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CITY OF PORTLAND
INTELLECTUAL PROPERTY LICENSE AGREEMENT
FOR USE OF THE PORTLAND OREGON SIGN

Subject to the terms and conditions of this **INTELLECTUAL PROPERTY LICENSE AGREEMENT** (“Agreement”), the City of Portland, Oregon (the “City”) hereby grants a license to the Licensee (defined below in the Definitions section) to use the intellectual property identified in Exhibit A (“Licensed Intellectual Property”), according to the terms and conditions below. The City and the Licensee may be referred to herein singularly as a “Party,” or collectively as “Parties.”

WHEREAS the Licensee wishes to use the Licensed Intellectual Property depicted in Exhibit A;

WHEREAS the City owns intellectual property rights, including at least state and federal trademark rights and a U.S. federal copyright registration, in the “Portland, Oregon” sign depicted in Exhibit B;

WHEREAS, the City desires to promote a positive image of the City through use of the “Portland, Oregon” sign and variations thereof, and to promote goodwill for the general benefit of the City; and

WHEREAS, the City has been asked by the Licensee to authorize use of the Licensed Intellectual Property;

NOW, THEREFORE, for good and valuable consideration, the sufficiency of which has been acknowledged by the Parties, the Parties agree as follows:

(1) Definitions:

- “City” means the City of Portland, Oregon.
- “Derivatives” means any variations or derivatives of the contents of Exhibit A to this Agreement.
- “Licensed Intellectual Property” means the contents of Exhibit A to this Agreement, along with any other state and federal copyright and trademark registrations and common law rights owned by the City and pertaining to the City’s iconic “Portland, Oregon” sign depicted in Exhibit B.
- “Licensee” means Enter Company Name here
- “License Fee” means the annual fee due from Licensee to the City, calculated as follows:
 - Licensee category: Small Business, Corporation, Non-Profit, Government, Etc.
 - Base fee: \$
 - Oregon corporation discount: 20%
 - License Fee: \$
- “Licensed Goods and Services” means

- “Licensed Use” means Licensee’s use of the Licensed Intellectual Property in connection with the Licensed Goods and Services and any associated promotion and advertising, only to the extent that the City has preapproved Licensee’s use of the Licensed Intellectual Property pursuant to this Agreement.
- “Term” means the term during which this Agreement is in effect, which shall be as follows:

from _____ to _____ .

(2) License:

Upon execution of this Agreement, the City grants to the Licensee a non-exclusive, non-transferrable, non-sublicensable license (the “License”) to use the Licensed Intellectual Property and to make and use certain derivative works of the Licensed Intellectual Property for only the Licensed Use described in this Agreement. The License shall extend throughout the United States for the duration of the Term, subject to the remaining terms and conditions of this Agreement. Except as set forth in this Agreement, the City is not granting any rights to produce any items for sale or merchandise that incorporates any Licensed Intellectual Property, other than the Licensed Use.

Licensee agrees not to grant any license or sublicense of the Licensed Intellectual Property and shall not otherwise assign or transfer any rights granted by the City pursuant to this Agreement. It is understood by the Parties that the manufacture of any licensed product embodying the Licensed Use may be performed by a third party manufacturer designated by the Licensee and acceptable to the City, but that the third party manufacturer shall not gain any rights in the Licensed Intellectual Property, including in the “Portland, Oregon” sign.

Licensee in return grants to the City, a non-exclusive, royalty free, limited right to use and display the Licensed Intellectual Property in City business, to the extent the Licensed Intellectual Property includes any proprietary elements owned by Licensee and requiring such a license.

(3) Intellectual Property Ownership:

The City owns and retains all rights, title and interest in and to the Licensed Intellectual Property (including in the “Portland, Oregon” sign), and has the right to control all uses, images and derivative works of, based upon, or confusingly similar to the Licensed Intellectual Property. This Agreement does not confer any ownership rights in the Licensed Intellectual Property to Licensee or any third party.

