

08-29-2002

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Form PTO-1594

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U.S. DEPARTMENT OF COMMERCE

(Rev. 03/01)

U.S. Patent and Trademark Office

OMB No. 0651-0027 (exp. 5/31/2002)

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

1. Name of conveying party(ies): Cequadrat GmbH

Individual(s) Association
 General Partnership Limited Partnership
 Corporation - State (Germany) *8/26/02*
 Other

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

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

Name: Roxio, Inc.
Internal
Address:
Street Address: 455 El Camino Real
City: Santa Clara State: CA Zip: 95050

Individual(s) citizenship
 Association
 General Partnership
 Limited Partnership
 Corporation - State (Delaware)
 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) and address(es) attached? Yes No

3. Nature of conveyance:

Assignment Merger
 Security Agreement Change of Name
 Other

Execution Date: May 5, 2001

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

A. Trademark Application No.(s)

Additional number(s) attached Yes No

B. Trademark Registration No.(s):

1957675

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

Name: Allyn Taylor, Esq.
Internal Address: _____
Street Address: 400 Hamilton Avenue
City: Palo Alto State: CA Zip: 95050

6. Total number of applications and registrations involved: 1

7. Total Fee (37 CFR 3.4i) \$40

Enclosed
 Authorized to be charged to deposit account

8. Deposit Account Number: 07-1907 ✓

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

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 if a true copy of the original document.

Heather A. Dunn *[Signature]* 8/20/02
Name of Person Signing Signature Date

Total number of pages including cover sheet, attachments and document: 4

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents and Trademarks, Box Assignments

08/28/2002 LMUELLER 00000190 071907 1957675

Washington, D.C. 20231

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TRADEMARK
REEL: 002571 FRAME: 0174

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DECLARATION OF EXCUSABLE NONUSE
UNDER SECTION 8
TRADEMARK: CORPORATION

Mark: **CEQUADRAT**
Registrant: **Roxio, Inc.**
Registration No.: **1,957,675**
Registration Date: **February 20, 1996**
Class: **9**

I, William Growney, declare that I am Secretary of Roxio, Inc., a Delaware corporation, and am authorized to make this declaration on behalf of said corporation, that said corporation is the owner of the above-identified registration; and that said mark is not currently in use in commerce on or in connection with the identified goods, namely, computer programs for interfacing personal computers with CD-ROM recorders, but said corporation expects to resume use, and the nonuse is due to special circumstances, as follows:

Registrant's predecessor in interest began using the mark in U.S. commerce at least as early as September 9, 1994. The mark was used continuously on or in connection with the goods by Applicant or Applicant's predecessor in interest until November of 2001. Thus, the last date of use was in November of 2001.

In July of 1999, Adaptec, Inc. acquired Cequadrat GmbH the owner of the mark at the time; in September of 2000 Registrant was incorporated to develop and offer for sale digital media software, such as that covered by the registration; and in May of 2001, Cequadrat GmbH became a wholly owned subsidiary of Registrant and the mark and registration were assigned to Registrant. Registrant's present non-use for the mark results from a phase-out of the former products offered under the mark as a result of the multiple corporate changes and associated changes in trademark ownership, as described above, and a short period of development of the new product or products to be offered under the mark, also associated with the multiple corporate changes and associated changes in corporate ownership. Registrant is now and has been since July 8, 2002 taking steps to resume use of the mark. Specifically, Registrant is and has been since July 8, 2002 developing its new product to be offered under the mark. The new product is presently in production. The new product is expected to be launched to the public in interstate commerce in October of 2002. Thus, the period of actual non-use of the mark will be very short, specifically, eleven months.

I declare further that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true and that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this document and the registration to which it relates.

Applicant hereby appoints the following attorneys of the law firm of Gray Cary Ware & Freidenrich:

Allyn Taylor, Esq., Mark F. Radcliffe, Esq., Stacy A. Snowman, Esq., Françoise Gilbert, Esq., Margaret M. Powers, Esq., Michelle R. Harbottle, Esq., Eliane Setton, Esq., Heather Dunn, Esq., Farah Bhatti, Esq., David Dolkas, Esq. and Andrew P. Valentine, Esq. to prosecute this application to register, to transact all business in the Patent and Trademark Office in connection therewith, and to receive the Certificate of Registration.

All correspondence concerning this registration should be sent to:

Allyn Taylor, Esq.
GRAY CARY WARE & FREIDENRICH LLP
400 Hamilton Avenue
Palo Alto, CA 94301-1833
(650) 833-2170
ataylor@graycary.com

Signed at Santa Clara, CA, this 20th day of August, 2002.

Roxio, Inc.

