

WEST VIRGINIA UNIVERSITY TRADEMARK LICENSE AGREEMENT

THIS AGREEMENT is made by and between the West Virginia University Board of Governors on behalf of West Virginia University, a state research and land-grant institution organized under the laws of the State of West Virginia (WVU), and the West Virginia University at Parkersburg Board of Governors on behalf of West Virginia University at Parkersburg (PARKERSBURG).

WHEREAS, WVU is the owner of all right, title and interest in and to certain valuable designations comprising designs, trade names, trademarks, and service marks (hereinafter called "Indicia"), which have come to be associated in the public mind with WVU;

WHEREAS, PARKERSBURG, acknowledging that the Indicia are and shall be associated with WVU's good will in the public mind, and acknowledging WVU's rights thereto, desires a non-exclusive license to use the Indicia in connection with PARKERSBURG's services as an institution of higher education;

NOW, THEREFORE, in consideration of the mutual promises, covenants and conditions contained herein and other good and valuable consideration, it is hereby agreed as follows:

1. GRANT

- a) Upon the terms and conditions hereinafter set forth, WVU hereby grants to PARKERSBURG and PARKERSBURG hereby accepts a limited, non-exclusive, non-assignable license to use the Indicia solely on and in association with its service as an institution of higher education.
- b) This License Agreement shall inure to the benefit of WVU, its successors and assigns, but will be personal to PARKERSBURG and shall not be assigned by PARKERSBURG or by operation of law. PARKERSBURG shall have no right to grant any sub-license without WVU's prior written approval. Any attempt by PARKERSBURG to arrange for production of licensed products by a third party or to sub-license or assign to third parties the rights granted hereunder shall constitute a material breach of this License Agreement resulting in the immediate termination of this agreement pursuant to Paragraph 6 below.
- c) All rights not specifically granted to PARKERSBURG under this License Agreement are hereby reserved to WVU.

2. TERM

The effective date of this License Agreement shall be the date of signing and continue until terminated pursuant to Paragraph 6 hereof.

3. OWNERSHIP OF RIGHTS

- a) PARKERSBURG understands and agrees that it is an essential condition of the validity of this License Agreement and of the validity of the Indicia identified in this License Agreement, as well as being an essential condition for the protection of the high reputation enjoyed by WVU, that any use of the Indicia be of high and consistent quality subject to the on-going approval and continuing supervision and control of WVU. Any use of the Indicia by PARKERSBURG must be submitted to WVU's Office of Trademark Licensing Services prior to such use in the market, pursuant to the terms of this Agreement.
- b) Any and all production of licensed products bearing the Indicia must be prepared by official WVU licensee or with the approval of WVU's Office of Trademark Licensing Services.
- c) PARKERSBURG recognizes the value of the goodwill associated with the Indicia and acknowledges that the Indicia and all rights therein and the goodwill pertaining thereto, belong exclusively to WVU.
- d) PARKERSBURG acknowledges and agrees that WVU is the sole and exclusive owner of all rights, title, and interest in and to the Indicia. Nothing contained herein shall be construed as an assignment to PARKERSBURG of any rights, title or interest in the Indicia. PARKERSBURG shall not represent that it has any ownership in the Indicia or in any registration of the same, and will not knowingly do or cause to be done any act or thing contesting or impairing any part of such right, title and interest.
- e) PARKERSBURG shall not, during the term of this Agreement and thereafter, contest or otherwise challenge or attack WVU's rights in the Indicia or the validity of the license being granted herein and agrees to execute assignments or other documents necessary to perfect WVU's rights hereunder.
- f) PARKERSBURG agrees that its use of the Indicia inures to the benefit of WVU and agrees not to register or attempt to register, in any jurisdiction, any of the Indicia or designations colorably similar.
- g) PARKERSBURG may use the Indicia in advertising as needed; however, any such use must be approved, in advance, by WVU's Trademark Licensing Unit pursuant to this Agreement. WVU reserves the right to disapprove any use and PARKERSBURG agrees to discontinue or cancel same at WVU's request.

- h) The form and content of all artwork used by PARKERSBURG is subject to prior written approval by WVU. All artwork, designs, seals, symbols, marks or logo graphics containing or comprising Indicia shall, notwithstanding their creation, development or use by PARKERSBURG, be and remain the property of WVU. All intellectual property rights in such works, including all copyright and trademark rights, are by this License Agreement assigned to WVU and shall be owned solely and for all purposes by WVU. PARKERSBURG represents and warrants that all work on art performed under this License Agreement containing or comprising WVU's Indicia shall be performed by PARKERSBURG's employees or independent contractors under the direct control of PARKERSBURG.
- i) All artwork containing or comprising the Indicia therefore may, in WVU's sole discretion be registered in the U.S. Copyright Office or in the U.S. Patent and Trademark Office, as appropriate, in the name of WVU or, if already registered in the name of PARKERSBURG, assigned to WVU. To that end, PARKERSBURG agrees to and does assign to WVU all right, title and interest in such artwork, and in all intellectual property rights in them, and agrees that WVU may register, at WVU's expense, the assignment in the U.S. Copyright Office or the U.S. Patent and Trademark Office, as appropriate, in the name of WVU. PARKERSBURG agrees that it will not, at any time, assert any right in any such copyright or trademark registered or assigned to the University. Further, to the maximum extent permitted by law, PARKERSBURG waives any moral rights, including the rights of integrity and paternity, that exist now or that may be created in the future with regard to such artwork or the Indicia.

