

# Licenties & Contracten

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# Licensing and other Agreements

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- Licensing Agreements
- Technology Transfer Agreements:
  - Technology Development Agreements
  - R&D Agreements, such as Collaborative Research/Development Agreements (CRA/CDA), Joint Development Agreements (JDA)
- Material Transfer Agreements (MTA)
- Non Disclosure Agreements (NDA)
- But also Manufacture, Supply and Distribution Agreements

# (Broader) Collaboration Agreements, Cooperation Agreements, Joint Alliance Agreements

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## Contains Further Arrangements:

- Manufacturing Agreements (who manufactures the Product)
- Purchase and Supply of Material (Note: Vertical Restraints Regulation may limit term of exclusive supply arrangement)
- Agreements on Commercialisation (Products, Field of Use, Territory)
- Distribution Agreements

## What is the Primary Purpose of the Agreement?

- Licensing of IP? Technology Transfer Regulation applicable?

# Licensing Agreements

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- License Grants
  - Exclusive License
  - Sole License
  - Co-Exclusive License
  - Non-Exclusive License
  - Cross-Licenses
  - Development License (license to use IP only for research and development) or Commercial License (license to manufacture and/or commercialise)
- For Sole/Joint IP, Background/Foreground IP, Existing/Arising or Developed IP

# License Grants (1)

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- Licensed Rights vs. Retained Rights
  - Field-of-Use Limitations/Territory
  - (Co)Exclusive vs. Non-Exclusive
  - (Implied) obligation to Exploit vs. No obligation to Exploit
  - Alternative or Competitive Products (Alternative or Competitive R&D)
  - Scope of license and Licensee's Right to Sue
  - “Affiliated”, “controlled” or “related” companies, “change of control” and sublicensing
  - Variations on the grant (exceptions, reservations, exceptions, non-assertions, releases, cross-licenses and grant backs)
  - Licensing of Claims and License to “make and use” or “make, use and sell”

## License Grants (2)

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- Definition of “Licensed Rights”/”Licensed Patents”/”Licensed Products”
- Option to Purchase
  - Valuation and compensation
- Representations and Warranties
  - Title and Right to Grant
  - Right to Exploit/Freedom to Operate
  - Validity, Scope and Enforceability
  - Remedies for breach
  - Implied representations
- Severability Clauses

# Sole vs. Joint IP/Background Existing IP vs. Foreground/Arising or Developed IP

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## Sole IP: Party A's Sole IP

- 1. IP owned by, conceived or developed by or licensed to Party A prior to the Effective Date of the Agreement
- 2. IP conceived or developed by or licensed to Party A during the term of the Agreement but outside the scope of the collaboration pursuant to the Agreement
- 3. IP conceived or developed during the term and within the scope of the collaboration pursuant to the Agreement but conceived or developed independently by Party A alone, or with a third party (in case of non-exclusive collaboration)



**Existing IP**



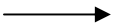
**Background Party A's Arising or Developed IP**



**Foreground Party A's Arising or Developed IP**

## Joint IP

IP conceived or developed during the term of the Agreement and conceived or developed jointly with Party B within the scope of the collaboration pursuant to the Agreement



**Foreground Arising or Developed Joint IP**

# Joint IP – Allocation of Ownership

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- Ownership of Joint IP:
  - Co-ownership of Joint IP vs. Sole-Ownership of Joint IP vested in one of the collaborating Parties
- Joint-ownership of Joint IP:
  - Messy, diverging rules in local, national Patent Acts
  - Applicable law to Agreement is not necessarily the applicable law to co-ownership
  - When Joint-ownership of Joint IP is unavoidable, there is a tendency to specifically deal with joint ownership in Agreement and stipulate that the section in the Patents Act of the applicable law and/or any provisions corresponding thereto, which exist in any other country granting co-ownership in respect of the Joint IP shall not apply to the Agreement
  - Agreement to deal with:
    - Procurement, Prosecution and Maintenance (Abandonment) of IP
    - Exploitation and/or Assignments and Licensing
    - Enforcement against infringement, unauthorised use or opposition
    - Information, Consultation, Assistance
    - Costs, Liabilities and damages arising out of prosecution and litigation
    - Dispute settlement