

KTI Practical Guide

Assignment



Foreword

The KTI Practical Guides have been produced as a resource for those approaching transactions between Irish research performing organisations (RPOs)¹ and commercial companies. Each Practical Guide explains common terms in the agreements and describes the considerations that might apply.

The KTI Model Agreements contained in each Practical Guide take account of the legal constraints upon RPOs when entering into contracts, as well as the unique nature of RPOs, whose primary purpose is not-for-profit rather than commercial. At the same time, the terms of the agreements seek to address the typical commercial priorities of companies, e.g. to have access to intellectual property rights. The Guides are based on European best practice.

The Practical Guides are offered as a starting point for drafting and discussion, as required. Neither companies nor RPOs are mandated to use the Model Agree.

The KTI Practical Guides and Model Agreements are available on the KTI website to download and use direct. www.knowledgetransferireland.com

Disclaimer

Parties should take their own legal advice on the suitability of any model agreement for their individual circumstances and on associated legal and commercial issues. Neither Knowledge Transfer Ireland, Enterprise Ireland nor any of the individuals or organisations who have produced or commented on these documents assumes any legal responsibility or liability to any user of any of these model agreements or commentaries.

The KTI Practical Guides and Model Agreements were prepared by Anderson Law LLP (Oxford, UK; www.andlaw.eu) with advice on certain Irish law issues from LK Shields Solicitors (Dublin, Ireland; www.lkshields.ie).

¹ RPOs are considered to be Higher Education Institutes (Universities and Institutes of Technology) or State research organisations

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Introduction to IP Assignments

What is an IP assignment?

An IP assignment is a contract that transfers ownership of intellectual property from one person or organisation to another. It can be distinguished from an IP licence agreement in that, with an IP licence the owning party will grant the licensee a right under the IP (e.g. to manufacture certain products), but ownership of the IP right itself remains with the licensor.

Inherent with an IP assignment is a loss of control of the assets from the date of assignment as the new owner will usually be able to do what it likes with the IP, including transferring ownership to another party. An assignment also means that if a new owner breaches any of its obligations, this will not usually affect the new owner's ownership of (or right to use) the IP (although it could give rise to a claim for breach of contract or a claim of repudiation).

In contrast to the above, an IP licence agreement will typically contain detailed provisions as to what the licensee can and cannot do (which may include a prohibition on transferring the licence or sub-licensing to a third party). If the licensee fails to comply with its obligations under the licence, the licensor, in many cases, has the right to terminate the licence and therefore the licensee's right to use the particular IP will cease.

Why do RPOs enter into assignments?

There are a number of situations in which an RPO may wish to enter into an IP assignment, these include:

- the RPO may require staff working on a particular project to assign (or confirm the assignment of) IP to the RPO;
- the RPO may require third party collaborators to assign IP to it on completion of a project;
- the RPO may be asked to assign certain IP to a collaborating institution (which is perhaps taking the responsibility for maintaining IP arising from a research project);
- the RPO may be assigning the IP to a third party in exchange for a payment as part of its technology transfer activities;
- the RPO may be setting up a spin-out company and may have agreed that the spin-out company will be the owner of the IP; or
- the RPO may have decided that it is not going to pursue the exploitation of a particular technology and may therefore agree to assign ownership of such IP back to the generating academic(s).

Does the RPO need a written assignment?

As a matter of law, assignments of copyright, trademarks and design rights must be made in writing for them to be effective. In respect of patents and patent applications, although there is no statutory requirement for an assignment to be in writing, a written assignment is arguably always used, because an instrument must be produced to the Patents Office to achieve legal ownership (as opposed to beneficial ownership). This is due to the requirement that the assignment will need to be recorded on the Patent Register and the Patent Office will need to be satisfied that title has been transferred. It should be noted that many IP assignments may also involve the transfer of IP in jurisdictions other than Ireland and, in many other jurisdictions (including the UK) writing is a requirement for all IP assignments. Accordingly, best practice is to always use a written assignment.

In addition to the above, a written assignment also allows the parties to clearly define:

- what IP is being assigned;
- whether any other 'associated rights' are being assigned (e.g. the right to sue third parties for past infringements);
- when the assignment will take place;
- what price (or other consideration) is payable in exchange for the assignment and on what payment terms; and
- whether any warranties are given as to the IP being assigned.

What is a “confirmatory assignment”?

Confirmatory assignments are used in most instances to give assurances to a party that it owns all the necessary rights to a particular package of IP. For example, prior to the RPO assigning ownership of a copyright work to a company, that company may ask the RPO for a warranty, or even provide it with documentary proof, that it is the rightful owner of the copyright and that it is therefore able to transfer title. Ownership of IP produced in the course of employment (i.e. in the circumstances envisaged by the relevant statute for the IP in question) is typically dealt with in a supplemental manner in individuals’ contracts of employment, but it is often much easier to provide the potential assignee with copies of confirmatory assignments than it would be to show copies of individuals’ employment contracts.

It should be noted that it is standard practice in many RPOs to obtain confirmatory assignments as a matter of course. This is on the basis that, if the RPO were to wait until a third party requested evidence of the RPO’s ownership, it may be that some of the individuals who contributed to the creation of the work are no longer employed or contactable by the RPO. A Model Confirmatory Assignment accompanies this Practical Guide.

What additional formalities are required?

All assignments of registered intellectual property (i.e. patents, trade marks and registered design rights) must be registered with the appropriate IP register. For registered intellectual property in Ireland, the relevant registers are held by the Irish Patent Office². Where the IP assignment is transferring ownership of registered rights in multiple territories, applications to update the register will need to be filed in each such territory.

Failure to register an assignment within the defined limits in the particular territories can result in:

- a fine;
- a delay in bringing, or an inability to bring, an action for damages against third party infringers; and/or
- another party registering a separate interest in such IP which may take priority.

Accordingly, best practice is to register the assignment as soon as reasonably practicable.

Can confidential information or know-how be assigned?

