

05-15-2000

FORM PTO-1618A  
Expires 06/30/99  
OMB 0651-0027



101354773

U.S. Department of Commerce  
Patent and Trademark Office  
**TRADEMARK**

APR 26

### RECORDATION FORM COVER SHEET TRADEMARKS ONLY

TO: The Commissioner of Patents and Trademarks: Please record the attached original document(s) or copy(ies).

#### Submission Type

4.26.00

#### Conveyance Type

- New
- Resubmission (Non-Recordation)  
Document ID #
- Correction of PTO Error  
Reel #  Frame #
- Corrective Document  
Reel #  Frame #

- Assignment  License
- Security Agreement  Nunc Pro Tunc Assignment
- Merger  Effective Date  
Month Day Year
- Change of Name
- Other

#### Conveying Party

Mark if additional names of conveying parties attached

Execution Date  
Month Day Year

Name

Formerly

- Individual  General Partnership  Limited Partnership  Corporation  Association
- Other
- Citizenship/State of Incorporation/Organization

#### Receiving Party

Mark if additional names of receiving parties attached

Name

DBA/AKA/TA

Composed of

Address (line 1)

Address (line 2)

Address (line 3)

City

State/Country

Zip Code

- Individual  General Partnership  Limited Partnership
- Corporation  Association
- Other

If document to be recorded is an assignment and the receiving party is not domiciled in the United States, an appointment of a domestic representative should be attached. (Designation must be a separate document from Assignment.)

- Citizenship/State of Incorporation/Organization

FOR OFFICE USE ONLY

Public burden reporting for this collection of information is estimated to average approximately 30 minutes per Cover Sheet to be recorded, including time for reviewing the document and gathering the data needed to complete the Cover Sheet. Send comments regarding this burden estimate to the U.S. Patent and Trademark Office, Chief Information Officer, Washington, D.C. 20231 and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Paperwork Reduction Project (0651-0027), Washington, D.C. 20503. See OMB Information Collection Budget Package 0651-0027, Patent and Trademark Assignment Practice. DO NOT SEND REQUESTS TO RECORD ASSIGNMENT DOCUMENTS TO THIS ADDRESS.

Mail documents to be recorded with required cover sheet(s) information to:  
Commissioner of Patents and Trademarks, Box Assignments, Washington, D.C. 20231

REEL: 002071 FRAME: 0828

**Domestic Representative Name and Address**

Enter for the first Receiving Party only.

Name

Address (line 1)

Address (line 2)

Address (line 3)

Address (line 4)

**Correspondent Name and Address**

Area Code and Telephone Number

404-885-3414

Name

Address (line 1)

Address (line 2)

Address (line 3)

Address (line 4)

**Pages**

Enter the total number of pages of the attached conveyance document including any attachments.

# 11

**Trademark Application Number(s) or Registration Number(s)**

Mark if additional numbers attached

Enter either the Trademark Application Number or the Registration Number (DO NOT ENTER BOTH numbers for the same property).

**Trademark Application Number(s)**

75650850	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>

**Registration Number(s)**

2312510	1147401	1079576
2223940	1224872	<input type="text"/>
1292728	1089852	<input type="text"/>

**Number of Properties**

Enter the total number of properties involved.

# 8

**Fee Amount**

Fee Amount for Properties Listed (37 CFR 3.41):

\$ 215.00

Method of Payment:

Enclosed

Deposit Account

Deposit Account

(Enter for payment by deposit account or if additional fees can be charged to the account.)

Deposit Account Number:

# 20-1507

Authorization to charge additional fees:

Yes

No

**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. Charges to deposit account are authorized, as indicated herein.

Peter J. Pawlak, Jr.

Name of Person Signing

Signature

4/26/00

Date Signed

# CONDITIONAL ASSIGNMENT AND TRADEMARK SECURITY AGREEMENT

**THIS CONDITIONAL ASSIGNMENT AND TRADEMARK SECURITY AGREEMENT** (this "Agreement") is made as of the 20<sup>th</sup> day of April, 2000, between MID-STATE AUTOMOTIVE DISTRIBUTORS, INC., a Tennessee corporation (the "Assignor"), and BANK OF AMERICA, N.A. (the "Lender").

