

7 TRADEMARK LAW OFFICE 107
Serial Number: 76/303459-
Mark: R+H

Please Place on Upper Right Corner
of Response to Office Action ONLY

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

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

on the date shown below:

Deanna Bierwerth

(Typed or Printed Name of Person Signing Certificate)

Deanna Bierwerth

(Signature)

10-9-02

(Date)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

In Re Trademark Application of:

russell&hazel, LLC
a Minnesota limited liability company

Serial No.: 76-303,459
Filing Date: August 22, 2001
Mark: R+H
Class: International 16, 18, 35

AMENDMENT

Box Responses - No Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Attn: Robert H. Coggins, Attorney-Advisor
Law Office 107

Dear Mr. Coggins:

Pursuant to the Agreement attached hereto as Exhibit A, the applicant hereby amends its identification of goods in Class 16 (Class 18 and Class 35 are not being amended) to add the word "protective" before the words "book covers" and to omit the

Vertical stamp: RECEIVED - 9 11 02 10 59 AM '02

CP

words "combination magazine and". The amended Class 16 identification of goods will now read:

Belts and cords to hold binders shut; binders; blank books; protective book covers; catalog in the field of school supplies; composition books; drawing rulers; drawing compasses; erasers; flash cards; folders, index dividers; loose leaf paper; note pads; notebook dividers; paper expanding files; paper file jackets; pen grips, pencil grips; pencil or pen holders; pencil sharpeners; pencils; pens; postcards; wirebound books; and writing pads.

Please acknowledge receipt of these items on the attached postcard and return the same to the undersigned.

Respectfully submitted,



Glen E. Schumann
Attorney for Applicant
4800 Wells Fargo Center
90 South Seventh Street
Minneapolis, MN 55402-4129
Telephone: (612) 347-0300

Dated: October 7, 2002.

GES/sel
Attachment

cc: Ms. Christine Plantan (w/attach.)
M. Graham Coleman, 2d, Esq. (w/attach.)

AGREEMENT

AGREEMENT, effective as of April 24, 2002, by and between THE RODGERS & HAMMERSTEIN ORGANIZATION, for itself and on behalf of THE FAMILY TRUSTS U/W RICHARD RODGERS AND DOROTHY F. RODGERS and THE ESTATE OF OSCAR HAMMERSTEIN II, c/o 1065 Avenue of the Americas, Suite 2400, New York, New York 10019 (collectively "R&H") and russell&hazel, LLC, 901 Third Street North, Suite 115, Minneapolis, Minnesota 55401 ("Applicant").

WHEREAS, R&H has adopted and is using a variety of marks incorporating the distinctive term "R&H" in connection with a variety of goods and services; and

WHEREAS, R&H is the owner of several federal registrations for trademarks incorporating the distinctive term "R&H", including Reg. No. 1,736,241 (registered December 1, 1992 for pre-recorded videocassettes in Class 9), Reg. No. 1,744,458 (registered January 5, 1993 for various print materials, including catalogs, in Class 16), Reg. No. 1,819,011 (registered February 1, 1994 for clothing in Class 25), Reg. No. 1,856,829 (registered October 4, 1994 for various toys in Class 28), and Reg. No. 1,891,058 (registered April 25, 1995 for publications, namely newsletters in Class 16), all of which have achieved incontestable status since their original registration; and

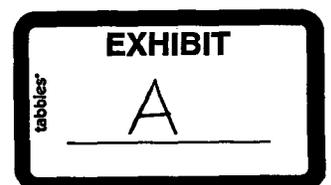
WHEREAS, on August 22, 2001, Applicant filed an intent-to-use application with the United States Patent and Trademark Office, Serial Number 76/303,459, for registration of the mark "R+H" (the "Mark") in connection with various goods and services in Classes 16, 18 and 35, as more fully described in the print-out of Applicant's prosecution history attached hereto as Exhibit A (the "Subject Goods and Services");

NOW, THEREFORE, to avoid the expense of litigation and to provide for coexistence in connection with use of the Mark, the parties agree as follows:

1. Applicant and its successors, assigns and licensees may use the Mark, in the United States and internationally, on and in conjunction with the Subject Goods and Services, subject to the restrictions described in Section 2 below.

