



February 29, 2016

Mr. Joe Passiatore
General Counsel
CENTRAL FLORIDA EXPRESSWAY AUTHORITY
4974 ORL Tower Road
Orlando, FL 32807

29 FEB '16 at 11:54

RE: Agreement between UCFRF and CFX
UCF #80529

Dear Mr. Passiatore:

Pursuant to our recent activities and discussions, I am attaching three Agreements executed by an authorized representative of the University of Central Florida Research Foundation, Inc. for approval by the Central Florida Expressway Authority Board at the meeting scheduled for March 10. Please return one fully executed original Agreement to me for UCFRF's records.

If you have any questions, please contact me directly at 407-823-0138 or via e-mail Andrea.Adkins@ucf.edu. Thank you.

Sincerely,

A handwritten signature in cursive script, appearing to read "Andrea Adkins".

Andrea Adkins
Assistant Director

Attachments: (3)

Technology Transfer
Office of Research & Commercialization
12201 Research Parkway, Suite 501 • Orlando, FL 32826
(407) 823-3778 • FAX (407) 823-3299 • <http://www.research.ucf.edu/>

An Equal Opportunity and Affirmative Action Institution

AGREEMENT
between
UNIVERSITY OF CENTRAL FLORIDA RESEARCH FOUNDATION, INC.
And
CENTRAL FLORIDA EXPRESSWAY AUTHORITY

This Agreement ("**Agreement**") is effective this ____ day of ____ 2016 ("**Effective Date**"), between the University of Central Florida Research Foundation, Inc. ("**UCFRF**"), a Florida nonprofit corporation, having an address at 12201 Research Parkway, Suite 501, Orlando, FL 32826, and Central Florida Expressway Authority ("**CFX**") (previously, Orlando-Orange County Expressway Authority), a body and corporate politic and agency of the State of Florida, having an address at 4974 ORL Tower Road, Orlando, FL 32807. (**UCFRF** and **CFX** shall be referred to individually as "**Party**" or collectively as "**Parties**")

1. **BACKGROUND**

- 1.1 In the course of performance under and disclosing information relating to an Interlocal Agreement effective March 1, 2014, between the University of Central Florida ("**UCF**") and Orlando-Orange County Expressway Authority (now known as **CFX**), Dr. Haitham Al-Deek and Mr. John Rogers of UCF and Mr. Corey Quinn of **CFX** (collectively the "**Inventors**") made or reduced to practice certain invention(s) described in an invention disclosure titled, "*Design Concept and Implementation of Rectangular Rapid Flashing Beacon (RRFB) Technology as Countermeasure for Wrong Way Driving*" and further described and subsequently filed as a provisional patent application on July 31, 2015, U.S. serial number 62/199,579 ("**Invention**"), which is included within the **Patent Rights**, as defined in Paragraph 2.1. This is disclosed as UCFRF Case No.10996/33317.
- 1.2 Dr. Al-Deek and Mr. Rogers are each required to assign to **UCF** their respective interest in any patent rights covering inventions made during the course of employment with **UCF**, and have assigned such rights in the Invention to **UCFRF**. **UCFRF** has been assigned the rights by **UCF** to certain inventions and discoveries emanating from research and educational activities at **UCF**, a public university of the state of Florida.
- 1.3 Mr. Corey Quinn is an employee of **CFX** and is either required by employment contract or at will to assign to **CFX** his respective interest in any patent rights covering inventions made during the course of his employment with **CFX** and has assigned or will assign such rights in the Invention to **CFX**.
- 1.4 **UCFRF** and **CFX** are co-owners of the **Patent Rights** through the assignments as described herein.
- 1.5 **UCFRF** is willing to take the lead in identifying licensee(s) and negotiating a license(s) or option agreement(s) for the **Patent Rights** for commercial purposes on behalf of **UCFRF** and **CFX**.
- 1.6 **UCFRF** is willing to administer all subsequent patent filings, prosecution, and maintenance of the **Invention**.
- 1.7 It is the mutual desire of **UCFRF** and **CFX** that their respective undivided interests in the **Patent Rights** be administered in a manner to ensure the rapid commercialization of the **Patent Rights** and to make their benefits widely available to the public.
- 1.8 **UCFRF** and **CFX** wish to enter into this **Agreement** to establish a means for filing and prosecuting the **Patent Rights**, for administering and licensing the **Patent Rights**, and for sharing income derived from licensing of the **Patent Rights**.

