Volume 1

PART I. INTRODUCTION

CHAPTER 1. OVERVIEW

§ 1:1	Introduction
§ 1:2	Business uses of intellectual property rights—
	Importance of intellectual property rights to the firm
§ 1:3	—Value and uses of intellectual property rights
§ 1:4	Technology transfers and business strategy
§ 1:5	Business uses of intellectual property rights—
	Technology transfers and business strategy—
_	Technology transfers
§ 1:6	——Basic technology transfer arrangements
§ 1:7	——Technology-based strategic alliances
§ 1:8	General considerations in negotiating technology transfers
§ 1:9	—Confidentiality and nondisclosure agreements
§ 1:10	—Due diligence investigation
§ 1:11	—Substantive terms of the transaction
§ 1:12	—Representations and warranties
§ 1:13	—Legal and regulatory considerations
§ 1:14	—Covenants and closing conditions
§ 1:15	Forms of technology-based transactions—Introduction
§ 1:16	—Licensing Arrangements
§ 1:17	—Research and development arrangements
§ 1:18	—Purchasing and manufacturing arrangements
§ 1:19	—Distribution arrangements
§ 1:20	—Joint venture arrangements
§ 1:21	—Investment transactions
§ 1:22	—Alternative methods for funding research and development
§ 1:23	Considerations in selecting technology partners— Locating potential technology partners
§ 1:24	—Evaluating potential licensing partners
§ 1:25	—Evaluating potential investment partners
§ 1:26	—Evaluating potential joint venture partners

§ 1:27 —Relative size of the potential partner

II. CHECKLISTS

§ 1:28 Considerations in selecting technology partners— Checklist: Interviewing prospective technology partners

PART II. INTELLECTUAL PROPERTY RIGHTS

CHAPTER 2. INTELLECTUAL PROPERTY IN THE GLOBAL MARKETPLACE

§ 2:1	Types of intellectual property rights
§ 2:2	
§ 2:3	—Trade secrets
§ 2:4	—Copyrights
§ 2:5	—Trademarks
§ 2:6	—Special types of intellectual property rights
§ 2:7	Summary comparison of intellectual property rights
§ 2:8	—Protectable subject matter
§ 2:9	—Standards for obtaining protection
§ 2:10	—Perfecting intellectual property rights
§ 2:11	—Rights of intellectual property owners
§ 2:12	Differences among international intellectual property
	laws
§ 2:13	—Patent laws
§ 2:14	1 1
§ 2:15	——Term of protection
§ 2:16	——Working requirements
§ 2:17	— —Enforcement
§ 2:18	—Trade secret laws
§ 2:19	——Scope of protectable subject matter
§ 2:20	— — Trade secrets and the employment relationship
§ 2:21	——Duration of trade secret protection
§ 2:22	——Rights against third parties
§ 2:23	—Copyright laws
§ 2:24	——Eligible works and media forms
§ 2:25	——Limitations on exclusive rights
§ 2:26	— —Term of protection
§ 2:27	Enforcement
§ 2:28	—Trademark laws
§ 2:29	——Registration policies

--Use requirements § 2:30 § 2:31 ——Compulsory licensing § 2:32 ——Licensing restrictions — Enforcement § 2:33 § 2:34 —Semiconductor chip designs § 2:35 —International registration of industrial designs § 2:36 —Other examples of intellectual property rights § 2:37 International intellectual property conventions § 2:38 —Paris convention § 2:39 —Berne convention § 2:40 —Universal Copyright Convention § 2:41 —Madrid Agreement § 2:42 Executive summary for clients regarding intellectual property rights in the global marketplace

CHAPTER 3. U.S. PATENT LAW AND PRACTICE

§ 3:1	Introduction
§ 3:2	Patent risk assessment
§ 3:3	—Industry climate
§ 3:4	—Technical sophistication
§ 3:5	—Competition
§ 3:6	—Development difficulties
§ 3:7	—Availability of alternative forms of protection
§ 3:8	Protecting patentability rights
§ 3:9	—Employee invention agreements
§ 3:10	—Invention development record
§ 3:11	—Joint development agreements
§ 3:12	—Invention disclosures
§ 3:13	—Evaluation of invention disclosures
§ 3:14	—Patentability search
§ 3:15	—Public disclosure or use
§ 3:16	Selecting patent counsel
§ 3:17	Requirements for patentability
§ 3:18	—Patentable subject matter
§ 3:19	—Utility
§ 3:20	—Novelty
§ 3:21	—Nonobviousness
§ 3:22	—Inventorship
§ 3:23	Patent applications
§ 3:24	—Oath or declaration

TECHNOLOGY MGMT & TRANSACTIONS

§ 3:25	—Specification
\$ 3:26	— —Background
§ 3:27	— —Summary
\$ 3:28	——Preferred embodiment
§ 3:29	— —Claims
§ 3:30	— —Information Disclosure Statement
§ 3:31	—Drawings
§ 3:32	—Filing fees
§ 3:33	—Provisional applications
§ 3:34	—Review and examination
§ 3:35	 — Initial rejections and objections
§ 3:36	 —Responses to initial rejections and objections
§ 3:37	— —Examiner's reconsideration
§ 3:38	— —Final rejection
§ 3:39	——Appeal from final rejection
3:40	——Accelerated examination procedures
3:41	— Reissue patent applications
§ 3:42	——Certificate of correction
\$ 3:43	——Reexamination of issued patents
\$ 3:44	Strategic uses of patent rights
\$ 3:45	—Financing
\$ 3:46	—Patent enforcement
§ 3:47	—Licensing
\$ 3:48	—Capital contribution
§ 3:49	Infringement of patent rights
\$ 3:50	—Direct infringement
\$ 3:51	—Indirect infringement
\$ 3:52	—Burden of proof
\$ 3:53	—Defenses
\$ 3:54	—Injunctive relief
3:55	—Damages
3:56	—Unfair import investigations by the International
,	Trade Commission
§ 3:57	Software patents
II. I	FORMS
§ 3:58	Invention disclosure form
3:59	Patent perfection and protection procedures
	questionnaire
§ 3:60	Patent rights assignment
§ 3:61	Executive summary for clients regarding U.S. patent law and practice

CHAPTER 4. U.S. COPYRIGHT LAW AND PRACTICE

§ 4:1	Introduction
§ 4:2	Protectable works
§ 4:3	—Works of authorship
§ 4:4	—Originality requirement
§ 4:5	—Tangible medium of expression requirement
§ 4:6	Ownership of copyrights
§ 4:7	—Works made for hire
§ 4:8	—Joint authorship
§ 4:9	Creation of copyright rights
§ 4:10	—Copyright registration
§ 4:11	——Advantages of registration
§ 4:12	——Persons entitled to file for registration
§ 4:13	——Registration elements
§ 4:14	— — Application forms
§ 4:15	——Deposit requirements
§ 4:16	— — Effective date of registration
§ 4:17	——Renewal of registration
§ 4:18	——Online works
§ 4:19	—Copyright notices
§ 4:20	Fundamental rights of the copyright owner
§ 4:21	Moral rights of the copyright holders
§ 4:22	Fundamental rights of the copyright owner—Transfers
	of copyright ownership
§ 4:23	—Assignments and termination rights
§ 4:24	—Duration of copyright protection
§ 4:25	Infringement of copyright rights
§ 4:26	—Proof of infringement
§ 4:27	—Contributory infringement
§ 4:28	—Doctrine of fair use
§ 4:29	—Avoiding third-party infringement claims
§ 4:30	—Damages—Actual damages
§ 4:31	——Statutory damages
§ 4:32	— —Attorneys' fees
§ 4:33	——Injunctive relief
§ 4:34	—Criminal penalties
§ 4:35	-Recording copyrights with U.S. Customs and Border
5	Protection Protection
§ 4:36	Semiconductor chips
§ 4:37	Computer software
	_

Technology Mgmt & Transactions

§ 4:38 —Preexisting works § 4:39 —Functional constraints § 4:40 —Substantial similarity test § 4:41 —Degree of protection § 4:42 -Authorized copies and adaptation § 4:43 —Fair use doctrine and reverse engineering § 4:44 Copyright law and the internet § 4:45 —Uploaded content and system caching § 4:46 —Print or CD works § 4:47 —Linking and framing —Digital Millennium Copyright Act § 4:48 § 4:49 — — Duties of service providers ——Safe harbor provisions § 4:50 § 4:51 ———System storage and information locating tools ———System caching § 4:52 ———Transmission and routing § 4:53 — Notice and take-down provisions § 4:54 ——Copyright management information and security § 4:55 measures

II. FORMS

- § 4:56 Assignment of copyright
- § 4:57 Copyright license
- § 4:58 Copyrightable works policy
- § 4:59 Employee agreement for copyrightable works policy
- § 4:60 Policy of university with respect to copyrightable materials

Appendix 4A. Copyright Basics

CHAPTER 5. U.S. TRADE SECRETS LAW AND PRACTICE

- § 5:1 Overview
- § 5:2 General definitions of trade secrets
- § 5:3 —Restatement of Torts
- § 5:4 —Uniform Act
- § 5:5 —State legislation and decisions
- § 5:6 —Other trade secret definitions
- § 5:7 Eligible subject matter
- § 5:8 General definitions of trade secrets—Processes, methods, machines and devices
- § 5:9 —Business information
- § 5:10 —Customer lists
- § 5:11 —Submitted ideas

§ 5:12	—Computer software programs
§ 5:13	—General business knowledge
§ 5:14	—Nonsecret information
§ 5:15	Secrecy requirement
§ 5:16	Generally known outside of business
§ 5:17	Security measures
§ 5:18	Acquisition or duplication by proper means
§ 5:19	Memorializing protection program in formal writing
§ 5:20	Economic value and use requirements
§ 5:21	Protection of trade secrets in litigation
§ 5:22	Enforcing trade secret rights
§ 5:23	—Acts creating basis for liability
§ 5:24	—Injunctive relief
§ 5:25	—Damages
§ 5:26	—Federal statutes and criminal liability
§ 5:27	—State statutes and criminal liability
§ 5:28	Foreign trade secret laws
§ 5:29	Antitrust and competition laws
§ 5:30	Definition of "know-how" for tax purposes
§ 5:31	Tax aspects of licenses and transfers of trade secrets

CHAPTER 6. TRADE SECRET PROTECTION PROGRAMS

§ 6:1	Overview
§ 6:2	Establishing and organizing a trade secret protection
	program
§ 6:3	—Coordinator or committee
§ 6:4	—Initial audit
§ 6:5	—Access restrictions
§ 6:6	—Employee disclosure obligations
§ 6:7	—Third party disclosure procedures
§ 6:8	—Periodic review
§ 6:9	—Policy statements and guidelines
§ 6:10	—Training programs
§ 6:11	Identifying and classifying company business
	information
§ 6:12	—Identifying company business information
§ 6:13	—Classifying company business information
§ 6:14	Physical security measures
§ 6:15	—Controlling access to trade secret information
§ 6:16	—Use of confidentiality legends and special markings
§ 6:17	—Restricting copying of sensitive information

