

07-17-2000

ET

Docket No.:

RCH 15584

6-19-00



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To the Honorable Commissioner of Patents and Trademark

d original documents or copy thereof.

1. Name of conveying party(ies):

Lawee, Inc.

f receiving party(ies):

ational Corporation S.A.

06-19-2000

U.S. Patent & TMOrc/TM Mail Rcpt Dt. #26



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

Street Address: 5 Boulevard De La Foire
 City: Luxembourg State: _____ ZIP: L-1528

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

If assignee is not domiciled in the United States, a domestic designation is Yes N
 (Designations must be a separate document from Additional name(s) & address(es) Yes N

Additional names(s) of conveying party(ies) Yes No

3. Nature of conveyance:

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

Execution Date: February 25, 1997 & March 18, 1997

4. Application number(s) or registration numbers(s):

A. Trademark Application No.(s)

B. Trademark Registration No.(s)

1,912,450

(Note: Schedule A contains a typographical error. Reg. No. 1,913,450 should be Reg. No. 1,912,450)

Yes No

Additional numbers

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

Name: Anthony P. Venturino

Internal Address: Stevens, Davis, Miler & Mosher, L.L.P.

Street Address: 1615 L Street, N.W., Suite 850

City: Washington State: DC ZIP: 20036

6. Total number of applications and registrations involved:.....

1

7. Total fee (37 CFR 3.41):.....\$ 340.00

- Enclosed
- Authorized to be charged to deposit account

8. Deposit account number:

19-4375

07/14/2000 ASCOTT 00000106 1912450

01 FC:481

40.00 OP

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9. 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.

Anthony P. Venturino

Name of Person Signing

Anthony P. Venturino
Signature

June 19, 2000
Date

Total number of pages including cover sheet, attachments, and

TRADEMARK


ASSIGNMENT AGREEMENT

WHEREAS, Lawee, Inc., a California corporation, Assignor, having a place of business at 3030 Walnut Avenue, Long Beach, California 90807, has adopted, used and is using marks which are the subject of the United States and foreign trademark registrations and applications for registration listed on the annexed Schedule A;

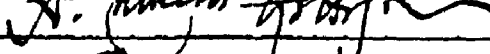
WHEREAS, Derby International Corporation S.A., a Luxembourg corporation, Assignee, having a place of business at 5 Boulevard De La Foire, L-1528, Luxembourg, is desirous of acquiring said marks and the registrations and applications therefor, together with that part of the goodwill of the business connected with the use of and symbolized by said marks; and

NOW, THEREFORE, for good and valuable consideration, receipt of which is hereby acknowledged, (1) Assignor does hereby sell, assign and transfer to Assignee, the entire right, title and interest in and to the aforementioned marks and the registrations and applications therefor, together with the part of the goodwill of the business connected with the use of and symbolized by said marks; and (2) Assignee does hereby absolve and release Assignor and its agents from all responsibility for all renewals and further actions which may hereafter be necessary to maintain the aforementioned registrations and applications in force.

LAWEE, INC.

By 
Title President
Date Feb 25, 1997

DERBY INTERNATIONAL CORPORATION S.A.

By 
Title Chairman
Date March 18, 1997

Schedule A

United States Registrations and Applications

<u>U.S. Registration/Application No.</u>	<u>Trademark</u>
Reg. No. 1,075,465	UNIVEGA
Reg. No. 1,212,360	NUOVO-SPORT
Reg. No. 1,212,361	VIVA-SPORT
Reg. No. 1,212,362	SPECIALISSIMA
Reg. No. 1,212,363	SUPER SPECIAL
Reg. No. 1,215,716	GRAN-PREMIO
Reg. No. 1,263,549	BERTONI
Reg. No. 1,290,908	ALPINA
Reg. No. 1,387,461	STERLING
Reg. No. 1,390,546	TOP GEAR
Reg. No. 1,501,255	ITALAMERICA
Reg. No. 1,784,035	CONCEPT
Reg. No. 1,913,450	BORALITE
Reg. No. 1,939,014	MOUNTAIN FORCE
Reg. No. 1,943,857	COBRA
Reg. No. 1,959,936	SUPER G
Reg. No. 1,989,261	CAVEMAN
Reg. No. 1,996,137	WILLOW
Reg. No. 1,996,138	HORNET
Application No. 74/603,165	MAD DOG
Application No. 75/082,050	REMOTE CONTROL
Application No. 75/161,657	ZIG ZAG

Foreign Registrations

<u>Country</u>	<u>Registration</u>	<u>Trademark</u>
Benelux	549,757	UNIVEGA
Canada	305,210	UNIVEGA
China	651,638	UNIVEGA
Denmark	7987/90	UNIVEGA

06-19-2000

J.S. Patent & TMO/c/TM Mail Rcpt Dt. #26

UNITED STATES PATENT AND TRADEMARK OFFICE



In re the Application of

CAMPAGNOLO s.r.l.

