



Office Use only
Company Name \_\_\_\_\_
Member Number: \_\_\_\_\_
Date: \_\_\_\_\_



TRADEMARK LICENSE AGREEMENT

THIS AGREEMENT is made this \_\_\_ day of \_\_\_\_\_, 20\_\_\_, by and between National Celiac Association, Inc., a Massachusetts non-profit corporation with its principal place of business located at 225 Schoolmasters Lane, Dedham, Massachusetts 02026 (hereinafter "Licensor"); and \_\_\_\_\_ a \_\_\_\_\_ corporation, with its principal place of business in \_\_\_\_\_ (hereinafter "Licensee").

RECITALS

WHEREAS: Licensor is a non-profit corporation which is organized for the purposes of, among other things, dedication to education and advocacy for individuals with celiac disease and non-celiac gluten sensitivities (NCGS), their families, and communities throughout the United States. Persons with these conditions must maintain a diet which is gluten-free. Licensor is desirous of promoting labeling practices which will readily enable affected persons to identify food products which are gluten-free, and which they may purchase and use with confidence; and

WHEREAS: The Licensor seeks to develop sources of revenue which will assist the Licensor to accomplish the objectives and goals referred to in the foregoing paragraph;

WHEREAS: Licensor has adopted and used the trademark which is attached hereto and marked Appendix 1 (the "Mark") since at least June, 2017 and, in a substantially similar form used by a predecessor company, at least as early as June 2003; and

WHEREAS: Licensor applied for a federal registration for the Mark in June, 2017. The application is currently pending; and

WHEREAS: Licensor has established substantial secondary meaning in the Mark due to its long and widespread use and promotion of the Mark in connection with the services provided by the Licensor. As a result, the Mark has become well-known and recognized by persons afflicted with celiac disease and related disorders and by knowledgeable health-care providers. The Mark is associated in the public mind with the Licensor and with foods which are safe for consumption by persons afflicted with celiac disease and dermatitis herpetiformis. Licensor

wishes to promote the Mark as an indicator to persons afflicted with celiac disease and dermatitis herpetiformis of products which are complete free of wheat, barley, and rye; and

WHEREAS: Licensee manufactures and markets products throughout the United States and the world under a wide variety of brand names. The Licensee wishes to assist persons afflicted with celiac disease and related disorders to easily identify products which are marketed by the Licensee which are gluten-free and to use the Mark for that purpose.

NOW, THEREFORE, in consideration of the mutual promises herein contained, and for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged by the parties, it is agreed:

**1. LICENSE:**

(a) Articles. Upon the terms and conditions hereinafter set forth, Licensor hereby grants to Licensee and Licensee hereby accepts the right, license and privilege to utilize the Mark upon and in connection with the manufacture, sale and distribution of the following articles: All products manufactured and sold by the Licensee which are “gluten free” as that term is defined herein (the “Licensed Articles”). For purposes of this Agreement, “gluten free” means a food article product that is completely free of wheat, barley, and rye and their derivatives..

(b) Territory. The license hereby granted extends worldwide (the "Territory").

(c) Term. The term of the license hereby granted shall commence on \_\_\_\_\_, 20\_\_ and shall continue until \_\_\_\_\_, 20\_\_, unless sooner terminated in accordance with the provisions hereof.

**2. CONTRIBUTION:**

Licensee agrees that it will contribute the sum of \$\_\_\_\_\_ to the Licensor to assist the Licensor in meeting its purposes and objectives as stated in the first recital to this Agreement. The Licensee agrees that it will make said contribution contemporaneously with its execution of this Agreement.

**3. EXCLUSIVITY:** The License granted by the Licensor to the Licensee is non-exclusive.

**4. GOODWILL:** Licensee recognizes the great value of the goodwill associated with the Mark, and acknowledges that the Mark and all rights therein and the goodwill **appurtenant** thereto belong exclusively to Licensor, and that the Mark has secondary meaning in the mind of the public.

