

RESOLUTION NO. 2019- 297

A RESOLUTION BY THE BOARD OF COUNTY COMMISSIONERS OF ST. JOHNS COUNTY, FLORIDA, APPROVING THE TERMS, PROVISIONS, CONDITIONS, AND REQUIREMENTS OF AN INTELLECTUAL PROPERTY ASSIGNMENT AGREEMENT BETWEEN THE COUNTY AND REHAB FOR FIREFIGHTERS, INC., AND AUTHORIZING THE COUNTY ADMINISTRATOR, OR DESIGNEE, TO EXECUTE THE AGREEMENT ON BEHALF OF THE COUNTY.

RECITALS

WHEREAS, Rehab for Firefighters (RFF) is a Florida corporation whose founder and sole director, Jason Gerona, is employed in St. Johns County's Fire Rescue Department; and

WHEREAS, while employed with the County, Gerona invented a SMART trailer, which is described as a single-unit resource that provides prehab and rehab essentials and logistical support for firefighters at emergency incidents and training events; and

WHEREAS, under Florida law, St. Johns County does not have the legal authority to obtain copyright, registered trademark, or patent protection for its intellectual property rights; and

WHEREAS, the County desires to assign and transfer to RFF any intellectual property rights that it may have in the SMART trailer and the other intellectual property described in the attached agreement; and

WHEREAS, RFF desires to acquire any intellectual property interest that it may have in the SMART trailer and the other intellectual property described in the attached agreement,

NOW, THEREFORE, BE IT RESOLVED BY THE BOARD OF COUNTY COMMISSIONERS OF ST. JOHNS COUNTY:

Section 1. The above recitals are incorporated into the body of this resolution and are adopted as findings of fact.

Section 2. The Board of County Commissioners approves the terms, provisions, conditions, and requirements of the agreement and authorizes the County Administrator, or his designee, to execute the agreement in substantially the same form as attached on behalf of the County.

Section 3. To the extent that there are typographical or administrative errors that do not change the tone, tenor, or concept of this Resolution, then this Resolution may be revised without subsequent approval of the Board of County Commissioners.

Section 4. This resolution shall be effective upon its adoption by the Board of County Commissioners.

PASSED AND ADOPTED by the Board of County Commissioners of St. Johns County, Florida, this 12th day of September, 2019.

**BOARD OF COUNTY COMMISSIONERS OF
ST. JOHNS COUNTY, FLORIDA**

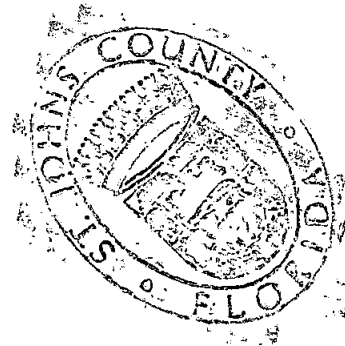
Attest: Hunter S. Conrad, Clerk

Pam Hatterman
Deputy Clerk

By:

Paul M. Waldron
Paul M. Waldron, Chair

RENDITION DATE 9/17/19



INTELLECTUAL PROPERTY ASSIGNMENT AGREEMENT

This Intellectual Property Assignment Agreement (the Agreement) is made and effective as of _____, 2019 (the Effective Date), between St. Johns County, a political subdivision of the state of Florida (the County) and Rehab for Firefighters, Inc., a Florida corporation, (R4FF). The County and R4FF may be referred to individually as a Party or collectively as the Parties.

RECITALS

WHEREAS, R4FF is a Florida corporation whose founder and sole director is Jason Gerona (Gerona), an employee of the County's Fire Rescue Department; and

WHEREAS, while employed with the County's Fire Rescue Department, Gerona invented a SMART trailer, described more particularly in Exhibit A; and

WHEREAS, under Florida law, the County does not have the legal authority to obtain copyright, trademark, or patent protection for its intellectual property rights; and

WHEREAS, the County desires to assign and transfer to R4FF any intellectual property rights that it may have in the SMART trailer and the other intellectual property described in this Agreement; and

WHEREAS, R4FF desires to acquire all of the County's intellectual property rights in the SMART trailer and the other intellectual property described in this Agreement; and

WHEREAS, each Party is duly authorized and capable of entering into this Assignment.