2. Applicant agrees to abide by the following restrictions and to take the following actions with respect to its use and/or registration of the Mark:

(a) Applicant and its successors, assigns and licensees will refrain from use of the Mark in connection with theatrical or musical activities (including without limitation performance, production, publication or licensing in connection with such activities), and from taking any action that might suggest that Applicant and/or its activities in connection with the Mark are sponsored by, affiliated with, or approved by R&H. R&H agrees to notify Applicant or its successors, assigns or licensees, in writing, of any claimed violation of this Section 2(a) and the parties agree to use their best efforts to reach a commercially reasonable and mutually acceptable resolution with respect to any such claimed violation.



*to add the word "protective" before
the words "book covers" and



(b) As soon as practicable after execution of this Agreement, Applicant will file an amendment to the recitation of goods in the Class 16 portion of its application to register the Mark* to omit the words "combination magazine and", such that the phrase from which such words are removed reads "catalog in the field of school supplies". Applicant will provide counsel to R&H with a copy of such amendment as submitted to the Trademark Office and with a copy of the Trademark Office's acceptance and acknowledgment of same.

(c) As soon as practicable after execution of this Agreement, Applicant will record a fully-executed copy of this Agreement with the Trademark Office as part of the file for the Mark, and to provide R&H with a copy of the Trademark Office's filing receipt for such submission.

3. Except in the event of a breach by Applicant or its successors, assigns or licensees of any of the conditions of Section 2 above, R&H shall not oppose, cancel, attempt to oppose or cancel, or otherwise challenge Applicant's application to register the Mark for use in connection with the Subject Goods and Services or Applicant's future use of the Mark in connection with the Subject Goods and Services. R&H hereby consents to registration of the Mark by the Applicant with respect to the Subject Goods and Services, as amended pursuant to Section 2(b) hereof.

4. The parties agree that the use by Applicant of the Mark in the manner provided in this Agreement concurrently with R&H's use of its respective marks is not likely to confuse consumers as to the source of the goods and services provided by Applicant and/or R&H. The parties further agree that in the unlikely event that a likelihood of confusion should arise in the future, they will consult with each other as soon as possible and take whatever steps are necessary to prevent confusion in the marketplace.

5. This Agreement shall inure to the benefit of and be binding upon the parties, their successors, transferees, assigns, affiliates, licensees and representatives, and may be assigned by any party without the other party's consent.

6. The validity, construction and performance of this Agreement shall be governed by the laws of the State of New York without giving effect to the conflict of laws rules thereof.

7. There are no representations, warranties or covenants other than those set forth in this Agreement, which sets forth the entire understanding between the parties, and which cannot be modified except by an agreement in writing.

8. All notices required under this Agreement shall be sent to the parties at their respective addresses first given above, with a copy of all notices to Applicant at 901 Third Street North, Suite 115, Minneapolis, Minnesota 55401 and to Moss & Barnett, 4800 Wells Fargo Center, 90 South Seventh Street, Minneapolis, Minnesota 55402-4129, Attention: Glen E. Schumann, Esq., and all notices to R&H to Kay & Boose, LLP, One Dag Hammarskjold Plaza, 31st Floor, New York, New York 10017, Attention: M. Graham Coleman, 2d, Esq.

9. R&H, its successors, transferees, assigns, affiliates, licensees and representatives will refrain from expanding use of their distinctive "R&H marks" in connection with Applicant's goods and services, described on the attached Exhibit B, and from taking any action that might suggest that R&H and/or its activities in connection with its "R&H marks" are sponsored by, affiliated with, or approved by Applicant. For avoidance of doubt, the parties acknowledge that R&H has historically distributed theatrical and musical material (including without limitation newsletters and other print materials, and audio and video recordings) in various educational markets, and the continued distribution and sale of such material in educational markets shall not be deemed "school supplies" within the meaning of Applicant's description of goods and services as referenced in Exhibit B. Applicant agrees to notify R&H or its successors, assigns or licensees, in writing, of any claimed violation of this Section 9 and the parties agree to use their best efforts to reach a commercially reasonable and mutually acceptable resolution with respect to any such claimed violation.

IN WITNESS WHEREOF; the parties have caused this Agreement to be signed as of the date indicated below.

