

Note: Individuals (as opposed to companies) will be provided with a slightly different version of this form that is tweaked to accommodate the difference, but will be substantively the same agreement as below.

PATENT PURCHASE AGREEMENT

This Patent Purchase Agreement (the “Agreement”) is entered into and effective as of the Effective Date by and between Google Inc., a Delaware corporation with its principal place of business at 1600 Amphitheatre Parkway, Mountain View, CA 94043 USA (“Google”), and [REDACTED], a [REDACTED] [entity], with its principal place of business at [REDACTED] (“Seller”). The parties hereby agree as follows:

1. BACKGROUND

- 1.1. Seller owns United States Patent Number [REDACTED] (the “Seller’s Patent” as further defined below).
- 1.2. Seller wishes to sell to Google all right, title, and interest in the Seller’s Patent including all enforcement rights.
- 1.3. Google wishes to purchase from Seller all right, title, and interest in such the Seller’s Patents free and clear of any restrictions, liens, claims, and encumbrances other than as specified below in Section 4.3.
- 1.4. Seller wishes to receive a license back from Google to the Seller’s Patent.

2. DEFINITIONS

“**Affiliate**” means any Entity in whatever country organized, that controls, is controlled by or is under common control of a party to this Agreement. The term “control” means possession, direct or indirect, of the power to direct or cause the direction of the management and policies of an Entity, whether through the ownership of voting securities, by contract or otherwise.

“**Assigned Patent Rights**” means the Seller’s Patent and the additional rights set forth in Section 4.2.

“**Effective Date**” is the date of Google’s signature on the signature line of this Agreement.

“**Entity**” means any person, corporation, partnership, limited liability company, association, joint stock company, trust, joint venture, unincorporated organization, governmental entity (or any department, agency, or political subdivision thereof) or any other legal entity.

“**Seller’s Patent(s)**” as defined above, includes (a) U.S. Patent No. [REDACTED] and (b) any and all patents which are subject to a terminal disclaimer with U.S Patent No. [REDACTED].

“**Prosecution Files**” means all files, documents and tangible things, as those terms have been interpreted pursuant to rules and laws governing the production of documents and things, constituting, comprising or relating to the investigation, evaluation, preparation, prosecution, maintenance, defense, filing, issuance and registration of the Seller’s Patent, and such files, documents and tangible things constituting, comprising or

relating to the assertion or enforcement of the Seller's Patent to the extent that they could be deemed to affect the scope, validity, patentability, or enforceability of the Seller's Patent.

3. DELIVERY AND PAYMENT

- 3.1. **Delivery.** Seller will send to Google, at its own expense, the items identified on Exhibit A (the "Deliverables") within ten (10) calendar days following the Effective Date.
- 3.2. **Payment.** Within 30 business days of the Effective Date, Google will pay to Seller the amount of US \$ [REDACTED] by wire transfer. Google may record assignments with any applicable patent offices only on or after the Effective Date.

4. TRANSFER OF PATENTS AND ADDITIONAL RIGHTS

- 4.1. **Assignment of Patents.** Upon the Effective Date, Seller hereby sells, assigns, transfers, and conveys to Google, or shall have caused its Affiliates to sell, assign, transfer and convey to Google, all right, title, and interest in and to the Seller's Patent.
- 4.2. **Assignment of Additional Rights.** Upon the Effective Date, Seller hereby also sells, assigns, transfers, and conveys to Google, or shall have caused its Affiliates to sell, assign, transfer and convey to Google, all right, title and interest in and to all:
 - 4.2.1. inventions, invention disclosures, and discoveries described in the Seller's Patent to the extent that such inventions, invention disclosures and discoveries could be claimed in any of the Seller's Patent; and
 - 4.2.2. causes of action (whether known or unknown or whether currently pending, filed, or otherwise) and other enforcement rights under, or on account of, any of the Seller's Patent, including, without limitation, all causes of action and other enforcement rights for (i) damages, (ii) injunctive relief, and (iii) any other remedies of any kind for past, current and future infringement, and (iv) rights to collect royalties or other payments under or on account of any of the Seller's Patent and/or any of the foregoing.
 - 4.2.3. nothing in the above is meant to imply or infer that any other issued patents or pending patent applications are transferred under this Agreement other than those that are related to the Seller's Patent through terminal disclaimer.
- 4.3. **Existing Licenses.** The transfers of the Assigned Patent Rights pursuant to Section 4.1 and 4.2 are subject to any existing licenses and covenants not to sue executed prior to the Effective Date that are expressly binding on successors to the applicable Patents ("Existing Licenses"); any and all such Existing Licenses and the entities to which they apply are identified on Exhibit B hereunder. Other than the license grants and covenants not to sue described in the preceding sentence, Google will not assume the obligations under such existing licenses of, and covenants not to sue on, the Patents, and, for the avoidance of doubt, such existing licensing or covenant not to sue agreements and rights resulting from such agreements (including but not limited to royalties payable under such agreements) shall not be transferred to Google under this Agreement.
- 4.4. **License Back to Seller.** As of the Effective Date, Google hereby grants to Seller, for the benefit of Seller and its Affiliates, for the life of all the Seller's Patent, an irrevocable, non-exclusive,

