

Draft 10 August 2016

IANA IPR ASSIGNMENT AGREEMENT

This IANA IPR Assignment Agreement (“Agreement”) is entered into as of this ___ day of _____, 2016 (“Effective Date”), by and between the IETF Trust, a Virginia common law trust (“IETF Trust”) and the Internet Corporation for Assigned Names and Numbers, a California nonprofit public benefit corporation (“ICANN”). The IETF Trust and ICANN may each be referred to herein as a “Party,” and collectively as the “Parties.”

ARTICLE 1 DEFINITIONS

1.1 Affiliate: With respect to a party hereto, a corporation or business entity that, directly or indirectly, is controlled by, controls, or is under common control with such party, together with all officers, members, managers and directors of such party, corporation or business entity. For this purpose, the word “control” shall mean direct or indirect ownership of fifty percent (50%) or more of the equity or voting shares or interest of such corporation or business entity having the right to vote for the election of directors, or the power to appoint a majority of the board of directors or other governing body or otherwise to direct the management and policies of such corporation or business entities, whether by contract or otherwise. For the avoidance of doubt, (i) the Internet Society, a District of Columbia non-profit corporation, is not an Affiliate of the IETF Trust, and (ii) Public Technical Identifiers, a California non-profit corporation, is an Affiliate of ICANN.

1.2 Assigned Intellectual Property: All rights owned, held or controlled by ICANN and its Affiliates throughout the world in the names “Internet Assigned Numbers Authority” and “IANA,” including all associated designs and logos and all derivatives, variants, combinations and modifications thereof and all Internet domain names including any material portion of any of the foregoing. Without limiting the generality of the foregoing, the registered trademarks and domain names and other intellectual property rights listed in Exhibit A are included in the Assigned Intellectual Property.

1.3 Claim: Any actual or threatened legal claim, action, demand, suit, litigation, appeal or other proceeding.

1.4 Effective Date: Has the meaning set forth in the Preamble.

1.5 Encumbrance: Any lien, claim, easement, attachment, option, right to acquire an interest, lease, license, sublease, covenant, charge, security interest, mortgage, pledge, restriction on use, conditional sale or other encumbrance of any kind or nature whatsoever.

1.6 Liability: Liabilities, losses, costs, expenses and damages.

1.7 Third Party: A person or entity that is not an Affiliate of a Party.

1.8 Third Party Claim: Any Claim initiated by a Third Party.

ARTICLE 2 ASSIGNMENT

2.1 Assignment. For good and valuable consideration, the sufficiency and receipt of which are hereby acknowledged, ICANN hereby irrevocably assigns and transfers the Assigned Intellectual Property, including all goodwill therein, to the IETF Trust, free and clear of any and all Encumbrances.

2.2 Trademark Office Filings. Within ten (10) days following the Effective Date or the date of receipt of all required information from the IETF Trust necessary to record the assignment, whichever date is later, ICANN will, at its expense, file the form attached hereto as Exhibit B with the U.S. Patent and Trademark Office. ICANN shall provide copies of all filings, and all receipts, acknowledgements and other relevant correspondence with U.S. Patent and Trademark Office regarding such assignment, to the IETF Trust within ten (10) days following receipt, as applicable.

2.3 Domain Name Registrars. Within ten (10) days following the Effective Date, ICANN will, at its expense, submit all documentation to the relevant Internet domain name registrars that is necessary to transfer ownership and administrative control over all Internet domain names included within the Assigned Intellectual Property set forth in Exhibit A to the IETF Trust. Following such filing, ICANN shall retain no administrative control with respect to such domain names.

2.4 Transfer of Files. No later than thirty (30) days following the Effective Date, ICANN's current counsel shall deliver to the IETF Trust or its designee copies of all existing files and records pertaining to the registered trademarks set forth in Exhibit A, including, but not limited to, any registration certificates, applications, office actions, affidavits, renewal certificates, receipts, drawings, official correspondence and other relevant non-privileged files kept by ICANN trademark counsel (internal or external). ICANN shall instruct its counsel to cooperate with the IETF Trust counsel, at no charge to the IETF Trust, in effecting an orderly and prompt transition of all dockets and associated files to the IETF Trust's counsel.

