

CHECKLIST: TRADE MARK LICENCE

This checklist lists basic information required for a trade mark licence. It is not necessarily complete, as particular circumstances may require different/extra information. Some of the questions may require our advice for proper interpretation and response. If you would like us to draft or review a trade mark licence for you, please complete the checklist (so far as you can) and send it to us.

Trade mark particulars

What is the trade mark?
Please provide a good quality copy of the trade mark.

Owner's particulars

Owner's full name

Owner's ACN or ABN

Owner's registered office address

Owner's contact name

Owner's telephone no.

Owner's facsimile no.

Is the owner a sole director and sole secretary company?

Yes / No

Is the owner the trustee of any trust?
If yes, please provide the following in respect of each trust:

Yes / No

(a) A copy of the trust deed.

(b) Copies of all deeds amending the trust deed.

(c) Copies of all deeds of retirement and appointment of trustee.

Licensee's particulars

Licensee's full name

Licensee's ACN or ABN

Licensee's registered office address

Licensee's contact name

Licensee's telephone no.

Licensee's facsimile no.

Is the licensee a sole director and sole secretary company?

Yes / No

Is the licensee the trustee of any trust?
If yes, please provide the following in

Yes / No

<p>respect of each trust:</p> <p>(a) A copy of the trust deed.</p> <p>(b) Copies of all deeds amending the trust deed.</p> <p>(c) Copies of all deeds of retirement and appointment of trustee.</p>	
Prior registrations	
Is the trade mark registered?	Yes / No
<p>If the trade mark is registered, please provide the following information:</p> <p>(a) Please specify all jurisdictions that the trade mark is registered in.</p> <p>(b) Please provide a copy of every certificate of registration of the trade mark.</p> <p>(c) When did the owner begin using the trade mark in each of those jurisdictions?</p> <p>(d) Has the owner used the trade mark continuously in each jurisdiction since then? If not, please provide further details.</p>	
<p>If the trade mark is not registered, please provide the following information:</p> <p>(a) What goods and services does the trade mark relate to?</p> <p>(b) Please specify all jurisdictions that the trade mark is used in.</p> <p>(c) When did the owner begin using the trade mark in each of those jurisdictions?</p> <p>(d) Has the owner used the trade mark continuously since then? If not, please provide further details.</p> <p>(e) Was there any previous owner of the trade mark? If so, please provide full details of all previous owners and copies of all documents transferring ownership.</p>	
Use(s)	
Please provide details of each use of the trade mark (i.e., the different ways that it is used).	
Third party rights	
Has the owner granted any other person the right to use the trade mark?	Yes / No

If so, on what terms? Please provide copies of all relevant agreements.	
Has any person challenged the owner's ownership or right to use the trade mark? If so, please provide full details of each challenge and its outcome.	Yes / No
Encumbrances	
Is the trade mark the subject of any registered or unregistered charge? If so, please provide the following details: (a) Registered number (if applicable). (b) Chargee's full name. (c) Chargee's (registered) address. (d) Chargee's ACN or ABN. (e) Chargee's contact name. (f) Chargee's telephone no. (g) Chargee's facsimile no.	Yes / No
Are there any other encumbrances affecting licensing of the trade mark. If so, please provide full particulars.	Yes / No
Licence term and options to renew	
How long is the licence to last for?	
What is to be the licence commencement date?	
What is to be the licence termination date?	
Is the licensee to have options to renew the licence? If so: (a) How many renewal options? (b) What length of renewal term?	Yes / No
What minimum length of notice is required to exercise an option to renew?	
What maximum length of notice can be given to exercise an option to renew?	
What is the final termination date?	
Licence fees and fee reviews	
Is the licensee to pay a fixed licence fee? If so, please specify: (a) The sum payable. (b) The date or dates on which it is payable.	Yes / No
Is the licensee to pay a periodic licence	Yes / No

fee? If so, please specify: (a) The sum payable. (b) The date or dates on which it is payable.													
Is the periodic licence fee subject to review? If so, please specify the frequency or the dates of review.	Yes / No												
Type(s) of review (specify years): - Fixed amount or percentage (specify) - Consumer price index Other (specify):	<table border="0"> <thead> <tr> <th></th> <th><u>Years</u></th> <th><u>Details</u></th> </tr> </thead> <tbody> <tr> <td>No / Yes</td> <td></td> <td></td> </tr> <tr> <td>No / Yes</td> <td></td> <td></td> </tr> <tr> <td>No / Yes</td> <td></td> <td></td> </tr> </tbody> </table>		<u>Years</u>	<u>Details</u>	No / Yes			No / Yes			No / Yes		
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No / Yes													
No / Yes													
No / Yes													
Can the periodic licence fee reduce in any circumstances (e.g., fall in CPI)	No / Yes												
Is the licensee to pay a royalty? If so, please specify: (a) The royalty basis. (b) The date or dates on which it is payable.	Yes / No												
Is GST included or to be added to the licence fee(s) and royalty?	Included / To be added / N/A												
Other licence terms													
What is the licensee's business (i.e., what type of business)?													
What is/are the permitted use(s) of the trade mark?													
In what territories(s) (i.e., countries, states or smaller localities) is the licensee to be allowed to use the trade mark?													
Is the licensee to be allowed to sub-license others to use the trade mark? If so, on what terms?	Yes / No												
What controls are there to be over the licensee's use of the trade mark, e.g.: (a) Quality control standards. (b) Production of samples of goods for approval by the trade mark owner. (c) Trade mark owner's right to inspect production facilities, materials, packaging, storage, delivery, etc. (d) Production of samples of the licensee's proposed uses of the trade mark for approval by the trade													

mark owner. (e) Approval of licensee's terms of trade with end users. (f) Other controls.	
Is the licensor or the licensee required to register the trade mark in any jurisdiction? If so, please provide details of what is required.	Yes / No
Please specify all special conditions that have been agreed.	
Representations & warranties	
Please specify all representations that have been made by the licensor/its agent <u>and/or</u> by the licensee.	
Please specify all warranties that have been given by the licensor/its agent <u>and/or</u> by the licensee.	
Insurances required	
Which of the following insurances must the licensee effect?	Minimum cover
Product liability	\$
Professional indemnity	\$
Public risk	\$
Workers compensation – per legislation	Yes / No
Other (specify)	\$
Guarantee of licensee's obligations	
Please provide the following details if guarantees of the licensee's obligations are to be provided:	
Guarantors' full names	
Guarantors' addresses	
Have you obtained or do you require financial references for the guarantors?	Obtained / (Not) required
Is the guarantee to be unlimited or limited?	Unlimited / Limited to (specify)
Costs	
Is the licensee to pay all the trade mark owner's costs?	Yes / No
If not, please specify the owner's and the licensee's respective contributions	

Is a non-refundable deposit for legal costs required to be paid by the licensee?	Yes / No
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