

# Deed Of Assignment Of Intellectual Property Rights

Dated

Party One (1)  
Party Two (2)  
Party Three (3)

Draft:  
Ref:

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THIS DEED IS DATED [DATE]

## PARTIES

- (1) [FULL COMPANY NAME] incorporated and registered in England and Wales with company number [NUMBER] whose registered office is at [REGISTERED OFFICE ADDRESS] OR [INDIVIDUAL NAME] of [INDIVIDUAL ADDRESS] ("Assignor");
- (2) [FULL COMPANY NAME] incorporated and registered in England and Wales with company number [NUMBER] whose registered office is at [REGISTERED OFFICE ADDRESS] OR [INDIVIDUAL NAME] of [INDIVIDUAL ADDRESS] ("Assignee").

## BACKGROUND

- (A) [The Assignor owns the intellectual property rights in the Materials (as defined below).]
- (B) The Assignor has agreed to assign to the Assignee the intellectual property rights [in the Materials OR shown in the Schedules to this Agreement OR arising, or to arise, from work done on [NAME PROJECT]] on the terms set out in this Agreement.

## AGREED TERMS

### 1 Interpretation

The following definitions and rules of interpretation apply in this Agreement.

#### 1.1 Definitions:

**Assigned Rights:** [the Patents, Trade Marks and Registered Designs and] [all the Intellectual Property Rights [set out in Schedule 6 OR embodied in the Materials OR arising, or to arise, from work done on [NAME PROJECT]]].

**Business Day:** a day other than a Saturday, Sunday or public holiday in England when banks in London are open for business.

**Intellectual Property Rights:** patents, utility models, rights to inventions, copyright and neighbouring and related rights, trade marks and service marks, business names and domain names, rights in get-up and trade dress, goodwill and the right to sue for passing off or unfair competition, rights in designs, database rights, rights to use, and protect the confidentiality of, confidential information (including know-how and trade secrets) and all other intellectual property rights, in each case whether registered or unregistered and including all applications and rights to apply for and be granted, renewals or extensions of, and rights to claim priority from, such rights and all similar or equivalent rights or forms of protection which subsist or will subsist now or in the future in any part of the world.

**[Materials:** the materials described in Schedule 5.]

**[Patents:** the patents [and the applications] short particulars of which are set out in Schedule 1.]

**[Registered Designs:** the registered designs [and the applications] short particulars of which are set out in Schedule 2.]

**[Trade Marks:** the registered trade marks [and the applications] [and the unregistered trade marks and trade names] short particulars of which are set out in Schedule 3.]

**VAT:** value added tax or any equivalent tax chargeable in the UK or elsewhere.

- 1.2 Clause, Schedule and paragraph headings shall not affect the interpretation of this Agreement.

- 1.3 A person includes a natural person, corporate or unincorporated body (whether or not having separate legal personality).
- 1.4 The Schedules form part of this Agreement and shall have effect as if set out in full in the body of this Agreement. Any reference to this Agreement includes the Schedules.
- 1.5 References to clauses and Schedules are to the clauses and Schedules of this Agreement.
- 1.6 Unless the context otherwise requires, words in the singular shall include the plural and in the plural shall include the singular.
- 1.7 Unless the context otherwise requires, a reference to one gender shall include a reference to the other genders.
- 1.8 This Agreement shall be binding on, and enure to the benefit of, the parties to this Agreement and their respective personal representatives, successors and permitted assigns, and references to any party shall include that party's personal representatives, successors and permitted assigns.
- 1.9 A reference to a statute or statutory provision is a reference to it as amended, extended or re-enacted from time to time.
- 1.10 A reference to a statute or statutory provision shall include all subordinate legislation made from time to time under that statute or statutory provision.
- 1.11 A reference to writing or written includes email.
- 1.12 Any words following the terms including, include, in particular, for example or any similar expression shall be construed as illustrative and shall not limit the sense of the words, description, definition, phrase or term preceding those terms.

## 2 Assignment

- 2.1 In consideration of the sum of £[AMOUNT] (receipt of which the Assignor expressly acknowledges), the Assignor assigns to the Assignee absolutely with full title guarantee all its right, title and interest in and to the Assigned Rights, including:
  - (a) [the absolute entitlement to any registrations granted pursuant to any of the applications comprised in the Patents, Registered Designs and Trade Marks;]
  - (b) [all goodwill attaching to the Trade Marks and to that part of the Assignor's business that relates to the goods or services for which the Trade Marks are registered or used; and]
  - (c) the right to bring, make, oppose, defend, appeal proceedings, claims or actions and obtain relief (and to retain any damages recovered) in respect of any infringement, or any other cause of action arising from ownership, of any of the Assigned Rights whether occurring before, on, or after the date of this Agreement.

## 3 VAT

All payments made by the Assignee under this Agreement are exclusive of VAT. If any such payment constitutes the whole or any part of the consideration for a taxable or deemed taxable supply by the Assignor, the Assignee shall increase that payment by an amount equal to the VAT which is chargeable in respect of the taxable or deemed taxable supply, provided that the Assignor shall have delivered a valid VAT invoice in respect of such VAT to the Assignee.