Unlike what would be considered to be the ‘traditional’ IP rights (i.e. patents, copyright, trade marks and designs) which are created by statutes, ownership of confidential information is generally dealt with by a contract.

RPOs may sometimes be requested to enter into an assignment of confidential information or know-how. In such cases, what is typically being requested is an agreement under which the party who holds the information agrees:

- to supply the identified information to the other party;
- that it will no longer use the information itself;
- that it will not pass on the same information to any other party; and
- that it will transfer to the other party what rights it has to maintain the confidentiality of such information (which may include the novation/transfer of any existing confidentiality agreements).

For RPOs, any request to agree to the above is likely to cause difficulties, particularly in respect of the restriction on use and further dissemination of the information. As a general rule RPOs are reluctant to agree to anything that may impact on an individual academic’s or RPO’s ability to conduct research in a particular field and/or on their ability to publish.

Who should draft the assignment?

Assignments are generally not as detailed as, for example, a licence agreement, and so there is typically not the same battle between the parties as to whose form to use. Pro-forma assignments are

² <http://www.patentsoffice.ie/>

often encountered. For example, confirmatory assignments are likely to be a standard form with blank spaces that need to be filled in on a project-by-project basis. The Model Assignments that accompany this Practical Guide provide templates which the parties may wish to use.

What are the key terms in a typical IP assignment?

Most provisions encountered in assignments are fairly standardised, even if the precise wording used may differ. The areas that are subject to negotiation typically include one or more of the following:

- *Identify the IP.* It is crucial to clearly identify what IP is being assigned to the new owner and best practice is to clearly set this out in a schedule. Particular care should be taken with patents and whether the assignment also includes other patents (and applications) that derive priority from those identified (whether they have been filed at the date of assignment or not). In respect of copyright works, it is standard practice to identify the work by reference to its title and perhaps the date that it was created. For software, or other copyright works that are of substantial size, the parties may decide to identify the work by saving it to a CD or other media which is initialled for identification purposes. When dealing with software and other copyright works, care should be taken to exclude from the IP assignment any third party IP that may be incorporated into the work. In many cases the assignor will not have the right to transfer ownership of such third party IP to the assignee.
- *Scope of assignment.* The assignment clause is normally drafted using the phrase “A hereby assigns to B”. This is to indicate that the assignment is intended to take effect now and that it is not an agreement to assign something in the future. If the intent is for the assignment to take place on a particular date in the future, or on the occurrence of a particular event, this should be clearly set out in the assignment. In addition to assigning the IP, most IP assignments will include provisions that also give the new owner the right to sue third parties for past infringement.
- *Payment terms.* Due to the fact that an assignment is a one-off transaction, akin to a sale, it is typical for the assignee to pay a one-off lump sum to the assignor. As a general rule, for a contract to be effective there has to be consideration (i.e. something of value) passing both ways. In some cases, the one-off lump sum is only notional (normally €1). In the absence of any consideration passing from the assignee to the assignor, the assignment will need to be executed as a deed to be effective. Due to the more onerous signature requirements for some RPOs to execute a deed, it is often preferable to simply provide for a nominal consideration to be paid by the assignee.

Although most payments for an IP assignment will be a one-off lump sum, in some situations payments may be structured as multiple milestone payments or a royalty. Accepting milestone payments or an on-going royalty is something that is generally only considered in exceptional cases as difficulties for the RPO can arise where:

- The assignee goes into liquidation – it will typically be very difficult (and may not be possible at all) to recover the IP from the liquidator post-assignment, even though ‘payment in full’ has yet to be made; and
 - The assignee transfers the IP onwards to a third party – as the payment obligations are contractual, they will normally only be binding on the other party to the contract. The RPO can therefore find itself in a situation where the party who owns and is exploiting the IP is under no contractual obligation to the RPO in respect of making any milestone or royalty payments.
- *Assignment of IP.* It is important when entering into an assignment to understand the rights which are being assigned and any third party arrangements which might impact the assignee's freedom to use the assigned rights, such as licences to use some or all of those rights which were granted prior to the current assignment. A licence of this nature may need to be extinguished or a guarantee provided that its termination shall be procured by the assignor. Under Irish law, there is no wording which is accepted as implying that an assignment is free from a prior grant of rights, nor from any other type of encumbrance. Therefore, it is prudent for an assignee to seek to explicitly list the following as being captured in the assignment language:

- o the assignor assigns all “right, title and interest” in the IP;
- o the assignor has the right to assign the IP;
- o the assignor will do all it reasonably can, at its own cost, to give effect to the assignment;
- o the IP is being assigned is free from all charges and encumbrances, such as mortgages or other securities; and
- o the assignment is free from the benefit or burden of any licence or other right to use the IP.

The Model IP Assignment and other templates provided with this Practical Guide assume that the RPO will usually be the assignor and in that event, the RPO may opt to include or exclude (d) and (e) above, as applicable to the assignment in question.

- *Warranties.* A warranty is a contractual promise or statement, breach of which will entitle the other party to claim damages. As with any contract, care should be taken before giving any warranties to ensure that they are accurate and can be safely given. As with IP licences, it is unusual for RPOs to give anything more than very basic and fact-based warranties (if any at all) in an assignment.

