



March 21, 2022

M E M O R A N D U M

TO: Jim Murdaugh, Ph.D.
President

FROM: Barbara Wills, Ph.D.
Vice President for Administrative Services and Chief Business Officer

SUBJECT: Oyster Dome License Agreement

Item Description

This item is a request for approval of the Exclusive License Agreement between TCC and Restord Tech, LLC. This document will provide to Restord Tech a license to develop commercial applications of the oyster reef dome.

Overview and Background

TCC holds the assignment of invention of the oyster dome, provided March 26, 2019. This Exclusive License allows Restord Tech, LLC to manufacture, deploy and sell the oyster dome. Restord Tech will pay TCC 100% of the net profits until such time the College has fully recouped costs. After initial recovery of costs, Restord Tech agrees to pay TCC 10% of net profits. The Agreement also provides a process for Restord Tech to purchase the patent rights from the College.

Funding/ Financial Implications

Financial implications are to be determined based on future net profits.

Past Actions by the Board

There have been no past actions by the Board. Also presented to the Board at this meeting is the Revenue Sharing Agreement.

Recommended Action

Approve the Exclusive License Agreement between TCC and Restord Tech, LLC.

EXCLUSIVE LICENSE AGREEMENT
BETWEEN TCC AND RESTORD TECH, LLC

This Exclusive License Agreement (this “Agreement”) is entered by and between The District Board of Trustees of Tallahassee Community College (the “Licensor”) and Restord Tech LLC, (the “Licensee”) as of _____ (the “Effective Date”).

RECITALS

WHEREAS, Licensor is the owner of, or has acquired the patent rights to the Oyster Reef Dome, as further described in Appendix A.

WHEREAS, Licensee has the capability of developing commercial applications of the Oyster Reef Dome to which Licensor currently holds the intellectual property rights.

WHEREAS, Licensor is willing to grant a license to Licensee and Licensee desires a license from them.

NOW THEREFORE, in consideration of the promises and mutual covenants contained in this Agreement, the parties agree as follows:

SECTION 1: DEFINITIONS

1.1 “Annual Financial Report” means a written account of Licensee’s financial earnings over the calendar year preceding submission of the report. The report will give Licensor access to financial information of Licensee as if they are in a Florida partnership. The Annual Financial Report shall be audited by an independent auditor, at the expense of the Licensee, and provided to the Licensor by March 1 for the preceding calendar year.

1.2 “Exclusive License” means a license to be the sole manufacturer, seller, and distributor of the Oyster Reef Dome and the sole right to sublicense or transfer the license.

1.3 “Licensed Product” means any product or part thereof, on a country-by-country basis, which is covered in whole or in part by the Patent Rights, in any country in which such product is made, used, exported, imported, sold, or manufactured by using a process which is covered in whole or in part by the Patent Rights.

1.4 “Licensed Territory” means worldwide.

1.5 “Net Profits” means the total dollar amount invoiced on sales of Licensed Product by Licensee or by any Sublicensee, less costs of production for the Oyster Reef Domes; costs of surveying and evaluating location prior to installation of Oyster Reef Domes; costs of transport of Oyster Reef Domes to location of installation; costs of installation of Oyster Reef Domes; insurance; taxes; and legal costs.

1.6 “Oyster Reef Dome” means the concrete dome created for the purpose of becoming an artificial oyster reef, as more fully described in the Patent Application, attached as Appendix B.

1.7 “Patent Challenge” means a formal, written challenge, brought in any judicial or administrative governmental forum having jurisdiction over the subject matter, to the validity, patentability, and/or enforceability of any claim or claims of the Patent Rights.

1.8 “Patent Rights” means rights to the patented Oyster Reef Dome, identified in Appendix A.

1.9 “Sublicense” means the agreement to grant to, or the agreement not to assert against, a third party any of the rights granted to Licensee under Section 2. An agreement which is described in this definition is a Sublicense whether or not it is called a “sublicense” and whether or not it is included in a stand-alone document or is part of a broader collaboration, development, or joint venture agreement or arrangement, but shall not include any manufacturing or distribution company or other third party which manufactures or distributes Licensed Product on behalf of Licensee.

1.10 “Sublicensee” means any third party granted a Sublicense.

SECTION 2: GRANT OF LICENSE RIGHTS

2.1 Patent Rights. In return for the payments described in Section 5, Licensor hereby grants to Licensee an exclusive license to use the Oyster Reef Dome in the Licensed Territory to make, have made, use, sell, have sold, import, and export Licensed Products.

