

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT8375908

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	EXCLUSIVE PATENT LICENSE AGREEMENT
CONVEYING PARTY DATA	
Name	Execution Date
MANDLI COMMUNICATIONS, INC.	04/29/2021
DBI SERVICES, LLC	04/29/2021
DBI/CIDAUT TECHNOLOGIES, LLC	04/29/2021
AMAC NORTH AMERICA, LLC	04/29/2021
RECEIVING PARTY DATA	
Name:	FACET TECHNOLOGY CORP.
Street Address:	4555 MERRYWOOD LANE
City:	EXCELSIOR
State/Country:	MINNESOTA
Postal Code:	55331
PROPERTY NUMBERS Total: 14	
Property Type	Number
Application Number:	15993883
Patent Number:	6891960
Patent Number:	7515736
Patent Number:	7995796
Patent Number:	8660311
Patent Number:	8860944
Patent Number:	9335255
Patent Number:	9671328
Patent Number:	9989457
Patent Number:	6674878
Patent Number:	7043057
Patent Number:	7173707
Patent Number:	7411681
Patent Number:	9989456
CORRESPONDENCE DATA	
Fax Number:	(414)273-5198
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent</i>	
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using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.

Phone: 414-273-3500
Email: emcguire@gklaw.com
Correspondent Name: JENNIFER L. GREGOR; GODFREY & KAHN, S.C.
Address Line 1: 833 E. MICHIGAN STREET, SUITE 1800
Address Line 4: MILWAUKEE, WISCONSIN 53202-5615

ATTORNEY DOCKET NUMBER:	010683.0014
NAME OF SUBMITTER:	JENNIFER L. GREGOR
SIGNATURE:	/Jennifer L. Gregor/
DATE SIGNED:	01/11/2024

Total Attachments: 6

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EXCLUSIVE PATENT LICENSE AGREEMENT

This Exclusive Patent License Agreement ("Agreement") is made as of the 29th day of April, 2021 ("Effective Date"), between Facet Technology Corp. ("Facet"), a Minnesota Corporation with an office at 4555 Merrywood Lane, Excelsior, MN 55331; Mandli Communications, Inc. ("Mandli"), a Wisconsin Corporation having its principal place of business at 2655 Research Park Dr., Fitchburg, WI 53711-4906; DBi Services, LLC ("DBi"), a Pennsylvania Limited Liability Corporation having its principal place of business at 100 North Conahan Drive, Hazleton, PA 18201; DBi/Cidaut Technologies, LLC, a Delaware Limited Liability Corporation having its principal place of business at 100 North Conahan Drive, Hazleton, PA 18201 ("DBi/Cidaut"); and AMAC North America, LLC, a Delaware Limited Liability Corporation having its principal place of business at 100 North Conahan Drive, Hazleton, PA 18201 ("AMAC"), each of which may be individually referred to as a "Party" and all of which may be collectively referred to as "Parties" in this Agreement.

WHEREAS, Facet originally filed certain patent applications with priority dates back to 2000-2001 relating to roadway reflective surfaces, including assessment, determination, and/or mapping of road signs and/or lane markings (the "Facet Patent Family"); and

WHEREAS, Facet in 2011 licensed certain of the patents and patent applications in the Facet Patent Family to Mandli and then in 2017 sold the remaining patents and patent applications in the Facet Patent Family as set forth in Schedule 1.1 to Mandli; and

WHEREAS, Facet in 2012 licensed and then in 2014 sold certain of the patents and patent applications in the Facet Patent Family as set forth in Schedule 1.2 to DBi; and

WHEREAS, the Parties in 2019 entered into a License Agreement that provided Facet with certain exclusive but limited rights to license the Facet Patent Family on behalf of DBi and Mandli; and

WHEREAS, the Parties now desire to enter into this Exclusive License Agreement under which Facet is granted all substantial rights to enforce and/or license the Facet Patent Family with respect to making, using or selling products or services under the Facet Patent Family, including the sole and exclusive right to license and sublicense the Facet Patent Family and the sole and exclusive right of standing to sue to enforce the Facet Patent Family, including for any and all current and/or past damages for infringement of the Facet Patent Family, under the terms and conditions of this Agreement;

NOW, THEREFORE, the Parties agree as follows:

1. Exclusive Rights.

- 1.1 **Grant of Rights** – Subject the Covenant Not to Sue below, Facet is hereby exclusively granted all substantial rights in and to the Patent Family, including the right to practice any claimed invention and to enforce and/or license the Facet Patent Family with respect to making, using or selling products or services under the Facet Patent Family, and Mandli, DBi, DBi/Cidaut and AMAC each hereby grant to Facet the sole and exclusive rights with respect to the Facet Patent Family to:
 - 1.1.1 practice and claimed invention in any or all of the patents and/or patent applications in the Facet Patent Family;
 - 1.1.2 license and/or sublicense any or all of patents and/or patent applications in the Facet Patent Family; and
 - 1.1.3 enforce any or all of patents and/or patent applications in the Facet Patent Family, including for any and all current and/or past damages for infringement of the Facet Patent Family, and including the sole and exclusive right of standing to file, maintain, dismiss and/or settle any lawsuits with respect to the Facet Patent Family.