THE RODGERS & HAMMERSTEIN ORGANIZATION,
for itself and on behalf of THE FAMILY TRUSTS U/W
RICHARD RODGERS AND DOROTHY F. RODGERS
and THE ESTATE OF OSCAR HAMMERSTEIN II

By:

Title:

russell&hazel, LLC

By:

Title:

EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Tue Jul 30 04:30:36 EDT 2002

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT BOTTOM HELP

Logout

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status

(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark R+H

Goods and Services IC 016. US 002 005 022 023 029 037 038 050. G & S: belts and cords to hold binders shut; binders; blank books; book covers; combination magazine and catalog in the field of school supplies; composition books; drawing rulers; drawing compasses; erasers; flash cards; folders; index dividers; loose leaf paper; note pads; notebook dividers; paper expanding files; paper file jackets; pen grips; pencil grips; pencil or pen holders; pencil sharpeners; pencils; pens; postcards; wirebound books; and writing pads

IC 018. US 001 002 003 022 041. G & S: backpacks; and school bags

IC 035. US 100 101 102. G & S: electronic catalog services featuring school supplies; mail order catalog services featuring school supplies; on-line retail store services featuring school supplies; and retail shops featuring school supplies

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

76303459

Filing Date

August 22, 2001

Filed ITU

FILED AS ITU

Published for

February 19, 2002

Opposition

Owner

(APPLICANT) russell&hazel, LLC LIMITED LIABILITY COMPANY MINNESOTA
901 Third Street North, Suite 115 Minneapolis MINNESOTA 55401

Attorney of

J. Michael Hirsch

Record

Type of Mark TRADEMARK. SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

[PTO HOME](#) [TRADEMARK](#) [TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSER DICT](#) [TOP](#) [HELP](#)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 07/30/2002 12:26:07 ET

Serial Number: 76303459

Registration Number: (NOT AVAILABLE)

Mark (words only): R+H

Current Status: A request for an extension of time to file an opposition has been filed at the Trademark Trial and Appeal Board.

Date of Status: 2002-03-05

Filing Date: 2001-08-22

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMEG Law Office 107

CURRENT APPLICANT(S)/OWNER(S)

1. russell&hazel, LLC

Address:

russell&hazel, LLC
901 Third Street North, Suite 115
Minneapolis, MN 55401
United States

State or Country Where Organized: Minnesota

Legal Entity Type: Other

GOODS AND/OR SERVICES

belts and cords to hold binders shut; binders; blank books; book covers; combination magazine and catalog in the field of school supplies; composition books; drawing rulers; drawing compasses; erasers; flash cards; folders; index dividers; loose leaf paper; note pads; notebook dividers; paper expanding files; paper file jackets; pen grips; pencil grips; pencil or pen holders; pencil sharpeners; pencils; pens; postcards; wirebound books; and writing pads

International Class: 016

First Use Date:

First Use in Commerce Date:

Basis: 1(b)

backpacks; and school bags

International Class: 018

First Use Date:

First Use in Commerce Date:

Basis: 1(b)

electronic catalog services featuring school supplies; mail order catalog services featuring school supplies; on-line retail store services featuring school supplies; and retail shops featuring school supplies

International Class: 035

First Use Date:

First Use in Commerce Date:

Basis: 1(b)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

- 2002-03-05 - Extension of time to oppose - Filed
 - 2002-02-19 - Published for opposition
 - 2002-01-30 - Notice of publication
 - 2001-11-15 - Approved for Pub - Principal Register (Initial exam)
 - 2001-11-14 - Case file assigned to examining attorney
 - 2001-11-14 - Examiner's amendment mailed
 - 2001-11-14 - Case file assigned to examining attorney
 - 2001-10-24 - Case file assigned to examining attorney
-

CONTACT INFORMATION

Correspondent (Owner)

J. Michael Hirsch (Attorney of record)

J. MICHAEL HIRSCH
MOSS & BARNETT
WELLS FARGO
90 S 7TH ST STE 4800
MINNEAPOLIS MN 55402-4129
United States

EXHIBIT B
DESCRIPTION OF GOODS AND/OR SERVICES

belts and cords to hold binders shut; binders; blank books; protective book covers; catalog in the field of school supplies; composition books; drawing rulers; drawing compasses; erasers; flash cards; folders; index dividers; loose leaf paper; note pads; notebook dividers; paper expanding files; paper file jackets; pen grips; pencil grips; pencil or pen holders; pencil sharpeners; pencils; pens; postcards; wirebound books; and writing pads (in Class 16); backpacks; and school bags (in Class 18); and electronic catalog services featuring school supplies; mail order catalog services featuring school supplies; on-line retail store services featuring school supplies; and retail shops featuring school supplies (in Class 35)