



ideas and enterprise

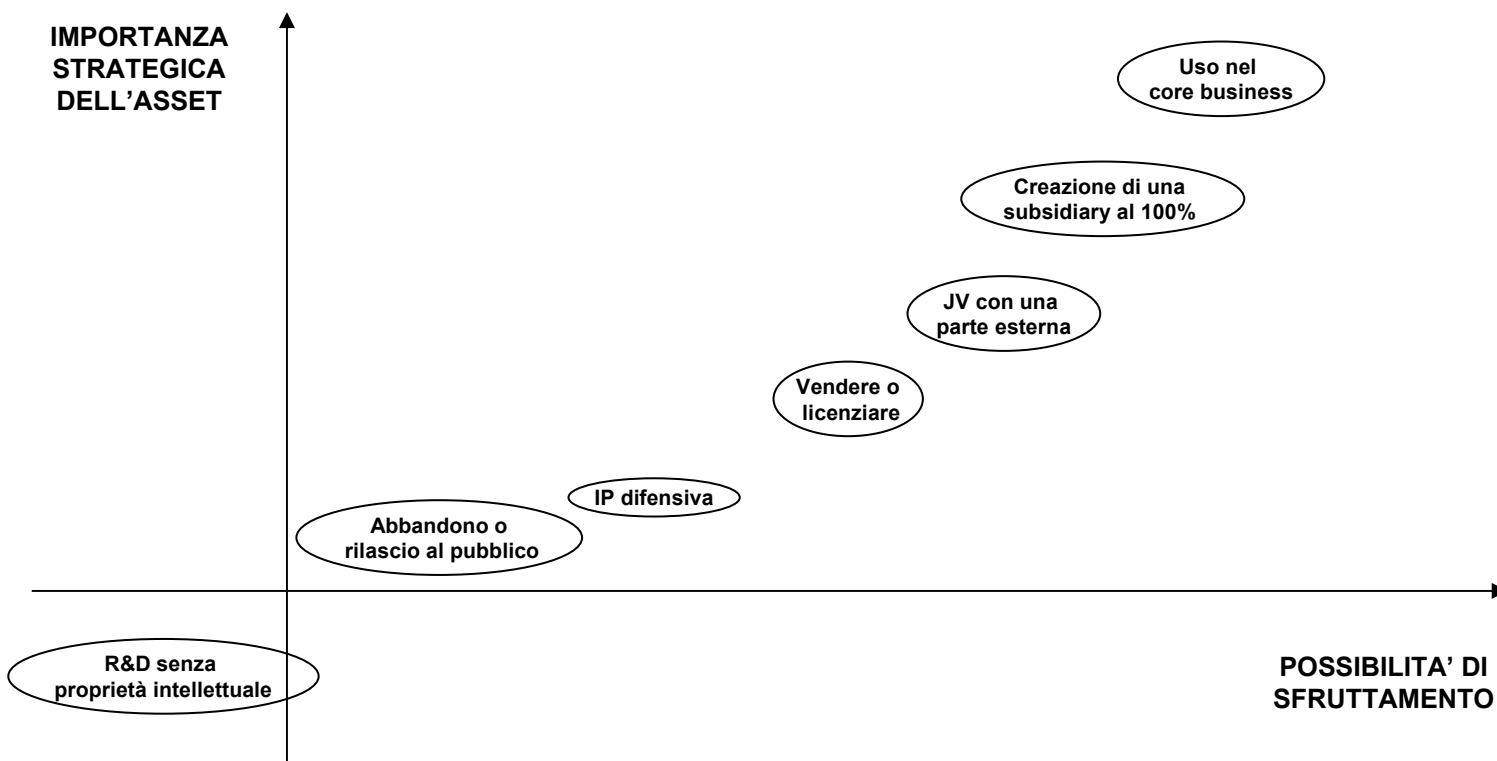


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# TEORIA E PRATICA DEGLI ACCORDI PER IL TRASFERIMENTO TECNOLOGICO

Pavia, 10 giugno 2004

## Vale per le imprese, ma anche per gli EPR



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10 giugno 2004

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- 1. DEFINIRE LA STRATEGIA DI SFRUTTAMENTO E DI CONTENZIOSO.**
- 2. EFFETTUARE DUE DILIGENCE ATTIVA E PASSIVA (DETERMINARE FoO).**
- 3. DETERMINARE REGIME CIRCOLATORIO SULLA BASE DELLE FONTI DI FINANZIAMENTO (vale per gli EPR).**
- 4. CONCEDERE OPZIONI, SE NECESSARIO O OPPORTUNO.**
- 5. COMPLETARE UNA CHECKLIST**
- 6. ANDARE AL NEGOZIATO**

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# UNA CHECKLIST PER ACCORDI DI TRASFERIMENTO TECNOLOGICO

## 1. Introductory Clause

- Effective Date

*(Date from which the Agreement becomes binding on the Parties. Can be substantially different from the date the Agreement is executed by the Parties.)*

- Parties

*(Think about whether definitions should include subsidiaries, parents, sister companies, companies who may acquire or merge with one of the Parties.)*

- Licensor
- Licensee

## 2. Recitals

- Purpose of Agreement

*(This may seem like a basic recital. Lawyers often give it short shrift. But this is an opportunity to craft in writing the intent of the parties. Don't neglect it .)*

- Facts leading up to the Agreement
- What Licensor Owns
- What Licensee Desires

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## 3. Definitions

- Field of Agreement  
(*Territorial restrictions, restrictions on type of products or use or markets.*)
- Licensed Process or Product
- Know How or Technical Information
- Subsidiaries
- Existing
- After Acquired
- Licensed Patents
- Guillotine at end of term
- Broad enough to cover divisionals, Continuations, etc.

## 4. Grant of Rights

- Bounds of license: time, space, scope.
- Exclusive or Nonexclusive or Sole
- Make Use or Sell or Have Made
- Sublicense
- Competitors of customer/licensee may enjoy benefits of license to supplier without giving up any patent rights

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## 4-bis. Grant of Rights (Cont'd)