By: [Signature]
William Growney
Secretary

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail on 8/20/02, in an envelope addressed to:

Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Signed: [Signature]

Printed Name: Victoria Irene Perry

Allyn Taylor, Esq.
GRAY CARY WARE & FREIDENRICH
400 Hamilton Avenue
Palo Alto, CA 94301-1833
(650) 833-2170

TRADEMARK ASSIGNMENT AND LICENSE BACK AGREEMENT

This Trademark Assignment and License Back Agreement ("Agreement") is entered into on this 5th day of May, 2001 (the "Effective Date"), by and between Roxio GmbH & Co. KG, a German corporation with offices located at Jens-Otto-Krag-Str. 11 D-52146 Würselen, Germany ("Roxio KG"), and Roxio, Inc., a Delaware corporation with offices located at 461 South Milpitas Road Milpitas, California ("Roxio").

WHEREAS, Roxio KG, is the owner of certain U.S. and foreign trademarks identified in Exhibit A, attached hereto (the "Trademarks") and made a part of the Agreement;

WHEREAS, Roxio KG is an indirect wholly-owned subsidiary of Roxio;

WHEREAS, Roxio KG agrees to assign all right, title and interest in the Trademarks to Roxio;

WHEREAS, Roxio KG desires to obtain a license to use the Trademarks in connection with the type of products and services with which it presently uses the Trademarks; and

WHEREAS, Roxio agrees to grant, and Roxio KG desires to accept, a license to use the Trademarks as set forth below.

NOW, THEREFORE, in exchange for good and valuable consideration, the sufficiency and receipt of which is hereby acknowledged, the parties agree as follows:

I. ASSIGNMENT

A. Assignment. Roxio KG hereby assigns to Roxio all right, title and interest in and to the Trademarks throughout the world together with the common law rights and goodwill of the business symbolized by the Trademarks and together with the right to recover for damages and profits from past infringements thereof, if any. Roxio KG further agrees to execute the agreement attached hereto as Exhibit B ("Recording Agreement") and made a part of this Agreement for submission to the U.S. and German Patent and Trademark Offices so as to record this assignment of the Trademarks. The parties acknowledge that the terms of this Agreement and the terms of the Recording Agreement are consistent.

B. Power of Attorney. Roxio KG hereby constitutes and appoints Roxio as Roxio KG's true and lawful attorney in fact, with full power of substitution in Roxio KG's name and stead, to take any and all steps, including proceedings at law, in equity or otherwise, to execute, acknowledge and deliver any and all instruments and assurances necessary or expedient in order to vest or perfect the aforesaid rights and causes of action more effectively in Roxio or to protect the same or to enforce any claim or right of any kind with respect thereto. This includes, but is not limited to, any rights with respect to the Trademarks that may have accrued in Roxio KG's favor from the respective date of first use or filing of any of the Trademarks to the Effective Date of this Assignment. Roxio KG hereby declares that the foregoing power is coupled with an interest and as such is irrevocable.

C. Warranty. Roxio KG makes no warranties with respect to the Trademarks, and assigns the Trademarks "As Is."

II. LICENSE BACK

A. Grant. Subject to the terms of this Agreement, Roxio grants to Roxio KG a non-exclusive, royalty-free, perpetual, worldwide, non-transferable license to use the Trademarks on products and in connection with services that are the same or substantially similar to those with which Roxio KG presently uses the Trademarks and/or has used the Trademarks in the past, and to use ROXIO KG as its corporate name and trade name (the "License"). This License does not include the right to sublicense the use of the Trademarks.

B. Formalities. In order to comply with the requirements under certain foreign trademark laws, Roxio may need to know if the products are being sold in a particular country or countries and other information regarding such use. Roxio KG shall supply such information upon Roxio's request. Roxio KG shall assist Roxio in complying with the formalities of local law, including but not limited to, the execution of any application for registration as a registered user, the execution of additional license agreements suitable for recording with appropriate authorities, or providing proof of use of the Trademarks or any other applicable documents. Roxio KG shall pay the expense of complying with such formalities.

C. Quality Standards. Roxio acknowledges that the current level of quality of Roxio KG's goods and services meets its minimum standards and Roxio KG agrees to maintain such quality level to at least this minimum amount for the duration of the Agreement. Roxio may, from time-to-time, request in writing specimens of Roxio KG's goods and services that bear the Trademarks (the "Goods and Services") and Roxio KG's materials relating to its services that bear the Trademarks to assess the level of consistency and quality of use of the Trademarks on and in connection with the Goods and Services and to ensure that Roxio KG maintains the consistency and quality of said Goods and Services throughout the term of the Agreement. Roxio KG shall provide such specimens at no cost to Roxio. If at any time, Roxio reasonably determines that the Goods and Services bearing the Trademarks fail to materially conform to Roxio's minimum standards Roxio shall so notify Roxio KG in writing and Roxio KG shall correct the non-conformance and provide a corrected specimen of the Goods and/or Services to Roxio for review within thirty (30) days from the written notice from Roxio regarding such non-conformance.

