

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"/>

Guidance Note for items 1 and 2: These items set out the parties' representatives, including for disputes under the Agreement

The location of the Assignor is also the governing law and jurisdiction of the Agreement (see clause 12.2).

Guidance Note for item 3: The date from which the assignment of the IPRs takes effect, should be specified in this item. If the Fee is a single payment, this would normally be the date on which the Fee is received by the Assignor or a date after that has occurred. If the Fee is nominal (e.g. \$1), the parties may agree that the assignment takes effect from the date when the last party signs the Agreement. If a custom fee structure is used, then the date (or the formula for calculating the date) should be specified in Schedule 2.

Guidance Note for item 4: This item is only applicable when Schedule 1 identifies trade mark or service mark rights. It allows the parties to specify whether trade marks will be assigned with business goodwill or not.

It is possible to assign the right to a registered trade mark without assigning the goodwill in the business concerned.

Rights in relation to unregistered trade marks can only be assigned by way of an assignment of goodwill of the underlying business. This goodwill cannot be separated from the goodwill of the business itself except where the organisation comprises several discrete businesses and the trade mark assigned is not associated with all of those discrete operations. In those circumstances, the goodwill of each business component can be separated.

Advice should be sought from a stamp duty expert if an assignment of goodwill is required.

Payments		
5.	Fee (AUD) (clause 6)	<p><i>[Tick as applicable.]</i></p> <p>The following amount, as a single payment: <i>[\$insert]</i> (excluding GST) <input type="checkbox"/></p> <p>The custom Fee Structure as set out in Schedule 2 <input type="checkbox"/></p>
6.	Payment date (clause 6)	<p><i>[Tick as applicable.]</i></p> <p>The date that the last party signs this Agreement, with the Assignor's receipt of the Fee acknowledged. <input type="checkbox"/></p> <p>The following date: <i>[insert]</i> (only use if Fee is a single payment) <input type="checkbox"/></p> <p>The date(s) as set out in the custom Fee structure in Schedule 2 (only use if a custom fee structure is used) <input type="checkbox"/></p>
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>

Guidance Note for item 5: This item should indicate whether the Fee is a single payment, or in accordance with a custom fee structure to be set out in Schedule 2.

If the parties choose the Fee to be a single payment, then this item should also set out the amount of the Fee (exclusive of GST) payable by the Assignee.

The Fee should be at least \$1 (or other nominal amount) to ensure there is consideration for the Agreement. While the assignment itself may not require consideration, it is required for the additional contractual obligations.

Guidance Note for item 6: This item allows the parties to specify the payment date. The Assignee must pay the Assignor the Fee on or before the date specified in this item 6.

If the Fee is nominal (for example \$1), a payment date that is the date that the last party signs this Agreement, with the Assignor's receipt of the Fee acknowledged may be appropriate. If the parties intend to have the Fee paid in instalments, the Agreement would require amendments to provide for payment by that method and to address when the assignment of IPR is effective.

Guidance Note for item 8: This item allows the parties to specify any documents or materials that the Assignor must provide to the Assignee after the Date of Assignment, upon request (and subject to the payment of the Fee).

The Related Materials may include, for example, originals of documents, prototype models, source code files, drawings, or any other physical or electronic materials.

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.

Guidance Note for definition of Property: The Property that is being assigned under this Agreement should be detailed in Schedule 1. For patents, this will include all future patent applications and granted patents that claim priority from the assigned patent(s)/patent application(s) whether under domestic law (e.g. divisional patents), under the Paris Convention, or under the Paris Cooperation Treaty (PCT). For trade marks, this will include international applications that claim priority from the assigned trade mark(s) under the Paris Convention. For designs, this will include applications in other countries/regions that claim priority from the assigned design(s) under the Paris Convention.

The parties should exercise caution if the Property identified in Schedule 1 includes any foreign IPR. If it does, the parties should consider whether local advice may be necessary or desirable.

Guidance Note for clauses 2(a) and 2(b): These provisions transfer the ownership of, and all rights in, the Property detailed in Schedule 1, free of any encumbrances.

Guidance Note for clause 2(c): This clause transfers the rights of the Assignor in respect of any infringement claims it has or had prior to the Date of Assignment to the Assignee. The Assignee is entitled to pursue remedies in respect of any infringements of the Property.

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.

Guidance Note for clause 3: This clause requires the Assignor to complete any documents that are needed to enable the Assignee's ownership of the IPR in the Property. For example, if a regulatory body requires a further document to be completed to enable the Assignee to register its ownership of the IPR in the Property.

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).

Guidance Note for clause 4: This clause requires, subject to the Assignee having paid the Fee, the Assignor to deliver any Related Materials specified in item 8 of the Details Schedule to the Assignee in the form that the Assignee reasonably requires.

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.

Guidance Note for clauses 9(a), 9(b) and 9(c): These clauses require the Assignor to promise that it is the sole owner of the IPR in the Property and that it is not aware of any entity or person that has started or is intending to start a law suit against the Assignor in relation to its ownership of the Property.