2.2 Sublicense Rights.

(a) Licensee may grant written Sublicenses to third parties. However, Licensee shall notify Licensor of the initiation of license negotiations with all potential Sublicensees. Any agreement granting a Sublicense shall state the Sublicense is subject to the terms of this Agreement. Licensee has the same responsibility for the activities of any Sublicensee under any Sublicense as if the activities were directly those of Licensee.

(b) Licensor has right to receive copies of Sublicenses subject to the ability to redact confidential information of the Sublicensee which is not reasonably necessary for Licensor to confirm the compliance of the Sublicense with this Agreement (hereinafter “Redacted Sublicense”). Licensee shall provide Licensor with a final copy of each Redacted Sublicense and will include in each Annual Financial Report submitted to Licensor hereunder, which shall include reporting on development of Licensed Products and payments under the Sublicense agreements.

2.3 Retained Rights. Licensor reserves to itself the right under the Patent Rights to develop, import, and use Licensed Products solely for internal not-for-profit research.

SECTION 3: OBLIGATIONS OF LICENSEE

3.1 Licensee agrees and warrants:

(a) Licensee will prepare and provide Licensor an audited Annual Financial Report after the end of each calendar year, no later than March 1 of each year.

(b) Licensee shall pay Licensor in accordance with a separately executed Revenue Sharing Agreement.

SECTION 4: OBLIGATIONS OF LICENSOR

4.1 Licensor agrees and warrants:

(a) Licensor will give Licensee an Exclusive License to manufacture, deploy, and sell the Oyster Reef Dome and the sole right to sublicense or transfer the License with prior written approval of the Licensor, which approval shall not be unreasonably withheld, conditioned or delayed.

(b) Licensor shall split the Net Profits in accordance with a separately executed Revenue Sharing Agreement.

(c) Licensee will have the option to purchase the Patent Rights from Licensor for the fair market value of the Patent Rights at the time of purchase or for \$100,000.00, whichever is greater at the time of purchase. The fair market value of the Patent Rights at the time of purchase is to be determined by an independent appraiser with experience in valuation of patent rights. If the Parties cannot agree on an independent appraiser, one appraiser shall be designated by Licensee, one appraiser shall be designated by Licensor, and the two appraisers shall designate an independent appraiser with experience in valuation of patent rights to determine the fair market value of the Patent Rights. The valuation of the third appraiser shall be binding. Licensee and Licensor shall each pay one-half of the cost of any appraisal.

SECTION 5: PAYMENTS

5.1 Licensee shall pay Licensor 100 percent of Net Profits until such time as Licensor has fully recouped all direct and indirect costs incurred by Licensor in the development of the Patent Rights.

5.2 Licensee shall pay Licensor 10 percent of Net Profits of Licensed Products for each calendar year as soon as the Net Profits are determined by check. The first payment made once the Net Profits are determined will be to Licensor.

5.3 With respect to Sublicenses granted by Licensee or by a Sublicensee under Section 2.3(a), Licensee shall pay to Licensor an amount equal to what Licensee would have been required to pay had Licensee sold the Licensed Products which are sold by a Sublicensee.

(a) Licensee may not receive from Sublicensees anything of value in lieu of cash payments in consideration for any Sublicense under this Agreement without the express prior written approval of Licensor, which approval Licensor may not unreasonably withhold, condition, or delay.

5.4 Except as otherwise directed, Licensee shall pay all amounts owing to Licensor under this Agreement in United States dollars at the following address:

Attn: Vice President of Administrative Services
Tallahassee Community College
444 Appleyard Drive
Tallahassee, Florida 32304

5.5 Based on the financial statement provided by Licensee, Licensor will confirm the amount due to the Licensor. If no payment is due, Licensor should provide a written affirmation of this fact.

5.6 Licensee shall be entitled to deduct from the payments otherwise due to Licensor hereunder the amount of any withholding taxes, value-added taxes or other taxes, levies or charges which may be imposed on Licensee by any government or political subdivision with respect to such payments which are required to be withheld.

