

06-03-1999

FORM PTO-151M  
1-31-99



101053785

COVER SHEET  
S ONLY

U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Tab settings <<< ▾

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

516-99  
I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Post Office to Addressee, Express Mail No. 8594840. This is in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington VA 22202-3513 on May 11, 1999.  
Lisa M. Hendore  
65-11-99

1. Name of conveying party(ies):

SchoolWorks Associates, Inc.

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

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

3. Nature of conveyance:

- Assignment
- Security Agreement
- Other Contract of Sale
- Merger
- Change of Name

Execution Date: August 12, 1992

2. Name and address of receiving party(ies):

Name: K-12 MicroMedia Publishing

Internal Address:

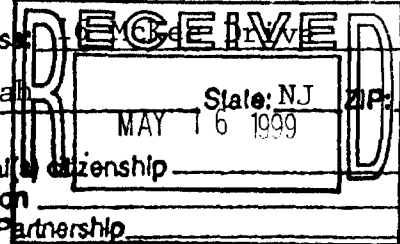
Street Address:

City: Mahwah State: NJ ZIP: 07430

- Individual citizenship
- Association
- General Partnership
- Limited Partnership
- Corporation-State New Jersey
- Other

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)

1,769,745

Additional numbers attached?  Yes  No

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

Name: David A. Lundy

Internal Address: Lundy and Associates

825 Anthony Wayne Building

Street Address: 203 E. Berry Street

City: Fort Wayne State: IN ZIP: 46802

6. Total number of applications and registrations involved

1

7. Total fee (37 CFR 3.41):..... \$ 40.00

Enclosed

Authorized to be charged to deposit account

8. Deposit account number:

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

06/1999 INGVEN 00000275 1769745  
Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

David A. Lundy, Reg. No. 22,162  
Name of Person Signing

Signature

May 11, 1999  
Date

Total number of pages comprising cover sheet

1

TRADEMARK  
REEL: 001905 FRAME: 0940

## CONTRACT OF SALE

**WHEREAS SchoolWorks Associates Inc.** (hereinafter "SchoolWorks") wishes to assign all trademarks, copyrights, and all other non-tangible assets to **K-12 MicroMedia Publishing Inc.** a New Jersey Corporation henceforth referred to as K-12 MMP for the sum of One Thousand Five Hundred Dollars (\$1,500.00).

*We the undersigned*, which constitute all of the stockholders of SchoolWorks, wish to assign all rights regarding certain computer based programs (assets), trademarks and copyrights as listed in Addendum A.

*Assets to be transferred:* The assets shall include and not be limited to copyrights, trademarks, use of the SchoolWorks name, and good reputation. This agreement shall be exclusive. Trademarks shall be subject to the consent to use agreement by and between The Software Toolworks, Inc. and SchoolWorks Associates Inc., executed 8-11-92, a copy of which is attached as Addendum "B". No other contract or agreement shall be executed whether in writing or verbal with any third party regarding the assets listed in Appendix A. SchoolWorks shall upon receipt of payment mail to K-12 MMP any and all documents relating to its trademarks and copyrights.

*Payment:* Payment shall be made to Larry Pletcher in the amount of One Thousand Five Hundred Dollars (\$1,500.00) with ten (10) days of receipt of the executed contract by K-12 MMP.

*K-12 MMP's liability:* K-12 MMP does not assume any obligations legal, financial or otherwise that SchoolWorks has assumed during its course of business.

*SchoolWorks liability:* SchoolWorks and its stockholders shall be held harmless by K-12 MMP in any and all liability, loss or damage, including but not limited to attorney's fees and costs, arising out of the sale or use of the SchoolWorks name or the assets listed in Addendum A, or the terms and conditions of Addendum B commencing at the date of execution of this contract.

*It is agreed* that K-12 MMP may use the SchoolWorks name and trademark in the course of its normal business dealings. There shall be no cost other than outlined above or limitations in use or duration. K-12 MMP shall have the right to transfer any and all assets covered in this agreement to a third party without prejudice. This contract may only be changed in writing and shall be governed by the laws of the State of Indiana.

This contract represents the entire agreement of the parties.

If any provision of this contract is deemed void of without force, such a determination shall no affect on the remaining portions of this contract.

