



YORK UNIVERSITY LICENSING PROGRAM

1050 Kaneff Tower, 4700 Keele Street, Toronto, ON M3J 1P3

Trade Mark License Agreement

THIS AGREEMENT, made as of the __ day of _____, 201__ ,

BETWEEN:

YORK UNIVERSITY, a body corporate existing under the laws of the Province of Ontario (referred to in this Agreement as “York”)

and

(referred to in this Agreement as the “Licensee”)

WHEREAS:

- (a) York is the owner of certain trade marks, names, abbreviations, designs and symbols which have come to be associated with York; and
- (b) the Licensee desires to obtain a license from York to use one or more of such trade marks, names, designs and symbols in accordance with the terms and conditions of this Agreement.

NOW THEREFORE, in consideration of the mutual covenants and premises set forth in this Agreement, York and the Licensee agree as follows:

1. Definitions

In this Agreement the following terms shall have the meaning indicated below:

Item: Any item of wares, goods or products upon which the Licensee is permitted by the terms of this Agreement to place a Mark.

Mark: Any trademark, name, abbreviation, design or symbol which is the property of York and which is listed in Schedule A to this Agreement.

2. Grant of License

- (a) York hereby grants to the Licensee a limited, revocable, non-exclusive and non-transferable license to place the Marks on Items in accordance with and subject to the terms and conditions of this Agreement.
- (b) The Licensee is not authorized by this Agreement to place a mark on any item unless and until the Item Sample Approval Request Form for such item is approved by York in accordance with Section 3.

3. Control of Quality by York

- (a) The Licensee acknowledges that if Items are manufactured, distributed or sold by the Licensee which are of inferior quality in design, material or workmanship, York’s significant good will in the Marks may be diminished or impaired, and therefore the Licensee hereby undertakes to ensure that Items shall be of high quality generally and specifically to permit York to exercise the control of quality measures set out in this Section 3.
- (b) Prior to commencing the manufacture, distribution or sale of any type of Item, the Licensee will furnish to York a sample of such Item (referred to hereinafter as a “Sample”) at no cost to York, together with any associated carton, container, packing or wrapping material. Together with each Sample the Licensee shall submit a complete Item Sample Approval Request Form in the form attached to this Agreement as Schedule B.
- (c) York shall review and approve or disapprove each Sample, the graphics and designs depicting the requested York marks, and product packaging and designs within 30 days of receipt of an Item

Sample Approval Request Form from the Licensee. If York fails to approve or disapprove any Sample within such 30 day period such Sample and the related item shall be deemed to have been disapproved.

(d) If the Licensee desires to make any modifications in the design, materials or quality of an Item for which a Sample had been previously approved by York, the Licensee shall submit to York a further sample of such modified item in accordance with the procedure set out in subsection 3(b) and York shall review and approve or disapprove such modified item in accordance with the procedure set out in paragraph 3(c).

(e) The Licensee agrees not to manufacture, distribute or sell any Items which are not of the same quality of design, materials and workmanship as the Sample for such Item approved by York and the Licensee agrees to maintain such reasonable manufacturing, servicing and quality standards as are necessary to ensure that each Item conforms with its Sample.

(f) The Licensee shall permit a duly authorized representative of York to inspect at all reasonable times the Licensee's premises where it carries on activities authorized by this Agreement in order to verify that the standards of quality, as reflected in the approved Samples, are being maintained by the Licensee. From time to time, at the request of York, the Licensee shall submit to York a sample of an Item which the Licensee is manufacturing, distributing or selling so that York may determine compliance by the Licensee with the terms of this Agreement. If the sample is in compliance it will be returned at the Licensees request.

(g) Subject to Section 13, if at any time York is of the opinion that Items are being manufactured, distributed or sold by the Licensee which do not conform in quality of design, material and workmanship or in any other respect to the relevant Sample approved by York, York may give notice to the Licensee of such non-conformity. Upon receipt of such notice the Licensee immediately shall cease to manufacture, distribute and sell or otherwise deal in Items to which the notice relates, and the Licensee shall not continue such manufacture, distribution or sale until the Licensee has satisfied York that subsequent Items will conform to the relevant Sample approved by York.