## **5. LICENSOR'S TITLE AND PROTECTION OF LICENSOR'S RIGHTS:**

(a) Licensee agrees that it will not during the term of this Agreement, or thereafter, attack the title or any rights of Licensor in and to the Mark or attack the validity of this license. Licensor warrants that, to the best of Licensor's knowledge, it is the owner of the Mark, and that there is no other person or entity which claims or has an ownership in the Mark or any other mark which is so similar to the Mark as to be likely to confuse the purchasers of Licensee's products to which this License applies. Licensor hereby agrees to indemnify Licensee and undertakes to hold it harmless against any claims or sub arising solely out of the use by Licensee of the Mark as authorized in this Agreement, provided that prompt notice is given to Licensor of any such claim or suit and provided, further, that Licensor shall have the option to undertake and conduct the defense of any suit so brought and no settlement of any such claim or suit may be made without the prior written consent of Licensor. And provided further, that Licensor's liability to the Licensee arising under this paragraph, or under any and all other terms and conditions of this Agreement, shall be no greater than the amount of the compensation paid to the Licensor by the Licensee under the terms of this Agreement. **FURTHERMORE, UNDER NO CIRCUMSTANCES SHALL LICENSOR BE LIABLE TO LICENSEE FOR ANY CONSEQUENTIAL OR SPECIAL DAMAGES WITH RESPECT TO THE FOREGOING.**

(b) Licensee agrees to assist Licensor to the extent necessary in the procurement of any registration for or to protect any of Licensor's rights to the Mark, and Licensor, it so desires may commence or prosecute any claims or suits in its own name or in the name of Licensee or join Licensee as a party thereto. Licensee shall notify Licensor in writing of any infringements or imitations by others of the Mark on articles the same as or similar to those covered by this Agreement which may come to Licensee's attention, and Licensor shall have the sole right to determine whether or not any action shall be taken on account of any such infringements or imitations. Licensee shall not institute any suit or take any action on account of any such infringements or imitations without first obtaining the written consent of the Licensor to do so.

## **6. INDEMNIFICATION BY LICENSEE:**

(a) Licensee hereby agrees to indemnify Licensor and undertakes to defend Licensee and/or Licensor against and hold licensor harmless for any claims, suits, loss or damage arising out of any allegedly unauthorized use of any trademark, patent, process, idea, method or device by Licensee in connection with the articles covered by this Agreement or any other alleged action by Licensee and also from any claims, suits, loss or damage arising out of alleged defects in the articles, including but not limited to the presence of gluten in such articles. The indemnification provided for in this paragraph shall include an obligation on the part of the Licensee to pay the Licensor's cost and attorney fees.

(b) As used in the first two sentences of this paragraph 6, and for purposes of determining liability of "Licensor," Licensor shall include the officers, directors, agents and employees of the Licensor.

## **7. QUALITY OF MERCHANDISE:**

(a) Licensee agrees that the Licensed Articles covered by this Agreement shall be of high standard and of such style, appearance and quality as to be adequate and suited to their exploitation to the best advantage and to the protection and enhancement of the Mark and the goodwill pertaining thereto, that such Licensed Articles will be manufactured, sold and distributed in accordance with all applicable federal, state and local laws and regulations, and that the manufacture, sale and distribution of such Licensed Articles shall not reflect adversely upon the good name of Licensor or any of its programs or the Mark.

(b) Licensee shall, before selling or distributing any of the Licensed Articles, furnish to Licensor free of cost for its prior written approval a reasonable number of samples of each article, its cartons, containers, packing and wrapping material. The quality and style of such Licensed Articles as well as of any carton, container, packing or wrapping material shall be subject to the approval of Licensor. All Licensed Articles must be “gluten free” as that phrase is defined and used in this Agreement. Any item submitted to Licensor shall not be deemed approved unless and until the same shall be approved by Licensor in writing. After samples have been approved pursuant to this paragraph, Licensee shall not depart therefrom in any material respect without Licensor's prior written consent, and Licensor shall not withdraw Its approval of the samples except on sixty (60) days' prior written notice to licensee.

