

HERC IP Framework – Assignment Agreement

Details Schedule

Item	Parties	
1.	Assignor (granting entity)	Name: <i>[insert]</i> ABN: <i>[insert]</i> Address: <i>[insert]</i> Email: <i>[insert]</i> For attention of: <i>[insert]</i>
2.	Assignee (receiving entity)	Name: <i>[insert]</i> ABN: <i>[insert]</i> Address: <i>[insert]</i> Email: <i>[insert]</i> For attention of: <i>[insert]</i>
Assignment Details		
3.	Date of Assignment (clause 1)	<i>[Tick which date applies.]</i> The date that the last party signs this Agreement. <input type="checkbox"/> The date that the Assignor receives payment of the Fee <i>(only use if Fee is a single payment)</i> . <input type="checkbox"/> The date as set out in Schedule 2 <i>(only use if a custom fee structure is used)</i> <input type="checkbox"/> The following date: <i>[insert]</i> <input type="checkbox"/>
4.	Goodwill (clause 1)	<i>[Tick which applies.]</i> Goodwill to be assigned <input type="checkbox"/> Goodwill not to be assigned (tick this option if not applicable) <input type="checkbox"/>
Payments		
5.	Fee (AUD) (clause 6)	<i>[Tick as applicable.]</i> The following amount, as a single payment: <input type="checkbox"/> \$ <i>[insert]</i> (excluding GST) The custom Fee Structure as set out in Schedule 2 <input type="checkbox"/>
6.	Payment date (clause 6)	<i>[Tick as applicable.]</i> The date that the last party signs this Agreement, with the Assignor's receipt of the Fee acknowledged. <input type="checkbox"/> The following date: <i>[insert]</i> <i>(only use if Fee is a single payment)</i> <input type="checkbox"/> The date(s) as set out in the custom Fee structure in Schedule 2 <i>(only use if a custom fee structure is used)</i> <input type="checkbox"/>
Licences		
7.	Existing Licence Details	<i>[Insert details of any licences in force in respect of the Property as at the Date of Assignment.]</i>
Related Materials		
8.	Related Materials to be delivered (clause 4)	<i>[Insert details of any documents or materials to be provided by the Assignor to the Assignee.]</i>

Operative provisions

1. Definitions

Agreement means this assignment agreement, and any schedules, annexures and attachments to it.

Business Day means a day that is not a Saturday, Sunday, public holiday or bank holiday in the place where the act is to be performed or where the notice is received.

Date of Assignment means the date the assignment of the IPRs in the Property takes effect and is the date specified in item 3 of the Details Schedule.

Details Schedule means the schedule of details particular to this Agreement and is set out on the front cover of this Agreement.

Fee means the amount payable to the Assignor in accordance with item 5 of the Details Schedule, and (if applicable) in accordance with the custom fee structure set out in Schedule 2.

Intellectual Property Rights or IPR means patents, rights to exploit inventions, trade marks or service marks (including goodwill, if specified in item 4 of the Details Schedule), registered designs, plant breeder's rights, copyrights and related rights, database rights, design rights, circuit layout rights, in each case whether registered or unregistered, including rights to apply for and be granted and applications for any of the above and any continuations, continuations-in-part, divisional applications, renewals or extensions of, and rights to claim priority from, those rights, and any similar right recognised from time to time in any jurisdiction, together with all rights of action in relation to the infringement of any of the above, but does not include Moral Rights and similar personal rights, which by law are non-assignable.

Moral Rights has the same meaning in Part IX of the *Copyright Act 1968* (Cth) or any similar foreign legislation as applicable.

Property means the IPR identified in Schedule 1, and any future IPR which is entitled to claim priority from any of those listed in Schedule 1 as developed and/or owned by the Assignor.

2. Assignment

- (a) In consideration of the Fee paid by the Assignee to the Assignor, the Assignor irrevocably transfers and assigns to the Assignee on and from the Date of Assignment all property, right, title and interest in and to the Property.
 - (b) Subject to any licences disclosed in item 7 of the Details Schedule, the assignment under clause 2(a) is free from all encumbrances and includes all the rights, powers, liberties and immunities conferred on the owner of any of the Property.
 - (c) Without limiting clause 2(b), to the extent the Assignor has the right to take action against any other person for infringement or misuse of the Property, to the extent possible under law, the Assignor assigns to the Assignee on and from the Date of Assignment all such rights (including the right to sue for damages and other remedies), whether such infringement or misuse took place before or after the Date of Assignment.
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3. Further assurances

Unless otherwise agreed by the parties, the Assignor undertakes at the expense of the Assignee to do all acts and execute all documents as are necessary to enable the Assignee to have the assignment of any of the Property and the Assignee's ownership of any of the Property recorded under any relevant law.

4. Delivery of the Related Materials

If item 8 of the Details Schedule specifies any documents or other physical materials (**Related Materials**), then on request by the Assignee, but subject to receipt of payment of the Fee, the Assignor must deliver the Related Materials to the Assignee (in a form reasonably nominated by the Assignee).

