

## TRADEMARK ASSIGNMENT AND LICENSE BACK

This Trademark Assignment and License Back agreement (the "Agreement") is by and between **The Lutheran Church-Missouri Synod**, a Missouri nonprofit corporation with offices at 1333 South Kirkwood Road, Kirkwood, Missouri 63122 ("the LCMS") on the one hand, and **Rev. Todd Wilken**, an individual residing at \_\_\_\_\_ ("Wilken"), and **Mr. Jeff Schwarz**, an individual residing at \_\_\_\_\_ ("Schwarz") on the other hand. Hereinafter, Wilken and Schwarz may be referred to collectively as the "Assignees," and the LCMS and the Assignees may be referred to collectively as the "Parties." The effective date of this Agreement shall be the date of the last signature required for full execution of this Agreement by the LCMS and both Assignees.

WHEREAS, the LCMS has used the trademark "ISSUES, ETC." (the "Trademark") for many years in connection with the production and distribution of a radio program on its radio station, KFUE-AM, and by virtue of such use has acquired common law trademark rights therein; and

WHEREAS, the LCMS recently discontinued producing new installments of its radio program, but possesses a substantial library of archived broadcasts and related materials that bear the Trademark, including, without limitation, all media on which archived broadcasts are recorded (including online archives, CDs, written transcripts, etc.) as well as all associated merchandise (collectively, the "LCMS Archived Materials"), which the LCMS intends to continue using on a limited basis, including for purposes of re-broadcasting such archived broadcasts and distributing the related materials; and

WHEREAS, Assignees desire to use the Trademark in connection with a new radio program that they are producing independently from the LCMS and KFUE-AM; and

WHEREAS, the Parties now desire to have the LCMS assign all of its right, title and interest in and to the Trademark to the Assignees, subject to a license back to the LCMS to continue using the LCMS Archived Materials, in accordance with the terms and conditions of this Agreement.

NOW, THEREFORE, in consideration of the foregoing premises, the mutual promises, covenants and conditions herein contained, and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Parties agree as follows.

### 1. ASSIGNMENT

(a) Assignment. Subject to Sections 2 and 3 of this Agreement, the LCMS hereby assigns to Assignees all of its right, title and interest in and to the Trademark, together with the goodwill of the business associated with and symbolized by the Trademark, and all causes of actions, claims, demands or other rights in respect of any

infringement or other violation of rights, including, without limitation, any past infringement or other violation of rights, with respect to the Trademark ("Assignment").

(b) Further Documents. The LCMS agrees to execute any further documents that Assignees may reasonably request to fully effectuate this Assignment, at Assignees' expense.

(c) No Warranties. The Assignment is made by the LCMS on an "AS IS" basis. NOTHING IN THIS AGREEMENT SHALL BE DEEMED TO BE A REPRESENTATION OR WARRANTY BY LCMS WITH RESPECT TO THE OWNERSHIP, VALIDITY OR ENFORCEABILITY OF THE TRADEMARK. LCMS SHALL HAVE NO LIABILITY WHATSOEVER TO ASSIGNEES FOR OR ON ACCOUNT OF ANY LOSS OR DAMAGE, OF ANY KIND OR NATURE, SUSTAINED BY, OR ANY DAMAGE ASSESSED OR ASSERTED AGAINST, OR ANY OTHER LIABILITY INCURRED BY OR IMPOSED ON ASSIGNEES, ARISING OUT OF OR IN CONNECTION WITH OR RESULTING FROM ASSIGNEES' USE OF THE TRADEMARK, INCLUDING WITHOUT LIMITATION ANY LOSS OR DAMAGE ARISING OUT OF THIRD PARTY INFRINGEMENT CLAIMS.

## 2. OWNERSHIP/USE OF THE LCMS ARCHIVED MATERIALS

(a) Ownership of the LCMS Archived Materials. Notwithstanding the Assignment, the LCMS shall retain ownership and possession of the LCMS Archived Materials.