non-transferable, non-assignable (including by operation of law or otherwise), non-sublicensable, worldwide, fully paid-up right and license under the Patents, to develop, have developed, make, have made, use, have used, sell, offer to sell, import, export and otherwise transfer or dispose of any product, service, method or process.

5. ADDITIONAL OBLIGATIONS

- 5.1. **Further Cooperation.** At the reasonable request of Google, Seller will execute and deliver such other instruments and do and perform such other acts and things as may be necessary or desirable for effecting completely the consummation of the transactions contemplated hereby, including, without limitation, execution, acknowledgment, and recordation of other such papers, and using commercially reasonable efforts to obtain the same from the respective inventors, as necessary or desirable for fully perfecting and conveying unto Google the benefit of the transactions contemplated hereby. To the extent any attorney-client privilege or the attorney work-product doctrine applies to any portion of the Prosecution Files, Seller will ensure that it is not disclosed to any third party unless (a) disclosure is ordered by a court of competent jurisdiction, after all appropriate appeals to prevent disclosure have been exhausted, and (b) Seller gave Google prompt notice upon learning that any third party sought or intended to seek a court order requiring the disclosure of any such portion of the Prosecution Files. In addition, Seller will continue to prosecute, maintain, and defend the Patents at its sole expense until the Effective Date. To the extent that any conception and reduction to practice information is not provided as part of the Deliverables, Seller shall promptly respond to Google's requests for any such additional information that may exist, if needed by Google in connection with the prosecution and enforcement of the Patents.
- 5.2. **Payment of Fees.** Seller will pay any maintenance fees, annuities, and the like due or payable on the Patents until the Effective Date. Seller hereby gives Google power-of-attorney to (a) execute documents in the name of Seller in order to effectuate the recordation of the transfers of any portion of the Patents in an governmental filing office in the world and (b) instruct legal counsel to take steps to pay maintenance fees and annuities that Seller declines to pay and to make filings on behalf of Seller prior to the Closing and otherwise preserve the assets through the Closing Date. Such power-of-attorney is irrevocable and coupled with an interest.
- 5.3. **Conduct.** Seller shall not engage in any act or conduct, or omit to perform any necessary act, the result of which would invalidate any portion of any of the Patents or render any portion of them unenforceable.

6. REPRESENTATIONS AND WARRANTIES OF SELLER

Seller hereby represents and warrants to Google as follows that as of the Effective Date and as of Closing:

- 6.1. **Authority.** Seller is a company duly formed, validly existing, and in good standing under the laws of the jurisdiction of its formation. Seller has the full power and authority and has obtained all third party consents, approvals, and/or other authorizations required to enter into this Agreement and to carry out its obligations hereunder, including, without limitation, the assignment of the Assigned Patent Rights to Google.
- 6.2. **Title and Contest.** Seller or its Affiliate owns all right, title, and interest to the Assigned Patent Rights, including, without limitation, all right, title, and interest to sue for infringement of the Seller's Patent. Seller and its Affiliates have obtained and properly recorded previously executed