As discussed elsewhere in these Practical Guides, where it is not possible to remove a warranty, it is sometimes possible to limit its scope. Common ways of doing so are by making the warranty knowledge-based or limiting its applicability. For example, if an assignee requests that the assignor provides a warranty that the assignor owns all IP rights in and to a particular piece of software, the assignor may consider giving a warranty that:

- o the RPO owns the copyright in the software but gives no warranties in respect of any patents that might subsist;
 - o the RPO has caused all of its employees who were involved in the creation of a particular piece of software to execute an assignment of the copyright in favour of the RPO; and/or
 - o to the knowledge of a particular named individual no third party rights subsist in the software.
- *Further assurances.* It is typical for the assignor to agree that it will do all such things, and execute all such documents, as are necessary to give effect to the assignment. This is more likely to be relevant for registered intellectual property where forms may need to be completed and/or signed for various national IP offices, but is also useful to have for unregistered intellectual property rights. When the assignment includes IP subsisting in territories other than Ireland, this provision gives the assignee the comfort that if there are additional requirements in a particular jurisdiction to complete the transfer, that the assignor will co-operate with this process. The only point that is usually an issue for negotiation is who bears the cost – i.e. is the assignor entitled to any compensation for the time it spends in carrying out such activities?
 - *Moral rights waivers.* It is common to find provisions in an IP assignment that state that the assignor warrants that it has obtained a moral rights waiver from all persons who created a particular work. Before looking at whether or not this should be accepted by an RPO, it is worth noting a few features of moral rights:
 - o Moral rights are only applicable in connection with copyright works;
 - o Moral rights give each individual author of a work the right to be identified as the author and the right to object to derogatory treatment of that work; and
 - o For moral rights to be waived, the waiver has to be in writing, identify the specific work and be signed by the relevant author.

Given the above, an RPO should only ever agree to give this warranty if it has actually obtained the necessary written waivers from the academics with the moral rights. More fundamentally, an RPO should always ask itself if it is appropriate for its academics to be giving up their right to be identified as the author of a particular work and also giving up their right to object to it being treated in a derogatory manner.

Issues to consider

The following is a list of some issues to consider when reviewing an IP assignment:

- *Templates.* Use of one of the Model Assignments that accompany this Practical Guide will speed up negotiations and allow an assignment to be concluded as swiftly as possible.
- *Parties.* Are the parties to the assignment clearly identified?
- *Diligence.* In cases where the RPO is assigning IP to a third party, has the RPO satisfied itself that it is the rightful owner of the IP and that it has the freedom to assign it? Have any licences been granted under the IP? If so, do they also need to be assigned together with the IP or do they need to be terminated?
- *Terms of the assignment:*
 - *Assignment wording.* Is it clear what is being assigned and when? What about future patent applications and the right to take action against past infringers?
 - *Payment terms.* Are the payment terms clear (amount, when and how) and is the price correct? If there is no payment, is other consideration being provided? If not, the assignment will need to be structured as a deed for it to be effective.
 - *Licence back.* Does the RPO want to consider including a licence back to the RPO so it can use the IP for future teaching / research purposes?
 - *Further assurances.* What obligations is the assignor under to execute further documents (e.g. to register the assignment with national IP offices etc.) and who bears the costs of this?
- *Administration.* The RPO will need to update its internal IP databases and, where appropriate, notify the various national registers (and possibly their patent and trademark attorneys to ensure no future fees are incurred).

Important points to note about the Model Assignments

The reader faced with drafting an assignment must always keep in mind that a template can only ever be a starting point. The specific circumstances of the particular arrangement must always be considered and the template tailored as appropriate. For example, a number of fact specific, complex issues may be raised when drafting an assignment, which by their nature cannot be dealt with in a template. Examples of these issues include the following:

- The Model Assignments have not been drafted to take account of any individual requirements of Irish RPOs which might apply. The reader is advised to seek out and address, by additional provisions, any peculiarities or requirements of a relevant institution.
- The Model Assignments have not been drafted with regard to any tax law, treatment or policy. It may be advisable to get specific tax advice in relation to any tax issue or treatment which might arise as a result of performing or implementing the assignment. Tax treatment will depend in part on the parties' circumstances at the time the assignment is executed and thereafter.
- The Model Assignments have not been drafted to be used by or in relation to consumers. Contracts concluded with consumers are obliged to include an additional layer of legal protections, to be written in plain-spoken language, and to contain other features imposed by consumer-specific laws which are beyond the scope of this Practical Guide.
- Where the Model Assignments are adapted to be used to govern the performance of obligations in a jurisdiction outside of the Republic of Ireland, the reader should note that their ability to enforce the rights and obligations of the assignment may be subject to the laws of that jurisdiction and that local legal advice may need to be sought.
- In addition, readers should be aware that in some situations the law relating to "state aid" might need to be considered (e.g. if the industrial party to the assignment does not pay market value for the benefits it receives). This is a complex area and there is no 'one-size-fits-all' way of dealing with it. Accordingly, the reader should seek specialist advice when required.

Checklist of preliminary issues and provisions commonly found in IP assignments

The checklist provided below lists (i) some preliminary points that may need consideration, and (ii) the main clauses usually found in an IP assignment together with the main issues that should be addressed regarding each provision.

Preliminary	
<i>Parties</i>	<ul style="list-style-type: none"> Are the parties to the assignment correctly described—have their full legal names and “official” addresses been included?
<i>Diligence</i>	<ul style="list-style-type: none"> In cases where the RPO is assigning IP to a third party, has the RPO satisfied itself that it is the sole and rightful owner of the IP and that it has the freedom to assign it? Have any licences or options been granted under the IP? If so, do they also need to be assigned together with the IP or do they need to be terminated?
<i>Authorised signatory</i>	<ul style="list-style-type: none"> Does the assignment need to be signed by a particular person or in a particular department both in the RPO and/or in the other party? If the assignment is to be signed by way of a deed, is it clear what signatories are required and whether either party is required to attach their corporate seal?
<i>Approvals, etc.</i>	<ul style="list-style-type: none"> Have various internal approvals/confirmations been obtained?
Contract terms	
<i>Date</i>	<ul style="list-style-type: none"> The date of the assignment is found at the top of each assignment template, just above the names of the parties; the date of the assignment is the date on which the last party executes the assignment and it is customary for this to be left blank initially and filled in by hand by the final party to sign.
Definitions	
<i>IP</i>	<ul style="list-style-type: none"> Does the IP to be assigned comprise of existing or future rights? Is the IP to be assigned clearly defined? In respect of registered IP rights, does the assignment also include applications? Is the IP being assigned limited to IP in particular territories?
Assignment	
	<ul style="list-style-type: none"> Does the assignment include the right to sue for past infringement? Does the RPO need a licence back from the assignee to permit the RPO to continue to use the assigned IP (perhaps limited to use for teaching / research purposes)?
Price and payment	
<i>Consideration</i>	<ul style="list-style-type: none"> Is the assignee paying for this assignment? Has an appropriate price calculation method been used to fix this price? If the assignee is not providing any consideration, note that the assignment will need to be structured as a deed to be effective. If payments are to be staggered, based on milestones or future royalties, are these clear and objectively defined. What steps has the RPO taken to protect itself against the assignee going insolvent or transferring the IP on

