Schedule 18 — Intellectual Property Schedule

# Definitions

Unless otherwise expressly defined below, expressions used in this Schedule have the meanings given to them in clause 1.

In this Schedule:

1. **Brand** means all branding and goodwill associated with the Project (or any part of the Project) including:
   1. all registered and unregistered trade marks (other than those trademarks of any Project Co Associate or Financier which are used in its business more generally and are not created or developed in connection with the Project);
   2. all names including business names, domain names and company names (other than those names of any Project Co Associate or Financier that are used in its business more generally and are not created or developed in connection with the Project); and
   3. all telephone numbers, email addresses, internet addresses and all other addresses used by the general public in relation to the Project to make contact using an ICT network.
2. **Core IP Providers** has the meaning given in section 2.16(g). ***[Note: Details of specific entities to be inserted based on successful Respondent's responses. These will be the entities from whom the State will require Deeds of Assurance. However, the State reserves its position to require other arrangements (such as direct licences for the State) depending on the specific intellectual property circumstances of Respondents)]***
3. **COTS** means, in respect of Software and Firmware, a commercial off-the-shelf product that is ready-made and available for sale to the general public.
4. **Data** means all data and expressions of data contained in, or processed or generated by, the Project Assets or produced as a result of the Project Activities, including:
   1. all data and expressions of data contained in all images contained in or processed or generated by the Project Assets;
   2. all data and expressions of data comprising reports generated by the Project Assets; and
   3. all data and expressions of data about or relating to or generated by Project Co or any Project Co Associate in connection with the Project Assets.
5. **Deed of Assurance** means a deed of assurance substantially in the form of Annexure A.
6. **Developed Intellectual Property** means all Intellectual Property Rights, trade secrets and know-how comprised in or related to:
   1. all or any part of the Project Assets;
   2. all or any part of the Project Activities including all or any items, software tools or materials or documents used by Project Co in carrying out the Project Activities; or
   3. all or any part of any Project Co Material,
7. created, developed or produced in connection with the Project by or on behalf of Project Co or any Project Co Associate, whether before or after the date of this Deed excluding the Licensed Intellectual Property, Third Party Software, State IP and the Intellectual Property Rights subsisting in any Escrow Material.  ***[Note: The State requires ownership of all Intellectual Property developed in connection with the Project. However, the State is prepared to consider Respondent specific carve outs from this definition which will be treated as Licensed Intellectual Property.]***
8. **Domain Names** means any internet domain names used by Project Co in relation to the Project.

**Escrow Material** means **[to be inserted]**.

1. ***[Note: The State is willing to consider Respondent requirements for escrow arrangements relating to specific categories of Intellectual Property on a project specific basis provided that the State has adequate access rights to the escrow material. To be deleted if no Escrow Material is proposed.]***

**[Escrow Release Event** means:

* 1. an Insolvency Event occurs in respect of **[insert party providing Escrow Material]**;
  2. an Insolvency Event occurs in respect of **[insert name of party who may own Escrow Material if not the same as party providing it]** and **[insert party providing Escrow Material]** has not entered into a technical software support arrangement in respect of the Escrow Material with the State on terms satisfactory to the State, acting reasonably, within 20 Business Days after the occurrence of the Insolvency Event;
  3. the State exercises any step-in right in accordance with this Deed due to the acts or omissions of **[insert party providing Escrow Material]** and requires access to the Escrow Material to exercise its step-in rights (but only to the extent, and for the period, required for the State to reasonably exercise its step-in rights);
  4. a Default Termination Event occurs due to an act or omission of **[insert party providing Escrow Material]** and the State terminates this Deed; or
  5. **[insert party providing Escrow Material]** otherwise agrees to release their respective Escrow Material to the State, whether in accordance with any agreement between **[insert party providing Escrow Material]** and the State or otherwise.]

### ***[Note: Escrow Release Events to be considered on a project specific basis.]***

1. **Firmware** means a set of coded instructions embedded within a device or component of a device that performs functions or provides data to enable the device to operate in a specified manner.
2. **Intellectual Property Rights** includes any and all intellectual and industrial property rights throughout the world, whether subsisting now or in the future, including rights of any kind in:
   1. inventions, discoveries and novel designs, whether or not registered or registrable as patents, innovation patents or designs, including developments or improvements of equipment, technology, processes, methods or techniques;
   2. literary works, dramatic works, musical works, artistic works, cinematograph films, television broadcasts, sound broadcasts, published editions of works and any other subject matter in which copyright (including future copyright and rights in the nature of or analogous to copyright) may, or may upon creation of the subject matter, subsist anywhere in the world;
   3. registered and unregistered trademarks and service marks, including goodwill in the business concerned in the relevant goods and/or services;
   4. trade, business or company names;
   5. internet domain names; and
   6. proprietary rights under the *Circuit Layouts Act 1989* (Cth),

whether created or in existence before or after the date of this Deed.

