CA-IPipp32

IP licence agreement: to use name or trademark for merchandising in a different field or industry

Contents

1. Definitions
2. Interpretation
3. Warranties for authority
4. Relationship of parties
5. Entire agreement
6. Licensor's representations as to Intellectual Property
7. The Licence of [Animalia]
8. Licensor's approval of Products
9. Licence of the Supporting IP
10. Third Party IP
11. Protection of Licensed Material
12. Royalty calculation
13. Third party infringement
14. Continuing improvement of Licensed Material
15. Product Updates
16. Derived Products
17. Confidential Information
18. Indemnity by Licensee
19. Indemnity by Licensor
20. Indemnification process
21. The measure of damages
22. Publicity / Announcements
23. Miscellaneous matters

Schedule 1: [Animalia]
Schedule 2: Supporting IP
Schedule 3: Third Parties IP
Schedule 4: Press release

This agreement is dated: [date]

It is made between:

[ABC Limited], a company incorporated in [Province] of Canada [under incorporation number [number] and] whose ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ [■ ■ ■ ■ ■ ■ ■ ■] (■ ■ ■ ■ " ■ ■ ■ ■ ");

And

[DEF Limited], a company incorporated in [Province] of Canada [under incorporation number [number] and] whose ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ [■ ■ ■ ■ ■ ■ ■ ■], (■ ■ ■ ■ " ■ ■ ■ ■ ").

It is now agreed as follows:

1. Definitions

"[Animalia]"	means the [Animalia programme, as presented on the Independent Television Network and other channels from time to time] ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■

	information about the Intellectual Property, the Know-how ■ ■ ■

	*complete and clear statement of industry and application. If ■ ■ ■ ■ ■ ■ ■ ■ 100 ■ ■ ■ ■ , ■ ■ ■ ■ ■ ■ ■ ■

[redacted] , [redacted] , [redacted] - [redacted] .

2.2. a reference to one gender shall include any or all genders and a reference to the singular may be interpreted [redacted] .

2.3. a reference to a paragraph or schedule is to a paragraph or schedule to this agreement unless the context [redacted] . [redacted] .

2.4. the headings to the paragraphs and schedules (if any) to this agreement are inserted [redacted] .

2.5. any agreement by any party not to do or omit to do something includes an obligation not to allow some [redacted] .

2.6. a reference to the knowledge, information, belief or awareness of any person shall be deemed to include the knowledge, information, [redacted] .

2.7. all money sums mentioned in this agreement are calculated net of GST, which [redacted] .

2.8. this agreement is made only in the English language. If there is any [redacted] , [redacted] .

3. Warranties for authority

The Licensee warrants that:

3.1. it is a registered entity [redacted] [[redacted] / [redacted] / [redacted]];

3.2. it has power to enter [redacted] [[redacted]];

3.3. it is not subject to any order, decree [redacted] .

© Andrew Taylor and Net Lawman Ltd

3.4. it is not aware of anything within [redacted];

3.5. it is not insolvent and knows of no circumstance which would [redacted].

3.6. its performance of this agreement will not:

3.6.1 conflict with or result in the breach of any provision [redacted];

3.6.2 conflict with any law or [redacted];

3.6.3 constitute a default (or event which with the giving [redacted], [redacted]) [redacted].

4. Relationship of parties

4.1. Nothing in this agreement shall create a partnership, [redacted], [redacted].

4.2. Neither party shall have, nor represent that it [redacted], [redacted], [redacted].

5. Entire agreement

5.1. This agreement contains the entire [redacted].

5.2. No express or implied licence of the [redacted].

© Andrew Taylor and Net Lawman Ltd

5.3. Conditions, warranties or other terms implied by [redacted].

5.4. Each party acknowledges that, in entering into this agreement, [redacted], [redacted], [redacted].

5.5. As an exception to the last [redacted], [redacted]:

[Enter list [redacted]]

6. Licensor's representations as to Intellectual Property

The Licensor [redacted]:

6.1. the Licensor is either the owner of the entire right, title and interest in and [redacted];

6.2. use of the Licensed Material [redacted];

6.3. the Licensor shall not be responsible for any loss caused [redacted].

6.4. the Licensor shall not permit [redacted], [redacted].

7. The Licence of [Animalia]

7.1. The Licensee acknowledges that the Licensor owns all right, title and [redacted] [[redacted]] [redacted].

© Andrew Taylor and Net Lawman Ltd

7.2. For the Licence fee of $ [amount], [receipt of which the Licensor now acknowledges] and [redacted].

OR

7.3. For the Licence fee of $ [amount], [receipt of which the Licensor now [redacted].

OR

7.4. For the Licence fee of $ [amount], [receipt of which the Licensor now acknowledges] and the Royalty, and to [redacted].