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1.2 **No Termination** – The exclusive grant of all rights to Facet under Section 1.1 shall commence on the Effective Date and shall have no termination date.

1.3 **Covenant Not to Sue** – Facet hereby grants to each of Mandli, DBi, DBi/Cidaut and AMAC a non-transferable covenant not to sue with respect to any patent or patent application in the Facet Patent Family, which shall extend to any subsidiaries or affiliates of the Party that are more than fifty-percent (50%) controlled by that Party as of the Effective Date and to any distributors, customers or users with respect to products or services designed or developed by Mandli, DBi, DBi/Cidaut or AMAC.

1.4 **No Authority to License or Sue.** As of the Effective Date, neither Mandli nor DBi shall have any rights or authority to license, enforce, sue or settle with any third-party with respect to any the Facet Patent Family.

1.5 **Assistance.** Each of Mandli, DBi, DBi/Cidaut or AMAC shall provide reasonable assistance at their own costs if reasonably requested by Facet with respect to any licensing or enforcement of the Facet Patent Family, including providing responses to discovery requests in any lawsuit or proceeding with respect to the Facet Patent Family.

2. Licenses.

2.1. **Licensees/Settlements** – for purposes of this Agreement, Facet shall enter into potential licenses and/or settlements on terms generally consistent with the Term Sheet set forth in Schedule 2.

2.2. **Net Recovery** – The Parties shall each receive a portion of the Net Recovery that is obtained from any entity that is granted any license, rights, covenant not to sue or settlement for the Facet Patent Family after the Effective Date in accordance with the distribution set forth in Schedule 3. The term “Net Recovery” shall mean all payments, sums, or anything of value (including cash, stock, stock options, warrants, stock appreciation rights, partnership shares or units, or any other form of non-cash payment) received by Facet as a result of any claim, demand, negotiation, license, assignment, or settlement regarding the Facet Patent Family. The term “Net Recovery” includes, without limitation, past damages, future damages, royalties, and all related forms of compensation and, in addition, includes any amounts recovered as interest, costs and disbursements, attorneys’ fees. It is understood that Facet may utilize an alternative fee arrangement with a law firm and/or a funded litigation approach whereby a third-party funds some, most, or all of the costs up to and including a settlement or license. Net Recovery is defined as the total recovery for any such licensing or enforcement action, less any repayment of costs and/or fees incurred by Facet in connection with such licensing or enforcement action, including any costs and/or fee due to the law firm and/or litigation funding entity.

2.3. **Payment of Net Recovery** – For each signed license and/or settlement agreement, Facet agrees to pay the Net Recovery portion due to each of Mandli and DBi via wire transfer within ten (10) business days of receipt of the Net Recovery by Facet.

3. Independent Contractor.

Mandli and DBi each understand that Facet is independently engaged in other licensing activities related to intellectual property and that such licensing activities are inherent to the nature of Facet’s business. Mandli and DBi each agree that this Agreement will not be construed to limit the licensing activities of Facet, and that for the avoidance of doubt no such licensing activities will be deemed to conflict with this Agreement.

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4. Confidentiality.

The Parties agree to enter into the Confidential Information and Joint Privilege/Common Interest Agreement in the form set forth in Schedule 4.

5. Miscellaneous.

This Agreement may not be assigned by either party without the prior written consent of the other party. This Agreement will be binding upon and inure to the benefit of the parties hereto and their respective successors and permitted assigns. This Agreement constitutes the entire understanding of the parties with respect to the subject matter hereof and supersedes all prior agreements with respect thereto. This Agreement may not be amended except in writing signed by both parties. This Agreement will be governed by and construed in accordance with the laws of the State of Minnesota, without reference to the principles of conflicts of law. This Agreement may be executed in two or more counterparts which may be signed and delivered by facsimile or scanned and emailed copies and shall have the same force and effect as an original.

IN WITNESS WHEREOF, the Parties have executed, or caused their duly authorized representatives to execute, this Exclusive Patent License Agreement under seal as of the Effective Date.

Mandli Communications, Inc.