	to another third party without passing on the associated payment obligations?
Warranties	
<i>Warranties</i>	<ul style="list-style-type: none"> • What warranties is the RPO prepared to offer in regard to the IP being assigned (if any)? • Is the RPO willing to transfer the IP free from encumbrances and from the benefit or burden of any licence or other right to use the IP? • If the assignment is from a third party to the RPO, are there any warranties that the RPO requires from the third party?
Moral rights	
<i>Moral rights</i>	<ul style="list-style-type: none"> • Is a warranty as to having obtained a waiver of moral rights being requested? • If so, is it appropriate to ask the individual academics to waive such rights? • If the RPO does agree to give the warranty, have written waivers actually been obtained?
Boilerplate	
<i>Law and jurisdiction</i>	<ul style="list-style-type: none"> • Does the assignment state which law and jurisdiction should apply to the assignment? • If the law is not the law of the Republic of Ireland, why not and what are the consequences? • Does the chosen law and jurisdiction comply with the RPO's insurance policies and internal policies? • Are there provisions clarifying that questions of validity and subsistence determined by the relevant national courts?

Model IP Assignment



Dated _____ 20[●]

(1) [*Full legal name of the RPO*]

and

(2) [*Full legal name of the Assignee*]

MODEL IP ASSIGNMENT

IP ASSIGNMENT^{i ii iii iv}

This Assignment dated _____ 20[●]^v is between:

- (1) [●] (the “RPO”), [an academic institution incorporated or established under [statute or charter in Ireland],] whose [principal address or registered office] is at [●]^{vi}; and
- (2) [●] (the “Assignee”), [a company incorporated in [●] under registration number [●],]^{vii} whose [principal place of business or registered office] is at [●]^{viii}.

The RPO and the Assignee together shall be referred to as the “Parties”, and individually shall be referred to as a “Party”.

The Parties agree as follows:

1. Definitions

1.1 *Definitions.* In this Assignment, the following words shall have the following meanings:

Assigned Property	The Patents and other items of intellectual and physical property described in the attached Schedule.
Patents	The patents and patent applications identified in the Schedule[, and any future patents and patent applications which derive priority from any of those listed in the Schedule]. ^{ix}

2. Assignment

2.1 *Assignment.* In consideration of the sum of [●] Euro (€[●]) now paid by the Assignee to the RPO, receipt of which is acknowledged, the RPO hereby assigns and transfers to the Assignee absolutely all its right, title, and interest in and to the Assigned Property, which assignment and transfer is hereby accepted by the Assignee^x.

2.2 *Further details of assignment.* Without limiting the scope of Clause 2.1, the assignment effected by Clause 2.1 shall include the assignment and transfer to the Assignee of:

- (a) all patents and other intellectual property that may be granted pursuant to any applications listed in the Schedule[, as well as all patents and other intellectual property that may derive priority from or have equivalent claims to the Assigned Property in any country of the world (and including supplementary protection certificates, divisions, continuations, continuations in part, reissues, and extensions), and the Assigned Property shall be deemed to include all such items of property];^{xi}
- (b) the right to apply for, and obtain, any item of intellectual property referred to in Clause 2.2(a);
- (c) any unregistered intellectual property listed in the Schedule;
- (d) the entire right, title, and interest in and to the existing and/or future copyright and rights in the nature of copyright in the works listed in the Schedule throughout the world for the full term of the copyright in them and all renewals or extensions of such rights;
- (e) [all rights in respect of any know-how that is listed in the Schedule]^{xii}];
- (f) all rights of ownership of any materials that are listed in the Schedule; and
- (g) all rights of action, powers, and benefits arising from ownership of the Assigned Property, including the right to sue for damages and other legal and equitable remedies in respect of all causes of action arising before, on, or after the date of this Assignment.

- 2.3 *Further assurances.*^{xiii} The RPO shall execute such documents and give such assistance as the Assignee may reasonably require at the Assignee's expense:
- (a) to secure the vesting in the Assignee of all rights in the Assigned Property;
 - (b) to uphold the Assignee's rights in the Assigned Property;
 - (c) to defeat any challenge to the validity of, and resolve any questions concerning, the Assigned Property; and
 - (d) to enable the Assignee or its nominee to enjoy the full benefit of the property and rights assigned in this Assignment and to enjoy the exclusive benefit of any extension or further grant of patents vested in the Assignee by virtue of this Assignment.
- 2.4 *Further work.* For the avoidance of doubt, nothing in this Assignment shall require the RPO to do any further development, investigation, or other work in respect of or in relation to the Assigned Property.
- 2.5 [*Registration.* The Assignee is entitled to notify, on the RPO's behalf, the assignment provided for by this Clause 2, to the relevant IP registers. The costs of making such notifications will be borne by the Assignee.]^{xiv}

3. Warranties

- 3.1 [*Disclosure.* The RPO warrants that, as far as it is aware, it has disclosed to the Assignee in writing the names of all of the RPO's staff and students who were involved in developing the Assigned Property. For the purposes of the preceding sentence, the RPO's awareness means the awareness of its technology transfer manager (or equivalent) responsible for the Assigned Property.]^{xv}
- 3.2 *Acknowledgements.* The Assignee acknowledges that the RPO:
- (a) does not warrant or guarantee the validity of any of the Assigned Property or that the Assigned Property does not infringe any valid and subsisting patent or other rights not held by it; and
 - (b) has not performed any searches or investigations into the existence of any third-party rights that may affect any of the Assigned Property.