D. Suspected Infringement. Roxio KG agrees to notify Roxio, in writing, of any suspected infringement of the Trademarks in any jurisdiction of which Roxio KG becomes aware. Roxio KG agrees to notify Roxio of any claims made against it, adverse to or conflicting with Roxio's exclusive ownership of the Trademarks.

E. Termination for Material Breach. Roxio may terminate this license upon ninety (90) days prior written notice to Roxio KG, without need of judicial notice or court action, for a material breach of this Agreement, unless the breach is corrected to Roxio's reasonable satisfaction within the ninety (90) day period.

1. Material Breach Defined. Material breaches shall include, but not be limited to:

1.1 Roxio KG's use of the Trademarks on products or marketing materials inconsistent with the License granted under this Agreement, or otherwise contrary to the provisions of such license;

- 1.2 Roxio KG's challenge to Roxio's ownership of the Trademarks or the validity of the Trademarks.
2. Effect of Termination. Upon termination of this Agreement, Roxio KG shall immediately cease use of the Trademarks, either alone or in combination with another term, and shall cease distribution or offering of any goods and services using the Trademarks. The obligations set forth in Paragraph II F (Trademark Ownership) shall survive the termination of this Agreement.
- F. Trademark Ownership.
1. License Acknowledgement. Roxio KG acknowledges that as of the Effective Date of this Agreement, Roxio is the sole and exclusive owner of the Trademarks. Except as required by law, Roxio KG agrees that it will do nothing inconsistent with such ownership either during the term of the Agreement or afterwards. Specifically, Roxio KG shall supply best efforts to use the Trademarks in a manner that does not deviate from Roxio's rights in the Trademarks and will take no action that will interfere with or diminish Roxio's right in the Trademarks. Roxio KG agrees that its use of the Trademarks shall inure to the benefit of and be on behalf of Roxio. Roxio KG acknowledges that the Trademarks are valid under the applicable law and that Roxio KG's utilization of the Trademarks will not create any right, title or interest in said Trademarks. Roxio KG shall use the Trademarks so that such trademark rights are a separate and distinct impression from any other trademark that may be used or affixed to the Goods, their associated documentation or marketing material. Except as permitted in this Agreement, Roxio KG agrees that it will not adopt or use as part or all of any corporate name, trade name, trademark, service mark or certification mark, the Trademarks, either alone or in combination with other words, or any other mark based on the Trademarks or any designation confusingly similar to the Trademarks.
2. Non-Assistance. Roxio KG agrees not to apply or assist any third party to register the Trademarks or a confusingly similar designation anywhere in the world. If any application for registration is or has been filed by or on behalf of Roxio KG in any country and relates to any Trademarks which, in the reasonable opinion of Roxio, is confusingly similar, deceptive or misleading with respect to, or dilutes or any way damages the Trademarks, Roxio KG shall, at Roxio's request, abandon all use of such Trademarks, and any registration or application for registration thereof and shall reimburse Roxio for all costs and expenses of any opposition or related legal proceeding, including attorneys' fees, instigated by Roxio or its authorized representative.

G. Miscellaneous.

1. Waiver. No waiver of any provision of this Agreement shall be deemed, or shall constitute, a waiver of any other provision, nor shall any waiver constitute a continuing waiver. No waiver shall be binding unless executed in writing by the party making the waiver.
2. Successors or Assigns. This Agreement shall be binding on, and shall inure to the benefit of the parties hereto and their respective heirs, legal representatives, successors and assigns. Roxio KG may not assign this Agreement without the prior written consent of Roxio in any case except as part of a corporate reorganization, consolidation, or merger, which consent shall not be unreasonably withheld.
3. Notices. All notices, requests, demands and other communications relating to this Agreement shall be in writing and shall be deemed to have been duly given on the date of service if served personally or by facsimile on the party to whom notice is to be given, or five (5) days after mailing if mailed to a party to whom notice is to be given, by first class mail, postage prepaid, and addressed as set forth above.
4. Severability. In the event that any provision of this Agreement shall be unenforceable or invalid under any applicable law or be so held by applicable court decision, such unenforceability or invalidity shall not render this Agreement unenforceable or invalid as a whole, and, in such event, such provision shall be changed and interpreted so as to best accomplish the objectives of such unenforceable or invalid provision without the limits of applicable law or applicable court decisions.
5. Governing Law. This Agreement shall be construed in accordance with, and governed by, the laws of the State of California applicable to contracts entered into by California residents and to be performed within such State.
6. Entire Agreement. This Agreement constitutes the entire agreement between the parties as to the subject matter hereof, and supersedes all prior and contemporaneous agreements, representations and understandings between them. This Agreement shall not be changed, modified, or amended except by a writing signed by both parties.
7. CONSEQUENTIAL DAMAGES WAIVER. ROXIO SHALL NOT BE LIABLE TO ROXIO KG FOR ANY INDIRECT, INCIDENTAL, OR CONSEQUENTIAL DAMAGES OR DAMAGES FROM LOST PROFITS OR LOST USE EVEN IF ROXIO HAS BEEN ADVISED OF THE POSSIBILITY OF SUCH DAMAGES.
8. Effective Date. This agreement shall be deemed effective only as of the date on which it has been fully executed by both parties. It shall remain an offer which may at any time be revoked and shall not be deemed effective unless and until both parties have executed this Agreement in full. It may be executed in any number of identical counterparts, each of