4. USE OF INDICIA

- a) Indicia which PARKERSBURG is allowed to use upon approval pursuant to this agreement shall be:
 - a. The words "West Virginia University"*
 - b. The West Virginia University Flying "WV"*
 - c. The West Virginia University Mountaineer graphic*
 - d. The initials "WVU"*
 - e. The word "Mountaineers"

(* Denotes federally registered trademark and should be accompanied by ® trademark designation. All other trademarks should be accompanied by the ™ trademark designation.)

- b) PARKERSBURG agrees that it will not alter, modify, dilute or otherwise misuse the Indicia, or bring them into disrepute.

- c) All use of the Indicia shall bear the appropriate legends, markings and notices as required by WVU. These marks may include, but shall not be limited to, the ® to serve notice of WVU's Indicia that are registered in the U.S. Patent and Trademark Office or the TM for unregistered marks owned by WVU.
- d) For the term of this Agreement, PARKERSBURG shall be permitted, if previously approved by WVU, to associate the Indicia with indicia specifically created by or for PARKERSBURG, including but not limited to a different name/designation meant to represent PARKERSBURG, a stylized graphic meant to represent PARKERSBURG and/or a mascot meant to represent PARKERSBURG. PARKERSBURG agrees not to use any other third party trademark, service mark, trade name, logo, symbol or device in combination with the Indicia, without the prior written consent of WVU.
- e) The official colors of West Virginia University are Blue – PMS 295 and Gold PMS 124.

5. INFRINGEMENTS

- a) PARKERSBURG shall notify WVU in writing of any infringements, protection or registration deficiencies, or limitations by third parties of the Indicia which may come to PARKERSBURG's attention. WVU shall have the sole right to determine what type of action shall be taken. WVU shall be under no obligation to disclose to PARKERSBURG the nature of any settlement or other action made with regard to the same.
- b) PARKERSBURG agrees not to contact the third party, not to make any demands or claims, not to institute any suit nor take any other action on account of such infringements without first obtaining the express written permission of WVU. All costs and expenses, including attorney's fees, incurred in connection with any suit instituted by PARKERSBURG without the consent of WVU shall be borne solely by PARKERSBURG.
- c) WVU shall have the sole right to employ counsel of its choosing in any infringement action and to direct the handling of the litigation and any settlement thereof. PARKERSBURG shall be entitled to receive and retain all amounts awarded.
- d) PARKERSBURG undertakes and agrees to provide, at a reasonable cost to be borne by WVU, any evidence, documents and testimony concerning the use by PARKERSBURG of any of the Indicia which may be requested by WVU to assist in the filing, institution, prosecution, settlement or appeal of any action or potential action or lawsuit, in any court or any state or federal agency, against any third party arising out of any infringement or unfair competition in relation to any of WVU's Indicia or in the defense by WVU of any action against WVU by

any third party arising out of the use of any of WVU's Indicia. In addition, shall join as a party plaintiff or defendant with WVU at WVU's request.

6. TERMINATION

- a) The effective date of this Agreement shall be the date of signing and shall remain in full force and effect unless otherwise terminated as follows:
1. by mutual agreement;
 2. by either institution upon at least one (1) year written notice to the other institution;
 3. by operation of law; or
 4. by WVU upon written notice to PARKERSBURG, if PARKERSBURG:
 - i. produces, promotes, distributes, sells, or otherwise uses the Indicia without having the prior written approval of WVU as provided in this License Agreement, or continues to produce, promote, distribute, sell or otherwise use the Indicia, in any way, after receipt of notice from WVU disapproving or withdrawing approval of same;
 - ii. at the sole discretion of WVU, brings disrepute upon WVU and/or the Indicia through its own actions or actions attributed to it;
 - iii. discontinues its business, becomes administratively linked to a third party or is otherwise subsumed by a third party;
 - iv. breaches any of the covenants or provisions of this License Agreement and fails to cure such breach within ninety (90) days after receipt of notice thereof.
- b) Termination of this License Agreement shall not impair any rights of WVU accrued hereunder.

7. POST TERMINATION RIGHTS

- a) Upon expiration or termination of this License Agreement, all rights granted to PARKERSBURG shall revert to WVU and the PARKERSBURG shall refrain from further use of the Indicia or any further reference to them, except as permitted in Paragraph 7(c) below.
- b) Upon termination of this License Agreement, or portions of it, for cause, PARKERSBURG agrees immediately to discontinue the use of the Indicia.

