

07-30-2003

Docket No.:

4519-4

Tab settings

7-24-03



102510744

Send original documents or copy thereof.

1. Name of conveying party(ies):

Shane Jewelry Co.

- Individual(s)
- General Partnership
- Corporation-State **Michigan**
- Other

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

3. Nature of conveyance:

- Assignment
- Security Agreement
- Other
- Association
- Limited Partnership
- Corporation-State
- Change of Name

Execution Date: 08/01/2002

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

Name: **Midwestern Stone & Metal LLC**

Internal Address:

Street Address: **9200 E. Mineral Ave., Suite 200**

City: **Englewood** State: **CO** ZIP: **80112**

- Individual(s) citizenship
- Association
- General Partnership
- Limited Partnership
- Corporation-State
- Other **a Colorado Limited Liability Company**

If assignee is not domiciled in the United States, a domestic designation is

(Designations must be a separate document from Additional name(s) & address(es)  Yes  No

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

A. Trademark Application No.(s)

73/584436 (concurrent use: 74/004111)

Additional numbers

B. Trademark Registration No.(s)

1959461 (concurrent use: 1934523)

Yes  No

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

Name: **David J. Stephenson, Jr.**

Internal Address: **Fairfield and Woods, P.C.**

Street Address: **1700 Lincoln Street, Suite 2400**

City: **Denver** State: **CO** ZIP: **80203**

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:

501642

07/30/2003 6TOM11 00000073 501642 73584436

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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.

**David J. Stephenson, Jr.**

Name of Person Signing

Signature

July 24, 2003

Date

Total number of pages including cover sheet, attachments, and

18

RECOI  
TR/

02-13-2003



102365077

Docket No.:

2131-65

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To the Honorable Commissioner of Patents and

original documents or copy thereof.

1. Name of conveying party(ies): SHANE JEWELRY CO. 1-22-03

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

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

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

Name: WESTERN STONE AND METAL CORP.  
Internal Address: \_\_\_\_\_  
Street Address: 9200 E. Mineral Ave., Suite 200  
City: Englewood State: CO ZIP: 80112

Individual(s) citizenship \_\_\_\_\_  
 Association \_\_\_\_\_  
 General Partnership \_\_\_\_\_  
 Limited Partnership \_\_\_\_\_  
 Corporation-State Colorado  
 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

3. Nature of conveyance:

Assignment  Merger  
 Security Agreement  Change of Name  
 Other \_\_\_\_\_

Execution Date: August 1, 2002

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

A. Trademark Application No.(s)  
4/004111  
73/584436

Additional numbers  Yes  No

B. Trademark Registration No.(s)  
1934523  
1959461

Yes  No

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

Name: Brian D. Wallace  
Internal Address: Fairfield and Woods, P.C.  
Street Address: 1700 Lincoln Street, Suite 2400  
City: Denver State: CO ZIP: 80203

6. Total number of applications and registrations involved: 2

7. Total fee (37 CFR 3.41): \$ 80.00  
 Enclosed  
 Authorized to be charged to deposit account

8. Deposit account number:  
501642

DO NOT USE THIS SPACE

02/12/2003 DBYRNE 00000073 74004111

01. Fee 40.00 OP  
02. Patent 25.00 OP

To the best of my knowledge and belief, the foregoing information is true and correct and the attached copy is a true copy of the original document.

Brian D. Wallace  
Name of Person Signing

B.D.W.  
Signature

January 21, 2003  
Date

Total number of pages including cover sheet, attachments: 11

Refund Ref: 02/12/2003 DBYRNE 000012425  
CHECK Refund Total: \$15.00

TRADEMARK ASSIGNMENT

WHEREAS, the **Shane Jewelry Co.** (ASSIGNOR), a corporation organized and existing under the laws of the State of Michigan, pursuant an Order from the Trademark Trial and Appeal Board of the United States Patent and Trademark Office in Concurrent Use No. 924 (the "Concurrent Use Order"), attached hereto as Exhibit A, has certain concurrent use rights to the U.S. trademark registrations listed in Schedule 1 attached hereto in a four county area within the State of Michigan consisting of the counties of Ionia, Chinton, Ingham and Eaton.