4. Royalty Payments

(a) As consideration for the grant by York to the Licensee of the license hereunder the Licensee shall pay to York a royalty equal to such percent of the Net Sale Price (as defined below) of all Items sold by the Licensee as is set out in Schedule A. An Item shall be deemed to be sold by the Licensee when it is delivered to a customer, or when an invoice in respect of the Item is sent to a customer, whichever occurs first and this royalty shall be payable by the Licensee even if this Licensee does not charge the customer for the Item, in which case the royalty shall be based on the usual Net Sale Price charged to other customers in the same geographic area.

(b) The term "Net Sale Price" in subsection 4(a) shall mean the price (exclusive of any applicable federal or provincial sales taxes) actually charged by the Licensee to a customer in respect of an Item less any quantity or volume discount actually allowed and taken as such, and any credits for returns actually made, and shown on the Licensee's invoices; however, in calculating the Net Sale Price of an Item no deduction shall be made for uncollectible accounts, and no costs incurred in the manufacture, promotion, distribution or sale of Items shall be deducted in computing the Net Sale Price. If the Licensee sells an Item to a non-arms-length affiliate of the Licensee, then the term sales shall be deemed to be the Net Sale Price charged by the Licensee for items sold in the same period to similar customers not so controlled by or related to the Licensee. If there are no such other sales, the Net Sale Price, shall be the greater of the total gross invoice amounts payable by the Licensee for the wares plus the costs associated with the material for and the process of placing marks on wares, or the total gross invoice amounts billed by the Licensee to the related or controlled customer for the Items.

(c) Royalty payments due and payable to York by the Licensee under subsection 4(a) shall be calculated and paid quarterly, and shall be paid on or before the fifteenth day of the month next following the end of each calendar quarter. Payments shall be made in April, July, October and January for each preceding three-month period.

All payments due to York under this Agreement shall be made by cheque payable to "York University - Licensing Programme Account" and shall be sent or delivered to York's address for notice as specified in Section 15. Overdue payments shall bear interest at the rate of eighteen percent (18%) per annum on the amount outstanding from the date payment is due until the date payment is received by York from the Licensee.

(d) Upon the execution of this Agreement the Licensee shall pay to York the sum set out in Schedule A as a non-refundable advance on the royalty payments to be paid by the Licensee under

subsection 4(a) (the “Advance”). The Advance shall be applied against the first and, if necessary, each subsequent quarterly royalty payments until the whole of the Advance has been applied against royalty payments, but in no event shall the Licensee be entitled to a refund of any portion of the Advance.

5. Reports, Records and Audit

(a) On or before the fifteenth day of April, July, October and January of each year, the Licensee shall submit to York a royalty report certified by a senior officer of the Licensee setting out the following: total sales of Items, the date of invoices and invoice numbers, the customer purchasing the Items, any volume discounts and actual credits for returns, and any additional information necessary to enable an independent determination of the royalty payment due hereunder. If no sales of Items or other use of the Marks were made during any quarterly reporting period, a similarly certified report to that effect shall be submitted by the Licensee.

(b) The Licensee shall keep accounts, books and records, including copies of actual invoices itemizing Items sold, showing details of the manufacture, distribution and sale of Items. Such books and records shall be maintained by the Licensee at the Licensee’s premise for a period of at least three years after the payment of the corresponding royalty payment.

(c) The Licensee shall make the accounts, books and records referred to in subsection 5(b) reasonably available to York during normal business hours and York or its duly authorized representative shall have the right to audit such books and records (including making copies thereof) for the purpose of verifying the royalty payments payable by the Licensee hereunder. If such audit indicates an under payment, the payment in full of such outstanding amount shall be made by the Licensee to York with the subsequent quarterly royalty payment (as required under subsection 4(c)), following such audit. If such audit indicates an under payment of ten percent (10%) or more by the Licensee of amounts properly due hereunder, the cost of such audit shall be borne by the Licensee.