(b) License. Assignees hereby grant to the LCMS a perpetual, royalty-free, exclusive (except as set forth in Section 4 of this Agreement), worldwide license to use the Trademark in association with the LCMS Archived Materials (the "License"). Without limiting the generality of the foregoing, the License includes the right to re-broadcast the archived broadcasts and distribute the LCMS Archived Materials, but does not include the right to produce, distribute or broadcast new programs or new merchandise bearing the Trademark. The License shall be deemed to include the right to grant sublicenses to affiliates of the LCMS that control, are controlled by, or are under common control with the LCMS, as necessary to allow the LCMS to make use of the LCMS Archived Materials as intended by this Agreement.

(c) Quality Control. In order to preserve the reputation and integrity of the licensed Trademark, the LCMS agrees that its use of the Trademark in connection with the LCMS Archived Materials will meet the same standards of quality that were met by the LCMS prior to the Assignment, which Assignees acknowledge is an acceptable level of quality. The LCMS agrees that its use of the Trademark pursuant to the License shall inure to the benefit of Assignees and that the LCMS shall not, at any time, acquire or represent that it has any rights in the Trademark by virtue of any use it may make of the Trademark, other than as contemplated by this Agreement.

### 3. COVENANTS OF ASSIGNEES

(a) Assignees shall cause Harry B. Madsen, an individual residing in Arlington Heights, Illinois ("Madsen") to abandon U.S. Trademark App. No. 77/487,948 for the mark ISSUES, ETC., which was filed with the U.S. Patent and Trademark Office by Madsen on May 31, 2008 (the "Madsen Application").

(b) Assignees shall not use any LCMS trademarks or other intellectual property (including, without limitation, the "LCMS" mark, the "Lutheran Church-Missouri Synod" name, the LCMS Logo Cross and the official "Seal" of the LCMS) in any manner that: (i) suggests an affiliation with the LCMS that does not exist, (ii) suggests that the LCMS endorses or sponsors Assignees or its products/services, or (iii) disparages the LCMS or in any way casts the LCMS or its members in a negative light.

### 4. LIMITED USE OF ARCHIVED MATERIALS BY ASSIGNEES

Assignees shall be permitted to make limited use of copies of archived ISSUES, ETC. broadcasts and materials, provided that all references to the LCMS (including, without limitation, all LCMS trademarks) are deleted/removed before such broadcasts and materials are published or re-broadcast, so as to avoid confusion regarding the source of the publication/re-broadcast or any interpretation that the limited use of the archived ISSUES, ETC. broadcasts and materials by Assignee is sponsored or endorsed by the LCMS.

### 5. TERM

The term of this Agreement (the "Term") shall commence on the Effective Date and shall continue until terminated in accordance with the termination provisions of this Agreement.

### 6. TERMINATION:

(a) Assignees may terminate the License upon one-hundred eighty (180) days' written notice to the LCMS following a material breach of this Agreement by LCMS (the "Notice Period"), unless (i) such material breach is cured within the Notice Period, or (ii) a plan to remedy such material breach is submitted to Assignees in writing within the Notice Period and approved by Assignees (such approval not to be unreasonably withheld) within thirty (30) days of submission (the "Approval Period"). In the event that Assignees do not respond within the Approval Period, their failure to respond shall be deemed an approval.

(b) The LCMS shall have the right to terminate the License upon written notice to Assignees.

(c) The Assignment is conditioned upon Assignees' compliance with Section 3(a) of this Agreement and upon Assignees' continuing compliance with Sections 3(b) and 4

of this Agreement. In the event either of the Assignees, or those acting in coordination with them, materially breach any of the provisions of Sections 3 or 4 of this Agreement, the LCMS may provide written notice of such material breach to Assignees, and the Assignment shall become null and void one-hundred eighty (180) days' following said written notice (the "Notice Period"), except with respect to a material breach of Section 3 (b) of this Agreement in which case the Assignment shall become null and void fifteen (15) days' following said written notice (the "Accelerated Notice Period"), and all rights to the Trademark shall revert to the LCMS, unless (i) such material breach is cured within the Notice Period or Accelerated Notice Period, as the case may be, or (ii) a plan to remedy such material breach is submitted to the LCMS in writing within the Notice Period or Accelerated Notice Period, as the case may be, and approved by the LCMS (such approval not to be unreasonably withheld) within thirty (30) days of submission (the "Approval Period"). In the event that the LCMS does not respond within the Approval Period, its failure to respond shall be deemed an approval.

