

DATED

UP³I Limited

- and -

[LICENSEE]

UP³I LICENCE

Prepared by:

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Ref: CU/JSM/3696-2/149004v7**

THIS AGREEMENT is dated _____ ***[insert date]***

BETWEEN:

- (1) **UP³I Limited** (registered in England under number 5039982) whose registered office is at 3 Cloth Street, Barbican, London EC1A 7NP (the “**Licensor**”); and
- (2) _____ ***[INSERT NAME OF LICENSEE]***
a company registered in _____ ***[insert country]***
whose principal place of business is at _____
_____ ***[insert address]*** (the “**Licensee**”).

WHEREAS:

- (A) The Licensor is the owner of the Licensed Marks and the UP³I Specification.
- (B) The Licensee manufactures goods and/or equipment for the digital printing industry and wishes to be granted a licence to use the UP³I Specification and a licence of the Licensed Marks and related rights to use in its business in relation to its products manufactured in accordance with the UP³I Specification.

NOW IT IS HEREBY AGREED as follows:

1. DEFINITIONS

- “Licensed Marks”** means the trade mark “UP³I”, details of which are set out in Schedule 1, and any future registrations, applications for registration of the same mark in countries other than those listed in Schedule 2, together with all devices, get-ups and indicia owned by the Licensor and used in connection with such registered trademarks or applications for registration;
- “Territory”** means those countries listed in Schedule 2;
- “UP³I Specification”** means the specification set out in Schedule 3 as amended from time to time.

In this Agreement (except where the context otherwise requires):

- (a) Any reference to a Recital, Clause or Schedule is to the relevant Recital, Clause or Schedule of or to this Agreement and any reference to a sub-clause or paragraph is to the relevant sub-clause or paragraph of the Clause or Schedule in which it appears;
- (b) The Clause headings are included for convenience only and shall not affect the interpretation of this Agreement;
- (c) Use of the singular includes the plural and vice versa;
- (d) Use of any gender includes the other genders;
- (e) Any reference to “persons” includes natural persons, firms, partnerships, companies, corporations, associations, organisations, governments, states, foundations and trusts (in each case whether or not having separate legal personality).

2. COMMENCEMENT AND DURATION

This Agreement shall come into force on the date hereof and, subject to earlier termination pursuant to Clauses 7.3 or 15 below, shall continue in force until terminated by notice pursuant to Clause 16.5 below.

3. GRANT

- 3.1 Subject to and in reliance on Clause 3.4, the Licensor hereby grants to the Licensee a non-exclusive licence in the Territory to use the UP³I Specification and the Licensed Marks in its business subject to the provisions of this Agreement.
- 3.2 No other rights under the UP³I Specification and/or the Licensed Marks are granted to the Licensee and nothing in this Agreement shall prevent the Licensor or any person authorised by the Licensor from using the UP³I Specification or the Licensed Marks in the Territory.
- 3.3 The Licensor may in the future register the Licensed Marks in other countries which will be incorporated into the Territory by notice in writing to the Licensee. If the Licensee shall use the Licensed Marks outside the Territory (i.e. where they are not registered) it shall do so at its own risk and the Licensor shall incur no liability to the Licensee in respect of such use.

3.4 For the benefit of the Licensor, the Licensee:-

- (a) represents and warrants that each product and the related documentation that the Licensee puts onto the market or offers for sale, and on which it applies the Licensed Marks, will comply with the most recent version of the UP³I Specification current on the date when such product (or the applicable version or model thereof) was first put onto the market or offered for sale;
- (b) undertakes to specify in the user documentation issued with each product the version of the UP³I Specification with which it complies;
- (c) undertakes to comply with all instructions for the use of the UP³I Specification and/or the UP³I Trademark set out in the UP³I Specification;
- (d) undertakes not to promote or pass off as the UP³I Specification any standard or specification developed independently by itself or with others (whether or not it is similar or analogous to the UP³I Specification);
- (e) undertakes that it will promptly cease to apply the Licensed Marks on any product and its related documentation upon receipt of written notice from the Licensor stating that, in its reasonable opinion, such product does not comply with the applicable UP³I Specification;

and the Licensee acknowledges that the Licensor is entering into this Licence in reliance on the Licensee's representations, warranties and undertakings set out in this Clause.

