

12-20-2001

Docket No.:



101922624

Tab settings
To the Honorable Commissioner of Patent

Attached original documents or copy thereof.

1. Name of conveying party(ies):
Bruce A. Donoho



12.17.01

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

Name: **OMS Investments, Inc.**

Internal Address:

Street Address: **1105 North Market Street**

City: **Wilmington** State: **DE** ZIP: **19899**

Individual(s) citizenship

Association

General Partnership

Limited Partnership

Corporation-State **Delaware**

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

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

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

3. Nature of conveyance:
 Assignment Merger
 Security Agreement Change of Name
 Other **Assignment and License Agreement**

Execution Date: **December 7, 2001**

4. Application number(s) or registration numbers(s):
A. Trademark Application No.(s)
75/680,795
Additional numbers Yes No

B. Trademark Registration No.(s)

5. Name and address of party to whom correspondence concerning document should be mailed:
Name: **Cory M. Amron, Esquire**
Internal Address: **Vorys Sater Seymour and Pease LLP**
Street Address: **1828 L Street, N.W.**
11th Floor
City: **Washington** State: **DC** ZIP: **20036**

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:
22-0585

12/19/2001 TDIAZ1 00000196 75680795
01 FC:481 40.00 OP

DO NOT USE THIS SPACE

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.

Cory M. Amron
Name of Person Signing

Cory Amron
Signature

December 17, 2001
Date

Total number of pages including cover sheet, attachments, and

10

ASSIGNMENT AND LICENSE AGREEMENT

WHEREAS, Bird-B-Gone, Inc., a California corporation with an address of 24362 Via Madrugada, Mission Viejo, California 92692 (“BBG”), is using in commerce in the United States the trademarks BIRD-B-GONE (the “Word Mark”) and BIRD-B-GONE and Design (the “Design Mark”; collectively, the “Marks”) and has applied to register the Design Mark before the United States Patent and Trademark Office (“PTO”) in connection with spiked barriers for bird control in International Class 6, serial number 76/255,846 (the “’846 Application”):

WHEREAS, BBG’s president, Bruce A. Donoho, has applied in his own name but on BBG’s behalf to register the Word Mark in connection with pest repellent devices, namely, a metal architectural barrier for preventing birds from landing and perching in International Class 6, and a non-metal architectural barrier for preventing birds from landing and perching in International Class 19, serial number 75/680,795 (the “’795 Application”);

WHEREAS, BBG has made sales of goods associated with the Marks from the United States into a number of foreign jurisdictions, including, but not limited to, Canada and Mexico, which activity may or may not have given rise to trademark rights held by BBG and/or Mr. Donoho in such jurisdictions (the “Foreign Rights”);

WHEREAS, OMS Investments, Inc. ("OMS"), a Delaware corporation having a principal place of business at 1105 North Market Street, Wilmington, Delaware 19899, is the owner of numerous trademarks including the term "B-GON" in the field of pesticides and herbicides, including, but not limited to, United States trademark registrations No. 1,261,432 for FLEA-B-GON; No. 1,301,169 for BRUSH-B-GON; No. 1,995,777 for GRASS-B-GON; No. 2,073,033 for BUG-B-GON; No. 2,074,449 for WEED-B-GON EXTRA GREEN; and 2,236,054 for GRUB-B-GON;

WHEREAS, OMS has filed a Notice of Opposition to the '795 Application (the '846 Application not having yet been published) based on, inter alia, an asserted likelihood of confusion with its "B-GON" family of marks described above;

WHEREAS, OMS is desirous of acquiring BBG's and Donoho's interest in the Marks and then licensing said Marks to BBG for BBG's continued use in the field of bird repellent devices; and BBG and Donoho desire to assign to OMS whatever rights each of them has in each of the Marks and desire for BBG to receive said license.

