



# Practitioners' Checklists

## Trademark Assignment Agreement Checklist

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### 1. Geographic Scope

Where are the to-be-assigned trademark assets located (i.e., in what country, countries or multi-country registration systems like Benelux, CTM, OAPI, etc.)? Determine the requirements of each applicable jurisdiction for each of the Checklist items below.

### 2. Recording Requirements

- a. \_\_\_ Is recordal of trademark assignment mandatory or optional in the jurisdiction?
- b. \_\_\_ Is there a time limit for submitting an executed Trademark Assignment Agreement (TAA) to be recorded in a patent and trademark office (TMO)?
- c. \_\_\_ Is late recordal permitted? What are the consequences of not recording a TAA, or of recording after expiration of an applicable time period?
- d. \_\_\_ What are the benefits of timely recordal?
- e. \_\_\_ Are original documents required?

- f. \_\_\_ Can a single assignment document covering marks in multiple jurisdictions be recorded either: (i) in original form or (ii) as a copy? If a copy is acceptable, is legalization required for recordal?
- g. \_\_\_ Is a separate assignment document for each jurisdiction required or advisable?
- h. \_\_\_ Can non-essential information be redacted from the assignment or schedule?

### 3. **Assets to Be Assigned**

What trademark assets are to be assigned? For purposes of this Checklist, please consider “trademarks” to include trademarks, service marks, certification marks, and collective marks, as applicable.

#### a. *Pending Trademark Applications*

- i. \_\_\_ Do the to-be-assigned trademark assets include pending trademark applications?
- ii. \_\_\_ Can pending trademark applications (of any type) be assigned in the jurisdiction?
- iii. \_\_\_ Are there any restrictions on assigning applications based on intent-to-use or proposed-use grounds?
- iv. \_\_\_ If the latter assignment restriction applies, is a *conditional* assignment of an application filed on intent-to-use or proposed-use grounds (i.e., to make the assignment subject to issuance of a resulting registration) acceptable?
- v. \_\_\_ What are the requirements, if any, for setting forth details of pending trademark applications in either the body of the TAA or any attached Schedule?

#### b. *Issued Trademark Registrations*

- i. \_\_\_ Are there issued trademark registrations among the to-be-assigned trademark assets?
- ii. \_\_\_ Are there any restrictions on assigning trademark registrations in the jurisdiction?

- iii. \_\_\_ What are the requirements, if any, for setting forth details of issued registrations in either the body of the TAA, or any attached Schedule?
- iv. \_\_\_ If desired, is it possible to assign *fewer than all* of the listed goods or services in a given trademark application or registration?

c. *Goodwill*

- i. \_\_\_ Is assignment of the goodwill associated with the underlying marks *optional* or *mandatory*?
- ii. \_\_\_ If mandatory, is *partial* assignment of goodwill (as to some trademark assets but not others) permitted?

d. *Associated Marks, Applications and/or Registrations*

- i. \_\_\_ Is association of related similar marks held by the same owner practiced in the jurisdiction?
- ii. \_\_\_ Are any of the to-be-assigned trademark assets subject to association in the jurisdiction?
- iii. \_\_\_ Is it possible to assign *fewer than all* of a given set of associated marks, applications or registrations, or is assignment of *all* associated marks, applications or registrations required if one is assigned?

e. *International Registrations*

- i. \_\_\_ Do the to-be-assigned trademark assets include International Registrations, a basic application or registration upon which an International Registration is premised, or national designations from an International Registration?
- ii. \_\_\_ Are there any restrictions or conditions imposed on assignment of the International Registration under the Madrid Agreement or Madrid Protocol?
- iii. \_\_\_ Are there any restrictions or conditions imposed on assignment of the basic application or registration?
- iv. \_\_\_ Are there any restrictions or conditions imposed on assignment of any of the national designations under the applicable jurisdictions?

f. *Common Law Trademarks*

- i. \_\_\_ Do the to-be-assigned trademark assets include trademarks that are in use but *not* the subject of trademark applications or registrations (i.e., common law trademarks)?
- ii. \_\_\_ What are the requirements, if any, for setting forth details of common law trademarks, underlying goods or services, and/or trade zones, in either the body of the TAA, or any attached Schedule?

