

07-12-2000

D

FORM PTO-1594



Docket No. 10/WPC/D226

101400423

EET

Box Assignment  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

S. 22.00

Post Office Box 7068  
Pasadena, CA 91109-7068

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

<p><b>1. Name of conveying party(ies):</b> <b>Creative Food 'N Fun Company</b></p> <p><input type="checkbox"/> Individual(s)      <input type="checkbox"/> Association  <input type="checkbox"/> General Partnership      <input type="checkbox"/> Limited Partnership  <input checked="" type="checkbox"/> Corporation  <input type="checkbox"/> Other  <input checked="" type="checkbox"/> Exists Under Laws of Delaware</p> <p>Additional name(s) of conveying party(ies) attached: <b>no</b></p>	<p><b>2. Name and address of receiving party(ies):</b> Name: <b>Del Taco, Inc.</b></p> <p>Street Address: <b>23041 Avenida de la Carlota, Laguna Hills, California 92653</b></p> <p><input type="checkbox"/> Individual(s) citizenship  <input type="checkbox"/> Association  <input type="checkbox"/> General Partnership  <input type="checkbox"/> Limited Partnership  <input checked="" type="checkbox"/> Corporation  <input type="checkbox"/> Other:  <input checked="" type="checkbox"/> Exists Under Laws of <b>California</b></p> <p>05-22-2000 U.S. Patent &amp; TMO/c/TM Mail Rcpt Dt. #54</p>												
<p><b>3. Name of conveyance:</b></p> <p><input type="checkbox"/> Assignment      <input type="checkbox"/> Merger  <input type="checkbox"/> Security Agreement      <input type="checkbox"/> Change of Name  <input checked="" type="checkbox"/> Other: <b>Trademark License Agreement</b></p> <p>Execution Date: <b>December 8, 1999</b></p>	<p>If assignee is not domiciled in the United States, a domestic representative designation is attached:  (Designation must be a separate document from Assignment). Additional name(s) &amp; address(es) attached?</p>												
<p><b>4. A. Trademark Application No.(s)</b></p>	<p><b>4. B. Trademark Registration No.(s)</b></p> <table border="0"> <tr><td>1,035,949</td><td>1,219,339</td><td>1,221,321</td><td>1,231,138</td></tr> <tr><td>1,231,168</td><td>1,231,240</td><td>1,232,360</td><td>1,392,800</td></tr> <tr><td>1,458,796</td><td>1,728,349</td><td>1,793,268</td><td>1,830,903</td></tr> </table> <p>Additional numbers attached? <b>no</b></p>	1,035,949	1,219,339	1,221,321	1,231,138	1,231,168	1,231,240	1,232,360	1,392,800	1,458,796	1,728,349	1,793,268	1,830,903
1,035,949	1,219,339	1,221,321	1,231,138										
1,231,168	1,231,240	1,232,360	1,392,800										
1,458,796	1,728,349	1,793,268	1,830,903										
<p><b>5. Please return the recorded document and address all correspondence to:</b> <b>CHRISTIE, PARKER &amp; HALE, LLP</b> P.O. Box 7068 Pasadena, CA 91109-7068 Attention: <b>William P. Christie</b></p>	<p><b>6. Total number of applications or registrations involved.....</b> <span style="border: 1px solid black; padding: 2px;">12</span></p> <p><b>7. <input checked="" type="checkbox"/> Total fee enclosed (37 CFR 3.41):</b>      \$ <b>315.00</b></p> <p><b>8. <input checked="" type="checkbox"/> Any deficiency or overpayment of fees should be charged or credited to <b>Deposit Account No. 03-1728</b>, except for payment of issue fees required under 37 CFR § 1.18. Please show our docket number with any credit or charge to our Deposit Account.</b></p>												
<p><b>10. <input type="checkbox"/> Explanatory letter is enclosed.</b></p>													
<p><b>9. Statement and signature.</b> 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.</p> <p>Date: <b>May 16, 2000</b></p> <p>By <u><i>William P. Christie</i></u> Name: <b>William P. Christie</b> 626/795-9900</p> <p>I hereby certify that this correspondence is being deposited with the U.S. Postal Service in first class mail in an envelope addressed to Assistant Commissioner for Trademarks, 2900 Crystal Drive Arlington, VA 22202-3513 on: Date of Deposit: <u><i>May 16, 2000</i></u> <u><i>Mary L. Morley</i></u></p> <p>Total number of pages including cover sheet, attachments, and document: <span style="border: 1px solid black; padding: 2px;">11</span></p>													

