Memorandum

MIAMI-DADE COUNTY

Date: February 1, 2011

To: Honorable Chairman Joe A. Martinez
and Members, Board of County Commissioners

Agenda Item No. 8(J)(1)(B)

From: George M. Burgess
County Manager

Subject: Resolution Approving Execution of a License Agreement between Miami-Dade County and ArrivalStar S.A. and Melvino Technologies Limited (collectively "ArrivalStar") for the use of United States Patent No. 7,030,781

RECOMMENDATION

It is recommended that the Board of County Commissioners (Board) approve a license agreement between Miami-Dade County and ArrivalStar S.A. and Melvino Technologies, Limited (collectively "ArrivalStar") in the amount of $30,000 related to the licensing and enforcement of ArrivalStar's United States Patent No. 7,030,781 ("the 781 patent"), and thirty-three additional related U.S. patents, five Canadian patents, and any patents issued in the future from ArrivalStar's several pending U.S. patent applications and their foreign counterparts (collectively "the ArrivalStar Patents").

SCOPE

This agreement benefits the riding public and is therefore countywide.

FISCAL IMPACT/FUNDING SOURCE

The fiscal impact for this agreement is a one-time fee of $30,000 which will be funded from the Miami-Dade Transit (MDT) Operating budget. There is no additional future on-going annual licensing or operating costs associated with this agreement.

TRACK RECORD/MONITOR

The person who will be responsible for monitoring the Agreement is Rosie Perez, Senior Chief, Information Technology and Support Services.

DELEGATED AUTHORITY

In accordance with Section 2-8.3 of the Miami-Dade County Code related to identifying delegation of Board authority, there are no authorities beyond that specified in the resolution which include authority for the Mayor, or designee, to execute a License Agreement between Miami-Dade County and ArrivalStar.

BACKGROUND

On August 9, 2010, MDT received a letter from Dowell Baker Patent Agent, representing ArrivalStar, notifying MDT of an alleged patent infringement for predictive arrival technologies and requesting a license agreement for $150,000. Upon review, the County Attorney's Office (CAO) recommended MDT commence negotiations with Arrival Star for a licensing agreement. The CAO, MDT and the Department of Procurement Management (DPM) successfully reached a perpetual licensing agreement with ArrivalStar at a one-time negotiated price of $30,000. This Agreement will have no expiration date, shall remedy any past alleged patent infringements, and protect the County against any future claims pertaining to the use of the above referenced patents.

MDT has implemented in-house systems that utilize the predictive arrivals through its applications, namely "Train Tracker" and "Bus Tracker." The Train Tracker application currently in use will ultimately be utilized in the Electronic Signage Information System (to be implemented by December of 2012) in all Metrorail stations, including the new station at the Miami Intermodal Center (MIC). The Bus Tracker System, currently in its pilot phase, also utilizes this process to provide Kendall Cruiser riders with estimated bus

arrival times that are accessible from their wireless devices, smart phones, and PDAs. The proposed license agreement will be utilized for future procurements related to predictive arrivals, namely the MDT Bus Tracker System/Computer Aided Dispatch-Automated Vehicle Locator (CAD/AVL) Replacement & Traffic Signal Priority (TSP) Project.

Assistant County Manager

MEMORANDUM

(Revised)

TO: Honorable Chairman Joe A. Martinez and Members, Board of County Commissioners

DATE: February 1, 2011

FROM: R. A. Cuevas, Jr. County Attorney

SUBJECT: Agenda Item No. 8(J)(1)(B)

Please note any items checked.

_____ **"3-Day Rule" for committees applicable if raised**

_____ **6 weeks required between first reading and public hearing**

_____ **4 weeks notification to municipal officials required prior to public hearing**

_____ **Decreases revenues or increases expenditures without balancing budget**

_____ **Budget required**

_____ **Statement of fiscal impact required**

_____ **Ordinance creating a new board requires detailed County Manager's report for public hearing**

✓ **No committee review**

_____ **Applicable legislation requires more than a majority vote (i.e., 2/3's ____, 3/5's ____, unanimous _____) to approve**

✓ **Current information regarding funding source, index code and available balance, and available capacity (if debt is contemplated) required**

Approved _____ Mayor
Veto _____
Override _____

Agenda Item No. 8(J)(1)(B)
2-1-11

RESOLUTION NO. _____

RESOLUTION AUTHORIZING EXECUTION OF A LICENSE AGREEMENT WITH ARRIVALSTAR S.A AND MELVINO TECHNOLOGIES LIMITED (COLLECTIVELY KNOWN AS "ARRIVALSTAR") IN THE AMOUNT OF $30,000 RELATED TO THE LICENSING AND ENFORCEMENT OF ARRIVALSTAR'S CURRENT AND FUTURE PATENTS (COLLECTIVELY KNOWN AS "THE ARRIVALSTAR PATENTS"), AND AUTHORIZING USE OF CHARTER COUNTY TRANSIT SYSTEM SURTAX FUNDS