WHEREAS, **Western Stone and Metal Corp.** (ASSIGNEE), a corporation organized and existing under the laws of the State of Colorado, is the owner of the U.S. trademark registrations listed in Schedule 1 attached hereto (the "Trademarks"), and is desirous of acquiring all of ASSIGNOR's rights, including all concurrent use rights identified in the Concurrent Use Order, and the good will of the business symbolized by the trademarks;

NOW, THEREFORE, for the payment of ONE THOUSAND DOLLARS (\$1,000.00) and up to FIVE HUNDRED DOLLARS (\$500.00) for reimbursement of ASSIGNOR's attorney's fees, and other good and valuable consideration the receipt of which is hereby acknowledged, ASSIGNOR does hereby agree to transfer and assign to ASSIGNEE its successors and assigns at a time at which such marks may be transferred consistent with Title 37 CFR, all right, title and interest in and to said Trademarks and the concurrent use rights set forth in the registrations therefor, together with the good will of the business symbolized by the Trademarks; to be held and enjoyed by ASSIGNEE, its successors and assigns, licensees or other legal representatives, as fully and entirely as the same would have been held by ASSIGNOR had this assignment not been made.

Effective the 1st day of August, 2002.

Shane Jewelry Co., Inc.  
a Michigan corporation

By: Gerald D. Shane  
Name: GERALD D. SHANE  
Title: PRESIDENT

State of MICHIGAN }  
  } ss  
County of EATON }

Before me personally appeared Gerald D. Shane, to me known to be the person described in the above assignment, who signed the foregoing instrument in my presence, and acknowledged the same to be his free act and deed, on Aug. 1, 2002.

[Signature]  
Notary Public

JOHN D SCHNEEBERGER  
NOTARY PUBLIC EATON CO., MI  
MY COMMISSION EXPIRES Jan 4, 2005

My Commission Expires: 1-4-05

**SCHEDULE 1**

Mark

U.S. Registration / Application No.

Shane Co.

Reg. No. 1934523, SN 74/004111

Shane Co.

Reg. No. 1959461, SN 73/584436

#170086 v1 - Midwestern Stone Trademark Assignment from Shane Jewelry

EXHIBIT A

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2800 Crystal Drive  
Arlington, Virginia 22202-3513

**Bottorff**

Concurrent Use No. 926

Western Stone & Metal  
Corp., dba Shane Co.,  
concurrent use applicant

v.

Trading Company of  
America, Ltd., by change  
of name from Shane  
Company, Inc.,  
concurrent use applicant,

v.

S & R Jewelry Company  
West, Inc. (Los Angeles,  
California),  
excepted user,

v.

Shane Jewelry Co. (Grand  
Ledge, Michigan),  
excepted user

v.

Shane, Inc. (Warwick,  
Rhode Island), excepted  
user

MAILED

JUN 06 1995

PAT. & T.M. OFFICE

**INTRODUCTION**

This concurrent use proceeding involves two concurrent use applicants, Western Stone & Metal Corp., dba Shane Co. (hereinafter Western Stone), and Trading Company of America,

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Ltd., by change of name from Shane Company, Inc.  
(hereinafter Trading Company).

By order dated November 17, 1994, the Board, inter alia, acknowledged the entitlement of Western Stone to the concurrent use registration it seeks in Application Serial No. 74/004,111. However, the Board found that concurrent use applicant Trading Company had not yet established its entitlement to the concurrent use registration it seeks, vis-a-vis each of the excepted users named in its application Serial No. 73/584,436. The Board allowed Trading Company time in which to submit additional evidence establishing such entitlement.<sup>1</sup>

On February 14, 1995, Trading Company submitted its statement of entitlement to registration, in response to the Board's order.<sup>2</sup> In its statement, Trading Company requested that Shane Inc., (R.I.) be deleted as a named user from application Serial No. 73/584,436 and as a party to this proceeding, and that five other users named in its application be deleted therefrom. Trading Company has also submitted a copy of a settlement agreement between itself and named user Shane Jewelry Co. of Grand Ledge, Michigan, as evidence of its entitlement to a concurrent registration.

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<sup>1</sup>This order shall use the same abbreviated designations for the various parties and named users involved in this proceeding as were used in the November 17, 1994 order.

<sup>2</sup>Trading Company's January 17, 1995 request to extend its time to respond to the Board's order is granted.

**SHANE INC. (R.I.) DELETED FROM APPLICATION**

The Board's November 17, 1994 order allowed Shane Inc. (R.I.) twenty days therefrom to show cause why it should not be deleted as a named user from Trading Company's application and deleted as a party to this case. The record shows no response from Shane Inc. (R.I.). In view thereof, Shane Inc. (R.I.) is deleted as a named excepted user in Trading Company's application Serial No. 73/584,436, and is dismissed as a party to this concurrent use proceeding.