(c) From time to time after Licensee has commenced selling the Licensed Articles and upon Licensor's written request, Licensee shall furnish without cost to Licensor not more than three additional random samples of each article being manufactured and sold by Licensee hereunder, together with any cartons, containers, packing and wrapping material used in connection therewith. In addition, Licensor shall have the right to inspect Licensee's business operations and facilities with respect to the Licensed Articles in order to assure Licensor that the quality standards and other provisions of this Agreement are being observed.

(d) Nothing contained in this paragraph shall make the Licensor responsible to the Licensee or to any third persons for the quality or suitability of the article. Without limiting the generality of the forgoing, the Licensor shall not have a responsibility to the Licensee or to any third party to determine whether a Licensed Article is in fact “gluten-free” or otherwise safe for consumption by persons afflicted with celiac disease or NCGS.

## **8. LABELING:**

(a) Licensee agrees that it will cause to appear on or within each Licensed Article sold by it under this license and on or within all advertising, promotional or display material bearing the Mark the and the notice as shown on Appendix 2 attached hereto, and where such Licensed Article or advertising, promotional or display material bears a trademark or service mark, appropriate statutory notice of registration or application for registration thereof. In the event that any article is marketed in a carton, container, packing or wrapping material bearing the Mark, such notice shall also appear upon that carton, container, packing or wrapping material. Each and every tag, label, imprint or other device containing any such notice and all advertising, promotional or display material bearing the Mark shall be submitted to Licensor for its written

approval prior to use by Licensee. Approval by Licensor shall not constitute a waiver of Licensor's rights or Licensee's duties under any provision of this Agreement.

(b) Licensee agrees to cooperate fully and in good faith with Licensor for the purpose of securing and preserving Licensor's rights in and to the Mark. In the event there has been no previous registration of the Mark and/or articles and/or any material relating thereto, Licensee shall, at Licensor's request and expense, cooperate in the effort to register a copyright, trademark or service mark in the appropriate class in the name of Licensor. It is agreed that nothing contained in this Agreement shall be construed as an assignment or grant to the Licensee of any right, title or interest in or to the Mark, it being understood that all rights relating thereto are reserved by Licensor, except for the license hereunder to Licensee of the right to use and utilize the Mark only as specifically and expressly provided in this Agreement. Licensee hereby agrees that at the termination or expiration of this Agreement Licensee will be deemed to have assigned, transferred and conveyed to Licensor any rights, equities, goodwill, title or other rights in and to the mark which may have been obtained by Licensee or which may have vested in Licensee in pursuance of any endeavors covered hereby, and that Licensee will execute any instruments requested by Licensor to accomplish or confirm the foregoing. Any such assignment, transfer or conveyance shall be without other consideration than the mutual covenants and considerations of this Agreement

(c) Licensee hereby agrees that its every use of the Mark shall inure to the benefit of Licensor and that Licensee shall not at any time acquire any rights in the Mark by virtue of any use it may make of the Mark.

(d) Licensee shall not suggest in its labeling, advertising or other promotion of any article subject to this Agreement, that Licensor endorses such product; that Licensor has found the product to be fit for consumption by persons afflicted with celiac disease and NCGS; or make any representation regarding the Mark other than as specifically indicated on Appendix 2 which is attached to this Agreement.

## **9. PROMOTIONAL MATERIAL:**

(a) In all cases where Licensee desires artwork involving Licensed Articles, the cost of such artwork and the time for the production thereof shall be borne by Licensee. All artwork and designs involving the Mark, or any reproduction thereof, shall, notwithstanding their invention or use by Licensee, be and remain the property of Licensor and Licensor shall be entitled to use the same and to license the use of the same by others.

(b) Licensor shall have the right, but shall not be under any obligation, to use the Mark and/or the name of Licensee so as to give the Mark, Licensee, Licensor and/or Licensor's programs full and favorable prominence and publicity.

