

# TRANSFER OF INTELLECTUAL PROPERTY – SOME QUICK TIPS

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Category: [CNPupdates](#)

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## **Beyond the underlying agreement:**

### **Updating particulars with the IP registry**

Before the transfer of the IP is carried out, the IP owner (the assignor) should consider whether its particulars with the IP registry require updating. If the assignor has since changed its name or address, it should update the registry's records by way of an application known as a Recordal of Change of Name and/or Address.

### **Negotiating, drafting and entering into IP transfer agreement**

Documentation used to effect an IP transfer include a Deed of Assignment, an Assignment Agreement or, in the context of a sale of assets of an undertaking, a Sale and Purchase Agreement. However, some jurisdictions may require these documents to fulfil certain requirements or be in a particular form. If this is not done, the transfer may not be effective.

### **Recordal of Assignment**

The assignment should be recorded with the IP registry by the person acquiring the IP (the assignee). In Singapore, an assignment of a patent, trade mark or registered design is a registrable transaction. If the assignment is not recorded, the transaction will not be effective as against a person who acquires a conflicting interest under the IP in ignorance of the transaction.

### **Costs of the transfer of IP**

Apart from the professional fees payable for drafting the underlying agreement and assisting in the work incidental to the IP transfer, the following costs may also be payable:

### **Unique legal requirements in foreign jurisdictions**

Countries have different legal requirements when it comes to the transfer of IP. When dealing with a multi-jurisdictional IP portfolio, it is important to understanding the legal framework of the jurisdictions in which the transfer of IP will take place.

There may be many legal requirements to understand and comply with, depending on the jurisdictions involved. For instance, certain jurisdictions such as Qatar require all marks which have been designated as associated trade marks (i.e. trade marks with similar features owned by the same proprietor) to be assigned

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together, even if the assignee is only interested in one of these marks. This may increase the costs involved in the transfer.

## **How to approach IP transfers**

1. Consult both local and foreign IP counsel before undertaking an IP transfer exercise to get an idea of the process, requirements and costs involved; and
2. With an understanding of these matters, parties can budget for both the time and costs of the IP transfer and negotiate over who will bear the costs. An understanding of these matters can assist in planning to ensure that the transaction proceeds smoothly and most importantly, to avoid any surprises.

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