

JAN 19 2010

# LOS ANGELES FIRE DEPARTMENT



MILLAGE PEAKS  
FIRE CHIEF

January 7, 2010

BOARD OF FIRE COMMISSIONERS  
FILE NO. 09-141-S1

TO: Board of Fire Commissioners  
FROM: Millage Peaks, Fire Chief *MP*  
SUBJECT: LAFD PARTNERSHIP WITH MYSAFE:LA

FINAL ACTION:	<input type="checkbox"/> Approved	<input type="checkbox"/> Approved w/Corrections	<input type="checkbox"/> Withdrawn
	<input type="checkbox"/> Denied	<input type="checkbox"/> Received & Filed	<input type="checkbox"/> Other

**Recommendation:** That the Board:

1. Authorize the Fire Chief to execute the attached Trademark License Agreement to facilitate a partnership with MySafe:LA to provide fire and life safety education to children and senior citizens in the greater Los Angeles area.

**Summary:**

At its meeting of December 15, 2009, the Board approved a Memorandum of Understanding with MySafe:LA. At this meeting, the Board also reviewed a draft copy of the proposed Trademark License Agreement between My Safe:LA and the City. Pursuant to the terms of the MOU, the parties agreed to execute a Trademark License Agreement prior to My Safe:LA's use of Fire Department marks.

The City Attorney's office has reviewed and approved, as to form, the attached agreement. The Trademark License Agreement is now in final form and ready to be executed and the file hereby resubmitted to the Board for approval.

**Conclusion:**

The Fire Department welcomes the opportunity to partner with MySafe:LA. This partnership will provide many benefits to the Department including the ability to promote and distribute our public safety programs including CERT; Ready, Set, Go; Stop, Drop & Roll; etc., at no cost to the LAFD.

Board report prepared by: Blanca E. Perez, Sr. Management Analyst I, Community Liaison Office.

Attachment: Trademark License Agreement

## **TRADEMARK LICENSE AGREEMENT**

THIS AGREEMENT is entered into as of \_\_\_\_\_, 2010, by and between the City of Los Angeles, a municipal corporation duly organized and existing under the laws of California, having an address at City Hall East, Room 607, 200 North Main Street, Los Angeles, California 90012 ("LICENSOR" or "CITY"), and My Safe: LA, a nonprofit public benefit corporation duly organized and existing under the laws of the State of California, having an address at 6767 Sunset Boulevard, Los Angeles, California 90028 ("LICENSEE").

### **W I T N E S S E T H:**

WHEREAS, concurrent with this License agreement (this "Agreement") LICENSOR and LICENSEE have entered into a Memorandum of Understanding ("MOU") whereby LICENSOR authorizes LICENSEE to be an authorized entity to promote Fire Life Safety Education on the behalf of and for the benefit of the Los Angeles Fire Department ("LAFD"); and

WHEREAS, LICENSOR is the sole and exclusive owner of the rights to use the LAFD Marks and other intellectual property of the LAFD (collectively, the "MARKS") identified on Schedule "A," attached hereto and made a part hereof, in connection with LAFD services and related goods, in the United States and worldwide, and has established substantial goodwill and reputation in the MARKS and other intellectual property through such use; and

WHEREAS, LICENSOR has the power and authority to grant to LICENSEE the right, privilege, and license to use the MARKS on or in association with the promotion of Fire Life Safety Education for the LAFD and all goods and activities of the LICENSEE associated therewith as authorized by the MOU; and

WHEREAS, LICENSEE desires to obtain from LICENSOR a non-exclusive license to use the MARKS, including in or in association with the photographs, videos, clothing or other items associated therein (collectively "Licensed Materials"); and

WHEREAS, LICENSEE wishes to use and LICENSOR wishes to license the MARKS for use in ways that do not demean, disparage, disgrace, or cast in an unfavorable light, the CITY or any of its employees or departments; and in ways that are consistent with the terms and conditions of the MOU and this Agreement; and

WHEREAS, both LICENSEE and LICENSOR are in agreement with respect to the terms and conditions on which LICENSEE shall use the MARKS.