2.5 Further Assurances. At any time and from time to time after the date hereof, at the IETF Trust's request and expense, ICANN promptly shall execute and deliver, and shall cause its Affiliates and employees to execute and deliver, such instruments of sale, transfer, conveyance, assignment and confirmation, and take such other actions, as the IETF Trust may reasonably request to more effectively transfer, convey and assign to the IETF Trust, and to confirm the IETF Trust's title to, all of the Assigned Intellectual Property, to assist the IETF Trust in exercising all rights with respect thereto and to carry out the purpose and intent of this Agreement.

ARTICLE 3 LICENSE AND COMMUNITY AGREEMENT

3.1 License. The IETF Trust commits to, contemporaneously with the signing of this Agreement, execute three License Agreements to license the Assigned Intellectual Property to ICANN to use solely in the performance of the IANA Services, as defined in each such License Agreement.

3.2 Community Agreement. The IETF Trust also commits, contemporaneously with the signing of this Agreement, to enter into an agreement among the operational communities for which the IANA Services are performed, which will guide how the operational communities will consult with the IETF Trust on the maintenance and oversight of the Assigned Intellectual Property, including considerations to guide future assignments of the Assigned Intellectual Property

ARTICLE 4 REPRESENTATIONS AND WARRANTIES OF ICANN

As of the Effective Date, ICANN hereby represents and warrants to the IETF Trust:

4.1 Assets. Exhibit A hereto lists all trademark registrations issued to ICANN for the Assigned Intellectual Property throughout the world. Exhibit A hereto lists all domain names registered by ICANN for “iana” or “internetassignednumbersauthority.”

4.2 No Encumbrances. The Assigned Intellectual Property is subject to no known Encumbrance.

4.3 Ownership. ICANN is the owner of the Assigned Intellectual Property, and ICANN has the unencumbered right to assign and transfer to the IETF Trust good, clear record and marketable title to the Assigned Intellectual Property as contemplated hereby. ICANN makes no warranty or representation whatsoever, express or implied, regarding the validity or enforceability of the Assigned Intellectual Property.

4.4 Currency of Registrations. All registered trademarks and domain names included in the Assigned Intellectual Property are subsisting and in full force and effect, and no renewal or other fees are owing or unpaid with respect thereto. The execution of this Agreement will not result in the loss or impairment of the rights of the IETF Trust to own or use any Assigned Intellectual Property.

4.5 No Known Claims. No claims or proceedings, or threat of claims, are known by ICANN or are known to have been asserted by any third party against ICANN or any Affiliate relating to the Assigned Intellectual Property or challenging or questioning the validity, effectiveness or infringement of third-party rights thereof. Except as disclosed to the IETF Trust by ICANN on or prior to the Effective Date, no claims, demands or proceedings instituted by ICANN or any Affiliate are currently pending charging any third party with infringement, misappropriation, or dilution of any Assigned Intellectual Property and ICANN knows of no third party intellectual property rights that would be infringed by the use of the Assigned Intellectual Property anywhere in the world.

4.6 Authorization. This Agreement has been duly and validly executed and delivered by ICANN, and constitutes the valid and legally binding obligation of ICANN, enforceable in accordance with its terms and conditions. The execution, delivery, and performance of this Agreement has been duly authorized by ICANN, and no other corporate proceedings on the part of ICANN are necessary to authorize this Agreement or the transactions contemplated hereby.

ARTICLE 5 REPRESENTATIONS AND WARRANTIES OF THE IETF TRUST

As of the Effective Date, the IETF Trust hereby represents and warrants that: (i) it is an entity capable of owning the trademark registrations set forth in Exhibit A, either in its own right or through the individual trustees of the IETF Trust; (ii) this Agreement has been duly and validly executed and delivered by the IETF Trust, and constitutes the valid and legally binding obligation of the IETF Trust, enforceable in accordance with its terms and conditions; and (iii) the execution, delivery, and performance of this Agreement has been duly authorized by the IETF Trust, and no other corporate proceedings on the part of the IETF Trust are necessary to authorize this Agreement or the transactions contemplated hereby.