NOW, THEREFORE, in consideration of the covenants and premises set forth herein, and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Parties hereto agree as follows:

1. ASSIGNMENT OF INTELLECTUAL PROPERTY.

As of the Effective Date of this Agreement, the County assigns to R4FF all right, title, and interest that it may have in all intellectual property rights that it may have in the intellectual property described in Exhibit A (the Intellectual Property), attached hereto and incorporated herein. For the purpose of this Agreement, "intellectual property rights" means all patent, trademark, service mark, tagline, trade dress, copyright, design, trade name, business name, domain name, any registration or application for registration for any of the foregoing, any related rights and all associated goodwill, database right, rights in inventions, know-how, trade secret, rights in confidential information, rights of publicity, moral rights, or all similar or equivalent rights in any part of the world, including the right to enforce and recover damages for the infringement or misappropriation of all of the foregoing, and all copies and tangible embodiments of the foregoing.

Assignor Initials: _____

Assignee Initials: _____

2. NON-EXCLUSIVE LICENSE

- (a) In consideration of the County's assignment of its intellectual property rights to R4FF, R4FF grants the County a non-exclusive license to use the Intellectual Property, subject to the limitations set forth herein. The grant of this license includes the right of the County to use all inventions, patents, trade secrets, copyrights, software programs, works of authorship, trademarks, service marks, and other intellectual property rights shown in Exhibit A. For clarity, the County understands and agrees all future inventions, patents, trade secrets, copyrights, software programs, works of authorship, trademarks, service marks, and other intellectual property rights not shown in Exhibit A are specifically excluded from this Agreement. The subject matter of the County's non-exclusive license is specifically limited to the exact disclosure shown in Exhibit A and shall not include any other trailer.
- (b) The rights granted by this non-exclusive license are subject to the following limitations:
 - i. The County may not copy or distribute any of the Intellectual Property except as necessary in connection with its use of the Intellectual Property in the course of its day-to-day operations;
 - ii. The County may not modify, decompile, disassemble, reverse engineer, or create derivative works based on the Intellectual Property; and
 - iii. The County shall use the Intellectual Property in compliance with applicable law, including, but not limited to, all applicable provisions of patent and other intellectual property laws.
- (c) Nothing in this non-exclusive license shall be deemed to grant to the County any ownership rights to the Intellectual Property other than the rights specifically granted herein.
- (d) The rights granted to the County by virtue of this non-exclusive license may not be sublicensed or assigned without the written consent of R4FF.

3. COUNTY'S REPRESENTATIONS.

The County represents to the R4FF that it:

- (a) is, to the best of its knowledge, the sole owner (other than Gerona or R4FF) of all right, title, and interest in and to the Intellectual Property;

Assignor Initials: _____

Assignee Initials: _____

- (b) has not assigned, transferred, licensed, pledged, or otherwise encumbered any Intellectual Property or agreed to do so;
- (c) has full power and authority to enter into this Agreement and to make the assignment as provided in Section 1;
- (d) is not aware of any violation, infringement, or misappropriation of any third party's rights (or any claim thereof) by the Intellectual Property;
- (e) is not aware of any third-party consents, assignments, or licenses that are necessary to perform under this Agreement;
- (f) is not aware of any questions or challenges with respect to the patentability or validity of any claims of any existing patents or patent applications relating to the Intellectual Property; and
- (g) was not acting within the scope of employment of any third party when conceiving, creating, or otherwise performing any activity with respect to any item of Intellectual Property purportedly assigned in Section 1.

The County agrees to immediately notify R4FF in writing if any facts or circumstances arise that would make any of the representations in this Agreement inaccurate.

4. DOCUMENTATION.

The County will, as soon as is reasonably possible following a request from R4FF, provide R4FF with a complete copy of any documentation in its possession relating to the Intellectual Property for R4FF's own use, to meet record-keeping requirements of R4FF, or to allow R4FF to assert its rights granted pursuant to this Agreement. The County will also, on request:

- (a) execute and deliver, or cause to be executed and delivered, to the R4FF any additional papers, including any separate assignments of the Intellectual Property, reasonably necessary to record the assignment in the United States and throughout the world;
- (b) do all other lawful acts reasonable and necessary to record the Agreement in the United States and throughout the world; and
- (c) execute all lawful papers reasonable and necessary for R4FF to obtain a patent, copyright, or trademark on any of the Intellectual Property and on any continuing, divisional, or reissue applications thereof.