(c) Licensee agrees not to offer for sale, advertise or publicize any of the Licensed Articles hereunder, either online, on radio or television or on social media without the prior written approval of Licensor, which approval Licensor may grant or withhold in its unfettered discretion.

## **10. DISTRIBUTION:**

(a) Licensee agrees that during the term of this Agreement it will diligently and continuously manufacture, distribute and sell the Licensed Articles covered by this Agreement and that it will make and maintain adequate arrangements for the distribution of such articles.

(b) Licensee agrees to sell to Licensor such quantities of the Licensed Articles at as low a rate and on as good terms as Licensee sells similar quantities of the such articles to the general trade.

## **11. BREACH:**

(a) If Licensee shall violate any of its obligations under the terms of this Agreement, Licensor shall have the right to terminate the license hereby granted upon ten days' notice in writing, and such notice of termination shall become effective unless Licensee shall completely remedy the violation within the ten-day period and satisfy Licensor that such violation has been remedied.

(b) Termination of the license under the provisions of this paragraph shall be without prejudice to any rights which Licensor may otherwise have against licensee. Upon the termination of this license, notwithstanding anything to the contrary herein, all royalties on sales theretofore made shall become immediately due and payable.

**12. FINAL STATEMENT UPON TERMINATION OR EXPIRATION:** Sixty (60) days before the expiration of this license and, in the event of its termination, ten (10) days after receipt of notice of termination of the happening of the event which terminates this Agreement where no notice is required, Licensee shall furnish to Licensor a statement showing the number and description of Licensed Articles on hand or in process. Licensor shall have the right to take a physical inventory to ascertain or verify such inventory and statement, and refusal by Licensee to submit to such physical inventory by Licensor shall forfeit Licensee's right to dispose of such inventory with Licensor retaining all legal and equitable rights Licensor may have in the circumstances.

**13. DISPOSAL OF STOCK UPON TERMINATION OR EXPIRATION:** After termination of the license under the provisions of paragraph 12, Licensee, except as otherwise provided in this Agreement, may dispose of Licensed Articles which are on hand or in process at the time notice of termination is received for a period of sixty (60) days after notice of termination. Notwithstanding anything to the contrary herein, Licensee shall not manufacture, sell or dispose of any Licensed Articles after its expiration or its termination based on the failure of the Licensee to affix a notice of copyright, trademark or service mark registration or any other notice to the articles, cartons, containers, packing or wrapping material, advertising, promotional or display material, or if the licensee has departed from the quality and style approved by Licensor pursuant to paragraph 7.

**14. EFFECT OF TERMINATION OR EXPIRATION:** Upon and after the expiration or termination of this license, all rights granted to Licensee hereunder shall forthwith revert to Licensor and Licensee will refrain from further use of the Mark or any further reference to it, direct or indirect, or use of any mark deemed by Licensor to be similar to the Mark in connection with the manufacture, sale or distribution of Licensee's products, except as provided in paragraph 13.

**15. LICENSOR'S REMEDIES:**

(a) Licensee acknowledges that its failure (except as otherwise provided herein) to cease the manufacture, sale or distribution of the Licensed Articles or any class or category thereof at the termination or expiration of this Agreement will result in immediate and irremediable damage to Licensor and to the rights of any subsequent licensee. Licensee agrees that in the event of such failure Licensor shall be entitled to equitable relief by way of temporary and permanent injunctions and such other further relief as any court with jurisdiction may deem just and proper.

(b) Resort to any remedies referred to herein shall not be construed as a waiver of any other rights and remedies to which Licensor may be entitled under this Agreement or otherwise.

**16. NOTICES:** All notices and statements to be given, and all payments to be made hereunder, shall be given or made at the respective addresses of the parties as set forth below unless notification of a change of address is given in writing, and the date of mailing shall be deemed the date the notice or statement is given.

National Celiac Association, Inc.  
105 S. 6<sup>th</sup> Street  
Seward, NE 68434  
Attn: \_\_\_\_\_

[Licensee]  
\_\_\_\_\_  
\_\_\_\_\_  
Attn: \_\_\_\_\_

**17. NO JOINT VENTURE:** Nothing herein contained shall be construed to place the parties in the relationship of partners or joint venturers, and Licensee shall have no power to obligate or bind Licensor in any manner whatsoever.