(d) The rights and remedies of the Parties set forth in this Section 6 are not exclusive of any other right or remedy conferred by this Agreement or otherwise conferred by law or in equity; rather, all of such rights and remedies are cumulative of every other such right or remedy and may be exercised concurrently or separately from time-to-time.

## 7. NOTICES

(a) Any notice required by this Agreement shall be given as follows:

If to LCMS: The Lutheran Church-Missouri Synod  
1333 South Kirkwood Road  
Kirkwood, Missouri 63122  
Attention: Ronald P. Schultz, Chief Administrative Officer

With a copy to:

Sherri C. Strand, Esq.  
Thompson Coburn LLP  
One US Bank Plaza  
St. Louis, Missouri 63101

and

If to Assignees: Rev. Todd Wilken

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and

Mr. Jeff Schwarz

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or to such other person(s) and/or address(s) as the party to be noticed shall hereafter designate to the other party in writing.

(b) All notices or other communications required to be sent to either party shall be in writing and sent by Registered or Certified Mail, postage prepaid, return-receipt requested or by a nationally recognized overnight delivery service, charges prepaid.

## 8. GENERAL

(a) Assignability of Rights. Neither of the Parties may assign or otherwise convey any of the rights or obligations arising under this Agreement without prior written approval from the other of the Parties, which approval shall not be unreasonably withheld, conditioned or delayed; provided, however, that a Party may assign this Agreement to an entity that controls, is controlled by, or is under common control with that Party, or in connection with any merger, acquisition or other corporate reorganization of that Party, upon notice to the other Party. All terms and provisions of this Agreement shall be binding upon, shall inure to the benefit of, and shall be enforceable by the permitted successors and assigns of the Parties.

(b) Independent Contractors. It is agreed and understood that each of the Parties is an independent contractor and not an agent or employee of the other party. Neither of the Parties has a proprietary interest in the other party, and neither of the Parties has an interest in the business of the other party, except to the extent set forth in this Agreement. Nothing in this Agreement shall be construed as creating a partnership between the Parties.

(c) Governing Law. The validity, construction and performance of this Agreement shall be governed by and construed in accordance with the laws of the State of Missouri, without regard to any conflict of laws principles. In any action between the Parties arising out of or relating to this Agreement or any of the transactions contemplated by this Agreement: (i) each party irrevocably and unconditionally consents and submits to the exclusive jurisdiction and venue of each of (A) the state courts located in St. Louis County, Missouri, and (B) the United States District Court for the Eastern District of Missouri, (ii) each party irrevocably consents to service of process by first class certified mail, return receipt requested, postage prepaid, and (iii) each party irrevocably waives any and all rights to a trial by jury in any legal proceeding arising out of or related to this Agreement or the transactions contemplated hereby. The prevailing party in any litigation in connection with this Agreement may recover attorneys' fees and litigation costs incurred in prosecuting or defending such litigation from the nonprevailing party.

(d) Waiver. No waiver by either party of a breach or a default hereunder shall be deemed a waiver by such party of a subsequent breach or default of a like or similar

nature and either party may, within the time provided by applicable law, commence appropriate legal proceedings to enforce any such rights.

(e) Integration and Severability. This Agreement supersedes any and all prior agreements, and it embodies the entire Agreement of the Parties hereto relating to the subject matter hereof. Any changes or modifications to this Agreement shall be in writing, executed by all of the Parties hereto, and any attempt at oral modification of this Agreement, or through writing signed by fewer than all of the Parties, shall be void. If any of the provisions of this Agreement are void or unenforceable, the remaining provisions shall nevertheless be effective, the intent being to effectuate this Agreement to the fullest extent possible.

(f) Execution. This Agreement may be executed in multiple, identical counterparts, each of which shall be deemed an original.

IN WITNESS WHEREOF, the Parties hereto have caused this Agreement to be executed.

**The Lutheran Church-Missouri Synod**  
By:

**Rev. Todd Wilken**

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Printed Name and Title

\_\_\_\_\_  
Date

\_\_\_\_\_  
Date

**Mr. Jeff Schwartz**

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Date