(4) License Payment:

In consideration for the License, Licensee shall pay to the City an annual fee in the amount of the License Fee set forth in the Definitions section above. The License Fee may be paid by check payable to:

City of Portland
 Bureau of Internal Business Services
 Re: Portland, Oregon sign
 1120 SW 5th Ave Room 1250
 Portland, Or 97204

Please include “Portland, Oregon sign” in the notes section. Any alternative method of payment must be approved by the Bureau of Internal Business Services.

Licensee may choose to designate its license payment as a donation to offset the maintenance and support of the Portland, Oregon sign, and designation as a donation may provide the Licensee with a tax benefit, which the Licensee should determine with assistance from a tax professional. Additional information about designating a License Fee as a donation is provided in Exhibit C.

Failure to pay the required License Fee within thirty (30) calendar days of the City’s invoice will nullify this Agreement, and the City shall have the right to enjoin immediately Licensee’s use of the Licensed Intellectual Property.

SAMPLE

(5) Licensed Use:

- a) Licensee is authorized to use the Licensed Intellectual Property in connection with the Licensed Goods and Services set forth in the Definitions section above and any associated promotion and advertising, only to the extent that the City has preapproved use of the Licensed Intellectual Property pursuant to this Section (“the Licensed Use”).
- b) Licensee shall not adopt or use, without the City’s preapproval pursuant to this Section, any variations or derivatives of the Licensed Intellectual Property (collectively “Derivatives”). Upon such approval by the City, the approved Derivatives shall be included as part of the Licensed Intellectual Property and subject to the same terms and conditions, except as noted below.
- c) To the extent any Derivatives are used as the Licensee’s primary mark, Licensee agrees to include a small image of the exact mark depicted in Exhibit B in connection with the Licensed Use, along with adjacent attribution language, as shown in Exhibit D. Licensee also agrees to use the Licensed Intellectual Property only in the form and manner, and with appropriate legends (e.g., TM or ®), as prescribed and approved by the City. Suggested guidelines are set forth in Exhibit D. The purpose of these guidelines is to help guide the Licensee on proper usage of the form and manner of Licensed Intellectual Property, but following these guidelines does not constitute an approval of use by the City. Licensee must still follow the approval of use process for the Licensed Intellectual Property and the Licensed Use, as set forth below in this Section.
- d) Licensee agrees that the nature and quality of the Licensed Use shall conform to standards prescribed by the City, and that Licensee will not depart from such prescribed standards without the City’s advance written permission. Prior to use, the City must review and provide written approval of final designs and materials specifications supplied by Licensee for any such materials to be produced, marketed, sold, or given away by Licensee in connection with the Licensed Use. City shall not be held accountable for any design, production, or marketing cost involved with this Agreement. Licensee shall provide the City with the opportunity to inspect, approve (or disapprove) and control all proposed uses of the Licensed Intellectual Property before such use of the Licensed Intellectual Property is made public (e.g., released or sold to the public). The City has the right to reject any particular use of the Licensed Intellectual Property or Licensed Use as improper or below the City’s quality standards, at the City’s sole discretion.
- e) Licensee shall provide to the City (a) samples of the Licensed Use and (b) samples of any other proposed use of the Licensed Intellectual Property, including on advertising, packaging, etc., for approval by the City before any such use of the Licensed Intellectual Property is made public. The Licensed Intellectual Property shall only be used in connection with the Licensed Use after approval by City. Licensee may not alter approved designs for the Licensed Use without the express written approval of the City. The Licensed Use that is made public shall conform to the quality levels specified by City and be in conformity with the representative samples approved by the City. Any samples attached to this Agreement in Exhibit E are hereby approved by the City for use by Licensee, but the City’s authorization extends only to the use(s) depicted in Exhibit E and other uses preapproved by the City in writing.