WHEREAS, the Assignor and the Lender have entered into that certain Loan and Security Agreement of even date herewith (as amended, supplemented and modified from time to time, the "Loan Agreement"; capitalized terms used herein without definition shall have the meanings ascribed to such terms in the Loan Agreement); and

WHEREAS, in order to induce the Lender to enter into the Loan Agreement and to make the Loans, the Assignor has agreed to assign to the Lender certain trademark rights as described herein.

NOW, THEREFORE, in consideration of the premises, the Assignor hereby agrees with the Lender as follows:

1. **Grant of Security Interest.**

To secure the complete and timely payment and performance of all Secured Obligations, the Assignor hereby grants, assigns and conveys to the Lender a security interest in the entire right, title and interest in and to the United States ("U.S.") and international trademarks and service marks and their respective registrations and applications for registration listed in **Schedule A** attached hereto and by reference made a part hereof, together with the goodwill of the business symbolized by such trademarks and service marks, all licenses relating thereto, and all proceeds thereof (including, without limitation, license royalties and proceeds of infringement suits), and the right to sue for past, present and future infringements (all of which trademarks, service marks, trademark and service mark registrations, applications for registration, goodwill, licenses, proceeds, and other related rights are collectively called the "Trademarks").

2. **Representations and Warranties.**

- (a) The Assignor represents and warrants that:
  - (i) The Trademarks are subsisting and have not been adjudged invalid or unenforceable, in whole or in part, in their country of registration or the respective states thereof;

- (ii) Each of the Trademarks is valid and enforceable in their country of registration and the respective states thereof;
- (iii) Except as noted on **Schedule B**, the Assignor is the sole and exclusive owner of the entire and unencumbered right, title and interest in and to each of the Trademarks, free and clear of any liens, charges, encumbrances, mortgages, hypothecations, pledges, liens, security interests or claims of any kind, and covenants by the Assignor not to sue third persons; and
- (iv) The Assignor will make all necessary filings to protect and maintain its interest in the Trademarks, including, without limitation, all necessary filings in the U.S. Patent and Trademark Office, and will diligently endeavor to ensure that the filings appear of record in the U.S. Patent and Trademark Office.
- (v) The Assignor has the unqualified right, power and authority to execute, deliver and perform this Agreement; and
- (vi) Until all of the Secured Obligations shall have been satisfied in full, the Assignor will not enter into any agreement which is inconsistent with the Assignor's obligations under this Agreement, without the Lender's prior written consent.

### 3. **Conditional Grant of Additional Trademarks.**

If, before the Secured Obligations shall have been satisfied in full, (i) the Assignor shall have, or obtain ownership of, any trademark or service mark, including any registration or application therefor, or (ii) any trademarks or service marks filed by Assignor as intent-to-use applications, including, without limitation, those listed in **Schedule A** attached hereto and by reference made a part hereof, become federal registrations in the U.S. Patent and Trademark Office, the provisions of Paragraph 1 shall automatically apply thereto, and also to any composite marks, or other marks of the Assignor which are confusingly similar to such mark, and the Assignor shall give to the Lender prompt written notice thereof. This Paragraph 3 shall not apply to trademarks which are owned by others and licensed to the Assignor. The Assignor shall perform all acts and execute all documents reasonably requested by the Lender at any time and from time to time to evidence, perfect, maintain, record and enforce the Lender's security interest in the Trademarks, including, without limitation, any trademarks or service marks falling under this Paragraph. All such trademarks, service marks, or registrations therefor shall be considered Trademarks under this Agreement.

Furthermore, if, before the Secured Obligations shall have been satisfied in full, the Assignor has filed any intent-to-use applications, any such intent-to-use application shall be automatically included in **Schedule A**.

**4. Modification of Agreement.**

The Assignor authorizes the Lender to modify this Agreement by amending **Schedule A** to include any additional trademarks, service marks, registrations or applications for registration thereof pursuant to Paragraphs 1 and 3 hereof, and to have this Agreement, as amended, or any other document evidencing the security interest granted therein, recorded in the U.S. Patent and Trademark Office or, in the reasonable discretion of the Lender, in the trademark office of any relevant country at the expense of the Assignor.