WPC/mlm  
MLM IRV1035941.1\*-5/16/00 2:45 PM

TRADEMARK  
REEL: 002098 FRAME: 0841

40.00 08  
275.00 08  
1035949  
0000009 1035949  
7/12/2000  
01 FC:441  
02 FC:442

## TRADEMARK LICENSE AGREEMENT

Trademark License Agreement dated ~~November~~ <sup>December</sup> 8, 1999, is between CREATIVE FOOD 'N FUN COMPANY, a Delaware corporation, having executive offices at 7500 Grace Drive, Columbia, Maryland 21044 ("CFF"), a wholly-owned subsidiary of W. R. Grace & Co.-Conn., a Connecticut corporation, with offices at 7500 Grace Drive, Columbia, Maryland 21044, and DEL TACO, INC., a California corporation, having executive offices at 23041 Avenida de la Carlotta, Suite 400, Laguna Hills, California 92653 ("DTI");

WHEREAS, CFF has operated restaurants under the Del Taco name and has franchised a system for operating Mexican fast food restaurants under the Del Taco name based on the Del Taco system;

WHEREAS, CFF sold to DTI substantially all of the fee and leasehold properties at which CFF and its affiliates operated such restaurants; and

WHEREAS, CFF is the owner of the trademarks listed in the attached Schedule in the United States and various states and has obtained federal and state registrations for such trademarks and also is the owner of the goodwill associated with those trademarks ("own" being used in the sense of having the right to grant licenses to use such trademarks); and

WHEREAS, CFF and DTI have this day entered into a Trademark Assignment Agreement pursuant to which CFF will transfer title to these trademarks to DTI as provided

under a certain Modification and Purchase Agreement dated July 7, 1992 between CFF and DTI.

WHEREAS, under Section 4(c) of the Modification and Purchase Agreement DTI has the option to purchase from CFF upon the occurrence of certain events and CFF has the right to sell to DTI upon the occurrence of certain events all of CFF's right, title and interest in and to the MARKS, together with the goodwill symbolized by the MARKS; and

WHEREAS, DTI has exercised its option under Section 4(c) of the Modification and Purchase Agreement to purchase the MARKS upon the payment to CFF of one thousand dollars (\$1,000.00) and CFF has accordingly assigned the MARKS; and

WHEREAS, CFF wishes to use the MARKS only in connection with its Del Taco franchisees in the event that a certain Management Agreement dated July 7, 1992, between CFF and DTI is terminated and CFF resumes the management of its remaining Del Taco franchisees under the MARKS, and DTI is willing to allow such usage on the terms and conditions hereinafter set forth.

NOW, THEREFORE, in consideration of the mutual promises and covenants contained in this Trademark License Agreement as well as in the other agreements entered into by the parties, the parties hereby agree as follows:

## I. DEFINITIONS

a. The term "MARKS" as used herein shall mean the trademarks listed in the attached Schedule and any other trademarks or tradenames that may be added from time to time by mutual agreement of the parties.

b. The term "THE TERRITORY" as used herein shall mean the geographic area comprising the state of Georgia.

c. The term "PRODUCTS AND SERVICES" as used herein shall mean those restaurant related goods and services used and offered in the ordinary course of the Del Taco restaurant business and bearing the MARKS and such other uses as the parties shall from time to time mutually agree to.

d. The term "EFFECTIVE DATE" shall mean the date of this Agreement first above written.

