

LICENSE AGREEMENT FOR USE OF CITY-OWNED TRADEMARKS

THIS AGREEMENT, effective this _____ day of _____, _____ (hereinafter "Effective Date") is made by and between the City of Lee's Summit, Missouri, a municipal corporation organized and existing under the laws of the State of Missouri, (hereinafter "City") and _____ (hereinafter "Licensee.")

WHEREAS, City is the exclusive owner of the trademark shown in Exhibit A, attached hereto, as used in connection with the goods and services listed in Exhibit B, attached hereto, which are duly registered with the U.S. Patent and Trademark Office (USPTO) (hereinafter "the Mark;") and

WHEREAS, Licensee desires a license to use the City's trademark and related designs in connection with the products listed in Exhibit B attached hereto; and

WHEREAS, Licensee recognizes and understands that the value, reputation, and goodwill of the Mark is dependent upon the high quality standards established and prescribed for use by the City; and

WHEREAS, Licensee desires to comply with the City's quality control standards in order to preserve the reputation and goodwill of the Marks and the goods and services to which they are affixed.

NOW, THEREFORE, for and in consideration of the mutual covenants and undertakings hereinafter set forth, and other good and valuable consideration, it is agreed as follows:

1. Grant of License. Subject to the terms and conditions set forth in this Agreement, the City hereby grants to Licensee the non-exclusive right and license to use the Marks in connection with [describe proposed use of the Mark.]

2. Assignment Prohibited, Exception – Sub-Licensing/Use Agreements. Licensee's rights under this Agreement to use the Mark shall not be assigned to any third party by the Licensee without the prior written approval of the City. Attempted assignment by the Licensee may, at the sole discretion of the City, be sufficient cause for termination of this Agreement; **OR**

Licensee shall have the right to sub-license the rights granted to Licensee for use of the Marks under the following conditions [insert conditions of Sub-Assignment or Licensure of the Mark.]

3. Covenant Against Challenge. Licensee is hereby prohibited from challenging in any way the validity of the licensed Marks, including its registration or ownership by the City.

4. Best Marketing Efforts. Licensee shall exert its best efforts to advertise, promote and sell products and services using the Mark in a manner that will maintain and enhance the value of the goodwill residing in the Mark, and in doing so will adhere to the Graphic Brand Standards as established by the City, attached hereto as Exhibit C.

All goodwill arising from Licensee's use of the Marks shall inure solely to the benefit of the City. Licensee shall not take any action that could be detrimental to the goodwill associated with the Marks or with the City during the term of this Agreement or after termination of this Agreement.

5. Trademark Usage. Licensee hereby acknowledges the City's right and title to the Mark licensed herein. In consideration of permitting Licensee to use the City's Mark, Licensee hereby agrees not to claim title to the Mark and to use the Mark only as permitted by this Agreement.

Licensee shall prominently display the licensed Mark in accordance with the written instructions and guidelines proscribed by the City, as more clearly defined in the Graphic Brand Standards, attached hereto as Exhibit C. Licensee shall use the registration symbol ® and other registration notices correctly. Licensee shall also display all notices and legends with respect to the Mark as are requested by the City during the term of this Agreement.

Licensee shall not adopt or use, without the City's prior written consent, which said consent shall not be unreasonably withheld, any variation of the Mark including any Mark similar to or confusing with the Mark. If the City consents to any variation of the Mark, Licensee hereby agrees that the City shall own such new Mark and shall at the City's cost and expense obtain, in the City's name, all United States and international trademark registrations. Licensee shall provide the City with reasonable assistance in filing such application for trademark registration.

Licensee shall during the term of this Agreement and after termination thereof, execute such documents as the City may request from time to time to ensure that all right, title, and interest in and to the Mark reside with the City.

The terms and conditions of this Paragraph 5 shall survive any termination of this Agreement.

6. Quality Control. Prior to use of the Mark, Licensee shall furnish to the City for its written approval copies of the version of the advertising and promotional materials to be displayed, disseminated or otherwise utilized (hereinafter "Sample" or "Samples.")