§	6:18	—Physical security of facilities
§	6:19	—Restricting visitor access to trade secret information
§	6:20	—Transferring trade secret information
§	6:21	—Document destruction procedures
§	6:22	—Protection of trade secret information on computers
§	6:23	—Special measures for highly sensitive information
§	6:24	—Other physical security measures
§	6:25	Protection of trade secrets in the employment relationship
§	6:26	—Informing employees of protection obligations
§	6:27	—New employees and trade secrets of prior employers
§	6:28	—Confidentiality and assignment of inventions agreements
§	6:29	—Non-competition agreements
§	6:30	—Exit interviews
§	6:31	—Post-employment notices to employees and new employers
§	6:32	—Employee departures and physical security measures
§	6:33	Review of public disclosures
§	6:34	Protection of trade secrets obtained from third parties
§	6:35	Protection against disclosure by third parties
§	6:36	—Pre-disclosure investigation
§	6:37	—Content of nondisclosure agreements
§	6:38	—Confidentiality provisions in standard contracts
§	6:39	—Disclosure of trade secrets to federal agencies
Ι	I. C	HECKLISTS
§	6:40	Checklist for protecting trade secrets
§	6:41	Checklist for designing and implementing a trade secret protection program
I	II. F	CORMS
§	6:42	Guide to the protection of trade secrets
	6:43	Statement of trade secret security program
-	6:44	Memorandum to employees regarding importance of protecting the company's proprietary information
§	6:45	Employee's acknowledgment of employer's trade secret program $% \left(1\right) =\left(1\right) \left(1\right)$
§	6:46	Executive summary for clients regarding trade secret protection program

CHAPTER 7. CONFIDENTIALITY AND NONDISCLOSURE AGREEMENTS

	7:1	Background; Requirements for trade secret protection
§	7:2	Validity and enforceability of confidentiality agreements
8	7:3	—Implied duties to protect confidential information
	7:4	—Contractual nondisclosure obligations
	7:5	—Advantages of express contracts
	7:6	—Disadvantages of express contracts
	7:7	Elements of confidentiality agreements—Definitions of
0	•••	confidential information
8	7:8	— —General definitions
	7:9	——Detailed listing of general classes of information
_	7:10	——Specific listing of covered information
_	7:11	——Information identified by disclosing party
_	7:12	——Combination method
_	7:13	——Information requested by receiving party
_	7:14	——Information derived from observation or
o		inspection
8	7:15	— Form of embodiment of confidential information
	7:16	— — Acknowledgement of confidentiality
_	7:17	——Procedures for identifying confidential
Ŭ		information
§	7:18	—Exclusions
§	7:19	——"Already known" information
§	7:20	——"Independently developed" information
§	7:21	— —Information disclosed without violating agreement
§	7:22	——Restrictions on disclosures to third parties
§	7:23	— —Information subsequently disclosed to others
§	7:24	—Obligations of receiving party
§	7:25	——Precautions to prevent disclosures
§	7:26	——Standard of care
§	7:27	——Permitted disclosures
§	7:28	——Required disclosures
§	7:29	——Activities of receiving party
§	7:30	— —Limits on receiving party's liability
§	7:31	— — Return of confidential information
§	7:32	Types of confidentiality/nondisclosure agreements
§	7:33	General confidentiality agreements—Unilateral
_		agreement
§	7:34	—Mutual agreement
	7:35	—Review of secret process

§ 7:3	6 —Negotiation of potential business venture
§ 7:8	7 Customer and vendor nondisclosure agreements— Disclosure of confidential information to customers
§ 7:3	8 —Receipt of confidential information from customers
§ 7:3	9 —Nondisclosure by vendor
§ 7:4	O Joint development agreements—Joint venture nondisclosure agreement
§ 7:4	 —Joint product research and development arrangement
§ 7:4	2 —Confidential data exchange agreements
§ 7:4	3 New product idea agreements—Unsolicited idea agreements
§ 7:4	4 —New product idea review agreements
§ 7:4	5 Investment relationship agreements—Corporate partnering agreement
§ 7:4	6 —Agreement for delivery of information to corporate investors
§ 7:4	7 —Corporate partnering agreement—Private investor nondisclosure agreement
§ 7:4	8 Acquisitions
§ 7:4	9 Confidentiality provisions in standard contracts
§ 7:5	0 —License agreements
§ 7:5	1 —Product design agreements
§ 7:5	
§ 7:5	1 9
§ 7:5	4 —Government contracts
§ 7:5	5 Employment relationships
§ 7:5	3
§ 7:5	7 Formal termination of nondisclosure agreements
II.	FORMS
§ 7:5	8 Confidentiality/nondisclosure agreement
§ 7:6	į e
§ 7:6	8 8
_	agreement
§ 7:6	1
§ 7:6	3 Mutual non-disclosure agreement—Template for customized description of nature and scope of disclosures
§ 7:6	4 Idea submission agreement
§ 7:6	5 Mutual nondisclosure agreement—Public companies

CHAPTER 8. U.S. TRADEMARK LAW AND PRACTICE

§ 8:1	Introduction
§ 8:2	Governing law—Federal trademark statutes and regulations
§ 8:3	—State statutes and common law
§ 8:4	General requirements for protection—Use requirement
§ 8:5	—Distinctiveness requirement
§ 8:6	— —Fanciful and arbitrary marks
§ 8:7	——Suggestive marks
§ 8:8	——Descriptive marks
§ 8:9	— —Generic marks
§ 8:10	—Trademark notices
§ 8:11	Clearing a mark for use
§ 8:12	Trademark registration
§ 8:13	—Application procedures—Applicants
§ 8:14	— —Filing requirements
§ 8:15	———Drawing
§ 8:16	———Fees
§ 8:17	———Specimens
§ 8:18	— — — Additional requirements for intent-to-use
3 0.10	applications
§ 8:19	———Where to send the application and
	correspondence
§ 8:20	—Application review
§ 8:21	Scope of trademark rights
§ 8:22	Maintenance and duration of trademark registration
§ 8:23	—Declaration of continued use
§ 8:24	—Declaration of incontestability
§ 8:25	—Renewals
§ 8:26	Recording trademark rights with U.S. Customs and Board Protection
§ 8:27	Trademark infringement
§ 8:28	Trade dress protection
§ 8:29	False advertising
§ 8:30	Trademark dilution
§ 8:31	Trademark law and the internet
§ 8:32	—Domain names and trademark infringement
§ 8:33	—Domain name registration
§ 8:34	Trademark management and protection programs
§ 8:35	Trademark licenses and assignments
§ 8:36	Trademark-related policies and procedures

II. FORMS

§ 8:37	Assignment of trademark
§ 8:38	Trademark license agreement—General form
§ 8:39	—Foreign licensing rights
§ 8:40	—Investment advisory relationship
§ 8:41	Executive summary for clients regarding U.S.
	trademark law and practice
§ 8:42	Trademark use policy
§ 8:43	Trademark and logo usage guidelines
§ 8:44	General trademark guidelines

Protecting Your Trademark: Enhancing Your Rights through Federal Registration Appendix 8A.

CHAPTER 9. INTELLECTUAL PROPERTY IN THE EMPLOYMENT RELATIONSHIP

§ 9:1	Overview
§ 9:2	Employee duties to protect confidential information and trade secrets
§ 9:3	Ownership and assignment of employee innovations
§ 9:4	Form and content of confidentiality and innovation assignment agreement
§ 9:5	—Identification and protection of confidential information
§ 9:6	—Prior knowledge and relationships
§ 9:7	—Disclosure and assignment of employee innovations
§ 9:8	—Conflicting employment and activities
§ 9:9	—Termination of employment
§ 9:10	Agreements restricting competitive activities of employees
§ 9:11	Employee interview checklist and statement
§ 9:12	Employee exit interview worksheet
§ 9:13	Post-employment letters
§ 9:14	Employees who will not sign
II F	ORMS

§ 9:15	Proprietary information and inventions agreement
§ 9:16	Employee statement
§ 9:17	Employee exit interview worksheet
§ 9:18	Termination certificate
§ 9:19	Letter to terminated employee

- § 9:20 Employee confidential information and invention assignment agreement with conflict of interest guidelines and covenants on security and use of open source software
- § 9:21 Employment offer letter and employee confidentiality, non-solicitation and assignment of creative works agreement

CHAPTER 10. INTELLECTUAL PROPERTY STRATEGY

- § 10:1 Introduction
- § 10:2 Identification of business goals and objectives
- § 10:3 Identification of the company's intellectual property rights
- § 10:4 Valuation of the company's intellectual property rights
- § 10:5 Understanding the competitive landscape
- § 10:6 Formulation of the intellectual property rights strategy
- § 10:7 Implementation of the intellectual property rights strategy
- § 10:8 Role of board of directors in intellectual property rights strategy

CHAPTER 11. INTELLECTUAL PROPERTY COMPLIANCE PROGRAMS AND MANUALS

- § 11:1 Introduction
- § 11:2 Preliminary issues and considerations
- § 11:3 Participants in the design and implementation of compliance program
- § 11:4 —Legal department
- § 11:5 —Board of directors and senior management
- § 11:6 —Technical groups
- § 11:7 —Business units
- § 11:8 —Sales and marketing
- § 11:9 —Information services
- § 11:10 —Personnel
- § 11:11 —Other departments
- § 11:12 Intellectual property compliance committee
- § 11:13 Intellectual property audits
- § 11:14 Intellectual property policies and procedures
- § 11:15 Intellectual property compliance manual
- § 11:16 Training programs

II. FORMS

- § 11:17 Instructions for preparing an intellectual property compliance manual
 § 11:18 Technology hardware purchasing policy
 § 11:19 Computer and telecommunications resources use policy
- § 11:20 Software use policy
- § 11:21 Artificial intelligence ("AI") usage policy

PART III. TECHNOLOGY MANAGEMENT AND DEVELOPMENT

CHAPTER 12. TECHNOLOGY MANAGEMENT

§ 12:1	Scope and challenges of managing emerging
6 10 0	technologies—Definition of emerging technologies
§ 12:2	—Distinguishing challenges of emerging technologies
§ 12:3	—Emerging technologies and established companies
§ 12:4	Strategic aspects of technology management
§ 12:5	—Competitive advantages of technology
§ 12:6	—Technology-based definition of the company's business portfolio
§ 12:7	—Developing the technology strategy
§ 12:8	—Implementing and monitoring the technology
0.10.0	strategy
§ 12:9	Management responsibility for technology activities
§ 12:10	—Creating the technology strategy
§ 12:11	—Planning and coordinating research and
	development activities
§ 12:12	Scope and practice of technology management
§ 12:13	Technology forecasting
§ 12:14	—Technology monitoring and expert opinions
§ 12:15	—Trend analysis
§ 12:16	—Scenario planning
§ 12:17	—Predicting the rate of diffusion of emerging
	technologies
§ 12:18	Technology selection
§ 12:19	—Technology scanning
§ 12:20	—Evaluation and selection

§ 12:21	Methods for acquisition of new technologies
§ 12:22	Internal research and development
§ 12:23	—Categories of research and development activities
§ 12:24	—General strategic considerations
§ 12:25	—Measuring research and development productivity and performance
§ 12:26	——Productivity measures
§ 12:27	— Evaluation based on benefits to the organization
§ 12:28	—Organizational structure
§ 12:29	Inbound technology transfer
§ 12:30	—Contract research and development arrangements
§ 12:31	—Purchasing and licensing arrangements
§ 12:32	—Joint development arrangements
§ 12:33	—Joint ventures and strategic alliances
§ 12:34	—Advantages of technology outsourcing
§ 12:35	—Identifying and evaluating technology outsourcing opportunities
§ 12:36	Exploitation strategies
§ 12:37	Appropriating and protecting the advantages of technologies
§ 12:38	—Statutory intellectual property rights
§ 12:39	—Trade secrets
§ 12:40	—Complementary assets
§ 12:41	—Lead time
§ 12:42	Knowledge management

