**Assignment of Trademark**

***\* Add/delete іnfоrmаtіоn in brасkеtѕ as аррrорrіаtе***

**This Assignment** dated [insert date] is between:

1. [Your business name] (a company incorporated and registered in the Republic of Ireland with company number [insert company number] whose registered office is at [insert address] (called **‘the Assignor’** in this agreement); and

2. [Customer’s name] (a company incorporated and registered in the Republic of Ireland with company number [insert company number] whose registered office is at [insert address] (called **‘the Assignee’** in this agreement)

Within this agreement, we agree that:

As the Assignor, we own the Trademarks (defined below)

We have agreed to assign the Trademarks to you, the Assignee, on the terms set out in this deed

**Agreed terms**

The terms agreed here (including the attached Additional Terms and Conditions at Annex 1 and all other attached annexes), set out the basis on which these agreed terms will operate.

1. **Definitions and interpretations**

1.1 If any word, phrase or explanation used within this agreement is not clear, it will be defined and interpreted according to the definitions and interpretations set out in these Additional Terms and Conditions at Annex 1.

**2. Assignment**

The Assignor hereby assigns to the Assignee absolutely with full title guarantee and free from all encumbrances all its right, title and interest in and to the trademarks, including:

1. its entitlement to any registered trademarks granted pursuant to any of the applications comprised in the trademarks; and
2. its entitlement to any unregistered trademarks referred to in Annex 2; and
3. all statutory and common law rights attaching to the trademarks; and
4. the right to make or defend any claim in respect of any infringement, or any other cause of action arising from ownership, of any of the trademarks whether occurring before, on or after the date of this deed.

**3. Fee**

[No fee shall be payable by the Assignee for the assignment of the trademarks]

**OR**

[The fee for the assignment of the trademarks is € [insert amount] plus VAT, which the Assignee shall pay to the Assignor immediately on execution of this deed].

**4. Warranties**

The Assignor represents and warrants that:

1. it is the sole legal and beneficial owner of the trademarks;
2. it is properly registered as the applicant or registered proprietor of the trademarks listed in Part 1 and Part 2 of Annex 2;
3. all application, registration, renewal and other fees in respect of each of the trademarks listed in Part 1 and Part 2 of Annex 2 have been paid; and
4. it has not given any third-party permission to use any trademark or otherwise licensed or assigned any of the rights under the trademarks [except as set out in Annex 3];
5. as far as it aware, none of the trademarks infringes any third-party rights;
6. as far as it is aware, none of the trademarks is subject to challenge and there is nothing that may prevent any trademark application from being granted;
7. it is not aware of any infringement of any of the trademarks.

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

# Executed as a deed by

# Name and signature of Assignor

# Witnessed by

# Executed as a deed by

# Name and signature of Assignee

# Witnessed by

### **Annex 1 - Additional Terms and Conditions**

1. **Interpretation**

The following definitions and rules of interpretation apply in this deed

1.1 Definitions:

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

**Trademarks:** registered trademarks [and the applications] **OR** [and the unregistered trademarks], short particulars of which are set out in Annex 2

1.2 Clause and Annex 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 Annexes 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 Annexes

1.5 A reference to a **company** shall include any company, corporation or other body corporate, wherever and however incorporated or established

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 A reference to a statute or statutory provision is a reference to it as amended, extended or re-enacted from time to time

1.8 A reference to **writing** or **written** includes email.

1.9 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

1.10 Where the phrase ‘**so far as the Assignor is aware**’ or ‘**to the Assignor's knowledge**’ or any similar phrase, that statement shall be deemed to include an additional statement that it has been made after due and careful enquiry

**2. Further assurance**

The Assignor shall promptly execute such documents and take such other steps as may reasonably be required to give full effect to this deed

**3. Waiver**

A waiver of any right or remedy is only effective if given in writing and shall not be deemed a waiver of any subsequent breach or default. A delay or failure to exercise, or the single or partial exercise of, any right or remedy shall not:

1. Waive that or any other right or remedy.
2. Prevent or restrict the further exercise of that or any other right or remedy.

