

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