which shall be deemed an original, but all of which when taken together, shall constitute one and the same instrument.

IN WITNESS WHEREOF, the undersigned have affixed their signatures on the dates set forth below:

Roxio KG: [Signature]
Roxio GmbH & Co. KG

Roxio: _____
Roxio, Inc.

By: Harm Meyer, its Managing Director

By: Thomas J. Shea, its Senior Vice President and Chief Operating Officer

Date: May 5, 2001

Date: _____, 2001

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TO: [unclear]

WORKING COPY [unclear]

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which shall be deemed an original, but all of which when taken together, shall constitute one and the same instrument.

IN WITNESS HEREOF, the undersigned have affixed their signatures on the dates set forth below:

Roxio KG: _____

Roxio: *Thomas J. Shea*

Roxio GmbH & Co. KG

Roxio, Inc.

By: Harm Meyer, its Managing Director

By: Thomas J. Shea, its Senior Vice President and Chief Operating Officer

Date: _____, 2001

Date: May 5, 2001

OK LEGAL
WJG

EXHIBIT A**1.VIDEOPACK**

Status: Unpublished application (Pending)
Class: 9 16 42
Owner Name: CeQuadrat, Gesellschaft fur
Computer und Kommunikation mbH
Germany

2.WINONCD

Status: Registered
Class: 9 16 42
Owner Name: CeQuadrat, Gesellschaft fur
Computer und Kommunikation mbH
Germany

3.CEQUADRAT

Status: Registered
Class: 42
Owner Name: CeQuadrat, Gesellschaft fur
Computer und Kommunikation mbH
Germany

4.POWER EDITION

Status: Unpublished application (Pending)
Class: 9 16 42
Owner Name: CeQuadrat, Gesellschaft fur
Computer und Kommunikation mbH
Germany

5.C CEQUADRAT

Status: Registered

Class: 9 42

Owner Name: CeQuadrat, Gesellschaft fur
Computer und Kommunikation mbH
Germany

6.C-QUADRAT

Status: Registered

Class: 42

Owner Name: CeQuadrat, Gesellschaft fur
Computer und Kommunikation mbH
Germany

7.CEQUADRAT

Status: Enregistrement (Registered)

Class: 42

International Register

8.WINONCD

Status: Unpublished application (Pending)

Class: 9 16 35 36 38 39 42

Owner Name: Roxio GmbH & Co. KG
Germany

9.TOAST

Status: Unpublished application (Pending)

Class: 9 16 35 38 42

Owner Name: Roxio GmbH & Co. KG
Germany

10.EASY CD CREATOR

Status: Unpublished application (Pending)

Class: 9 16 35 38 42

Owner Name: Roxio GmbH & Co. KG
Germany

11.JAM

Status: Unpublished application (Pending)

Class: 9 16 35 38 42

Owner Name: Roxio GmbH & Co. KG
Germany

12.GOBACK

Status: Unpublished application (Pending)

Class: 9 16 35 38 42

Owner Name: Roxio GmbH & Co. KG
Germany

13.SOUNDSTREAM

Status: Unpublished application (Pending)

Class: 9 16 35 38 42

Owner Name: Roxio GmbH & Co. KG
Germany

14.ROXIO

Status: Unpublished application (Pending)

Class: 9 16 35 38 42

Owner Name: Roxio GmbH & Co. KG
Germany

15.ROXIO

Status: Unpublished Application (Pending)

Class: 9 16 35 38 42

Owner Name: Roxio GmbH & Co KG

Community Trademarks

16. CEQUADRAT

IC 009. US 021 023 026 036 038. G & S: computer programs for interfacing personal computers with CD-ROM recorders.

Registration Number 1957675