1. **IP Escrow Agent** means [#]. ***[Note: To be appointed on a project specific basis.]***
2. **IP Escrow Deed** means [#].***[Note: To be developed on a project specific basis.]***
3. ***[Note: To be used on a project specific basis where the State agrees that certain intellectual property may be placed in escrow.]***
4. **Licensed Intellectual Property** means all Intellectual Property Rights, trade secrets and know-how comprised in or related to:
   1. all or any part of the Project Assets;
   2. all or any part of the Project Activities including all or any items, software tools or materials or documents used by Project Co in carrying out the Project Activities; or
   3. all or any part of the Project Co Material,

that are:

* 1. Non-Project Specific IP;
  2. Project Co Data; and
  3. the Escrow Material to the extent released to the State in accordance with section 2.6(c),

but excluding:

* 1. the Third Party Software; and
  2. the State IP.

1. **List of Intellectual Property** means a list of each item comprising Intellectual Property Rights used or to be used by Project Co or any Project Co Associate in performing its obligations under any State Project Document, which includes, separately identified, the List of Software, and specifies in relation to any Intellectual Property Rights not identified in the List of Software:
   1. the nature and, if applicable, name of the material in which the Intellectual Property Rights is comprised;
   2. the owner of the Intellectual Property Rights and, to the extent applicable, the licensor and the licensee of those Intellectual Property Rights;
   3. the duration of any licence and maintenance agreements; and
   4. the licence and maintenance fees and similar fees,

provided that neither Project Co nor any Project Co Associate will be required to disclose the information specified in paragraph (d) above if such information is subject to any contractual confidentiality obligations imposed on that party as a result of such information comprising confidential information.

1. **List of Software** means a list of each item of Software used or to be used by Project Co or any Project Co Associate in performing the Project Activities which specifies in relation to each item of Software:
   1. name and release version of the Software;
   2. owner and distributor of the Software and, if relevant, the licensor and the licensee of that Software;
   3. whether the Software is Third Party Software;
   4. the duration of any licence and maintenance agreements; and
   5. the licence and maintenance fees and similar fees,

provided that neither Project Co nor any Project Co Associate will be required to disclose the information specified in paragraph (e) above if such information is subject to any contractual confidentiality obligations imposed on that party as a result of such information comprising confidential information.

1. **Moral Rights** has the meaning given to it in the *Copyright Act 1968* (Cth).
2. **Non-Project Specific IP** means:
   1. any and all Material which is or has been developed other than in connection with the Project by Project Co or any Project Co Associate and brought to the Project by Project Co or any Project Co Associate (**Background IP**);
   2. any Developed Intellectual Property which is primarily derived or adapted from Background IP; and
   3. **[insert]**.

***[Note: Respondents may bid back consortium specific Intellectual Property developed for the purposes of the Project but which will be treated as Licensed Intellectual Property rather than Developed Intellectual Property.]***

1. **Project Co Data** means [to be inserted]. ***[Note: The State requires ownership of data associated with the Project. However, the State is prepared to consider ownership of limited specified categories of non-operational data vesting in Project Co where Respondents can show a legitimate need for such ownership.]***
2. **Software** means a set of coded instructions that performs functions or provides working data or parameters to enable a device or system to operate in a specified manner, and be loaded into a system or device dynamically by a user and includes all Firmware and operating systems required by a system or subsystem to perform in a specified manner.
3. **State IP** means all Intellectual Property Rights and trade secrets and know-how comprised in:
   1. the Data;
   2. the Brand; and
   3. the Trade Marks.
4. **Third Party Software** means any COTS Software and Firmware owned by any entity other than Project Co or the Project Co Associates that is:
   1. comprised in all or any part of the Works or the Project Assets;
   2. otherwise used or to be used by, or on behalf of, Project Co or any Project Co Associate in performing the Project Activities; or
   3. Software tools necessary for the State, or that a person in the State's position would otherwise require, to modify, maintain, test, further develop or regenerate the bespoke Software contained in the Project Assets or otherwise exercise any rights of ownership given to the State under section 2.12,

and is identified as such in the List of Software and any information provided under section 2.10(b)(iv).

1. **Trade Marks** means any trade marks specified by the State to Project Co in writing and any other trademarks used by or on behalf of Project Co or a Project Co Associate in relation to the Project (other than those trademarks of any Project Co Associate which are used in their business generally and are applied by them to devices or equipment they supply, but which do not include, directly or indirectly, any brands which are created or developed in connection with, the Project or any part of the Project).