**THE FIVE OTHER "SHANE CO." NAMED USERS**

The Board's November 17, 1994 order noted that Trading Company had named the following, inter alia, as excepted users: (1) Shane Co., of San Mateo, California; (2) The Shane Co., of Englewood, Colorado; (3) The Shane Co., of Atlanta, Georgia; (4) The Shane Co., of Seattle, Washington; (5) The Shane Co., of St. Thomas, U.S. Virgin Islands. The Board also noted that it appeared from the record herein that these five entities might be related to or encompassed by Western Stone, with whom Trading Company has entered into a settlement agreement which the Board has already determined to be sufficient to entitle Western Stone and Trading Company to concurrent registrations. The Board stated that upon a definitive statement from Trading Company as to the existence of such a relationship between Western Stone and these five entities, the Board will delete those

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entities as named users in Trading Company's application.  
(See November 17, 1994 order at pp. 8-9.)

Trading Company, in its February 14, 1995 statement, has stated affirmatively that these five entities are owned by, and thus encompassed by Western Stone. In view of this statement (which Western Stone has not contested), those five entities are hereby deleted as named users from Trading Company's application Serial No. 73/584,435.

**SHANE JEWELRY CO. OF GRAND LEDGE, MICHIGAN**

Finally, in response to the Board's November 17, 1994 order, Trading Company has submitted a copy of a settlement agreement executed by Trading Company and Shane Jewelry Co. of Grand Ledge, Michigan. The agreement is submitted in support of Trading Company's contention that it is entitled to its concurrent registration, vis-a-vis Shane Jewelry Co.

The agreement provides, in relevant part, that Shane Jewelry Co. of Grand Ledge, Michigan will not use or advertise any SHANE marks in the geographic area for which Trading Company is seeking its concurrent registration, i.e., the states of Indiana, Kentucky, Ohio, and Pennsylvania (except for the Philadelphia metropolitan area), and an area encompassed by a radius of eighty miles in all directions from Houston, Texas, and also that Trading Company will not use or advertise any SHANE marks within the four county area in Michigan consisting of the counties of Ionia, Clinton, Ingham and Eaton. The parties agree that



these geographic restrictions on the parties' rights to use their respective marks will be sufficient to avoid likelihood of confusion.

The Board finds that the above-summarized provisions of this agreement are sufficient to establish that concurrent use of the SHANE mark by Trading Company and Shane Jewelry Co., in accordance with the restrictions imposed by the agreement, is not likely to cause confusion, mistake or deception.<sup>1</sup>

The Board has previously found, in its November 17, 1994 order, that Trading Company's agreements with the other remaining users named in its application, i.e., Western Stone and S & R Jewelry Company West, Inc., are sufficient evidence that confusion is not likely to result from concurrent use of the marks by Trading Company and those parties. Thus, Trading Company has now established its entitlement to the concurrent registration it seeks in application Serial No. 73/584,436, vis-a-vis each of the remaining excepted users named in that application. See *Precision Tune Inc. v. Precision Auto-Tune, Inc.*, 4 USPQ2d 1097 (TTAB 1987).

<sup>1</sup>The parties to the agreement may wish to review the provisions of paragraph 5 of the agreement, which contains what appears to be a drafting error. Specifically, in line 2 of paragraph 5 of the agreement, the reference to "Paragraph 1" might need to be changed to "Paragraph 2." Alternatively, and also in line 2, the word "outside" might need to be changed to "inside." As currently drafted, Paragraph 5 of the agreement would require Shane Jewelry Co. to withdraw its claim of use of the mark in its home base of Grand Ledge, Michigan, which is a location "outside of the area set forth in Paragraph 1." It is unlikely that the parties intended this result.

**SUMMARY**

By way of summary (including the orders previously issued in the Board's November 17, 1994 decision), and in termination of this concurrent use proceeding,

**IT IS HEREBY ORDERED THAT:**

1. Western Stone's application Serial No. 74/004,111 is hereby amended to delete, from page 2, Lines 16 and 17, the following wording: "; and Shane, Inc., 2525 West Shore Road, Warwick, Rhode Island in Warwick, Rhode Island".

2. All references in Trading Company's application Serial No. 73/584,436 to the following named excepted users are hereby deleted and to be given no effect:

- a. Shane Co., Inc., of San Mateo, California;
- b. The Shane Co. of Englewood, Colorado;
- c. The Shane Co., of Atlanta, Georgia;
- d. The Shane Co., of Seattle, Washington;
- e. The Shane Co., of St. Thomas, U.S. Virgin Islands;
- f. Shane, Inc., of Warwick, Rhode Island.

