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

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Schedule 1: [Animalia]

Schedule 2: Supporting IP Schedule 3: Third Parties IP

Schedule 4: Press release

This agreement is dated: [date] And made between: [ABC Limited], a company incorporated in New Zealand [under company number [number] and] whose registered = = = = = = = = [ = = = = = ] ( = = = " **= = =** "); and [DEF Limited], a company incorporated in New Zealand [under company number [number] and] whose registered **••••••** [ ••••• | [ ••••• | ], ( •••• " ■ ■ ■ ■ "). It is now agreed as follows: 1. **Definitions** means the [Animalia programme, as presented "[Animalia]" on the Independent Television Network and other "[Animalia] Rights" means concepts, designs, drawings, characterisation, software programmes and other Intellectual Property which together .....[...].............. "Confidential Information" means all information about the parties,  $\blacksquare \blacksquare \blacksquare \blacksquare \blacksquare$ given or received in any medium whatever, including orally; of any description, whether recorded or unrecorded; whether protected by law ......................

It includes among other things:

information about staff, their performance and  $\blacksquare$ 

. . . . . . . . . . . . . . ,

data or information relating to suppliers, product plans, marketing strategies, finance, performance, operations, customer ■ ■ ■ , ■ ■

.....,...,....,...,

	information about the Intellectual Property, the Know-how
	information owned by a third party and in respect of which a party
	information, comment or implication published on
"Derived Product"	means any product or other material in any medium which is based or originated,
"DP Rights"	means Intellectual Property rights in a Derived Product.
"Intellectual Property"	means intellectual property of every sort, whether or not registered or registrable in any country, including intellectual property of kinds coming into existence after today; and including, among others, patents, trademarks, unregistered marks, designs, copyrights, software, domain names, discoveries, Know-
"Know-how"	means scientific or technical information, and other procedures and ways of working and organising
"Licence"	means the licence granted by this agreement.
"Licensed Material"	means the [Animalia] Rights together with the Supporting IP or •••••••••••••••••••••••••••••••••••
"Products"	means products derived from or inspired by or copied from or connected $\blacksquare \blacksquare \blacksquare \blacksquare \blacksquare \blacksquare \blacksquare$ , $\blacksquare \blacksquare \blacksquare \blacksquare \blacksquare \blacksquare \blacksquare$ .
"Range"	means [clothing or children's toys or tee shirts or meals or software apps or whatever]. [Enter

complete and clear statement of industry and application. If  $\blacksquare \blacksquare \blacksquare \blacksquare \blacksquare \blacksquare \blacksquare 100 \blacksquare \blacksquare \blacksquare \blacksquare$ , "Royalty" means the sums payable from time to time . "Supporting IP" means all Intellectual Property which is necessary or desirable to enable the Licensee fully to exploit this Licence. It includes the trade mark "[Animalia]" and collectively, the names of OR "Supporting IP" means all Intellectual Property which is necessary or desirable to enable the Licensee fully to exploit this Licence. . . . . . . . . . . 2 . "Territory" means the countries of [the  $\blacksquare$   $\blacksquare$   $\blacksquare$   $\blacksquare$   $\blacksquare$ "Third Party IP" means Intellectual Property owned by some person other than the parties, which has been incorporated = = = [ = = = ] = = = = = = = . . . . . . . . . "Update" means a revision, modification, improvement or corrected version of the Licensed Material, developed by the Licensor,  $\blacksquare \blacksquare \blacksquare \blacksquare \blacksquare \blacksquare \blacksquare$ .......................

### 2. Interpretation

In this agreement unless the context otherwise requires:

2.1. a reference to a person includes reference to that person's successors, legal representatives, permitted assigns and any person to whom rights and obligations are transferred or pass as a

2.2.	a reference to one gender shall include any or all genders and a reference to the singular may be interpreted • • • • • • • • • • • • • • • • • • •
2.3.	a reference to a paragraph or schedule is to a paragraph or schedule to this agreement unless the context •••••••••••••••••••••••••••••••••••
2.4.	the headings to the paragraphs and schedules (if any) to this agreement are inserted ••••••••••••••••••••••••••••••••••••
2.5.	any agreement by any party not to do or omit to do something includes an obligation not to allow some
2.6.	a reference to the knowledge, information, belief or awareness of any person shall be deemed to include the knowledge, information, ■ ■ ■
2.7.	all money sums mentioned in this agreement are calculated net of GST, which <b>E E E E E E E E E E E E E E E E E E E</b>
2.8.	this agreement is made only in the English language. If there is any
War	ranties for authority
The L	icensee warrants that:
3.1.	it is a registered entity • • • • • • • • • • • • • • • • • • •
3.2.	it has power to enter • • • • • • • • • • • • • • • • • • •
3.3.	it is not subject to any order, decree