OR

7.5. For the Licence fee of $ [amount], [receipt of which the Licensor now acknowledges] and the Royalty, [redacted].

7.6. The Licensee shall not promote or sell any Product connected with or derived from the [redacted].

7.7. The Licensee must not assign nor charge [redacted].

© Andrew Taylor and Net Lawman Ltd

7.8. The Licensee may not allow any other person [redacted] [redacted] [redacted] .

7.9. This grant includes the right to [redacted] . [redacted]]

7.10. The Licence may not [redacted] , [redacted] :

7.10.1 that the Licensor approves [redacted] ([redacted]);

7.10.2 that the assignee enters into an agreement directly with the Licensor in [redacted] , [redacted] [redacted] [redacted] [redacted] [redacted] .

7.10.3 the sub-licence is non-assignable.

7.11. So far as any goodwill is generated [redacted] .

7.12. Every Product shall carry an attribution "[redacted] "[[[redacted]]" [redacted] [[redacted]]]"

7.13. Expiry of any patent, trademark or third party [redacted] [[redacted]].

8. Licensor's approval of Products

8.1. In order to preserve the brand value, goodwill and reputation of [Animalia], the Licensee shall consult with [redacted] , [redacted] , [redacted] , [redacted] . [redacted] .

© Andrew Taylor and Net Lawman Ltd

8.2. The consultation shall include the provision by the Licensee [redacted].

9. Licence of the Supporting IP

9.1. The Licensor grants to the Licensee a licence in perpetuity to use the [redacted] [[redacted]] [redacted].

9.2. No licence fee [redacted].

9.3. It is not required that [redacted].

10. Third Party IP

10.1. Third Party IP is listed in Schedule 3.

10.2. The Licensor has obtained all necessary permissions and [redacted], [redacted], [redacted].

10.3. The Licensor now grants a licence of in respect [redacted], [redacted].

11. Protection of Licensed Material

The Licensee agrees that it will:

11.1. not claim nor register any Intellectual Property right [redacted];

11.2. not [within ten years] create, write or make any [redacted], [redacted] [[redacted]

© Andrew Taylor and Net Lawman Ltd

[redacted] ;

11.3. not use in its own business, any [redacted] ;

11.4. not represent that the Licensee is the owner [redacted] .

11.5. use its best endeavours to notify all persons who [redacted] , [redacted] .

11.6. not remove any identification or reference [redacted] .

11.7. not publish any [redacted] , [redacted] :

11.7.1 denigrate the Licensor or [redacted] , [redacted] , [redacted] , [redacted] ;

11.7.2 reduce the value of [redacted] .

12. Royalty calculation

12.1. In this paragraph, “Net Sales Value” means [redacted] , [redacted] , [redacted] :

12.1.1 normal trade [redacted] ;

12.1.2 the costs [redacted] , [redacted] , [redacted] ;

12.1.3 general sales tax or other [redacted] , [redacted] ;

12.1.4 bank charges on sales receipts;

12.1.5 sales commission payable to third parties;

© Andrew Taylor and Net Lawman Ltd

12.1.6 other transaction taxes.

12.2. The Royalty is [twenty] per cent of the ■ ■ ■

12.11. If tax is payable or money withheld, the cost shall be borne by the [redacted].

12.12. The Licensee shall keep complete and accurate records and books [redacted].

12.13. The Licensor shall have the right, at its own cost and expense, not [redacted] [redacted] / [redacted] [redacted].

12.14. Such accountants will have access on reasonable notice to the Licensee's records during reasonable business hours for the [redacted].

12.15. The accountants shall be instructed to disclose to [redacted].

12.16. If any underpayment by the Licensee is greater than [ten] percent (10) %of [redacted].

12.17. The provisions of [redacted].

13. Third party infringement

13.1. If either party becomes in any way aware of [redacted].

© Andrew Taylor and Net Lawman Ltd

13.2. The Licensor shall have the first right, but not the [redacted] , [redacted] , [redacted] , [redacted] .

13.3. The Licensor must notify the Licensee within [28] [redacted] , [redacted] .

13.4. The Licensee agrees to co-operate with the Licensor in any litigation or other enforcement action that the Licensor [redacted] . [redacted] - [redacted] , [redacted] .

13.5. All reasonable lawyers' fee and other expenses incurred by the Licensee in [redacted] - [redacted] .

13.6. The Licensee shall have the right to participate [redacted] , [redacted] .

13.7. The Licensee shall have no recourse against the Licensor arising out of the Licensor's handling of or decisions concerning [redacted] . [redacted] , [redacted] . [redacted] .

13.8. If the Licensor fails to take action on a matter which affects or may [redacted] , [redacted] . [redacted] , [redacted] , [redacted] , [redacted] .

