

12/22/03

12-24-2003

Form PTO-1594 (Rev. 10/02) OMB No. 0651-0027 (exp. 6/30/2005) Tab settings



U.S. DEPARTMENT OF COMMERCE U.S. Patent and Trademark Office

102632307

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Xerox Corporation

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

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

3. Nature of conveyance:

- Assignment Merger Security Agreement Change of Name Other

Execution Date: 05/13/1999

2. Name and address of receiving party(ies)

Name: dpiX, LLC

Internal Address:

Street Address: 3406 Hillview Ave.

City: Palo Alto State: CA Zip: 94304

- Individual(s) citizenship Association General Partnership Limited Partnership Corporation-State Other Limited Liability Company

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 number(s):

A. Trademark Application No.(s)

B. Trademark Registration No.(s) 2168064, 2179041

Additional number(s) attached Yes No

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

Name: Robert Kane

Internal Address: dpiX, LLC

Street Address: 3406 Hillview Ave.

City: Palo Alto State: CA Zip: 94304

6. Total number of applications and registrations involved:

2

7. Total fee (37 CFR 3.41) \$ 65

- Enclosed Authorized to be charged to deposit account

8. Deposit account number:

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DO NOT USE THIS SPACE

9. Signature.

Dr. John M. Manning

Name of Person Signing

Signature

12/09/2003

Date

Total number of pages including cover sheet, attachments, and document: 11

12/24/2003 LMUELLER 00000038 2168064

Mail documents to be recorded with required cover sheet information to: Commissioner of Patent & Trademarks, Box Assignments Washington, D.C. 20231

01 FC:8521 02 FC:8522

40.00 OP 25.00 OP

TRADEMARK REEL: 002884 FRAME: 0837

AMENDED AND RESTATED TECHNOLOGY AGREEMENT

This AMENDED AND RESTATED TECHNOLOGY AGREEMENT ("Agreement") is entered into as of May 3, 1999, between Xerox Corporation, a New York corporation ("Xerox"), and dpiX, Inc., a Delaware corporation.

WITNESSETH:

WHEREAS, Xerox and dpiX entered into that certain Technology Agreement effective December 18, 1998;

WHEREAS, Xerox and dpiX desire to amend and restate said Technology Agreement at the Effective Time (as defined below) replacing said agreement in its entirety with this Amended and Restated Technology Agreement;

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

ARTICLE 1 - DEFINITIONS

Unless otherwise specifically defined below, all capitalized words and other defined terms shall have the meanings ascribed to them in the Agreement and Plan of Merger, dated as of May 3, 1999, among Xerox, dpiX and New dpiX LLC (the "Merger Agreement").

1.01 **FX** shall mean Fuji Xerox Co. Ltd.

1.02 **Intellectual Property** shall mean all worldwide intellectual property rights, including without limitation, all issued and pending patents, patent applications and foreign equivalents thereof, unpatented inventions and invention disclosures, registered and unregistered copyrights, know-how, trade secrets, and information contained in notebooks and drawings, registered and unregistered trademarks along with applications for registration thereof, trade names, Internet domain names, logos, icons and protectable trade dress.

1.03 **Group A Intellectual Property** shall mean those issued-patents and pending patent applications, together with their foreign equivalents, and invention proposals, if any, listed in Exhibit A attached hereto, together with all forms of Xerox Technology (other than patent and utility model rights, created, conceived, reduced to practice, published, or otherwise originated or obtained by or on behalf of Xerox), but only as related to the dpiX Field, and specifically related to the items listed in Exhibit A, and are owned, controlled or licensable by Xerox. dpiX shall have one (1) year from the Effective Time to request that a specifically identified item of Xerox Technology listed in Exhibit B as of the date of execution of this Agreement be added to Exhibit A by Xerox. Xerox shall grant such request if, in Xerox's sole discretion, including the item in Exhibit A would not be detrimental to Xerox's business. dpiX shall specifically identify each item for each such request. Xerox shall not unreasonably withhold a grant of such a request. Section 6.09 notwithstanding, a refusal by Xerox to add an item to Exhibit A under this Section shall not be grounds for arbitration. Xerox will not grant any license of or right to those items listed in Exhibit A pursuant to Section 3.12 and 5.02 hereof.

1.04 **Group B Intellectual Property** shall mean those issued and pending patent applications, together with their foreign equivalents, and Invention Proposals, if any, listed in Exhibit B attached hereto, together with all forms of Xerox Technology (other than patent and utility model rights, created, conceived, reduced to practice, published, or otherwise originated or obtained by or on behalf of Xerox), but only in the dpiX Field and as related to the dpiX Business and which are owned, controlled or licensable by Xerox. dpiX shall have one (1) year from the Effective Time to request that a specifically identified item of Xerox Technology be added to Exhibit B by Xerox. Xerox shall grant such request if, in Xerox's sole discretion, including the item in Exhibit B would be necessary for dpiX's Business. dpiX shall specifically identify each item for each such request. Xerox shall not unreasonably withhold a grant of such a request. Section 6.09 notwithstanding, a refusal by Xerox to add an item to Exhibit B under this Section shall not be grounds for arbitration.

1.05 **Xerox Companies** shall mean FX, Xerox, Xerox Canada, Inc., Xerox Limited (formerly Rank Xerox Limited), and their respective world-wide subsidiaries and affiliates.

1.06 **Xerox Technology** shall mean any and all Intellectual Property and rights thereto relating to the dpiX Field and owned, controlled or licensable by Xerox, excluding all registered and unregistered trademarks along with applications for registration thereof, trade names, logos, Internet domain names, and icons.

1.07 **dpiX Field** shall mean (a) amorphous silicon and polycrystalline silicon sensor image capture devices for detecting (i) particles, or (ii) electromagnetic radiation with wavelengths smaller than 2×10^{-7} meters and (b) amorphous silicon and polycrystalline silicon active matrix liquid crystal image display devices. Excluded from the dpiX Field are all: xerographic devices; copiers and duplicators; printers; facsimile devices; document scanners (where documents for such scanners are fixed in a tangible medium or otherwise); marking processes and marking devices; material ejection processes and devices; microprocessors; integrated circuits; memory devices (other than those with integrally formed sensor devices); solar cells; display devices using rotating picture elements; personal document readers and personal document appliances; components, supplies, software, and scanners for or enabling use of any of the above excluded items; combinations and subcombinations of any of the above excluded items; kits of unassembled elements of any of the above excluded items; all processes specifically related to the above excluded items. Xerox may request of dpiX that a specific area of technology be added to the exclusions list of this Section 1.07. dpiX shall grant such request if doing so would not materially damage dpiX in the dpiX Business. dpiX shall not unreasonably withhold a grant of such a request.

1.08 **dpiX Products** shall mean any and all products, parts thereof, services, and related documentation developed or acquired by dpiX for sale, lease or distribution to customers.

1.09 **Effective Time** shall have the meaning set forth in the Merger Agreement.

1.10 **dpiX Business** shall mean the commercial, industrial, and research dealings in which dpiX is actually and demonstrably involved on the Effective Time, including modifications

or enhancements to its commercial and industrial dealings as of the Effective Time in its markets as of the Effective Time, but excluding any activities related to the exclusions under Section 1.07.

ARTICLE 2 - DISCLOSURE OF INFORMATION

2.01 **Xerox Confidential Information.** All Xerox Technology received by dpiX in accordance with the terms of this Agreement or prior thereto, either being (1) in tangible form and if practicable marked as confidential or (2) in intangible form, or in tangible form but not practicably marked as confidential, and indicated at the time of disclosure to dpiX to be confidential and further summarized in a writing (which writing shall confirm the confidential nature of the information summarized therein) delivered to dpiX within thirty (30) days of initial disclosure, shall be treated in strict confidence by dpiX, and may be used only for or on behalf of dpiX or pursuant to the exercise of its license and sub-license rights under Article 3. dpiX shall use commercially reasonable efforts, but in no event any lesser degree of effort than it uses to protect its own most sensitive confidential information, to prevent inadvertent disclosure to and improper use by any third party of Xerox Technology governed by this Section 2.01.

2.02 **dpiX Confidential Information.** All information owned or controlled by dpiX (other than by operation of this Agreement) disclosed by dpiX to Xerox, either being (1) in tangible form and if practicable marked as confidential or (2) in intangible form, or in tangible form but not practicably marked as confidential, and indicated at the time of disclosure to Xerox to be confidential and further summarized in a writing (which writing shall confirm the confidential nature of the information summarized therein) delivered to Xerox within thirty (30) days of initial disclosure (hereinafter the "dpiX Information"), shall be treated in strict confidence by Xerox, and may be used only for or on behalf of Xerox for purposes consistent with the terms of this Agreement. Xerox shall use commercially reasonable efforts, but in no event any lesser degree of effort than it uses to protect its own most sensitive confidential information, to prevent inadvertent disclosure to and improper use by any third party of the dpiX Information.

2.03 **Termination of Obligations.** The obligations of Section 2.01 and Section 2.02 shall not apply with respect to any particular information: (i) to the extent that:

(a) it was in the public domain, or in recipient's possession free of obligation of confidence, at the time of communication thereof to recipient,

(b) it entered the public domain through no fault of recipient subsequent to the time of its communication to recipient,

(c) at any time after the date of its disclosure it came into recipient's possession free of any obligation of confidence to discloser,

(d) it was rightfully communicated to recipient by a third party free of any obligation of confidence to discloser subsequent to the time of discloser's communication thereof to recipient, or

(e) it was developed by employees or agents of recipient independently of and without reference to any of the information governed by Section 2.01 or Section 2.02;

(ii) is disclosed with the prior written consent of discloser; or (iii) is disclosed pursuant to the order or requirement of a court or similarly empowered administrative or government agency. In the event of a disclosure under subsection (iii) of this Section 2.03, recipient shall give discloser written notice of such order or requirement as soon as practicable prior to disclosure, subject to such order or requirement, and shall provide reasonable cooperation and assistance in opposing such order or requirement if requested by discloser.

ARTICLE 3 - OWNERSHIP AND LICENSE GRANTS

3.01 Xerox Intellectual Property. All Xerox Technology, including but not limited to Group A and Group B Intellectual Property, shall continue to be owned by Xerox and may be used by Xerox in any manner and in any field of business, subject to the grants of rights set forth in this Article 3.

3.02 Group A Intellectual Property. Xerox hereby grants to dpiX in the dpiX Field an exclusive (even as to Xerox and the Xerox Companies) worldwide, royalty free, perpetual (subject to Article 5), sublicensable license (subject to Section 3.04 and Section 3.12) under the Group A Intellectual Property to make, have made, use, import, offer for sale, sell, lease, service, reproduce, create derivatives of and distribute any products, services and related documentation. The foregoing notwithstanding, dpiX shall only have a right to sublicense Group A Intellectual Property under this Section 3.02 to the extent such sublicensing is required to enable a bona fide second source for a dpiX customer, and to permit a customer to take advantage of dpiX Products and such second source products in the dpiX Field.

3.03 Group B Intellectual Property. Xerox hereby grants to dpiX in the dpiX Field a non-exclusive, worldwide, royalty-free, perpetual (subject to Article 5), sublicensable license (subject to Section 3.04 and Section 3.12) under the Group B Intellectual Property to make, have made, use, import, offer for sale, sell, lease, service, reproduce, create derivatives of and distribute any products, services and related documentation in the dpiX Field. The foregoing notwithstanding, dpiX shall only have a right to sublicense Group B Intellectual Property under this Section 3.03 to the extent such sublicensing is required to enable a bona fide second source for a dpiX customer, and to permit a customer to take advantage of dpiX Products and such second source products in the dpiX Field.

3.04 Third Party Rights. The ownership and license rights of the parties under this Article 3 shall be subject in all respects to the licenses and other rights granted by Xerox prior to the date of execution of this Agreement set forth in Exhibit D hereto, including without limitation any renewals, continuations and extensions of such licenses but only to the extent that such renewals, continuations and extensions do not modify in any way the scope or terms of the licensed rights therein in the dpiX Field.