WHEREAS, this Board desires to accomplish the purposes outlined in the accompanying memorandum, a copy of which is incorporated herein by reference; and

WHEREAS, the use of real-time estimated arrival information for both rail and buses provides convenience and efficiency for Miami-Dade County residents and visitors; and

WHEREAS, future applications utilizing the aforementioned information are currently in the process of implementation,

NOW, THEREFORE, BE IT RESOLVED BY THE BOARD OF COUNTY COMMISSIONERS OF MIAMI-DADE COUNTY, FLORIDA, that this Board hereby authorizes the execution of a License Agreement between Arrival Star and Miami-Dade County for the enforcement of all licenses pertinent to the ArrivalStar Patent in substantially the form attached hereto and made a part hereof; and authorizes the County Mayor, or designee, to execute the agreement in substantially the form attached herein.

The foregoing resolution was offered by Commissioner ,

who moved its adoption. The motion was seconded by Commissioner

and upon being put to a vote, the vote was as follows:

Joe A. Martinez, Chairman
Audrey M. Edmonson, Vice Chairwoman

Bruno A. Barreiro	Lynda Bell
Jose "Pepe" Diaz	Carlos A. Gimenez
Sally A. Heyman	Barbara J. Jordan
Jean Monestime	Dennis C. Moss
Natacha Seijas	Rebeca Sosa
Sen. Javier D. Souto	

The Chairperson thereupon declared the resolution duly passed and adopted this 1st day of February, 2011. This resolution shall become effective ten (10) days after the date of its adoption unless vetoed by the Mayor, and if vetoed, shall become effective only upon an override by this Board.

MIAMI-DADE COUNTY, FLORIDA
BY ITS BOARD OF
COUNTY COMMISSIONERS

HARVEY RUVIN, CLERK

By:_____
Deputy Clerk

Approved by County Attorney as
to form and legal sufficiency.

Bruce Libhaber

SETTLEMENT, RELEASE AND LICENSE AGREEMENT

This Settlement, Release and License Agreement ("Agreement") is entered into between Melvino Technologies Limited, a corporation organized under the laws of British Virgin Islands of Tortola and having a place of business at P.O. Box 3174, Palm Chambers, 197 Main Street, Road Town, Tortola, British Virgin Islands ("Melvino") and ArrivalStar S.A., a corporation organized under the laws of Luxembourg and having offices at 127 rue du Mühlenbach, L-2168, Luxembourg ("ArrivalStar"), on the one hand (together sometimes referred to as the "Patent Holders"), and Miami-Dade County , a political subdivision of the State of Florida, having its principal office at 111 N.W. 1st Street, Miami, Florida 33128 (referred to as "Licensee") (all collectively referred to herein as the "Parties.")

WHEREAS, Melvino owns all right, title and interest in, and/or has the right to license, the patents identified in Schedule A attached hereto, including any continuations, continuations-in-part, divisionals, re-issues or re-examinations of such patents, including any counterparts thereof in any country of the world in which there are counterparts of the foregoing U.S. patents (collectively, the "ArrivalStar Patents"), and ArrivalStar is the exclusive licensee of the ArrivalStar Patents, with the right to sub-license all ArrivalStar Patents.

WHEREAS, Patent Holders assert that certain products and/or services made, used, sold and/or offered for sale by Licensee infringe certain claims of the ArrivalStar Patents;

WHEREAS, Licensee denies all such claims of infringement, but nonetheless wishes to obtain a license and release for any and all past, present, and future actions with respect to the ArrivalStar Patents, and the Patent Holders are willing to grant such a license and release under the terms hereof;

NOW, THEREFORE, in accordance with the foregoing recitals, and in consideration of the mutual covenants contained herein, the Patent Holders and Licensee agree as follows:

1. "ArrivalStar Patents" means the entire patent portfolio of Patent Holders including but not limited to the patents identified in Schedule A attached hereto, including any continuations, continuations-in-part, divisionals, re-issues, re-examinations, renewals, extensions, and parents of such patents, and including any counterparts thereof in any country of the world in which there are counterparts of the foregoing U.S. patents, and also including without limitation, any and all current or future worldwide patents and patent applications and all corresponding foreign patents and patent applications and any continuations, continuations-in-part, divisionals, re-issues, re-examinations, renewal, extensions, or parent thereof that are directed to information systems or methods, or communications systems, or methods, for the transportation, logistics, shipping, warehousing, cargo, and/or parcel delivery industries that are owned

by (now or hereinafter) or exclusively licensed to (now or hereinafter) Melvino, ArrivalStar, their subsidiaries, Affiliates or principals, assigns and successors.