4. PATENTS

4.1 The Licensor makes no representation nor gives any warranty with respect to the existence of any patents that may affect the UP³I Specification and the Licensee shall use the UP³I Specification at its own risk. However, the Licensee acknowledges that patents may exist or be developed in the future the practice of which will be required for the implementation of the UP³I Specification. Accordingly, in order to avoid uncertainty for licensees of the UP³I Specification, it is a condition of this licence that the Licensee agrees as follows:-

- (a) In this Clause 4, "**Patent**" means a patent or an application for a patent under the laws of any jurisdiction the practice of which is required for the implementation of any present or future version or release of the UP³I Specification.
- (b) This paragraph (b) applies to any Patent of which the Licensee is the grantee or applicant at the date of this Agreement and the

practice of which is required for the implementation of the UP³I Specification current at such date. If at any time the Licensee becomes aware of a Patent to which this paragraph (b) applies, the Licensee shall provide full written details thereof to the Licensor and confirm that it is prepared to grant a licence under such Patent on a royalty-free basis or (at its option) on reasonable and non-discriminatory terms determined by the Licensee. The Licensor will promptly publish on the UP³I Web site the details of such Patent and give written notice thereof to each other licensee of the UP³I Specification. The Licensee will promptly grant to any such licensee on request at any time a perpetual world-wide licence under such Patent to allow, at a minimum, the practice and use of the then current and/or any future version or release of the UP³I Specification.

- (c) Within 60 days of the date on which the Licensor publishes a new version of the UP³I Specification on the UP³I Web site (whether in draft, interim or final form, and whether for consultation purposes or otherwise), the Licensee shall, if it holds a Patent to which paragraph (b) does not apply, provide full written details of that Patent to the Licensor and notify the Licensor that:-
 - (i) the Licensee will grant a perpetual world-wide royalty-free licence of such Patent to each licensee of the UP³I Specification on request at any time to allow, at a minimum, the practice and use of such new version and any future version or release of the UP³I Specification; or
 - (ii) the Licensee will grant a perpetual world-wide licence of such Patent to each licensee of the UP³I Specification on request to allow, at a minimum, the practice and use of such new version and any future version or release of the UP³I Specification on reasonable and non-discriminatory terms; or
 - (iii) the Licensee will not grant a licence of such Patent to any licensee of the UP³I Specification.
- (d) Where the Licensee gives notice under paragraphs (c)(i) or (c)(ii) above, the Licensor shall promptly publish on the UP³I Web site the details of such Patent and indicate that a licence thereunder is required and gives written notice thereof to each licensee of the UP³I Specification.

- (e) Where the Licensee gives notice under paragraph (c)(iii) above, the Licensor shall, at its option, amend the applicable version of the UP³I Specification and/or take such other steps as may be necessary to avoid infringement of the Patent referred to in such notice.
- (f) Where the Licensee fails to give notice of a Patent to which paragraph (c) applies within the period of 60 days referred to in paragraph (c), then the Licensee shall be deemed to have notified the Licensor that paragraph (c)(ii) shall apply.
- (g) Notwithstanding the termination of this Agreement:-
 - (i) any licence granted under a Patent pursuant to this Clause 4.1 shall remain in full force and effect; and.
 - (ii) the Licensee shall remain under a continuing obligation without any limitation of time to grant licences in accordance with this Clause 4.1 under any Patent of which it was the grantee or the applicant at the date of termination other than under a Patent in respect of which the Licensee shall have given notice that paragraph (c)(iii) applies.
- (h) This Clause shall not require the Licensee to undertake a review of its patents and patent applications to determine whether this Clause applies to any of them.

