

## TECHNOLOGY AND KNOW-HOW LICENSE AGREEMENT

### Introduction

This Technology and Know-How License Agreement ("**Agreement**") is made and entered into by and between **EATON Elektrotechnika s.r.o** a corporation organized and existing under the laws of Czech Republic, with offices in Komárovská 2406 Praha 9, Horní Počernice 193 00, CZ, ("**Eaton**") and Ústav fyzikální chemie J. Heyrovského AV ČR, v.v.i., an university organized and existing under the laws of Czech Republic with offices in Dolejškova 2155/3, 182 00 Praha 8 CZ, ("**Institute**"), and Vysoká škola chemicko-technologická v Praze, an university organized and existing under the laws of Czech Republic with offices in Technická 1905/5, 166 28 Praha 6, CZ, ("**ICT Prague**"). Either of Eaton, Institute and ICT Prague might be referred to individually as a "**Party**" or together as the "**Parties**", Institute and ICT Prague together might be referred "**Licensors**".

### Recitals

Licensors and Eaton have collaborated together in the government funded project No. TH03020063 entitled "Replacement of SF6 gas in switchboards which was submitted and accepted in a public tender in the Program for Support of Applied Research and Experimental Development EPSILON (the "**Project**").

Licensors and Eaton co-own valuable technologies developed during the Project, including trade secrets, proprietary information and materials.

Eaton desires to obtain the right to practice and utilize the technology to design, produce and sell certain products or services, and Licensors is willing to grant such a right.

Licensors and Eaton desire to enter into this Agreement upon the terms and conditions set forth below.

### Agreement

In consideration of the mutual covenants and obligations set forth herein the Parties agree as follows:

#### Article 1 Definitions

The definitions set forth in this Article apply to the following terms, in both singular and plural, whenever used in this Agreement:

- 1.1 **Affiliate** means any domestic or foreign company, firm or entity (i) that either Party has or acquires a significant ownership interest in during the Term; (ii) that directly or indirectly through one or more intermediaries, either controls, is controlled by, or is under common control with a Party; or (iii) that assumes all obligations and liabilities of the respective Party relating to this Agreement during the Term. Affiliates include both subsidiaries and parent corporations of the Parties.
- 1.2 **Effective Date** means the last date on which either Party signs this Agreement. This Agreement does not come into effect until signed by both Parties and published in the Register of contracts pursuant to Section 15.14 of this Agreement.
- 1.3 **Field of Use** means the permitted scope for use of the Licensed Intellectual Property which is for energy production, transfer and protection.
- 1.4 **Improvements** means any changes, revisions, modifications, developments or enhancements to the Licensed Intellectual Property that are developed, made or created by any of the Parties, whether or not patentable.

- 1.5 **Know-How** means any unpublished information, data and results generated by any Party in the course of the Project; for the avoidance of doubt, Know-How is a subset of Proprietary Information
- 1.6 **Licensed Materials** means (i) any materials or items identified at **Attachment A** to be provided to Eaton by Licensors, (ii) any other materials or items provided to Eaton under this Agreement at any time by or on behalf of Licensors; and (iii) any copies, adaptations, translations, updates or modifications of any of the foregoing. Licensed Materials include materials in both tangible and intangible form.
- 1.7 **Licensed Products** means any product designed or made in whole or in part by practicing any portion of the Licensed Intellectual Property.
- 1.8 **Licensed Intellectual Property** means the Licensed Materials and Proprietary Information.
- 1.9 **Proprietary Information** has the meaning assigned to it in the Article 3 ("Confidentiality").
- 1.10 **Residual Know-How** means information in non-tangible form which may be retained in the unaided memory by persons who have had access to the Know-How, Proprietary Information or Licensed Material so long as such persons have not studied the information for the purpose of replicating the same from memory.
- 1.11 **Sole License** means a license in which Licensors reserve for themselves the right to practice the Licensed Intellectual Property for any purpose including, but not limited to, the right to research, design, develop, make, have made, modify, use, offer for sale, sell, customize, sell, promote, import, support and service any product or service, but agrees not to license the Licensed Intellectual Property to any Third Party.
- 1.12 **Term** means the period commencing on the Effective Date and terminating as provided in the Article herein entitled "Term; Termination," together with any renewal or extension period that may be provided for therein.
- 1.13 **Territory** means the geographic area described as worldwide.
- 1.14 **Third Party** means a person or entity that is not a Party to this Agreement.