SECTION 6: WARRANTIES AND DISCLAIMERS OF LICENSEE

6.1 Licensor represents its employees have assigned their entire right, title, and interest in the Patent Rights which it has authority to grant the rights and licenses set forth in this Agreement. However, nothing in this Agreement is:

(a) a warranty or representation by Licensor of the validity or scope of any right included in the Patent Rights;

(b) a warranty or representation of anything made, used, sold or otherwise disposed of under the license granted in this Agreement does not infringe patents or other rights of third parties;

(c) an obligation to bring or prosecute actions or suits against third parties for infringement of Patent Rights; or

(d) an obligation to furnish services other than those specified in this Agreement.

6.2 Licensor assumes no responsibilities whatsoever with respect to construction, use, sale, transport, installation, or other disposition by licensee or its sublicensees. Neither party shall be liable for any consequential, indirect or special damages arising out of this Agreement or any breach of this Agreement.

SECTION 7: INFRINGEMENT AND INVALIDITY

7.1 Licensee shall inform Licensor, and similarly Licensor shall inform Licensee, promptly in writing of any alleged infringement of the Patent Rights in the Licensed Territory by a third party and of any available evidence of the alleged infringement.

7.2 Licensee may, but is not obligated to, prosecute at its own expense any alleged infringement of the Patent Rights and shall have the first right to do so. Licensee will not prosecute or take any other enforcement-related steps with respect to any such infringements of the Patent Rights except as is provided in Section 7.3. Licensee shall first apply any recovery of damages of any unreimbursed expenses and legal fees of Licensee relating to the suit and next toward reimbursement of Licensor for any legal fees and unreimbursed expenses born by Licensor. Licensee will keep any remaining balance. Licensee may not enter any settlement, consent judgment, or other voluntary final disposition of the suit without the prior, written consent of Licensor, which consent Licensor may not unreasonably withhold. Licensee shall indemnify Licensor against any order for costs and legal fees which may be made against Licensor in the proceedings.

7.3 If Licensee is unsuccessful in persuading the alleged infringer to desist, has not brought an infringement action against the alleged infringer (unless, and only so long as, Licensee has, as part of its enforcement strategy, reasonable grounds supporting a delay by Licensee in bringing such action against a particular alleged infringer or infringers, and Licensee so notifies Licensor and provided Licensor's rights against such infringer are preserved), or notifies Licensor of its intention not to bring suit against the alleged infringer, then, and in those events only, Licensor may, but is not obligated to, prosecute at its own expense such alleged infringement of the Patent Rights. Licensor may use the name of Licensee as party plaintiff in the infringement action without expense to Licensee. If Licensor undertakes the enforcement of the Patent Rights by litigation, Licensor shall apply any recovery of damages first in satisfaction of any unreimbursed expenses and legal fees of Licensor relating to the suit and next toward reimbursement of Licensee for any legal fees and unreimbursed expenses born by Licensee at Licensor's request. Any remaining balance shall be distributed as Net Profits in accordance with the Revenue Sharing Agreement.

7.4 If Licensee undertakes the enforcement or defense of the Patent Rights by litigation, Licensor may voluntarily join the litigation, represented by its own counsel at its own expense. Licensee shall apply any recovery of damages first in satisfaction of any unreimbursed expenses and legal fees of Licensee relating to the suit and next toward reimbursement of Licensor for any legal fees and unreimbursed expenses.

7.5 In any suit in which either party is involved to enforce or defend the Patent Rights pursuant to this Agreement, the other party shall, at the request and expense of the party initiating the suit, cooperate in all respects and, to the extent possible, have its employees testify when requested and make available relevant records, papers, information, samples, and the like.

SECTION 8: ASSIGNABILITY

8.1 This Agreement may not be transferred or assigned by Licensee except with the prior written approval of Licensor, which approval may not be unreasonably withheld, conditioned, or delayed. Any attempted assignment in contravention of this Section 8.1 is void.

- (a) The new assignee shall assume all responsibilities under this Agreement and agree in writing to Licensor to be bound by this Agreement.

8.2 Licensor has the exclusive right to assign its rights under this Agreement to the Tallahassee Community College Foundation, Inc. If such assignment is made, all other material provisions of this Agreement shall remain the same.