# Intellectual Property

## Warranty by Project Co

Project Co represents and warrants that:

### (**no infringement**): no Intellectual Property Rights or Moral Rights or other rights of any person will be infringed or breached:

#### in delivering the Project;

#### by the performance of the Project Activities; or

#### by:

##### the use or enjoyment of the Project Co Material or the Project Assets; or

##### use or exercise of the Intellectual Property Rights licensed or assigned to the State in accordance with this Schedule,

* 1. by the State, any State Associate or any person nominated or authorised by the State in connection with any State Project Document (excluding in respect of the State IP);

### (**ownership**): it owns, or has the authority to grant the rights granted in accordance with this Schedule, in connection with the Intellectual Property Rights licensed or assigned to the State in accordance with this Schedule and neither:

#### the exercise of those rights by the State, any State Associate or any person nominated or authorised by the State in connection with any State Project Document; nor

#### the possession or use of any materials in which those rights subsist in connection with any State Project Document,

* 1. will give rise to any Liability on the part of the State, any State Associate or any person nominated or authorised by the State in connection with any State Project Document, including to pay any compensation (including any royalty) to any person, or give rise to a right entitling any person to make a Claim against the State, any State Associate or any person nominated or authorised by the State in connection with any State Project Document for any attribution or acknowledgment or rectification in relation to such Intellectual Property Rights or any materials in which they subsist;

### (**licences**): it has all appropriate licences of, or title to, all Intellectual Property Rights that are required by it for the purpose of its obligations under any State Project Document;

### (**Project Co's Associates' licences**): each Project Co Associate has all appropriate licences of, or title to, all Intellectual Property Rights that are required for performing their obligations under the Project Documents;

### (**no State licences**): Project Co does not and the Project Co Associates do not require any licences of, or title to, any Intellectual Property Rights from the State in order to perform their obligations under any State Project Document, apart from any licences to Intellectual Property Rights granted under this Deed;

### (**required Intellectual Property**): the Developed Intellectual Property, the Licensed Intellectual Property, the Third Party Software, the Escrow Material and the State IP are all the Intellectual Property Rights that are required for Project Co and any Project Co Associate to carry out their respective obligations under any Project Document;

### (**authority**): it has authority to assign, license or disclose (as the case may be) all Intellectual Property Rights granted to the State under any State Project Document;

### (**List of Software**): every item of the Software (excluding Software comprising the State IP) used or to be used by Project Co or any Project Co Associate in performing the Project Activities or which is part of the Project Assets is contained in the List of Software or will be later identified in accordance with section 2.10(b)(iv);

### (**third Party Software**): it has the authority to undertake the obligations concerning the Third Party Software contained in section 2.12;

### (**Third party rights or interests**): no third party rights or interests will affect the enjoyment of the benefit of the licences in section 2.4(a) or prevent the rights in section 2.4(b), section 2.5 or section 2.6;

### (**no Permitted Encumbrance**): other than a Permitted Encumbrance, there are no Encumbrances, and it will not allow any Encumbrance to be created, over its rights to any Intellectual Property Rights that are used by it for the purposes of its obligations under any State Project Document, except for any Permitted Encumbrance;

### (**allegations or notices**): it is not aware of any allegations of infringement or notices of misappropriation issued by any person or any Claims that the Project Assets or their use or enjoyment in accordance with or as contemplated by any State Project Document infringe or will infringe any rights, including any Intellectual Property Rights or Moral Rights, of any third party; and

### [(**Escrow Material**): none of the Escrow Material contains information, material, documentation or otherwise that would be required by the State or any person nominated or authorised by the State in connection with any State Project Document to operate or maintain the [Maintained Assets] in accordance with or as contemplated by any State Project Document.]***[Note: To be included if Escrow Material is contemplated.]***

Each representation and warranty in this section 2.1 is a continuing representation and warranty and will be repeated on each day while any obligation under any State Project Document remains outstanding, with reference to the facts and circumstances then subsisting.

## Indemnity

Project Co's liability to indemnify the Indemnified IP Persons in respect of Intellectual Property Rights and Moral Rights is set out in clause 43.5.

## Infringements

### (**Project Co notice**): If Project Co:

#### becomes aware of a Claim by a person that the use of any of the Intellectual Property Rights or Moral Rights relating to the Project or the Project Assets infringes or amounts to a misuse of the Intellectual Property Rights, Moral Rights or other rights of a third party; or

#### believes that the State may have a Claim against a person for infringement or misuse of any Intellectual Property Rights or Moral Rights relating to the Project or the Project Assets,

it must promptly provide the State with written notice of the alleged Claim.