**4. Entire agreement**

4.1 This agreement contains the entire agreement between the parties and supersedes all previous agreements and understandings between them, whether written or oral, relating to its subject matter.

4.2 Each party agrees that it shall have no remedies in respect of any statement, representation 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.

**5. Variation**

No variation of this agreement shall be effective unless it is in writing and signed by the parties.

**6. Severance**

If any part 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 part shall be deemed deleted. Any modification to or deletion of such part under this clause shall not affect the validity and enforceability of the rest of this agreement

**7. Counterparts**

This deed may be executed in any number of counterparts, each of which when executed and delivered shall constitute a duplicate original, but all the counterparts shall together constitute the one deed.

**8. Third-party rights**

This agreement does not give rise to any third-party rights to enforce any of its terms

**9. Notices**

9.1 Any notice given to a party under or in connection with this agreement shall be in writing and shall be:

1. 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
2. sent by email to the address in set out below (or such other address as notified in writing by that party to the other):
   1. [email addresses]

9.2 Any notice shall be deemed to have been received:

1. if delivered by hand at the time the notice is left at the proper address;
2. 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 at the time recorded by the delivery service;
3. if sent by email, at 9:00 am on the next Business Day after transmission.

9.3 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

9.4 A notice given under this agreement is not valid if sent by email.

**10. Law and jurisdiction**

10.1 This agreement and any dispute or claim arising out of or in connection with it shall be governed by and construed in accordance with Irish law

10.2 The parties hereby submit to the exclusive jurisdiction of the Irish courts in relation to any dispute or claim arising out of or in connection with this agreement

**Annex 2 - Trade Marks**

Registered trademarks

|  |  |  |  |  |
| --- | --- | --- | --- | --- |
| Irish or EUTM | Class | Mark | Number | Specification of goods or services |
|  |  |  |  |  |

Trademark applications

|  |  |  |  |  |
| --- | --- | --- | --- | --- |
| Irish or EUTM | Class | Mark | Number | Specification of goods or services |
|  |  |  |  |  |

Unregistered trademarks

|  |  |  |
| --- | --- | --- |
| Mark | Date first used | Goods or services in respect of which the mark has been used |
|  |  |  |

**Annex 3 - Licences and other third-party rights**

**Guidance Notes**

**Assignment of trademarks**

**General Notes**

Use this template assignment agreement to transfer your ownership of one or more trademarks to someone else.

We do recommend that you take some legal advice with assignments of any IP rights.

**Why is this being executed as a deed?**

Deeds are contracts, but they have more exacting signature provisions, incorporating witnesses of signatures, which means they tend to be used in certain circumstances where a straightforward contract would be considered insufficient.

The point of including the witnesses is to make clear, unequivocally, that both the signing parties fully understood what they were signing and that they intended to agree to the terms set out in the deed.

Powers of attorney, transfers of property, including intellectual property and other valuable items will usually be done by way of a deed.

It’s considered the most appropriate way to evidence that the IP owner fully intends to transfer valuable property to someone else.

Deeds can be executed electronically. The witness needs to genuinely observe the making of the electronic signature in connection with the deed and then must immediately sign the adjoining ‘attestation clause’ confirming their presence as a witness to this signature.

It is also acceptable for one party to sign and having witnessed in ink and the counterparty to electronically sign and have witnessed.

A deed must also be ‘delivered’ to be considered valid. You’ll see the wording included in our template. Contrary to what you’d expect, it doesn’t mean it has to be couriered anywhere.

Instead, it means that there must be a clear statement in the document that confirms the date on and from which the parties intend to be bound by its terms (which might be a different date from the date that the deed is in fact signed).

**What does ‘full title guarantee’ mean?**

‘Full title guarantee’ means the Assignor owns the items entirely free of any charges or other encumbrances and ties.