SECTION 9: INDEMNIFICATION

9.1 Licensee and Sublicensee(s) shall, at all times during the term of this Agreement and thereafter, indemnify, defend and hold The District Board of Trustees of Tallahassee Community College, Licensor, and each of their directors, trustees, officers, employees, agents, and the inventor of the Patent Rights, regardless of whether the inventor is employed by Licensor at the time of the claim, harmless against all claims and liabilities, including legal expenses and reasonable attorneys' fees, arising from a third party claim, arising out of the death of or injury to any person or persons or out of any damage to property and against any other third party claim, proceeding, demand, expense and liability resulting from the development, production, manufacture, sale, use, or lease of Licensed Products; except to the extent such claims result from the gross negligence, willful misconduct or breach of applicable law by any indemnitee. Licensor shall give Licensee prompt notice of any such claim. Notwithstanding the above, Licensor at all times reserves the right to retain counsel of its own to defend the interests of Licensor, The District Board of Trustees of Tallahassee Community College Board of Trustees, Licensor, and the inventor. Licensor shall give Licensee prompt notice of any such claim.

SECTION 10: INSURANCE

10.1 Licensee shall, throughout the term of this Agreement, obtain and maintain at its own cost and expense from a qualified insurance company licensed to do business in Florida with a Best Rating of B+ or better, standard product liability insurance naming Licensor and its officers, directors, trustees, employees, agents, and shareholders as additional insured parties. Such policy shall provide protection against all claims, demands and causes of action arising out of any defects or failure to perform, alleged or otherwise, of the Licensed Products or any material used in connection therewith or any use thereof. The amount of liability coverage shall be \$1,000,000 with \$200,000 per person, \$300,000 per occurrence. The Licensee must provide a Certificate of Liability insurance as proof of coverage, with the Licensor being named as an additional insured party on the insurance plan. The policy shall provide for thirty (30) days' notice to Licensor from the insurer by registered or certified mail, return receipt requested, in the event of any modification, cancellation or termination thereof. Licensee agrees to furnish Licensor a certificate of insurance evidencing same prior to the Effective Date and in no event shall Licensee manufacture, distribute or sell any Licensed Products prior to receipt by Licensor of such evidence of insurance.

SECTION 11: USE OF NAMES

11.1 Licensee and its Sublicensee(s) may not use the names or logos of Licensor, nor of any of the institution's employees, trustees, agents, or affiliates, except for the name of the inventor of the Oyster Reef Dome, nor any adaptation of those names, in any promotional, advertising or marketing materials or any other form of publicity, or to suggest any endorsement by these entities or individuals, without the prior written approval of Licensor in each case, which approval the Licensor may not unreasonably withhold, condition, or delay.

SECTION 12: MISCELLANEOUS

12.1 Governing Law. This Agreement shall be governed and construed in accordance with the internal laws of the State of Florida.

12.2 Independent Contractors. The parties are independent contractors and not joint venturers or partners.

12.3 Integration. This Agreement constitutes the full understanding between the parties with reference to its subject matter, and no statements or agreements by the parties, whether oral or in writing, may modify the terms of this Agreement. Neither party may claim any amendment, modification, or release from any provisions of this Agreement, unless the mutual agreement is in writing and signed by both parties.

12.4 Laws and Regulations. Licensee shall comply with all local, state, federal, and international laws and regulations which are applicable to the development, manufacture, use, and sale of Licensed Products.

12.5 Force Majeure. Neither party is responsible for default, delay, or failure to perform, if such default, delay or failure to perform is due to causes beyond the party's reasonable control, including, but not limited to, acts of God, wars, acts of public enemies, strikes, fires, floods, or other natural disasters beyond the control of the parties, provided the nonperforming party uses commercially reasonable efforts to avoid or remove those causes of nonperformance and continues performance under this Agreement with reasonable dispatch when the causes are removed. In the event of a default, delay or failure to perform described in this Section 12.5, any date or times by which either party is scheduled to perform is extended automatically for a time equal to the time lost by reason of the excused default, delay or failure to perform.

12.6 Severability. If any provision of this Agreement shall be held invalid, illegal or unenforceable, such provision shall be enforced to the maximum extent permitted by law and the parties' fundamental intentions hereunder, and the remaining provisions shall not be affected or impaired.

SECTION 13: NOTICES

13.1 The parties shall provide any notice required to be given pursuant to this Agreement in writing to the addresses listed in this Section 13.1. Notice is effective on the day it is delivered personally with written receipt from an authorized signatory, on the second day after the day on which the notice has been delivered for next day delivery prepaid to a nationally recognized courier service, on the fifth business day following deposit in the United States mail if sent certified or registered mail, (return receipt acknowledgement is not required to certify delivery).