2. "Affiliates" as used herein means, with respect to each party, any person, corporation, partnership, trust, or other entity, existing or which has yet to exist, that, directly or indirectly, legally or beneficially, owns, is/will be owned by, or is/will be under common ownership with the party or the party's ultimate parent. For purposes of the foregoing, "own", "owned", or "ownership" means holding ownership of, or the right to vote, fifty percent (50%) or more of the voting stock or ownership interest entitled to elect a board of directors or a comparable managing authority.

3. Patent Holders warrant and represent that (a) except as stated below with respect to WNS Holdings LLC, they exclusively own the entire right, title, and interest in, and have the exclusive and entire right to enforce and license, the United States ArrivalStar Patents identified in Schedule A; (b) they have the right to license the Worldwide Patents identified in Schedule A; (c) they have the right to enter into this Agreement; (d) there are no liens, conveyances, mortgages, assignments, encumbrances or other agreements to which Patent Holders are a party or by which they are bound, which would prevent or impair the full exercise of all substantive rights granted to Licensee, its subsidiaries, and its Affiliates by Patent Holders pursuant to the terms of the Agreement; and (e) they have not assigned or transferred to any other person or entity any of their claims, demands or causes of action settled and released herein. Patent Holders warrant that no other entity or individual including but not limited to ArrivalStar Jersey Ltd., Noticom International, LLC, LaBarge, Inc., WNS Holdings, LLC, Global Research Systems, Inc. and the inventors holds any right, title or interest in or to any of the patents identified in Schedule A or to any corresponding foreign patents and patent applications or any continuations, continuations-in-part, divisionals, re-issues, re-examinations, renewals, extensions, or parents thereof, except that Patent Holders represent that WNS Holdings LLC holds an interest in two of the patents identified in Schedule A with an asterisk (*). Patent Holders represent that said interest of WNS Holdings LLC does not preclude Patent Holders from licensing the subject patents to Licensee, its subsidiaries and its Affiliates or otherwise from entering into this Agreement and granting the warranties, releases, licenses and covenants included herein.

4. The terms, provisions and payments set forth in this agreement are not and shall not be construed as an admission by Licensee of the infringement, validity, or enforceability of the ArrivalStar Patents.

5. In full settlement and release of any and all claims asserted by, or which could have been asserted by, Patent Holders against Licensee in connection with the ArrivalStar Patents in any lawsuit or otherwise, and in full consideration of the license, releases, and covenants in this Agreement, Licensee shall pay the sum of US$30,000 ("the Settlement Amount"), which shall be due by January 31, 2011, to Patent Holders and their attorneys, Dowell Baker, P.C., to the following client trust account:

First Merchants Bank
ABA No. 074900657
Credit to Lafayette Bank and Trust – Lafayette, Indiana
Account No. 9009108
Dowell Baker, P.C. Client Trust IOLTA Account
Account No. 9000201658

6. Patent Holders grant to Licensee, its subsidiaries, and Affiliates, a fully paid-up, worldwide, irrevocable, non-exclusive, non-transferable (except as set forth below) right and royalty-free license to the ArrivalStar Patents in connection with any product, service, or systems provided or developed by or for Licensee, either now existing or later developed. Such license shall be deemed to extend to and include an immunity from suit against all past, present and future customers, suppliers, sublicensees, consultants and users of any product, service, or system provided by or for Licensee but solely with respect to such product, service, or system of Licensee. Patent Holders shall not enter into any agreement or take any action which would interfere with the release, covenants not to sue and license grants in this Agreement.

7. Patent Holders do hereby release, forever discharge, and covenant not to sue Licensee from any and all claims, actions, causes of action, suits, damages, injuries, duties, rights, obligations, liabilities, adjustments, responsibilities, judgments, trespasses, and demands, whatsoever, in law or in equity, whether known or unknown, suspected or unsuspected to exist, now existing or later acquired, which were made or could have been made or may be made in the future by Patent Holders relating to the ArrivalStar Patents. This release is not intended and shall not be construed to affect Patent Holders' claims (including claims for patent infringement) against any other current or future alleged infringer of the ArrivalStar Patents.

8. Patent Holders agree to indemnify, defend, and hold harmless Licensee, its subsidiaries, and Affiliates (individually as an "Indemnified Party" or collectively as the "Indemnified Parties") from and against any and all liabilities, obligations, penalties, judgments, disbursements of any kind and nature, losses, damages, costs and expenses (including, without limitation, reasonable attorney's fees and costs) (collectively "Losses") incurred as a result of any claims, demands, actions, or other proceedings by a third party against an Indemnified Party or Parties to the extent arising out of: (a) Patent Holders' breach of any representation, warranty or covenant under this Agreement, except to the extent that such Losses arise out of Licensee' breach of any representation, warranty, or covenant under this Agreement; (b) the negligence, recklessness, or wrongful intentional acts or omissions of Patent Holders, its subsidiaries, or its Affiliates in connection with the exercise of rights under this Agreement; and (c) any cause of legal action, legal proceeding, or lawsuit concerning the ArrivalStar Patents.