II. FORMS

- § 12:43 Executive summary for clients regarding technology management
- § 12:44 Interim chief technology officer agreement
- § 12:45 Technology hardware purchasing policy

CHAPTER 13. RESEARCH AND DEVELOPMENT

- § 13:1 Scope of research and development activities
 § 13:2 —Models of research and development activities
 § 13:3 —Initial research and development activities by emerging companies
 § 13:4 —Performing contract research and development for outside parties
- § 13:5 —Outsourcing research and development activities
- § 13:6 Strategic planning for research and development
- § 13:7 —Research and development portfolio analysis
- § 13:8 —Budgeting

§ 13:9	—Measuring productivity and performance
§ 13:10	Management of research and development activities
§ 13:11	Organizing research and development activities
§ 13:12	Policies and procedures
§ 13:13	—Intellectual and tangible property rights policies
§ 13:14	—Invention disclosure forms
§ 13:15	—Intellectual and tangible property assignment
Ü	agreements
§ 13:16	—Conflicts of interest policies
§ 13:17	—Consulting policies and agreements
§ 13:18	—Policies and agreements to protect confidential
	information
§ 13:19	Processes for internal technology transfer
§ 13:20	Management of internal research and development
	projects
§ 13:21	—Scope and content of research program
§ 13:22	——Field of activity
§ 13:23	——Program goals and objectives
§ 13:24	——Content of research program
§ 13:25	——Duration and completion
§ 13:26	—Research budget
§ 13:27	—Staffing
§ 13:28	—Management procedures
§ 13:29	Management of technology development projects
§ 13:30	Management of outsourcing arrangements
§ 13:31	—Identification and selection of outsourcing partners
§ 13:32	——Protection of intellectual property rights
§ 13:33	——Scheduling
§ 13:34	——Technical and scientific background and
8 19.95	expertise
§ 13:35	— — Quality controls
§ 13:36	— — Technology transfer and technical assistance
§ 13:37	——Reputation and reliability
§ 13:38	—Terms and conditions of research and development
	agreements
СНАР	TER 14. PRODUCT DEVELOPMENT
	Introduction
§ 14:1 § 14:2	The new product development process
§ 14:3	Strategic planning for new products
§ 14:4	Product development strategies for technology-based
2 14.4	organizations
§ 14:5	—Dominant sector strategy
§ 14:6	—Product group specialist strategy
§ 14:7	—Market specialist strategy
	· 00

TABLE OF CONTENTS

§ 14:8	—Technology specialist strategy
§ 14:9	Organizational structure for new product
	development
§ 14:10	—Function-based new product specialist approach
§ 14:11	—Fraternal approach
§ 14:12	—Entrepreneurial approach
§ 14:13	—Impact of structure on success of development
	projects
§ 14:14	—Managing functional boundaries
§ 14:15	Identification and selection of new product
	opportunities
§ 14:16	Concept generation
§ 14:17	Concept evaluation and testing
§ 14:18	—Initial evaluation
§ 14:19	—Feasibility study
§ 14:20	—Concept testing
§ 14:21	—Full screen
§ 14:22	—Financial analysis
§ 14:23	—Product definitions and protocols
§ 14:24	Development stage
§ 14:25	—Development team management
§ 14:26	——Organizational structure of new product
0 1 4 0 5	development teams
§ 14:27	——Selection of team members
§ 14:28	——Team management
§ 14:29	—Design
§ 14:30	—Product use testing
§ 14:31	—Marketing plan
§ 14:32	Launch
§ 14:33	—Launch planning
§ 14:34	—Launch management
§ 14:35	—Activities and schedules
§ 14:36	—Product announcement strategies
§ 14:37	—Reseller motivation strategies
§ 14:38	—Market testing
§ 14:39	—Internal marketing activities
§ 14:40	Product development problems
§ 14:41	—Delayed product development
§ 14:42	—Premature product launch
§ 14:43	—Accelerated product development schedules
§ 14:44	Product development for global markets
§ 14:45	Development of new services
§ 14:46	Evaluating the new product development program
§ 14:47	Conclusion: Conditions for successful product development

CHAPTER 15. FINANCING RESEARCH AND DEVELOPMENT

§ 15:1	Introduction
§ 15:2	R&D partnerships and special purpose companies
§ 15:3	—Royalty/warrants structure
§ 15:4	— —Formation of limited partnership
§ 15:5	——Research agreement
§ 15:6	— Joint venture arrangement
§ 15:7	——Purchase of limited partnership's joint venture interest
§ 15:8	— — Warrants to purchase sponsoring corporation's
, 10.0	stock
§ 15:9	— —General terms of business relationship
§ 15:10	—Equity structure
§ 15:11	— —Formation of limited partnership
§ 15:12	——Conversion of limited partnership to corporate
	form
§ 15:13	 — Management and operation of successor corporation
§ 15:14	—Joint venture structure
§ 15:15	"SWORDs"
§ 15:16	Strategic alliances
§ 15:17	—Types of strategic alliances
§ 15:18	—Advantages and risks of strategic alliances
§ 15:19	—Procedures for establishing strategic alliances
§ 15:20	——Preliminary analysis
§ 15:21	— Evaluation and selection of strategic partners
§ 15:22	
§ 15:23	— — Managing strategic alliances
§ 15:24	—Corporate partnering
§ 15:25	—R&D relationships
§ 15:26	—Product development and purchase arrangements
§ 15:27	—Investment relationships
§ 15:28	——Selecting the investment instrument
§ 15:29	— —Terms of convertible preferred stock
§ 15:30	— — Dividends
§ 15:31	— — —Liquidation preference
§ 15:32	
§ 15:33	
§ 15:34	— — —Redemption
§ 15:35	——Agreements and covenants of the junior partner
§ 15:36	———Information rights

§ 15:37	— — —Management participation
§ 15:38	— — Registration rights
§ 15:39	———Right to participate in subsequent financings
§ 15:40	— — —Covenants regarding conduct of business
	activities
§ 15:41	— — —Ancillary agreements
§ 15:42	——Equity investment and funding for R&D
§ 15:43	——Senior partner option to acquire junior partner
§ 15:44	—Negotiated acquisitions

II. FORMS

§ 15:45	Cross license agreement: Research and development partnership
§ 15:46	Development agreement: research and development partnership
§ 15:47	Joint venture and partnership purchase option agreement
§ 15:48	Joint venture agreement: Research and development partnership
§ 15:49	Technology development agreement

CHAPTER 16. UNIVERSITY RESEARCH AND COMMERCIALIZATION ACTIVITIES

§ 16:1	Introduction
§ 16:2	Unique legal and business issues
§ 16:3	—Academic integrity
§ 16:4	—Laws regulating university access to rewards of commercialization
§ 16:5	—Restrictions on academic freedom to publicly release information
§ 16:6	—Role of patent protection
§ 16:7	—Transition to "for-profit" values
§ 16:8	Bayh-Dole Act
§ 16:9	—Requirements for retaining title to federally-funded inventions
§ 16:10	—Retained rights of federal agencies in funded inventions
§ 16:11	—March-in rights
§ 16:12	—Preference to US manufacturing requirements
§ 16:13	—Royalty sharing requirements
§ 16:14	State assistance for research activities

§ 16:15	Organization of university technology development
	activities
§ 16:16	—Corporate development
§ 16:17	—Industrial liaison
§ 16:18	—Sponsored research
§ 16:19	—Technology transfer
§ 16:20	—Consultancy support and other activities
§ 16:21	—Institutional structures
§ 16:22	Internal university intellectual property policies
§ 16:23	Evaluating and commercializing university technologies
§ 16:24	
0	University technology licensing arrangements
§ 16:25	University research arrangements
§ 16:26	Individual consulting agreements with research sponsors
§ 16:27	Other structures for commercializing university technology

II. FORMS

§ 16:28	University research agreement
§ 16:29	University licensing agreement
§ 16:30	University patent and know how license agreemen
§ 16:31	License agreement: University research program
§ 16:32	Clinical trial agreement
§ 16:33	License agreement between not-for-profit developer and manufacturer
§ 16:34	License and product development consultation agreement

CHAPTER 17. GOVERNMENTAL RESEARCH AND DEVELOPMENT AND TECHNOLOGY TRANSFER ACTIVITIES

§ 17:1	Introduction
§ 17:2	The federal government's role in research and development
§ 17:3	The federal government's role in technology transfer
§ 17:4	Transferring federally owned technology by licensing
§ 17:5	Cooperative research and development agreements
§ 17:6	Working with universities and not-for-profit organizations
§ 17:7	Private sector strategies for improving technology transfer—Making contact with a federal laboratory
§ 17:8	—Cultural adaptation in the private sector
§ 17:9	—Learning from large companies

§ 17:10 Federal laboratory strategies for improving technology transfer—Federal laboratory consortium § 17:11 —Protecting intellectual property —Developing good licensing practices § 17:12 § 17:13 —Creating quality CRDAs faster § 17:14 —Accelerating cultural change throughout the federal § 17:15 —Making laboratory inventors accessible § 17:16 —Assessing and marketing laboratory capabilities § 17:17 —Legislation § 17:18 —Avoiding conflict of interest § 17:19 —Copyrighting software created by federal employees —Expanding the federal technology transfer resource § 17:20 base

PART IV. TECHNOLOGY TRANSACTIONS

CHAPTER 18. GENERAL CONSIDERATIONS IN NEGOTIATING TECHNOLOGY TRANSACTIONS

Introduction
Confidentiality and nondisclosure agreements
Substantive terms of the transaction
—Scope of the technology transfer
—Compensation
—Protection of transferred technology
—Technical assistance and training arrangements
—Risk-allocation procedures
Representations and warranties
—Representations for technology transfer
transactions
—Utility of intellectual property rights
—Related representations and warranties
—Qualifications
Domestic legal and regulatory considerations
—Antitrust laws
—Product testing laws and regulations
—Export control laws
——Department of Commerce ("DOC")

Technology Mgmt & Transactions

```
§ 18:19
         — — Definitions
         — — — Controlled transactions
§ 18:20
§ 18:21
         ———Export license applications
§ 18:22
         ——Department of State ("DOS")
§ 18:23
         -- --- Munitions list
         ———Registration requirements
§ 18:24
§ 18:25
         ———License requirements
§ 18:26
         ———Prohibited exports and sales to certain
          countries
         ——Department of Treasury ("DOT")
§ 18:27
§ 18:28
         — —Sanctions for violations
§ 18:29
         — — Multilateral export control regimes
§ 18:30
         — Other U.S. governmental export controls
§ 18:31
         — —Compliance programs
§ 18:32
         —Antiboycott regulations
         —Import laws
§ 18:33
§ 18:34
         —Products liability laws
         —Bankruptcy considerations
§ 18:35
§ 18:36
         Foreign legal and regulatory considerations
§ 18:37
         —Competition laws
         —Regulation of technology transfer arrangements
§ 18:38
§ 18:39
         —Regulation of inbound investment
§ 18:40
         —Agency and distributorship laws
§ 18:41
         —Customs laws and import controls
§ 18:42
         —Product certification standards
§ 18:43
         Covenants
§ 18:44
         —Protection of intellectual property assets
§ 18:45
         —Intellectual property litigation
§ 18:46
         —Future business activities of target company
§ 18:47
         —Subsequent assignments and licenses
§ 18:48
         Remedial actions
§ 18:49
         Legal opinions
         —Types of intellectual property opinions
§ 18:50
§ 18:51
         — —Trade secrets
§ 18:52
         ——Patents
§ 18:53
         --- Trademarks
§ 18:54
         — —Copyrights
         — —Transfers of title
§ 18:55
§ 18:56
         ——Consents and approvals
§ 18:57
         — —Employees and consultants
§ 18:58
         — —Infringement opinions
§ 18:59
         ——Litigation opinions
§ 18:60
         —Form and structure of the legal opinion—Date of
          the opinion
§ 18:61
         ——Scope of investigation
```