By: _____

Name: _____

Title: _____

Facet Technology Corp.

By: James E. Retterath

Name: James E. Retterath

Title: CEO

DBi Services, LLC

By: _____

Name: _____

Title: _____

DBi/Cidaut Technologies, LLC

By: _____

Name: _____

Title: _____

AMAC North America, LLC

By: _____

Name: _____

Title: _____

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Mandli Communications, Inc.

Facet Technology Corp.

By: _____

By: _____

Name: _____

Name: James E. Retterath

Title: _____

Title: CEO

DBi Services, LLC

DBi/Cidant Technologies, LLC

By: _____

By: _____

Name: _____

Name: _____

Title: _____

Title: _____

AMAC North America, LLC

By: _____

Name: _____

Title: _____

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Mandli Communications, Inc.

By: Trace M Mandli

Name: Trace M. Mandli

Title: Chief Executive Officer

Facet Technology Corp.

By: _____

Name: James E. Retterath

Title: CEO

DBi Services, LLC

By: _____

Name: _____

Title: _____

DBi/Cidaut Technologies, LLC

By: _____

Name: _____

Title: _____

AMAC North America, LLC

By: _____

Name: _____

Title: _____

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**Schedule 1
The Assets**

The "Assets" means the patents and patent applications set forth on Schedule 1, any patents directly or indirectly issuing from such applications, any foreign counterparts, continuations, continuations-in-part and divisionals of such applications, any reissues, reexaminations and extensions of the foregoing patents, any patents and patent applications claiming priority to or from any of the foregoing, any patents or patent applications terminally disclaimed to or from any of the foregoing, and all patent rights arising from any of the foregoing.

1.1 – Mandli Communications, Inc. Assets

Pub. No.	App. No.	Title	Status	Priority	File Date	Pub/Grant	Est. Exp.
AU8643801	AU20010086438	System for road sign sheeting classification	Active	8/12/00	8/10/01	2/25/02	8/10/21
US20180372621	US15/993883	System and assessment of reflective objects along a roadway	Active	8/12/00	5/31/18	12/27/18	8/10/21
US8891960	US09/028218	System for road sign sheeting classification	Active	8/12/00	8/10/01	5/10/05	7/9/23
US7515736	US11/056926	System for road sign sheeting classification	Active	8/12/00	2/11/05	4/7/09	12/16/22
US7995796	US12/419843	System for road sign sheeting classification	Active	8/12/00	4/7/09	8/9/11	11/4/21
US8660311	US13/205337	System for assessment reflective objects along a roadway	Active	8/12/00	8/8/11	2/25/14	9/28/21
US8860944	US14/025614	System and assessment of reflective objects along a roadway	Active	8/12/00	9/12/13	10/14/14	8/10/21
US9335255	US14/512735	System and assessment of reflective objects along a roadway	Active	8/12/00	10/13/14	5/10/16	8/10/21
US9671328	US15/148722	System and assessment of reflective objects along a roadway	Active	8/12/00	5/6/16	6/6/17	8/10/21
US9989457	US15/593504	System and assessment of reflective objects along a roadway	Active	8/12/00	5/15/17	6/5/18	5/10/21
WO0215144	WO2001/525159	System for road sign sheeting classification	Expired	8/12/00	8/10/01	2/21/02	2/12/03

1.2 – DBI Services LLC Assets

Pub. No.	App. No.	Title	Status	Priority	File Date	Pub/Grant	Est. Exp.
AU2002305854	AU2002305854	System for automated determination of retroreflectivity of road signs and other reflective objects	Expired	6/7/01	6/5/02	12/23/02	3/11/04
US6674878	US09/918375	System for automated determination of retroreflectivity of road signs and other reflective objects	Active	6/7/01	7/30/01	1/6/04	3/8/22
US7043657	US10/736434	System for automated determination of retroreflectivity of road signs and other reflective objects	Active	6/7/01	12/15/03	5/9/06	9/13/21
US7173707	US11/381503	System for automated determination of retroreflectivity of road signs and other reflective objects	Active	6/7/01	5/3/06	2/6/07	7/30/21
US7411681	US11/702421	System for automated determination of retroreflectivity of road signs and other reflective objects	Active	6/7/01	2/5/07	8/12/08	7/30/21
US9989456	US13/781017	System for the determination of retroreflectivity of road signs and other reflective objects	Active	8/12/00	2/25/13	6/5/18	8/10/21
WO02101340	WO2002/US17914	System for automated determination of retroreflectivity of road signs and other reflective objects	Expired	6/7/01	6/5/02	12/19/02	12/7/03

RECORDED: 01/11/2024 **PATENT REEL: 066272 FRAME: 0320**