9. To claim indemnification, the Indemnified Party or Parties shall promptly notify Patent Holders, in writing, of any claim, demand, action, or other proceeding in respect of which the indemnified party intends to claim such indemnification; provided, however, that failure to provide such notice within a reasonable period of time shall not

relieve the Patent Holders of their obligations under this Agreement except to the extent Patent Holders are prejudiced by such failure. The Indemnified Party or Parties shall permit Patent Holders, at its discretion, to settle any such action, claim, or other matter. Notwithstanding the foregoing, the Patent Holders shall not enter into any settlement that would adversely affect the Indemnified Party's or Parties' rights under this Agreement, or impose any obligations on the Indemnified Party or Parties in addition to those set forth in this Agreement. No such action, claim, or other matter shall be settled without the prior written consent of the Indemnifying Party or Parties, which shall not be unreasonably withheld or delayed. The Indemnified Party or Parties shall reasonably cooperate with Patent Holders and their legal representatives in the investigation and defense of any claim, demand, action, or other proceeding covered by the indemnification obligations identified above. The Indemnified Party or Parties shall have the right, but not the obligation, to be represented in such defense by counsel of its own selection and at its own expense.

10. The releases and license set forth above are assignable and transferable by Licensee only in the case of a merger or sale of all or substantially all of its assets or stock, in the case of an acquisition of Licensee or to a subsidiary or a present or future Affiliate of Licensee.

11. This Agreement shall be binding upon Melvino, ArrivalStar, their successors, principals and assigns as well as any future successor owner of the ArrivalStar Patents.

12. Each Party hereto warrants and represents to the others that (a) its execution of this Agreement has been duly authorized by all necessary corporate action of such Party; and (b) it has requisite legal rights necessary to grant the other Party all releases, covenants not to sue as set forth above.

13. The Parties agree that the terms of this Agreement will be treated as confidential and maintained in confidence and will not be disclosed to any other person or entity except as may be required by law or pursuant to a protective order entered by a Court or tribunal. Licensee may represent that it is licensed under the ArrivalStar Patents without violating this confidentiality provision.

14. This Agreement shall be construed under the laws of the State of Florida and venue shall lie in the 11th Judicial Circuit of Florida and/or the United States Southern District of Florida.

15. This Agreement shall become binding and effective upon signature by the Parties later date and shall continue in perpetuity.

WHEREFORE, the Parties hereby acknowledge their agreement and consent to the terms and conditions set forth above through their respective signatures as contained below and each Party represents and warrants that the representatives signing below have the authority to legally bind such Party:

MELVINO TECHNOLOGIES LIMITED

Dated: 15/11/10

Its: Directors

ARRIVALSTAR S.A.

Dated: Alexandre Taskiran
Director

Its: Category "B" Director

Arrivalstar S.A.

Sarah J Langton

Category "A" Director

Dated:

MIAMI-DADE COUNTY

Dated:

Its:

Approved as to form and legal sufficiency

Schedule A

United States Patents

1. 5,400,020
2. 5,444,444*
3. 5,623,260
4. 5,648,770*
5. 5,657,010
6. 5,668,543
7. 6,278,936
8. 6,313,760
9. 6,317,060
10. 6,363,254
11. 6,363,323
12. 6,411,891
13. 6,415,207
14. 6,486,801
15. 6,492,912
16. 6,510,383
17. 6,618,668
18. 6,683,542
19. 6,700,507
20. 6,714,859
21. 6,741,927
22. 6,748,318
23. 6,748,320
24. 6,763,299
25. 6,763,300
26. 6,804,606
27. 6,859,722
28. 6,904,359
29. 6,952,645
30. 6,975,998
31. 7,030,781
32. 7,089,107
33. 7,191,058
34. 7,400,970

Worldwide Patents

AT 257265
AT 273547
AU 2608700
AU 3393300
AU 3998401
AU 6284999
AU 6404799
AU 6453598
AU 7391696
BR 0007537
BR 0008670
BR 9808005
CA 2267206
CA 2283239
CA 2360288
CA 2363556
CA 2521206
CA 2528647
CN 1345413
DE 60104824
DE 69631255
EP 0929885
EP 0966720
EP 1261902
EP 1264296
MXPA01008914
WO 9814926
WO 0019171
WO 0019170