4. General

- 4.1 *Interpretation.* Except where otherwise stated:
- (a) any reference in this Assignment to a Clause or a Schedule is to a clause of or a schedule to this Assignment;
 - (b) the provisions of the Schedule shall form part of this Assignment as if set out here;
 - (c) the headings in this document are inserted for convenience only and shall not affect the construction or interpretation of this Assignment; and
 - (d) where the word "including" is used in this Assignment, it shall be understood as meaning "including without limitation".
- 4.2 *Governing law and jurisdiction.* The validity, construction, and performance of this Assignment shall be governed by the laws of the Republic of Ireland and shall be subject to the exclusive jurisdiction of the courts of the Republic of Ireland to which the Parties submit. Notwithstanding the preceding sentence, any question concerning the validity of any intellectual property right shall be subject to the law and jurisdiction of the country in which such intellectual property right exists.^{xvi}

Agreed by the Parties through their authorised signatories:

For and on behalf of
[Insert full legal name of the RPO]

For and on behalf of
[Insert full legal name of the Assignee]

Signed

Signed

Name

Name

Title

Title

Date

Date



Schedule

Assigned Property

[1 *Patents and patent applications*]

Title	Inventor	Application Number	Date Filed	Publication Number	Date Granted

[2 *Copyright works, design rights, database rights, etc.*]

[3 *Know-how*]

[4 *Materials*]

Drafting Notes

ⁱ This is a template Model IP Assignment for the general assignment of intellectual property; where only patents and/or patent applications are being assigned, the Model Patent Assignment template should be used as the starting point instead. For further details about IP assignments, the user should consult the accompanying Practical Guide entitled "Introduction to IP Assignments".

The user should note that this template is drafted on the assumption that the RPO is assigning intellectual property to a third party. If the RPO wishes to use this template for an assignment from a third party to the RPO, the RPO may want to consider if it wants the assignor to give any warranties as to the intellectual property that is being assigned. For example, in these circumstances, the reader should consider whether clause 2.1 should be amended as shown below:

"Assignment. In consideration of the sum of [●] Euro (€[●]) now paid by the RPO to the Assignor (receipt of which is acknowledged), the Assignor hereby assigns and transfers to the RPO all its right, title, and interest in and to the Assigned Property, free from any encumbrance/free from the benefit or burden of any licence or other right to use, which assignment and transfer is hereby accepted by the RPO."

ⁱⁱ Users of this Model IP Assignment should be aware that in some situations the law relating to "state aid" might need to be considered (e.g. if the industrial party to the assignment does not pay market value for the benefits it receives). This is a complex area and there is no 'one-size-fits-all' way of dealing with it. Accordingly, the user should seek specialist advice when required.

ⁱⁱⁱ Users of this document should note that the authors have not drafted it to take account of the individual requirements of Irish RPOs which might apply. Users are advised to seek out and address, by additional provisions, any peculiarities or requirements of a relevant institution.

^{iv} Users of this document are advised that the authors have not drafted it to be used by or in relation to consumers. Contracts concluded with consumers are obliged to include an additional layer of legal protections, to be written in plain-spoken language and to contain other features imposed by consumer-specific laws which are not dealt with in this template assignment.

^v This should be the date on which the last party signs the assignment – it is often left blank and inserted by hand by the last party to sign.

^{vi} Insert the full name of the RPO, the statute or charter under which it was incorporated or established, and its registered/principal address. Individual RPOs will have their own legal formalities which will need to be completed to bind the RPO.

^{vii} Note that the assignee may be a company, another RPO, or some other type of entity. This wording should be adapted for the particular type of entity to whom the IP is to be assigned. For example, for a university, this might read "a university incorporated by statute".

^{viii} Insert the full name of the party to whom IP is to be assigned, its registered number (or equivalent), and its registered/principal address.

^{ix} Optional wording to be used where the RPO wishes to assign the entire patent family in all territories (which may include patent applications that have not yet been filed at the date of this assignment that derive priority from the patents listed in the Schedule).

^x Users of this Model IP Assignment Agreement are advised that it has not been prepared with regard to any tax law, treatment or policy, and that it may be advisable to get specific tax advice in relation to any tax issue or treatment which might arise as a result of performing or implementing this assignment. Tax treatment will depend in part on the parties' circumstances at the time the assignment is executed and thereafter.

^{xi} Optional wording to be used where the RPO wishes to assign the entire patent family in all territories (which may include patent applications that have not yet been filed at the date of this assignment that derive priority from the patents listed in the Schedule).

^{xii} Know-how is referred to here for completeness, but please note that the national IP Protocol states that know-how should usually only be licensed on a non-exclusive basis (and by implication should not be assigned).

^{xiii} This gives the assignee comfort that if, for example, particular forms need to be filed at national patent offices, then the RPO will complete these as and when required.

^{xiv} This gives the assignee the authority to file the relevant forms with the relevant patent offices, provided this is permitted by the relevant patent office. This is often a sensible provision to include as it is often the assignee, as the new owner of the IP, that is incentivised to register the assignment promptly.

^{xv} This is a very limited warranty, but the RPO should consider whether it is able to give this at all.

^{xvi} This is an additional qualification that is not contained in the law and jurisdiction clauses in other Model Agreements (that accompany other Practical Guides in this series). As a general rule, matters such as validity and subsistence of intellectual property are handled on a territory by territory basis by the national courts – i.e. the Irish courts will have no jurisdiction to declare a UK patent to be invalid for example.

Model Patent Assignment



Dated _____ 20[•]

(3) [*Full legal name of the RPO*]

and

(4) [*Full legal name of the Assignee*]

MODEL PATENT ASSIGNMENT

PATENT ASSIGNMENT^{i ii iii iv}

This Assignment dated _____ 20[●]^v is between:

- (1) [●] (the “RPO”), [an academic institution incorporated or established under [statute or charter in Ireland],] whose [principal address or registered office] is at [●]^{vi}; and
- (2) [●] (the “Assignee”), [a company incorporated in [●] under registration number [●],]^{vii} whose [principal place of business or registered office] is at [●]^{viii}.