NOW, THEREFORE, in consideration of the mutual covenants and obligations herein assumed, the parties hereto, willing and intending to be legally bound, hereby agree as follows:

1. **Assignment of Mark.**

a. Donoho hereby assigns whatever right, title and interest he may have in the Marks and all goodwill associated therewith, including, without limitation, the '795 Application and whatever Foreign Rights he may have acquired, to OMS, together with any and all common law rights appurtenant thereto, including, without limitation, the right to sue for past infringement, if any, of said Marks. Donoho shall, upon the request and at the expense of OMS, perform any acts reasonably necessary as requested by OMS to establish and maintain the rights of OMS in and to said Marks and the '795 Application, including, without limitation, assisting OMS in recording the instant assignment in the PTO.

b. BBG hereby assigns whatever right, title and interest it may have in the Marks, and all goodwill associated therewith, including, without limitation, the '846 Application and whatever Foreign Rights it may have acquired, to OMS, together with any and all common law rights appurtenant thereto, including, without limitation, the right to sue for past infringement, if any, of said Marks. BBG shall, upon the request and at the expense of OMS, perform any acts reasonably necessary as requested by OMS to establish and maintain the rights of OMS in and to said Marks and the '846 Application, including, without limitation, assisting OMS in recording the instant assignment in the PTO.

2. **License Grant.** OMS hereby grants to BBG an exclusive, royalty-free license to use the Marks throughout the United States (the "Territory") in connection with

the sale, distribution and advertising of physical and electronic bird barrier devices that are not in any way related to pesticides, herbicides, fertilizers or other chemical lawn and garden products (the "Licensed Goods"). OMS also grants to BBG an exclusive, royalty-free license to use the Marks outside the United States to the extent of the Foreign Rights it has obtained from BBG and Donoho (the "Foreign License Rights"). All such use of the Marks by BBG pursuant to this license, including any Foreign Rights that may be developed in the future, shall inure to the benefit of OMS. Under no circumstances shall the Foreign License Rights from OMS to BBG be construed to be greater in scope than the Foreign Rights OMS owns, whether obtained from BBG pursuant to the assignment in section 1, supra, or inuring to OMS' benefit through BBG's use thereof.

3. **Term.** The license granted hereunder shall be perpetual, so long as BBG continues to sell, distribute and advertise the Licensed Goods in the Territory in connection with the Marks. Should BBG cease to make such use of both of the Marks in the Territory for a period of six (6) consecutive months, the license granted hereunder shall terminate.

4. **No Sublicense Rights.** BBG shall not be entitled to grant any sub-license of its rights granted hereunder; provided, however, that if BBG is not the manufacturer of the Licensed Goods, it may utilize a third-party manufacturer in connection with the manufacture and production of the Licensed Goods, but BBG shall remain primarily responsible under this Agreement, and BBG shall not permit any such third-party

manufacturer to sell or distribute the Licensed Goods except directly to or on behalf of BBG.

5. **Formalization of Foreign Rights.** In the event that BBG desires to formalize its use of the Marks in jurisdictions outside of the United States, it shall notify OMS, which shall, at BBG's expense, use its best efforts to obtain registration of the Marks in such jurisdictions. Any such registration will be licensed to BBG in accordance with the terms set forth in section 2 hereunder; provided, however, that the indemnity provided from OMS on behalf of BBG in paragraph 7(b) of this Agreement shall not apply with respect to any use whatsoever by BBG of the Marks outside the United States.

6. **Quality Control.** OMS shall have the right reasonably to control the nature and quality of the Licensed Products associated with the Marks, as well as the packaging, displays, and promotional and marketing materials associated therewith (collectively, the "Related Items"). OMS approves all Licensed Products and Related Items currently sold or distributed by BBG, as shown in the attached Exhibit A. Further pursuant to this right, BBG shall provide to OMS for approval one (1) sample of any commercially significant modification to any current Licensed Product, as well as one (1) sample of any new Licensed Product proposed to be sold by BBG, and any new Related Items proposed to be distributed by BBG. Such approval by OMS shall not be unreasonably withheld. Any proposed Licensed Product or Related Item not disapproved by OMS within fourteen (14) days of its receipt by OMS shall be deemed approved.