### (**Prevention from using Intellectual Property Rights**): Notwithstanding clause 43.5 or section 2.1, if as a result of any alleged or threatened violation or infringement of Intellectual Property Rights or Moral Rights, the State, Project Co or any other entity performing work under any Project Documents is prevented (whether by court order or otherwise) from exercising Intellectual Property Rights or Moral Rights it had been exercising or was proposing to exercise to carry out the Project Activities or to use or enjoy the Project Co Material or the Project Assets, Project Co must (at the State's option):

#### secure for the State the right to continue exercising such Intellectual Property Rights or Moral Rights on terms no more onerous than those in this Deed;

#### replace such Intellectual Property Rights or Moral Rights with equivalent non‑infringing Intellectual Property Rights or Moral Rights (as applicable); or

#### modify any materials, equipment, Software, devices or processes so that they become non‑infringing or remove any materials, equipment, Software, devices or processes that are infringing without prejudice to any other rights of the State, and refund to the State all sums paid by the State for them.

### If the amount of time necessary to proceed with one of the options set out in section 2.3(b) is deemed excessive by the State, the State may direct Project Co to exercise another option providing for an equivalent outcome and Project Co must comply with that direction.

### The steps required for Project Co to comply with its obligations under sections 2.3(b) and 2.3(c) are at Project Co's sole cost and expense unless the alleged infringement or threatened infringement directly arises in respect of the licence granted to Project Co under section 2.7, in which case the costs are to be borne based upon the extent of responsibility of each party for the alleged infringement or threatened infringement, as reasonably determined by the State.

## Licensed Intellectual Property

### (**Grant of licence**): Subject to section 2.4(c), Project Co grants to the State and any entity nominated by the State a worldwide, permanent, perpetual, irrevocable, transferable, royalty‑free, non‑exclusive licence to exercise the Licensed Intellectual Property for the following purposes:

#### to enable the State to receive the benefit of the Project Assets and the Project Co Materials;

#### to carry out the Project or the Project Activities, including for any person other than Project Co to carry out the Project or Project Activities in accordance with the terms of any State Project Document;

#### to carry out the Functions/Operations; ***[Note: Delete as applicable to LIPD and SIPD.]***

#### to operate, maintain or modify the Project Assets;

#### to disclose the Licensed Intellectual Property on a confidential basis to third parties for the purposes of a tender process for the procurement of the integration of the Project Assets with any Augmentation;

#### to integrate the Project Assets with any Augmentation or any other project that interfaces with the Project Assets or any Augmentation (including any Interface Works); or

#### any other project relating to the Project Assets, including any Modification or any other project that interfaces with the Project Assets.

### (**Licence terms and conditions**): The licence granted in section 2.4:

#### arises in respect of each component of the Licensed Intellectual Property upon the later of the date of this Deed or the creation of the relevant component of the Licensed Intellectual Property;

#### may be sub-licensed (free of charge); and

#### will survive expiry of this Deed or termination of this Deed on any basis.

### [(**Escrow Material**): Escrow Material will only be Licensed Intellectual Property upon its release to the State in accordance with section 2.6(c).] ***[Note: To be included if Escrow Material is contemplated.]***

## Developed Intellectual Property

### (**Ownership of Developed Intellectual Property**): All Developed Intellectual Property will be owned by the State (or its nominee) and to the extent necessary to give effect to this, Project Co assigns to the State (or its nominee) all of its rights, title and interest in the Developed Intellectual Property. The ownership of each component of the Developed Intellectual Property vests in the State (or its nominee) on the later of:

#### the date of this Deed; and

#### creation of the relevant component of the Developed Intellectual Property.

### (**Assignment**): To the extent that any Developed Intellectual Property is owned by a party other than Project Co, Project Co will procure that party to assign its rights, title and interest in such Developed Intellectual Property to the State.

### (**Developed Intellectual Property licence**): The State grants to Project Co a non‑exclusive, irrevocable, worldwide, royalty-free licence during the Term to exercise the Intellectual Property Rights referred to in sections 2.5(a) and 2.5(b) solely for the purposes of performing its obligations under any State Project Document. This licence may be sublicensed (free of charge) subject to such conditions as the State may reasonably impose.

## [Escrow Material

***[Note: To be included if Escrow Material is proposed by Project Co.]***

### (**Initial deposit of Escrow Material**): Within 90 days after Financial Close, Project Co must procure that the Escrow Material then in existence is deposited with the IP Escrow Agent on the terms of the IP Escrow Deed.

### (**Regular deposit of Escrow Material**): Within 20 Business Days after the end of each Quarter during the Term, Project Co must deposit a copy of all Escrow Material that has been created during that Quarter with the IP Escrow Agent in accordance with the IP Escrow Deed.

### (**Release of Escrow Material**): The State will be entitled, at Project Co’s cost, to be provided with the Escrow Material pursuant to the IP Escrow Deed if an Escrow Release Event occurs.

### (**Escrow Material audit**): The State may, at its cost, Quarterly during the Term, have an auditor review, analyse and conduct tests on a confidential basis in relation to the Escrow Material maintained with the IP Escrow Agent for the purpose of verifying that Project Co is complying with sections 2.6(a) and 2.6(b).