5. SUCCESSORS AND ASSIGNS.

Assignor Initials: _____

Assignee Initials: _____

All references in this Agreement to the Parties shall be deemed to include, as applicable, a reference to their respective successors and assigns. The provisions of this Agreement shall be binding upon and shall inure to the benefit of the successors and assigns of the Parties.

6. NO IMPLIED WAIVER.

The failure of either Party to insist on strict performance of any covenant or obligation under this Agreement, regardless of the length of time for which such failure continues, shall not be deemed a waiver of such Party's right to demand strict compliance in the future. No consent or waiver, express or implied, to or of any breach or default in the performance of any obligation under this Agreement shall constitute a consent or waiver to or of any other breach or default in the performance of the same or any other obligation.

7. NOTICE.

Any notice or other communication provided for herein or given hereunder to a Party hereto shall be in writing and shall be given in person, by overnight courier, or by mail (registered or certified mail, postage prepaid, return receipt requested) to the respective Party as follows:

If to the County:

If to R4FF: Jason
Gerona

8. GOVERNING LAW.

This Agreement shall be governed by the laws of the state of Florida. Venue for any action arising under this Agreement shall lie exclusively in St. Johns County, Florida, or in the federal courts for the Middle District of Florida, Jacksonville Division. In the event that litigation results from or arises out of this Agreement or the performance thereof, the Parties agree to reimburse the prevailing Party's reasonable attorneys' fees, court costs, and all other expenses, whether or not taxable by the court as costs, in addition to any other relief to which the prevailing Party may be entitled.

9. COUNTERPARTS/ELECTRONIC SIGNATURES.

This Agreement may be executed in one or more counterparts, each of which shall

Assignor Initials: _____

Assignee Initials: _____

be deemed an original but all of which shall constitute one and the same instrument. For purposes of this Agreement, use of a facsimile, e-mail, or other electronic medium shall have the same force and effect as an original signature.

10. SEVERABILITY.

Whenever possible, each provision of this Agreement, will be interpreted in such manner as to be effective and valid under applicable law, but if any provision of this Agreement is held to be invalid, illegal, or unenforceable in any respect under any applicable law or rule in any jurisdiction, such invalidity, illegality, or unenforceability will not affect any other provision or any other jurisdiction, but this Agreement will be reformed, construed, and enforced in such jurisdiction as if such invalid, illegal, or unenforceable provisions had never been contained herein.

11. ENTIRE AGREEMENT.

This Agreement, constitutes the final, complete, and exclusive statement of the agreement of the Parties with respect to the assignment of intellectual property rights hereof, and supersedes any and all other prior and contemporaneous agreements and understandings, both written and oral, between the Parties.

12. HEADINGS.

Headings used in this Agreement are provided for convenience only and shall not be used to construe meaning or intent.

THE REMAINDER OF THE PAGE IS INTENTIONALLY BLANK

Assignor Initials: _____

Assignee Initials: _____

IN WITNESS WHEREOF, the Parties have executed this Agreement as of the date first above written.

ST. JOHNS COUNTY

By: _____
Name: _____
Title: _____

**ACKNOWLEDGMENT
OF NOTARY PUBLIC**

State of _____)
County of _____) .ss

On this _____ day of _____, 20____, before me, the undersigned Notary Public, personally appeared _____, personally known to me or proved to me on the basis of satisfactory evidence to be the individual who signed the foregoing document as the authorized representative of the County and acknowledged to me that he/she executed the same in his/her authorized capacity, and that by such signature, the person executed the instrument.

WITNESS my hand and official seal.

Signature of Notary Public: _____

My Commission Expires: _____

Assignor Initials: _____

Assignee Initials: _____

REHAB FOR FIREFIGHTERS, INC.

By: _____
Name: Jason Gerona

**ACKNOWLEDGMENT
OF NOTARY PUBLIC**

State of _____)
County of _____) .ss

On this _____ day of _____, 20____, before me, the undersigned Notary Public, personally appeared _____, personally known to me or proved to me on the basis of satisfactory evidence to be the individual who signed the foregoing document as Rehab for Firefighters, Inc., and acknowledged to me that he/she executed the same in his/her authorized capacity, and that by such signature, the person executed the instrument.

WITNESS my hand and official seal.