**5. Covenants of Assignor.**

(a) The Assignor covenants as follows: (i) that it will maintain and assume primary responsibility for the high standard of quality which has become associated with the Trademarks; (ii) that the Lender from time to time and upon request shall have the right to inspect samples of the goods and services with respect to which the Trademarks will be used (the "Goods") and the premises at which the Goods are produced; and (iii) that the Lender shall have the right to prevent use of the Trademarks on Goods which are not of high quality, all so as to preserve the goodwill symbolized by the Trademarks.

(b) The Assignor agrees that it shall use and maintain all right, title and interest in and to the Trademarks, and the Assignor will not abandon or permit the expiration of any of the Trademarks, unless so directed by a court of law. Should the Assignor determine that one or more of the Trademarks is no longer desirable in the conduct of the business of the Assignor, or otherwise determine that the Assignor is unable, pursuant to applicable law, to maintain said Trademark(s), the Assignor shall notify the Lender, in writing, of such determination prior to abandoning any such Trademark(s). The Assignor further agrees that (i) it shall give the Lender written notice, and a complete copy, of any license or sublicense of the Trademarks; and (ii) on all goods bearing the Trademarks and on the first use or appearance of each Trademark in any publications, the Assignor or its licensees will include such notices of registration as are required or authorized from time to time under applicable law.

(c) With respect to each Trademark, the Assignor agrees to take all necessary steps, including, without limitation, in the U.S. Patent and Trademark Office or in the trademark office of any country or in any court, to: (i) maintain each such Trademark, and (ii) pursue each such application for trademark registration, now or hereafter included in the Trademarks under this Agreement, including, without reservation, the filing of responses to office actions issued by the U.S. Patent and Trademark Office, the filing of applications for renewal, the filing of affidavits under Sections 8 and 15 of the United States Trademark Act, and the participation in opposition, cancellation and infringement and misappropriation proceedings, unless the Assignor shall have previously determined that such use or the pursuit or maintenance thereof is no longer desirable in the conduct of the business of the Assignor and that the loss thereof will not have a materially adverse effect (in which event the Assignor shall notify the Lender in writing of such determination prior to any such action). The Assignor agrees to take corresponding steps with respect to each new or acquired trademark, trademark registration, or application therefor covered by Paragraph 3 hereof. Any and all expenses incurred in connection with such activities shall be borne by the Assignor.

6. Remedies Upon Default; Power of Attorney.

(a) If any Event of Default under the Loan Agreement, any of the Security Documents, or any other Loan Document shall have occurred, or if the Assignor fails to perform any agreement or to meet any of its obligations to the Lender hereunder, upon the election of the Lender in its sole discretion, all right, title and interest in and to the Trademarks shall be granted, assigned, conveyed and delivered to the Lender or its designee, and the Assignor hereby irrevocably constitutes and appoints the Lender and any officer, agent or employee thereof, with full power of substitution, as its true and lawful attorney-in-fact with full irrevocable power and authority in the place and stead of the Assignor and in the name of the Assignor or the Lender's own name or the name of the Lender's designee, all acts of said attorney being hereby ratified and confirmed, except to the extent any of the same constitute gross negligence or willful misconduct, such power being coupled with an interest is irrevocable, upon the occurrence of an Event of Default: (i) to complete, date, execute and file, or cause to be filed, the Assignment attached hereto as Exhibit A and by reference made a part hereof (the "Assignment") in the U.S. Patent and Trademark Office and in all other applicable offices, and to execute and deliver any and all documents and instruments which may be necessary or desirable to accomplish the purpose of the Assignment; (ii) to collect all proceeds from the Trademarks (including, without limitation, license royalties and proceeds of infringement suits); (iii) to convey, in any transaction authorized by the Loan Agreement, any goods covered by the registrations listed on Schedule A to any purchaser thereof; and (iv) to make payment or to discharge taxes or liens levied or placed upon or threatened against any goods covered by the registrations listed on Schedule A, the legality or validity thereof and the amounts necessary to discharge the same to be determined by the Lender in its sole discretion, and such payments made by the Lender to become the obligations of the Assignor to the Lender, due and payable immediately without demand.