### (**Licensed Intellectual Property**): Intellectual Property Rights comprised in any material which the State is entitled to be provided with on the occurrence of an Escrow Release Event will be Licensed Intellectual Property.

## State IP

### (**State IP licence**): The State grants to Project Co an irrevocable, royalty‑free, non-exclusive licence during the Term to use the State IP solely for the purposes of carrying out the Project Activities, subject to such conditions as the State may reasonably impose from time to time.

### (**Licence terms and conditions**): The licence granted in section 2.7(a) may be sublicensed (free of charge) by Project Co on such conditions as the State may reasonably impose from time to time.

## Access to Intellectual Property

### (**Disclosure**): If requested by the State, Project Co must promptly, at its own cost:

#### fully disclose to the State all details of the Intellectual Property Rights, trade secrets and know-how comprised in or related to all or any part of the Project Assets, the Project Activities or any Project Co Material; and

#### allow the State to discuss such Intellectual Property Rights, trade secrets and know-how with, and obtain information about the Intellectual Property Rights, trade secrets and know-how from, Project Co, any Key Subcontractor, any Significant Subcontractor, any other Project Co Associate or any of their respective Associates involved in the creation, development or use of the Intellectual Property Rights, trade secrets and know-how,

except for Escrow Material (to the extent such Escrow Material has not been released under the IP Escrow Deed) in each case:

#### to enable the State, the State Associates and any person nominated or authorised by the State in connection with any State Project Document to carry out any of the purposes set out in sections 2.4(a) and 2.4(b); and

#### subject to the State providing such confidentiality undertakings as Project Co may reasonably require where Project Co is subject to any confidentiality obligations to a third party (other than a Key Subcontractor or Significant Subcontractor).

### (**Public Disclosure Obligations**): Subject only to clause 55.1(d), the State will not be required to provide confidentiality undertakings under section 2.8(a)(iv) that are inconsistent with its Public Disclosure Obligations.

## Moral Rights

(**Moral Rights**): To the extent permitted by Law, Project Co must not, and must take all reasonable steps to ensure that the Project Co Associates do not or any other person does not, sue, enforce any Claim, bring any action or exercise any remedy in respect of any breach or alleged breach, infringement or other wrong doing (whether before or after the date of this Deed) in respect of any person's Moral Rights in respect of the Project Activities or the Project Assets by:

### the State;

### any third party to whom the State sub-licenses (whether that sub-licence is express or implied) or grants any other right to use, possess, vary or amend any Developed Intellectual Property, any Licensed Intellectual Property, the Project Assets or the Project Activities; or

### any third party to whom the State assigned any Developed Intellectual Property or any part of the Project Assets.

## Physical material

### (**Delivery of physical material**): Project Co must deliver, from time to time on request of the State during the Term and upon termination or expiry of this Deed, such physical media embodying:

#### Developed Intellectual Property;

#### Licensed Intellectual Property;

#### Third Party Software which Project Co or any Project Co Associate owns or has appropriate rights to provide; and

#### all Data,

as the State reasonably requests to enable it to fully exercise its ownership and rights under any State Project Document.

### (**Project Co obligations**): Without limiting section 2.10(a):

#### Project Co must create and deliver to the State prior to the Date for Final Acceptance one copy of the object code of any Software comprised in the Licensed Intellectual Property;

#### within 10 Business Days after any change to the Software comprised in the Licensed Intellectual Property, Project Co must deliver a copy of it to the State;

#### immediately prior to Financial Close Project Co must deliver the List of Software (current at that date) to the State as part of the List of Intellectual Property delivered under section 2.16(e); and

#### within 10 Business Days after the use by Project Co of any Software (excluding Software comprising the State IP) in carrying out the Project Activities which is not specified on the List of Software, Project Co must:

provide the State with the following information:

name of the Software;

owner of the Software; and

confirmation that the Software is the subject of the warranty in section 2.1;

use commercially reasonable endeavours to provide the State with a copy of the Software licence, if any; and

promptly update the List of Software to include that Software and the information above.

***[Note: State access to Software during Operational Phase to also be considered in Services Specifications.]***

## [Copyright and Circuit Layout Act

This Deed does not exclude or limit, or have the effect of excluding or limiting, the operation of subsection 47B(3) or sections 47C, 47D, 47E or 47F of the *Copyright Act 1968* (Cth) or Part II, Division 3 of the *Circuit Layout Act 1989* (Cth).] ***[Note: To be included on a project specific basis as required.]***

## Third Party Software

### Notwithstanding anything to the contrary in this Schedule, to the extent that any item of Project Co Material is Third Party Software, at the State's option, Project Co must (or must procure any Project Co Associate to):

#### license that item of Third Party Software to the State and each State Associate, if Project Co is legally able to do so, and on the terms of the licence granted to Project Co or any Project Co Associate by the third party licensor (and Project Co must use all reasonable endeavours to procure the consent of that licensor to grant that licence to the State and each State Associate); or

#### procure (at the State's cost) a licence of that item of Third Party Software from the third party licensor to the State and each State Associate on terms approved by the State.