NOW, THEREFORE, in consideration of the foregoing as well as the promises and agreements set forth herein, and for other good and valuable consideration, the receipt and adequacy of which are hereby acknowledged, the parties, each intending to be legally bound hereby, do promise and agree as follows:

**1. LICENSE**

LICENSOR hereby grants to LICENSEE for the Term of this Agreement as recited herein a non-exclusive, non-transferable, license to use the MARKS contained in Schedule "A," including on or in association with the Licensed Materials throughout the City of Los Angeles ("The Territory") and in all media, now known or hereafter developed. It is understood and agreed that this license shall pertain only to the MARKS and the Licensed Materials and does not extend to any other mark, product, or service. Said license authorizes LICENSEE and its manufacturers to produce items and goods bearing the MARKS as authorized by this Agreement. In the avoidance of doubt, the license grant herein does not confer on LICENSEE, any rights to sublicense or to make derivative marks based on the MARKS or any designs therein.

## 2. TERM OF THE AGREEMENT

This Agreement and the provisions hereof except as otherwise provided, shall be in full force and effect commencing on the date of execution by both parties for two (2) years, so long as the MOU, including any amendments, modifications or extensions thereof, is in effect (the "Term").

## 3. COMPENSATION

A. Use in Licensed Materials. In consideration for the license granted hereunder for use of the MARKS, in all media, in connection with the Licensed Materials, LICENSEE agrees to provide LICENSOR with other good and valuable consideration including good faith promise to promote Fire Life Safety Education for the LAFD, the receipt of which is hereby acknowledged by LICENSOR.

B. Non-Licensed Use. Other than use in Licensed Materials, LICENSEE shall not, without a separate written agreement with LICENSOR, use the MARKS in connection with any tangible goods or services.

## 4. NOTICES AND QUALITY CONTROL

A. Trademark Notice. The License granted hereunder is conditioned upon LICENSEE'S compliance with the marking provisions of the trademark laws of the United States, where applicable. Where applicable, each copy of the Licensed Materials shall include the following trademark notice: "*All Los Angeles Fire Department™ marks, insignias and badges are trademarks of the City of Los Angeles. Use permitted.*"

B. Quality Control Requirements. The Licensed Materials shall not demean, disparage, disgrace, or cast in an unfavorable light, the City or any of its employees or departments, and shall be of a high quality. The Licensed Materials shall not be used in

connection with the depiction of a violation of LAFD policy/procedure or any unlawful, immoral, racist, or reckless act performed by the City of Los Angeles or any of its employees or departments. LICENSOR, via the Chief's Office of the LAFD, shall have the right, as it may request in writing, to review, approve, and reject, consistent with the prior two (2) sentences of this Paragraph 4B as determined by the Chief in his/her sole discretion, all Licensed Materials at least thirty (30) days before the Licensed Materials are manufactured, distributed, displayed, or placed in the stream of commerce in any manner, provided said approval shall not be unreasonably withheld. Any Licensed Material so rejected in writing by LICENSOR shall not be manufactured, distributed, displayed, or placed in the stream of commerce in any manner.

## **5. INTELLECTUAL PROPERTY RIGHTS**

A. LICENSEE acknowledges LICENSOR's exclusive rights in the MARKS and, further, acknowledges that the MARKS are unique and original to LICENSOR and that LICENSOR is the owner thereof. LICENSEE shall not, at any time during or after the effective Term of the Agreement, dispute or contest, directly or indirectly, LICENSOR's exclusive right and title to the MARKS or the validity thereof. LICENSOR, however, makes no representation or warranty with respect to the validity of any patent, trademark, or copyright that may be issued or be granted therefrom.

B. LICENSEE acknowledges that the MARKS have acquired secondary meaning.

C. LICENSEE agrees that its use of the MARKS inures to the benefit of LICENSOR and that LICENSEE shall not acquire any rights in the MARKS other than those contained herein as a result of this license.

D. LICENSEE acknowledges that any rights not expressly granted herein remain solely with LICENSOR, including without limitation, the right to register, or to renew the registrations for, the MARKS in the Territory, and the right to use, and to authorize others to use, the MARKS in connection with any other products or services in the Territory.