## **Article 2 Grant by Licensors**

- 2.1 **License Grant.** From the Effective Date, Licensors grants to Eaton and its Affiliates an irrevocable, perpetual, Sole License under the Licensed Intellectual Property within the Field of Use in the Territory. Licensors retain the right to practice and use the Licensed Intellectual Property for any purposes, with the exception of licensing the Licensed Intellectual Property to any Third Party.
- 2.2 **Improvements.** Improvements shall vest in and be owned by the Party who developed it. Unless otherwise specified, no license under the Improvements is herein granted between the Parties. In particular, no license under the Improvements is herein granted even when the Improvement makes use, incorporates or references the other Party's proprietary intellectual property.
- 2.3 **Reserved Rights.** No ownership in the Licensed Intellectual Property is transferred to Eaton under this Agreement. Except as expressly set forth herein, no additional license, grant or working right is granted or implied by this Agreement.

**Article 3      Confidentiality**

- 3.2 Disclosure to Contractors. Eaton is authorized to disclose Proprietary Information to Third Party contractors solely for the purpose of assisting Eaton in the performance of this Agreement.
- 3.2.1 Prior to any disclosure, Eaton shall obtain a written confidentiality agreement from the Third Party contractor, in form reasonably acceptable to Licensors, confirming that the Third Party contractor (i) shall not disclose Proprietary Information to any Third Party; (ii) shall use Proprietary Information only on behalf of Eaton; (iii) shall be bound by all of the restrictions and limitations of this Agreement; and (iv) acknowledges Licensors is an intended beneficiary under such confidentiality agreement. Eaton agrees to provide copies of all written confidentiality agreements to Licensors upon request, and to be liable to Licensors for any breach thereof by a Third Party contractor.
- 3.2.2 In the event Eaton becomes aware of any actual or threatened breach of a confidentiality agreement by a Third Party contractor, Eaton shall notify Licensors and use its best efforts to promptly cure the breach, without prejudice to any other right or remedy of Licensors. If, despite such efforts, Eaton fails to cure the breach, Licensors shall have the right to enforce its

proprietary rights or other rights directly against the Third Party contractor, in which event Eaton shall provide reasonable assistance, at no cost to Licensors.

#### **Article 4 Additional Undertakings by Licensee**

- 4.1 Best Efforts. Eaton shall devote its best efforts to the diligent development, manufacture, distribution, promotion and sale of the Licensed Products in the Territory.
- 4.2 Financial Risk. Eaton assumes the financial risk related to the design, distribution, promotion, sale and support of the Licensed Products.

#### **Article 5 Term; Termination**

- 5.1 Initial Term; Renewal. This Agreement commences as of the Effective Date and, unless sooner terminated as provided elsewhere herein, shall continue in effect for five (5) years. Thereafter, this Agreement shall automatically renew for successive one (1) year periods.
- 5.2 Voluntary Termination. Licensors may only terminate this Agreement voluntary if, at any time during the Term, Eaton, its agents or contractors reproduces, uses or transfers any Licensed Intellectual Property in violation of this Agreement.
- 5.3 Termination Upon Breach. Either Party may terminate this Agreement if, at any time during the Term, the other Party commits a material breach and the breach is not remedied within thirty (30) days of notice thereof from the other Party. Material breach includes, without limitation, the following: (i) any payment owed to Licensors by Eaton is over thirty (30) days past due; (ii) Eaton becomes inactive, terminates, suspends or discontinues business; (iii) Eaton becomes insolvent, has a receiver appointed, goes into liquidation or becomes party to any action relating to its own bankruptcy or insolvency that is instituted and not dismissed within thirty (30) days; (iv) Eaton's trustee in bankruptcy or Eaton as a debtor in possession fails to assume this Agreement within sixty (60) days after the filing of a bankruptcy petition; (v) Eaton fails to procure and maintain insurance in accordance with the terms of this Agreement; or (vi) Eaton fails to fulfill any performance requirement provided for under this Agreement.
- 5.4 Return or Destroy. Except as otherwise provided herein, upon expiration or termination of this Agreement or upon the conclusion of any permitted sell-off period provided for in the Section herein entitled "Sell-Off Period," Eaton shall (i) cease use of the Licensed Intellectual Property; (ii) return or destroy, at Licensors' option, all tangible or intangible materials embodying the same within thirty (30) days after expiration or termination; and (iii) provide to Licensors a sworn certificate signed by an authorized representative of Eaton stating that Eaton has fully complied with this clause.
- 5.5 Residual Know-How: Either party shall be free to use for any purpose the Residual Know-How resulting from access to or work with Confidential Information and Licensed Material disclosed

hereunder. Neither party shall have any obligation to limit or restrict the assignment of such persons or to pay royalties for any work resulting from the use of residuals.