The RPO and the Assignee together shall be referred to as the “Parties”, and individually shall be referred to as a “Party”.

The Parties agree as follows:

1. Definitions

1.1 *Definitions.* In this Assignment, the following word shall have the following meaning:

Patents All patents and patent applications identified in the attached Schedule[, and any future patents and patent applications which derive priority from or share a right of priority with any such patents and/or patent applications]^{ix}.

2. Assignment

2.1 *Assignment.* In consideration of the sum of [●] Euro (€[●])^x now paid by the Assignee to the RPO (receipt of which is acknowledged), the RPO hereby assigns and transfers to the Assignee all its right, title, and interest in and to the Patents, which assignment and transfer is hereby accepted by the Assignee^{xi}.

2.2 *Further details of the assignment.* Without limiting the scope of Clause 2.1, the assignment effected by Clause 2.1 shall include the assignment and transfer to the Assignee of:

- (a) all patents listed, and all patents that may be granted pursuant to any applications listed, in the attached Schedule[, as well as all patents that may derive priority from or share a right of priority with any of the Patents in any country of the world (and including all divisions, continuations, continuations in part, reissues and extensions), and the Patents shall be deemed to include all such items of intellectual property]^{xii};
- (b) the right to apply for, and obtain, any item of intellectual property referred to in Clause 2.2(a); and
- (c) all rights of action, powers, and benefits arising from ownership of the Patents, including the right to sue for damages and other legal and equitable remedies in respect of all causes of action arising before, on or after the date of this Assignment.^{xiii}

2.3 *Further assurances.* The RPO shall: (a) execute, acknowledge, and deliver such further documents; and (b) give such assistance as the Assignee may reasonably require at the Assignee’s reasonable expense to secure the vesting in the Assignee of all rights in the Patents.^{xiv}

2.4 *Further work.* For the avoidance of doubt, nothing in this Assignment shall require the RPO to do any further development, investigation, or other work in respect of or in relation to the inventions described in the Patents.

2.5 *[Registration.* The Assignee shall be entitled to notify and/or register on the RPO’s behalf the assignment under Clause 2.1 to the relevant patent offices, the costs of which shall be borne by the Assignee.]^{xv}

3. General

- 3.1 *Interpretation.* In this Assignment: (a) any reference in this Assignment to a Clause or a Schedule is to a clause of or a schedule to this Assignment; (b) the provisions of the Schedule shall form part of this Assignment as if set out here; (c) the headings in this document are inserted for convenience only and shall not affect the construction or interpretation of this Assignment; and (d) where the word “including” is used in this Assignment, it shall be understood as meaning including without limitation.
- 3.2 *Governing law and jurisdiction.* The validity, construction, and performance of this Assignment shall be governed by the laws of the Republic of Ireland and shall be subject to the exclusive jurisdiction of the courts of the Republic of Ireland to which the Parties submit. Notwithstanding the preceding sentence, any question concerning the validity of any intellectual property right shall be subject to the law and jurisdiction of the country in which such intellectual property right exists.^{xvi}

Agreed by the Parties through their authorised signatories:

For and on behalf of
[Insert full legal name of the RPO]

For and on behalf of
[Insert full legal name of the Assignee]

Signed

Signed

Print name

Print name

Title

Title

Date

Date

Schedule

The Patents

Patent applications

Country	Application Number	Publication Number	Title	Date filed

Granted patents

Country	Application Number	Publication or Registration Number	Title	Date filed

Drafting Notes

ⁱ This is a template Model Patent Assignment for use where the only intellectual property being assigned is patents and/or patent applications. If the intellectual property portfolio includes other types of intellectual property, the Model IP Assignment template should be used as the starting point instead. For further details about IP assignments, the user should consult the accompanying Practical Guide entitled "Introduction to IP Assignments".

The user should note that this template is drafted on the assumption that the RPO is assigning patents and/or patent applications to a third party. If the RPO wishes to use this template for an assignment from a third party to the RPO, the RPO may want to consider if it wants the assignor to give any warranties as to the patents and/or patent applications that are being assigned. For example, in these circumstances, the user should consider whether clause 2.1 should be amended as shown below:

"Assignment. In consideration of the sum of [●] Euro (€[●]) now paid by the RPO to the Assignor (receipt of which is acknowledged), the Assignor hereby assigns and transfers to the RPO all its right, title, and interest in and to the Patents, free from any encumbrance/free from the benefit or burden of any licence or other right to use, which assignment and transfer is hereby accepted by the RPO."

ⁱⁱ Users of this Model Patent Assignment should be aware that in some situations the law relating to "state aid" might need to be considered (e.g. if the industrial party to the assignment does not pay market value for the benefits it receives). This is a complex area and there is no 'one-size-fits-all' way of dealing with it. Accordingly, the user should seek specialist advice when required.

ⁱⁱⁱ Users of this document should note that the authors have not drafted it to take account of the individual requirements of Irish RPOs which might apply. Users are advised to seek out and address, by additional provisions, any peculiarities or requirements of a relevant institution.

^{iv} Users of this document are advised that the authors have not drafted it to be used by or in relation to consumers. Contracts concluded with consumers are obliged to include an additional layer of legal protections, to be written in plain-spoken language and to contain other features imposed by consumer-specific laws which are not dealt with in this template agreement.

^v This should be the date on which the last party signs the assignment – it is often left blank and inserted by hand by the last party to sign.

^{vi} Insert the full name of the RPO, the statute or charter under which it was incorporated or established, and its registered/principal address. Individual RPOs will have their own legal formalities which will need to be completed to bind the RPO.