ARTICLE 6 INDEMNIFICATION

6.1 By ICANN. ICANN will indemnify, defend and hold harmless the IETF Trust, its Affiliates, employees and trustees (“Trust Indemnitees”) from and against any and all Third Party Claims and associated Liability to the extent arising directly or indirectly from (a) ICANN’s material breach of any of its representations, warranties or agreements set forth herein, or (b) ICANN’s or any of its licensee’s use of the Assigned Intellectual Property, and the conduct of any business or other activity by ICANN or its licensees under or using the Assigned Intellectual Property, prior to the Effective Date, or (c) the IETF Trust’s or any of its licensees’ (other than ICANN or any of its Affiliates or sublicensees) use of the Assigned Intellectual Property, and the conduct of any business or other activity by the IETF Trust or such licensees under or using the Assigned Intellectual Property, after the Effective Date, which use is of the same scope and nature as ICANN’s or its Affiliates’ or licensees’ use prior to the Effective Date (including location and class of service). Notwithstanding the forgoing, ICANN’s indemnity obligation with respect to clause 6.1(c) above shall have a duration of only X years [*TBD prior to signing*] from the Effective Date.

6.2 By the IETF Trust. The IETF Trust will indemnify, defend and hold harmless ICANN, its Affiliates, employees, officers and directors (“ICANN Indemnitees”) from and against any and all Third Party Claims and associated Liability to the extent arising directly or indirectly from (a) the IETF Trust’s material breach of any of its representations, warranties or agreements set forth herein, or (b) the IETF Trust’s or any of its licensees’ (other than ICANN or any of its Affiliates or sublicensees) use of the Assigned Intellectual Property, and the conduct of any business or other activity by the IETF Trust or such licensees under or using the Assigned Intellectual Property, after the Effective Date, unless such use is of the same scope and nature as ICANN’s or its Affiliates’ or licensees’ use prior to the Effective Date (including location and class of service).

6.3 Indemnification Procedure.

a. A party seeking indemnification hereunder (“Indemnified Party”) will give prompt written notice (an “Indemnification Notice”) to the party from which indemnification is sought (“Indemnifying Party”) of the assertion of any Claim in respect of which indemnity may be sought under Section 6.1 or 6.2, as applicable, and will provide the Indemnifying Party such information with respect thereto that the Indemnifying Party may reasonably request. The failure to promptly notify the Indemnifying Party shall not relieve the Indemnifying Party of its obligations hereunder, except to the extent such failure shall have prejudiced the Indemnifying Party.

b. The Indemnifying Party shall manage and control the defense of any Claim asserted by any third party (“Third Party Claim”) as to which indemnification is sought hereunder at its sole expense using counsel of its selection, subject to the reasonable prior approval of the Indemnified Party. The Indemnifying Party shall obtain the prior written consent of the Indemnified Party (which shall not be unreasonably withheld) before entering into any settlement of such Third Party Claim if the settlement does not release the Indemnified Party from all liabilities and obligations with respect to such Third Party Claim or the settlement imposes injunctive or other equitable relief against the Indemnified Party. The Indemnified Party shall be entitled to participate in the defense of such Third Party Claim and to employ separate counsel of its choice for such purpose at its own expense. Each party shall cooperate in the defense or prosecution of any Third Party Claim and shall furnish or cause to be furnished such records, information and testimony, and attend such

conferences, discovery proceedings, hearings, trials or appeals, as may be reasonably requested in connection therewith, at the expense of the requesting party.

ARTICLE 7 GENERAL PROVISIONS

7.1 Disputes. This Agreement will be governed by and construed in accordance with the laws of the State of California, USA, excluding its conflicts of law provisions.