#### **Article 6      Consideration**

- 6.1 License Fee. As a consideration for the rights granted under Article 2, Eaton shall pay Licensors a non-refundable non-creditable license fee in the amount of one million four hundred thousand Czech Kronas (1,400.000 CZK).

#### **Article 7      Taxes**

- 7.1 Withholding. In the event any withholding Tax is imposed on payments to be made to Licensors under this Agreement, Eaton shall withhold and pay the appropriate amount of Tax and shall provide Licensors with the official Tax receipt evidencing payment. Notwithstanding the payment, Eaton shall "gross up" and pay to Licensors the entire pre-tax amount due Licensors under this Agreement.
- 7.2 Exemption. The Parties agree to cooperate in any claim for tax exemption relating to the license, grant or provision of any rights, information, products and/or services under this Agreement. Eaton agrees, at Licensors's request, to (i) provide to Licensors a copy of any applicable Tax law, regulation or ordinance containing the exemption; (ii) assist Licensors in obtaining any applicable exemption; and (iii) assist Licensors in processing any application form to obtain any applicable Tax treaty benefit.

#### **Article 8      Payments**

- 8.1 Payment. Eaton agrees to remit to Licensors the consideration due under Article 7 following the below schedule upon receipt of a corresponding invoice from the Licensors:
- 600.000 CZK within 30 (thirty) days of signature of this Agreement;
  - 400.000 by January 31<sup>st</sup> 2022;
  - 400.000 by January 31<sup>st</sup> 2023.
- 8.2 Licensors' Shares. Each payment made by Eaton shall be split between the Licensors as follows:
- 63.16% to the benefit of the Institute;
  - 36.84% to the benefit of the ICT Prague.
- 8.3 Any electronic funds transfer ("EFT"), wire transfer or other transaction fees incurred in connection with the payment or transmittal of funds by Eaton are solely for the account of Eaton and shall not be deducted from amounts payable to Licensors.

#### **Article 9      Disclaimers; Exclusions of Liabilities**

- 9.1 DISCLAIMERS. UNLESS OTHERWISE SPECIFICALLY PROVIDED FOR HEREIN, ALL LICENSED INTELLECTUAL PROPERTY ARE PROVIDED "AS IS," AND LICENSORS DISCLAIM THAT THE APPLICATION OR USE THEREOF SHALL HAVE ANY EFFECT ON EATON OR EATON'S BUSINESS. EATON WAIVES, RELEASES AND RENOUNCES ALL WARRANTIES, OBLIGATIONS AND LIABILITIES OF LICENSORS, AND ALL OTHER RIGHTS, CLAIMS AND REMEDIES OF EATON AGAINST LICENSORS, EXPRESS OR IMPLIED, ARISING BY LAW OR OTHERWISE, WITH RESPECT TO ANY NONCONFORMANCE OR DEFECT IN THE LICENSED INTELLECTUAL PROPERTY, INCLUDING (i) ANY IMPLIED WARRANTY OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE; (ii) ANY IMPLIED WARRANTY ARISING FROM COURSE OF PERFORMANCE, COURSE OF DEALING OR USAGE OF TRADE; (iii) ANY OBLIGATION, LIABILITY, RIGHT, CLAIM, OR REMEDY IN TORT, WHETHER OR NOT ARISING FROM THE

NEGLIGENCE OF LICENSORS; AND (iv) ANY OBLIGATION, LIABILITY, RIGHT, CLAIM OR REMEDY FOR LOSS OF OR DAMAGE TO ANY PROPERTY.

9.2 INTELLECTUAL PROPERTY. LICENSORS MAKE NO REPRESENTATION, GUARANTEE OR WARRANTY AS TO THE SCOPE OR VALIDITY OF THE LICENSED INTELLECTUAL PROPERTY OR ANY INTELLECTUAL PROPERTY RIGHTS THEREIN, OR THAT EATON'S USE THEREOF SHALL BE FREE FROM INFRINGEMENT OF ANY INTELLECTUAL PROPERTY RIGHTS HELD BY THIRD PARTIES. LICENSORS SHALL INCUR NO OBLIGATION OR LIABILITY FOR BRINGING OR PROSECUTING ACTIONS AGAINST THIRD PARTIES FOR ANY ALLEGED INFRINGEMENT OF INTELLECTUAL PROPERTY RIGHTS OR FOR DEFENDING EATON AGAINST THE SAME.