OMS further shall have the right, at its own expense and no more than once in any calendar year, to enter and inspect the premises where the Licensed Products are made.

7. **Indemnification.**

a. BBG hereby indemnifies OMS, its affiliated companies, and their respective officers, directors, agents and employees, and shall hold them harmless from any and all liability, damages, judgments, and costs (including reasonable attorney's fees) arising from the activities of BBG, including, without limitation, any claims of negligence, strict liability, product liability, patent infringement, or breach of warranty arising from the sale of the Licensed Products.

b. OMS hereby indemnifies BBG, and its officers, directors, agents and employees, and shall hold them harmless from any and all liability, damages, judgments, and costs (including reasonable attorney's fees) arising from any claim that BBG's use of the Marks in the United States pursuant to the terms of the License infringes the valid trademark rights of any third party.

8. **Assignability.** This Agreement is freely assignable by OMS but may not be assigned by BBG other than to a successor of the entirety of BBG's business. Any such assignment by BBG is subject to the approval of OMS, which shall not be unreasonably withheld.

9. **Breach, Cure and Termination.** In the event that any party deems the other party to be in breach of any provision of this Agreement, that party shall give written notice to the other, following the receipt of which the breaching party shall have ten (10) business days to cure the breach. If the breach is material and is not cured by the other party, then the party shall have the right to terminate the Agreement by thirty (30) days advance written notice to the other party.

10. **Notices.** Any notices by either party to the other shall be given to the following respective addresses:

To OMS:

Ms. Susan T. Dubb
OMS Investments, Inc.
1105 N. Market Street
Wilmington, DE 19899

To BBG:

Mr. Bruce A. Donoho
Bird-B-Gone, Inc.
24362 Via Madrugada
Mission Viejo, CA 92692

11. **Miscellaneous.**

a. This agreement shall be governed by and interpreted in accordance with the laws of the State of Ohio applicable to agreements wholly made and performed within the State of Ohio. Any controversy or claim arising out of or relating to this

agreement shall be brought in the state or federal courts of Franklin County, Ohio, in which BBG consents to jurisdiction.

b. This Agreement shall not create or be deemed to create any agency, partnership or joint venture between the parties. The Agreement shall be binding upon and enforceable against each of the parties hereto and their respective administrators, executors, successors and permitted assigns.

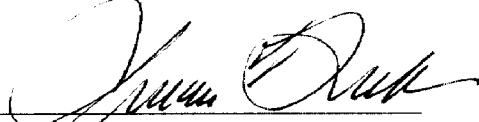
c. This Agreement is intended by the parties as a final and complete expression of their agreement and supersedes any and all prior and contemporaneous agreements and understandings relating thereto. This Agreement may not be modified except in writing signed by both parties. This Agreement may be executed in two or more counterparts, each of which shall be deemed an original but all of which together shall constitute one and the same instrument.

d. The failure of either party to enforce, or the delay by either party in enforcing, any of that party's rights under this Agreement shall not be deemed a waiver of such rights.

e. If any part of this Agreement shall be declared invalid, void or unenforceable by a court of competent jurisdiction, it shall not affect the validity of the rest of this Agreement.

AGREED AND ACCEPTED:

OMS INVESTMENTS, INC.

By: 
Susan T. Dubb
Assistant Secretary

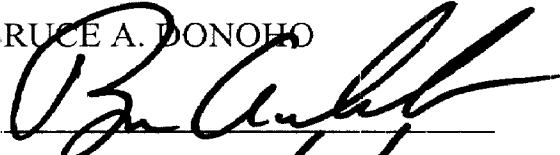
Dated: December 13, 2001

BIRD-B-GONE, INC.

By: 
Bruce A. Donoho
President

Dated: 12/7/01

BRUCE A. DONOHO


Dated: 12/7/01