(6) Goodwill in Licensed Marks:

Licensee agrees that all goodwill generated from the Licensed Use shall inure to the benefit of the City. Licensee agrees that the essence of this License Agreement is founded on the goodwill associated with the “Portland, Oregon” sign and the value of that goodwill in the minds of the citizens of the City of Portland and elsewhere. Licensee agrees that it is critical that such goodwill be protected and enhanced and, towards this end, Licensee shall not during the Term or thereafter:

- (a) Apply to register or maintain any copyright or trademark application or registration of the Licensed Intellectual Property (modified or otherwise) or any other mark confusingly similar to the “Portland, Oregon” sign;
- (b) Challenge the validity of any of the intellectual property rights covering the “Portland, Oregon” sign or the ownership thereof by the City;

- (c) Use any colorable imitation of any of the “Portland, Oregon” sign, or any variant form (including variant design forms, logos, colors, or type styles) of the “Portland, Oregon” sign not specifically approved by City;
- (d) Misuse the “Portland, Oregon” sign, the Licensed Intellectual Property, or variations thereof;
- (e) Take any action that would bring the City or its intellectual property into public disrepute;
- (f) Take any action that would tend to destroy or diminish the goodwill in the “Portland, Oregon” sign or the Licensed Intellectual Property; or
- (g) Use the Licensed Intellectual Property for any purpose that is unlawful, prohibited by or outside the terms of this Agreement.

(7) Right to Inspect by the City. After the initial approval by the City, the City shall have the right to inspect periodically samples of the Licensed Use, to ensure that the Licensed Use remains of a proper quality. The City shall have the right at all reasonable times during the Term of this Agreement to inspect the Licensee’s marketing products, materials, marketing plans or proposals, and any and all related materials for the purposes of confirming the Licensee’s use of the Licensed Intellectual Property is in conformity with the standards of quality outlined in this Agreement. If through such inspection the City determines that the Licensed Use fails to conform or no longer conforms to the City’s quality standards, then the City will describe the nonconformity to Licensee. In any notice disapproving the quality of the Licensed Use, the City shall provide the reasons for disapproval, which shall be based on reasonable criteria consistent with industry practices. Licensee shall correct or restore such quality within thirty (30) calendar days of being notified of such nonconformity. Failure to reach or restore acceptable quality by the deadline (or another deadline mutually agreed upon) shall immediately grant the City the right to terminate the Agreement, and Licensee shall immediately cease selling and recall any such nonconforming Licensed Use.

(8) The Parties agree to comply with all applicable government regulations. Licensee shall be responsible for, and bear all costs of, obtaining any necessary governmental approval needed in connection with the Licensed Use.

(9) The City expressly does NOT warrant the Licensee’s freedom to make, use or sell items embodying the Licensed Intellectual Property with respect to third party intellectual property rights, and does NOT indemnify the licensee against third party claims of any type, including but not limited to claims of product liability, trademark infringement or copyright infringement, based on Licensee’s manufacture, use or sale of the Licensed Intellectual Property and the Licensed Use. Licensee accepts the risk of possible liability to third parties that Licensee incurs by virtue of the Licensed Use.

(10) The City shall not be liable for the quality of the Licensed Use or any complaint issued from consumers. The City shall forward any complaint it receives regarding the Licensed Use to Licensee. Licensee shall hold harmless the City, and the City’s officials, employees, agents, and representatives, from and against all liabilities, claims, actions, demands of liability, suits, and other proceedings, and any losses, damages, sanctions, fines, expenses, costs (including reasonable attorney fees or disbursements), and judgments (collectively “Claims”) that are or may be raised by any third party in connection with the manufacture, use, sale, or condition of the Licensed Use and the Licensed Intellectual Property (including the “Portland, Oregon” sign), or related products produced by Licensee, including Claims related to infringement of third party intellectual property rights (including trademark and copyright infringement), industrial rights, bodily injury, product liability, environmental, and human rights. This provision shall be valid and enforceable regardless of whether or not Licensee is in compliance with any quality requirements of this Agreement.

(11) The City’s grant of this License does not imply endorsement of any products, materials or any content embodying the Licensed Intellectual Property.

(12) Confidentiality: Licensee acknowledges that this Agreement may be subject to public disclosure under Oregon Public Records law. The City acknowledges that all trade secret information relating to the business and operations of Licensee which it learns or has learned during or prior to the term of this Agreement are exempt under Oregon Public Records laws. The City acknowledges the need to abide by the Oregon trade secrets laws and preserve the confidentiality of such information and agrees that during the term of this Agreement, it shall not disclose the same unless required by law.