3.05 Software Sub-License Rights. Insofar as any dpiX Product is comprised of or incorporates software of which the copyrights are vested in Xerox, dpiX may sublicense

third parties to use, reproduce, create derivatives of and distribute such software, in object code format only, under any Intellectual Property in such software licensed by Xerox to dpiX under Sections 3.02 and 3.03.

3.06 Sublicenses. Any sublicense granted by dpiX pursuant to the right to grant sublicenses of Sections 3.02 and 3.03 shall expressly be subject to the provisions of Section 3.04, Section 3.12, and Section 5.02, and shall expressly include an obligation that the sublicensed party maintain the confidentiality of any Xerox Technology consistent with the obligations of dpiX hereunder.

3.07 Maintenance of Intellectual Property Rights.

(a) Xerox may, solely at its own discretion, take all actions necessary and commercially reasonable to apply for, prosecute, defend, maintain, and otherwise perfect any Intellectual Property rights in and to the Xerox Technology. dpiX shall take all actions and provide all assistance reasonably required by Xerox in order that Xerox may take any action contemplated by this Section 3.07(a). Nothing in this Agreement shall obligate Xerox in any way to apply for, prosecute, defend, maintain, or otherwise perfect any intellectual property rights in and to Xerox Technology.

(b) Xerox will provide dpiX with advance notice of Xerox' intent to abandon or forego applying for, prosecuting, defending, maintaining, or otherwise perfecting any Intellectual Property rights licensed to dpiX pursuant to Article 3 hereof, and as to any such Intellectual Property rights in such notice, provide dpiX with the right and option to itself, and at its own expense, apply for, prosecute, defend, maintain, or otherwise perfect same in its own name. In the event dpiX elects to exercise its rights under this Section 3.07(b), Xerox will assign all right, title, and interest in and to such Intellectual Property right (subject to Sections 3.04 and 3.12) without limitation to field of use. Xerox will cooperate fully with dpiX to perfect such rights, including without limitation, executing all assignments and other documentation necessary to formally transfer title thereto in the U.S. Patent and Trademark Office and any like offices in foreign jurisdictions.

(c) In the event dpiX elects to exercise its rights under Section 3.07(b), dpiX grants to the Xerox Companies, an irrevocable, non-exclusive, royalty-free, world-wide, sublicensable license to rights obtained thereby to make, have made, use, import, offer for sale, sell, lease, license, disclose, reproduce, create derivatives of and distribute any products, services and related documentation outside the dpiX Field.

3.08 Enforcement. dpiX may, from time to time, report in writing to Xerox the identity of third parties who dpiX has a reasonable belief may be infringing the Group A Intellectual Property rights licensed to dpiX herein. As part of such report, dpiX shall provide Xerox with a letter from dpiX's intellectual property counsel, comprised of a good faith specific

and itemized writing, indicating: the alleged infringing party; the item or items of Group A Intellectual Property alleged to be infringed, including the claim or claims alleged to be infringed if such item is a patent; the item or items alleged to be infringing; any impediment which may affect Xerox's ability to bring an action for infringement, including but not limited to prior art of any kind (including systems, devices, processes and the like), patents, publications, disclosures, sales, and offers for sale, and any activities affecting enforceability, if known; and a sales forecast showing ongoing annual sales attributable to the alleged infringement of at least \$1,000,000. Xerox may, at its sole discretion, investigate the reported alleged infringement, and may further at its sole discretion act to enforce such intellectual property rights. If Xerox elects to enforce such rights, Xerox shall consult with dpiX, and if Xerox and dpiX cannot timely reach an agreement on how to allocate the costs therefor, Xerox may elect to enforce the rights at its own expense or allow dpiX to enforce the rights at its own expense and in its own name or, in the name of Xerox if necessary to establish standing. If, within 90 days of receiving an infringement report from dpiX, including the aforementioned writing, Xerox does not elect to enforce its rights in Group A Intellectual Property identified in such report or if Xerox does not diligently continue prosecution of such claims of infringement, Xerox agrees to cooperate with dpiX, at dpiX's sole expense, in the enforcement by dpiX of such Group A Intellectual Property rights against an alleged infringer (i.e., a party not licensed by Xerox) within the grant of rights to dpiX under Section 3.02. Notwithstanding the foregoing, Xerox will have no right to grant a license under Group A Intellectual Property in the dpiX Field. Xerox will have no obligation to cooperate with dpiX, and dpiX will have no right to join and will not seek to join Xerox, in the enforcement of any intellectual property rights which, in the sole opinion of Xerox, (i) would jeopardize a relationship Xerox has or may be interested in establishing with any third party, or (ii) would expose Xerox to legal liability, or (iii) would otherwise adversely affect Xerox's business (including loss or limitation of its assets) or personnel, or (iv) Xerox would otherwise be precluded from enforcing. In addition, dpiX hereby agrees to indemnify, reimburse, and hold Xerox harmless for any costs, expenses or losses incurred by Xerox as a result of dpiX's exercise of its rights under this Section 3.08. For avoidance of doubt, dpiX acknowledges that dpiX has no right to assert infringement claims without the cooperation of Xerox. Further, dpiX shall never have any right to independently act to enforce its rights in Xerox Technology against FX.