### If, despite using all reasonable endeavours to do so, Project Co is unable to license (or, if applicable, procure a licence of) any Third Party Software owned by a third party to the State and each State Associate, as required under section 2.12(a), Project Co must consult with the State and do all things reasonably necessary to obtain for the benefit of the State and each State Associate such rights or arrangements as the State requires for any purpose under, or contemplated by, any State Project Document or for the Project Assets and its use or the Project more generally.

## Perfecting licence and ownership

### Without limiting any other provision of any State Project Document, including section 2.16, Project Co must do all things necessary (including executing documents) to perfect the licences and ownership granted to the State in this section 2 and otherwise to give effect to Project Co's obligations and the State's rights under this section 2. If Project Co fails to perfect the licences and ownership granted to the State in this section 2 or to otherwise give effect to Project Co's obligations and the State's rights under this section 2, Project Co appoints the State as its attorney (in accordance with clause 2.19) to perfect such licences and ownership and to give effect to any of the State's rights under this section 2.

## Ownership of Data

Notwithstanding any other provision of any State Project Document, Project Co agrees and acknowledges that the State owns the Data (other than the Project Co Data) including all Intellectual Property Rights in the Data (other than the Project Co Data). These ownership rights vest in the State upon creation of the Data (other than the Project Co Data). To the extent necessary to give effect to this, Project Co assigns to the State all of its rights, title and interest in the Data (other than the Project Co Data).

## Patent validity

If any component of any Intellectual Property Rights which is licensed or assigned under any State Project Document expires through the effluxion of time or is or becomes invalid, then, without limiting the State's rights in respect of that expiry or invalidity, that component will, to that extent only, be deemed to be excluded from the Intellectual Property Rights licensed or assigned under any State Project Document and each State Project Document will otherwise continue in full force and effect.

## Assurance

### (**Relationship with Intellectual Property Rights owner**): Project Co shall use reasonable endeavours to ensure that it maintains its relationship with the owner of any Licensed Intellectual Property (not owned by Project Co) or Third Party Software.

### (**Change in relationship**): If any circumstances occur whereby the direct or indirect relationship between Project Co and the owner of any Licensed Intellectual Property (not owned by Project Co) or Third Party Software changes or is likely to change, then Project Co must:

#### immediately notify the State in writing, which notice must describe, with a reasonable level of detail, the nature of those circumstances and their effect or likely effect on the State;

#### notwithstanding those circumstances, use its best endeavours to procure that the owner of the Licensed Intellectual Property or Third Party Software permits the State to continue exercising its rights to the Licensed Intellectual Property as if such circumstances did not occur, or as the case requires, had not occurred; and

#### do, and must use best endeavours to procure that the owner of the Licensed Intellectual Property or Third Party Software and Project Co will do, all such acts and things as the State reasonably requests in order to give effect to this section 2.16.

### (**Circumstances**): Circumstances referred to in section 2.16(b) include termination of any licensing arrangement or circumstances involving an inability to pay debts.

### (**Deeds of assurance**): Project Co must ensure that no arrangements with respect to Intellectual Property Rights owned by, or licensed to, a Core IP Provider are entered into in connection with the Project, the Project Assets, the Project Activities or the Project Co Materials without Project Co and the relevant Core IP Provider having delivered to the State duly executed Deeds of Assurance in relation to any Licensed Intellectual Property and Third Party Software owned by, or licensed to, the Core IP Provider.

### (**Delivery of List of Intellectual Property**): Immediately prior to Financial Close, Project Co must deliver the List of Intellectual Property (current at that date) to the State.

### (**Notice of Intellectual Property Rights not on List of Intellectual Property**): Prior to entering into any arrangements with respect to any Intellectual Property Rights which are not specified on the List of Intellectual Property, Project Co must provide the State with written notice specifying:

#### the nature of the Intellectual Property Rights;

#### the owner of the Intellectual Property Rights and, if relevant, the licensor and licensee of the Intellectual Property Rights; and

#### details of the proposed arrangements to be entered into with respect to the Intellectual Property Rights.

### (**Nomination**): The State may, acting reasonably, nominate any owner of, or holder of rights in, Intellectual Property Rights:

#### identified in the List of Intellectual Property; or

#### provided by Project Co to the State under a notice in accordance with section 2.16(f),

as a core provider of intellectual property (each a **Core IP Provider**), in which case section 2.16(d) will apply.

### (**Updated List**): Project Co must deliver an updated List of Intellectual Property to the State within 20 Business Days after the use of any Intellectual Property Rights not listed on the List of Intellectual Property previously delivered to the State.