assignments for the Seller's Patent as necessary to fully perfect its rights and title therein in accordance with governing law and regulations in each respective jurisdiction. The Seller's Patent is free and clear of (a) any restrictions and encumbrances including without limitation any pledge, charge, hypothecation, liens, claim, mortgage, security interest, license, covenant not to sue, or other restrictions and encumbrances, (collectively "Restrictions and Encumbrances") and (b) any agreement to create any Restrictions and Encumbrances, in each case other than the existing licenses and covenants not to sue that are expressly binding on successors to the Seller's Patent described in Section 4.3 and listed as Existing Licenses on Exhibit B. There are no existing binding contracts, agreements, options, commitments, proposals, bids, offers, or rights with, to, or in any person to acquire any of the Seller's Patent.

- 6.3. **Existing Licenses.** After the Effective Date, none of Seller or its Affiliates, any prior owner, or any inventor will retain any rights or interest in the Seller's Patent, except as described in Sections 4.3 and 4.4. None of the licenses or rights in the Seller's Patent granted by Seller or its Affiliate is an exclusive grant or right and each such license is nontransferable (except solely in the context of acquisition of the respective licensee and in that case, the scope of each such license or rights in the Patents is limited to the activities of the licensee prior to the acquisition) and non-sublicensable (except to affiliates of the licensee). There are no Existing Licenses other than those identified in Exhibit B.
- 6.4. **Validity and Enforceability.** The Seller's Patent has never been found invalid, unpatentable, or unenforceable for any reason in a final decision in any administrative, arbitration, judicial or other proceeding.
- 6.5. **Conduct.** There is no obligation imposed by a standards-setting organization on Seller or Google to license any of the Patents on particular terms or conditions.
- 6.6. **Fees.** All maintenance fees, annuities, and the like due or payable on the Patents have been timely paid. For the avoidance of doubt, such timely payment includes payment of any maintenance fees for which the fee is payable (e.g., the fee payment window opens) even if the surcharge date or final deadline for payment of such fee would be in the future.

7. MISCELLANEOUS

- 7.1. **Disclaimer of Representations and Warranties.** NEITHER PARTY MAKES ANY REPRESENTATION OR WARRANTY EXCEPT FOR THEIR RESPECTIVE REPRESENTATIONS AND WARRANTIES SET FORTH IN SECTION 6, AND EACH PARTY DISCLAIMS ALL IMPLIED WARRANTIES, INCLUDING, WITHOUT LIMITATION, THE IMPLIED WARRANTIES OF MERCHANTABILITY AND FITNESS FOR A PARTICULAR PURPOSE.
- 7.2. **Limitation of Liability.** EXCEPT IN THE EVENT OF BREACH OF ANY OF THE REPRESENTATIONS AND WARRANTIES BY SELLER SET FORTH IN SECTION 6, NEITHER PARTY'S TOTAL LIABILITY UNDER THIS AGREEMENT WILL EXCEED THE PURCHASE PRICE SET FORTH IN SECTION 3.4. THE PARTIES ACKNOWLEDGE THAT THE LIMITATIONS ON POTENTIAL LIABILITIES SET FORTH IN THIS SECTION 7.2 WERE AN ESSENTIAL ELEMENT IN SETTING CONSIDERATION UNDER THIS AGREEMENT.