## 4 Warranties

- 4.1 The Assignor warrants that:

- (a) it is the sole legal and beneficial owner of, and owns all the rights and interests in, the Assigned Rights;
- (b) for each of the applications and registrations listed in Schedule 1, Schedule 2 and Schedule 3 it is validly registered as the applicant or registered proprietor, and all application, registration and renewal fees have been paid;
- (c) it has not licensed or assigned any of the Assigned Rights [except as set out in Schedule 4];
- (d) the Assigned Rights are free from any security interest, option, mortgage, charge or lien [except as set out in Schedule 4];
- (e) it is unaware of any infringement or likely infringement of any of the Assigned Rights;
- (f) as far as it is aware, all the Assigned Rights are valid and subsisting and there are and have been no claims, challenges, disputes or proceedings, pending or threatened, in relation to the ownership, validity or use of any of the Assigned Rights, and there is nothing that might prevent any application listed in Schedule 1, Schedule 2 or Schedule 3 proceeding to grant;
- (g) as far as it is aware, exploitation of the Assigned Rights will not infringe the rights of any third party;
- (h) [all previous assignments of the applications and registrations listed in Schedule 1, Schedule 2 and Schedule 3 are valid and were registered within applicable time limits; and]
- (i) [the Materials are its original work and have not been copied wholly or substantially from any other source.]

## 5 Indemnity

- 5.1 The Assignor shall indemnify the Assignee against all liabilities, costs, expenses, damages and losses (including but not limited to any direct, indirect or consequential losses, loss of profit, loss of reputation and all interest, penalties and legal costs (calculated on a full indemnity basis) and all other reasonable professional costs and expenses) suffered or incurred by the Assignee arising out of or in connection with:
- (a) any breach of the warranties contained in clause 4; or
  - (b) the enforcement of this Agreement.
- 5.2 At the request of the Assignee and at the Assignor's own expense, the Assignor shall provide all reasonable assistance to enable the Assignee to resist any claim, action or proceedings brought against the Assignee as a consequence of that breach.
- 5.3 This indemnity shall apply whether or not the Assignee has been negligent or at fault.
- 5.4 If a payment due from the Assignor under this clause is subject to tax (whether by way of direct assessment or withholding at its source), the Assignee shall be entitled to receive from the Assignor such amounts as shall ensure that the net receipt, after tax, to the Assignee in respect of the payment is the same as it would have been were the payment not subject to tax.

## 6 Moral rights

[The Assignor shall provide the Assignee, on or before the date of this Agreement, with written absolute waivers from all authors of the Materials in relation to all their moral rights arising under the Copyright, Designs and Patents Act 1988 in relation to the Materials and, as far as

**Commented [FA1]:** The first option is where the company is assigning the rights and the second option is where an individual is assigning the rights.

is legally possible, any broadly equivalent rights such authors may have in any territory of the world.]

OR

[The Assignor, being the sole author of the Materials, waives absolutely their moral rights arising under the Copyright, Designs and Patents Act 1988 in relation to the Materials and, so far as is legally possible, any broadly equivalent rights the Assignor may have in any territory of the world.]

## 7 Further assurance

7.1 At the Assignee's expense the Assignor shall, and shall use all reasonable endeavours to procure that any necessary third party shall, promptly execute and deliver such documents and perform such acts as may reasonably be required for the purpose of giving full effect to this Agreement, including:

- (a) registration of the Assignee as applicant or (as applicable) proprietor of the Assigned Rights; and
- (b) assisting the Assignee in obtaining, defending and enforcing the Assigned Rights], and assisting with any other proceedings which may be brought by or against the Assignee against or by any third party relating to the Assigned Rights].

7.2 The Assignor appoints the Assignee to be its attorney in its name and on its behalf to execute documents, use the Assignor's name and do all things which are necessary or desirable for the Assignee to obtain for itself or its nominee the full benefit of this Agreement.

7.3 This power of attorney is irrevocable and is given by way of security to secure the performance of the Assignor's obligations under this Agreement and the proprietary interest of the Assignee in the Assigned Rights and so long as such obligations of the Assignor remain undischarged, or the Assignee has such interest, the power may not be revoked by the Assignor, save with the consent of the Assignee.

7.4 Without prejudice to clause 7.2, the Assignee may, in any way it thinks fit and in the name and on behalf of the Assignor:

- (a) take any action that this Agreement requires the Assignor to take;
- (b) exercise any rights which this Agreement gives to the Assignor; and
- (c) appoint one or more persons to act as substitute attorney(s) for the Assignor and to exercise such of the powers conferred by this power of attorney as the Assignee thinks fit and revoke such appointment.

7.5 The Assignor undertakes to ratify and confirm everything that the Assignee and any substitute attorney does or arranges or purports to do or arrange in good faith in exercise of any power granted under this clause.

