

ZA-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: Supporting IP

Schedule 2: Third Parties IP

Schedule 3: press Release

This agreement is dated [date] :

ABC Limited, a company incorporated in the Republic of South Africa [under company registration number [number] and] whose registered [] (“ ”);

DEF Inc, a company incorporated in England and Wales under [act / law], whose main place of [], (“ ”).

It is now agreed as follows:

1. Definitions

- “Animalia” means the Animalia programme, as presented on the Independent Television Network .
- “Animalia Rights” means concepts, designs, drawings, characterisation, software programmes and other Intellectual Property which .
- “Confidential Information” means all information about the parties to this agreement, including any information which may give a commercially competitive advantage to any other person. It does not include information that it is reasonably necessary to disclose to a customer or other person .
- information about staff, their performance and ,
- data or information relating to suppliers, product plans, marketing strategies, finance, performance, operations, customer , ;
- information about the Intellectual Property, the Know-how and all ;
- information created or arising from this

agreement;

information owned by a third party and in respect of which a party

information, comment or implication published on

data or information relating to processes, formulae, procedures, designs, drawings, apparatus,

information about the Intellectual Property and

It does not include information that it is reasonably necessary to disclose to a customer or other person in the usual course

“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, trade marks, 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
“Person”	means a human individual, a corporate entity, a partnership, a governmental authority and any organisation which is managed or controlled as a unit. A reference to a Person includes reference to that Person’s successors, legal representatives, permitted assigns and any Person to whom
“Products”	means products derived from or inspired by or copied from or connected
“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 100 ,]
“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
1 .	
OR	
“Supporting IP”	means all Intellectual Property which is necessary or desirable to enable the Licensee fully to exploit this Licence.
1 .	
“Territory”	means the countries of the European

“Third Party IP”	means intellectual property owned by some Person other than the parties, which has
"Update"	means a revision, modification, improvement or corrected version of the Licensed Material, developed by the Licensor,

2. Interpretation

In this agreement unless the context otherwise requires:

- 2.1. a reference to one gender shall include any or all genders and a reference to the singular may be interpreted
- 2.2. a reference to a paragraph or schedule is to a paragraph or schedule to this agreement unless the context
- 2.3. the headings to the paragraphs and schedules (if any) to this agreement are inserted
- 2.4. any agreement by any party not to do or
;
- 2.5. a reference to the knowledge, information, belief or awareness
,
- 2.6. all money sums mentioned in this
,
- 2.7. this agreement is made only in the English language. If there is any conflict in meaning between the English language version of this agreement

3. Warranties for authority

Each of _____ :

3.1. it is properly registered and operates under the _____

;

3.2. it is not subject to any order, decree _____

3.3. it is not aware of anything within _____

;

3.4. it is not insolvent and knows of no circumstance which would _____

3.5. The Licensee warrants _____

:

3.5.1 _____ conflict with or result in the breach of any provision of its _____

;

3.5.2 _____ conflict with any law or _____

;

3.5.3 _____ constitute a default (or event which with the giving _____

)

4. Relationship of parties

4.1. Nothing in this agreement shall create a partnership,

4.2. Neither party shall have, nor represent that it

5. Entire agreement

5.1. This agreement contains the entire

5.2. Each party acknowledges that, in entering into this agreement,

5.3. No express or implied licence of the

5.4. Conditions, warranties or other terms implied by

5.5. As an exception to the last

*[Enter list
]*

6. Licensor's representations as to Intellectual Property

The Licensor :

6.1. the Licensor is either the owner of the entire right, title and interest in
and

6.2. use of the Licensed Material

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

6.4. [the Licensor shall not

].

7. The Licence of Animalia

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

7.2. For the Licence fee of R [500,000], [receipt of which the Licensor now acknowledges]

OR

7.3. For the Licence fee of R [500,000], [receipt of which the Licensor]

OR

7.4. For the Licence fee of R [500,000], [receipt of which the Licensor now acknowledges] and the Royalty,

[/ /]

OR

- 7.5. For the Licence fee of R [500,000], [receipt of which the Licensor now acknowledges] and the
,
- 7.6. the Licensee shall not promote or sell any product or service connected with or derived from
,
- 7.7. The Licensee must not assign nor
[].
- 7.8. The Licensee may not allow any other
- 7.9. This grant includes the right to
[].
- 7.10. The Licence may not
:
- 7.10.1 that the Licensor approves ();
- 7.10.2 that the assignee enters into an agreement directly with the Licensor
,
- 7.10.3 the sub-licence is non-assignable.
- 7.11. So far as any goodwill is generated
- 7.12. Every Product shall carry an attribution “
“ ”
[]”

7.13. Expiry of any patent, trademark or third party

[].