E. LICENSEE shall not do anything that is inconsistent with or harmful to LICENSOR's ownership of any rights to the MARKS or the goodwill associated with the MARKS, whether in the Territory or elsewhere, without written consent of the City. Consistent with the immediately preceding sentence, LICENSEE shall, including without limitation:

(1) Not use the MARKS in connection with any products or services other than the Licensed Materials;

(2) Not use any marks confusingly similar to the MARKS in connection with any products or services;

(3) Not register or attempt to register the MARKS or any marks confusingly similar to them; and

(4) Not challenge or dispute LICENSOR's ownership of and rights to the MARKS and the validity of any of LICENSOR's registrations or applications for the MARKS.

LICENSEE'S duty under this Paragraph 5 entitled INTELLECTUAL PROPERTY RIGHTS shall survive the expiration or any termination of this Agreement.

## **6. TERMINATION**

Either party may terminate this Agreement on thirty (30) days written notice to the other party in the event of an uncured material breach of any material provisions of this Agreement by

the other party, provided that, during the thirty-day period, the breaching party fails to cure such material breach.

## **7. POST TERMINATION RIGHTS**

Upon the expiration or termination of this Agreement, all rights granted to LICENSEE under this Agreement shall forthwith terminate and immediately revert to LICENSOR and LICENSEE shall discontinue all use of the MARKS. All materials bearing the MARKS shall be accounted for and submitted to the LAFD Chief's Office within thirty (30) calendar days from the termination date. The LICENSEE shall be permitted to use, consistent with this Agreement (other than the Term), its then-already manufactured (as of the termination date) inventory of products bearing the MARKS in a reasonably practicable manner after reaching a mutual understanding with the LAFD Chief Officer regarding such phase-out period and conditions.

## **8. INDEMNITY AND INSURANCE**

A. Except for City's gross negligence or willful misconduct and except as contemplated by Paragraph 8A above, LICENSEE shall indemnify, hold harmless and defend the LAFD and the CITY, and each of their officers, commissioners, employees, agents and representatives, against any losses, claims, damages, suits, costs, expenses (including reasonable attorneys' and experts' fees) or other liabilities arising out of the design, manufacture, packaging, distribution, shipment, advertising, promotion, sale, or exploitation of LICENSEE'S products bearing the MARKS or in connection with the use of the MARKS under the terms of this Agreement; provided, however, that LICENSOR shall notify LICENSEE in writing within ten (10) calendar days, if reasonably practicable, after LICENSOR receives written notification of any claim or suit (including but not limited to any cease-and-desist letter, request, demand, or notice, etc.) relating to the Marks. LICENSEE shall undertake and control the defense and

settlement of any such claim or suit in a manner consistent with the Los Angeles City Charter Sections 272 et seq., a copy of which was previously provided to LICENSEE in writing, LICENSEE hereby acknowledged. Further, LICENSOR shall reasonably cooperate fully with LICENSEE in connection with defense and settlement of such claim or suit. Subject to Los Angeles City Charter Sections 272 et seq., LICENSEE, with advance notice to LICENSOR of a pending settlement, shall have the right to settle any claim so long as such settlement in no way interferes with any of LICENSOR's rights with respect to the MARKS. In lieu of any other remedies the law might or might not afford the LICENSOR, the foregoing indemnification and duty to defend constitute the sole and exclusive remedies LICENSOR and its successors-in-interest are entitled to receive.

B. LICENSEE shall at all times while this Agreement is in effect and for three (3) years thereafter, obtain and maintain at its own expense, from a qualified insurance carrier with a Best rating of "A" general liability insurance including, without limitation, coverage for personal and advertising injury, which includes LICENSOR as an additional insured, along with its officers, commissioners, employees, agents and representatives. The amount of coverage shall be not less than Two Million dollars (\$2,000,000 USD), combined single limit (with no deductible amount) for each single occurrence and in the aggregate. The policy shall provide for thirty (30) days written notice [ten (10) days for non-payment of premium] to LICENSOR from the insurer by receipted mail, in the event of any modification, cancellation or termination. Upon execution of this Agreement, LICENSEE shall furnish LICENSOR (attention to its City Risk Manager) with an insurance industry certificate of insurance or a certified copy of the full insurance policy evidencing the same. [To see a complete list of insurance compliance instructions, please see "instructions for City insurance requirements" attached as Schedule B] In no event shall



LICENSEE manufacture, advertise, distribute or sell any products bearing the MARKS prior to LICENSOR'S receipt of such proof of insurance.