	3.4.	it is not aware of anything within • • • • • • • • • • • • • • • • • • •
	3.5.	it is not insolvent and knows of no circumstance which would
	3.6.	its performance of this agreement will not:
		3.6.1 conflict with or result in the breach of any
		3.6.2 conflict with any law or
		3.6.3 constitute a default (or event which with the giving $\blacksquare$
4.	Rela	ationship of parties
	4.1.	Nothing in this agreement shall create a partnership,
	4.2.	Neither party shall have, nor represent that it = = = , = = = = = = = , = = = = = = =
5.	Ent	ire agreement
	5.1.	This agreement contains the entire   I I I I I I I I I I I I I I I I I I
	5.2.	No express or implied licence of the

	7.1.	The Licensee acknowledges that the Licensor owns all right, title and
7.	The	Licence of [Animalia]
	6.4.	the Licensor shall not permit • • • • • • • • • • • • • • • • • • •
	0.1	
	6.3.	the Licensor shall not be responsible for any loss caused
	6.2.	use of the Licensed Material
		and;
	6.1.	the Licensor is either the owner of the entire right, title and interest in
6.		ensor's representations as to Intellectual Property
		[Enter list = = = = = = = = = = = = = = = = = = =
	5.5.	As an exception to the last •••••, ••••.
	5.4.	Each party acknowledges that, in entering into this agreement, ■ ■ ■
	5.3.	Conditions, warranties or other terms implied by $\blacksquare$ $\blacksquare$ $\blacksquare$ $\blacksquare$ $\blacksquare$ $\blacksquare$ $\blacksquare$ $\blacksquare$

7.2.	For the Licence fee of \$ [500,000], [receipt of which the Licensor now acknowledges] • • • • • • • • • • • • • • • • • • •
OR	
7.3.	For the Licence fee of \$ [500,000], [receipt of which the Licensor • • • • • • • • • • • • • • • • • • •
OR	
7.4.	For the Licence fee of \$ [500,000], [receipt of which the Licensor now acknowledges] and the Royalty,
OR	
7.5.	For the Licence fee of \$ [500,000], [receipt of which the Licensor now acknowledges] and the Royalty,
7.6.	The Licensee shall not promote or sell any Product connected with or derived from the [
7.7.	The Licensee must not assign nor charge • • • • • • • • • • • • • • • • • • •

7.8.		censee may not allow any other person • • • • • • • • • • [
7.9.	_	ant includes the right to ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■
7.10.		cence may not • • • • • • • • • • • • • • • • • • •
	7.10.1	that the Licensor approves • • • • • • • • • • • • • • • • • • •
	7.10.2	that the assignee enters into an agreement directly with the Licensor in
	7.10.3	the sub-licence is non-assignable.
7.11.		as any goodwill is generated
7.12.	Every F	Product shall carry an attribution "■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■
7.13.		of any patent, trademark or third party
Lice	ensor's	s approval of Products
8.1.		r to preserve the brand value, goodwill and reputation of lia], the Licensee shall consult with

8.2.	The consultation shall include the provision by the Licensee
	••••
Lice	ence of the Supporting IP
9.1.	The Licensor grants to the Licensee a licence in perpetuity to use the
9.2.	No licence fee
9.3.	It is not required that • • • • • • • • • • • • • • • • • • •
Thir	d Party IP
10.1.	Third Party IP is listed in Schedule 3.
10.2.	The Licensor has obtained all necessary permissions and
10.3.	The Licensor now grants a licence of in respect
	■ .
Prot	tection of Licensed Material
The L	icensee agrees that it will:
11.1.	not claim nor register any Intellectual Property right
	;
11.2.	not [within ten years] create, write or make any

10.

	11.3.	••••	e in its own business, any
	11.4.		resent that the Licensee is the owner
	11.5.		best endeavours to notify all persons who
	11.6.	not rem	nove any identification or reference
	11.7.	not pub	olish any • • • • • • • • • • • • • • • • • • •
		11.7.1	denigrate the Licensor or $\blacksquare$ $\blacksquare$ $\blacksquare$ $\blacksquare$ $\blacksquare$ $\blacksquare$ , $\blacksquare$ $\blacksquare$ $\blacksquare$ , $\blacksquare$ $\blacksquare$ $\blacksquare$ , $\blacksquare$
		11.7.2	reduce the value of •••••••••••••••••••••••••••••••••••
12.	Roy	alty ca	alculation
	12.1.		paragraph, "Net Sales Value" means ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■
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		12.1.1	normal trade = = = = = = = = = = = = = = = = = = =
			normal trade = = = = = = = = = = = = = = = = = = =
		12.1.2	normal trade = = = = = = = = = = = = = = = = = = =
		12.1.2 12.1.3	normal trade • • • • • • • • • • • • • • • • • • •