4.2 Any dispute arising out of or in connection with this Clause 4 shall be referred to and finally resolved by a single arbitrator who shall be a senior patent counsel appointed by agreement between the parties or, in default of agreement within thirty days of notification of a dispute by one party to the other, by the President of the Law Society of England and Wales upon the application of either of them. The place of the arbitration shall be London and the arbitration shall be conducted in English.

5. APPLICATION OF THE MARK

5.1 The Licensee may display the Licensed Marks on all products manufactured in conformity with the UP³I Specification and on all documentation relating to such products and used in the normal course of its business. The Licensee shall comply strictly with the directions of the Licensor regarding the form and manner of the application of the Licensed Marks.

5.2 Without prejudice to the generality of Clause 5.1, the Licensor shall be entitled at any time to review the specification of the Licensee's product on which it has applied a Licensed Mark and if the Licensor finds that such product does not comply with the UP³I Specification, it may prohibit the further use of the Licensed Mark or make any further use subject to conditions. Any and all information that comes within the knowledge of the Licensor during any such review of the specification of a Licensee's product shall be deemed to be confidential.

5.3 The Licensee shall not use in its business any other trademark confusingly similar to the Licensed Marks and shall not use the Licensed Marks or any word confusingly similar to the Licensed Marks as or part of its corporate trading name.

6. TITLE AND GOODWILL

6.1 The Licensee acknowledges that the Licensor is the owner of the Licensed Marks and the UP³I Specification and all copyrights therein whether or not registered. The Licensee shall indicate that the Licensed Marks are the property of the Licensor by use of appropriate wording where the Licensed Marks are displayed, such wording to be approved by the Licensor.

6.2 Any goodwill derived from the use by the Licensee of the Licensed Marks and/or the UP³I Specification accrues to the Licensor. The Licensor may at any time call for a confirmatory assignment of that goodwill and the Licensee shall immediately execute it.

7. TRADEMARK REGISTRATIONS

7.1 The Licensee shall not apply for or obtain registration of the Licensed Marks for any goods or services in any country.

7.2 The Licensee shall not apply for or obtain registration of any trade or service mark in any country which consists of or comprises the word "UP³I" or any confusingly similar word or words.

7.3 In the event that any registration of the Licensed Marks expires or becomes suspended or cancelled in relation to a country or countries identified in Schedule 2 this Agreement will terminate in relation to that country or countries. The Agreement will continue in full force and effect in respect of the other countries within the Territory.

8. DUTIES OF THE PARTIES

- 8.1 The Licensee shall not do or omit to do anything to diminish the rights of the Licensor in the Licensed Marks or the UP³I Specification or impair any registration of the Licensed Marks.
- 8.2 Because this Licence is granted free of charge the Licensor reserves the right to abandon all registrations of the Licensed Marks in any country in the Territory and shall not be obliged to take any steps to maintain the existing registration of the Licensed Marks in any country in the Territory. However the Licensee shall provide at its own expense all necessary assistance in maintaining such registration or prosecuting any applications for registration in respect of the Licensed Marks.
- 8.3 The Licensee shall promptly notify the Licensor of any attack on the validity of any registration of the Licensed Marks or the UP³I Specification.
- 8.4 The Licensee shall abide by regulations and practices in force or in use in the Territory in order to safeguard the Licensor's rights in the Licensed Marks and the UP³I Specification.

9. ROYALTY

The licence granted by this Agreement shall be royalty-free.

10. UP³I ASSOCIATE DEVELOPER

- 10.1 The Licensee may apply to the Licensor to become a "UP³I Associate Developer" (as described on the UP³I Web site) using the UP³I Associate Developer Application Form set out in Schedule 4 to this Licence.
- 10.2 A UP³I Associate Developer shall be entitled:-
- (a) to ask the Licensor to incorporate additional features into the UP³I Specification;
 - (b) to participate at technical meetings arranged by the Licensor; and
 - (c) to receive relevant information, protocols and feedback on the current status of the development of the UP³I Specification.