## II. LICENSE GRANT

a. For good and valuable consideration, the receipt of which is hereby acknowledged, DTI hereby grants to CFF a non-exclusive license to use the MARKS in connection with the rendering of restaurant services as well as the manufacture, marketing, advertising and sale of PRODUCTS AND SERVICES in THE TERRITORY, so long as CFF shall comply with the terms of this Agreement.

b. CFF shall have the right to grant sublicenses to use the MARKS only to the extent necessary for its franchisees to possess this same licensed right.

c. The parties agree that nothing in this specific Trademark License Agreement creates any added royalty obligations to CFF and DTI has no intention of creating any added royalty obligations by way of this Trademark License Agreement.

### III. DURATION OF LICENSE

The license grant provisions of this Agreement shall remain in force until either (i) all CFF's remaining Del Taco franchisees cease to operate or are otherwise terminated; or (ii) all remaining CFF's Del Taco franchisees convert to DTI's franchise system.

### IV. TERMINATION

a. Notwithstanding the provisions of the foregoing Article III;

(i) CFF may terminate its right to use the MARKS at any time prior to the foregoing period upon thirty (30) days written notice to DTI.

(ii) DTI may terminate its grant of license under this Agreement in the event that CFF breaches any of its obligations under this Agreement. DTI's termination of the grant of license under this Article IV (ii) shall be effective one hundred twenty (120) days after DTI's giving written notice according to Article X to CFF of such termination provided CFF has not commenced to remedy such breach within such one hundred twenty (120) day period.

(iii) DTI may terminate the license grant provision of this Agreement if CFF assigns, transfers or sublicenses this Agreement or any of its rights or obligations hereunder, except as expressly permitted herein.

b. In the event of any termination of CFF's right to use the MARKS or at the expiration of this Agreement under Article III, CFF shall immediately cease all use of the MARKS, including, but not limited to, use of the MARKS in conjunction with the advertising and sale of PRODUCTS AND SERVICES in THE TERRITORY and use of any trademark that is similar to the MARKS provided however that CFF shall have the right to continue the use of the MARKS for a reasonable period of time not to exceed six (6) months from such termination or expiration solely in connection with the sale of products in inventory as of the effective date of such termination or expiration.

V. OWNERSHIP OF THE MARK

a. CFF acknowledges DTI's right, title and interest in and to the MARKS and the goodwill associated with the MARKS. CFF shall not represent in any manner that it has ownership in the MARKS. CFF acknowledges that use of the MARKS shall not create any ownership, rights, title or interest in CFF, but that all such use by CFF shall inure to the sole benefit of DTI. CFF acknowledges that it will not during the term of this Agreement or thereafter register or apply for registration of the MARKS anywhere in the world.

b. The PRODUCTS AND SERVICES as manufactured and offered by CFF which bear the MARKS shall be manufactured, packaged, labeled, offered and sold in accordance with all applicable laws and regulations within THE TERRITORY.

c. CFF shall display the MARKS only in accordance with the laws and regulations that are applicable within THE TERRITORY.

d. Any change in the manner of use of the MARKS in or on labels, packaging, advertisements and the like bearing the MARKS shall be approved by DTI prior to use by CFF, which approval shall not be unreasonably withheld or delayed.

e. CFF agrees that DTI shall have the right throughout the life of this Agreement, to ascertain that CFF is complying with the provisions of this Agreement. CFF shall, upon reasonable prior written notice, provide DTI or its authorized representatives with access to CFF's relevant premises and operations, during normal business hours, for the purpose of inspection and sample gathering reasonably necessary to ascertain proper compliance with this Agreement.

f. From time to time each party, as and when requested by the other party, shall execute and deliver, or cause to be executed and delivered, all such documents and instruments and shall take, or cause to be taken, all such further or other actions as the requesting party may reasonably deem necessary or desirable to carry out the intent and purpose of this Agreement and to consummate the transactions contemplated hereby.