g. *Trade Dress or Get-Up*

- i. \_\_\_ Is trade dress or get-up included among the to-be-assigned trademark assets?
- ii. \_\_\_ What are the requirements, if any, for describing, depicting or otherwise setting forth details of trade dress or get-up in either the body of the TAA, or any attached Schedule?

h. *Names of Living or Deceased Individuals*

- i. \_\_\_ Do the to-be-assigned trademark assets include the name of a living or deceased individual person?
- ii. \_\_\_ Is a signed, written consent from a living or deceased individual required in order to obtain a registration for a corresponding trademark in the applicable jurisdiction?
- iii. \_\_\_ If yes, provide in either the TAA or a separate written agreement irrevocable consent to the Assignee to use, apply to register, register, maintain and renew registrations for the subject individual's name as a trademark.

i. *Domain Names, Email Accounts, Social Media or Website Accounts, Telephone Number Mnemonics, Etc.*

- i. \_\_\_ Do the to-be-assigned trademark assets include any domain name registrations, email accounts, social media or website accounts, telephone number mnemonics (e.g., 800-ATTORNEY) or similar addressing tools that correspond to other trademark assets?
- ii. \_\_\_ Given the type of asset, what are the requirements for creating a binding assignment agreement that can be used to cause the applicable

registrar or account administrator to recognize and record a transfer from the Assignor to the Assignee?

j. *Rights to Sue and Collect for Current and/or Past Infringements*

- i. \_\_\_ Do the to-be-assigned trademark assets include the rights to sue and collect for current and past infringements?

**4. Execution Requirements**

a. *Signatories*

- i. \_\_\_ Must the TAA be executed by *both* the Assignor and the Assignee, or only by the Assignor?

b. *Witnesses*

- i. \_\_\_ Must the TAA be executed by one or more witnesses? How many?

c. *Notarization*

- i. \_\_\_ Must the TAA be notarized?
- ii. \_\_\_ What is the type of notarization required (e.g., simple, affirming identity and title of signatories, affirming place of execution, affirming nationality of the Assignor, sealed, formal notarial certificate based on documents presented, etc.)?

d. *Legalization or Apostille*

- i. \_\_\_ Is legalization of the TAA or use of an apostille required?

e. *Date and Place of Execution*

- i. \_\_\_ Must the TAA be dated?
- ii. \_\_\_ If yes, should the date be the actual date of execution of the TAA, or is it acceptable to back date the effective date of the TAA?
- iii. \_\_\_ Must the place of execution by the Assignor be stated (e.g., “in the City of \_\_\_\_\_”)?

f. *Power of Attorney*

- i. \_\_\_ Must the Assignor grant a power of attorney to the Assignee or a local practitioner in any applicable TMO for purposes of:
- recording the TAA;
  - prosecuting or withdrawing pending trademark applications;
  - maintaining or renewing registrations;
  - filing, prosecuting or withdrawing oppositions, cancellations or other proceedings;
  - filing new applications?
- ii. \_\_\_ If yes, what are the requirements for an acceptable power of attorney? From the Assignee's point of view, the grant should include the right to grant substitute, replacement or additional powers of attorney.
- iii. \_\_\_ Must the assignee grant a power of attorney to a local practitioner to record the assignment?
- iv. \_\_\_ May an appointment of agent or other similar document be used instead of a power of attorney from either party?

**5. Assignor**

a. *Name*

- i. \_\_\_ What is the Assignor's legal name? Confirm name consistency across all assets.

b. *Type of Entity, Place of Organization*

- i. \_\_\_ If the Assignor is a legal entity, what type of entity is it? Corporation, limited-liability company, limited partnership, general partnership, etc.?
- ii. \_\_\_ Where (what state or nation) was the entity formed or organized?
- iii. \_\_\_ Confirm consistency of type and place of organization across all assets.

c. *Address*

i. \_\_\_ What is the Assignor's current official address?

ii. \_\_\_ Confirm consistency of address across all assets.

