

Field Fisher Waterhouse LLP

Intellectual Property Assignment Agreement (UK)

This template Intellectual Property Assignment Agreement is drafted under English law. It covers an arms-length assignment of intellectual property rights existing as at the date of the assignment and is drafted in favour of the assignee.

The template is drafted under English law and is necessarily generic. It should therefore should be adapted to meet applicable local law requirements where necessary, as well as the particular intellectual property rights that are being assigned.

This document is intended only as a starting point for drafting and must be carefully considered in the context of the specific transaction. This document is not a substitute for detailed advice on specific transactions and should not be taken as providing legal advice on any of the topics discussed, nor should it be taken as creating a solicitor-client relationship between the reader and Field Fisher Waterhouse LLP.

THIS AGREEMENT is made this [•] day of [•] 20[•]

BETWEEN:

- (1) [•] (Company Registration No. [•]) whose registered office is at [•] (the "Assignor"); and
- (2) [•] (Company Registration No. [•]) whose registered office is [•] (the "Assignee").

WHEREAS:

- (A) The Assignor is the proprietor of certain intellectual property rights.
- (B) The Assignor has agreed to assign such intellectual property rights to the Assignee, and the Assignee hereby accepts such assignments on the terms of this Agreement.

IT IS AGREED as follows:

1. Interpretation

1.1 In this Agreement, unless the contrary intention appears:

"**Business Day**" means a day on which banks are open in [•] not being a Saturday or Sunday;

"**Copyright**" means the copyright which subsists in the Works;

"**Database Rights**" means the database rights subsisting in the databases specified in Schedule [•];

"**Goodwill**" means [all goodwill attaching to the Registered Marks and Unregistered Marks];

"Intellectual Property Rights" means:

- (a) the [Registered Marks] [Mark Applications] [Goodwill] [Unregistered Marks] [Copyright] [Patents] [Patent Applications] [Unregistered Designs] [Registered Designs] [Registered Design Applications] [Invention Rights] and [Database Rights]
- (b) all rights of action, powers and benefits belonging or accrued to the rights set out at (a) above, including, without limitation, rights to claim priority from such rights, the right to sue for past infringement and any and all other rights, whether tangible or intangible, and whether now known or created in the future and all similar or equivalent rights or forms of protection which subsist or will subsist in the future in any part of the world; and
- (c) all registrations, applications, renewals, extensions, continuations, divisions, reversionary interests in or reissues of any of the rights referred to in paragraph (a) to (c) above in force or created in the future;

"Invention Rights" means the rights in the inventions particulars of which are set out in Schedule [●];

"Mark Applications" means the applications for registration of trade marks and service marks particulars of which are set out in Schedule [●];

"Patents" means the registered patents particulars of which are set out in Schedule [●];

"Patent Applications" means the applications for registration of patents, particulars of which are set out in Schedule [●];

"Registered Designs" means the registered designs particulars of which are set out in Schedule [●];

"Registered Design Applications" means the applications for registration of designs, particulars of which are set out in Schedule [●];

"Registered Marks" means the registered trade marks and service marks' particulars of which are set out in Schedule [●];

"Territory" means the world;

"Unregistered Designs" means the unregistered designs, particulars of which are set out in Schedule [●];

"Unregistered Marks" means the unregistered trade marks and service marks, particulars of which are set out in Schedule [●]; [and]

"Works" means the works specified in Schedule [●];

1.1. In this Agreement, unless the context otherwise requires

- (a) a reference to a provision or law is a reference to that provision as extended, applied, amended or enacted from time to time and includes any subordinate legislation;
- (b) the singular includes the plural and vice versa;

- (c) words denoting persons include bodies corporate and unincorporated associations of persons;
- (d) reference to this Agreement or any other agreement or document are to this Agreement or such other agreement as it may be varied, amended, supplemented, restated, renewed, novated or replaced from time to time;
- (e) references to any party of this Agreement include a reference to its successors and assigns;
- (f) the word "including" is by way of illustration and emphasis only and does not operate to limit the generality or extent of any other words or expressions;
- (g) references to Clauses and Schedules refer to clauses of and schedules to this Agreement;
- (h) the headings in this Agreement do not affect its interpretation.

2. Assignment

In consideration of the sum of £[•] now paid by the Assignee to the Assignor (receipt of which is hereby acknowledged) the Assignor hereby assigns the Intellectual Property Rights to the Assignee to hold to the Assignee its successors and assigns absolutely throughout the Territory for so far as permissible in perpetuity.

3. Further Assurance

The Assignor hereby covenants and agrees with the Assignee that the Assignor will, at the Assignee's request and at the Assignor's expense, execute all such documents, and do all such acts and things as may be necessary to vest fully the Intellectual Property Rights in the Assignee.

4. Warranties and Representations

4.1 The Assignor warrants and represents that:

- (a) it is the sole legal and beneficial owner of the Intellectual Property Rights free of all liens, charges, options, licences and encumbrances;
- (b) it is not restricted or prohibited, contractually or otherwise from assigning the Intellectual Property Rights and that this assignment will not result in a violation of or breach of any agreement between the Assignor and any other person;
- (c) [that the [Registered Marks] [Patents] [and] [Registered Designs] are owned by and registered under current valid registrations in the name of the Assignor as sole proprietor;]
- (d) none of the Intellectual Property Rights is the subject of any pending or threatened proceedings nor are there any facts or matters which might give rise to any such proceedings [including any proceedings that any of the Registered Marks should be revoked for lack of use] or that might prevent the Mark Applications or Registered Design Applications or Patent Applications from being granted registrations;
- (e) none of the Intellectual Property Rights infringe the rights of any other person;

- (f) all registration and renewal fees regarding the Intellectual Property Rights in respect of which fees are payable and due on or before the date of this Agreement have been paid in full;
- (g) none of the Intellectual Property Rights is being or has been infringed or threatened to be infringed by any person;
- (h) the Assignor has not previously assigned or granted any licence to use any of the Intellectual Property Rights; and
- (i) [no inventor has the right to any share in the profits or income of the Assignor by reference to the successful exploitation of the Intellectual Property [or any of it].]¹

5. Waiver of Moral Rights

The Assignor irrevocably and unconditionally waives all moral rights in respect of the Works to which it may now or at any time in the future be entitled under [Section 77, 80 and 84 of the Copyright, Designs and Patents Act 1988] and under any similar laws in force from time to time in any part of the world and the Assignor declares that the waiver shall operate in favour of the Assignee and its licensees, assigns and successors in title. The Assignor represents and warrants that its contractors and employees have similarly waived all such moral rights in the Works.

6. Indemnity

The Assignor hereby indemnifies and agrees to keep indemnified the Assignee (on an after tax basis) from and against all losses, claims, demands, proceedings, damages (including any damages or compensation paid by the Assignee on the advice of its legal advisors to compromise or settle any claim), liabilities, costs, charges and expenses (including reasonable legal expenses) arising out of or in connection with any breach of the warranties and undertakings contained in this Agreement, or out of any claim by a third party based on alleged facts which, if substantiated, would constitute such a breach.

7. General

- 7.1 This Agreement and any dispute or claim arising out of or in connection with it (including non-contractual disputes or claims) shall be governed by and construed in accordance with the laws of [England].
- 7.2 The parties irrevocably agree that the courts of [England] have [non-]exclusive jurisdiction to settle any dispute or claim that arises out of or in connection with this Agreement (including non-contractual disputes or claims).
- 7.3 No alteration, modification or addition to this Agreement, nor any waiver of any of the terms hereof, shall be valid unless made in writing and signed by the duly authorised representatives of both parties.
- 7.4 No delay, neglect or forbearance on the part of either party in enforcing any term or condition of this Agreement shall be or be deemed to be a waiver of, or otherwise prejudice, any right of that party under this Agreement.

¹ Include only if patent rights (or patent applications) are being assigned.

- 7.5 This Agreement constitutes the entire agreement and understanding between the parties relating to its subject matter and supersedes any other agreement or understanding (written or oral) between the parties or any of them relating to the same.
- 7.6 Each party acknowledges and agrees that it does not rely on, and shall have no remedy in respect of, any promise, assurance, statement, warranty, undertaking or representation made (whether innocently or negligently) by any other party or any other person except as expressly set out in this Agreement in respect of which its sole remedy shall be for breach of contract.
- 7.7 Nothing in Clauses 7.5 or 7.6 however, shall operate or be construed to exclude or limit any liability of any person for fraud, including fraudulent misrepresentation.
- 7.8 Any notice to be given under or in connection with this Agreement shall be in writing and shall be sent by hand or recorded delivery or telex:
- (a) to the Assignor, at the following address: [•];
 - (b) to the Assignee, at the following address: [•];
- or at any other address notified in accordance with this Clause.

IN WITNESS whereof the hands of the parties or their duly authorised attorneys or representatives the day and year first above written.