^{vii} Note that the assignee may be a company, another RPO, or some other type of entity. This wording should be adapted for the particular type of entity to whom the patents are to be assigned. For example, for a university, this might read "a university incorporated by statute".

^{viii} Insert the full name of the party to whom IP is to be assigned, its registered number (or equivalent), and its registered/principal address.

^{ix} Optional wording to be used where the RPO wishes to assign the entire patent family in all territories (which will therefore include patent applications that have not yet been filed at the date of this assignment that derive priority from the patents listed in the Schedule).

^x Note that if consideration is not present, this assignment should be amended so that it is structured and executed as a deed to ensure it is effective.

^{xi} Users of this Model Patent Assignment are advised that it has not been prepared with regard to any tax law, treatment or policy, and that it may be advisable to get specific tax advice in relation to any tax issue or treatment which might arise as a result of performing or implementing this assignment. Tax treatment will depend in part on the parties' circumstances at the time the assignment is executed and thereafter.

^{xii} Optional wording to be used where the RPO wishes to assign the entire patent family in all territories (which will therefore include patent applications that have not yet been filed at the date of this assignment that derive priority from the patents listed in the Schedule).

^{xiii} In the absence of this provision, the assignee will only be able to sue for, and claim damages in respect of, infringements by third parties that occur on and/or after the date of assignment.

^{xiv} This gives the assignee comfort that if, for example, particular forms need to be filed at national patent offices, then the RPO will complete these as and when required.

^{xv} This gives the assignee the authority to file the relevant forms with the relevant patent offices, provided this is permitted by the relevant patent office. This is often a sensible provision to include as it is often the assignee, as the new owner of the IP, that is incentivised to register the assignment promptly.

^{xvi} This is an additional qualification that is not contained in the law and jurisdiction clauses in other model agreements (that accompany other Practical Guides in this series). As a general rule, matters such as validity and subsistence of intellectual property are handled on a territory by territory basis by the national courts – i.e. the Irish courts will have no jurisdiction to declare a UK patent to be invalid for example.

Model Confirmatory Assignment

Dated _____ 20[●]

(5) [*Full name of the Researcher*]

and

(6) [*Full legal name of the RPO*]

MODEL CONFIRMATORY ASSIGNMENT

CONFIRMATORY ASSIGNMENT^{i ii iii}

This Assignment dated _____ 20[●]^{iv} is between:

- (1) [●] (the “**Researcher**”), an individual, whose home address is at [●]^v; and
- (2) [●] (the “**RPO**”), [an academic institution incorporated or established under [statute or charter in Ireland],] whose [principal address or registered office] is at [●]^{vi}.

The RPO and the Researcher together shall be referred to as the “**Parties**”, and individually shall be referred to as a “**Party**”.

BACKGROUND

- A. The Researcher is [an employee of] OR [enrolled as a student at] the RPO and has developed certain [technology, inventions, and know-how]^{vii} relating to [insert a brief description of the IP to be assigned] (together, the “**Technology**”).
- B. The Researcher is willing to assign and transfer all his/her right, title and interest in and to such Technology to the RPO, and the RPO is willing to accept such assignment and transfer, all in accordance with the provisions of this Assignment.

The Parties agree as follows:

1. Definitions

1.1 *Definitions.* In this Assignment, the following words shall have the following meanings:

Assigned Property [All [Patents,] know-how, inventions, and other items of intellectual and physical property described in the attached Schedule]^{viii}.

[Patents] [The patent(s) and patent application(s) identified in the Schedule[, and any future patents and patent applications which are based upon or derive priority from those listed in the Schedule.]]^{ix, x}

2. Assignment

2.1 *Assignment.* In consideration of the sum of [●] Euro (€[●])^{xi} now paid by the RPO to the Researcher, receipt of which is acknowledged by the Researcher, the Researcher hereby assigns and transfers to the RPO absolutely all his/her right, title, and interest in and to the Assigned Property [free from any encumbrance and free from the benefit or burden of any licence or other right to use]^{xii}, which assignment and transfer is hereby accepted by the RPO^{xiii}.

2.2 *Further details of assignment.* Without limiting the scope of Clause 2.1, the assignment effected by Clause 2.1 shall include the assignment and transfer to the RPO of:

- (a) all patents and other intellectual property that may be granted pursuant to any applications listed in the Schedule, [as well as all patents and other intellectual property that may derive priority from or have equivalent claims to or be based upon the Assigned Property in any country of the world (and including supplementary protection certificates, divisions, continuations, continuations in part, reissues, and extensions), and the Assigned Property shall be deemed to include all such items of property];^{xiv}

- (b) the right to apply for, and obtain, any item of intellectual property referred to in Clause 2.2(a);
- (c) any unregistered intellectual property listed in the Schedule;
- (d) the entire right, title, and interest in and to the existing and/or future copyright, and rights in the nature of copyright, in the works listed in the Schedule throughout the world for the full term of the copyright in them and all renewals and extensions of such rights;
- (e) all rights in respect of any know-how that is listed in the Schedule;
- (f) all rights of ownership of any materials that are listed in the Schedule; and
- (g) all rights of action, powers, and benefits arising from ownership of the Assigned Property, including the right to sue for damages and other legal and equitable remedies in respect of all causes of action arising before, on, or after the date of this Assignment.

2.3 *Further assurances.*^{xv} The Researcher agrees to execute all such documents and give all such assistance as the RPO may reasonably require, at the RPO's reasonable expense, including:

- (a) to secure the vesting in the RPO of all rights in the Assigned Property;
- (b) to uphold the RPO's (or any successor in title's) rights in the Assigned Property;
- (c) to defeat any challenge to the validity of, and resolve any questions concerning, the Assigned Property;
- (d) to enable the RPO or its nominee to enjoy (i) the full benefit of the property and rights assigned in this Assignment, and (ii) the exclusive benefit of any extension or further grant of patents vested in the RPO by virtue of this Assignment; and
- (e) to apply for, and endeavour to assist in the obtaining of, patents and/or similar protection for the Assigned Property and any improvements of it in any country of the world.