**18. NO ASSIGNMENT OR SUBLICENSE BY LICENSEE:** This Agreement and all rights and duties hereunder are personal to Licensee and shall not, without the written consent of Licensor, be assigned, mortgaged, sublicensed or otherwise encumbered by Licensee or by operation of law. Licensor may assign the Mark, but shall furnish written notice of assignment.

**19. NO WAIVER:** None of the terms of this Agreement can be waived or modified except by an express agreement in writing signed by both parties. There are no representations, promises, warranties, covenants or undertakings other than those contained in this Agreement, which represent the entire understanding of the parties. The failure of either party hereto to enforce, or the delay by either party in enforcing, any of its rights under this Agreement shall not be deemed a continuing waiver or a modification thereof and either party may, within the time provided by applicable law, commence appropriate legal proceedings to enforce any or an of

such rights. No person, firm, group or corporation other than Licensee and Licensor shall be deemed to have acquired any rights by reason of anything contained in this Agreement.

**20. GOVERNING LAW:** This Agreement shall be governed exclusively by the provisions hereof and by the laws of the Commonwealth of Massachusetts without regard to conflicts-of-laws principles, as such laws may from time to time exist. Any dispute arising hereunder shall be adjudicated in a state court of competent jurisdiction located in Norfolk County, Massachusetts, or the Federal District Court located in Boston, Massachusetts, which court shall have sole and exclusive jurisdiction over the matter. The parties hereto consent to the personal jurisdiction of said court.

**21. ENTIRE AGREEMENT:** This Agreement contains the entire agreement between the parties relating to the subject matter hereof, and all prior proposals, discussions or writings are superseded hereby. The terms of this License shall be binding upon and shall inure to the benefit of the parties and their successors, heirs and assigns.

[Signatures on the following page]



**IN WITNESS WHEREOF**, the parties have caused this instrument to be duly executed as of the day and year first above written.

**NATIONAL CELIAC ASSOCIATION, INC.**

By: Lee Graham

Signature: \_\_\_\_\_

Address: 105 S. 6th St.

Seward, NE 68434

Title: Executive Director, National Celiac Association

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

**LICENSEE:**

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

Signature: \_\_\_\_\_

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

Title: \_\_\_\_\_

Address: \_\_\_\_\_

\_\_\_\_\_  
Email: \_\_\_\_\_

**Method of Payment—Amount remitted \$** \_\_\_\_\_

**Check enclosed:** \_\_\_\_\_ (Payable to National Celiac Association)

**Credit Card** \_\_\_\_\_ **Select:** Visa \_\_\_\_\_ MasterCard \_\_\_\_\_ Discover \_\_\_\_\_ American Express \_\_\_\_\_

**Credit Card Number:** \_\_\_\_\_ **Security Code:** \_\_\_\_\_

**Name on credit card:** \_\_\_\_\_ **Expiration Date:** \_\_\_\_\_

Address on credit card \_\_\_\_\_

City \_\_\_\_\_ State \_\_\_\_\_ Zip \_\_\_\_\_

**Signature:** \_\_\_\_\_

Mail to: NCA Recognition Seal, 105 S. 6th St., Seward, NE 68434

email: [sue.b@nationalceliacs.org](mailto:sue.b@nationalceliacs.org)

phone (local): 402-643-4101

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Appendix 1  
 Examples of CSA Recognition Seal with and without text.



*Seal with Product text*



Innovative Category



Appendix 2

The Licensee may use the Mark in connection with the following approved products sold under the following brand names:

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

Brand \_\_\_\_\_ Name:

\_\_\_\_\_

Products: \_\_\_\_\_

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Brand \_\_\_\_\_ Name:

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Products: \_\_\_\_\_

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

Brand

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

Brand

Name:

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Products: \_\_\_\_\_

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