3.09 No Enforcement. Xerox covenants and agrees that it and the Xerox Companies will not enforce against dpiX or its sublicensees any Intellectual Property right with respect to any business activity of dpiX or its sublicensees, so long as such activity was conducted as part of the dpiX Business on or prior to the Effective Time. Furthermore, Xerox and the Xerox Companies hereby release dpiX along with its officers, directors and agents from any and all claims, losses, damages and liabilities for infringement of any Xerox or Xerox Company Intellectual Property arising out of acts prior to the Effective Time.

3.10 Assignment of Trademarks. Xerox hereby grants, assigns and releases to dpiX all of its right, title and interest in and to the trademarks, trade names, logos and Internet domain names identified in Exhibit C hereto. Xerox will promptly deliver to dpiX all relevant paper work respecting registered trademarks and trademark applications and all documentation necessary to formally transfer title thereto in the U.S. Patent and Trademark Office and any like offices in foreign jurisdictions. Subject to Xerox's representations and warranties herein and in the Merger Agreement and exhibits thereto, dpiX hereby releases Xerox from any liability regarding

the applications for trademarks identified in Exhibit C, and any use of the items listed in Exhibit C prior to the Effective Time. Xerox will cooperate fully with dpiX to transfer, perfect, and enforce such rights, including without limitation executing all assignments and other documentation deemed necessary by dpiX to carry out the purpose of this Section 3.10.

3.11 Post Execution Date Inventions. For inventions first conceived on or after the Effective Time, and with respect to employees hired on or before the Effective Time by dpiX, Xerox assigns to dpiX any rights it may have in agreements executed by such employees which protect confidential dpiX information developed after the Effective Time or assign to Xerox inventions first conceived after the Effective Time.

3.12 Limitations on Grant. Subject to Section 3.04, for a period of seven (7) years from the Effective Time, Xerox shall not grant any intellectual property cross licenses having an effective date after the Effective Time which license items listed in Exhibit A specifically within the dpiX Field. Thereafter, however, nothing in this Agreement shall limit Xerox's right to grant a cross license which includes a grant to items listed in Exhibit A within the dpiX Field, and modifications, amendments, renewals, continuations, extensions, and replacements thereof, or of licenses in effect as of the Effective Time, provided such cross license also includes a grant from Xerox of rights other than or in addition to the rights granted to dpiX by this Agreement.

However, nothing contained in this Agreement shall limit Xerox Companies' free right to make, have made, use, license, sell, service or otherwise exploit xerographic devices, copiers and duplicators, printers, facsimile devices, document scanners (where documents for such scanners are fixed in a tangible medium or otherwise), marking processes and marking devices, material ejection processes and devices, microprocessors, integrated circuits, memory devices (other than those with integrally formed sensor devices), solar cells, display devices using rotating picture elements, personal document readers and personal document appliances, components, supplies, software, and scanners for or enabling use of any of the above, combinations and subcombinations of any of the above, kits of unassembled elements of any of the above, and all processes specifically related to the above, and such other practices as may be reflected in any addition to Section 1.07 above, nor limit Xerox Companies' free right to perform research in any field.