6. Rights Retained by York

(a) The Licensee acknowledges and agrees that York possesses the absolute and exclusive proprietary rights to the Marks and that the Marks shall remain the sole property of York. The Licensee shall acquire no right, title or interest in and to the marks, except the right to use the Marks in accordance with the terms of this Agreement. The Licensee shall not use the Marks in any manner calculated to represent that the Licensee is the owner of the Marks.

(b) The Licensee recognizes the great value of the publicity and goodwill associated with the Marks and acknowledges that such goodwill belongs exclusively to York. The Licensee shall not, during the term of this Agreement and thereafter, dispute or contest directly or indirectly, the validity, ownership or enforceability of the Marks, directly or indirectly attempt to dilute the value of the goodwill attaching to the Marks, nor alter, modify, dilute or otherwise misuse the Marks or bring them into disrepute, nor counsel, procure or assist anyone else to do any such acts.

(c) The Licensee agrees not to use any other trade mark, service mark, trade name, logo, symbol or device in combination with any Mark without the prior written consent of York. At York’s request, the Licensee shall remove from any advertisement, marketing material, product or product package bearing the Marks any element which York, in the exercise of York’s sole discretion, believes will in any way harm the Marks or the reputation of York.

(d) Upon the request of York the Licensee shall cause to appear on or within each Item, by means of a tag, label, imprint or other appropriate device, such copyright or trademark notices as York may from time to time designate. Every Item must bear a legend designating it as an official licensed product on either the Item or its packaging as approved in advance by York.

(e) The Licensee agrees that upon the revocation of the License granted to the Licensee under Section 2, the Licensee thereafter will not use the Marks for any purpose whatsoever.

7. Enforcement of Rights by York

(a) The Licensee shall report to York any infringement or imitation of, or challenge to, the Marks, immediately upon becoming aware of same. The Licensee shall report any such infringement by completing and delivering to York a Trade Mark Infringement Report in the form set out as Schedule C to this Agreement.

(b) York, at its sole discretion, shall determine whether or not action shall be taken on account of any infringements or imitations of, or challenges to the Marks and York’s determination shall be final. The Licensee shall not be entitled to call upon or compel York to bring any action or other legal

proceedings on account of such infringements, imitations or challenges, nor shall the Licensee be entitled to bring any action on account of such infringements, imitations or challenges without the written consent of York. York shall not be liable for any loss, cost, damage or expense suffered or incurred by the Licensee because of the failure or inability of York to take any action on in respect of such infringements, imitations or challenges. If York brings suit against an infringer, York shall have the sole right to control such lawsuit and to settle the same on terms and conditions approved solely by York and any monetary recoveries resulting from such a lawsuit brought by York shall belong solely to York. If York commences any legal action against an infringer, York shall have the right to join the Licensee if necessary and the Licensee shall provide York with all reasonable assistance (other than financial assistance) requested by York in preparing and prosecuting such suit.

8. Relationship of Parties

The Licensee acknowledges that it is not an employee, agent or legal representative of York for any purpose and shall not hold itself out or permit any person within its control or employ to so hold itself out as being any of the foregoing. The Licensee further agrees that it cannot bind York in any way. The Licensee shall have and be responsible for the complete management and control of the Licensee's business and shall be solely responsible for its employees and agents. The Licensee shall neither state nor imply, directly or indirectly, that the Licensee, or its activities, other than the exercise of the license granted hereunder, are supported, approved or sponsored by York, and upon the direction of York the Licensee shall issue express disclaimers of any such support, endorsement or sponsorship.

The Licensee shall not take any action nor make any statement which misrepresents the relationship between the parties or the purpose of the York University Licensing Programme.

9. Fair Labour Practices

The Licensee acknowledges that York does not wish its names and marks to be associated with products produced under illegal or unfair labour conditions. The Licensee therefore agrees not to manufacture or imprint merchandise which has been manufactured in these conditions and agrees to exercise due diligence in avoiding such practices both in its own and in its suppliers' workplaces. The Licensee agrees that it will disclose a list of its suppliers when asked to do so by York. The Licensee agrees to maintain a valid membership in the Fair Labor Association (FLA).

