



DELIVERING STRATEGIC SOLUTIONS ACCA'S 2000 ANNUAL MEETING

ACCA CONFERENCE 2000

STRATEGICALLY LICENSING YOUR COMPANY'S IP ASSETS

OUTLINE/CHECKLIST

Types of IP to License

- Patent
- Trademark
- Copyright
- Technology/Know-how/trade secrets

To Whom (Factors to Consider)

- Expertise/experience
- Reputation
- Financial capacity
- Commercialization
- Competitive position
- Benefits

To What Extent

- Exclusivity vs. non-exclusivity
- Territory
- Category
- Term

Compensation

- Up-front payments
- Royalties
- Valuation
- Non-monetary compensation

Managing Licensing Relationships

- Royalty collection
- Quality monitoring
- Responsibilities
- Compliance

Risks/Pitfalls

- Control
- Franchise issues
- Hidden dangers

Other Issues

LICENSE AGREEMENT MODEL — SAMPLE BASIC PROVISIONS

1. Definitions
2. Grant of License
 - a. Licensed Intellectual Property
 - b. Permissible uses and scope of license
 - c. Licensed Products
 - d. Territory
 - e. Media
 - f. Category
 - g. Term and option terms
 - h. Exclusivity
 - i. Reservation of Rights
 - j. Rights and ownership in derivative works
1. Compensation
 - a. Fees
 - b. Royalty Payments
 - c. Minimums and guarantees
 - d. Audit Rights
 - e. Reporting requirements
1. Intellectual Property
 - a. Rights and ownership
 - b. Protection and maintenance
 - c. IP attribution and notices
1. Quality Control
 - a. Use of IP
 - b. Quality Control Standards
 - c. Notices
 - d. Inspection Procedures
 - e. Approval provisions
1. Obligations of Parties
2. Right to Sublicense
3. Confidentiality

4. Representations and Warranties

- a. Warranty of title/non-infringement
- b. Policing of third party infringements

1. Indemnification and Insurance

2. Termination

- a. Termination for Breach
- b. Termination for Failure to Meet Minimum Royalties
- c. Effect of Termination

1. Remedies

2. Miscellaneous Provisions

- a. Assignment
- b. Notices
- c. Waiver
- d. Survival of Provisions
- e. Entire Agreement
- f. Severability
- g. Choice of Law
- h. Counterparts

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