- 7.3. **Limitation on Consequential Damages.** NEITHER PARTY WILL HAVE ANY OBLIGATION OR LIABILITY (WHETHER IN CONTRACT, WARRANTY, TORT (INCLUDING NEGLIGENCE) OR OTHERWISE, AND NOTWITHSTANDING ANY FAULT, NEGLIGENCE (WHETHER ACTIVE, PASSIVE OR IMPUTED), REPRESENTATION, STRICT LIABILITY OR PRODUCT LIABILITY), FOR COVER OR FOR ANY INCIDENTAL, INDIRECT, CONSEQUENTIAL, MULTIPLIED, PUNITIVE, SPECIAL, OR EXEMPLARY DAMAGES OR LOSS OF REVENUE, PROFIT, SAVINGS OR BUSINESS ARISING FROM OR OTHERWISE RELATED TO THIS AGREEMENT, EVEN IF A PARTY OR ITS REPRESENTATIVES HAVE BEEN ADVISED OF THE POSSIBILITY OF SUCH DAMAGES. THE PARTIES ACKNOWLEDGE THAT THESE EXCLUSIONS OF POTENTIAL DAMAGES WERE AN ESSENTIAL ELEMENT IN SETTING CONSIDERATION UNDER THIS AGREEMENT.
- 7.4. **Compliance With Laws.** Notwithstanding anything contained in this Agreement to the contrary, the obligations of the parties with respect to the consummation of the transactions contemplated by this Agreement shall be subject to all laws, present and future, of any government having jurisdiction over the parties and this transaction, and to orders, regulations, directions or requests of any such government.
- 7.5. **Confidentiality of Terms.** The parties hereto will keep the terms and existence of this Agreement and the identities of the parties hereto and their Affiliates confidential and will not now or hereafter divulge any of such information to any third party except (a) with the prior written consent of the other party; (b) as otherwise may be required by law or legal process, including, without limitation, in confidence to legal and financial advisors in their capacity of advising a party in such matters; (c) during the course of litigation, so long as the disclosure of such terms and conditions is restricted in the same manner as is the confidential information of other litigating parties; (d) in confidence to its legal counsel, accountants, insurers, indemnitors, indemnitees, banks and financing sources and their advisors solely in connection with complying with its obligations under this Agreement; (e) by Google, in order to perfect Google's interest in the Assigned Patent Rights with any governmental agency (including, without limitation, recording assignment in any governmental patent office); (f) by Google, in the course of any legal proceeding to support any claim or defense; (g) to inform either party's existing licensees or prospective licensees of the Seller's assignment to Google of the Seller's Patent (provided that Seller shall not identify Google); or (h) to enforce Google's right, title, and interest in and to the Assigned Patent Rights; provided that, in (b) and (c) above, (i) to the extent permitted by law, the disclosing party will use all legitimate and legal means available to minimize the disclosure to third parties, including, without limitation, seeking a confidential treatment request or protective order whenever appropriate or available; and (ii) the disclosing party will provide the other party with at least ten (10) calendar days' prior written notice of such disclosure.
- 7.6. **Governing Law; Venue/Jurisdiction.** This Agreement will be interpreted, construed, and enforced in all respects in accordance with the laws of the State of California, without reference to its choice of law principles to the contrary. Seller irrevocably consents to the jurisdiction and venue of the courts identified in the preceding sentence in connection with any action, suit, proceeding, or claim arising under or by reason of this Agreement.
- 7.7. **Notices.** All notices given hereunder will be given in writing (in English or with an English translation), will refer to Google, Seller, and to this Agreement and will be delivered to the

address set forth below by (i) personal delivery, or (ii) delivery postage prepaid by an internationally-recognized express courier service:

If to Google:

If to Seller:

Google Inc.
1600 Amphitheatre Parkway
Mountain View, CA 94043

Attention: Legal - Patents

With copy via electronic mail to:

[REDACTED]

- 7.8. **Relationship of Parties.** The parties hereto are independent contractors. Nothing in this Agreement will be construed to create a partnership, joint venture, franchise, fiduciary, employment or agency relationship between the parties. Neither party has any express or implied authority to assume or create any obligations on behalf of the other or to bind the other to any contract, agreement or undertaking with any third party.
- 7.9. **Remedies.** Seller's sole and exclusive remedy in the event of any claim, dispute, or controversy under this Agreement will be the recovery of money damages, subject to the disclaimer and limitations set forth in this Agreement, including, without limitation, those in Sections 7.1 through 7.3.
- 7.10. **Severability.** If any provision of this Agreement is found to be invalid or unenforceable, then the remainder of this Agreement will have full force and effect, and the invalid or unenforceable provision will be modified, or partially enforced, to the maximum extent permitted to effectuate the original objective.
- 7.11. **Waiver.** Failure by either party to enforce any term of this Agreement will not be deemed a waiver of future enforcement of that or any other term in this Agreement or any other agreement that may be in place between the parties.
- 7.12. **Agreement Non-Transferable.** The Seller may not assign or otherwise transfer this Agreement, or any rights or obligations under this Agreement, to any third party without the prior written consent of Google.
- 7.13. **Miscellaneous.** This Agreement, including its exhibits, constitutes the entire agreement between the parties with respect to the subject matter hereof and merges and supersedes all prior agreements, understandings, negotiations, and discussions. Neither of the parties will be bound by any conditions, definitions, warranties, understandings, or representations with respect to the subject matter hereof other than as expressly provided herein. The section headings contained in this Agreement are for reference purposes only and will not affect in any way the meaning or interpretation of this Agreement. This Agreement is not intended to confer any right or benefit on any third party (including, but not limited to, any employee or beneficiary of any party), and no action may be commenced or prosecuted against a party by any third party claiming as a third-party beneficiary of this Agreement or any of the transactions contemplated by this