§ 18:62	——Assumptions and statement of facts
§ 18:63	<u>-</u>
§ 18:64	Perfecting assignments of intellectual property rights
§ 18:65	—Assignments of statutory rights
§ 18:66	—Assignments of trade secrets and proprietary
	information
§ 18:67	—Assignments of jointly owned intellectual property
§ 18:68	—Assignments of license agreements

II. FORMS

§ 18:69 U.S. export control compliance policy

CHAPTER 19. ANTITRUST AND COMPETITION LAW ASPECTS OF TECHNOLOGY TRANSACTIONS

§ 19:1	Introduction
§ 19:2	Overview of U.S. antitrust laws
§ 19:3	—Rule of reason and per se rule
§ 19:4	—Horizontal and vertical restraints
§ 19:5	—The Sherman Act
§ 19:6	—The Clayton Act
§ 19:7	—The Hart-Scott-Rodino Antitrust Improvements Act
§ 19:8	——Acquisitions of securities or assets
§ 19:9	— —Corporate joint ventures
§ 19:10	— —IP acquisitions and licenses
§ 19:11	 — Non-corporate entities and interests
§ 19:12	— —Procedural considerations
§ 19:13	—The National Cooperative Research and Production
	Act
§ 19:14	
	under U.S. antitrust laws
§ 19:15	—Guiding principles
§ 19:16	
	effects
§ 19:17	1 0
§ 19:18	· · · · · · · · · · · · · · · · · · ·
0.10.10	arrangements
§ 19:19	
§ 19:20	
§ 19:21	—Historical development of antitrust policies
6 10 05	regarding patent licensing arrangements
§ 19:27	· e i
§ 19:28	——Exclusive licensing arrangements
8 10.90	— Torritorial rostrictions

§	19:30	— Field-of-use and customer restrictions
§	19:31	— — Price restrictions
§	19:32	— —Output restrictions
§	19:33	— — Tying and packaging arrangements
_	19:34	— Exclusive dealing arrangements
§	19:35	— —Grant-back provisions
§	19:36	— Royalties
§	19:37	— Restrictions on licensee challenges to patent validity
§	19:38	——Cross-licensing and pooling arrangements
§	19:39	—Analysis and regulation of trade secret licenses
§	19:40	— —Trade secret misappropriation and illegal conspiracies
8	19:41	— —Use of trade secrets and illegal monopolization
-	19:42	—Analysis and regulation of trademark and copyright
Ŭ		licenses
§	19:43	——Analysis and regulation of trademark licenses—
_		Resale pricing provisions
-	19:44	— — —Horizontal restraints
_	19:45	— — — Vertical nonprice restraints
§	19:46	 — Analysis and regulation of copyright licenses— Resale pricing provisions
§	19:47	——Tying arrangements
§	19:48	———Blanket licensing
§	19:49	Regulation of joint ventures and collaborative arrangements under U.S. antitrust laws
Ş	19:50	—Joint ventures
_	19:51	——Analyzing the competitive effects of the joint
Ü		venture
Ş	19:52	——Application of rule of reason analysis
8	19:53	——Collateral agreements
8	19:54	——Spillover effects of joint ventures
-	19:55	— —Bottleneck or essential facilities concerns
-	19:56	—Competitor collaborations guidelines
-	19:57	Extraterritorial application of U.S. antitrust laws
		11

CHAPTER 20. INTELLECTUAL PROPERTY AUDITS

I. BUSINESS AND LEGAL CONSIDERATIONS

A. INTRODUCTION

- § 20:1 Overview
- § 20:2 Identification of the intellectual property rights

TABLE OF CONTENTS

§ 20:3	Ownership
$\S 20:4$	Perfection and protection
§ 20:5	Infringement analysis and contractual restrictions
§ 20:6	Use of the results of the investigation
В.	PROCEDURES FOR CONDUCTING THE INVESTIGATION
§ 20:7	Investigation plan
§ 20:8	Investigation team
§ 20:9	Investigation process
§ 20:10	Documented form of the investigation
C.	COLLECTING THE INFORMATION
§ 20:11	Overview
§ 20:12	Information collection procedures
§ 20:13	—Questionnaires
§ 20:14	—Document requests
§ 20:15	Information collection procedures
§ 20:16	—Interviews
§ 20:17	—Inspections
§ 20:18	—Legal opinions and independent reports
§ 20:19	—Registry searches
§ 20:20	Basic document and information requirements
§ 20:21	Information collection procedures—Statutory
8 00.00	intellectual property rights
§ 20:22 § 20:23	—Trade secret rights
§ 20:23 § 20:24	—Technology rights agreements—Employment agreements
§ 20.24 § 20:25	—Employment agreements —Intellectual property disputes and litigation
§ 20.25 § 20:26	—Other documents and information
, D.	
§ 20:27	Overview
§ 20:28	Description of intellectual property rights
§ 20:29	—Assets owned by the company
§ 20:30	—License agreements
§ 20:31	Ownership of intellectual property rights
§ 20:32	—Search procedures
§ 20:33	—Employees and consultants
§ 20:34	—Licenses from third parties to company
§ 20:35	—Company licenses to third parties
§ 20:36	Perfection and protection
§ 20:37	—Statutory rights

TECHNOLOGY MGMT & TRANSACTIONS

UAL

Volume 2

CHAPTER 21. DUE DILIGENCE IN TECHNOLOGY TRANSACTIONS

§ 21:1	Overview
§ 21:2	—Identification of the intellectual property rights
§ 21:3	—Ownership
§ 21:4	—Perfection and protection
§ 21:5	—Infringement analysis and contractual restrictions
§ 21:6	—Using the due diligence investigation
§ 21:7	Conducting the due diligence investigation—The
	investigation plan
§ 21:8	—Choosing the investigation team
§ 21:9	—Management and the due diligence investigation
§ 21:10	—The investigation process
§ 21:11	—Documented form of the investigation
§ 21:12	Collecting the information
§ 21:13	—Information collection procedures
§ 21:14	——Questionnaires
§ 21:15	——Document requests
§ 21:16	——File review
§ 21:17	——Interviews
§ 21:18	——Inspections
§ 21:19	 —Legal opinions and independent reports
§ 21:20	——Registry searches
§ 21:21	—Basic document and information requirements
§ 21:22	——Statutory intellectual property rights
§ 21:23	——Trade secret rights
§ 21:24	——Technology rights agreements
$\S 21:25$	——Employment agreements
§ 21:26	 —Intellectual property disputes and litigation
§ 21:27	— Other documents and information
§ 21:28	Analyzing information
§ 21:29	Description of intellectual property rights
§ 21:30	—Assets owned by target company
§ 21:31	—Trade secrets
§ 21:32	—License agreements
§ 21:33	Ownership of intellectual property rights
§ 21:34	—Search procedures
§ 21:35	—Employees and consultants
§ 21:36	——Employee assignments of inventions

— —Consultant assignments § 21:37 ——Representations and warranties § 21:38 § 21:39 — —Licenses from third parties to target company § 21:40 ——Target company licenses to third parties § 21:41 Perfection and protection § 21:42 —Statutory rights § 21:43 — Patents § 21:44 ——Copyrights --- Trademarks § 21:45 § 21:46 —Trade secrets § 21:47 — —Trade secret protection procedures § 21:48 — — Nondisclosure agreements § 21:49 —Protective provisions in licensing agreements § 21:50 —Prosecuting infringement claims against third parties Infringement of third-party rights § 21:51 § 21:52 —Prior employment relationships § 21:53 —Misappropriation of trade secrets § 21:54 —Copyright infringement § 21:55 Restrictions and limitations —Contractual restrictions and limitations § 21:56 § 21:57 —Intellectual property litigation § 21:58 Competitive utility of intellectual property assets —Statutory rights § 21:59 § 21:60 — Patents ——Copyrights § 21:61 — —Trademarks § 21:62 § 21:63 —Trade Secrets § 21:64 Curing defects in ownership of technology -Written assignments § 21:65 § 21:66 —Licensing the rights of third parties § 21:67 —Reverse engineering § 21:68 —Independent development II. FORMS § 21:69 Intellectual property due diligence questionnaire § 21:70 Intellectual property due diligence document request—Short form § 21:71 —Long form § 21:72 Intellectual property due diligence interview § 21:73 Intellectual property ownership analysis § 21:74 Intellectual property perfection and protection

§ 21:75

analysis

Mutual confidentiality agreement

§ 21:76 Unilateral non-disclosure agreement

CHAPTER 22. RESEARCH AND DEVELOPMENT ARRANGEMENTS

§ 2	2:1	Overview
§ 2	2:2	—Types of research and development arrangements
§ 2	2:3	—Key terms of the research and development
		arrangement
§ 2	2:4	The research program
§ 2	2:5	—Scope and content of the research program
§ 2	2:6	— —Field of activity
§ 2	2:7	——Program goals and objectives
§ 2	2:8	— —Content of the research program
§ 2	2:9	— — Duration and completion of the research
		program
	2:10	—The research budget
_	2:11	——Components of the research budget
-	2:12	——Capital equipment and facilities
-	2:13	——Researching party's profit on research project
_	2:14	——Supplemental funding from third parties
-	2:15	——Amendments and modifications
-	2:16	——Payment procedures
-	2:17	——Accounting procedures
-	2:18	—Staffing of the research project
-	2:19	—Management and reporting procedures
-	2:20	——Management procedures
_	2:21	— — Technical progress reviews
-	2:22	——Reporting procedures
§ 2	2:23	——Review meetings and monitoring of project
_	2:24	— — Voting and dispute resolution procedures
-	2:25	——Records and reports
-	2:26	—Technology exchange and technical assistance
§ 2	2:27	Contributions to the research program
§ 2	2:28	—Contributions of existing technologies to the
8 0	0.00	research project
8 2	2:29	—Participation of sponsor personnel in research
8 0	0.20	program
-	2:30	—Supply of raw materials by sponsor
_	2:31	Representations and covenants
-	2:32	—Representations and warranties
§ 2	2:33	 Researching party's obligation to conduct research work