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,

Guidance Note for clause 6: This clause requires the Assignee to pay:

- the Fee specified in item 5 of the Details Schedule; and
- by the date specified in item 6,

or otherwise in accordance with the custom fee structure, if applicable.

The Assignor should issue an invoice in respect of the payment of the Fee.

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.

Guidance Note for clause 7: This clause provides that if GST is payable by the Assignor, then the Assignee will pay the Assignor the Fee plus any GST payable on that supply.

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.

Guidance Note for clause 8: This clause clarifies that the Assignee takes the Property as it is on the Date of Assignment and that the Assignor has no obligation to undertake any further work in respect of the Property. If the Assignee wishes the Assignor to undertake further work on the Property, the parties should enter into a separate services agreement setting out those requirements.

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.

Guidance Note for clause 9(d): This clause requires the Assignor to promise that the only licence rights granted in respect of the IPR are those set out in item 7 of the Details Schedule.

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.

Guidance Note for clause 10: This clause provides that the Assignor does not make any promises in respect of the usefulness of the Property. The Assignee takes the Property as it is and must satisfy itself and conduct its own enquiries of the Property's value and usefulness.

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.

Guidance Note for clause 11(a): A party may go to court and urgently seek an order for injunctive or interim relief, including prior to following the Dispute process.

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.

Guidance Note for clause 12.1: The purpose of this clause is to make it clear that the parties can sign separate copies of this Agreement (called 'counterparts') and the Agreement will be binding. The parties should ensure that the counterpart documents are exactly the same.

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.

Guidance Note for clause 12.2: The location of the party specified as the Assignor in the Details Schedule determines the applicable law and jurisdiction of the Agreement.

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.

Guidance Note for 12.3: The purpose of this clause is to make clear that this Agreement is the entire agreement between the parties with respect to the assignment of the Property.

For guidance only

Schedule 1 - Property

1. Patents

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

Guidance Note for Schedule 1: This Schedule should clearly set out the Property to be assigned to the Assignee under the Agreement.

This Schedule sets out common forms of IPRs that are assigned. However, the parties should amend this Schedule as necessary to reflect the relevant Property.

Guidance Note for section 1 of Schedule 1: The details of all patents that are being assigned should be set out in this section. If a patent is in the process of being registered, the details and status of that registration should be included in this table. For some jurisdictions, it may also be important to separately identify in this Schedule any rights to claim priority from an originating patent application.

This Agreement operates so that the Property specified in this section includes all future patent applications and granted patents that claim priority from the assigned patent(s) as developed and/or owned by the Assignor.

2. Copyright

Title	Description	Author/s

Guidance Note for section 2 of Schedule 1: The details of all copyright that is being assigned should be set out in this section. As copyright is not a registerable property under Australian law, the parties should take care to clearly and specifically identify the Property that is being assigned. The parties should also make clear whether the copyright being assigned is existing copyright and/or future copyright.

The Assignor may assign the copyrights to any existing and/or future works that it holds.

3. Trade marks

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

Guidance Note for section 3 of Schedule 1: The details of all trade marks (both registered and unregistered) that are being assigned should be set out in this section. If the trade marks are in the process of being registered, the details and status of that registration should be included in this table.

This Agreement operates so that the Property specified in this section includes subsequent international applications claiming the earlier priority date of the assigned trade mark(s) under the Paris Convention.

4. Designs

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

Guidance Note for section 4 of Schedule 1: The details of all designs that are being assigned should be set out in this section. If the designs are in the process of being registered, the details and status of that registration should be included in this table.

This Agreement operates so that the Property specified in this section includes subsequent design applications and granted designs filed in other territories that take priority from the assigned design(s) under the Paris Convention.

5. Other Property

[insert any other relevant Property]

Guidance Note for section 5 of Schedule 1: This section can be used to detail any other form of IPR that is being assigned (for example, inventions not yet the subject of any patent application, plant breeder's rights, circuit layout rights, database rights and/or other materials). The parties should take care to provide the details of the Property, including any relevant registration and the status of any registration process commenced.

For guidance only

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.]

Guidance note for Schedule 2: This Schedule should only be used if the parties wish to agree a Fee structure that is different to the default arrangement where the Fee is paid as a single payment, by a specified date.

An example where this Schedule may be used is if the parties wish to agree to a Fee being paid in a series of instalments by certain dates/milestones.

The agreed Fee structure should be set out clearly, including details of the amounts of each payment, the dates by which each payment is due, and the point in time when the assignment under this Agreement comes into effect.

For guidance only

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

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

Signature of witness

Full name of witness

Guidance Note for execution: The default execution blocks provided require, in the case of both parties, that the Agreement be signed by an authorised representative and a witness.

However, the parties should amend these execution blocks if they are not appropriate for a party (for example, if a party is a company and prefers to sign the Agreement in accordance with section 127 of the *Corporations Act 2001* (Cth)) either by wet ink or electronically.

Each party is responsible for satisfying itself that the other party has validly signed the Agreement.

Once signed, there is no requirement to exchange physical versions of the Agreement with the other party and a PDF (of the whole signed document) could be exchanged if agreed by the parties.