5. Notification

The Assignee is entitled to notify, on the Assignor's behalf, the assignment provided for by clause 2, to the relevant IPR registers. The costs of making such notifications will be borne by the Assignee.

6. Payment

The Assignee must pay the Assignor the Fee:

- (a) on or before the payment date specified in item 6 of the Details Schedule; or
- (b) (if a custom fee structure is used) in accordance with the custom fee structure set out in Schedule 2,

7. GST

- (a) In this clause 7, words and expressions which have a defined meaning in the *A New Tax System (Goods and Services Tax) Act 1999* (Cth) (**GST Act**) have the same meaning as in the GST Act.
- (b) The Fee payable under this Agreement is exclusive of GST.
- (c) If GST is payable by a supplier on any supply made under this Agreement:
 - (i) the recipient, upon receiving a tax invoice from the supplier, will pay to the supplier an amount equal to the GST payable on the supply; and
 - (ii) this amount will be paid in addition to, and at the same time, that the consideration for the supply is to be provided.

8. Further work

For the avoidance of doubt, nothing in this Agreement requires the Assignor to do any further development, investigation or other work in respect of or in relation to the Property.

9. Warranties

The Assignor warrants that as at the Date of Assignment:

- (a) but for this Agreement the Assignor is and would be the sole and beneficial owner of the Property;
- (b) it is not aware (but without having carried out any investigation) that any third party owns or claims any rights in the Property;
- (c) it is not aware (but without having carried out any investigation) that the use of the Property, in any country or region listed next to that Property in Schedule 1 (if any) or otherwise in any country or region, will infringe the IPR or other rights of any other person; and
- (d) except as set out in item 7 of the Details Schedule, there are no licences in force in respect of the Property as at the Date of Assignment.

10. No representations

The Assignor does not give any warranty, representation or undertaking:

- (a) as to the efficacy or usefulness of the Property; or
- (b) that the Property is or will be valid or subsisting or (in the case of an application) will proceed to grant; or
- (c) that is not expressly set out in this Agreement.

11. Dispute resolution

- (a) Any dispute, controversy or claim arising out of or in connection with this Agreement, including its existence, breach, validity or termination (**Dispute**) must be dealt with in accordance with this clause 11. This clause 11 does not prevent either party from seeking urgent injunctive or similar interim relief from a court of competent jurisdiction.

- (b) The party claiming that there is a Dispute must notify the other party in writing and give details of that Dispute.
 - (c) On receipt of a notification under clause 11(b) the parties must arrange for their respective representatives to meet within 20 Business Days to attempt to resolve the Dispute in good faith.
 - (d) If the Dispute is not resolved within 20 Business Days of receipt of the notification (or longer period agreed by the parties) the parties will endeavour to settle the Dispute by mediation administered by the Australian Disputes Centre (ADC). The mediation must be conducted in accordance with the *ADC Guidelines for Commercial Mediation* operating at the time the matter is referred to ADC.
 - (e) If the Dispute is not resolved within 30 Business Days from the date that the written notice of the Dispute is received, then either party may initiate proceedings in a court of competent jurisdiction.
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12. General

12.1 Counterparts

This Assignment Agreement may be executed in any number of counterparts. All counterparts will collectively be taken to constitute one instrument.

12.2 Governing law

- (a) 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 are governed by, the laws of the State or Territory of the location of the Assignor set out in item 1 of the Details Schedule.
- (b) Notwithstanding clause 12.2(a), any question concerning the validity of any IPR will be subject to the law and jurisdiction of the country in which such IPR exists.

12.3 Entire agreement

This Agreement constitutes the entire agreement between the parties in connection with its subject matter and supersedes all previous agreements or understandings between the parties in connection with its subject matter.

Schedule 1 - Property

1. Patents

Title	Inventor/s	Registration / application no.	Country or region	Date filed	Publication number	Status and/or date granted

2. Copyright

Title	Description	Author/s

3. Trade marks

Trade mark	Registration / Application no.	Status	Country or region	Goods and services

4. Designs

Product name	Designer/s	Design no. or registration no.	Country or region	Status

5. Other Property

[insert any other relevant Property]

Schedule 2 - Custom Fee Structure

[Insert details of the custom fee structure, if applicable]

[If applicable, the formulae for identifying/calculating the Date of Assignment with reference to the fee payment date(s) should also be set out in this Schedule.]

Signing page

Signed as an agreement.

Signed for and on behalf of the
[Insert Assignor name and ABN]
by its duly authorised
representative:

Signature of authorised
representative

Full name of authorised
representative

Date

Signature of witness

Full name of witness

Signed for and on behalf of the
[Insert Assignee name and ABN]
by its duly authorised
representative:

Signature of authorised
representative

Full name of authorised
representative

Date

Signature of witness

Full name of witness