§ 22:34	—Restrictions on competitive activities
§ 22:35	—Confidentiality
§ 22:36	—Insurance and products liability
§ 22:37	—Publications and presentations
§ 22:38	—Supply of products for preclinical studies
§ 22:39	—Escrow arrangements
§ 22:40	—Independent contractor status
§ 22:41	—Additional research projects
§ 22:42	——Sponsor's right of first review
§ 22:43	——Exchange of new product ideas
§ 22:44	Ownership and protection of the technology
§ 22:45	—Ownership of project-related technology
§ 22:46	—Perfection and maintenance of intellectual property
0	rights
§ 22:47	——Preparation and prosecution of patent
	applications
§ 22:48	——Protection of technical information
§ 22:49	——Responsibility for patent infringement actions
§ 22:50	Uses of project-related technology
§ 22:51	—Uses of sponsor-owned technology by researching
	party
§ 22:52	——Right to use technology for internal purposes
§ 22:53	— Right to use technology outside field of activity
§ 22:54	——Agreement to supply products to sponsor
§ 22:55	—Uses of project-related technology owned by
Ü	researching party
§ 22:56	——Sponsor's right of first refusal for exclusive
	license
§ 22:57	——Sponsor's option to act as sole distributor
§ 22:58	—Creation of joint venture to commercialize
	technology
§ 22:59	—Uses of technology in the joint-venture context
§ 22:60	—Use of technologies outside the original field of
	activity
§ 22:61	—Use of basic technologies contributed to research
	program
§ 22:62	Termination of the research arrangement escrow
	arrangements
§ 22:63	—Events causing termination of the research
	arrangement—Failure or nonviability of research
	program
§ 22:64	——Inability of sponsor to fund research program
§ 22:65	——Other events causing termination of research
0.00.00	program
§ 22:66	—Rights and obligations of the parties upon
	termination

§ 22:67	Certain tax aspects of research and development arrangements—Research and development cost sharing
§ 22:68	—Section 197
§ 22:69	—Sections 162 and 174
§ 22:70	—Treatment of computer software
§ 22:71	—Research and experimentation tax credit

II. FORMS

8 22:12	Cooperative development agreement
§ 22:73	Research agreement for therapeutic products
§ 22:74	Funded innovative research agreement
§ 22:75	Base research agreement
§ 22:76	Research services agreement
§ 22:77	Development and license agreement (hardware)
§ 22:78	Joint research and development agreement
§ 22:79	Collaborative research agreement

CHAPTER 23. LICENSING ARRANGEMENTS

§ 23:1	Overview
§ 23:2	Legal and regulatory aspects of licensing
	arrangements
§ 23:3	General types of licensing arrangements
§ 23:4	—Classification by licensed subject matter
§ 23:5	——Patent license
§ 23:6	——Trademark license
§ 23:7	——Copyright license
§ 23:8	——Trade secret license
§ 23:9	— — Hybrid licenses
§ 23:10	—Classification by permitted functional uses
§ 23:11	— —Use licenses
§ 23:12	——Manufacturing license
§ 23:13	— — Modification license
§ 23:14	——Distribution license
§ 23:15	——Sublicenses
§ 23:16	——Licensing to original equipment managers and
	value-added resellers
§ 23:17	Advantages and disadvantages of licensing
	arrangements
§ 23:18	—Potential advantages of a licensing arrangement

TECHNOLOGY MGMT & TRANSACTIONS

0.00.10	A
§ 23:19	——Access to vertical capabilities
§ 23:20	— Technology acquisition and exchange
§ 23:21	— — Market penetration
§ 23:22	——Neutralizing blocking patents
§ 23:23	——Local regulatory requirements
§ 23:24	——Protection of intellectual property rights
§ 23:25	— — Cost reduction
§ 23:26	——Enhancing cash flow and harvesting
§ 23:27	General types of licensing arrangements—Potential disadvantages of a licensing arrangement
§ 23:28	——Dependence
§ 23:29	— Expropriation of licensed technology
§ 23:30	——Risks to value of goodwill
§ 23:31	——Licensee's costs of exploiting licensed rights
§ 23:32	Contents of the licensing agreement
§ 23:33	Definition and use of the licensed technology
§ 23:34	—Definition of the licensed subject matter
§ 23:35	——Statutory intellectual property rights
§ 23:36	——Trade secrets
§ 23:37	—Definition of the licensed technology—Rights
	licensed from third parties
§ 23:38	——Changes in legal form of protection
§ 23:39	— —Licensor-developed improvements and
	enhancements
§ 23:40	—Definition of the licensed subject matter—
	Licensee-developed enhancements and
\$ 00.41	improvements
§ 23:41	—Scope of use of the licensed subject matter — Permitted functional uses of the licensed
§ 23:42	subject matter
§ 23:43	— —Field of use restrictions: Products and
3 20.10	applications
§ 23:44	——Field of use restrictions: Geographic and
Ü	territorial
§ 23:45	—Exclusive and nonexclusive license rights
§ 23:46	— —Contractual restrictions on exclusivity
§ 23:47	 —Performance conditions for exclusivity
§ 23:48	——"Most favored licensee" clauses
§ 23:49	 — Legal consequences of exclusive licensing
§ 23:50	—Sublicensing and assignment
§ 23:51	Warranties and guarantees
§ 23:52	—Warranties against infringement of third-party
0.00.70	rights
§ 23:53	——Defending infringement claims by third parties
§ 23:54	——Right to obtain license or modify infringing
	technology

TABLE OF CONTENTS

§ 23:55	——Risks of providing noninfringement
	representations
§ 23:56	——Due diligence procedures
§ 23:57	——Remedies for breach of representation
§ 23:58	—Performance warranties and guarantees
§ 23:59	—Additional representations and warranties—No
	conflicts regarding ownership or right to use
§ 23:60	— —Legal validity
§ 23:61	——Regulatory matters
§ 23:62	—Government licenses
§ 23:63	—Limitations and disclaimers of warranties
§ 23:64	Rights and obligations of the parties
§ 23:65	—Protection of the licensed subject matter
§ 23:66	— —Establishment and maintenance of statutory
	rights
§ 23:67	——Infringement actions by or against third parties
§ 23:68	— —Confidentiality
§ 23:69	— —Use of protective notices
§ 23:70	—Technical assistance
§ 23:71	——Transfer of technical information
§ 23:72	— Technical assistance and training
§ 23:73	 — Other technical and commercial support
§ 23:74	—Licensee's improvements and grant-back
	provisions
§ 23:75	—Licensee's duty to exploit licensed subject matter
§ 23:76	—Restrictions on licensee engaging in competitive
	activities
§ 23:77	—Patent marking and nonendorsement
§ 23:78	—Quality control and products liability claims
§ 23:79	—Breach of the terms of the licensing agreement
§ 23:80	——Limitations on the forms of damages
§ 23:81	——Limitations on the amount of damages
§ 23:82	——Limitations on the type of remedies
§ 23:83	——Injunctive relief
§ 23:84	——Statute of limitations
§ 23:85	Compensation, accounting, and payment
§ 23:86	—Royalties
§ 23:87	——Scope of compensable uses
§ 23:88	——Royalty measurement standard
§ 23:89	——Royalty rate
§ 23:90	— Minimum and maximum royalty provisions
§ 23:91	——Royalty stacking provisions
§ 23:92	——Government-owned inventions
§ 23:93	— — Most favored licensee clauses
§ 23:94	——Patent licenses

§ 23:95	— —Trade secret licenses
§ 23:96	——Duration
§ 23:97	—"Lump-sum" or nonroyalty payments
§ 23:98	— — Mature technologies
§ 23:99	— —Limited life of licensed technology
§ 23:100	— —Cost recovery
§ 23:101	——Incentive for exploitation
§ 23:102	——Protection against country risk
§ 23:103	——Relation to royalty payments
§ 23:104	—In-kind payments
§ 23:105	—Accounting and payment procedures
§ 23:106	Term and termination of the licensing agreement
§ 23:107	—Term of the licensing agreement
§ 23:108	—Early termination provisions
§ 23:109	—Effect of termination and post-termination
0.00.110	covenants
§ 23:110	— —Final settlement of accounts
§ 23:111	——Protection of confidential information
§ 23:112	——Continued service to existing customers
§ 23:113	— —Termination damages
§ 23:114	Transferring federally-owned technology by licensing
II. FO	RMS
\$ 09.115	Euglissias licenses amount
§ 23:115	Exclusive license agreement
§ 23:116	License agreement
§ 23:117	Patent license agreement
§ 23:118	Technology transfer and cross-license agreement
§ 23:119	Technology license agreement
§ 23:120	Trade secret license agreement
§ 23:121	Technology product purchase and software license agreement
	19 100110110
CHAP'	TER 24. MANUFACTURING AND
DISTRIBUTION ARRANGEMENTS	
21011	
I. BUS	SINESS AND LEGAL CONSIDERATIONS
§ 24:1	Overview
§ 24:1	—Forms of manufacturing and distribution
0	or manaracouring and aboutour

§ 24:3 § 24:4

§ 24:5

relationships

relationship

— —Basic distributorship relationship

— Original equipment manufacturer relationship
— Manufacturing and distribution licensing