If to Licensor:

Attn: Vice President of Administrative Services
Tallahassee Community College
444 Appleyard Drive
Tallahassee, Florida 32304

If to Licensee:

Attn: Robert G. Ballard
3189 Mulberry Park Blvd.
Tallahassee, Florida 32311

SECTION 14: DISPUTE RESOLUTION

14.1 The Parties expressly waive any right to a trial by jury regarding any action, legal or equitable, arising out of this Agreement. Prior to bringing any legal or equitable action in any court of law, the Parties hereby irrevocably consent to mediation in Leon County, Florida. Said mediation shall be conducted within 120 days of a Party providing written notice of said Party’s claim(s) and request to mediate. The Parties shall make a good faith effort to agree upon a mediator. To the extent the Parties are unable to agree, the mediator shall be chosen from a list of certified mediators provided by the Florida Bar.

14.2 Venue. The state and federal courts located in Leon County, Florida, shall have exclusive jurisdiction to adjudicate any dispute arising out of or relating to this Agreement. Each party hereby consents to the jurisdiction of such courts and waives any right it may otherwise have to challenge the appropriateness of such forums, whether on the basis of the doctrine of *forum non conveniens* or otherwise. Each party also hereby waives any right to jury trial in connection with any action or litigation in any way arising out of or related to this Agreement.

SECTION 15: CONTRACT FORMATION AND AUTHORITY

15.1 Construction. The titles of the sections of this Agreement are for convenience of reference only and are not to be considered in construing this Agreement. Unless the context of this Agreement clearly requires otherwise: (a) references to the plural include the singular, the singular the plural, and the part the whole, (b) references to one gender include all genders, (c) “or” has the inclusive meaning frequently identified with the phrase “and/or,” (d) “including” has

the inclusive meaning frequently identified with the phrase “including but not limited to” or “including without limitation,” and (e) references to “hereunder,” “herein” or “hereof” relate to this Agreement as a whole. Any reference in this Agreement to any statute, rule, regulation or agreement, including this Agreement, shall be deemed to include such statute, rule, regulation or agreement as it may be modified, varied, amended or supplemented from time to time.

15.2 Entire Agreement. This Agreement embodies the entire agreement and understanding between the parties hereto with respect to the subject matter of this Agreement and supersedes all prior or contemporaneous agreements and understandings other than this Agreement relating to the subject matter hereof.

15.3 Amendment and Waiver. This Agreement may be amended only by a written agreement executed by the parties hereto. No provision of this Agreement may be waived except by a written document executed by the party entitled to the benefits of the provision. No waiver of a provision will be deemed to be or will constitute a waiver of any other provision of this Agreement. A waiver will be effective only in the specific instance and for the purpose for which it was given and will not constitute a continuing waiver.

15.4 Counterparts. This Agreement may be in any number of counterparts, each of which will be deemed an original, but all of which together will constitute one instrument.

15.5 The submission of this Agreement is not an offer, and this document is effective and binding only upon the execution by duly authorized representatives of both Licensee and Licensor. Copies of this Agreement which have not been executed and delivered by both Licensor and Licensee do not evidence an agreement between the parties.

15.6 Licensor and Licensee hereby warrant and represent the persons signing this Agreement have authority to execute this Agreement on behalf of the party for whom they have signed.

SECTION 16: TERMINATION OF AGREEMENT

16.1 This Agreement shall be terminated by mutual consent of both parties in writing, by the sale of Restord Tech in accordance with Section 4.1(a) of this Agreement, by Licensee’s purchase of the patent from the Licensor in accordance with Section 4.1(e) of this Agreement, or by material breach of this Agreement, as described in Section 17.1 (a), with 30 days’ notice and time to cure the breach.

(a) Material breach of this Agreement shall be defined as falsification of records; falsification of reports; failure to distribute Net Profits in accordance with the Revenue Sharing Agreement; failure to provide Licensor with Oyster Reef Domes in accordance with Section 3.1(c) of this Agreement, failure to maintain liability insurance in compliance with Section 10 of this Agreement; improper use of Licensor’s name or logos or names of Licensor’s employees, trustees, agents, or affiliates in violation of Section 11 of this Agreement; any violation of a federal, state, or local law, rule, or permitting requirement; any violation of EPA rules or regulations; any

violation of DEP rules or regulations; any violation of federal or state fish and wildlife rules or regulations; or any violation of Department of Labor and OSHA rules or regulations.

The parties have duly executed this Agreement on the dates indicated below.

Restord Tech LLC

The District Board of Trustees of
Tallahassee Community College

/s/ _____

By: /s/ _____

Date:

Date: