

01-18-2002



COVER SHEET  
(S ONLY)

U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Atty Docket No. M8540/164112

101952817

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

1. Name of conveying party(ies):

**E/M Corporation**

- ☐ Individuals(s) ☐ Association  
☐ General Partnership ☐ Limited Partnership  
☒ Corporation-State **Delaware**  
☐ Other \_\_\_\_\_

Additional names(s) of conveying party(ies) attached ☐ Yes ☒ No

3. Nature of conveyance:

- ☒ Assignment & relevant excerpts  
☐ Merger  
☐ Security Agreement ☐ Change of Name  
☐ Other \_\_\_\_\_

Execution Date: **November 12, 1996**

2. Name and address of receiving party(ies)

Name: **The Morgan Crucible Company plc**

Internal Address: **Madeira Walk, Windsor**

Street Address: **Berkshire SL4 1EP**

City: **England**

State: **7in**

- ☐ Individual(s) citizenship \_\_\_\_\_  
☐ Association \_\_\_\_\_  
☐ General Partnership \_\_\_\_\_  
☐ Limited Partnership \_\_\_\_\_  
☐ Corporation-State \_\_\_\_\_  
☒ Other **Company - England & Wales**

If assignee is not domiciled in the United States, a domestic representative designation is attached: ☒ Yes ☐ No

Additional names(s) & address(es) attached? ☐ Yes ☐ No

4. Application numbers(s) or patent numbers(s):

A. Trademark Application No.(s)

B. Trademark Registration No.(s)

**Reg. No. 2, 215,695 Mark: ANN-RO**

Additional numbers attached? ☐ Yes ☒ No

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

Name: **William H. Brewster**

Internal Address: **Kilpatrick Stockton LLP**

Street Address: **1100 Peachtree Street, Suite 2800**

City: **Atlanta** State: **GA** Zip: **30102**

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

The Commissioner is authorized to charge any deficiency in the required fee or credit any over payment to Deposit Account No. 11-0860.

8. Deposit account number:

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.

**Christine P. James**

Name of Person Signing

Signature

Date

Total number of pages including cover sheet, attachments, and document: **0**

01/17/2002 DBTRM 00000205 2215695

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40.00 DP

TRADEMARK  
REEL: 002427 FRAME: 0175

# INTELLECTUAL PROPERTY AGREEMENT

by and between

THE MORGAN CRUCIBLE COMPANY plc

and

E/M CORPORATION

Dated as of November 12, 1996

## INTELLECTUAL PROPERTY AGREEMENT

This INTELLECTUAL PROPERTY AGREEMENT is made as of November 12, 1996 (herein, together with the Exhibits and Schedules attached hereto, referred to as the "Agreement") by and between THE MORGAN CRUCIBLE COMPANY plc, a company incorporated in England and Wales ("Buyer") with its principal place of business in Windsor, Berkshire, UK, and E/M CORPORATION, a Delaware corporation with its principal place of business in West Lafayette, Indiana, USA ("E/M").

### WITNESSETH:

WHEREAS, E/M has on this same date entered into an Asset Purchase Agreement ("Asset Purchase Agreement") with MCP Acquisition Corporation, a Delaware corporation which is a subsidiary of Buyer, pursuant to which E/M agreed to sell and MCP Acquisition Corporation agreed to buy all of the assets of E/M used in the specialty grease and oil manufacturing business and the dry film lubricant and specialty coatings manufacturing and applications business (the "Business") other than the Intellectual Property sold to Buyer under this Agreement; and

WHEREAS, Buyer and E/M are entering into this Agreement in conjunction with and in reliance upon the various commitments and undertakings in the Asset Purchase Agreement as well as in this Agreement;

NOW THEREFORE, in consideration of the following representations, warranties, covenants and agreements, and in reliance on the execution and performance of the commitments and provisions of the Asset Purchase Agreement, the parties hereto agree as follows:

### ARTICLE I

#### SALE AND TRANSFER OF THE INTELLECTUAL PROPERTY

Subject to the terms and conditions of this Agreement, and in consideration of the purchase by Buyer described herein, E/M hereby agrees to sell, convey, transfer, assign and deliver to Buyer at the Closing all of the Intellectual Property (as hereinafter defined) owned by E/M and used or held for use or sale by E/M in conducting or otherwise in connection with the Business, including, but not limited to:

SECTION 1.1 Patents. All patents and patent applications held or used by E/M relating to or used in the Business, whether in the United States or any other jurisdiction, and all reissues, divisions, continuations, continuations-in-part, extensions, and renewals thereof and all income, royalties, rights to sue for past infringement and any damages and payments due or payable in connection therewith to E/M prior to Closing (all of the foregoing patents, patent applications and rights under or related thereto are sometimes hereinafter individually and collectively referred to as the "Patent Rights"), including those set forth on Schedule 1.1 hereto;

**SECTION 1.2 Trademarks and Copyrights.** All trademarks, service marks, trademark registrations, service mark registrations, applications for trademark registrations, applications for service mark registration, trade names, brand names, product names and common law marks held or used by E/M relating to or used in the Business, including the name "E/M," and all copyrights and copyright applications held or used by E/M related to or used in the Business, whether in the United States or any other jurisdiction, and the renewals thereof, and all income, royalties, rights to sue for past infringement and any damages and payments due or payable in connection therewith to E/M prior to Closing (all of the foregoing trademarks, trademark registrations, trademark applications, service marks, service mark registrations, service mark applications, trade names, brand names, product names, common law marks and rights under or related thereto are sometimes hereinafter individually and collectively referred to as the "Trademark Rights." and all of the foregoing copyrights, copyright applications and rights under or related thereto are sometimes hereinafter individually and collectively referred to as the "Copyrights"), including those set forth on Schedule 1.2 hereto; and

**SECTION 1.3 Other Intellectual Property.** All other intellectual property rights held or used by E/M relating to or used in the Business, including trade secrets, product formulations and know-how, including, without limitation, the trade secrets, product formulations and know-how relating to the Business or held or used by E/M in conducting the Business, including those set forth on Schedule 1.3.

The Patent Rights, Trademark Rights, Copyrights and the aforesaid intellectual property rights referenced in Section 1.3 are referred to herein collectively as the "Intellectual Property."

## ARTICLE II

### PURCHASE PRICE AND PAYMENT

**SECTION 2.1 Purchase Price.** Buyer agrees to pay to E/M \$\_\_\_\_\_ for the Intellectual Property, payable at the Closing in immediately available funds by wire transfer to an account designated by E/M.

**SECTION 2.2 No Additional Consideration.** E/M hereby acknowledges that any consideration specified in any individual assignments delivered pursuant to Article III below is part of and not in addition to the Purchase Price.

## ARTICLE III

### INSTRUMENTS OF CONVEYANCE, ASSIGNMENT, TRANSFER, ETC.

The sale, conveyance, assignment, transfer and delivery of the Intellectual Property shall be effected by E/M's delivery to Buyer of (i) an Assignment of Patent Rights substantially in

the form of Exhibit A hereto, (ii) an Assignment of Trademark Rights substantially in the form of Exhibit B hereto, and (iii) such other good and sufficient instruments of sale, conveyance, transfer, assignment and consent as Buyer may reasonably request to vest in Buyer all of E/M's right, title and interest as herein warranted in and to the Intellectual Property. E/M shall also take such additional action, including the execution of further documents, as may be reasonably requested by Buyer to effectuate the intent of the Assignment of Patent Rights and the Assignment of Trademark Rights to vest in Buyer the entire right, title and interest of E/M in and to the Patent Rights and the Trademark Rights. Notwithstanding anything to the contrary herein stated or otherwise implied, no Intellectual Property shall be transferred or assigned to Buyer by E/M at the Closing if such transfer or assignment would, without the prior consent or approval of another person which has not been obtained, be ineffective or constitute a breach of any agreement, obligation or instrument relating to the Intellectual Property in question with the effect being that Buyer would not in fact receive good and marketable title to the Intellectual Property. In such event and at the request of Buyer, E/M agrees that the beneficial interest in and to such Intellectual Property shall nonetheless pass to Buyer at the Closing and further, E/M shall (i) hold such Intellectual Property for the benefit of Buyer, its successors and permitted assigns from and after the Closing, (ii) use all reasonable efforts (not including the payment of any funds) to obtain and secure any and all consents and approvals that may be necessary to effect a valid and complete transfer of such Intellectual Property as soon as reasonably possible, and (iii) cooperate with Buyer in any other reasonable arrangement designed to provide Buyer with the beneficial enjoyment of such Intellectual Property.

#### ARTICLE IV

##### CLOSING

Subject to the provisions of Article VII, the Closing of the transactions provided for herein will take place when and where the Closing of the Asset Purchase Agreement takes place.

#### ARTICLE V

##### E/M'S REPRESENTATIONS AND WARRANTIES

E/M represents and warrants to Buyer the following:

**SECTION 5.1 Corporate Status and Good Standing.** E/M is a corporation duly organized, validly existing and in good standing under the laws of Delaware with full corporate power and authority under its articles of incorporation and by-laws to own and lease its properties and to conduct business, including the Business.

**SECTION 5.2 Authorization.** E/M has full corporate power and authority under its articles of incorporation and by-laws, and its Board of Directors has taken all necessary action to authorize E/M, to execute and deliver this Agreement including the exhibits and schedules hereto (collectively, the "Documents"), to consummate the transactions contemplated by the Documents

IN WITNESS WHEREOF, the parties hereto have duly executed this Agreement as of the date first above written.

THE MORGAN CRUCIBLE COMPANY plc

By: P. D. Wilkins  
Peter D. Wilkins  
Director of Legal Affairs

E/M CORPORATION

By: Lowell C. Horwedel  
Lowell C. Horwedel  
President

Exhibit B

ASSIGNMENT OF TRADEMARK RIGHTS

Express reference is made to that certain Intellectual Property Agreement, dated as of November 12, 1996 (the "Intellectual Property Agreement"), made and entered into by and between THE MORGAN CRUCIBLE COMPANY plc, a United Kingdom corporation ("Buyer"), and E/M CORPORATION, a Delaware corporation ("E/M"). Other than terms specifically defined or otherwise designated in this Assignment of Trademark Rights, capitalized terms used herein shall refer to the same terms defined in or referred to in the Intellectual Property Agreement and, more generally, this Assignment of Trademark Rights shall in all respects be governed and limited by and construed in conformity with the Intellectual Property Agreement.