2.4 *Registration.* The RPO is entitled to notify, on the Researcher's behalf, the assignment provided for by this Clause 0, to the relevant IP registers. The costs of making such notifications will be borne by the RPO.^{xvi}

3. Warranties

3.1 *Disclosure.* The Researcher warrants that he/she has disclosed to the RPO in writing the names of all persons of whom he/she is aware who might have rights in the Assigned Property, including any other persons who were involved in developing the Assigned Property, and any organisations that funded the development of the Assigned Property.

3.2 *Acknowledgements.* The RPO acknowledges that the Researcher:

- (a) does not warrant or guarantee the validity of any of the Assigned Property or that the Assigned Property does not infringe any valid and subsisting patent or other rights held by any third party; and
- (b) has not performed any searches or investigations into the existence of any third-party rights that may affect any of the Assigned Property.

4. General

4.1 Interpretation.

- (a) Except where otherwise stated:
- (i) any reference in this Assignment to a Clause or a Schedule is to a clause of or a schedule to this Assignment;
 - (ii) the provisions of the Schedule shall form part of this Assignment as if set out here;
 - (iii) the headings in this document are inserted for convenience only and shall not affect the construction or interpretation of this Assignment; and
 - (iv) where the word “including” is used in this Assignment, it shall be understood as meaning “including without limitation”.
- (b) This Assignment is without prejudice to any ownership rights that the RPO may have in the Assigned Property by virtue of any employment or other contract with the Researcher.

4.2 *No time limit.* The obligations under this Assignment shall continue in force without limit of time.

4.3 *Governing law and jurisdiction.* The validity, construction, and performance of this Assignment shall be governed by the laws of the Republic of Ireland and shall be subject to the exclusive jurisdiction of the courts of the Republic of Ireland to which the Parties submit. Notwithstanding the preceding sentence, any question concerning the validity of any intellectual property right shall be subject to the law and jurisdiction of the country in which such intellectual property right exists.^{xvii}

Agreed by the Parties through their authorised signatories:

By
[Insert full name of Researcher]

For and on behalf of
[Insert full legal name of the RPO]

Signed

Signed

Name

Name

Title

Title

Date

Date

Schedule

Assigned Property

[1 *Patents and patent applications*]

Title	Inventor	Application Number	Date Filed	Publication Number	Date Granted

[2 *Copyright works, design rights, database rights, etc.*]

[3 *Know-how*]

[4 *Materials*]

Drafting Notes

ⁱ This is a template Model Confirmatory Assignment for the assignment (or for the confirmation of the assignment of) intellectual property from an academic or a student to an RPO. Confirmatory assignments are typically used to give the RPO assurance that it has the necessary rights to licence and/or assign certain intellectual property and also act as a convenient way for the RPO to demonstrate title to third parties. For further details about IP assignments, the user should consult the accompanying Practical Guide entitled "Introduction to IP Assignments".

ⁱⁱ Users of this document should note that the authors have not drafted it to take account of the individual requirements of Irish RPOs which might apply. Users are advised to seek out and address, by additional provisions, any peculiarities or requirements of a relevant institution.

ⁱⁱⁱ Users of this document are advised that the authors have not drafted it to be used by or in relation to consumers. Contracts concluded with consumers are obliged to include an additional layer of legal protections, to be written in plain-spoken language and to contain other features imposed by consumer-specific laws which are not dealt with in this template assignment.

^{iv} This should be the date on which the last party signs the assignment – it is often left blank and inserted by hand by the last party to sign.

^v The home address of the researcher should be used here.

^{vi} Insert the full name of the RPO, the statute or charter under which it was incorporated or established, and its registered/principal address. Individual RPOs will have their own legal formalities which will need to be completed to bind the RPO.

^{vii} Amend this wording according to the types of IP to be assigned.

^{viii} This wording should be tailored according to what IP is to be assigned.

^{ix} This is optional wording to be used where the RPO wishes to take assignment of the entire patent family in all territories (which may include patent applications that have not yet been filed at the date of this assignment that derive priority from the patents listed in the schedule).

^x This wording should be deleted if no patents or patent applications are to form part of the assignment.

^{xi} The inclusion of a nominal sum (usually 1 Euro) is included to satisfy the requirement that consideration (i.e. something of value) is passing both ways in this transaction. In certain cases, and depending on the RPO's IP policy, this consideration may be satisfied by way of an obligation to pay certain royalties to the researcher under a separate royalty sharing agreement to be executed at the same time as the assignment. Note that if consideration is not present, this assignment should be amended so that it is structured and executed as a deed to ensure it is effective.

^{xii} The RPO should consider whether it wants the researcher to give these additional assurances about the IP to be assigned. If so, the square brackets around this wording should be deleted.

^{xiii} Users of this Model Confirmatory Assignment are advised that it has not been prepared with regard to any tax law, treatment or policy, and that it may be advisable to get specific tax advice in relation to any tax issue or treatment which might arise as a result of performing or implementing this assignment. Tax treatment will depend in part on the parties' circumstances at the time of execution of the assignment and thereafter.

^{xiv} This is optional wording to be used where the RPO wishes to take assignment of the entire patent family in all territories (which may include patent applications that have not yet been filed at the date of this assignment that derive priority from the patents listed in the schedule).

^{xv} This gives the RPO comfort that if, for example, particular forms need to be filed at national patent offices, then the researcher will complete these as and when required.

^{xvi} This gives the RPO the authority to file the relevant forms with the relevant patent offices, provided this is permitted by the relevant patent office. This is often a sensible provision to include as it is likely to be the RPO that is incentivised to register the assignment promptly.

^{xvii} This is an additional qualification that is not contained in the law and jurisdiction clauses in other Model Agreements (that accompany the other Practical Guides in this series). As a general rule, matters such as validity and subsistence of intellectual property are handled on a territory by territory basis by the national courts – for example, the Irish courts will have no jurisdiction to declare a UK patent to be invalid.

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