10. Indemnity and Product Liability Insurance

York shall have no liability for any Item manufactured, distributed or sold by the Licensee, nor does York assume any liability to the Licensee or third parties with respect to the quality or performance characteristics of Items. The Licensee agrees to indemnify and hold harmless York, its officers, employees and agents from any and all claims, demands, actions, causes of action, suits, proceedings, damages, liabilities, costs and expenses of every nature, including reasonable legal fees, whether arising in contract, tort or otherwise, relating to or arising out of any Item manufactured, distributed or sold by the Licensee or its agents or in respect of the use by the Licensee or its agents of any Marks licensed hereunder or resulting from any acts or omissions of the Licensee or its employees or agents. York may make its approval of any Sample subject to the Licensee maintaining in respect of the relevant Item product liability insurance in such amounts and subject to such conditions as York may stipulate in its Item Sample Reply Form.

11. Limitation of Liability

(a) The Licensee acknowledges that York disclaims all representations or warranties, express or implied, with respect to the Marks, and in particular that York shall not be liable to the Licensee in respect of infringement of any copyright or trademark owned by a third party, or for damages or costs involved in any proceedings based upon any such infringement.

(b) York's entire liability for any cause of action whatsoever, and regardless of the form of action (including negligence), shall be limited to the Licensee's actual direct, provable damages in an amount not to exceed the royalty payments received by York under Section 4 during the six months preceding the event giving rise to the cause of action. In no event shall York be liable under any indirect, consequential, special or incidental damages even if York has been advised of the possibility thereof including, but not limited to, lost profits, lost business revenue or other economic loss of any kind or for any claim against the Licensee by any other party.

12. Term

This Agreement and the License granted hereunder shall be deemed to have come into force as of the date hereof and shall remain in full force and effect for the period set out in Schedule A from such date, and this Agreement and the License granted hereunder shall terminate upon the expiry of such period unless (i) terminated earlier in accordance with the provisions of Section 13 or (ii) renewed by the execution by the parties of a written amendment to this Agreement.

13. Termination

(a) York may terminate this Agreement with immediate effect by giving the Licensee written notice of termination upon the happening of one or more of the following events:

(i) any breach of or default under any provision of this Agreement by the Licensee, including but not limited to, the manufacture, distribution or sale by the Licensee of Items which do not conform in all material respects to the related Sample which has been approved by York, a failure by the Licensee to pay to York royalty payments as required under Section 4 or failure by the Licensee to provide York with quarterly reports as required by Section 5, which continues in effect for 10 business days following the giving of notice of same to the Licensee by York; or

(ii) the commencement by or against the Licensee of any proceedings under the bankruptcy laws of any jurisdiction, the appointment of a receiver for the Licensee, any assignment for the benefit of creditors of the Licensee, insolvency of the Licensee, or the levy, seizure, assignment or sale for or by any creditor or governmental agency on a substantial part of the Licensee's property which is not released or satisfied within 10 business days thereafter.

(b) If the notice of termination given by York under subsection (a) includes a statement that York is of the opinion that the Licensee is manufacturing, distributing or selling Items which do not conform in all material respects to the relevant Sample approved by York, the Licensee immediately shall cease to manufacture, distribute or sell such Items until such time as the default has been cured by the Licensee or until otherwise authorized by York.

(c) Upon termination of this Agreement, all rights granted the Licensee hereunder shall revert to York and the Licensee shall make no claims to such rights.

(d) Upon termination of this Agreement, the Licensee agrees to discontinue immediately the use of the Marks and the manufacture, distribution or sale of Items bearing the Marks, provided, however, that the Licensee shall have the right to dispose of its stock of Items bearing the Marks at its normal Net Sale Price within two months after said termination; unless York has notified the Licensee of York's opinion that the Items do not conform in all material respects to the relevant Sample approved by York, in which case the Licensee shall not be entitled to such two month post termination disposition right in respect of such nonconforming goods. Such post termination disposition shall be subject to the terms of this Agreement, including the requirement of payment of royalties and the provision of royalty reports, and such post termination disposition is subject to the further condition that within 10 business days after termination the Licensee pay York all royalties accrued to the date of termination, deliver to York a royalty report up to the time of termination in the form required under Section 5 and provide York with an inventory of unsold Items bearing marks remaining and permit York, at its option, to conduct a physical inventory to verify such statement.