Signature of Notary Public: _____

My Commission Expires: _____

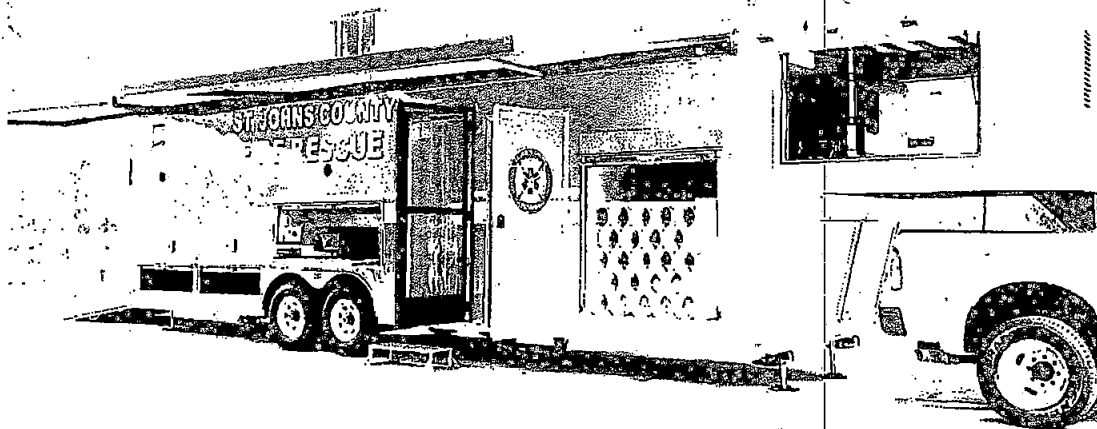
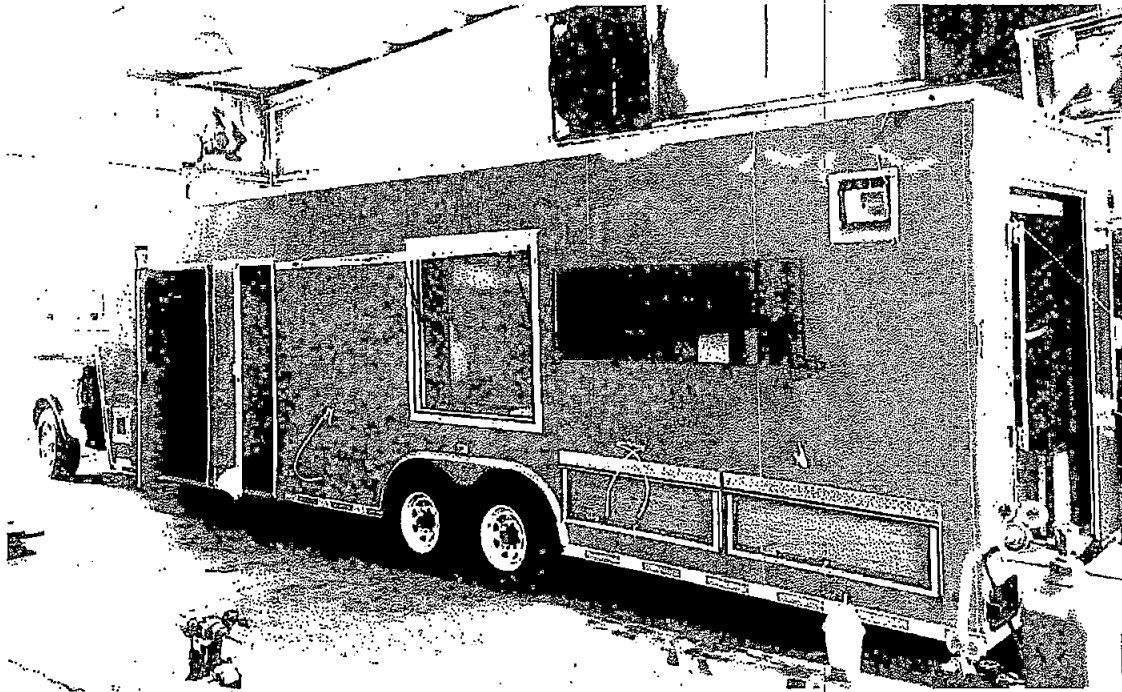
Assignor Initials: _____

Assignee Initials: _____

EXHIBIT A

DESCRIPTION OF INTELLECTUAL PROPERTY

The SMART Trailer is a single-unit resource that provides prehab and rehab essentials, and offers logistical support for firefighters at emergency incidents and training events. It optimizes performance, reduces injury/illness, and defends against cancer.



Assignor Initials: _____

Assignee Initials: _____