**What sorts of things might be covered by encumbrances’?**

‘Encumbrances’ means an obligation that adversely affects the assets being transferred, normally it means a charge, but it can also refer to any other third-party right over the asset that might otherwise restrict the way in which it may be used, (for example, an existing, current licence to someone else to use the trademarks).

Here it is used as a general ‘scoop-up’ provision to confirm that the assets being sold are not restricted in any way.

**Common law rights**

Common law rights include, for example, rights to take action against someone for ‘passing off’ activity.

‘Passing off’ is when someone else, usually another business, wrongly gives the impression that your goods or services are in fact their goods or services; in short, that they are you.

They essentially ‘free-ride’ off all the reputation and efforts that you have invested in your business. These free-riders can both damage your business reputation and lose you revenue, if customers wrongly confuse the ‘imposter’ with you.

Anyone using your slogans, business/trading names, packaging, branding, or other recognisable elements of your advertising and marketing without your permission, may present you with the right to take legal action against them for passing off.

Passing off is essentially a civil law wrong which falls under the ‘tort’ family of legal actions (a body of law that applies outside anything contractually agreed between parties or laid down by regulations.

It protects people and businesses from suffering harm/damage and gives the right to claim compensation where they do.)

**Warranty**

A warranty is a contractual guarantee or promise that specific facts or conditions are true or will happen.

If the facts or conditions prove false within that time limit however, then the recipient of that warranty can for example, return, have repaired or replaced, the item to which the warranty attaches.

**What is a waiver of a right or remedy under a contract and when might you want to exercise one?**

A ‘waiver’ is a well-recognised legal term that means a person or contract party voluntarily giving up or choosing not to enforce, a legal right that he/she/it otherwise has under the contract terms.

It’s worth including this clause as drafted, since waivers can be both deliberate and – crucially, unintentional or accidental.

If you expressly and deliberately choose not to exercise or not to enforce a legal right that you otherwise have, that’s fine.

You don’t technically need to do so in writing, but it’s often a good idea to do so, so that there can be no misunderstanding about your intentions or your future intentions.

For example, you might be happy not to enforce a right on one occasion – but if the same thing happens again, you might very well want to do so.

Putting your intention in writing really helps to prevent any misunderstandings or unwelcome assumptions on the part of any other party to your agreement.

Our drafting here also reinforces this by pointing out that just because you decided not to exercise a legal right in the contract on one occasion, that doesn’t mean you’ve lost the right to do so in future if the same trigger event happens again.

It also makes clear that if you don’t take immediate action to enforce your contractual right(s), that doesn’t mean you’ve implicitly agreed to surrender them.

Finally, and equally importantly, it covers the position where, if you didn’t have the requirement for a waiver to be in writing, you might otherwise accidentally surrender one or more of your contractual rights.

This is a significant protection. In some situations, it might otherwise be reasonable for your counterparty to assume that you have surrendered contractual rights (e.g. to be paid on time or in a particular way, or to allocate territorial protections, etc.) and/or for the law to support an argument by your counterparty that you have waived those rights.

Meaning that key terms of importance to you might become undermined or unenforceable.

**Severance**

Severance clauses have been around for a long while and most people don’t pay them a lot of attention, largely because they are very rarely needed.

What they set out to do is rescue the substance of a contractual agreement if the law subsequently intervenes, by e.g. changing its position on what’s lawful or enforceable and rendering a provision within the contract suddenly not lawful.

It’s good practice to have one of these included in your agreement and most agreements keep them ‘just in case’.

In these circumstances, they’re not something you should reasonably expect to

**Licences and other rights**

You should both describe the main aspects of these licences, (e.g. who they are with, in respect of what, for how long, fees charged) and you should include scanned copies of those licences.

(Depending on the wording of your licences with them, you might need to seek consent from your licensees to assign the trademarks to someone else. If this is the case, you should seek and attach evidence of those consents here too.)

Your assignee will expect to see copies of licenses to verify how their rights in the trademarks may be restricted – and indeed, to see what revenue (licence fees) they might expect to receive from the licence holder(s).