**K-12 MicroMedia Publishing Inc.**

**SchoolWorks Associates Inc.**

Signed A G Schweiker Signed Larry Pletcher  
President pres., Title

Print name ANTHONY G Schweiker Print name Larry Pletcher

Affix corporate seal here

Signed [Signature], Title

Print name Joel Robbins

Signed [Signature], Title

Print name David A. Goodrum

Affix corporate seal here

## **Addendum A**

SchoolWorks Athletic Director

SchoolWorks Department Head

SchoolWorks LetterFiles

SchoolWorks Office

SchoolWorks Teacher

SchoolWorks Social Studies

SchoolWorks States & Presidents

SchoolWorks™ Trademark

Assignment of copyrights of all SchoolWorks titles and documentation

## CONSENT TO USE AGREEMENT

WHEREAS, Schoolworks Associates ("Schoolworks") has adopted the word SCHOOLWORKS as part of its tradename and as a trademark for use in association with software programs which it produces for use by public, private and parochial schools and their employees; and

WHEREAS, The Software Toolworks, Inc. ("Toolworks") is the owner of the trademarks TOOLWORKS and THE SOFTWARE TOOLWORKS as used in association with software programs throughout the world; and

WHEREAS, Schoolworks has filed an application, Serial No. 637,275 for registration of the word SCHOOLWORKS in Class 9 for computer programs recorded on diskettes and instructional manuals sold as a unit for use in the field of education (the "Application") and Toolworks has filed an Opposition to said registration before the Trademark Trial and Appeal Board, Opposition No. 78,005 ("the Opposition")

WHEREAS, the parties wish to avoid consumer confusion with respect to Schoolworks' use of the SCHOOLWORKS tradename and trademark (the "Trademark and Tradename"); and

WHEREAS, Toolworks is willing to consent to Schoolworks' use and registration of the Trademark and Tradename so long as no consumer confusion is created by Schoolworks' use of the Trademark and Tradename.

THEREFORE, in consideration of the mutual promises contained herein, the parties agree as follows:

1. Upon execution of this Agreement by both parties, Toolworks agrees to withdraw the Opposition.

2. As soon as practicable after the execution of this Agreement, Schoolworks agrees to amend the Application to designate the goods as computer programs recorded on diskettes and instructional manuals sold as a unit for use in the field of education.

3. Schoolworks agrees that it will only use the Tradename and Trademark "SCHOOLWORKS" in association with the sale and distribution of the software listed in Exhibits A and B as well as any related subsequently developed software (the "Goods") directly to the public, private and/or parochial schools and their employees (the "Channel"). The Trademark and Tradename shall not be used in association with any other goods or channel of trade. The Trademark and Tradename shall not be used in association with goods distributed through retail channels or through other means to the general public. Toolworks consents to the school administration programs listed in Schedule A. Toolworks only consents to the use of the specific application programs listed in Schedule B so long as no consumer confusion results from Schoolworks' use of the

Tradename and Trademark in association with these specific titles.

4. Schoolworks agrees to report any incidence of actual confusion between Schoolworks and the Software Toolworks, Inc. or its TOOLWORKS or THE SOFTWARE TOOLWORKS trademarks, including, but not limited to, misdirected mail or telephone calls which comes to Schoolworks attention. Schoolworks will cooperate with Toolworks to avoid consumer confusion in the Channel. Schoolworks agrees that it will not adopt packaging or engage in advertising which is likely to cause confusion, and will modify its advertising and/or packaging if consumer confusion results from Schoolworks' use of the Trademark or Tradename in the Channel.

5. In the event Toolworks is prevented from registering TOOLWORKS, THE SOFTWARE TOOLWORKS, or any similar mark because of the use or registration by Schoolworks of the Trademark or Tradename, Schoolworks shall, at Toolworks election, execute any consent document for filing in the United States Patent and Trademark Office proposed by Toolworks and otherwise assist Toolworks at the expense of Toolworks in its registration thereof, and (b) in the event that Toolworks is prevented from registering TOOLWORKS, THE SOFTWARE TOOLWORKS, or any similar mark, Schoolworks as a last resort, shall assign without further consideration all right, title and interest in the trademark SCHOOLWORKS and any application or registrations thereof to Toolworks and Toolworks shall then grant Schoolworks a continuing, royalty free, exclusive license to use the trademark and tradename SCHOOLWORKS in association with the Goods in the Channel.