\$ 24:6 — Laws governing the sale of goods—Domestic laws \$ 24:7 — United Nations Convention for the International Sale of Goods \$ 24:8 — —Obligations of the seller/remedies of the buyer \$ 24:9 — —Obligations of the buyer/remedies of the seller \$ 24:10 Standard terms of product purchase agreements \$ 24:11 Manufacturing arrangements—General business considerations—Competitive advantages of manufacturing \$ 24:12 —General business and legal aspects of manufacturing activities \$ 24:13 —Outsourcing manufacturing requirements \$ 24:14 —Manufacturer selection process \$ 24:15 —Preliminary negotiations \$ 24:16 —Confidentiality agreements \$ 24:17 —Letter of intent \$ 24:18 —Limited prototype manufacturing agreement \$ 24:20 —Contract manufacturing arrangement \$ 24:21 —Products developed by manufacturer \$ 24:22 —Products developed by purchaser \$ 24:23 —Master manufacturing agreements \$ 24:24 —Requirements contracts \$ 24:25 —Manufacturing facilities and equipment arrangements \$ 24:26 —Subcontracting arrangements \$ 24:27 —Manufacturing and distribution arrangements \$ 24:28 —Ancillary agreements \$ 24:29 —Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 —Inventories \$ 24:31 —Accounting methods \$ 24:32 —Installment sales \$ 24:33 —Imputed interest
International Sale of Goods § 24:8 ———Obligations of the seller/remedies of the buyer § 24:9 ———Obligations of the buyer/remedies of the seller § 24:10 Standard terms of product purchase agreements § 24:11 Manufacturing arrangements—General business considerations—Competitive advantages of manufacturing § 24:12 ——General business and legal aspects of manufacturing activities § 24:13 ——Outsourcing manufacturing requirements § 24:14 ——Manufacturer selection process § 24:15 —Preliminary negotiations § 24:16 ——Confidentiality agreements § 24:17 ——Letter of intent § 24:18 ——Limited prototype manufacturing agreement § 24:20 —Contract manufacturing arrangements § 24:21 ——Products developed by manufacturer § 24:22 ——Products developed by purchaser § 24:23 ——Master manufacturing agreements § 24:24 ——Requirements contracts § 24:25 ——Manufacturing facilities and equipment arrangements § 24:26 ——Subcontracting arrangements § 24:27 ——Manufacturing and distribution arrangements § 24:28 ——Ancillary agreements § 24:29 —Tax considerations—Tax treatment of sale and purchase of goods § 24:30 ——Inventories § 24:31 ——Accounting methods § 24:32 ——Installment sales
\$ 24:9
buyer
\$ 24:10 Standard terms of product purchase agreements \$ 24:11 Manufacturing arrangements—General business considerations—Competitive advantages of manufacturing \$ 24:12 — General business and legal aspects of manufacturing activities \$ 24:13 — Outsourcing manufacturing requirements \$ 24:14 — Manufacturer selection process \$ 24:15 — Preliminary negotiations \$ 24:16 — Confidentiality agreements \$ 24:17 — Letter of intent \$ 24:18 — Limited prototype manufacturing agreement \$ 24:19 — Product or process development agreement \$ 24:20 — Contract manufacturing arrangements \$ 24:21 — Products developed by manufacturer \$ 24:22 — Products developed by purchaser \$ 24:23 — Master manufacturing agreements \$ 24:24 — Requirements contracts \$ 24:25 — Manufacturing facilities and equipment arrangements \$ 24:26 — Subcontracting arrangements \$ 24:27 — Manufacturing and distribution arrangements \$ 24:28 — Ancillary agreements \$ 24:29 — Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 — Inventories \$ 24:31 — Accounting methods \$ 24:32 — Installment sales
seller \$ 24:10 Standard terms of product purchase agreements \$ 24:11 Manufacturing arrangements—General business considerations—Competitive advantages of manufacturing \$ 24:12 — General business and legal aspects of manufacturing activities \$ 24:13 — Outsourcing manufacturing requirements \$ 24:14 — Manufacturer selection process \$ 24:15 — Preliminary negotiations \$ 24:16 — Confidentiality agreements \$ 24:17 — Letter of intent \$ 24:18 — Limited prototype manufacturing agreement \$ 24:19 — Product or process development agreement \$ 24:20 — Contract manufacturing arrangements \$ 24:21 — Products developed by manufacturer \$ 24:22 — Products developed by purchaser \$ 24:23 — Master manufacturing agreements \$ 24:24 — Requirements contracts \$ 24:25 — Manufacturing facilities and equipment arrangements \$ 24:26 — Subcontracting arrangements \$ 24:27 — Manufacturing and distribution arrangements \$ 24:28 — Ancillary agreements \$ 24:29 — Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 — Inventories \$ 24:31 — Accounting methods \$ 24:32 — Installment sales
\$ 24:10 Standard terms of product purchase agreements \$ 24:11 Manufacturing arrangements—General business considerations—Competitive advantages of manufacturing \$ 24:12 — General business and legal aspects of manufacturing activities \$ 24:13 — Outsourcing manufacturing requirements \$ 24:14 — Manufacturer selection process \$ 24:15 — Preliminary negotiations \$ 24:16 — Confidentiality agreements \$ 24:17 — Letter of intent \$ 24:18 — Limited prototype manufacturing agreement \$ 24:19 — Product or process development agreement \$ 24:20 — Contract manufacturing arrangements \$ 24:21 — Products developed by manufacturer \$ 24:22 — Products developed by purchaser \$ 24:23 — Master manufacturing agreements \$ 24:24 — Requirements contracts \$ 24:25 — Manufacturing facilities and equipment arrangements \$ 24:26 — Subcontracting arrangements \$ 24:27 — Manufacturing and distribution arrangements \$ 24:28 — Ancillary agreements \$ 24:29 — Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 — Inventories \$ 24:31 — Accounting methods \$ 24:32 — Installment sales
\$ 24:11 Manufacturing arrangements—General business considerations—Competitive advantages of manufacturing \$ 24:12 — General business and legal aspects of manufacturing activities \$ 24:13 — Outsourcing manufacturing requirements \$ 24:14 — Manufacturer selection process \$ 24:15 — Preliminary negotiations \$ 24:16 — Confidentiality agreements \$ 24:17 — Letter of intent \$ 24:18 — Limited prototype manufacturing agreement \$ 24:19 — Product or process development agreement \$ 24:20 — Contract manufacturing arrangements \$ 24:21 — Products developed by manufacturer \$ 24:22 — Products developed by purchaser \$ 24:23 — Master manufacturing agreements \$ 24:24 — Requirements contracts \$ 24:25 — Manufacturing facilities and equipment arrangements \$ 24:26 — Subcontracting arrangements \$ 24:27 — Manufacturing and distribution arrangements \$ 24:28 — Ancillary agreements \$ 24:29 — Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 — Inventories \$ 24:31 — Accounting methods \$ 24:32 — Installment sales
considerations—Competitive advantages of manufacturing \$ 24:12 — General business and legal aspects of manufacturing activities \$ 24:13 — Outsourcing manufacturing requirements \$ 24:14 — Manufacturer selection process \$ 24:15 — Preliminary negotiations \$ 24:16 — Confidentiality agreements \$ 24:17 — Letter of intent \$ 24:18 — Limited prototype manufacturing agreement \$ 24:19 — Product or process development agreement \$ 24:20 — Contract manufacturing arrangements \$ 24:21 — Products developed by manufacturer \$ 24:22 — Products developed by purchaser \$ 24:23 — Master manufacturing agreements \$ 24:24 — Requirements contracts \$ 24:25 — Manufacturing facilities and equipment arrangements \$ 24:26 — Subcontracting arrangements \$ 24:27 — Manufacturing and distribution arrangements \$ 24:28 — Ancillary agreements \$ 24:29 — Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 — Inventories \$ 24:31 — Accounting methods \$ 24:32 — Installment sales
manufacturing \$ 24:12 ——General business and legal aspects of manufacturing activities \$ 24:13 ——Outsourcing manufacturing requirements \$ 24:14 ——Manufacturer selection process \$ 24:15 —Preliminary negotiations \$ 24:16 ——Confidentiality agreements \$ 24:17 ——Letter of intent \$ 24:18 ——Limited prototype manufacturing agreement \$ 24:19 ——Product or process development agreement \$ 24:20 —Contract manufacturing arrangements \$ 24:21 ——Products developed by manufacturer \$ 24:22 ——Products developed by purchaser \$ 24:23 ——Master manufacturing agreements \$ 24:24 ——Requirements contracts \$ 24:25 ——Manufacturing facilities and equipment arrangements \$ 24:26 ——Subcontracting arrangements \$ 24:27 ——Manufacturing and distribution arrangements \$ 24:28 ——Ancillary agreements \$ 24:29 —Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 ——Inventories \$ 24:31 ——Accounting methods \$ 24:32 ——Installment sales
\$ 24:12 ——General business and legal aspects of manufacturing activities \$ 24:13 ——Outsourcing manufacturing requirements \$ 24:14 ——Manufacturer selection process \$ 24:15 —Preliminary negotiations \$ 24:16 ——Confidentiality agreements \$ 24:17 ——Letter of intent \$ 24:18 ——Limited prototype manufacturing agreement \$ 24:19 ——Product or process development agreement \$ 24:20 —Contract manufacturing arrangements \$ 24:21 ——Products developed by manufacturer \$ 24:22 ——Products developed by purchaser \$ 24:23 ——Master manufacturing agreements \$ 24:24 ——Requirements contracts \$ 24:25 ——Manufacturing facilities and equipment arrangements \$ 24:26 ——Subcontracting arrangements \$ 24:27 ——Manufacturing and distribution arrangements \$ 24:28 ——Ancillary agreements \$ 24:29 —Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 ——Inventories \$ 24:31 ——Accounting methods \$ 24:32 ——Installment sales
manufacturing activities § 24:13 ——Outsourcing manufacturing requirements § 24:14 ——Manufacturer selection process § 24:15 —Preliminary negotiations § 24:16 ——Confidentiality agreements § 24:17 ——Letter of intent § 24:18 ——Limited prototype manufacturing agreement § 24:19 ——Product or process development agreement § 24:20 —Contract manufacturing arrangements § 24:21 ——Products developed by manufacturer § 24:22 ——Products developed by purchaser § 24:23 ——Master manufacturing agreements § 24:24 ——Requirements contracts § 24:25 ——Manufacturing facilities and equipment arrangements § 24:26 ——Subcontracting arrangements § 24:27 ——Manufacturing and distribution arrangements § 24:28 ——Ancillary agreements § 24:29 —Tax considerations—Tax treatment of sale and purchase of goods § 24:30 ——Inventories § 24:31 ——Accounting methods § 24:32 ——Installment sales
\$ 24:13 — Outsourcing manufacturing requirements \$ 24:14 — Manufacturer selection process \$ 24:15 — Preliminary negotiations \$ 24:16 — Confidentiality agreements \$ 24:17 — Letter of intent \$ 24:18 — Limited prototype manufacturing agreement \$ 24:19 — Product or process development agreement \$ 24:20 — Contract manufacturing arrangements \$ 24:21 — Products developed by manufacturer \$ 24:22 — Products developed by purchaser \$ 24:23 — Master manufacturing agreements \$ 24:24 — Requirements contracts \$ 24:25 — Manufacturing facilities and equipment arrangements \$ 24:26 — Subcontracting arrangements \$ 24:27 — Manufacturing and distribution arrangements \$ 24:28 — Ancillary agreements \$ 24:29 — Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 — Inventories \$ 24:31 — Accounting methods \$ 24:32 — Installment sales
\$ 24:14 ——Manufacturer selection process \$ 24:15 —Preliminary negotiations \$ 24:16 ——Confidentiality agreements \$ 24:17 ——Letter of intent \$ 24:18 ——Limited prototype manufacturing agreement \$ 24:19 ——Product or process development agreement \$ 24:20 —Contract manufacturing arrangements \$ 24:21 ——Products developed by manufacturer \$ 24:22 ——Products developed by purchaser \$ 24:23 ——Master manufacturing agreements \$ 24:24 ——Requirements contracts \$ 24:25 ——Manufacturing facilities and equipment arrangements \$ 24:26 ——Subcontracting arrangements \$ 24:27 ——Manufacturing and distribution arrangements \$ 24:28 ——Ancillary agreements \$ 24:29 —Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 ——Inventories \$ 24:31 ——Accounting methods \$ 24:32 ——Installment sales
\$ 24:15 —Preliminary negotiations \$ 24:16 ——Confidentiality agreements \$ 24:17 ——Letter of intent \$ 24:18 ——Limited prototype manufacturing agreement \$ 24:19 ——Product or process development agreement \$ 24:20 —Contract manufacturing arrangements \$ 24:21 ——Products developed by manufacturer \$ 24:22 ——Products developed by purchaser \$ 24:23 ——Master manufacturing agreements \$ 24:24 ——Requirements contracts \$ 24:25 ——Manufacturing facilities and equipment arrangements \$ 24:26 ——Subcontracting arrangements \$ 24:27 ——Manufacturing and distribution arrangements \$ 24:28 ——Ancillary agreements \$ 24:29 —Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 ——Inventories \$ 24:31 ——Accounting methods \$ 24:32 —Installment sales
\$ 24:16 ——Confidentiality agreements \$ 24:17 ——Letter of intent \$ 24:18 ——Limited prototype manufacturing agreement \$ 24:19 ——Product or process development agreement \$ 24:20 —Contract manufacturing arrangements \$ 24:21 ——Products developed by manufacturer \$ 24:22 ——Products developed by purchaser \$ 24:23 ——Master manufacturing agreements \$ 24:24 ——Requirements contracts \$ 24:25 ——Manufacturing facilities and equipment arrangements \$ 24:26 ——Subcontracting arrangements \$ 24:27 ——Manufacturing and distribution arrangements \$ 24:28 ——Ancillary agreements \$ 24:29 —Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 ——Inventories \$ 24:31 ——Accounting methods \$ 24:32 ——Installment sales
\$ 24:17 — Letter of intent \$ 24:18 — Limited prototype manufacturing agreement \$ 24:19 — Product or process development agreement \$ 24:20 — Contract manufacturing arrangements \$ 24:21 — Products developed by manufacturer \$ 24:22 — Products developed by purchaser \$ 24:23 — Master manufacturing agreements \$ 24:24 — Requirements contracts \$ 24:25 — Manufacturing facilities and equipment arrangements \$ 24:26 — Subcontracting arrangements \$ 24:27 — Manufacturing and distribution arrangements \$ 24:28 — Ancillary agreements \$ 24:29 — Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 — Inventories \$ 24:31 — Accounting methods \$ 24:32 — Installment sales
\$ 24:18 ——Limited prototype manufacturing agreement \$ 24:19 ——Product or process development agreement \$ 24:20 —Contract manufacturing arrangements \$ 24:21 ——Products developed by manufacturer \$ 24:22 ——Products developed by purchaser \$ 24:23 ——Master manufacturing agreements \$ 24:24 ——Requirements contracts \$ 24:25 ——Manufacturing facilities and equipment arrangements \$ 24:26 ——Subcontracting arrangements \$ 24:27 ——Manufacturing and distribution arrangements \$ 24:28 ——Ancillary agreements \$ 24:29 —Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 ——Inventories \$ 24:31 ——Accounting methods \$ 24:32 ——Installment sales
 \$ 24:19 ——Product or process development agreement \$ 24:20 —Contract manufacturing arrangements \$ 24:21 ——Products developed by manufacturer \$ 24:22 ——Products developed by purchaser \$ 24:23 ——Master manufacturing agreements \$ 24:24 ——Requirements contracts \$ 24:25 ——Manufacturing facilities and equipment arrangements \$ 24:26 ——Subcontracting arrangements \$ 24:27 ——Manufacturing and distribution arrangements \$ 24:28 ——Ancillary agreements \$ 24:29 —Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 ——Inventories \$ 24:31 ——Accounting methods \$ 24:32 —Installment sales
\$ 24:20 —Contract manufacturing arrangements \$ 24:21 — Products developed by manufacturer \$ 24:22 — Products developed by purchaser \$ 24:23 — Master manufacturing agreements \$ 24:24 — Requirements contracts \$ 24:25 — Manufacturing facilities and equipment arrangements \$ 24:26 — Subcontracting arrangements \$ 24:27 — Manufacturing and distribution arrangements \$ 24:28 — Ancillary agreements \$ 24:29 — Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 — Inventories \$ 24:31 — Accounting methods \$ 24:32 — Installment sales
 § 24:21 ——Products developed by manufacturer § 24:22 ——Products developed by purchaser § 24:23 ——Master manufacturing agreements § 24:24 ——Requirements contracts § 24:25 ——Manufacturing facilities and equipment arrangements § 24:26 ——Subcontracting arrangements § 24:27 ——Manufacturing and distribution arrangements § 24:28 ——Ancillary agreements § 24:29 —Tax considerations—Tax treatment of sale and purchase of goods § 24:30 ——Inventories § 24:31 ——Accounting methods § 24:32 —Installment sales
 \$ 24:22 ——Products developed by purchaser \$ 24:23 ——Master manufacturing agreements \$ 24:24 ——Requirements contracts \$ 24:25 ——Manufacturing facilities and equipment arrangements \$ 24:26 ——Subcontracting arrangements \$ 24:27 ——Manufacturing and distribution arrangements \$ 24:28 ——Ancillary agreements \$ 24:29 —Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 ——Inventories \$ 24:31 ——Accounting methods \$ 24:32 —Installment sales
 § 24:23 — Master manufacturing agreements § 24:24 — Requirements contracts § 24:25 — Manufacturing facilities and equipment arrangements § 24:26 — Subcontracting arrangements § 24:27 — Manufacturing and distribution arrangements § 24:28 — Ancillary agreements § 24:29 — Tax considerations—Tax treatment of sale and purchase of goods § 24:30 — Inventories § 24:31 — Accounting methods § 24:32 — Installment sales
 \$ 24:24 — Requirements contracts \$ 24:25 — Manufacturing facilities and equipment arrangements \$ 24:26 — Subcontracting arrangements \$ 24:27 — Manufacturing and distribution arrangements \$ 24:28 — Ancillary agreements \$ 24:29 — Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 — Inventories \$ 24:31 — Accounting methods \$ 24:32 — Installment sales
 § 24:25 — Manufacturing facilities and equipment arrangements § 24:26 — Subcontracting arrangements § 24:27 — Manufacturing and distribution arrangements § 24:28 — Ancillary agreements § 24:29 — Tax considerations—Tax treatment of sale and purchase of goods § 24:30 — Inventories § 24:31 — Accounting methods § 24:32 — Installment sales
arrangements § 24:26 — Subcontracting arrangements § 24:27 — Manufacturing and distribution arrangements § 24:28 — Ancillary agreements § 24:29 — Tax considerations—Tax treatment of sale and purchase of goods § 24:30 — Inventories § 24:31 — Accounting methods § 24:32 — Installment sales
 § 24:26 ——Subcontracting arrangements § 24:27 ——Manufacturing and distribution arrangements § 24:28 ——Ancillary agreements § 24:29 —Tax considerations—Tax treatment of sale and purchase of goods § 24:30 ——Inventories § 24:31 ——Accounting methods § 24:32 —Installment sales
 \$ 24:27 — Manufacturing and distribution arrangements \$ 24:28 — Ancillary agreements \$ 24:29 — Tax considerations—Tax treatment of sale and purchase of goods \$ 24:30 — Inventories \$ 24:31 — Accounting methods \$ 24:32 — Installment sales
 § 24:28 ——Ancillary agreements § 24:29 —Tax considerations—Tax treatment of sale and purchase of goods § 24:30 ——Inventories § 24:31 ——Accounting methods § 24:32 —Installment sales
 § 24:29 —Tax considerations—Tax treatment of sale and purchase of goods § 24:30 —Inventories § 24:31 —Accounting methods § 24:32 —Installment sales
purchase of goods § 24:30 ——Inventories § 24:31 ——Accounting methods § 24:32 ——Installment sales
 § 24:30 — —Inventories § 24:31 — —Accounting methods § 24:32 — —Installment sales
§ 24:31 ——Accounting methods § 24:32 ——Installment sales
§ 24:32 ——Installment sales
5
§ 24:33 ——Imputed interest
§ 24:34 ——Cancellation of manufacturing agreements
§ 24:35 Basic distributorship relationships
§ 24:36 —Types of distributorship arrangements—
Nonexclusive distribution agreements
§ 24:37 ——Exclusive distribution agreements
§ 24:38 ——International distributor agreements
8
§ 24:39 ——Dealer arrangements
g g