KNOW ALL PERSONS BY THESE PRESENTS that E/M for good and valuable consideration received as provided in the Intellectual Property Agreement, does hereby grant, sell, convey, assign, set over and transfer to Buyer, its successors and assigns (collectively, "Buyer"), to have and to hold forever, all of E/M's right, title and interest in and to the Trademark Rights, together with the goodwill of the business symbolized by and associated with the Trademark Rights included within the Intellectual Property.

E/M hereby irrevocably constitutes and appoints Buyer its true and lawful attorney-in-fact with full power of substitution and in the name and stead of E/M, as the case may be, but on behalf and for the benefit of Buyer, to (a) demand and receive from time to time any and all of the Trademark Rights, (b) give receipts, releases and acquittances for and in respect of the Trademark Rights or any part thereof, (c) collect for the account of Buyer all Trademark Rights, (d) from time to time to institute and prosecute in the name of E/M or otherwise, but at the expense and for the benefit and liability of Buyer, any and all proceedings at law, in equity or otherwise which Buyer may deem proper in order to collect, reduce to possession, assert or enforce any claim, right, title or interest of any kind in or to the Trademark Rights, and (e) defend or compromise any and all actions, suits or proceedings in respect of any of the Trademark Rights. E/M hereby declares that the appointment made and the powers hereby granted are coupled with an interest and are and shall not be revocable in any manner or for any reason by E/M, its successors or assigns.

This instrument is intended to be binding upon and inure to the benefit of E/M and Buyer, respectively, and, consequently, shall be so construed.

IN WITNESS WHEREOF, E/M has caused this Assignment of Trademark Rights to be executed by its duly authorized representative and its corporate seal hereunto affixed this twelfth day of November, 1996.

E/M CORPORATION

By: Lowell C. Horwedel  
Lowell C. Horwedel  
President

November 12, 1996

Then personally appeared the above-named Lowell C. Horwedel, as President of E/M CORPORATION, and acknowledged the foregoing instrument to be the free act and deed of E/M CORPORATION.

Before me,

Sue Ann McGe  
Notary Public  
My Commission expires: June 19, 2000



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
POST REGISTRATION SECTION**

REGISTERED OWNER: E/M Corporation  
SUCCESSOR OWNER: The Morgan Crucible Company plc  
REGISTRATION NO.: 2,215,695  
MARK: ANN-RO  
CLASS: International Classes 2 and 3  
REGISTRATION DATE: January 5, 1999



01-10-2002  
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #66

**REQUEST FOR RECORDAL OF CORRECTION OF  
CURRENT OWNER IN CHAIN OF TITLE**

The Morgan Crucible Company plc (“Morgan Crucible”), the successor owner to the above mark, hereby requests that the recorded chain of title of that mark be amended to reflect that Morgan Crucible, and not E/M Corporation (“E/M”), is the current owner of the mark ANN-RO.


In 1996, the mark ANN-RO was the subject of an assignment from E/M to Morgan Crucible, by virtue of an Intellectual Property Agreement. The Intellectual Property Agreement and its schedule of marks were recorded at Reel/Frame 1677/0651 (with corrections recorded at Reel/Frame 1714/0704). The schedule inadvertently omitted the then-pending application, Serial No. 75/171,970, for the mark ANN-RO, which subsequently matured into United States Registration No. 2,215,695. The omission of this mark from the schedule was an oversight. As a result, the register incorrectly lists E/M as the current owner of the mark ANN-RO. The original E/M Corporation has been dissolved and consequently cannot provide a further assignment to remedy the original error in assignment.

JA

It is clear from the language of the recorded Intellectual Property Agreement that the ANN-RO mark was conveyed to Morgan Crucible as part of "all of the Intellectual Property owned by E/M and used or held for use or sale by E/M", with "Trademarks" being defined broadly as: "[a]ll trademarks, service marks, trademark registrations, service mark registration [sic], applications for trademark registrations, applications for service mark registrations, trade names, brand names, product names and common law marks held or used by E/M/ relating to or used in the Business, including the name "E/M"... (emphasis added). The relevant pages of the recorded Intellectual Property Agreement are annexed hereto for reference.

Morgan Crucible, the current owner of the mark ANN-RO, respectfully requests that the United States Patent and Trademark Office Post Registration Section amend the record to reflect the transfer of ownership of that mark and record The Morgan Crucible Company plc as the owner of all right, title and interest in and to the mark ANN-RO, U.S. Registration No. 2,215,695. Enclosed are a cover sheet and a recordal fee in the amount of forty dollars (\$40) pursuant to 37 C.F.R. §§ 2.6(b)(6), 3.41. A designation of domestic representative will follow under separate cover.

Respectfully Submitted,

  
Virginia S. Taylor, Esq.  
Christine P. James, Esq.

Attorneys for The Morgan Crucible Company plc

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