**6. Assignee**

a. *Name*

i. \_\_\_ What is the Assignee's legal name?

b. *Type of Entity, Place of Organization*

i. \_\_\_ If the Assignee is a legal entity, what type of entity is it? Corporation, limited-liability company, limited partnership, general partnership, etc.?

ii. \_\_\_ Where (what state or nation) was the entity formed or organized?

iii. \_\_\_ Confirm consistency of type and place of organization across all assets.

iv. \_\_\_ Is it necessary to obtain and submit confirmation of the Assignee's current, active legal standing from the applicable government agency?

c. *Address*

i. \_\_\_ What is the Assignee's current legal or principal address?

**7. Consideration and Taxation**

a. *Consideration*

i. \_\_\_ Should a valid and enforceable TAA expressly state the consideration given or paid by the Assignee to the Assignor for all of the trademark assets or for the assets in the jurisdiction where recordal is sought?

ii. \_\_\_ If yes, must the actual amount of the consideration be stated, or, is it sufficient to state a nominal sum or refer to the consideration generally, as in, "for valuable consideration received . . . "?

b. *Valuation*

- i. \_\_\_ Under what circumstances (e.g., a cross-border transfer between related parties) must a valuation study be conducted in order to determine the fair market value of the to-be-assigned trademark assets prior to the assignment, for transfer pricing purposes?
- ii. \_\_\_ If a prior valuation study must be conducted, what are the requirements as to timing, methods and documentation of any such valuation study?

c. *Taxes or Duties*

- i. \_\_\_ Will the TAA be subject to the purchase of deed stamps or other payment of a transfer tax or duty in the applicable jurisdictions?
- ii. \_\_\_ If yes, how is the tax or duty computed, reported and paid?
- iii. \_\_\_ Are reporting and payment the responsibility of the Assignor or the Assignee?
- iv. \_\_\_ Is proof of payment required in the TMO?

**8. Checking and Correcting Chain-of-Title Issues**

a. *Check Proposed Assignor's Data Against Current Owner of Record in Applicable TMO*

- i. \_\_\_ Determine identifying data (name, address, type of entity, place of organization) from applicable online TMO databases.
- ii. \_\_\_ If online TMO databases are not current or detailed enough, determine whether other sources (the TMO directly, or local counsel or agents) can obtain and provide the necessary data.
- iii. \_\_\_ Identify any discrepancies between TMO data and other data regarding the proposed Assignor.
- iv. \_\_\_ Is it necessary in the applicable TMO to resolve any such discrepancies *before* submitting the TAA for recordal?
- v. \_\_\_ How does one give evidence that is acceptable to the TMO of a name change, address change, entity change, etc.?



vi. \_\_\_ How much time should be allowed for correcting chain-of-title issues *before* submitting the TAA for recordal?

b. *Prepare and Submit Documents to Resolve Chain-of-Title Issues*

i. \_\_\_ What documentation is required to prove a name change, address change, entity change or the like, or can the current owner of record attest to such changes in a signed declaration?

ii. \_\_\_ Can other organizations, like a Chamber of Commerce, attest to such changes in a signed declaration?

iii. \_\_\_ Must any documents submitted to prove a name change, address change, entity change or the like be signed, notarized, witnessed, certified, legalized or apostilled?

**9. Miscellaneous Provisions**

a. *Heirs, Successors and Assigns*

i. \_\_\_ Should the TAA be binding upon the respective heirs, successors and assigns of the parties?

b. *Further Assistance*

i. \_\_\_ Should the Assignor agree to provide further cooperation and assistance to the Assignee in recording, supplementing, enforcing or taking other actions to implement the transactions contemplated in the TAA?

ii. \_\_\_ If yes, should such cooperation be at the expense of the Assignee, or the Assignor, or should each party bear its own expense?

c. *Follow-On Assignments*

i. \_\_\_ Is it expected that additional assignments or other documents will be necessary in the future in order for the Assignee to fully acquire all of the proposed trademark assets?

ii. \_\_\_ If yes, which trademark assets are involved, and what are the conditions that must be satisfied to trigger execution of a new follow-on TAA by the Assignor?

iii. \_\_\_ Should the Assignee be empowered to unilaterally execute one or more follow-on TAAs on behalf of and in the name of the Assignor and, if so, under what conditions?

d. *Other “Boilerplate” Provisions to Consider*

- Integration clause
- Severability clause
- Construction clause
- Law of the TAA, Jurisdiction and Venue clauses
- Counterparts clause

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