Serial No.: 75/007,512

Filed: October 18, 1995

Mark: BORA

Trademark Law Office: 104
Examining Attorney: Colleen M. Keegan

SUBMISSION OF CONSENT AGREEMENT WITH REQUEST FOR REMAND

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sir:

In response to the Final Office Action and after filing a Notice of Appeal, but prior to filing an Appeal Brief, applicant encloses a Consent Agreement and requests remand of this application to the Examiner.

The sole rejection is that the mark of the present application is confusingly similar to U.S. Trademark Registration No. 1,912,450 under Section 2(d) of the Trademark Act.

In response to this rejection, attached are the following.

A copy of a Consent Agreement signed by Mr. Gary Matthews in his stated capacity of Chief Executive Officer and President of Derby Cycle Corporation (signing for Derby International Corporation S.A.) and by Mr. Valentino Campagnolo in his stated capacity of President of Campagnolo S.r.l. (Attachment I).

A copy of the Consent Agreement signed by Alan Finden-Crofts in his stated capacity as a Director of Derby International Corporation S.A. (Attachment II). Mr. Finden-Crofts has been authorized to sign the Consent Agreement for Derby International Corporation S.A. Attachment II is provided in the event the Trademark Office questions the authority of Mr. Mathews to sign for Derby International Corporation S.A.

An assignment from Lawee, Inc. (the original owner) to Derby International Corporation S.A. showing Derby International Corporation S.A. is the current owner of the registered

TRADEMARK
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trademark (Attachment III). A copy of Attachment III has been filed for recordation concurrent with the filing of this Submission.

The undersigned notes the body of Attachment II indicates the Agreement is by Derby International Corporation of Luxembourg. The letterhead upon which Attachment II is written, lists Derby International Corporation S.A. at a Luxembourg address. It is apparent that these names are for the same company.

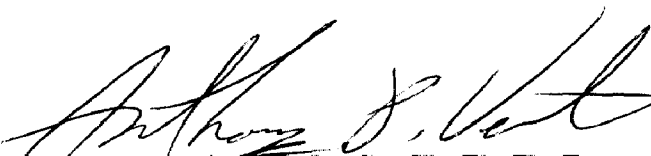
The undersigned also notes that, in Attachment III, BORALITE is listed as having U.S. Trademark Registration No. 1,913,450. This is clearly an inadvertent typographical error, with the correct number being 1,912,450

Conclusion

In view of the above, Applicant requests remand of this application to the Examiner and respectfully requests a Notice of Allowance be issued.

Respectfully submitted,

Date: June 19, 2000

By: 
Anthony P. Venturino

APV/aes
ATTORNEY DOCKET NO. RCH 15584

STEVENS, DAVIS, MILLER & MOSHER, L.L.P.
1615 L STREET N.W., SUITE 850
WASHINGTON, D.C. 20036
TEL. 202-785-0100 / FAX. 202-408-5200

ATTACHMENT I

DERBY INTERNATIONAL CORPORATION

S.A.

5 BOULEVARD DE LA FOIRE
L-1528 LUXEMBOURG

TELEX 2304
ANSWERBACK FINEXB LU
TELEFAX
(352) 45123-201

Please reply to: Alan Finden-Crofts

c/o Raleigh Industries Ltd
Triumph Road
Nottingham
NG7 2DD
England

Telephone: (0115) 942 0202
Telefax: (0115) 916 3511

Mr. Valentino Campagnolo
Vice President and Managing Director
Campagnolo S.r.L.
Via della Chimica 4-36100
Vicenza
ITALY

Dear Mr. Campagnolo:

Pursuant to the understanding reached between Derby International Corporation of Luxembourg (hereinafter "DERBY") and Campagnolo S.r.L. (hereinafter "CAMPAGNOLO"), the following herein represents an agreement between our respective organizations, in which DERBY consents to the use and registration of the mark "BORA" by CAMPAGNOLO under the mutual conditions and obligations hereinafter set forth.

DERBY owns U.S. Trademark Registration No. 1,912,450 covering the mark "BORALITE" for use on bicycles and structural parts for bicycles. This registration issued on August 15, 1995 to Lawee,

Mr. Valentino Campagnolo

DATE

Page 2

Inc. of Long Beach, California and claims a first use date of December 14, 1994. The rights to the mark "BORALITE" and this registration were assigned to DERBY on February 25, 1997. "BORALITE" is presently in use by DERBY.

CAMPAGNOLO wishes to use, on bicycles and structural parts for bicycles, the mark "BORA" and has filed an application on October 18, 1995 to register said mark basing its application upon the priority provided by an earlier application filed in Italy for the same mark and goods. That Italian application was filed on July 28, 1995 and was accorded MI95C 007820 as an application number.

The parties agree that:

(1) Registration of the mark "BORA" for use on such products is not believed to be likely to cause confusion, mistake or deception notwithstanding the existence of prior U.S. Trademark Registration No. 1,912,450 covering the mark "BORALITE."