#### **Article 10      Miscellaneous**

- 10.1 No Partnership. This Agreement does not constitute a partnership, joint venture or formal business organization of any kind. Each Party is and shall remain an independent contractor as to the other Party. Eaton is not constituted or appointed an agent or representative of Licensors for any purpose, nor shall anything contained herein be deemed or construed as granting to Eaton any right or authority to assume or to create any obligation, express or implied, for or on behalf of or in the name of Licensors.
- 10.1 Law; Venue. This Agreement is governed by the laws of the Czech Republic.
- 15.6 Waiver; Invalidity. The failure by either Party to enforce any provision of this Agreement shall not be construed as a waiver of any provision. If any provision of this Agreement is held unlawful or otherwise ineffective, in whole or in part, by a court of competent jurisdiction, the remainder of the Agreement shall remain in full force and effect, and the provision modified, or the Agreement interpreted to the maximum extent permitted, to effect the original intent and purpose of the Parties.
- 15.7 Interpretation. The rules of construction to the effect that ambiguities are to be resolved against the drafting party shall not be employed in the interpretation of this Agreement. The recitals, article headings and section headings used herein are inserted for convenience only and shall not be construed to affect the interpretation of this Agreement.
- 15.8 Order. In the event of any conflicting terms, the following order of precedence shall prevail: (i) this Agreement; (ii) the attachments to this Agreement; (iii) any documents that may be incorporated by reference to this Agreement; and (iv) any other documents or agreements.
- 15.9 Excusable Delay. Neither Party shall be liable for any delay in performance caused by (i) acts of God; (ii) war or armed hostilities; (iii) government acts or priorities; (iv) strikes or labor troubles causing cessation, slowdown or interruption of work; (v) inability, after due and timely diligence, to procure materials, systems, accessories, equipment or parts; or (vi) any other cause to the extent the cause is beyond the Party's control and not occasioned by the Party's fault or negligence. In the event of such a delay, the date for completion of the Party's performance shall be equitably extended; provided, however, that the performance of any obligation shall not under any circumstances be delayed for a period of more than ninety (90) days, or with respect to any obligation for the reporting or payment of any monies owed under this Agreement, for a period of not more than thirty (30) days.
- 15.10 Survival. The provisions of this Agreement that may reasonably be interpreted or construed as surviving the expiration or termination of this Agreement, including, without limitation, those Articles entitled "Confidentiality," "Disclaimers; Exclusions of Liabilities," "Limitation of Remedies" and "Indemnification" shall survive expiration or termination of this Agreement.
- 15.11 Notices. Notices under this Agreement shall be in English and shall be given in writing, delivered by (i) courier service; (ii) registered mail; or (iii) sent by email with a confirmation sent by registered mail. Either Party may change their address by notice as provided for herein. Notice shall be deemed to

have been given on the earlier of the day received or five (5) days following transmittal, addressed as follows:

- 15.12 Cooperation. Each Party agrees to execute and deliver all documents, perform all acts and take all steps that may be reasonably necessary to carry out their respective obligations under this Agreement and the transactions contemplated hereby.
- 15.13 Complete Agreement. The Parties acknowledge that each has read this Agreement, understands it and agrees to be bound by its terms. This Agreement constitutes the complete and exclusive written expression of the terms of the agreement between the Parties and supersedes all prior or contemporaneous proposals, understandings, representations, conditions, warranties, covenants and all other communications between the Parties relating to the subject matter of this Agreement, whether oral or written. This Agreement may be amended only by a written amendment duly executed by the authorized representatives of both Parties.
- 15.14. Register of Contracts: The Parties acknowledge and agree that this Agreement is subject to obligatory publication under the Czech Act No. 340/2015 Coll., on Special Conditions of Effect of certain Contracts, Publication of these Contracts and on the Register of Contract ("Act on the Register of Contracts"). The Parties have agreed that prior to disclosure of this Agreement, any and all provisions of this Agreement, Attachments, and appendices hereto designated by the Parties as business secret prior to the signing of this Agreement shall be removed (blackened); pursuant thereto, the following provisions of this Agreement, Attachments, and appendices are considered trade secret of the Parties, and the Institute shall redact (blacken) such provisions prior to disclosure: Section 3.1, Section 3.3, Attachment A. The obligatory disclosure of the Commercialization Agreement pursuant to the Act on the Register of Contracts shall be made by ICT Prague.

**Licensors:**

Ústav fyzikální chemie J. Heyrovského AV  
ČR, v.v.i.

Vysoká škola chemicko-technologická v Praze:



**Eaton:**

**Eaton:**