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12.2.	The Royalty is [twenty] per cent of the
12.3.	Royalty is payable for •••••••[••••]•••••••••••••••••••••••••
12.4.	On or before [day / date] in each [month / year] = = = = = = = = = = = = = = = = = = =
12.5.	the Licensee shall pay • • • • • • • • • • • • • • • • • • •
12.6.	Royalty payment shall be made
12.7.	Payments shall be considered to have
12.8.	Payments due but unpaid on the due date shall bear interest at a rate of [
12.9.	Any tax which the Licensee is required by law • • • • • • • • • • •
	,
12.10	. If money is withheld on account of tax, the Licensee shall
	<pre></pre>
	12.10.1 a written receipt for the tax paid;
	12.10.2 other documentation necessary or desirable to enable ■ ■ ■

12.1.6 other transaction taxes.

	12.11. If tax is payable or money withheld, the cost shall be borne by the ,,,,,,,
	12.12. The Licensee shall keep complete and accurate records and books
	12.13. The Licensor shall have the right, at its own cost and expense, not
	12.14. Such accountants will have access on reasonable notice to the Licensee's records during reasonable business hours for the,
	12.15. The accountants shall be instructed to disclose to •••••••••••••••••••••••••••••••••••
	12.16. If any underpayment by the Licensee is greater than [ten] percent (10%) of the,,,,,,,
	12.17. The provisions of <b>•••••••••••••••••••••••••••••••••••</b>
13.	Third party infringement
	13.1. If either party becomes in any way aware of

13.2.	The Licensor shall have the first right, but not the
13.3.	The Licensor must notify the Licensee within [28]
13.4.	The Licensee agrees to co-operate with the Licensor in any litigation or other enforcement action that the Licensor
	•
13.5.	All reasonable lawyers' fee and other expenses incurred by the Licensee in
13.6.	The Licensee shall have the right to participate
13.7.	The Licensee shall have no recourse against the Licensor arising out of the Licensor's handling of or decisions concerning
13.8.	If the Licensor fails to take action on a matter which affects or ■ ■ ■ ■ ■
	,,,
13.9.	The Licensee may at any time discontinue
13.10.	If a party brings an action under this paragraph and subsequently ceases to pursue

13.11. All money recovered through any proceeding or claim, or from any settlement of it, shall belong to the party
Continuing improvement of Licensed Material
14.1. The Licensor will maintain
14.2. The Licensee will co-operate with the Licensor so far as
14.3. If the Licensee shall reasonably so request, the
14.4.
14.5.
14.6.

#### 15. Product Updates

#### 16. Derived Products

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16.2.4

#### 17. Confidential Information

17.1.

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	17.1.5			■(■					 	
	17.1.6				:::				 	
17.2.	This par	ragraph	doesı	not ap	ply to	discl	osure	):		
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	17.2.2				•				 	• • • • • •
	17.2.3			■ , ( ■ ■ ■ ■					 	••••

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18.	Inde	mnity by Licensee
	18.1.	;
	18.2.	its breach of this agreement;
	18.3.	
	18.4.	;
	18.5.	, and the second
19.	Inde	mnity by Licensor
	19.1.	
	19.2.	:

	19.2.1								
	19.2.2	the Lice	nsee has	not con	tributed	to the in	fringeme	ent;	
	19.2.3						••••	••••	
	19.2.4								
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19.3.									
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21.	The	measure	of	damages
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21.1.																																			
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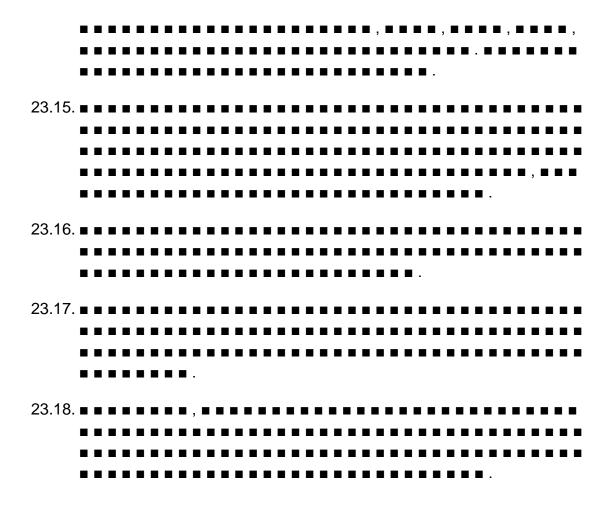
# 22. Publicity / Announcements

22.1.			J
OR			
22.2.	No part	ty shall:	
	22.2.1	make any public announcement; or	
	22.2.2	disclose any information; or	
	22.2.3		•
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22.3.		,	
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22.4.			•

## 23. Miscellaneous matters

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23.8.	
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	It shall be deemed to have been delivered:
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23.13	3. <b> </b>
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**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.