- Revocable or Irrevocable
- Transferable or Non Transferable
- Grant Back

- Improvements

*(Who has the right to improvements, including rights to file and prosecute patents, ownership of trade secrets, derivative works.)*

- Patent only and/or Know How

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## 5. Technical Information (Know-How)

- How and when will Technical Information be provided to licensee  
*(May intersect with Confidentiality obligations; format in which technical information is provided or kept may create security concerns.)*
- Territorial and product limitations on use of information
- Confidentiality obligations
- Right to use Technical Information of Licensee and right to make such Technical Information available to Affiliates, contractors and licensees, all without accounting to Licensee

## 6. Technology Exchange

- Transfer of Information and Improvement Information
- Period of Exchange
- Right to Use Improvement Information

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## 7. Technical Assistance

- Who Will Provide the Assistance

*(Consider identification of specific employees or departments.)*

- Costs of the Assistance and Expenses Incurred Therein

*(Who bears the burden; these can be significant; consider dividing them up according to which party benefits most from the assistance that incurs the cost.)*

## 8. Technology License Restrictions

- Tainting of technical resources
- Tainting of technology pool/designs
- Obligations to segregate designs and technology

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## 9. Confidentiality

- Nondisclosure

*(Make sure the term here is at least as strict as your company's stand-alone nondisclosure agreement ["NDA"]. Consider physical restrictions on where technical information is kept and how maintained, consider limitations on number of, or requirement for listing of, personnel with access to information.)*

- Limited Use

*(Define scope of use to maintain control over technical information.)*

- Third Party Contractors

*(Require that third party contractors also sign NDAs; require procedures for identification of and/or consent to particular third party contractors.)*