2. DEFINITIONS

- 2.1 “**License Agreement**” shall mean any agreement(s) entered into by **UCFRF** on behalf of **UCF** and **CFX** that grants a third party (or licensee) the right to make, use, and/or sell products or processes covered by **Patent Rights** in the territory.
- 2.2 “**Patent Rights**” means patent applications or patents as follows: U.S. Patent Application Serial Number - 62/199,579, filed on July 31, 2015 titled, “Wrong Way Indication Beacon and Related Methods,” and any future patent applications claiming the benefit of priority thereof including all divisions, continuations, reexaminations, reissues of this application only.
- 2.3 “**Expenses**” means all actual out-of-pocket costs incurred by **UCFRF** for the preparation, filing, and prosecution of United States and foreign patent applications, extraordinary expenses as provided in Paragraph 3.4, and the maintenance of resulting patents, exclusive of any salaries, administrative, or other indirect costs.

3. PATENT PROSECUTION AND PROTECTION

- 3.1 (a) **CFX** agrees that **UCFRF** shall coordinate with its outside patent counsel to file, prosecute, and maintain patent application(s) relating to the **Patent Rights** and shall promptly provide or direct patent counsel to provide to **CFX** all serial numbers and filing dates, together with copies of all the applications, including copies of correspondence, all patent office actions, responses, and all other patent office communications, including copies of issued patent(s). Such correspondence shall be sent electronically to the following **CFX** email address: Joe.Passiatore@CFXWay.com.
- (b) **UCFRF** shall consult with **CFX** at least ninety (90) days prior to any relevant bar date and shall make an election, in countries where statutory protection is available, as to whether, when, and in what countries to file foreign patent applications. If **UCFRF** decides not to file applications under the **Patent Rights** in any country that **CFX** desires to seek protection, then **CFX** shall have the right, at its sole expense, to file and prosecute such applications in such countries. If **UCFRF** decides to file applications under the **Patent Rights** in any country that **CFX** does not desire to seek prosecution, then **UCFRF** shall have the right to file and prosecute such applications at its sole expense.
- 3.2 Subject to the exclusions set forth in 3.1(b), **UCFRF** and **CFX** agree to equally (50/50) share **Expenses** associated with **Patent Rights**. Requests for reimbursement of fifty percent (50%) of the **Expenses** incurred by **UCFRF** shall be submitted periodically throughout the term of this **Agreement** to **CFX** via invoice with supporting documentation. In the event that **CFX** directly incurs any **Expenses**, requests for reimbursement of fifty percent (50%) of the **Expenses** incurred by **CFX** shall be submitted to **UCFRF** via invoice with supporting documentation. Reimbursement of its share of **Expenses** by **CFX** shall be capped at \$49,999.00 for purposes of this **Agreement**. Any additional reimbursement by **CFX** shall require a supplemental amendment to this **Agreement**.
- 3.3 Notwithstanding any other provision of this **Agreement**, **UCFRF** shall not abandon the prosecution of any patent application or the maintenance of any patent contemplated by this **Agreement**, without prior written notice to **CFX**. Upon receiving the written notice, **CFX** may, at its sole option and expense, assume responsibility for the prosecution of any patent application, or the maintenance of any patent.
- 3.4 In the event that **UCFRF** or **CFX** anticipates the possibility of any extraordinary expenditures arising from the preparation, filing, prosecution, licensing, or defense of any patent application or patent contemplated by this **Agreement**, including, without limitation, interferences, reexaminations, reissues and oppositions, the Party anticipating such expenditures shall notify the other Party with all relevant information and these extraordinary expenditures shall be included as **Expenses** only upon written agreement of both Parties. **UCFRF** and **CFX** shall agree on a mutually acceptable course of action prior to incurring these expenditures.