ARTICLE 4 - WARRANTIES AND DISCLAIMERS

4.01 Warranties. Each party represents and warrants that it has the right to (a) enter into this Agreement, (b) extend the rights, licenses and assurances granted to the other party under this Agreement, and (c) undertake and fully perform its obligations under this Agreement. In addition, and subject to the those items disclosed in Exhibit D, Xerox and dpiX represent and warrant until the fifth anniversary of the Effective Time, that:

(i) Xerox has not granted any rights under Group A Intellectual Property other than those rights granted in the license agreements mention in Section 3.04;

(ii) Neither Xerox nor dpiX has received written notice of any claim or threat of claim that the conduct of dpiX's business infringes the Intellectual Property rights of any third party; and

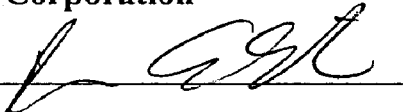
items to Exhibits A or B hereof, or matters as limited in Sections 1.03 and 1.04, any dispute which cannot be so resolved shall be submitted to binding arbitration using a single arbitrator agreed upon by both parties. The arbitration shall be held in New York City, in accordance with then applicable and existing rules of the London Court of International Arbitration. The decision of the arbitrator shall be in writing with findings of fact and conclusions of law, shall be binding and non-appealable, and may be entered by any court of competent jurisdiction.

6.10 **Independent Contractors.** The parties are and shall at all times be and remain independent contractors with respect to each other. Neither party may assume or create any obligation under this Agreement, express or implied, on behalf of the other party, or otherwise represent the other party in any capacity with respect to this Agreement.

6.11 **Entire Agreement.** This Agreement, including Exhibits A, B, C, and D constitutes the entire understanding and agreement of the parties as to its subject matter, and supersedes any and all prior and contemporaneous oral and written understandings and agreements as to such subject matter. This Agreement may be amended only by written amendment duly signed by authorized representatives of both parties.

6.12 **Counterparts.** This Agreement may be executed by the parties hereto in separate counterparts, each of which when so executed and delivered will be an original, but all such counterparts will together constitute one and the same instrument.

Xerox Corporation

By: 

Title: _____

Date: _____

dpiX, Inc.

By: _____

Title: _____

Date: _____

items to Exhibits A or B hereof, or matters as limited in Sections 1.03 and 1.04, any dispute which cannot be so resolved shall be submitted to binding arbitration using a single arbitrator agreed upon by both parties. The arbitration shall be held in New York City, in accordance with then applicable and existing rules of the London Court of International Arbitration. The decision of the arbitrator shall be in writing with findings of fact and conclusions of law, shall be binding and non-appealable, and may be entered by any court of competent jurisdiction.

6.10 **Independent Contractors.** The parties are and shall at all times be and remain independent contractors with respect to each other. Neither party may assume or create any obligation under this Agreement, express or implied, on behalf of the other party, or otherwise represent the other party in any capacity with respect to this Agreement.

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6.12 **Counterparts.** This Agreement may be executed by the parties hereto in separate counterparts, each of which when so executed and delivered will be an original, but all such counterparts will together constitute one and the same instrument.

Xerox Corporation

By: _____

Title: _____

Date: _____

dpiX, Inc.

By:  _____

Title: President

Date: _____

EXHIBIT C

<i>Trademark/Trade Name</i>		<i>Registration Data</i>
dpiX		Reg. No. 2168064
dpiX (design)		Reg. No. 2179041
FLASHSCAN		Ser. No. 75/194092
EAGLE		Ser. No. 75/240635
DIGITAL TRUE		Ser. No. 75/397183
GRADIENT		Ser. No. 75/558405
EXPRESSION		Ser. No. 75/3 81022
IMAGE QUALITY		(Recently filed - no filing receipt)
DIGITAL IQ		(Recently filed - no filing receipt)
<i>Internet domain names</i>		"@dpix.com"