## VI. WARRANTIES/DISCLAIMERS

DTI warrants that to the best of its knowledge, it owns the MARKS as represented and assigned to DTI by CFF and has the right to grant the license herein. DTI does not warrant that it has exclusive title to the MARKS in THE TERRITORY and represents only that it is granting CFF rights to the extent that DTI owns such rights in THE TERRITORY.

## VII. INFRINGEMENTS

a. CFF shall notify DTI in the event that CFF learns of any apparent infringement of the MARKS.

b. DTI may at its sole option elect to bring an action against any apparent infringement of the MARKS. In the event that DTI elects not to bring such an action, it may notify CFF and CFF shall have the right to bring an action at its option and expense to protect its interest and the interest of its franchisees. Any proceeds which either party receives by virtue of a successful action against or settlement with an apparent infringer shall be divided between DTI and CFF in the same proportion as each of them bore the reasonable cost of and participation in any such action.

## VIII. ASSIGNMENT/SUB-LICENSE

a. CFF shall not, without the prior written consent of DTI assign, transfer, or in any way sub-license this Agreement or any of its rights or obligations hereunder, except (i) to the extent sub-licensing is necessary to permit lawful use of the MARKS by CFF's remaining Del Taco franchisees in the event the Management Agreement between the parties identified above is terminated; and (ii) to the Purchaser of that portion of CFF's business which relates to the CFF Del Taco franchises.

b. DTI may assign or sub-license this Agreement or any of its rights or obligations hereunder.



IX. MODIFICATION/WAIVER

a. This Agreement may be modified only in writing signed by both DTI and CFF. Neither DTI's nor CFF's failure to enforce any of the provisions of this Agreement shall constitute a waiver of its rights to later enforce such terms or conditions.

b. Any waiver under this Agreement must be in writing signed by the party to be charged therewith.

X. NOTICE

a. Any notices, communications or payment given or required in connection with this Agreement shall be considered as properly made or sent when deposited with the U. S.

Postal Service, postage prepaid, addressed as follows:

If to CFF:

Creative Food 'N Fun Company  
c/o W. R. Grace & Co.  
7500 Grace Drive  
Columbia, Maryland 21044  
Attention: Trademarks

with a copy to:

Chief Patent Counsel  
W. R. Grace & Co.-Conn.  
7500 Grace Drive  
Columbia, Maryland 21044

If to DTI:

Del Taco, Inc.  
23041 Avenida de la Carlotta  
Suite 400  
Laguna Hills, California 92653  
Attention: General Counsel

b. Either party hereto may change its address as set forth in this Agreement at any time by notice in writing to the other, provided that such new address shall only become effective upon actual receipt by the other party.

XI. GOVERNING LAW

This Agreement shall be construed under the laws of the state of New York exclusive of its conflict of laws provision.

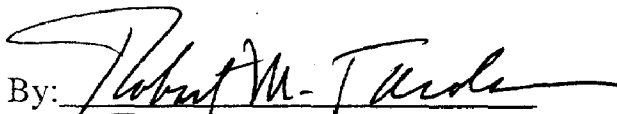
XII. ENTIRE AGREEMENT


This Agreement expresses the entire understanding between the parties with respect to its subject matter and any prior or contemporaneous negotiations, discussions or agreements are hereby superseded.

IN WITNESS WHEREOF, the parties have signed this Agreement through their duly authorized representative, as of the date first hereinabove written.

CREATIVE FOOD 'N FUN COMPANY

DEL TACO, INC.

By:   
Name: Robert M. Tarolo  
Title: Vice President/Treasurer

By:   
Name: Michael Davis  
Title: U.A. - Gen. Counsel

PD LICENSE/9-8039R  
JPR/kas