- E.U. Export Limitations

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## 10. Consideration

- In kind consideration (*tech transfer creates positive externalities*)
- Lump Sum Paid Up Royalty (*don't guess!!!*)
- Running Royalty (*don't guess!!!*)
- Minimum Royalty (*don't guess!!!*)
- Cross License
- Currency (*may be really important*)
- Reimbursement of patent fees
- Taxes and Other Charges (*Consider carefully litigation expenses*)  
(*International taxes may be substantial and may apply in a variety of circumstances; consider who shoulders royalty or withholding taxes.*)

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## 11. Reporting and Payment

- To Whom Payments are to be Made
- Right of Audit
- Method of Payment
- Royalty Reports
- How much information is really needed?
- Obligation to furnish reports
- Periodic Reporting

*(Can be costly and burdensome for licensee; consider ways to reduce burden and cost)*

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## 12. Audits

- Who will conduct audit
- Who will pay for audit, under which conditions
- What are the ground rules for conducting audit

## 13. Performance Warranties/Guarantees

- Licensee Responsibilities
- Licensor Responsibilities (Waivers)
- Test Run Procedure
- Remedies

*(Minimally indemnification in case of breach.)*

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## 14. Liability Indemnification and Insurance

- Division of Liability and Indemnification between Parties

*(Licensor to indemnify for use of licensed product, process; licensee to indemnify for use of finished good, mutual indemnification for breach of representations and warranties.)*

- Insurance Requirements
- Consider final products liability towards consumers
- Patent Indemnities (Complete or Partial)
- Obligation to defend/notify of claim *(define who leads litigations strategies and who pays what)*
- Obligation to pay damages and royalties
- Obligation to replace product if license can't be obtained

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## 15. Term, Termination and Default

- Duration of License
- Default, Termination if Uncured After Notice
- Effect of Termination on Some Obligations
- Payment and Confidentiality

*(Confidentiality obligations typically remain in place despite termination of agreement)*

- Bankruptcy Considerations (!!!!!!!)

*(Outcome should either party declare bankruptcy; reversion of license in case of licensee; continuation of license in case of licensor. This issue is dramatically important in case of license to start up or spin off companies as bankruptcy can jeopardize your patent rights).*

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## 16. General

- Assignment

*(Think about whether the license agreement is entered because of the particular reputation, capabilities or experience of the licensee; restriction of assignment may be appropriate; consider also restriction of assignment if assignment is to successor who may also be competitor of licensor.)*

- Governing Law/Choice of Law
- Venue
- Arbitration/Litigation

*(Consider costs of arbitration; who pays attorneys fees; how arbitrator is to be selected; whether arbitration is binding.)*

- Amendments
- Waivers
- Severability
- Force Majeure (1)
- Governmental Approval (2) or Regulation (3) (*jus superveniens*)

*(For all three of the above, provide for outcome if the license agreement is invalidated or restricted, whether by a court, governmental agency or externalities.)*

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- Entire Agreement

*(Typical contract term providing for integration of agreement.)*

- Notices

*(Typical contract term identifying persons or departments for each party who are to be provided any notices under the license agreement.)*

- Export Regulations

- Counterparts

*(Typical contract term providing that the license agreement may be executed in subparts.)*

- Independent Contractor

- Titles/Headings

*(Typical contract term providing that titles and headings should not be construed as substantive.)*

- Authorization of Signers

*(Representation that persons signing for the parties are authorized to do so.)*

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## 17. Trademark Considerations

- License to OEM supplier

*(Licensee will want to ensure these rights.)*

- Indemnification for infringement of 3rd party marks
- Restrictions concerning use of third party marks in advertising materials

## 18. Copyright License Issues

- Source Code Escrow
- Rights to implement/use software

*(If licensee is allowed to modify software, must consider creation and ownership of derivative works and licenses pertaining to those works.)*

- Grant back of patent license
- Right to grant sublicenses

*(Required with regards to licensee's end-users, if any; but distinguish between sublicenses to end-users vs. other types of competitive sublicenses.)*

- Does license include future versions/releases

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**GRAZIE**

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