(b) The Lender shall have, in addition to all other rights and remedies given it by this Agreement, those allowed by law and the rights and remedies of a secured party under the Uniform Commercial Code as enacted in any jurisdiction in which the Trademarks may be enforceable, and, without limiting the generality of the foregoing, the Lender may, if any Event of Default under the Loan Agreement shall have occurred, immediately, without demand or performance and without other notice (except as set forth below) or demand whatsoever to the Assignor, all of which are hereby expressly waived, and without advertisement, sell at public or private sale or otherwise realize upon, the Trademarks, together with the goodwill of the business symbolized by the Trademarks, and after deducting from the proceeds of sale or other disposition of the Trademarks all expenses (including all reasonable expenses for brokers' fees and legal services), shall apply the residue of such proceeds to the Secured Obligations. Notice of any sale or other disposition of the Trademarks shall be given to the Assignor at least ten (10) days before the time of any intended public or private sale or other disposition of the Trademarks is to be made, which the Assignor hereby agrees shall be reasonable notice of such sale or other disposition. At any such sale or other disposition, the Lender may, to the extent permissible under applicable law, purchase the whole or any part of the Trademarks sold, free from any right of redemption on the part of the Assignor, which right is hereby waived and released. The

Assignor hereby agrees to execute any documents reasonably requested by the Lender in connection with any disposition hereunder.

**7. Termination of Agreement.**

At such time as all of the Secured Obligations shall have been satisfied and the Lender shall have no further obligations to lend under the Loan Agreement, the Lender shall execute and deliver to the Assignor all deeds, assignments and other instruments as may be necessary or proper to re-vest in the Assignor unencumbered title to the Trademarks and the goodwill of the business symbolized by the Trademarks, subject to any disposition thereof which may have been made by the Lender pursuant hereto.

**8. Limitation of Liability and Indemnification.**

The Assignor hereby releases the Lender from, and agrees to hold the Lender free and harmless from and against, any claims arising out of any action taken or omitted to be taken with respect to the Trademarks (except to the extent of the Lender's gross negligence or willful misconduct), and the Assignor agrees to indemnify the Lender from and against any and all claims, demands, suits, losses, damages or other expenses (including reasonable attorneys' fees actually incurred) arising from or in any way related to the Trademarks, and any trademark infringement claim.

**9. Waiver and Amendment.**

(a) No course of dealing between the Assignor and the Lender, nor any failure to exercise, nor any delay in exercising, on the part of the Lender, any right, power or privilege hereunder shall preclude any other or further exercise thereof or the exercise of any other right, power or privilege.

(b) This Agreement is subject to modification only by a writing signed by the parties hereto.

**10. Cumulative Rights.**

All of the Lender's rights and remedies with respect to the Trademarks, whether established hereby or under the Loan Agreement, any Security Document or any other agreements or by law, shall be cumulative and may be exercised singularly or concurrently.

**11. Severability.**

The provisions of this Agreement are severable, and if any clause or provision shall be held invalid and unenforceable in whole or in part in any jurisdiction, then such invalidity or unenforceability shall affect only such clause or provision, or part thereof, in such jurisdiction, and shall not in any manner affect such clause or provision in any other jurisdiction, or any other clause or provision of this Agreement in any jurisdiction.

12. **Survival.**

The benefits and burdens of this Agreement shall inure to the benefit of and be binding upon the respective successors and permitted assigns of the parties.

13. **Counterparts.**

This Agreement may be executed in one or more counterparts, all of which taken together shall constitute one and the same instrument and any of the parties hereto may execute this Agreement by signing any such counterpart.

14. **Choice of Law.**


The validity, construction and enforcement of this Agreement, and the determination of the rights and duties of the parties shall be governed by the laws of the State of Georgia regardless of any choice of law or other provision that would result in the application of the laws of any other jurisdiction.

(Signatures On Following Page)




IN WITNESS WHEREOF, the undersigned have executed this Agreement as of the day and year first above written.