## 9. NOTICES

A. Any notice required to be given pursuant to this Agreement shall be in writing and (a) mailed by certified or registered mail, return receipt requested, (b) delivered by a national overnight express service, (c) hand delivered or (d) sent by facsimile and followed by U.S. mail, in each case to the address or facsimile number and to the attention of the party (by name or title) set forth below (or to such other address and to the attention of such other party as designated by written notice to the other party):

LICENSOR: Philip H. Lam  
Intellectual Property Counsel  
Los Angeles City Attorney's Office  
City Hall East, Suite 700  
200 North Main Street  
Los Angeles, CA 90012  
Fax: 213-978-8211

CC: Janet Jackson  
General Counsel, LAFD  
Los Angeles City Attorney's Office  
City Hall East, Suite 800  
200 North Main Street  
Los Angeles, CA 90012  
Fax: 213-978-8787

Chief Millage Peaks  
Los Angeles Fire Department  
City Hall East, Suite 1800  
200 North Main Street  
Los Angeles, CA 90012  
Fax: 213-978-3815

LICENSEE: David Barrett  
My Safe: LA  
6767 Sunset Blvd.  
Los Angeles, CA 90028

CC:

The date of giving of any such notice, consent, waiver or other communication shall be (i) the date of delivery if hand delivered, (ii) the date of receipt for certified or registered mail, (iii) the day after delivery to the overnight courier service if sent thereby, and (iv) the date of telephone facsimile transmission on production of a transmission report by the machine from which the facsimile was sent that indicates that the facsimile was sent in its entirety to the facsimile number of the recipient.

#### **10. JURISDICTION AND DISPUTES**

A. This Agreement shall be governed by and construed in accordance with the laws of the State of California and the U.S. laws that pre-empt the applicable California State Laws, without regard to any conflict-of-law principles.

B. All disputes under this Agreement shall be resolved by the courts of the State of California, including the U.S. District Court for the Central District of California, seated in the County of Los Angeles, and the parties all consent to the jurisdiction of such courts, agree to accept service of process by mail, and hereby waive any jurisdictional or venue defenses otherwise available to it.

#### **11. AGREEMENT BINDING ON SUCCESSORS**

The provisions of the Agreement shall be binding on and shall inure to the benefit of the parties hereto, and their heirs, administrators, successors, and assigns.

#### **12. WAIVER**

No waiver by either party of any default shall be deemed as a waiver of prior or subsequent default of the same or other provisions of this Agreement.

### **13. SEVERABILITY**

If any term, clause, or provision hereof is held invalid or unenforceable by a court of competent jurisdiction, such invalidity shall not affect the validity or operation of any other term, clause, or provision and such invalid term, clause, or provision shall be deemed to be severed from the Agreement.

### **14. ASSIGNABILITY**

LICENSEE may not assign any of its rights including the license granted herein, nor delegate any of its obligations under this Agreement, without the prior written consent of CITY via the Chief of the LAFD. Notwithstanding the foregoing, any change in the name, principal address and/or form of corporation of the LICENSEE shall not constitute or be construed as an assignment by LICENSEE of this Agreement, provided LICENSEE update the records of the City with such change in a timely manner.

### **15. RELATIONSHIP OF PARTIES**

LICENSEE acknowledges that it is not an agent or representative of LICENSOR and has no authority to assume or create any obligation on behalf of or in the name of, or binding upon, LICENSOR, or to represent LICENSOR in any manner not specifically provided herein except as stipulated to in the MOU.