## Trade Marks and Brand

### (**Ownership of Brand and Trade Marks**): Notwithstanding any other provision of any State Project Document, Project Co acknowledges and agrees that the State owns the legal and beneficial right, title and interest in the Intellectual Property Rights in the Brand and the Trade Marks.

### (**Assignment**): To the extent that any right, title or interest in the Intellectual Property Rights in the Brand or Trade Marks vests in Project Co or any Project Co Associate, Project Co assigns, and will procure that the Project Co Associates assign, such right, title and interest on its creation to the State.

### (**Registration of Trade Marks and Domain Names**): Project Co must do all things necessary (including executing documents) and provide the State with all such assistance as is reasonably required by the State to register the Trade Marks and the Domain Names in the name of the State and to maintain that registration throughout the Term.

### (**Identifying Trade Marks**): Project Co must ensure that where the Trade Marks appear in any written material (including any electronic material) published by or on behalf of Project Co, unless otherwise authorised by the State:

#### the Trade Marks must appear with the ® or the TM. symbol (as appropriate); and

#### the Trade Marks must be accompanied by the following footnote:

#### The ***[insert trade mark]*** trade mark is used by Project Co under licence from the State of Victoria.

### (**Prejudice the State**): Project Co must not use the Trade Marks in a manner which is prejudicial to the State or likely to prejudice the distinctiveness of the Trade Marks or the validity of any registration for the Trade Marks.

### (**Requirements regarding use**): The State may from time to time during the Term impose in writing, reasonable requirements regarding the use of the Trade Marks, and Project Co must comply with those requirements.

### (**Standards, directions and specifications**): Project Co must comply with any standards, directions and specifications notified in writing by the State from time to time during the Term as to the appearance, colour, size and positioning of the Trade Marks and the footnote referred to in section 2.17(d)(ii).

### (**Juxtaposition**): Project Co must not at any time during the Term use the Trade Marks in juxtaposition to any other trade mark, embellishment or device without the prior written consent of the State.

### (**Project Co obligations**): Project Co will:

#### if requested by the State, take all necessary action and execute and deliver to the State all necessary documents and instruments to record Project Co as a registered user of the Trade Marks;

#### if requested by the State, submit to the State, samples of all materials (including all advertisements, promotions and other marketing material) which incorporate the Trade Marks for the State's prior written approval;

#### except to the extent expressly permitted by this Deed, not use or apply to register the Trade Marks as part of its corporate, business, trading or domain name;

#### not directly or indirectly contest or oppose or assist any other party to contest or oppose the State's ownership of the Trade Marks; and

#### not register or use any trade mark or trade name which is substantially identical or deceptively similar to the Trade Marks.

### (**Goodwill**): Any and all goodwill attaching (now or in the future) to the Trade Marks as a result of use of the Trade Marks by or on behalf of or under licence from the State is and shall remain the property of and enure to the State, and Project Co will not obtain any rights in or to the Trade Marks.

### (**Infringement or unauthorised use**): If, during the Term, Project Co becomes aware of any infringement or unauthorised use of, act inconsistent with, challenge to or Claim against or in relation to any of the Trade Marks, Project Co must promptly notify the State.

### (**Legal proceedings**): The State will have the conduct of all proceedings relating to any infringement or unauthorised use of, act inconsistent with, challenge to or Claim against or in relation to any of the Trade Marks and will in its sole discretion decide what action (if any) to take in respect of that matter. Project Co must, at the State's reasonable cost, take any action which the State reasonably requests to bring the matter to an end.

### (**Telecommunication**): Project Co shall upon termination or expiry of this Deed procure that all telephone numbers, email addresses and all other electronic addresses which are designated by Project Co for use by the general public to make contact with Project Co in relation to the Project using a telecommunication network be transferred to the State.

## Survival

This Schedule survives:

### any frustration, suspension, termination or expiry of this Deed; or

### the exercise by the State of its step-in rights under clause 38.2.

1. Deed of Assurance

**Deed of Assurance**

**Dated**

**Parties** ***[Insert details of the owner of the Licensed Intellectual Property]* (** **Licensed IP Owner)**

**[#insert] (State)**

**[#insert] (Project Co)**

**Recitals**

A. The State has entered into, or may in future enter into, the [#] PPP Project Deed (the **Project** **Deed**) with Project Co.

B. Part of Project Co's obligations under the Project Deed include the licensing under or pursuant to the Project Deed of the Intellectual Property described in Schedule 1 (all and every part of which is referred to as the **Licensed Intellectual Property**) to the State and any third party authorised or licensed by the State, with the right to sublicense (the **IP Licence**).

