



TRADE MARK LICENCE AGREEMENT

DATED THE ___ DAY OF _____ 20__

BETWEEN

Company Pty Ltd ACN 111 222 333

AND

Other Company Pty Ltd ACN 333 222 111

TRADE MARKS LICENCE AGREEMENT

THIS AGREEMENT dated the _____ day of _____ 20__.

BETWEEN: Company Pty Ltd ACN 111 222 333 having its registered office at 1 Sydney Street Sydney 2000 (the “Licensor”);

AND: Other Company Pty Ltd ACN 333 222 111 having its registered office at 1 Brisbane Street Brisbane 7000 (the “Licensee”).

BACKGROUND:

- A. The Licensor is the registered owner of the Trade Marks in Australia
- B. The Licensee wishes to use the Trade Marks in relation to the Goods/Services and may wish to record its interest as an authorised user under the *Trade Marks Act 1995* (Cth).
- C. The Licensor has agreed to grant the licence and the Licensee accepts the licence on the following terms and conditions.

THE PARTIES AGREE:

1. LICENCE

- 1.1. The Licensor grants an exclusive, revocable licence to the Licensee to reproduce the Trade Marks for the Term in the Territory in relation to the Goods/Services.
- 1.2. (Authorised User) The parties agree to execute all documents necessary and do all acts required to record the Licensee on the Register as an authorised user. As an authorised user, the Licensee will not have the right to exercise the powers conferred by subsections 26(1)(e) and (f) of the *Trade Marks Act 1995* (Cth). The Licensee undertakes not to apply to cancel or vary its recordal on the Register as an authorised user without the prior written consent of the Licensor.
- 1.3. The Licensee may assign the Licence only with the prior written consent of the Licensor.
- 1.4. The Licensee may sub-license the Licence only with the prior written consent of the Licensor.

2. TERM OF LICENCE

- 2.1. The parties agree that the Licence is for a period of Three (3) years (the “Term”) from the Commencement Date unless terminated by either party pursuant to this Agreement./OR

Initial: _____

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2.2. The parties agree that the Licence is valid to 31 December (the “Term”) unless terminated by either party pursuant to this Agreement.

3. LICENCE FEE/ROYALTY

3.1. In consideration for the Licence, the Licensee will pay the Licensor the fee or royalty set out in Part E of the Schedule.

3.2. The Licensee is not obliged to pay any fee or royalty due unless it has received a Tax Invoice from the Licensor.

3.3. The Licensor is responsible for paying any government tax, duty or impost relating to the grant of this Licence including any fee to record the Licence.

4. INTELLECTUAL PROPERTY & TITLE

4.1. All Intellectual Property Rights in and to the Trade Marks remains vested in the Licensor.

4.2. The Licensee acknowledges the Licensor’s title to the Trade Marks. The Licensee undertakes:

- (a) not to take any action which would or might invalidate or put in dispute the Licensor’s title;
- (b) not to oppose any application for registration of the Trade Marks;
- (c) not to make any application for removal of a Trade Mark.

4.3. The Licensor also undertakes not to assist any third party directly or indirectly in any of the activities set out in Clause 4.2.

5. CONFIDENTIAL INFORMATION

5.1. Each party undertakes not to use or disclose to any other person or entity any of the other party’s Confidential Information including any manufacturing know-how and will only use such Confidential Information in good faith and for the proper purposes of this Agreement and subject to any restrictions imposed by the party that provides the Confidential Information. This is an essential clause which survives the end or termination of this Agreement.

5.2. Notwithstanding Clause 5.1, a party may disclose information if and to the extent that such disclosure is required by law or court order.

6. QUALITY CONTROL REQUIREMENTS

6.1. The Licensee must ensure that it will at all times strictly comply with all directions, instructions, requirements, samples and specifications given by the Licensor in respect of the use of the Trade Marks and the standard of quality, manufacture, packaging and advertising of the Goods/Services.

6.2. The Licensee will permit the Licensor at reasonable times and on reasonable notice to carry out inspections at the Licensee's premises for the purpose of verifying the Licensee's compliance with Clause 6.1.

6.3. Should the Licensee fail to meet a quality level pursuant to Clause 6.1, the Licensor reserves the right to terminate the Agreement and the Licensor will be entitled to all remedies available for breach of this Agreement.

7. RECORDS – MAINTENANCE & INSPECTION

7.1. For a period of seven (7) years starting on the Commencement Date, the Licensee must keep and maintain separate and accurate records including accounts of the production and sale of the Goods/Services.

7.2. The Licensee will permit the Licensor or its accountant access at reasonable times and on reasonable notice to inspect and make copies of the Licensee's books and accounting records for the purpose of verifying the Licensee's compliance with its obligations with Clause 7.1.

8. LICENSOR REPRESENTATIONS & WARRANTIES

8.1. The Licensor represents and warrants that it has the right to license the Trade Mark to the Licensee.

8.2. The Licensor agrees that during the Term it will maintain in force and renew registration of the Trade Marks, subject to Notice under Clause 9.2. If the Trade Marks are not yet registered, the Licensor will do everything reasonably necessary to obtain registration during the Term.

8.3. The Licensee's use of the Trade Marks in relation to the Goods/Services will not infringe the rights including Intellectual Property Rights and/or moral rights of any third party.

9. LICENSEE OBLIGATIONS, WARRANTIES & ACKNOWLEDGEMENTS

9.1. The Licensee may only use the Trade Mark during the Term in relation to the Goods/Services. This is an essential term which survives the end or termination of this Agreement.

9.2. The Licensee will immediately inform the Licensor by Notice if at any time during the Term it decides to no longer use any one of the Trade Marks on or in relation to the Goods/Services so that the Licensor may take whatever steps are necessary to ensure that a Trade Mark does not become vulnerable for removal from the Register for non-use.

- 9.3. The Licensee will ensure that all use of the Trade Marks will bear whatever proprietary statement is required by the Licensor from time to time including the trade mark symbol “®” if applicable or “™”.
- 9.4. The Licensee is not permitted to sell, charge, mortgage or otherwise encumber the Trade Marks in any way.
- 9.5. The Licensee undertakes and agrees that it will not at any time during the Term register or apply for registration of a trade mark any sign, word or logo that is substantially identical with or deceptively similar to any of the Trade Marks.
- 9.6. The Licensee is not permitted to claim or hold itself out, engage in any conduct or make any representation the effect of which would suggest that it is the agent of the Licensor.
- 9.7. During the Term, the Licensee undertakes to promptly advise the Licensor of any legal proceedings, threat of legal proceedings or claim which may involve the Trade Marks or any one of them including any allegation of infringement, passing off or misleading and deceptive conduct under the *Trade Practices Act 1974* (Cth) or corresponding State fair trading legislation.
- 9.8. In the event of a matter arising as contemplated in Clause 9.7, if requested by the Licensor the Licensee undertakes to keep the Licensor fully informed of the progress of any such proceeding or claim. In relation to any proposed settlement of such proceeding or claim, the Licensee must take into account and adhere to the views of the Licensor.
- 9.9. In the event of a matter arising as contemplated in Clause 9.7, at the Licensor’s request the Licensee will provide the Licensor with copies of any and all documents and materials including legal advice relating to such proceeding or claim.
- 9.10. The Licensee warrants that it has not relied upon any representation made by the Licensor other than as set out in this Agreement.

10. LIMITATION OF LIABILITY

- 10.1. To the fullest extent permitted by law, the Licensor excludes all liability for indirect or consequential loss including loss of revenue, loss of profits, failure to realise expected profits or savings and any other commercial or economic loss of any kind arising from this Agreement.

11. INDEMNITY

- 11.1. The Licensor indemnifies and holds harmless the Licensee from and against any loss, liability, cost or expense that the Licensee suffers directly or indirectly because of an Intellectual Property Rights and/or moral rights claim in any of the Trade Marks.
- 11.2. The Licensee indemnifies and holds harmless the Licensor and promises to keep the Licensor indemnified against any loss, claim, action, settlement, award, judgment, expense or damage of whatsoever kind or nature and howsoever arising that the Licensor might suffer as a result of any use of the Trade Marks including any unauthorised use of the Trade Marks by the Licensee.