13.9. The Licensee may at any time discontinue [redacted] , [redacted] .

13.10. If a party brings an action under this paragraph and subsequently ceases to pursue [redacted] , [redacted]

© Andrew Taylor and Net Lawman Ltd

[redacted].

13.11. All money recovered through any proceeding or claim, or from any settlement of it, shall belong to the party [redacted]. [redacted], [redacted], [redacted], [redacted].

14. Continuing improvement of Licensed Material

14.1. The Licensor will maintain [redacted].

14.2. The Licensee will co-operate with the Licensor so far as [redacted], [redacted].

14.3. If the Licensee shall reasonably so request, the [redacted], [redacted], [redacted].

14.4. [redacted].

14.5. [redacted], [redacted].

14.6. [redacted]. [redacted], [redacted]. [redacted].

© Andrew Taylor and Net Lawman Ltd

15. Product Updates

15.1. [redacted] [redacted] [redacted] [redacted], [redacted], [redacted], [redacted] [25] % [redacted].

15.2. [redacted].

16. Derived Products

16.1. [redacted], [redacted].

16.2. The Licensee now agrees that it will:

16.2.1 [redacted];

16.2.2 [redacted];

16.2.3 [redacted], [redacted], [redacted];

16.2.4 [redacted].

17. Confidential Information

17.1. [redacted], [redacted], [redacted]. [redacted], [redacted], [redacted]

© Andrew Taylor and Net Lawman Ltd

[redacted]

17.1.1 [redacted];

17.1.2 [redacted];

17.1.3 [redacted] [redacted. . . .]

17.1.4 [redacted];

17.1.5 [redacted] ([redacted]);

17.1.6 [redacted] ([redacted]) [redacted].

17.2. This paragraph does not apply to disclosure:

17.2.1 [redacted];

17.2.2 [redacted];

17.2.3 [redacted], ([redacted]), [redacted]. [redacted];

© Andrew Taylor and Net Lawman Ltd

17.2.4 [redacted];

17.2.5 [redacted];

17.2.6 [redacted];

17.2.7 [redacted]; [redacted], [redacted], [redacted], [redacted], [redacted];

17.2.8 [redacted];

17.2.9 [redacted]. [redacted].

17.3. [redacted].

17.4. [redacted].

17.5. [redacted].

17.6. [redacted], [redacted]-[redacted].

© Andrew Taylor and Net Lawman Ltd

17.7. [redacted]

17.8. [redacted]

18. Indemnity by Licensee

[redacted]:

18.1. [redacted];

18.2. its breach of this agreement;

18.3. [redacted];

18.4. [redacted];

18.5. [redacted];

19. Indemnity by Licensor

19.1. [redacted].

19.2. [redacted]:

© Andrew Taylor and Net Lawman Ltd

19.2.1 [redacted];

19.2.2 the Licensee has not contributed to the infringement;

19.2.3 [redacted];

19.2.4 [redacted]; [redacted]

19.2.5 [redacted].

19.3. [redacted]-[redacted], [redacted], [redacted]:

19.3.1 [redacted]; [redacted]

19.3.2 [redacted].

19.4. [redacted]-[redacted].

19.5. [redacted] ([redacted]) [redacted], [redacted], [redacted], [redacted], [redacted].

20. Indemnification process

20.1. [redacted], [redacted] ([redacted] "[redacted]") [redacted]. [redacted]

© Andrew Taylor and Net Lawman Ltd

[redacted].

20.2. [redacted], [redacted]. [redacted], [redacted].

20.3. [redacted].

20.4. [redacted], [redacted].

20.5. [redacted], [redacted].

20.6. [redacted], [redacted]-[redacted], [redacted]. "[redacted]" [redacted]-[redacted]. [redacted]-[redacted], [redacted], [redacted]-[redacted].

20.7. [redacted].

© Andrew Taylor and Net Lawman Ltd

21. The measure of damages

21.1. [redacted].

21.2. [redacted], [redacted], [redacted], [redacted], [redacted], [redacted].

22. Publicity / Announcements

22.1. [redacted].

OR

22.2. No party shall:

22.2.1 make any public announcement; or

22.2.2 disclose any information; or

22.2.3 [redacted];

[redacted].

22.3. [redacted], [redacted].

22.4. [redacted]4, [redacted].

© Andrew Taylor and Net Lawman Ltd

23. Miscellaneous matters

23.1. [redacted]

23.2. [redacted]

23.3. [redacted]

23.4. [redacted] 2000 [redacted]

23.5. [redacted]

23.6. [redacted]

23.7. [redacted]

© Andrew Taylor and Net Lawman Ltd

23.8. [redacted]

23.9. [redacted]

23.10. [redacted]

23.11. [redacted]

23.12. [redacted]

23.13. [redacted]

It shall be deemed to have been delivered:

[redacted]

[redacted]

[redacted] 24 [redacted]

© Andrew Taylor and Net Lawman Ltd

23.14. [redacted]

23.15. [redacted]

23.16. [redacted]

23.17. [redacted]

23.18. [redacted]

23.19. [redacted]

Signed by [personal name] on behalf of [Licensor name] as its representative who personally accepts liability for the proper authorisation by [Licensor name] to enter into this agreement.