(13) The City shall have all legal remedies available for any unauthorized, unlicensed use of the Licensed Intellectual Property.

(14) Term, Termination and Breach:

- a) Term. This Agreement is during the Term defined above in the Definitions section. At any time prior to the end of the Term, the City and Licensee may agree to renew this Agreement via a written addendum, signed by the City and Licensee. Licensee has 120 days, calculated starting from the first day after the Term concludes, to liquidate any remaining stock of the Licensed Use bearing the Licensed Intellectual Property. Licensee thereafter agrees not to use any mark which is substantially similar to the "Portland, Oregon" sign or any confusingly similar variation thereof.
- b) Breach. In the event of a breach by either Party, the non-breaching Party must provide written notice of the breach. If the breach is not cured within thirty (30) calendar days of receiving notice, the non-breaching Party may at its option pursue an action for specific performance or damages, and/or may immediately terminate this Agreement by providing written notice of termination.
- c) Termination. The License shall expire immediately upon termination of this Agreement, regardless of the reason for termination. Sections (6), (9) and (10) shall survive termination.

(15) Miscellaneous Provisions

- a) Mutual Representation. Each Party represents to the other Party that it has the full power and authority to enter into this Agreement, and that doing so does not conflict with any other agreement or obligation.
- b) Entire Agreement and Amendment. This Agreement supersedes all other agreements and understandings among the Parties, either oral or written and either express or implied, and constitutes the entire agreement of the Parties with respect to subject matter of this Agreement. The Parties may amend, modify, and/or alter any or all of the provisions of this Agreement, including adding new provisions, but only by a written instrument executed by both Parties.
- c) Successors. All terms and provisions of this Agreement shall be binding upon, inure to the benefit of, and be enforceable by the successors and assigns of each Party.
- d) No Waiver. Failure by either Party to enforce any provision of this Agreement shall not be deemed a waiver of future enforcement of that or any other provision.
- e) Severability. If any provision of this agreement is held to be unenforceable, then that provision is to be construed either by modifying it to the minimum extent necessary to make it enforceable (if permitted by law) or disregarding it (if not). If an unenforceable provision is modified or disregarded, the rest of the Agreement shall remain in effect.
- f) Notices. Any notice required under this Agreement shall be sent to the addresses specified by the Parties in the signature block below.
- g) Relationship of the Parties. The Parties hereto are independent contractors, and no Party is an employee, agent, partner, or joint venturer of the other Parties. Neither Party shall have the right to bind the other Party, whether directly or indirectly, to any agreement with a third party or to incur any obligation or liability on behalf of such other Party, whether directly or indirectly.
- h) Disputes. The laws of the state of Oregon, without giving effect to its principles of conflicts of law, govern all adversarial proceedings arising out of this agreement. Each Party consents to personal jurisdiction and exclusive venue in a state or federal court located in Portland, Oregon. If any legal or administrative proceeding arises out of this agreement, the prevailing Party will be entitled to recover, in addition to costs, reasonable attorney fees incurred as a result of the proceeding.

- i) Force Majeure. Neither Party shall be liable for any failure or delay in the performance or obligation hereunder on account of strikes, riots, fires, explosions, acts of God, war, governmental action, or any other cause which is beyond the reasonable control of such Party.
- j) Counterparts. This Agreement may be executed in multiple counterparts and by facsimile and/or by email, and all executed counterparts together shall constitute the original instrument. Faxed or emailed signatures shall be binding.

IN WITNESS WHEREOF, the City and the Licensee have executed this Intellectual Property License Agreement.

LICENSEE:

CITY: Office of Management and Finance/ Bureau of Internal Business Services

Authorized Signer

Tawnya Harris, Program Coordinator

Date

Date

Notice Information for Licensee

Notice Information for City:

Address Information

Bureau of Internal Business Services

Address: 1120 SW 5th Ave

ROOM 1250

Portland, OR 97204

Attn: Tawnya Harris, Program Coordinator

Email:

Email: PDXSign@portlandoregon.gov

Phone:

Telephone: 503-823-5073

Approved as to form:

Office of the City Attorney