11. QUALITY CONTROL

- 11.1 The Licensor shall notify the Licensee of the standards of quality and specifications which must be adopted by the Licensee in the use of the Licensed Marks and the Licensee undertakes to comply with such standards and specifications. Without prejudice to the generality of the foregoing, the Licensee shall not use the Licensed Marks on or in relation to any product which is not manufactured in accordance with the UP³I Specification. The Licensor shall give the Licensee written notice of any modifications or changes to the UP³I Specification and/ or any other standards of quality or specifications and the Licensee shall promptly implement any such modification or change.
- 11.2 The Licensee undertakes to ensure that its advertising and marketing of its own products and services that display the Licensed Marks shall in no way reduce or diminish the reputation, image and prestige of the Licensed Marks or the UP³I Specification.

12. INFRINGEMENT

- 12.1 The Licensee shall promptly notify the Licensor in accordance with Clause 16.5 of any actual or suspected infringement within the Territory of the Licensed Marks that comes to its attention (“**Infringement**”).
- 12.2 The Licensee will co-operate fully with the Licensor in taking all steps which the Licensor may deem necessary in connection with any Infringement, including without limitation, legal proceedings in the name of the Licensor, or the Licensee, or in the joint names of the Licensor and the Licensee. Each party will be responsible for the cost of any legal proceedings instigated at its request or for its benefit and such party shall also be entitled to any damages, account of profits and/or rights of cost recovered in respect of the same.

13. EXCLUSION OF LIABILITY

The Licensor provides the UP³I Specification and the information contained therein on an "AS IS" basis and USE OF THE UP³I SPECIFICATION AND THE UP³I TRADEMARKS IS AT THE LICENSEE'S OWN RISK. The Licensor makes no representation nor gives any warranty in relation to the UP³I Specification or the UP³I Trademarks and all warranties, whether express or implied, including but not limited to any warranty that the use of the UP³I Specification or any part of the information contained therein, or the use of the UP³I Trademarks will not infringe the intellectual property or other rights of third parties, or any warranties of merchantability or fitness for a particular purpose, are hereby expressly excluded.

TO THE EXTENT PERMITTED BY LAW, IN NO EVENT WILL THE LICENSOR BE LIABLE FOR OR BE REQUIRED TO INDEMNIFY THE LICENSEE OR ANY OTHER PERSON AGAINST ANY LOSS OF USE, LOSS OF REVENUE, PROFIT, CONTRACT OR DATA, OR ANY SPECIAL, INDIRECT, CONSEQUENTIAL, INCIDENTAL OR PUNITIVE LOSS OR DAMAGE, ARISING OUT OF OR RELATED TO THE USE OF OR INABILITY TO USE THE UP³I SPECIFICATION OR THE UP³I TRADEMARKS, EVEN IF THE LICENSOR OR ANY PERSON CONNECTED WITH IT HAS BEEN ADVISED OF THE POSSIBILITY OF SUCH LOSS OR DAMAGE AND WHETHER ARISING AS THE RESULT OF BREACH OF CONTRACT, NEGLIGENCE OR OTHER TORT, BREACH OF STATUTORY DUTY OR OTHERWISE AND REGARDLESS OF THE THEORY OF LIABILITY.

The Licensee agrees that this provision is reasonable and does not operate harshly in relation to it.

14. ASSIGNMENT AND SUB-LICENSING

- 14.1 This Agreement is personal to the Licensee. The Licensee may not assign, sub-licence, transfer, charge, encumber or otherwise deal with the whole or any part of this Agreement or its obligations under it.
- 14.2 The Licensor may assign the benefit of this Agreement and may delegate any of its duties under this Agreement.