TECHNOLOGY MGMT & TRANSACTIONS

§ 24:42	——Parts and supplies
§ 24:43	— —Enhancements and improvements
§ 24:44	——Rights to new products
§ 24:45	—Scope of appointment
§ 24:46	— —Geographic limitations
§ 24:47	——Market or customer limitations
§ 24:48	 —Subdistributors and dealers
§ 24:49	— —Exclusivity
§ 24:50	—Pricing and payment terms
§ 24:51	— Pricing of products sold to distributor
§ 24:52	——Payment terms
§ 24:53	——Security for performance of payment
	obligations
§ 24:54	 — Pricing adjustments for unsold inventories
§ 24:55	—Ordering and shipping procedures
§ 24:56	— —Ordering procedures
$\S 24:57$	— —Product availability
§ 24:58	——Shipping procedures
§ 24:59	— —Manufacturer's failure to deliver on a timely
	basis
§ 24:60	—Resale pricing
§ 24:61	—Product warranties
§ 24:62	— Express performance warranties
§ 24:63	 —Implied warranties and disclaimers
§ 24:64	 —Intellectual property warranties
$\S 24:65$	—Technical support and service—Technical
	assistance
$\S 24:66$	——Training classes
$\S 24:67$	——Documentation
§ 24:68	——Service
§ 24:69	—Duties of the distributor
§ 24:70	—Promotional activities
§ 24:71	—Trademarks and goodwill
§ 24:72	—Distributor review
§ 24:73	—Term and termination
§ 24:74	——Initial term and renewals
§ 24:75	— —Early termination
§ 24:76	 —Legal consequences of termination
§ 24:77	——Post-termination obligations and procedures
§ 24:78	— — Outstanding orders
§ 24:79	— — — Distributor inventories
§ 24:80	— — — Manufacturer products on distributor's
	premises
§ 24:81	———Customer service and warranty claims
§ 24:82	———Trademarks and marketing literature

§ 24:83	— — — Confidentiality obligations
§ 24:84	—Tax considerations
§ 24:85	— Tax treatment of principal and distributor
§ 24:86	——Accounting methods
§ 24:87	——Cancellation of dealership or distributorship
§ 24:88	Original equipment manufacturer relationships
§ 24:89	—Product specifications
§ 24:90	—Product manufacture and acceptance procedures
§ 24:91	—Pricing and ordering procedures
§ 24:92	—Spare parts
§ 24:93	—Product warranties
§ 24:94	—Confidentiality obligations
§ 24:95	—Termination
§ 24:96	Manufacture and distribution licensing
§ 24:97	—Definition of licensed products
§ 24:98	—Manufacturing activities
§ 24:99	— — Transfer of technical information
§ 24:100	——Training and assistance
§ 24:101	——Cooperative purchasing
§ 24:102	—Scope of manufacturing and distribution licenses
§ 24:103	—Senior party's obligation to purchase products
§ 24:104	——Pricing
§ 24:105	——Payment procedures
§ 24:106	— — Order forecast
§ 24:107	—Developer's right to purchase products
II. FO	RMS
§ 24:108	Manufacturing license and product purchase agreement
§ 24:109	Manufacturing and purchase agreement
§ 24:110	Manufacturing and purchase agreement (computer systems)
§ 24:111	Exclusive manufacturing agreement
§ 24:112	Branded product manufacturing agreement
§ 24:113	Original design manufacturer agreement
§ 24:114	Manufacturing and integration services agreement
§ 24:115	Requirements supply agreement
§ 24:116	Technology OEM agreement
§ 24:117	Patent and know-how license agreement
§ 24:118	Escrow agreement (technical information)
§ 24:119	Exclusive field of use license agreement for
-	biological materials
§ 24:120	OEM license agreement
§ 24:121	Licensing and technical assistance agreement

§ 24:122	Distributor agreement
§ 24:123	International distributor agreement (medical products)
§ 24:124	Manufacturing license and distribution agreement
§ 24:125	Retailer's standard terms and conditions for purchase of technology products
§ 24:126	OEM purchase agreement terms and conditions
§ 24:127	Manufacturing, sales and distribution exclusive license agreement
§ 24:128	Manufacturing license and distribution agreement— Issuance of equity interest in distributor as consideration for agreement
§ 24:129	Marketing and master distribution agreement