### **16. INTEGRATION**

This Agreement, along with the MOU, constitutes the entire understanding of the parties with respect to the subject matter hereof, and revokes and supersedes all prior agreements between the parties. It shall not be modified or amended except in writing signed by the parties hereto and specifically referring to this Agreement.

**17. SURVIVABILITY**

The following paragraphs shall survive termination, expiration and cancellation of this Agreement: Paragraphs 3, 4, 5, 7, 8, 10, 11, 12, 14, 15 and 17.

**18. PRIORITY OF AGREEMENTS**

Insofar as intellectual property rights (including trademark and copyright, if any) and License grant arising out of or related to the MARKS, this Agreement shall govern over the MOU or any other documents incorporated by reference hereto (this Agreement) or thereto (the MOU). As to all other non-intellectual property rights, issues or matters, the MOU shall take precedence over this Agreement.

*[Signature page to follow.]*

IN WITNESS WHEREOF, the parties hereto, intending to be legally bound hereby, have each caused to be affixed hereto its or his/her hand and seal the day indicated.

LICENSOR:

LICENSEE:

City of Los Angeles Los Angeles Fire  
Department

My Safe: LA

By: \_\_\_\_\_

By: \_\_\_\_\_

Title:, Millage Peaks, Fire Chief

Title: My Safe: LA, Director

Date: \_\_\_\_\_

Date: \_\_\_\_\_

Approved:

CARMEN A. TRUTANICH, City Attorney

By: \_\_\_\_\_

Philip H. Lam

Intellectual Property Counsel

\_\_\_\_\_ 2010

Attested to:

June Lagmay, City Clerk

By: \_\_\_\_\_ Dated: \_\_\_\_\_

Title \_\_\_\_\_

**SCHEDULE A  
TO  
TRADEMARK LICENSE AGREEMENT  
BETWEEN  
CITY OF LOS ANGELES  
AND  
MY SAFE: LA**

MARKS Licensed:

The following MARKS form part of this Agreement:

1. The Los Angeles Fire Department Badge.
2. The Los Angeles Fire Department Uniform.
3. The Letters "LAFD", including all logos.
4. Any other marks, designs, mottos, logos, and insignias that are readily identifiable with and/or associated with the Los Angeles Fire Department, and as modified from time to time.

SCHEDULE B  
TO  
TRADEMARK LICENSE AGREEMENT  
BETWEEN  
CITY OF LOS ANGELES  
AND  
MY SAFE: LA

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Instructions to Comply with City's Insurance Requirements:

**CITY OF LOS ANGELES  
INSTRUCTIONS AND INFORMATION  
ON COMPLYING WITH CITY INSURANCE REQUIREMENTS**  
(Share this information with your insurance agent or broker.)

1. **Agreement/Reference.** All evidence of insurance must identify the nature of your business with the CITY. Clearly show any assigned number of a bid, contract, lease, permit, etc. or give the project name and the job site or street address to ensure that your submission will be properly credited. Provide the **types of coverage and minimum dollar amounts** specified on the Required Insurance and Minimum Limits sheet (Form Gen. 146) included in your CITY documents.

2. **When to Submit.** Normally, no work may begin until an Office of the City Administrative Officer, Risk Management insurance approval number has been obtained, so documents should be submitted as early as practicable. For **As-needed Contracts**, insurance need not be submitted until a specific job has been awarded. **Design Professionals** coverage for new construction work may be submitted simultaneously with final plans and drawings, but before construction commences.

3. **Acceptable Evidence and Approval.** An **Insurance Industry Certificate of Insurance (such as an ACORD Certificate)** containing a thirty (30) days' cancellation notice provision (ten (10) days for non-payment of premium) AND an Additional Insured Endorsement naming the CITY an additional insured completed by your insurance company or its designee is the preferred form of evidence of insurance. If policy includes an automatic or blanket additional insured endorsement, the ACORD certificate must state the City is covered by this endorsement. An endorsement naming the CITY an Additional Named Insured and Loss Payee as Its Interests May Appear is required on property policies. All evidence of insurance must be authorized by a person with authority to bind coverage, whether that is the authorized agent/broker or insurance underwriter.