C. The Licensed IP Owner owns/has appropriate rights to **[delete whichever alternative is not appropriate]** all Intellectual Property in the Licensed Intellectual Property, and has authorised Project Co to grant the IP Licence to the State and any third party authorised or licensed by the State.

D. By this Deed, the Licensed IP Owner assures the State and any entity authorised or licensed by the State that the State and any entity authorised or licensed by the State may continue exercising its rights under the IP Licence, notwithstanding any change affecting the Licensed IP Owner's direct or indirect relationship with Project Co.

**Operative Provisions**

1. The Licensed IP Owner warrants that it owns/has appropriate rights to **[delete whichever alternative is not appropriate]** all Intellectual Property in the Licensed Intellectual Property and is entitled to enter into this Deed.
2. The Licensed IP Owner warrants that it has authorised Project Co to grant the IP Licence.
3. If any circumstances occur whereby the Licensed IP Owner's direct or indirect relationship with Project Co concerning the Licensed Intellectual Property changes, or is likely to change, then:
   * 1. the Licensed IP Owner and Project Co shall immediately notify the State in writing, which notice shall describe, with a reasonable level of detail, the nature of those circumstances and their effect or likely effect on the State;
     2. notwithstanding those circumstances, the State and any entity authorised or licensed by the State may continue exercising its rights under the IP Licence as if such circumstances do not occur, or as the case requires, had not occurred; and
     3. the Licensed IP Owner and Project Co will do all such acts and things as the State reasonably requests in order to give effect to this Deed.

Such circumstances include termination of any licensing arrangement or circumstances involving an inability to pay debts.

1. The Licensed IP Owner shall ensure that any entity which succeeds to, is assigned or otherwise becomes the owner of, any of the Intellectual Property in respect of the Licensed Intellectual Property agrees to be bound by the terms of this Deed as if it were named in this Deed as the Licensed IP Owner and the Licensed IP Owner shall notify the State and Project Co in writing immediately after any such entity succeeds to, is assigned or otherwise becomes the owner of any of the Intellectual Property in respect of the Licensed Intellectual Property.
2. The Licensed IP Owner shall at its cost and expense immediately, on demand by the State, perform all acts and execute all agreements, assurances and other documents and instruments as the State reasonably requests to perfect or give effect to the rights and powers of the State created or intended to be created by this Deed.
3. This Deed shall be governed by the laws in force in Victoria, Australia.
4. The Licensed IP Owner irrevocably submits to and accepts, generally and unconditionally, the non-exclusive jurisdiction of the courts and appellate courts of Victoria with respect to any legal action or proceedings which may be brought at any time relating in any way to this Deed.
5. The Licensed IP Owner irrevocably waives any objection it may now or in the future have to the forum of any action or proceeding, and any claim it may now or in the future have that any action or proceeding has been brought in any inconvenient forum.
6. The Licensed IP Owner agrees that, subject to any rights of appeal which the Licensed IP Owner may have in Victoria or to the High Court of Australia, a judgment or order of a Victorian court in connection with this Deed is conclusive and binding on the Licensed IP Owner and may be enforced against the Licensed IP Owner in the courts of any other jurisdiction.
7. The Licensed IP Owner irrevocably appoints Project Co as its agent to receive service of process or other documents in any action in connection with this Deed and irrevocably agrees that service on Project Co as agent will be sufficient service on it. ***[Note: this paragraph may be deleted if the Licensed IP Owner has its registered office in Australia.]***
8. Each warranty in this Deed is a continuing warranty for the benefit of the State.
9. The State may at any time assign, novate, transfer or otherwise deal with all or any part of its rights or obligations under this Deed to any entity to which the State assigns, novates, transfers or otherwise deals with its rights or obligations under the Project Deed, in accordance with clause 52.10 of the Project Deed.
10. For the purposes of this Deed **Intellectual Property** includes any and all intellectual and industrial property rights throughout the world, whether subsisting now or in the future, including rights of any kind in:
    * 1. inventions, discoveries and novel designs, whether or not registered or registrable as patents, innovation patents or designs, including developments or improvements of equipment, technology, processes, methods or techniques;
      2. literary works, dramatic works, musical works, artistic works, cinematograph films, television broadcasts, sound broadcasts, published editions of works and any other subject matter in which copyright (including future copyright and rights in the nature of or analogous to copyright) may, or may upon creation of the subject matter, subsist anywhere in the world;
      3. registered and unregistered trademarks and service marks, including goodwill in the business concerned in the relevant goods and/or services;
      4. trade, business or company names;
      5. internet domain names; and
      6. proprietary rights under the *Circuit Layouts Act 1989* (Cth),

whether created or in existence before or after the date of this Deed.

**Executed** as a Deed

***[Insert appropriate execution blocks]***

**Schedule 1**

***[Insert a description of the component of the Licensed Intellectual Property in which the Licensed IP Owner owns the Intellectual Property]***