(e) Termination of this Agreement shall not extinguish any cause of action or right which York may have under or in respect of a breach of this Agreement and, specifically, the Licensee's liability to pay royalties in accordance with Section 4 shall continue notwithstanding such termination.

(f) The Licensee acknowledges that any breach of this Agreement will result in immediate and irreparable damage for York, and that money damages alone would be inadequate to compensate York. Accordingly, in the event of a breach or threatened breach of any provision of this Agreement by the Licensee, the Licensee agrees that York may, in addition to all other remedies, immediately obtain and enforce injunctive relief prohibiting the breach or compelling specific performance.

14. Identification of the Licensee

York will have the right to identify the Licensee as a licensee of York and a user of the marks in the marketing, sales and other similar literature and material of York without having to obtain the consent of the Licensee.

20. Acknowledgement

The undersigned hereby acknowledges having received a copy of and having read the Trade Mark License Agreement between York University (“York”) and the “Licensee” under which York has granted a license to the Licensee to use certain trade marks of York (“Marks”), and whereas the undersigned has been retained by the Licensee to assist the Licensee in producing wares, goods or products bearing the Marks (“Items”), the undersigned hereby agrees not to deal with the Marks in any manner except as is necessary to produce Items and the undersigned shall not reproduce, copy, manufacture or in any other way deal with the Marks for any other purpose or in any manner that is prohibited under the License Agreement; specifically, the undersigned shall not attach the Marks to the products of any party other than the Licensee (unless the undersigned has signed an acknowledgement similar to this one in respect of such other part).

IN WITNESS WHEREOF York and the Licensee have executed this Agreement as of the date first written above.

YORK UNIVERSITY

Signature: _____ Signature: _____

Name: Gary Brewer Name : _____

Title: VP Finance and Administration Title: _____

Date: _____ Date: _____

Attached: Schedules A, B and C



1. York Marks licensed to Licensee under the Agreement (Section 1 and subsection 2(a)):

- York University "U" logo design
- York University: redefine the possible
- York University Crest design
- York Lions and Crest design
- York Alumni
- Atkinson Faculty of Liberal & Professional Studies
- Calumet College
- Faculty of Arts
- Faculty of Education
- Faculty of Environmental Studies
- Faculty of Fine Arts
- Faculty of Graduate Studies
- Faculty of Science and Engineering
- Founders College
- Glendon College/Collège Glendon
- Glendon Crest
- McLaughlin College
- Norman Bethune College
- Osgoode and logo design
- Schulich School of Business and logo design
- Stong College
- Vanier College
- Winters College
- Other (please visit our website at <http://www.yorku.ca/secretariat> for a full listing)

2. Percent of Net Sale Price paid as a royalty by Licensee to York
(subsection 4(a)): **7%**

3. Amount of non-refundable advance payable by Licensee to York upon execution of Agreement
(subsection 4(d)): **\$150.00**

4. Term of Agreement (subsection 12): **One Year**

DATED this ___ day of _____, 201__.

YORK UNIVERSITY

Signature: _____

Signature: _____

Name: Gary Brewer

Name: _____

Title: VP Finance and Administration

Title: _____

Date: _____

Date: _____



YORK UNIVERSITY LICENSING PROGRAM

1050 Kaneff Tower, 4700 Keele Street, Toronto, ON M3J 1P3

Trade Mark Infringement Report

1. Name of Licensee:
2. Date of Trade Mark License Agreement
3. Particulars concerning use of York Marks by non-authorized persons (include name of person, description of products carrying York marks, location where alleged infringement occurred, and any other pertinent information):

4. Signature of Licensee: _____

5. Company Name: _____