15. TERMINATION

- 15.1 The Licensor shall have the right to terminate this Agreement forthwith by notice in writing to the Licensee in the event that:
 - (a) a Receiver, Administrator or Administrative Receiver is appointed over any of the Licensee's assets or undertaking or a winding up resolution or petition is passed or presented or any circumstances arise which entitle the court or any other person to appoint a Receiver, Administrative Receiver, Administrator or to present a winding-up petition or make a winding-up order, or other similar, dissimilar or equivalent action is taken against or by the Licensee by reason of its insolvency or in consequence of debt under the law of any jurisdiction;
 - (b) the Licensee commits a breach of any term under this Agreement which, if capable of remedy, is not remedied within 35 days of the date of a notice given by the Licensor to the Licensee specifying the breach and requiring the same to be remedied.

15.2 In the event of expiry or termination of this Agreement howsoever arising, and subject to any express provisions set out elsewhere in this Agreement:

- (a) All rights and licences shall cease;
- (b) The Licensee shall co-operate with the Licensor in the cancellation of all or any licences registered pursuant to this Agreement and shall execute any and all such documents and do acts and things as may be necessary in such connection.

16. GENERAL

16.1 In the event that any Clause or any part of any Clause in this Agreement is declared invalid or unenforceable by the judgment or decree by consent or otherwise of a court of competent jurisdiction from whose decision no appeal is or can be taken all other Clauses or parts of Clauses contained in this Agreement shall remain in full force and effect and shall not be affected by such finding for the term of this Agreement.

16.2 No relaxation, forbearance, delay or indulgence by either party in enforcing any of the terms and conditions of this Agreement or the granting of time by either party to the other shall prejudice, affect or restrict the rights and powers of the said party nor shall any waiver by either party of any breach of this Agreement operate as a waiver of or in relation to any subsequent or continuing breach of it.

16.3 This Agreement may only be amended by a document in writing signed by a duly authorised officer of each party.

16.4 The parties shall execute all further documents as may be necessary or desirable to give full effect to the terms of this Agreement and to protect the rights of the parties under it.

16.5 Any notice or other document to be given under this Agreement shall be given by sending the same in a pre-paid first class letter or facsimile to the address of the relevant party specified above or to the facsimile number specified below or to such other address or facsimile number as such party may have notified to the other for such purposes. Any notice sent by post shall be deemed (in the absence of evidence of earlier receipt) to have been delivered four days (or if sent to another country seven days) after despatch and if sent by facsimile transmission shall be deemed to have been sent at the time specified on an automatically printed transmission report on the sender's fax machine.

16.6 Nothing in this Agreement shall make one party the agent of the other, and neither party has the power or authority to bind the other in respect of any of the rights or duties hereunder.

16.7 This Agreement shall be governed by and interpreted in accordance with the laws of England and the parties hereby submit to the exclusive jurisdiction of the English Courts.

16.8 It is not intended that any term of this Agreement shall be enforceable solely by virtue of the Contracts (Rights of Third Parties) Act 1999 by any person who is not a party to this Agreement.

IN WITNESS whereof the parties hereto have executed this licence the day and year first above written.

EXECUTED for and on behalf of the **LICENSOR**

(duly authorised officer)

Licensor's facsimile number: +49 8121 4221

EXECUTED for and on behalf of the **LICENSEE**

(duly authorised officer)

Licensee's facsimile number: _____ ***[insert number]***

SCHEDULE 1

The Licensed Marks

Registration Number	Country	Filing date	Mark

SCHEDULE 2

The Trade Marks

The Trade Marks are registered or the Licensor intends to apply for registration in the following jurisdictions:

1. Australia
2. Canada
3. Europe (Community wide registration)
4. Japan
5. South Africa
6. Switzerland
7. United States of America

SCHEDULE 3

The UP3I Specification

The current specification needs to be download from www.up3i.org/download