6. Schoolworks agrees that it will not oppose or otherwise challenge any application or registration by Toolworks for TOOLWORKS, THE SOFTWARE TOOLWORKS, or similar marks throughout the world.

7. Except as otherwise provided in this Agreement, Toolworks agrees that it will not oppose or otherwise challenge any application or registration by Schoolworks for SCHOOLWORKS as applied to the Goods for distributed in the Channel. Notwithstanding this Section 7, nothing in this Agreement will prohibit Toolworks from canceling the Trademark on the grounds of non-use.

8. This Agreement will continue until terminated by a material breach of the Agreement by either party. The non-breaching party will give thirty (30) days prior written notice of the alleged breach to the breaching party and such notice will describe the alleged breach in reasonable detail. This Agreement will terminate upon the completion of the thirty (30) day period unless the breaching party has cured the breach within such period. Nothing in this section precludes either party from seeking at any time any legal or equitable remedy it might otherwise have.

9. No term or provision hereof will be considered waived by either party, and no breach excused by either party, unless such

waiver or consent is in a writing signed by both parties. No consent by either party to, or waiver of, a breach by either party, whether express or implied, will constitute a consent to, waiver of, or excuse of any other, different, or subsequent breach by either party.

10. This Agreement will bind and inure to the benefit of both parties and their respective successors and permitted assigns.

11. Neither party will assign this Agreement or any rights and obligation under this Agreement without the written consent of the other party except for an assignment by either party to an entity which purchase all or substantially all of its assets in the products which bear the respective trademarks.

12. This Agreement will be governed by and construed in accordance with the laws of the United States and the State of California as applied to agreements entered into and to be performed entirely within California by California residents.

13. Any notice provided for or permitted under this Agreement will be treated as having been given on the date it is (a) delivered personally, (b) sent by confirmed telex or telecopy, or (c) sent by commercial overnight courier with written verification of receipt, or five business days after it is mailed postage prepaid by certified or registered mail, return receipt requested, to the party and its counsel to be notified, at the address set forth on the signature page, or at such other place of which the other party and its counsel has been notified in accordance with the provisions of this Section.

14. This Agreement constitutes the entire agreement between the parties relating to this subject matter and supersedes all prior or simultaneous representations, discussions, negotiations, and agreements, whether written or oral.

15. This Agreement may be amended or supplemented only by a writing that is signed by duly authorized representatives or both parties.

The persons signing below warrant that they are authorized to enter into this Agreement on behalf of their respective principals identified below and that by their signatures they bind such principals to this Agreement.

THE SOFTWARE TOOLWORKS, INC.

By: *[Signature]*  
Its: 8-20-92  
Date: President

SCHOOLWORKS ASSOCIATES, INC.

By: *[Signature]*  
Its: pres.  
Date: 8-11-92

SCHEDULE A

SchoolWorks: Teacher Apple  
SchoolWorks: Teacher 3.0 Apple  
SchoolWorks: Teacher IBM  
SchoolWorks: Teacher MAC  
SchoolWorks: Teacher DeskMate  
SchoolWorks: Office Apple  
SchoolWorks: Office IBM  
SchoolWorks: Office MAC  
SchoolWorks: Athletic Director Apple  
SchoolWorks: Athletic Director IBM  
SchoolWorks: Athletic Director MAC  
SchoolWorks: Set of 3 Apple  
SchoolWorks: Set of 3 IBM  
SchoolWorks: Set of 4 Apple  
SchoolWorks: Set of 4 IBM  
SchoolWorks: Set of 3 MAC  
SchoolWorks: Set of 4 MAC  
SchoolWorks: Set of 5 MAC  
SchoolWorks: LetterFiles Apple  
SchoolWorks: LetterFiles IBM  
SchoolWorks: LetterFiles MAC  
SchoolWorks: LetterFiles DeskMate  
SchoolWorks: Department Head Apple  
SchoolWorks: Department Head IBM  
SchoolWorks: Department Head MAC

Any related, subsequently developed software. ✓



SCHEDULE B

SchoolWorks: Social Studies Apple

SchoolWorks: Social Studies IBM

SchoolWorks: State and Presidents Apple

SchoolWorks: States and Presidents IBM

SchoolWorks: Social Studies and States and Presidents Bundle Apple

SchoolWorks: Social Studies and States and Presidents Bundle IBM

Any related, subsequently developed software.