4. LICENSING

- 4.1 **CFX** hereby grants to **UCFRF** the exclusive right to negotiate, execute, administer and manage **License Agreement(s)** for the commercial development and sale of the **Invention**.
- 4.2 **UCFRF** and **CFX** will use all reasonable efforts to cooperate with each other with respect to the licensing of **Patent Rights**, including exchanging information on licensing inquiries received, exchanging marketing materials, and providing other reasonable assistance to the other Party when requested.
- 4.3 **UCFRF** will provide **CFX** their respective drafts of term sheets, option agreements, and **License Agreement(s)** during negotiations with third parties and provide a reasonable period of at least 15 days for review and comments. **UCFRF** agrees to seek reimbursement for all past, present and future patent costs from any third party seeking an exclusive license. In addition, **UCFRF** shall use reasonable efforts to include, without limitation, the following business terms within any **License Agreement**: an upfront fee of cash or equity, milestone payments, an earned royalty, minimum annual royalties, payment of patent costs and diligence terms. Any **License Agreement** will include the following terms: full indemnification of **UCFRF**, **UCF**, and **CFX** by licensee(s), a prohibition against the use of the logos, names, trade names, service marks, or trademarks of **UCFRF**, **UCF**, and **CFX** and the names of the **Inventors**, confidentiality, and a reservation of rights to use as set forth in Section 4.7. To the extent permitted by applicable state law, the parties agree to keep such documents and related documentation confidential in accordance with Article 6 of this **Agreement**.
- 4.4 Except for revenue arising from patent(s) solely pursued by one Party pursuant to 3.1(b), **UCFRF** and **CFX** agree that revenue from licensing of the **Patent Rights** will be shared equally (50/50) between **UCFRF** and **CFX**. Revenue from licensing of the **Patent Rights** shall be distributed on at least a semi-annual basis. **UCFRF** shall keep books and records sufficient to verify **UCFRF's** accounting, including without limitation, invoice records relating to revenue and **Expenses**. Such books and records shall be preserved for a period not less than three (3) years.
- 4.5 Each **Party** shall be responsible for distributing shares of license revenue according to the Party's internal agreements, practices and policies.
- 4.6 It is understood that if the United States Government (through any of its agencies or otherwise) funded research during the course of or under which any invention of the **Patent Rights** were conceived or made, the United States Government is entitled, as a right, to a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced any invention of such **Patent Rights** for governmental purposes. Any license granted to a licensee shall be subject to such government right.
- 4.7 It is further understood that any **License Agreement** entered into between **UCFRF** and a third party for **Patent Rights** shall reserve to both **Parties** and their respective organizations, **UCF** and **CFX**, the royalty-free, non-exclusive right to practice any **Patent Rights** licensed hereunder for their own purposes, including research and education, or experimental use purposes for the State of Florida.

5. TERM AND TERMINATION

- 5.1 This **Agreement** is effective from the **Effective Date** and will remain in effect until the sooner of (i) the expiration of the last-to-expire patent under **Patent Rights**, or (ii) at least five (5) years after the **Effective Date** of this Agreement that no **License Agreement** respecting **Patent Rights** remains in effect. Termination of this **Agreement** will not relieve either **Party** of any obligation or liability accrued under this **Agreement** before termination, nor will it rescind any payments made or due before termination.

- 5.2 Unless a **License Agreement** is in effect or has been agreed upon as to all financial terms, either **Party** hereto may terminate this Agreement for any reason upon at least sixty (60) days written notice ("Notice of Termination") to the other Party, but in any event not less than sixty (60) days prior to the date on which responses to any pending patent office actions need to be taken to preserve **Patent Rights**. Upon termination of this **Agreement** all monies due to **UCFRF** or **CFX** as applicable shall become immediately due and payable. Apart from the obligations to share patent costs, Article 4, and apart from specific obligations accrued prior to termination, Article 6 - Confidentiality, the **Parties** will have no further rights or obligations under this Agreement after effective termination.
- 5.3 In the event that this **Agreement** is terminated, **UCFRF** may continue patent prosecution or maintenance of the **Patent Rights** at its sole expense. If **UCFRF** chooses not to continue prosecution or maintenance of the **Patent Rights**, **CFX** may proceed with the prosecution or maintenance at its sole expense.