3. Shane, Inc., of Warwick, Rhode Island is hereby dismissed as a party defendant in this concurrent use proceeding.

4. Western Stone & Metal Corp., dba Shane Co., (application Serial No. 74/004,111) is entitled to register the mark SHANE CO., in stylized form, (pursuant to Trademark Act Section 2(f) and subject to a disclaimer of the

exclusive right to use "CO.") for "jewelry made of precious metals and precious stones," in Class 14, and "retail jewelry store services," in Class 42, for the following geographic area:

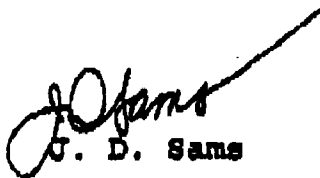
The entire United States and its territories except for: the states of Indiana, Kentucky, Ohio and Pennsylvania (except for the Philadelphia metropolitan area); an area encompassed by a radius of eighty miles in all directions from Houston, Texas; the Los Angeles, California metropolitan area; and a four county area within the state of Michigan consisting of the counties of Ionia, Clinton, Ingham and Eaton.

5. Trading Company of America, Ltd.<sup>4</sup> (application Serial No. 73/584,436) is entitled to register the mark SHANE CO., in stylized form, (pursuant to Trademark Act section 2(f) and subject to a disclaimer of the exclusive right to use "CO.") for "retail jewelry store services" in Class 42, for the geographic area comprising the states of Indiana, Kentucky, Ohio, and Pennsylvania (excluding the Philadelphia metropolitan area), and an area encompassed by

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<sup>4</sup>Trading Company's address of record is Two West Washington Street, Suite 600, Indianapolis, IN 46204. However, it appears from the settlement agreement between Trading Company and Shane Jewelry Co., executed in February 1995, that Trading Company has a new address, i.e., 8900 Keystone Crossing, Suite 1200, Indianapolis, IN 46240. The Board has corrected the Office's records accordingly.

a radius of eighty miles in all directions from Houston,  
Texas.

  
J. D. Sams

  
J. E. Rice

  
P. T. Hairston

Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

cc:

Trading Company of America, Ltd.  
c/o Clifford W. Browning, Esq.  
Woodard, Emhardt, et al  
Bank One Center/Tower  
111 Monument Circle, Suite 3700  
Indianapolis, IN 46204-5137

Western Stone & Metal Corp.  
c/o Gary D. Fields, Esq.  
Fields, Lewis, et al  
1720 S. Bellaire St., Suite 1100  
Denver, CO 80222

Shane Jewelry Co.  
c/o William L. Ferrigan, Esq.  
P.O. Box 27  
403 S. Clinton St.  
Grand Ledge, MI 48837

S & R Jewelry Company West, Inc.  
1018 Broxton Avenue  
Los Angeles, CA 90024

Shane, Inc.  
P.O. Box 1356  
Coventry, RI 02816

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SHANE CO HQ

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TRADEMARK

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UNITED STATES DEPARTMENT OF COMMERCE  
 Patent and Trademark Office  
 OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS  
 2900 Crystal Drive  
 Arlington, Virginia 22202-3513

REGISTRATION NO: 1959461 SERIAL NO: 73/584436 MAILING DATE: 01/22/2003  
 REGISTRATION DATE: 03/05/1996  
 MARK: SHANE CO.  
 REGISTRATION OWNER: MIDWESTERN STONE & METAL LLC  
 CORRESPONDENCE ADDRESS:

BRIAN D. WALLACE  
 FAIRFIELD AND WOODS, P.C.  
 1700 LINCOLN STREET  
 SUITE 2400  
 DENVER, CO 80203-4524

**NOTICE OF ACCEPTANCE**

15 U.S.C. Sec. 1058(a)(1)

THE COMBINED AFFIDAVIT FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

\*\*\*\*\*

**NOTICE OF ACKNOWLEDGEMENT**

15 U.S.C. Sec. 1065

THE AFFIDAVIT FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 15 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1065.

ACCORDINGLY, THE SECTION 15 AFFIDAVIT IS ACKNOWLEDGED.

\*\*\*\*\*

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):  
 042.

SMITH, WYE J  
 PARALEGAL SPECIALIST  
 POST-REGISTRATION DIVISION  
 (703)308-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION

ORIGINAL

## **REQUIREMENTS FOR MAINTAINING A FEDERAL TRADEMARK REGISTRATION**

### **I) SECTION 8: AFFIDAVIT OF CONTINUED USE**

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. Sec. 1058, at the end of each successive 10-year period following the date of registration.

**Failure to file the Section 8 Affidavit will result in the cancellation of the registration.**

### **II) SECTION 9: APPLICATION FOR RENEWAL**

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. Sec. 1059, at the end of each successive 10-year period following the date of registration.

**Failure to file the Application for Renewal will result in the expiration of the registration.**

**NO FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS WILL BE SENT TO THE REGISTRANT BY THE PATENT AND TRADEMARK OFFICE. IT IS RECOMMENDED THAT THE REGISTRANT CONTACT THE PATENT AND TRADEMARK OFFICE APPROXIMATELY ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.**