# Schedule 1: [Animalia]

# **Schedule 2: Supporting IP**

## **Schedule 3: Third Parties IP**

### **Schedule 4: Press Release**

# **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

## Paragraph specific notes

Notes numbering refers to paragraph numbers.

#### 1. Definitions

You should first decide on the contents of the document, then return to check what definitions are needed and whether they really   I I I I I I I I I I I I I I I I I I
The definition relating to the subject matter of the agreement requires particular care on your part. We have named your main product "Animalia". You should now find and replace
We have provided for a separate deal in respect of supporting IP from that relating to the main subject of your licence. That is because either you may not want to grant a licence in the same terms, or you may not be able to do so. The way the agreement is worded, you are saying: "Pay me for the rights in my special creation, but I know you will also need these
Only you know whether you need to make different provisions for some part of your licensed system. We have given a name to the main product, "Animalia Rights" and used "Supporting IP" to cover stuff that has been licensed but not

By all means use the find/replace function in your word processor to change a defined term. If you do, make sure it
Interpretation
Leave these items in place unless there is a good reason to edit or remove. Each of these items has been carefully considered in the context of this agreement and has been included for a purpose.
Warranties for authority
The importance of these warranties is largely in removing a defence of "I did not realise" in the event of some error on the part of a party. Although a warranty can be no more than a promise,
We have favoured the licensor strongly in the wording of this paragraph. You can edit it
Relationship of parties
This is a simple statement for the avoidance of doubt. We suggest $\blacksquare$
Entire agreement
This paragraph prevents a party from later saying he was relying on some other document or website or what was said. These provisions are more important in an international trade agreement, when another country may have slightly different law on, for example, implied conditions. If other documents are to be relied
Licenser's representations as to Intellectual Dreporty
Licensor's representations as to Intellectual Property
This is your document. You do not have to offer anything more than the barest of licences. However, we assume that your counter party is as intelligent and well advised as you are. If so, it will require confirmation of some of these points. You can edit now, or take them out and put some back only after your counter party has

## 7. The Licence of [Animalia]

2.

3.

4.

5.

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    I I I I I I I I I I I I I I I I I I
A limitation on sale outside the specified range and Territory is difficult to enforce. You should use it only where your product makes • • • • • • • • • • • • • • • • • • •
We have given you no fewer than four different alternatives for the licence terms. However, they are not intended to be straight alternatives. You can mix terms from each so as to come up with your perfect
Licensor's approval of Products
By definition, it is difficult to tie down an unknown future action. We cannot cover "unknown unknowns". Nevertheless, we have made it as clear as possible that your licensee has a positive obligation to obtain your approval of what it makes, or sells as a result of this agreement.
Licence of the Supporting IP
•
Whether or not you wish to include this paragraph depends on what your licensed material or product is. Either it requires ongoing support or it does not. If it
•
By all mean edit
Third Party IP
It is possible that you do not use any third party IP. But that is unlikely. If you know of any, we suggest you

9.

	Nothing you say here is binding on the supplier of the third party software or other IP,
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
12.	Royalty calculation
	We have provided a complete proposal.
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.
14.	Continuing improvement of Licensed Material
	This provision is most likely to apply to patents, trade marks 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 " • • • • " • • • • • • • • • • • • •
15.	Product Updates
	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

16.	Derived Products
	This is an optional paragraph. It is intended to protect your rights if your licensee makes changes
	This could happen deliberately, with the intention of finding an excuse to avoid payment to you, or accidentally, simply
	If you do not wish to use this paragraph, simply delete it. ■ ■ ■ ■ ■ ■ ■ ■ ■
	••.
	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
	We have favoured the licensor strongly in the wording of this paragraph. You may agree to share the value or to change the circumstances so that both sides benefit from derived products. Our advice is $\blacksquare$
17.	Confidential Information
	A useful provision for both parties.
	We have included this paragraph because a business has so many secrets ■
18.	Indemnity by Licensee
	Very • • • • • • • • • • • • • • • • • • •

19.	indemnity by Licensor
	A limited indemnity. This at
20.	Indemnification process
	This is a thorough "process" ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■
21.	The measure of damages
	The first sub-paragraph gives contractual force to • • • • • • • • • • • •
	The second sub-paragraph also re-indorses what may already be
	An order of the Court
22.	Publicity / Announcements
	This paragraph is largely to protect from
23.	Miscellaneous matters
	A number of special points. We have identified each of these as $\blacksquare$ $\blacksquare$ $\blacksquare$ $\blacksquare$
	·

Schedule 1: [Animalia]

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It is absolutely essential that you define the subject ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■	

#### 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**