6. CONFIDENTIALITY

- 6.1 Each **Party** agrees that during the term of this **Agreement**, and for a period of three (3) years from the expiration or effective date of termination of this **Agreement**, it will treat confidential information with reasonable care to avoid disclosure of the confidential information to any third party, person, firm or corporation, and each **Party** shall be liable for unauthorized disclosure or failure to exercise such reasonable care. Neither **Party** shall have any obligation, with respect to the confidential information, or any part thereof, which:
- (a) is already known to the receiving **Party** at the time of the disclosure;
 - (b) becomes publicly known without the wrongful act or breach of this **Agreement** by the receiving **Party**;
 - (c) is rightfully received by the receiving **Party** from a third **Party** on a non-confidential basis;
 - (d) is approved for release by written authorization of the other **Party**;
 - (e) is subsequently and independently developed by employees of the receiving **Party** who had no knowledge of the confidential information;
 - (f) is disclosed pursuant to any judicial or government request, requirement or order, provided that the **Party** so disclosing takes reasonable steps to provide the other **Party** prior notice in order to contest such request, requirement or order; and
 - (g) is disclosed as may be required by court order or applicable provisions of state or federal law.
- 6.2 Each **Party** shall be entitled, at its option, to disclose confidential information by a written non-disclosure agreement containing these same terms and provisions to its consultants or non-employees retained because of their standing and expertise in the area concerned.
- 6.3 To the extent permitted by law, the Parties agree that all non-published patent prosecution documentation and attorney communications shall be confidential information.

7. NO WARRANTIES

- 7.1 Each **Party** represents and warrants to the other **Party** that it is a duly organized, validly existing organization, and is in good standing under the laws of the jurisdiction of its state.
- 7.2 Each **Party** represents and warrants to the other **Party** that it has full power and authority (including full corporate power and authority) to execute and deliver this **Agreement** and to perform its obligations

hereunder. All necessary proceedings (including any necessary approval by a **Party's** board of directors) have been taken by such **Party** to duly authorize the execution, delivery, and performance of this **Agreement** by such **Party**. This **Agreement** constitutes the valid and legally binding obligation of such **Party**, enforceable against such **Party** in accordance with its terms and conditions.

- 7.3 THE **PARTIES** MUTUALLY AGREE AND ACKNOWLEDGE THAT NEITHER **PARTY**, BY THIS AGREEMENT, MAKES ANY REPRESENTATIONS AS TO THE OPERABILITY OR FITNESS FOR ANY USE, SAFETY, EFFICACY, ABILITY TO OBTAIN REGULATORY APPROVAL, PATENTABILITY, AND/OR BREADTH OF **PATENT RIGHTS**. THE **PARTIES**, MAKE NO REPRESENTATION AS TO WHETHER THERE ARE ANY PATENTS NOW HELD, OR WHICH WILL BE HELD, BY OTHERS OR BY EITHER **PARTY** IN THE **PATENT RIGHTS**, NOR DOES EITHER **PARTY** MAKE ANY REPRESENTATION THAT THE **PATENT RIGHTS** DO NOT OR WILL NOT INFRINGE ANY OTHER PATENTS NOW HELD OR THAT WILL BE HELD BY OTHERS OR BY EITHER **PARTY**.
- 7.4 IN NO EVENT WILL EITHER **PARTY'S** LIABILITY OF ANY KIND INCLUDE ANY SPECIAL, INDIRECT, INCIDENTAL, CONSEQUENTIAL OR PUNITIVE LOSSES OR DAMAGES, EVEN IF THE **PARTY** HAS BEEN ADVISED OF THE POSSIBILITY OF SUCH DAMAGES. IN NO CASE WILL EITHER **PARTY'S** LIABILITY OF ANY KIND EXCEED THE TOTAL ROYALTIES WHICH HAVE ACTUALLY BEEN PAID TO THE **PARTY** BY ANY LICENSEE AS OF THE DATE OF THE FILING OF THE ACTION AGAINST THE **PARTY** WHICH RESULTS IN THE SETTLEMENT OR AWARD OF DAMAGES.
8. GENERAL
- 8.1 All notices or payment required or permitted to the provisions of this **Agreement** shall be given by email, or prepaid, first class, registered or certified mail or by an express/overnight delivery service provided by a commercial carrier, properly addressed to the other **Party** at the address designated on the following signature page, or to another address as may be designated in writing by the other **Party** during the term of this **Agreement**.
- 8.2 It is understood that both **Parties** are subject to United States laws and regulations controlling the export of technical data, computer software, laboratory prototypes, and other commodities (including the Arms Control Act, as amended and the Export Administration Act of 1979), and their obligations hereunder are contingent on compliance with applicable United States export laws and regulations. The transfer of certain technical data and commodities may require a license from the cognizant agency of the United States Government and/or written assurances that any licensee will not re-export data or commodities to certain foreign countries without prior approval of the cognizant government agency. The **Parties** agree to cooperate in securing any license which the cognizant agency deems necessary in connection with this **Agreement**. However, neither **Party** guarantees that such licenses will be granted.
- 8.3 During the term of this **Agreement**, neither **Party** will assign its undivided interest in the **Patent Rights**.
- 8.4 It is agreed that no waiver by either **Party** hereto of any breach or default of any of the covenants or agreements set forth herein shall be deemed a waiver as to any subsequent or similar breach or default.
- 8.5 This **Agreement** is binding upon and shall inure to the benefit of the **Parties** hereto, their successors or assigns, but this **Agreement** may not be assigned by either **Party** without the prior written consent of the other **Party**, which consent will not be unreasonably withheld.
- 8.6 The captions and headings used in this **Agreement** are for convenience and in no way define, limit the scope or intent of this **Agreement** or any of its provisions.