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 the

, , ,

8.2. The consultation shall include the provision by the Licensee

9. Licence 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

9.4. Products derived from ,

10. Third Party IP

10.1. Third Party IP is listed in Schedule 2.

10.2. The Licensor has obtained all necessary permissions and

10.3. The Licensor now grants a licence of in respect

11. Protection of Licensed Material

The Licensee agrees that it will:

11.1. not claim nor register any intellectual property right

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

11.3. not use in its own business, any

11.4. not represent that the Licensee is the owner

11.5. use its best endeavours to notify all Persons who

11.6. not remove any identification or reference

11.7. not publish any

11.7.1 denigrate the Licensor or

11.7.2 reduce the value of

12. Royalty calculation

12.1. In this paragraph, "Net Sales Value" means

12.1.1 normal trade

12.1.2 the costs

12.1.3 value added tax or other

12.1.4 bank charges on sales receipts;

12.1.5 sales commission payable to third parties;

12.1.6 sales taxes;

12.1.7 other transaction taxes.

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

[8

]%,

12.9. Any tax which the Licensee is required by law

12.10. If money is withheld on account of tax, the Licensee shall

12.10.1 a written receipt for the tax paid;

12.10.2 other documentation necessary or desirable to enable

12.11. If tax is payable or money with held, 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 amount

12.17. The provisions of

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

?

14. Continuing improvement of Licensed Material

14.1.

14.2.

14.3.

14.4.

14.5.

14.6.

15. Product Updates

15.1. []

[25 %]

15.2.

16. Derived Products

16.1.

16.2. The Licensee now agrees that it will:

16.2.1

16.2.2

16.2.3

16.2.4

17. Confidential Information

17.1.

17.1.1

17.1.2

17.1.3

[...]

17.1.4

17.1.5

17.1.6

17.2. This paragraph does not apply to disclosure:

17.2.1

;

17.2.2

;

17.2.3

, (,) ,

;

17.2.4

;

17.2.5

;

17.2.6

;

17.2.7

;

,

,

,

,

;

17.2.8

;

17.2.9

.

.

17.3.

.

17.4.

17.5.

5

17.6.

17.7.

17.8.

18. Indemnity by Licensee

18.1.

18.2. its breach of this agreement;

18.3.

18.4.

18.5.

18.6. ()
) , , ,
,

19. Indemnity by Licensor

19.1.

19.2.

:

19.2.1

;

19.2.2 the Licensee has not contributed to the infringement;

19.2.3

;

19.2.4

;

19.2.5

19.3.

,

,

:

19.3.1

;

19.3.2

;

19.4.

20. Indemnification process

20.1.

(" ")

20.2.

20.3.

20.4.

20.5.

20.6.

[]

20.7.

21. The measure of damages

21.1.

21.2.

22. Publicity / Announcements

22.1.

OR

22.2. No party shall:

22.2.1 make any public announcement; or

22.2.2 disclose any information; or

22.2.3

;

22.3.

22.4.

3,

23. Miscellaneous matters

23.1.

23.2.

23.3.

23.4.

23.5.

23.6.

23.7.

23.8.

23.9.

23.10.

23.11.

23.12.

It shall be deemed to have been delivered:

;

[] ;

- : 24

. [

]

23.13.

23.14.

23.15.

23.16.

23.17.

23.18.

23.19.

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

Schedule 1: Supporting IP

Schedule 2: Third Parties IP

Schedule 3: Press Release

Explanatory Notes:

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

Paragraph Specific Notes:

Notes referring to specific paragraphs

1. Definitions

You should first decide on the contents of the document, then return to check what definitions are needed and whether they really

The definition relating to the subject matter of the agreement requires particular care on your part. You have selected this document because the deal you want is right here. But we

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 search/replace function in your word processor to change a defined term. If you do, make sure it

2. 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.

3. 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. These matters

4. Relationship of parties

We have no comment

5. Entire agreement

This paragraph prevents a party from later saying he was relying on some other document or web site 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

6. 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

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

A limitation on sale outside the specified Products and Territory is difficult to enforce. You

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

8. 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 he makes, or sells as a result of this agreement.

9. Licence of the Supporting IP

As we mentioned under "defined terms", if you do not wish to specify supporting IP separately, delete this paragraph. If

()

10. Third Party IP

It is possible that you use no third party IP. But that is unlikely. If you know of any, we suggest you list

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

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 not be the same in all ;

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

Derived products are the source of litigation the World over. The problem is to define what is derived

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

17. Confidential Information

We have included this paragraph because a business has so many secrets

18. Indemnity by Licensee

Very widely worded to give strong protection to

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

Schedule 1: Supporting IP

It is absolutely essential that you define supporting IP

“ ”

Schedule 2: Third Parties IP

Schedule 3: Press Release

End of notes