Agreement. No oral explanation or oral information by either party hereto will alter the meaning or interpretation of this Agreement. No amendments or modifications will be effective unless in a writing signed by authorized representatives of both parties. The terms and conditions of this Agreement will prevail notwithstanding any different, conflicting or additional terms and conditions that may appear on any letter, email or other communication or other writing not expressly incorporated into this Agreement. The following exhibits are attached hereto and incorporated herein: Exhibit A (entitled "Deliverables"), Exhibit B (entitled "Existing Licenses"), Exhibit C (entitled Enforcement Activities), and Exhibit D (entitled "Other Actions").

7.14. **Counterparts.** This Agreement may be executed in counterparts, each of which will be deemed an original, and all of which together constitute one and the same instrument.

IN WITNESS WHEREOF, intending to be legally bound, the parties have executed this Patent Purchase Agreement as of the execution date set forth below.

GOOGLE:

SELLER:

By: _____

By: _____

Name: _____

Name: _____

Title: _____

Title: _____

Date: _____

Date: _____

EXHIBIT A

DELIVERABLES

Seller will cause the following to be delivered to Google within the time provided in Section 3.1 of the attached Patent Purchase Agreement:

- If in your possession, the original ribbon copy issued by the United States Patent and Trademark Office,
- If in your possession, all available conception and reduction to practice materials,
- If in your possession, any copies of the Prosecution Files.
- Enforcement Activities. As scheduled in Exhibit C, any correspondence, filings or other documents in your possession pursuant to which Seller has (i) put a third party on notice of actual or potential infringement of any of the Seller's Patent, (ii) formally invited any third party to enter into a license under the Seller's Patent, or (iii) initiated any enforcement action with respect to the Seller's Patent.
- As scheduled in Exhibits D, materials related to any other actions, suits, investigations, claims, or proceedings threatened, pending, or, to Seller's knowledge, in progress relating in any way to the Seller's Patent (beyond those encompassed by Enforcement Activities indicated above).
- Existing Licenses. A copy of any and all Existing Licenses listed in Exhibit B that remain in your possession.
- Merger or Change of Name Documents. A copy of any and all merger or change of name documents (such as those related to a change of an Entity's name after or upon a merger) or other such documents relating to any of the Seller or its predecessor entities, as necessary to establish chain of title for any of the Patents, and in a form suitable for recordation with any applicable patent offices.
- Security Agreements. A copy of any and all security agreements and their corresponding releases relating to any of the Patents.

EXHIBIT B

Existing Licenses. List any entity that has an existing license related to the Seller's Patent.

| Licensed Entity Name | Agreement Title | Effective Date |
|----------------------|-----------------|----------------|
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EXHIBIT C

Enforcement Activities. Any correspondence, filings or other communications to which Seller has (i) put a third party on notice of actual or potential infringement of any of the Seller's Patent, (ii) formally invited any third party to enter into a license under the Seller's Patent, or (iii) initiated any enforcement action with respect to any of the Seller's Patent.

| Third party Contacted | First Contact Date | Enforcement Action Initiated (Y/N) |
|------------------------------|---------------------------|---|
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EXHIBIT D

Other Actions. Any other actions, suits, investigations, claims, or proceedings threatened, pending, or, to Seller's knowledge, in progress relating in any way to the Seller's Patent (beyond those encompassed by Enforcement Activities scheduled in Exhibit D).

| Third party threatening Action | Date of First Contact | Did party take formal action (e.g, filing suit, etc.) (Y/N) | Is Matter Resolved (Y/N) |
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