12. TERMINATION

- 12.1. Either party may terminate this Agreement immediately by Notice if:
- (a) the other party breaches a term of this Agreement and fails to remedy such breach within 21 days of being notified of such breach;
 - (b) the other party becomes subject to external administration or being a natural person becomes bankrupt or dies;
 - (c) the Licensee (if a partnership) dissolves or enters a process of dissolution or (if a corporation) undergoes a Change of Control event; or
 - (d) the Licensee ceases or notifies of its intention to cease trading as a business.
- 12.2. Either party may serve 2 weeks Notice of termination on the other party without in any way affecting rights accrued under this Agreement.
- 12.3. The Licensor may terminate this Agreement immediately if for any reason the Licensee ceases to provide the Goods/Services.
- 12.4. Following termination, the parties agree that the provisions in Clause 10 (Limitation of Liability) will continue to be binding.
- 12.5. Upon termination, the Licensee will immediately cease using the Trade Marks and/or any sign, word or logo that is substantially identical with or deceptively similar to the Trade Marks or any part of them and must remove the Trade Marks from all goods, stationery, premises, signage, packaging and advertising.

13. NOTICES

- 13.1. Any Notice given pursuant to this Agreement must be signed by an officer of the sender, addressed to the recipient at the address, facsimile number or email address set out in Part F of the Schedule or as a party may from time to time notify in writing to the other.

13.2. A Notice will be deemed given on the same day if hand delivered with authorised receipt; if posted, then three (3) business days after date of posting; if faxed, upon successful transmission record; and if by email, by return email to the sender informing receipt of the email.

14. DISPUTE RESOLUTION

14.1. In the event of a dispute arising between the parties in respect of any right or obligation under this Licence, each party covenants with the other in good faith to take all steps necessary to attempt to resolve the dispute.

14.2. In the event that the parties are unable between themselves to resolve a dispute within a reasonable period having regard to the nature of the Licence and the dispute, then either party may apply to their local State/Territory Alternative Dispute Resolution centre for resolution of the dispute.

15. GENERAL PROVISIONS

15.1. **(Law and Jurisdiction)** This Agreement shall be governed by and construed in accordance with the laws of NSW and any claim made by one party against the other in any way arising out of this Agreement will be heard in NSW and the parties submit to the jurisdiction of those Courts.

15.2. **(Relationship)** Nothing in this Agreement will constitute or be deemed to constitute a partnership, joint venture, franchise or agency between the parties.

15.3. **(Entire Agreement)** The terms of this Agreement constitute the entire terms of this Agreement and all understandings, prior representations, arrangements or commitments that are not contained in this Agreement have no effect whatsoever and do not bind the parties.

15.4. **(Invalidity)** If any provision of this Agreement is invalid under any law the provision will be limited, narrowed, construed or altered as necessary to render it valid, but only to the extent necessary to achieve such validity. If necessary the invalid provision will be deleted from the Agreement and the remaining provisions will remain in full force and effect.

15.5. **(Waiver)** No waiver of any right or remedy will be effective unless in writing and shall not operate as a waiver of that right or remedy or any other right or remedy on a future occasion.

15.6. **(Implied Terms)** Any implied term under law that can be excluded is expressly excluded and no term is to be implied as being a term of this Agreement unless by law it cannot be excluded.

15.7. **(Counterparts)** This Agreement may be executed in counterparts, each of which will be deemed to be an original and all of which together will constitute one instrument and Agreement provided that those counterparts have been exchanged.

15.8. **(Advice)** Each party acknowledges and represents to each other that it has had the opportunity to seek and obtain separate and independent legal advice before entering into this Agreement. If either party has entered this Agreement without first taking legal advice it has done so at its sole and absolute discretion and it will not be entitled to rely upon the absence of legal advice as a defence to any breach of any of the provisions of this Agreement.

