

Drafting a good assignment

Many inventions and patents will see a change in ownership at some time in their lives. For such a change to be legally effective it is generally necessary to prepare a formal written document setting out the terms of the transfer - this is known as an assignment.

Thinking carefully about what you say in an assignment before you sign it is important. It can save you time and expense when you come to recording the change of ownership at the various local Patent Offices, whereas getting it wrong can make the assignment difficult to record, and in extreme cases can render it ineffective.

Assignment documents

Some of the requirements for an assignment document to be valid in Europe differ significantly from US practice. They also differ from country to country within Europe according to local law. Before you start drafting an assignment here are a few key things to consider:

- **What do you want to assign?** The question may sound facetious, but we often see US originating assignments that aim to transfer the entire rights in an invention but that only refer to a US patent application. Include at least a reference to corresponding overseas rights if you want to assign those too, and preferably list foreign rights explicitly.
- **Who is assigning to whom?** Correctly identifying the parties is absolutely key to getting your assignment right. Also bear in mind that in nearly all European countries, as well as at the EPO, an assignment agreement must be signed by all the parties to the agreement, i.e. the assignor(s) and the assignee(s). Therefore an assignment that is only signed by one party, not both, will be difficult to record in Europe without executing further documentation.
- **Be aware that your document may be made public.** Many Patent Offices make assignment documents available in full when recorded on the patent register. Sometimes we see documents that include details about the assignment negotiation that the parties don't want made public. In many cases these can be redacted prior to recordal, but not including them in the document in the first place can save you both time and translation costs.

Drafting assignment documents – best practice tips

Once you have sorted out the basics of what you want to assign to whom, then the next thing is to make sure you draft a document that does what you want.

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First, **identify the rights** to be assigned:

- Prepare a schedule for attaching to the assignment which lists all the patents and applications being transferred by number and country. Preferably identify each application by multiple independent pieces of information, so that any errors which are inadvertently introduced during drafting can be easily corrected e.g. application number, publication number, date of filing, country, title, inventors.
- If an application has not yet been filed, consider attaching a description and drawings as an appendix to the assignment to make clear that all parties agree on what the invention being assigned actually is.
- Explicitly assign the right to file future applications for the inventions included in the patent applications set out in the schedule. This allows the assignment to be recorded for those applications too, and avoids any ambiguity over future ownership.
 - For example, 'INTELLECTUAL PROPERTY RIGHTS' means the patent applications listed in Schedule A, the inventions described therein, and any and all patents and patent applications arising therefrom, including any ensuing US or foreign national or regional patent applications, and any and all patents that may issue from said patent applications, including any and all reissues, extensions, registrations, validations, divisionals, continuations, or continuations-in-part of or to any of the aforesaid patent applications, and the right to claim priority therefrom.
- Consider assigning the right to bring infringement proceedings for past actions, and correspondingly the right to historic damages, costs, or lost profits, as well as the intellectual property right itself. This is possible in the UK, but not in some other jurisdictions. Local advice may be required as to whether such an assignment would be enforceable for an action against a prior infringer.

Next, make sure your **assignment is effective**:

- Include an operative clause actively assigning the rights. You don't want to merely make an agreement to assign the rights in future.
 - *"I hereby assign..."*, or *"...the Assignor hereby assigns to the Assignee its entire right and title to and interest in..."*
- Have a specified monetary consideration for the assignment – e.g. \$1.
 - Stating *"good and valuable consideration"* without an amount is not sufficient in some European countries, such as Italy.
 - On the other hand, stating a large amount can have tax implications (see below).
 - Keep a record of the transfer of the consideration, even where a token amount is given.
 - If you wish to avoid having a consideration, the alternative is to execute the assignment as a deed. For example, a deed must be witnessed, and must include an explicit statement that the document is *'signed as a deed'*. Official seals may also be required for deeds, so care needs to be taken with signature blocks.
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- Date the assignment, writing out the date in words e.g. 6th January 2019, not 06/01/19 (UK) or 01/06/19 (US). In cases where multiple signatures are needed, a different date can be provided for each signature. In this case, the document should specify the assignment is effective as of the date of the latest required signature.
- Have the assignment signed by both assignor and assignee. This is essential for the assignment to be valid in many European countries.

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Make sure you **get the details right**:

- Check that the assignor is the person, or the company, that is currently recorded as the registered owner on the relevant patent register. An assignment from someone the Patent Office does not have listed as the current owner may be worthless. If there has been an earlier unrecorded transaction, such as a change of name or another assignment, you may need to record that first before you are able to record your assignment.
- State the capacity of any person signing for a company – i.e. their job title. If the job title is not Director or similar, state that the person has the power under the rules of incorporation of the company to assign/accept assignments on behalf of the company (assuming that is true).
- Check that the address given for the assignor is the one currently recorded on the patent register – if they differ, you may need to record a change of address before you can record the assignment. It can reduce costs to list the same address for the assignor as is currently on the patent register – so long as it is actually still current.

Other things to consider:

- **How many originals should you make?** Some, but not all, European countries require you to submit an original document as evidence of the assignment. These may need to be notarised and/or legalised as well. It can therefore often be useful to execute multiple identical copies of the same assignment, if it transfers rights in more than one country, to avoid the need to re-execute confirmatory documents at a later time. There are also tax implications in some countries (see below), which may make it beneficial to assign some rights separately from others.
- **Will you need any more documents from the other side?** Once an assignment is completed, it is not always easy to go back to the other party and ask for more documents to be signed. However, some countries require additional paperwork from the assignor/assignee before they will record the assignment – a power of attorney, for instance. Executing these additional documents at the same time as the assignment, or including them as part of the assignment document itself, can save you having to go back and ask for more signatures later on.
- **Will you need any future assistance from the other side?** This may be needed if you discover that the assignor had not recorded an earlier assignment with a Patent Office, for instance, or if more signatures are needed. In addition, some countries will not allow you to assign the right to bring proceedings for past infringements, so you might want to retain the right to request assistance from the assignor in such cases.
- **Tax.** No stamp duty is payable on intellectual property assignments in the UK if the assignment document assigns only IP (and not other property such as stock or goods), and is not part of a wider series of transactions transferring other property. However, in some countries, including Italy and Ireland, tax is payable. In Italy for instance, the tax is a fixed value unless the total consideration exceeds around €4,000, in which case the tax is a percentage of the consideration. For this reason **it can be worth having a separate assignment document for use in each country where tax is payable**, transferring only property in that country. This can reduce the tax burden in some circumstances (e.g. where the tax is charged on the total value of property transferred in the document, the less value there is in the document, the lower the tax).
- **Translations.** Many European countries require a translation of the assignment into a local official language – keep it short if possible. If a large acquisition is planned, it may be worth having a separate document for the assignment of patent rights to reduce length, and hence translation costs.

Ensuring your assignment is recognised once it is made

To ensure that assignments are effective, many European countries require them to be formally registered at the local Patent Office. In cases where registration is not essential, there are often advantages in doing so.

The formal requirements for registration differ between Patent Offices. Please contact us for more information.

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