7.2 Notices. Any notice or report required or permitted to be given or made under this Agreement by a party hereto to any other party shall be given by registered mail or overnight courier (return receipt requested), to the parties at the addresses indicated below, and shall be effective upon the earlier of the date of actual receipt by the addressee or the date three (3) days after the same was posted or sent. Notices shall be sent to:

INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS

[insert address]

IETF TRUST

[insert address]

A party hereto may change its address or contact person by giving written notice to the other parties pursuant to this Agreement.

7.3 Severability. If, under applicable law or regulation, any provision of this Agreement is invalid or unenforceable, or otherwise directly or indirectly affects the validity of any other material provision(s) of this Agreement (“Severed Clause”), the parties hereto agree that this Agreement is intended to endure except for the Severed Clause. The parties shall consult and use their reasonable efforts to agree upon a valid and enforceable provision that shall be a reasonable substitute for such Severed Clause in light of the intent of this Agreement.

7.4 Headings. The subject headings of the Articles and Sections of this Agreement are included for purposes of convenience only, and shall not affect the construction or interpretation of any of its provisions.

7.5 Entire Agreement; Amendment. This Agreement and all the Exhibits hereto contain the entire understanding of the parties with respect to the matters contained herein and supersede any previous agreements (oral, written or otherwise) and may be altered or amended only by a written instrument duly executed by the parties hereto.

7.6 Assignment of Agreement. This Agreement is binding upon and shall inure to the benefit of the successors and permitted assigns of the parties hereto. This Agreement, in whole or in part, shall not be assignable by any party hereto to any third party without the prior written consent of the other, which shall not be unreasonably withheld.

7.7 Non-Waiver. The failure of a party in any one or more instances to insist upon strict performance of any of the terms and conditions of this Agreement shall not constitute a waiver or relinquishment, to any extent, of the right to assert or rely upon any such terms or conditions on any future occasion.

7.8 Independent Contractors. The parties hereto are independent contractors. No party is, or will be deemed to be, the partner or legal representative or agent of any other party, nor shall any party have the right or authority to assume, create, or incur any third party liability or obligation of any kind, express or implied, against or in the name of or on behalf of another except as expressly set forth in this Agreement.

7.9 Counterparts. This Agreement may be executed in two or more counterparts, each of which shall be an original and all of which shall constitute together the same document.

7.10 Duration. The provisions of Articles 4, 5, 6 and 7 of this Agreement shall survive until the expiration of the last-to-expire of the registered trademarks and domain names included in the Assigned Intellectual Property.

IN WITNESS WHEREOF, the parties have caused this Agreement to be executed as of the Effective Date by their duly authorized representatives:

INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS

By: _____

Name: _____

Title: _____

IETF TRUST

By: _____

Name: _____

Title: Trustee

EXHIBIT A

ASSIGNED INTELLECTUAL PROPERTY

Mark/Domain	Jurisdiction	Reg. No.
IANA	U.S.	3536171
	U.S.	2620519



INTERNET ASSIGNED NUMBERS AUTHORITY	U.S.	2764089
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Domains

e-iana.org
eiana.org
iana-servers.com
iana-servers.net
iana-servers.org
iana.com
iana.jobs
iana.net
iana.org
internetassignednumbersauthority.com
internetassignednumbersauthority.net
internetassignednumbersauthority.org

EXHIBIT B

TRADEMARK ASSIGNMENT

For good and valuable consideration, the sufficiency and receipt of which are hereby acknowledged, the Internet Corporation for Assigned Names and Numbers (“ASSIGNOR”), hereby irrevocably assigns and transfers the Assigned Marks (as set forth below), including all goodwill therein, to the IETF Trust (“ASSIGNEE”), free and clear of any lien, claim, easement, attachment, option, right to acquire an interest, lease, license, sublease, occupancy contract, encroachment, covenant, charge, security interest, mortgage, pledge, easement, restriction on use, conditional sale or other title retention agreement or defect in title.

Assigned Marks	Jurisdiction	Reg. No.
IANA	U.S.	3536171
	U.S.	2620519
INTERNET ASSIGNED NUMBERS AUTHORITY	U.S.	2764089

ASSIGNOR:

INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS

By: _____

[Name]

[Title]