PARKERSBURG further agrees that continued production, promotion, distribution or sale will result in immediate and irreparable damage to WVU, making injunctive relief appropriate.

- c) For a period of ninety (90) days after the termination of this License Agreement without cause or after expiration, PARKERSBURG may dispose of advertising material which are on hand or are in the process of production at the time of termination or expiration. This final use period shall be subject to all terms and conditions of this License Agreement.

8. WAIVER

The express or implied waiver by WVU of any right or remedy it may have under this License Agreement for any breach of any term or condition by PARKERSBURG shall not constitute a continuing waiver of WVU's rights and remedies resulting from any breach by PARKERSBURG of the same or any different term or provision. Failure of WVU to exercise any right or remedy shall not constitute a waiver of WVU's rights or PARKERSBURG's obligations.

9. REMEDIES

PARKERSBURG acknowledges that its material breach of this License Agreement will result in immediate and irremedial damage to WVU, and that money damages alone will be inadequate to compensate WVU. Therefore, in the event of a material breach or threatened material breach of any material provision of this License Agreement by PARKERSBURG, WVU may, in addition to other remedies, obtain injunctive relief prohibiting breach or compelling specific performance.

10. SEVERABILITY

If any provision of this License Agreement is found by a court of competent jurisdiction to be invalid or void, such provision, to the extent possible, shall be severed from this License Agreement, and all other provisions shall remain in effect.

11. SURVIVAL OF RIGHTS

Terms and conditions of this License Agreement necessary to protect the rights of WVU and those that pertain to any activity anticipated herein to later take place, shall survive termination or expiration of this License Agreement.

12. NO WARRANTY

WVU warrants that it has the lawful capacity to execute this License Agreement, but does not warrant and shall not be held to have warranted the validity or scope of all Indicia licensed hereunder.

13. FORCE MAJEURE

Neither party to this License Agreement shall be deemed in default or otherwise liable hereunder due to its inability to perform by reason of any fire, earthquake, flood, epidemic, accident, explosion, casualty, strike, lockout, labor controversy, riot, civil disturbance, act of public enemy, embargo, war, act of God, or any municipal, county, state, national or international ordinance or law or any executive, administrative, judicial or similar order (which order is not the result of any act or omission to act which would constitute a default under this License Agreement), or any failure or delay of any transportation, power, or other essential thing required, or similar causes beyond the party's control. Any delay in performance shall be no greater than the event of force majeure causing the delay. If an event of force majeure continues uninterrupted for a period exceeding six (6) calendar months, either party may elect to terminate this License Agreement upon notice to the other, but such right of termination, if not exercised, shall expire immediately upon the discontinuance of the event of force majeure.

14. GOVERNING LAW

This License Agreement shall be governed by the laws of the State of West Virginia and by the statutes of the United States pertaining to trademarks and copyrights. WVU and PARKERSBURG hereto consent to the jurisdiction of the courts of competent jurisdiction, federal or state, situated in the State of West Virginia for the bringing of any and all actions hereunder.

15. NOTICES

a) All notices shall be in writing and shall be sent to:

WVU:

West Virginia University
Office of the Vice President for Legal Affairs
105 Stewart Hall
PO BOX 6201
Morgantown, WV 26506-6686
Telephone: (304) 293-5841
Fax: (304) 293-2326
E-mail: Legalaffairs@mail.wvu.edu

PARKERSBURG:

West Virginia University at Parkersburg
President's Office
300 Campus Drive
Parkersburg, WV 26104-8647

- b) All artwork approval requests shall be in writing and sent to:

West Virginia University
Office of Trademark Licensing Services
302 Stewart Hall
PO Box 6686
Morgantown, WV 26506
Telephone: (304) 293-8028
Fax: (304) 293-7563
E-mail: Trademarklicensing@mail.wvu.edu

16. HEADINGS

The headings herein are for reference purposes only and shall not constitute a part of the License Agreement hereof or be deemed to limit or expand the scope of any provision of this License Agreement.

17. ATTORNEY'S FEES

In the event that WVU prevails in an action against PARKERSBURG for the enforcement or breach of this License Agreement, WVU shall be entitled to recover reasonable attorney's fees and costs of the proceeding.

18. INTEGRATION

- a) This License Agreement, and any other special provisions contained herein, represent the entire understanding between WVU and PARKERSBURG.
- b) This License Agreement supersedes all previous representations, understandings or agreements, oral or written, between WVU and PARKERSBURG with respect to the subject matter hereof and cannot be modified except by a written instrument signed by the parties hereto.

[Signatures to Appear on the Following Page]

IN WITNESS WHEREOF, WVU and PARKERSBURG have caused this instrument to be executed as a sealed instrument by their duly authorized representatives as set forth below:

WVU

PARKERSBURG

By: _____
(Signature)

By: _____
(Signature)

Title: _____

Title: _____

Date: _____

Date: _____