(2) The respective goods of the parties hereto, although similar, are not apt to be confused due to the obvious differences in appearance, pronunciation, connotation and commercial meaning. The parties hereto also recognize that the term "BORA" is the name of a violent cold wind which sweeps the Yugoslavian Coast in winter.

Mr. Valentino Campagnolo
DATE
Page 3

(3) CAMPAGNOLO agrees not to use or seek registration for any other marks which utilize the "BORA" or "BORO" formative.

(4) Based upon the differences between the marks as mentioned herein, and Campagnolo's stated intention not to expand its use of the "BORA" or "BORO" formative, the parties believe that there will not be a likelihood of confusion, mistake or deception.

(5) Under these circumstances DERBY hereby consents to the use and registration by Campagnolo of the mark "BORA" on or in connection with the goods set forth in paragraph 3 herein.

(6) Should the need arise, the parties hereto will cooperate to take the necessary steps to prevent the possibility of consumer confusion arising in the future including the proper re-direction of the few customers who may be confused between the parties hereto.

DERBY INTERNATIONAL CORPORATION

By: A. J. H. G.

Title: Director

Date: _____

Mr. Valentino Campagnolo
DATE
Page 4

Accepted and acknowledged on the date hereinbelow stated.

CAMPAGNOLO S.r.L.

By: _____

Title: _____

Date: _____

ATTACHMENT II

THE DERBY CYCLE CORPORATION

Mr. Valentino Campagnolo
Vice President and Managing Director
Campagnolo S.r.l.
via della Chimica 4-36100
Vicenza
ITALY

Dear Mr. Campagnolo:

Pursuant to the understanding reached between Derby International Corporation of Luxembourg (hereinafter "DERBY") and Campagnolo S.r.l. (hereinafter "CAMPAGNOLO"), the following herein represents an agreement between our respective organizations, in which DERBY consents to the use and registration of the mark "SORA" by CAMPAGNOLO under the mutual conditions and obligations hereinafter set forth.

DERBY owns U.S. Trademark Registration No. 1,912,450 covering the mark "SORALITE" for use on bicycles and structural parts for bicycles. This registration issued on August 15, 1995 to Lawec.

E

300 FIRST STAMFORD PLACE - 3RD FLOOR
STAMFORD CONNECTICUT 06901

Mr. Valentino Campagnolo

Page 2

Inc. of Long Beach, California and claims a first use date of December 14, 1994. The rights to the mark "BORALITE" and this registration were assigned to DERBY on February 25, 1997. "BORALITE" is presently in use by DERBY.

CAMPAGNOLO wishes to use, on bicycles and structural parts for bicycles, the mark "BORA" and has filed an application on October 18, 1995 to register said mark basing its application upon the priority provided by an earlier application filed in Italy for the same mark and goods. That Italian application was filed on July 28, 1995 and was accorded MI95C 007820 as an application number.

The parties agree that:

(1) Registration of the mark "BORA" for use on such products is not believed to be likely to cause confusion, mistake or deception notwithstanding the existence of prior U.S. Trademark Registration No. 1,912,450 covering the mark "BORALITE."

(2) The respective goods of the parties hereto, although similar, are not apt to be confused due to the obvious differences in appearance, pronunciation, connotation and commercial meaning. The parties hereto also recognize that the term "BORA" is the name of a violent cold wind which sweeps the Yugoslavian Coast in winter.

300 FIRST STAMFORD PLACE - 3RD FLOOR
STAMFORD, CONNECTICUT 06903

Mr. Valentino Campagnolo

Page 3

(3) ~~CAMPAGNOLO~~ agrees not to use or seek registration for any other marks which utilize the "BORA" or "BORO" formative.

(4) Based upon the differences between the marks as mentioned herein, and Campagnolo's stated intention not to expand its use of the "BORA" or "BORO" formative, the parties believe that there will not be a likelihood of confusion, mistake or deception.

(5) Under these circumstances DENBY hereby consents to the use and registration by Campagnolo of the mark "BORA" on or in connection with the goods set forth in paragraph 2 herein.

(6) Should the need arise, the parties hereto will cooperate to take the necessary steps to prevent the possibility of consumer confusion arising in the future including the proper re-direction of the few customers who may be confused between the parties hereto.

DENBY INTERNATIONAL CORPORATION

By: Sam A. Mantua

Title: CEO & President

Date: 12 Feb 2000

300 FIRST STAMFORD PLACE - 5TH FLOOR
STAMFORD, CONNECTICUT 06902

Mr Valentino Campagnolo

Page 4

Accepted and acknowledged on the date hereinbelow stated.

CAMPAGNOLO S. P. A.

By: [Signature]

Title: President

Date: 18 April 2000

300 FIRST STAMFORD PLACE - 5TH FLOOR
STAMFORD, CONNECTICUT 06902

ATTACHMENT III