Licensee shall maintain the quality standards as requested from time to time by the City and shall promptly make any changes in quality control required by the City. In order that quality standards continue to be maintained, Licensee shall implement all written specifications relating to the use of the Mark and will attend periodic conferences with City staff as designated by the Assistant City Manager or his or her designee regarding the use of the Mark as required or requested by the City.

Licensee shall promptly inform the City of any potential trademark dispute or infringement and shall furnish to the City a detailed report describing the dispute or infringement. The City, at its sole discretion, shall determine whether there has been an infringement and whether to pursue legal action. The City may, at its sole discretion, intervene in any legal actions against Licensee.

Licensee shall, at its sole expense, comply with all applicable federal and state laws and regulations relating to the use of the Mark.

7. Royalty Free. This Agreement is and shall remain, unless agreed to in writing by the City and the Licensee, Royalty Free, meaning no payment need be made from Licensee to the City for use of the Marks.

8. Term of License. This Agreement and the licenses granted hereunder shall commence from the date of this Agreement and shall remain in effect for a term of _____ years, or until the City terminates this license as set forth in this this Agreement.

9. Termination. The City may terminate this Agreement upon prior written notice of Licensee's breach or default under this Agreement, and unless such breach or default is cured within sixty (60) days after delivery of such notice of the breach or default, the City may terminate this Agreement forthwith by delivery of a written notice of termination at any time thereafter before such breach or default has been cured.

Upon termination of this Agreement, all rights of Licensee under the licenses granted herein shall terminate and revert to the City, and Licensee shall immediately cease use of the Marks. Licensee hereby acknowledges that failure to cease use of the Marks shall result in immediate and irreparable damage to the City.

10. Relationship of the Parties. The relationship of the City and Licensee are separate and distinct. It is clearly understood that the City and Licensee will act in its individual capacity and not as an agent, employee, partner, joint venturer, or associate of the other.

11. Notices. All notices regarding this Agreement shall be in writing shall be deemed delivered on the earlier date (1) if sent by e-mail or delivery when actually received and acknowledged; or (2) five (5) days after mailing by certified or registered mail, return receipt requested. Following are the addresses to which notice shall be provided:

If to City:

City of Lee's Summit
Attn: Assistant City Manager, Development Services & Communications
220 SE Green Street
Lee's Summit, Missouri 64063

If to Licensee:

12. Choice of Law. This Agreement shall be governed by the laws of the State of Missouri applicable to contracts deemed to be made within such state, without regard to choice of law or conflict of law provisions. Furthermore, the parties hereby agree that any action or proceeding arising out of or relating to this Agreement shall be instituted in a federal or state court located in Jackson County, Missouri, and the parties hereby irrevocably submit to the jurisdiction of such court and waive any objection to the venue or the inconvenience of such forum.

13. Indemnification of City. Licensee shall defend and indemnify the City and hold the City harmless from any and all claims, liabilities, damages, injuries, including personal and advertising injury, fines,

judgments, and reasonable attorneys' fees and related expenses arising out or resulting from (i) Licensee's use of the Mark and/or (ii) Licensee's performance under the Agreement. The provisions of this Section shall survive the termination of this Agreement.

Licensee shall promptly notify the City in writing upon receipt of notice of any claim arising out of this Agreement, providing full details thereof, including an estimate of the amount of loss or liability.

14. Insurance. Licensee shall maintain, at its sole expense, the following minimum insurance coverage before the comment, and throughout the term, of this Agreement:

- a. **INDUSTRY RATING:** The City will only accept coverage from an insurance carrier who offers proof that it is licensed to do business in the State of Missouri; carries a Best's policyholder rating of "A" or better; carries at least a Class VII financial rating or is a company mutually agreed upon by the City and Licensee.
- b. **PRIMARY INSURANCE:** The insurance required herein must be, or endorsed to be, primary insurance policies and any insurance policy maintained by the City is considered excess insurance. The existence of excess insurance policies should in no way be construed to limit the requirements of insurance described herein.
- c. **EVIDENCE OF INSURANCE:** Before the commencement of this Agreement, Licensee shall provide the City with suitable evidence of insurance in the form of certificates of insurance and a copy of the endorsements as required by this Agreement, issued by Licensee's insurance as evidence that policies are placed with acceptable insurers as specified herein and provide the required coverages, conditions and limits of coverage specified in this Agreement and that such coverage and provisions are in full force and effect. The City shall reasonably rely upon the certificates of insurance and declaration page(s) of the insurance policies as evidence of coverage but such acceptance and reliance shall not waive or alter in any way the insurance requirements or obligations of this Agreement. Failure to provide required coverage and failure to comply with the terms and conditions of this Agreement shall not waive the contractual obligations herein. Moreover, failure to provide evidence of required insurance as set forth below shall delay authorization to participate in the event. All certificates of insurance and declarations required by this Agreement shall be identified by referencing the event title and date, and this Agreement. All policies and forms must be satisfactory to the City.

Certificates of insurance and declaration page(s) shall specifically include the following provisions:

- (1) The City, its agents, representatives, officers, directors, officials and employees are Additional Insureds as follows:
 - (a) Commercial General Liability – Under Insurance Services Office, Inc., ("ISO") Form CG 20 10 03 97, or its equivalent.
 - (b) Excess Liability – Follow Form to underlying insurance.
- (2) Consultant's insurance shall be primary, non-contributory insurance with respect to performance of the Agreement.
- (3) All policies waive rights of recovery (subrogation) against City, its agents, representatives, officers, officials and employees for any claims arising out of work or services performed by Consultant under this Agreement.
- (4) ACORD certificate of insurance form 25 (2014/01) is preferred.

The Certificate Holder must be named as follows: **City of Lee's Summit, Missouri**

All certificates are to be sent to: City of Lee's Summit,

Attn: Director of Creative Services

220 SE Green St

Lee's Summit, MO 64063

- d. **COMMERCIAL GENERAL LIABILITY POLICY:** Licensee shall, at its sole expense, procure and maintain "occurrence" form Commercial General Liability insurance with an unimpaired limit of not less than \$1,000,000 for each occurrence, \$2,000,000 Products and Completed Operations Annual Aggregate and a \$2,000,000 General Aggregate Limit. The policy shall cover liability arising from premises, operations, independent contractors, products-completed operations, bodily injury, personal injury and advertising injury. Coverage under the policy will be at least as broad as ISO policy form CG 00 01 93 or equivalent thereof, including but not limited to, separation of insured's clause. The City, its agents, representatives, officers, officials and employees shall be endorsed as an Additional Insured under ISO, Commercial General Liability Additional Insured Endorsement form CG 20 10 03 97, or its equivalent. The policy shall also include an endorsed waiver of subrogation in favor of the City and the City's employees, directors, officials, officers, agents, and volunteers. If any Excess insurance is utilized to fulfill the requirements of this subsection, such Excess insurance shall be "follow form" equal or broader in coverage scope than underlying insurance.
- e. **CANCELLATION AND EXPIRATION NOTICE.** Insurance required herein shall not expire, be canceled, or be materially changed without thirty (30) days' prior written notice to the City.

15. Acknowledgement and Execution. Each party has read this Agreement in its entirety and understands its terms and consequences. Each of the undersigned hereby represents that he or she has the authority to enter into this Agreement.

16. Entire Agreement. This Agreement constitutes the entire agreement between the parties with respect to its subject matter, and any prior agreements, understandings, or other matters, whether oral or written, are of no further force or effect. This Agreement may be amended, changed, or supplemented only by written agreement executed by both of the parties hereto.

IN WITNESS WHEREOF, the parties hereto have executed this Agreement as of the Effective Date.

CITY OF LEE'S SUMMIT, MISSOURI

[INSERT NAME OF LICENSEE]

Stephen A. Arbo, City Manager

[INSERT SIGNER NAME AND TITLE]

Attest

Trisha Fowler Arcuri, City Clerk

Approved as to Form

Office of the City Attorney