Acceptable Alternatives to **Insurance Industry Certificates of Insurance:**

- A **copy of the full insurance policy** which contains a thirty (30) days' cancellation notice provision (ten (10) days for non-payment of premium) and additional insured and/or loss-payee status, when appropriate, for the CITY.
- **Binders and Cover Notes** are also acceptable as interim evidence for up to 90 days from date of approval.

Additional Insured Endorsements DO NOT apply to the following:

- Indication of compliance with statute, such as Workers' Compensation Law or the California Financial Responsibility Law for Automobile Liability.
- Professional Liability insurance.

Completed **Insurance Industry Certificates of Insurance** can be sent electronically ([CAO.insurance.bonds@lacity.org](mailto:CAO.insurance.bonds@lacity.org)) or faxed to the Office of the City Administrative Officer, Risk Management ((213) 978-7615 or (213) 978-7616). Electronic submission is the preferred method of submitting your documents. Verification of approved insurance and bonds may be obtained by checking the Office of the City Administrative Officer, Risk Management, Insurance & Bonds Compliance System at <http://www.lacity.org/cao/risk/index.htm>.

4. **Renewal.** When an existing policy is renewed, submit an Insurance Industry Certificate of Insurance or a renewal endorsement. If your policy number changes, you must submit a new Additional Insured Endorsement.

5. **Alternative Programs/Self-Insurance.** Risk financing mechanisms such as Risk Retention Groups, Risk Purchasing Groups, off-shore carriers, captive insurance programs and self-insurance programs are subject to separate approval after the CITY has reviewed the relevant audited financial statements. To initiate a review for approval of your program, you should complete and submit the Applicant's Declaration of Self Insurance form (<http://www.lacity.org/cao/risk/InsuranceForms.htm>) to the Office of the City Administrative Officer, Risk Management for consideration.

6. **General Liability** insurance covering your operations (and products, where applicable) is required whenever the CITY is at risk of third-party claims which may arise out of your work or your presence or special event on CITY premises. **Sexual Misconduct** coverage is a required coverage when the work performed involves minors. **Fire Legal Liability** is required for persons occupying a portion of CITY premises. (Information on two City insurance programs, the SPARTA program, an optional source of low-cost insurance which meets most minimum requirements, and PROMPT COVER, which provides liability coverage for short-term special events on CITY premises or streets, is available at <http://www.2sparta.com>, or by calling (800) 420-0555.)

7. **Automobile Liability** insurance is required only when vehicles are used in performing the work of your Contract or when they are driven off-road on CITY premises; it is not required for simple commuting unless CITY is paying mileage. However, compliance with California law requiring auto liability insurance is a contractual requirement.

8. **Errors and Omissions** coverage will be specified on a project-by-project basis if you are working as a licensed or other professional. The length of the claims discovery period required will vary with the circumstances of the individual job.

9. **Workers' Compensation and Employer's Liability** insurance are not required for single-person contractors. However, under state law these coverages (or a copy of the state's Consent To Self Insure) must be provided if you have any employees at any time during the period of this contract. Contractors with no employees must complete a Request for Waiver of



Workers' Compensation Insurance Requirement form from <http://www.lacity.org/cao/risk>. A **Waiver of Subrogation** on the coverage is required only for jobs where your employees are working on CITY premises under hazardous conditions, e.g., uneven terrain, scaffolding, caustic chemicals, toxic materials, power tools, etc. The Waiver of Subrogation waives the insurer's right to recover (from the CITY) any workers' compensation paid to an injured employee of CONTRACTOR/CONSULTANT.

10. **Property Insurance** is required for persons having exclusive use of premises or equipment owned or controlled by the CITY. **Builder's Risk/Course of Construction** is required during construction projects and should include building materials in transit and stored at the project site.

11. **Surety coverage** may be required to guarantee performance of work. A **Crime Policy** may be required to handle CITY funds or securities, and under certain other conditions. **Specialty coverages** may be needed for certain operations. For assistance in obtaining the CITY-required bid, payment and performance surety bonds, please see the Bond Assistance Program Los Angeles at <http://www.imwis.com/citylosangeles.htm> or call (213) 327-0298 for more information.