CHAPTER 25. SOFTWARE DEVELOPMENT AND LICENSING ARRANGEMENTS

§ 25:1	Software industry background—Industry standards
§ 25:2	—Preloaded versus customized software
§ 25:3	—Independent vendors
§ 25:4	—Systems management vendors
§ 25:5	—Packaged application software developers
§ 25:6	—Systems integrators and independent consultants
§ 25:7	—Software tool vendors
§ 25:8	—Operating systems vendors
§ 25:9	—Competitive factors
§ 25:10	Software development
§ 25:11	—Reverse engineering
§ 25:12	——Clean room procedures
§ 25:13	— — Physical code comparisons
§ 25:14	—Copyright protection
§ 25:15	—Contractual protection
§ 25:16	—Software tracers
§ 25:17	—Trade secret protection programs
§ 25:18	—Patent protection
§ 25:19	— —Compliance factors
§ 25:20	— —Commercial value and life expectancy factors
§ 25:21	——Competition factors
§ 25:22	—Basic terms of software development contracts—
	Description of services and development of
	specifications
§ 25:23	——Ownership rights
§ 25:24	——Development schedule

§ 25:25	——Delivery and acceptance testing
§ 25:26	——Fees
§ 25:27	——Representations and warranties
§ 25:28	— — Miscellaneous
§ 25:29	Software licensing agreements
§ 25:30	—Documenting the licensing arrangement
§ 25:31	—General forms of software license agreements—
-	Content licenses
§ 25:32	——Network licenses
§ 25:33	— —Integrated hardware and software agreements
§ 25:34	— —Integrated software and maintenance
	agreements
§ 25:35	 — Original equipment manufacturer licenses
§ 25:36	— —Bulk licenses
$\S 25:37$	 — Distribution and value-added reseller
	arrangements
§ 25:38	— Beta test licenses
§ 25:39	——Single-use licenses
§ 25:40	——Shrink-wrap licenses
§ 25:41	— —Multiple-use licenses
§ 25:42	—Technical and business factors for licensees
§ 25:43	— Working environment track record
§ 25:44	——Cost
§ 25:45	— —Financial, labor, and litigation history of
	vendors
§ 25:46	——Modification or development work
$\S 25:47$	 — Installation or implementation in phases
§ 25:48	——Negotiations
§ 25:49	—Technical and business factors for licensors
§ 25:50	—Hardware or system requirements
§ 25:51	—Development services
§ 25:52	—Scope of rights granted to licensee—Location of
	use
§ 25:53	——Use by subsidiaries and affiliates
§ 25:54	——Permitted individual users
§ 25:55	——Copies of software
§ 25:56	——Sublicenses
§ 25:57	——Modification of software
$\S 25:58$	——Exclusivity of rights
§ 25:59	—Establishing performance specifications
§ 25:60	 —Software capabilities and performance
	characteristics
§ 25:61	——Adaptability of software
§ 25:62	——Amount of consideration
§ 25:63	— Warranty and maintenance coverage

TECHNOLOGY MGMT & TRANSACTIONS

§ 25:64	— —Timing of performance measurement
§ 25:65	—Installation and acceptance
§ 25:66	——Acceptance procedures
§ 25:67	——Repair of defects
§ 25:68	—Compensation
§ 25:69	——Factors for determining compensation
§ 25:70	——Installment or royalty-based payment
	arrangements
§ 25:71	——Inspection and audit rights
§ 25:72	—Confidentiality
§ 25:73	—Documentation and support
$\S 25:74$	——Documentation
§ 25:75	— —Training
§ 25:76	— — Technical support
§ 25:77	—Maintenance
§ 25:78	——Covered services and exclusions
§ 25:79	— — Maintenance fees
§ 25:80	— — Discontinuation
§ 25:81	— — Updates and enhancements
§ 25:82	—Derivative works and improvements
§ 25:83	——Definitions
§ 25:84	— —Licensee's derivative works and improvements
§ 25:85	——Licensor's derivative works and improvements
§ 25:86	—Representations and warranties
§ 25:87	— Noninfringement warranties
§ 25:88	— —Limitations on direct damages and total
	liability
§ 25:89	——Incorporating sales materials
§ 25:90	——Authorization codes
$\S 25:91$	——Additional representations
§ 25:92	—Indemnification
§ 25:93	—Access to source code
$\S 25:94$	Employment and consulting agreements
§ 25:95	The Uniform Computer Information Transactions Act
§ 25:96	Open source software
§ 25:97	Tax considerations—Sales and leases of computer
	hardware and software—Treatment of developers,
	manufacturers, and lessors
§ 25:98	——Computers used for business purposes
§ 25:99	——Computers used for personal purposes
§ 25:100	—Depreciation of computer hardware and
	software—Computers and peripherals
§ 25:101	——Listed property
§ 25:102	——Business purpose requirement

§ 25:103	— Condition of employment
§ 25:104	— Record-keeping requirements
§ 25:105	——Personal use prohibition
§ 25:106	——Software

II. FORMS

§ 25:107	Software development agreement
§ 25:108	Master software development agreement
§ 25:109	Custom software development agreement
§ 25:110	Software usage agreement
§ 25:111	OEM license agreement
§ 25:112	Software license agreement (letter agreement)
§ 25:113	Prerelease software license agreement
§ 25:114	Software license agreement
§ 25:115	Software license, services, support, and
	enhancement agreement
§ 25:116	OEM software license agreement
§ 25:117	Master software vending agreement
§ 25:118	Software license agreement for master vending agreement
§ 25:119	Software maintenance agreement for master vending agreement
§ 25:120	Software maintenance agreement by authorized reseller
§ 25:121	Software click-wrap license agreement
§ 25:122	Software consulting agreement
§ 25:123	Agreement for joint ownership of computer software
§ 25:124	Escrow agreement
§ 25:125	Royalty agreement
§ 25:126	Royalty agreement (for film exposure technology)
§ 25:127	Software procurement and use policy
§ 25:128	Policy for purchasing or licensing software
§ 25:129	Software as a service agreement

CHAPTER 26. INTERNET TRANSACTIONS

§ 26:1	Introduction
§ 26:2	Organizational and physical components
§ 26:3	Transmission and storage of information
§ 26:4	Search tools
§ 26:5	Infrastructure
§ 26:6	Government regulation

Technology Mgmt & Transactions

```
§ 26:7
         —Service providers
         -Uniform regulations and laws
§ 26:8
§ 26:9
         Workplace and marketplace use
         —E-mail communications
§ 26:10
§ 26:11
         -Intranets
§ 26:12
         -Electronic commerce
§ 26:13
         —Content and service providers
§ 26:14
         -Business and financial risks
         Design and development
§ 26:15
§ 26:16
         —Types of design arrangements
§ 26:17
         —Preliminary negotiations and agreements
§ 26:18
         —Design agreements
§ 26:19
         —Consulting agreements
§ 26:20
         Hosting arrangements
§ 26:21
         Content and intellectual property issues
§ 26:22
         —Preexisting content
§ 26:23
         —Third-party materials
         — Content created by employees and independent
§ 26:24
          contractors
§ 26:25
         — License agreements with third parties
§ 26:26
         — — Third-party software
§ 26:27
         ——Linking agreements
§ 26:28
         —Ownership of content created during the
          development project
         --- Work made for hire
§ 26:29
§ 26:30
         ——Assignment
§ 26:31
         — —Licensing
         -Photographs
§ 26:32
§ 26:33
         -Music
§ 26:34
         Download licenses
         Intellectual property issues—Copyright law
§ 26:35
§ 26:36
         ——Scope of content licenses
§ 26:37
         ——Copyright notices
         — —Framing
§ 26:38
§ 26:39
         — — Third-party postings
         - Security and privacy disclaimers
§ 26:40
§ 26:41
         — Products for protecting online copyrights
§ 26:42
         —Trademark law
§ 26:43
         —Linking and framing
         -Meta-tagging
§ 26:44
         Domain names
§ 26:45
§ 26:46
         —Domain name levels
         —Name availability searches and registration
§ 26:47
§ 26:48
         Dispute resolution procedures
§ 26:49
         Joint ventures
```

- § 26:50 Advertising activities§ 26:51 —Disclosures and disclaimers
- § 26:52 —Endorsements
- § 26:53 —Content presentation
- § 26:54 —Sweepstakes
- § 26:55 —Sales
- § 26:56 —Data collection
- § 26:57 —Federal CAN-SPAM Act of 2003

II. CHECKLISTS

§ 26:58 Checklist for establishing an online business presence

III. FORMS

- § 26:59 Web site design agreement
- § 26:60 Web site hosting agreement
- § 26:61 Web site design nondisclosure agreement
- § 26:62 Work-made-for-hire agreement for Web site
- § 26:63 Web site consulting agreement
- § 26:64 Web site content license agreement
- § 26:65 Web site content development agreement
- § 26:66 Web site development legal questionnaire
- § 26:67 Domain name sale agreement
- § 26:68 Web site sponsorship agreement
- § 26:69 ASP service agreement

CHAPTER 27. MULTIMEDIA WORKS

- § 27:1 Introduction
- § 27:2 Strategies for collecting content for multimedia works
- § 27:3 Text
- § 27:4 —Copyright
- § 27:5 —Trademark
- § 27:6 —Titles
- § 27:7 —Characters
- § 27:8 Motion pictures
- § 27:9 —Copyright
- § 27:10 —Trademarks
- § 27:11 —Titles
- § 27:12 —Characters
- § 27:13 —Special effects
- § 27:14 Still images
- § 27:15 —Copyright

TECHNOLOGY MGMT & TRANSACTIONS

§ 27:16	—Trademarks
§ 27:17	—Characters
§ 27:18	—Privacy and publicity rights
§ 27:19	Music and audio
§ 27:20	—Copyright
§ 27:21	—Trademarks
§ 27:22	—Publicity rights
§ 27:23	—Sampling
§ 27:24	—Licensing
§ 27:25	— — Mechanical licenses
§ 27:26	——Synchronization licenses
§ 27:27	— —Master use licenses
§ 27:28	——Performance licenses
§ 27:29	— — Digital audio performance licenses
§ 27:30	Software
§ 27:31	—Copyright
§ 27:32	—Patents
§ 27:33	—Trade secrets
§ 27:34	Innovative patent protection for multimedia

II. FORMS

$\S 27:35$	Image merchandising license agreement
§ 27:36	Video license agreement
§ 27:37	Graphics license agreement
§ 27:38	Art work license agreement
§ 27:39	Illustration license agreement
§ 27:40	Music license agreement
§ 27:41	Synchronization and public performance license
§ 27:42	Publicity waiver and release

CHAPTER 28. TECHNOLOGY AND INTELLECTUAL PROPERTY ISSUES IN MERGERS AND ACQUISITIONS

§ 28:1	Introduction
§ 28:2	Confidentiality and nondisclosure agreements
§ 28:3	Due diligence investigation
§ 28:4	Substantive terms of the transaction
§ 28:5	Representations and warranties
§ 28:6	Legal and regulatory considerations
§ 28:7	Covenants and closing conditions

II. FORMS

§ 28:8	Asset purchase agreement
§ 28:9	Security agreement
§ 28:10	Patent License agreement
§ 28:11	Services agreement
§ 28:12	Purchase of technology assets relating to specific
_	product

APPENDICES

Appendix A. 2017 Antitrust Guidelines for the Licensing of Intellectual Property

Appendix B. European Union Technology Transfer Regulations

Table of Laws and Rules

Table of Cases

Index