**MID-STATE AUTOMOTIVE  
DISTRIBUTORS, INC.**

By:   
Michael W. Taylor  
Vice President

**BANK OF AMERICA, N.A.**

By:   
Kevin M. Moore  
Senior Vice President

**Schedule A**

<b>SUMMARY OF MID-STATE AUTOMOTIVE DISTRIBUTORS, INC. TRADEMARKS</b>			
<b>Registration/ Serial No.</b>	<b>Trademark Name</b>	<b>Country</b>	<b>Date of Filing/ Registration</b>
Serial No. 75-650850	BESTEST	U.S. Cl. 1, 5, 6, 10, 13, 19, 21, 23, 26, 31, 34, 35, 36, 38, 46 Int. Cl. 1, 7, 9	March 1, 1999
2,312,510	PARTS CITY (words & design)	U.S. Cl. 100, 101, 102 Int. Cl. 35	January 25, 2000
2,223,940	PARTS CITY	U.S. Cl. 100, 101, 102 Int. Cl. 35	March 23, 1999
1,292,728	AUTOSURE	U.S. Cl. 19, 21 Int. Cl. 9, 12	September 4, 1984
1,147,401	AUTOSURE	U.S. Cl. 101 Int. Cl. 42	February 17, 1981
1,224,872	AUTOSURE	U.S. Cl. 19, 21 Int. Cl. 7, 12	January 25, 1983
1,089,852	AS	U.S. Cl. 100, 101, 102 Int. Cl. 35, 42	April 18, 1978
1,079,576	PARTS CITY (stylized)	U.S. Cl. 101 Int. Cl. 42	December 13, 1977
923,859 (Florida Reg.)	PARTS CITY	U.S. Cl. 100 Int. Cl. 35, 42	July 6, 1991
S717 (Georgia Reg.)	PARTS CITY	U.S. Cl. 101 Int. Cl. 35, 42	March 15, 1977
S356 (Georgia Reg.)	AS	U.S. Cl. 101 Int. Cl. 35, 42	March 9, 1977
38,458 (Mass. Reg.)	AUTO MATE	U.S. Cl. 26 Int. Cl. 9	April 25, 1986
Serial No. 43301333 (Tennessee Reg. No. not available)	PARTS CITY	U.S. Cl. 101 Int. Cl. 35	August 27, 1998

**Schedule B**

**Liens and Claims of Third Parties**

None.

**Exhibit A**

**ASSIGNMENT OF TRADEMARKS AND GOODWILL**

THIS ASSIGNMENT dated the \_\_\_\_ day of \_\_\_\_\_, 20\_\_\_\_, from MID-STATE AUTOMOTIVE DISTRIBUTORS, INC., a Tennessee corporation (the "Assignor"), to BANK OF AMERICA, N.A. (the "Assignee"), recites and provides:

WHEREAS, Assignor is the owner of certain trademarks and service marks and the registrations and applications to register therefor listed in **Schedule A** hereto ("Trademarks"); and

WHEREAS, Assignee desires to obtain all of the Assignor's right, title and interest in all such Trademarks.

NOW, THEREFORE, for good and valuable consideration, the receipt and adequacy of which are hereby acknowledged, Assignor hereby grants, assigns and conveys to Assignee, its successors and assigns, the entire right, title and interest of Assignor in and to the Trademarks, including without limitation all proceeds thereof (such as, by way of example, license royalties and proceeds of infringement suits), and the right to sue for past, present and future infringements, together with the goodwill of the business symbolized by the Trademarks. Assignor acknowledges that it has granted Assignee the right to secure the assets of the Assignor associated with the business symbolized by the Trademarks, under separate agreement.

Assignor further agrees to execute such further instruments and documents and perform such further acts as Assignee may deem necessary to secure to Assignee the rights herein conveyed.

**MID-STATE AUTOMOTIVE DISTRIBUTORS, INC.**

By: \_\_\_\_\_  
Michael W. Taylor  
Vice President

**Schedule A**

**RECORDED: 04/26/2000**

**TRADEMARK  
REEL: 002071 FRAME: 0840**