Signed by [personal name] on behalf of [Licensee name] as its representative who personally accepts liability for the proper authorisation by [Licensee name] to enter into this agreement.

© Andrew Taylor and Net Lawman Ltd

Schedule 1: [Animalia]

© Andrew Taylor and Net Lawman Ltd

Schedule 2: Supporting IP

© Andrew Taylor and Net Lawman Ltd

Schedule 3: Third Parties IP

© Andrew Taylor and Net Lawman Ltd

Schedule 4: Press Release

© Andrew Taylor and Net Lawman Ltd

Explanatory notes:

IP licence agreement: to use name or trademark for merchandising in a different field or industry

General notes

We have drawn this agreement licensing the merchandising rights in any form of intellectual property. The deal is that the licensee will exploit your IP in a different market, or for a different application. If you require a medium weight agreement to license rights in one product, then ■■■

By all means use the find/replace function in your word processor to change a defined term. If you do, make sure it ■ ■ ■

This is the most important paragraph in the agreement because it records the essence of your deal. A licence may be limited in time, space, product, use and many more. Please do not rely on our having covered every ■ ■ ■ ■ . ■ ■ ■ ■

Nothing you say here is binding on the supplier of the third party software or other IP, [redacted].

11. Protection of Licensed Material

When you grant the licence, you specify exactly what it covers. This paragraph places restrictions on the licensee in many areas. We suggest that you [redacted].

We now mention the last sub-paragraph. It is an absolute defence to a defamation claim that the words complained of are true. However, this might charge; it may [redacted]; [redacted].

12. Royalty calculation

We have provided a complete proposal. [redacted].

13. Third party infringement

It is not only your licensee who may cause problems for you. Infringements leading to litigation are not common, but when they happen, the usual short notes found in legal agreements are hopelessly inadequate. [redacted].

14. Continuing improvement of Licensed Material

This provision is most likely to apply to patents, trademarks and software. But if you are licensing television characters, it would include new characters or series. Edit this paragraph according to your intentions. We have used the broad word “[redacted]” [redacted] “[redacted]”. [redacted]-[redacted].

15. Product Updates

© Andrew Taylor and Net Lawman Ltd

If you buy a licence today for a simple computer application, you will probably receive a message every year or so to invite you to buy the “upgrade”. It is assumed in this licence agreement that your licensee may intend [redacted].

16. Derived Products

This is an optional paragraph. It is intended to protect your rights if your licensee makes changes [redacted] / [redacted].

This could happen deliberately, with the intention of finding an excuse to avoid payment to you, or accidentally, simply [redacted].

If you do not wish to use this paragraph, simply delete it. [redacted].

Derived products are the source of litigation the World over. The problem is to define what is derived and what is original. Copyright law and patent law apply. Western courts are reluctant [redacted].

We have favoured the licensor strongly in the wording of this paragraph. You may agree to share [redacted].

17. Confidential Information

A useful provision for both parties.

We have included this paragraph because a business has so many secrets [redacted].

© Andrew Taylor and Net Lawman Ltd

[redacted] " [redacted] " [redacted] .

18. Indemnity by Licensee

Very [redacted] .

19. Indemnity by Licensor

A limited indemnity. This at [redacted] , [redacted] , [redacted] .

20. Indemnification process

This is a thorough “process” [redacted] . [redacted] .

21. The measure of damages

The first sub-paragraph gives contractual force to [redacted] . [redacted] “ [redacted] ” [redacted] , [redacted] .

The second sub-paragraph also re-indorses what may already be [redacted] . [redacted] , [redacted] - [redacted] , [redacted] .

An order of the Court [redacted] .

22. Publicity / Announcements

This paragraph is largely to protect from [redacted] . [redacted] .

23. Miscellaneous matters

A number of special points. We have identified each of these as [redacted] . [redacted] , [redacted] . [redacted]

© Andrew Taylor and Net Lawman Ltd

[redacted]. [redacted]
[redacted]
.

Schedule 1: [Animalia]

It is absolutely essential that you define the subject [redacted]. [redacted]
[redacted], [redacted] “[redacted]”. [redacted]
[redacted].

Schedule 2: Supporting IP

Same comment applies as to last previous note.

Schedule 3: Third Parties IP

We have no comment

Schedule 4: Press Release

We have no comment

End of notes

© Andrew Taylor and Net Lawman Ltd