## 8 Waiver

No failure or delay by a party to exercise any right or remedy provided under this Agreement or by law shall constitute a waiver of that or any other right or remedy, nor shall it prevent or restrict the further exercise of that or any other right or remedy. No single or partial exercise of such right or remedy shall prevent or restrict the further exercise of that or any other right or remedy.

**9 Entire agreement**

- 9.1 This Agreement constitutes the entire agreement between the parties and supersedes and extinguishes all previous agreements, promises, assurances, warranties, representations and understandings between them, whether written or oral, relating to its subject matter.
- 9.2 Each party agrees that it shall have no remedies in respect of any statement, representation, assurance or warranty (whether made innocently or negligently) that is not set out in this Agreement. Each party agrees that it shall have no claim for innocent or negligent misrepresentation or negligent misstatement based on any statement in this Agreement.

**10 Variation**

No variation of this Agreement shall be effective unless it is in writing and signed by the parties (or their authorised representatives).

**11 Severance**

- 11.1 If any provision or part-provision of this Agreement is or becomes invalid, illegal or unenforceable, it shall be deemed modified to the minimum extent necessary to make it valid, legal and enforceable. If such modification is not possible, the relevant provision or part-provision shall be deemed deleted. Any modification to or deletion of a provision or part-provision under this clause shall not affect the validity and enforceability of the rest of this Agreement.
- 11.2 If any provision or part-provision of this Agreement is invalid, illegal or unenforceable, the parties shall negotiate in good faith to amend such provision so that, as amended, it is legal, valid and enforceable, and, to the greatest extent possible, achieves the intended commercial result of the original provision.

**12 Counterparts**

- 12.1 This Agreement may be executed in any number of counterparts, each of which shall constitute a duplicate original, but all the counterparts shall together constitute the one agreement.
- 12.2 Transmission of an executed counterpart of this Agreement (but for the avoidance of doubt not just a signature page) by email (in PDF, JPEG or other agreed format) shall take effect as the transmission of an executed "wet-ink" counterpart of this Agreement
- 12.3 No counterpart shall be effective until each party has provided to the other at least one executed counterpart.

**13 Third party rights**

This Agreement does not give rise to any rights under the Contracts (Rights of Third Parties) Act 1999 to enforce any term of this Agreement.

**14 Notices**

- 14.1 Any notice or other communication given to a party under or in connection with this Agreement shall be in writing and shall be:
  - (a) delivered by hand or by pre-paid first-class post or other next working day delivery service at its registered office (if a company) or its principal place of business (in any other case); or
  - (b) sent by email to the following addresses:
    - (i) if to the Assignor: [EMAIL ADDRESS];

(ii) If to the Assignee: [EMAIL ADDRESS].

14.2 Any notice or communication shall be deemed to have been received:

- (a) if delivered by hand, at the time the notice is left at the proper address;
- (b) if sent by pre-paid first-class post or other next working day delivery service, at 9.00 am] on the second Business Day after posting; or
- (c) if sent by email, at the time of transmission, or, if this time falls outside business hours in the place of receipt, when business hours resume. In this clause, business hours means 9.00am to 5.00pm Monday to Friday on a day that is not a public holiday in the place of receipt.

14.3 This clause does not apply to the service of any proceedings or other documents in any legal action or, where applicable, any arbitration or other method of dispute resolution.

#### 15 **Governing law**

This Agreement and any dispute or claim (including non-contractual disputes or claims) arising out of or in connection with it or its subject matter or formation shall be governed by and construed in accordance with the law of England and Wales.

#### 16 **Jurisdiction**

Each party irrevocably agrees that the courts of England and Wales shall have exclusive jurisdiction to settle any dispute or claim (including non-contractual disputes or claims) arising out of or in connection with this Agreement or its subject matter or formation.

This document has been executed as a deed and is delivered and takes effect on the date stated at the beginning of it.



**Schedule 1**  
**[Patents]**

Country or territory	Application or publication number	Date of filing or registration	Description

**Schedule 2**  
**[Registered Designs]**

Country or territory	Application or registration number	Date of filing or registration	Description

**Schedule 3**  
**[Trade Marks]**

**Part 1**  
**[Registered trade marks and applications]**

Country/ territory	Mark	Application or registration number	Date of filing/regn	Classes	Specification of goods or services

**Part 2**  
**[Unregistered trade marks]**

Country or territory	Mark	Date of first use	Goods or services for which the mark has been used

**Schedule 4**

**[Licences, charges and other third party rights]**

**Schedule 5**  
**[Materials]**

**Schedule 6**  
**[Unregistered Assigned Rights]**

Executed as a deed by **[NAME OF ASSIGNOR]** .....

**[Director]**

[acting by **[NAME OF DIRECTOR]** a director.] in the presence of:

SIGNATURE OF WITNESS .....

NAME .....

ADDRESS .....

Executed as a deed by **[NAME OF ASSIGNEE]** .....

**[Director]**

[acting by **[NAME OF DIRECTOR]** a director.] in the presence of:

SIGNATURE OF WITNESS .....

NAME .....

ADDRESS .....