- 8.7 This **Agreement** constitutes the entire and only agreement between the **Parties** for **Patent Rights** described herein and all other prior negotiations, representations, agreements and understanding are superseded by the terms of this **Agreement**. Any modification to this **Agreement** must be in writing and agreed to by both parties.
- 8.8 Neither **Party** shall use publicly for publicity, promotion, or otherwise, any logo, name, trade name, service mark, or trademark of the other **Party**, or any simulation, abbreviation, or adaptation of the same, or the name of any employee or agent of the other **Party**, without that **Party's** prior written express consent. A **Party** may withhold such consent in its absolute discretion.
- 8.9 In the performance of their respective duties under this contract, the **Parties** are independent contractors of each other. Neither is the agent, employee, or servant of the other. Each is responsible only for its own conduct.
- 8.10 This **Agreement** in no way restricts either **Party** from cooperating with or receiving cooperation from other public and private agencies, organizations, and individuals with respect to any of the normal activities of either of the **Parties**.
- 8.11 Both **Parties** agree to all of the terms of this **Agreement**. Both **Parties** execute this **Agreement** only after reviewing it thoroughly. That one **Party**, or the other, may have drafted all or part of this **Agreement** will not cause this **Agreement** to be read more strictly against the drafting **Party**. This **Agreement** and any changes to it will be interpreted on the basis that both **Parties** contributed equally to the drafting of each of its parts.

SIGNATURES BEGIN ON NEXT PAGE

SIGNATURE PAGE

IN WITNESS WHEREOF, the parties hereto have executed this **Agreement** in duplicate originals by their respective duly authorized officers hereunto, on the day and year hereinafter written. Any communication or notice under this **Agreement** shall be provided to the respective Mailing Addresses listed below.

For Central Florida Expressway Authority

Name: Welton G. Cadwell
Title: Chairman

Date: _____

ATTEST: _____

Darlene Mazzillo
Executive Assistant

APPROVED AS TO FORM AND LEGALITY:

CFX General Counsel

Mailing Address for notices and communications:

Central Florida Expressway Authority
Attn: Joseph L. Passiatore, General Counsel
4974 ORL Tower Road
Orlando, FL 32807
Telephone: (407) 690-5000
Fax: (407) 690-5011
Email address: Joe.Passiatore@CFXWay.com

For University of Central Florida Research Foundation, Inc.



Dr. Thomas H. O'Neal
Vice President
University of Central Florida Research Foundation, Inc.

Mailing Address for notices and communications:

Andrea Adkins, Assistant Director
University of Central Florida
Office of Technology Transfer
12201 Research Parkway, Suite 501
Orlando, Florida 32826-3246
Email address: Andrea.Adkins@ucf.edu
Telephone: (407) 823-0138
Facsimile: (407) 882-9010

2/26/2016
Date

Approved as to Form and Legality

On behalf of SWS-12 2-25-16

Reviewed by OTT: AS 2-26-16