

IPR Portfolio Management offers businesses the opportunity to outsource, in whole or in part, the administration of their IPR portfolio, by providing EP validation, annuity, renewal and recordal services. Further, we offer a number of IPR portfolio management tools.

Recording license agreements - uncover your risk

Your patent, trademark or design has been granted or registered, and your intellectual asset has been secured ...or has it?

Most IPR owners experience the need to grant licenses to their IPR whether to related companies or to non-related partners. As a general rule a license is granted, directly or indirectly, when IPR is exploited by others than the owner. This typically happens as part of distribution and production arrangements.

The world of IPR

National intellectual property law in some countries acknowledges the validity and enforceability of IPR license agreements by their mere existence. However, the IPR laws in many countries require such license agreements to be recorded with the national Patent and Trademark Office (PTO) to be valid and enforceable.

The risk exposure of not recording an IPR license agreement varies substantially from country to country. In countries where the IPR law requires the recordal of license agreements, the typical consequence is one or more of the following:

RISKS

PATENTS AND DESIGNS

- Not valid between the parties
- Not valid towards third parties
- No claim for damages by licensee against an infringer

TRADEMARKS

- Not valid between the parties
- Not valid towards third parties
- No claim for damages by licensee against an infringer
- Use by licensee does not inure to the benefit of the owner and the trademark registration becomes vulnerable to cancellation due to non-use

Time to despair?

Recordal of licenses with national PTO's may be made at any time during the life cycle of the IPR. It is therefore never too late to fully secure your IPR by the recordal of license agreements.

Zacco understands the importance of recording license agreements, which is why we employ dedicated specialists with worldwide knowledge and experience in recording licenses with respect to large IPR portfolios. We can assist you in carrying out an initial screening review of your IPR portfolio, in order to disclose any potential risks with respect to non-recorded license agreements.

Zacco is represented with offices in Denmark, Norway, Sweden, the Netherlands and the USA. Due to the combination of local presence and global knowledge we may service you anywhere in the world and in any IPR related matter.

Please contact Zacco Recordal for a portfolio review or to receive further information.