16. INTERPRETATION

16.1. Definitions

“**Agreement**” means this licence agreement including the Schedule and any amendments in writing signed by both parties.

“**Change of Control**” means, in relation to a corporation, a change in control of the board of directors, a change of control of more than half the voting rights attaching to shares in the corporation, or a change of control of more than half the issued shares to which voting rights are attached.

“**Commencement Date**” means the date specified in Part B of the Schedule.

“**Confidential Information**” means all information in whatsoever form that is:

- (a) marked or identified as “Confidential”, “Secret”, “Not to be Disclosed” or “Private”;
- (b) is designated, described or referred to by the discloser in any document or correspondence as confidential, secret or private or not to be disclosed;
- (c) the receiving party knows or ought to know is confidential;

but does not include any information which prior to the date of this Agreement was lawfully in the public domain or which the discloser has published, circulated or announced publicly or was developed by the receiving party independently of the disclosing party.

“**Goods/Services**” means the goods and/or services in Part C of the Schedule being goods and/or services in respect of which the Trade Marks are registered or applications filed or are used under common law.

“**Intellectual Property Rights**” means all rights in copyright, circuit layout, designs, trade marks, patents and all other rights in intellectual property as defined in Article 2 of the World Intellectual Property Organisation (WIPO) Convention whether registrable, registered, patentable or not.

“**Licence**” means the software licence granted by the Licensor to the Licensee in Clause 1.

“**Notice**” means a notice in writing in English including those sent by facsimile, letter and email to the party’s address for notices set out in Part F of the Schedule.

“**Tax Invoice**” means an invoice that is GST compliant.

“**Territory**” means the State/Territory or States/Territories set out in Part D of the Schedule.

“**Trade Marks**” means the trade marks set out in Part A of the Schedule.

SAMPLE ONLY
YOUR DOCUMENT WILL VARY DEPENDING ON THE ANSWERS YOU
PROVIDE THROUGH THE BUILDING PROCESS

SCHEDULE

PART A – TRADE MARKS (Definition)

Installation of air-conditioning unites Transport of Air-conditioning units Repairing units
Callouts to client premise to test temperature Testing units Quoting of new units Adhere to
OH & S procedure Attend meetings when required

PART B – COMMENCEMENT DATE (Definition)

10 January 2010

PART C – GOODS/SERVICES (Definition)

Installation of air-conditioning unites
Transport of Air-conditioning units
Repairing units
Callouts to client premise to test temperature
Testing units
Quoting of new units
Adhere to OH & S procedure
Attend meetings when required

PART D – TERRITORY (Definition)

NSW

PART E – LICENCE FEE/ROYALTY (Clause 3)

One Hundred and twenty five thousand dollars Dollars (\$125 000) payable on signing the
Agreement exclusive of GST.

PART F – NOTICES (Clause 11)

Company Pty Ltd (**the Licensor**)

of: 1 Sydney Street Sydney 2000

Attention: _____

Facsimile N^o: _____

Email: _____

Other Company Pty Ltd (**the Licensee**)

of: 1 Brisbane Street Brisbane 7000

Attention: _____

Facsimile N^o: _____

Email: _____

Initial: _____

EXECUTED as an Agreement by the parties on the day and year first mentioned.

SIGNED BY)
Company Pty Ltd)
ACN 111 222 333 pursuant to)
Section 127 of the *Corporations Act* 2001)
(Cth) in the presence of:

Director

Print Name:

Signature of Witness

Print Name:

Director/Secretary

Print Name:

SIGNED BY)
Other Company Pty Ltd)
ACN 333 222 111 pursuant to)
Section 127 of the *Corporations Act* 2001)
(Cth) in the presence of:

Signature

Print Name:

Signature of Witness

Print Name:

SAMPLE ONLY
YOUR DOCUMENT WILL VARY DEPENDING ON THE ANSWERS YOU
PROVIDE THROUGH THE BUILDING PROCESS