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Drafting Patent License Agreements §8.00

example, in the form of field licenses) with which the proposed nonexclusive grant would be in conflict. Particularly for the holder of a large and actively administered patent portfolio, these issues can be material and, depending on the facts, may require contract clauses that are meticulously drawn to avoid later charges of bad faith or deceit. Several imaginable situations are explored in the following discussion.

8.00 Reservation of Rights in the Grantor

It is quite common for the patent owner (say, a corporation) that sells a patent or grants an exclusive license under the patent to wish to reserve for itself some rights of continued use of the transferred invention. No such rights, however, may be reserved if the grantor, and the counterparty, have entered into an agreement that is intended to be an exclusive license.

Form 8.00A
Examples of Reservation of Rights in Grantor

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Drafting Patent License Agreements §10.04

patent applications have just been filed, or even ahead of that date. If, under those conditions, payments are to be made in respect to activities commencing in the near future, the basis for such payments should be carefully spelled out. Possible alternative bases for royalties are as follows:

1. All "contract products" (defined without specific reference to the content of the applications)
2. All products utilizing inventions "disclosed" in the applications
3. All products utilizing inventions "disclosed and claimed" in the applications
4. All products utilizing inventions covered by "allowed claims"
5. Any variation of one of the above.

If alternative 1, 2, or 3 is adopted, it will nevertheless often be reasonable, for the licensee's protection, to make some provision for the contingency that claims will not be allowed in the pending application or that the allowance of such claims will be excessively delayed. The following alternative clauses may be useful to consider in this connection.

Form 10.04A—Royalties Under Pending Patent Application: Alternative 1

INCLUDES ALMOST 200 SAMPLE FORMS!

Partial Listing of Sample Forms Contained on CD:

- Form 1.01 Definition of Licensed Information
- Form 2.02A Covenant Not to Sue
- Form 3.03 Early Termination of Sublicenses
- Form 5.04 "Modern" Agreement Opening
- Form 6.01 Examples of Stipulative Definitions
- Form 7.01D Patent Expiration Provision
- Form 8.01B Reservations (Prior Licenses)
- Form 9.01A Infringement Release
- Form 10.01A "Net Selling Price" Defined
- Form 11.01A Third-Party Infringement Provision
- Form 12.01A Assignment by Licensee
- Form 13.00A Effect of Judgment Dealing with Patent Validity or Scope
- Form 14.00E Elimination of Patent Rights Acquired by Payment From Scope of License Grant
- Form 15.00 Indemnification by Licensor
- Form 16.00 Filing and Prosecution of Applications
- Form 17.00A Integration Provision
- Form 17.02C Choice of Law Provision 3
- Form 18.01 Term and Termination
- Form 19.00B Release for Future Infringement
- Form 20.00 Assent
- Form 21.04A Outline of Technology License Terms 1
- Form 22.00B Place of Payment, Rate of Exchange, Tax Burden Allocated
- Form 23.03A Label License Notice
- Form 24.04 Limited License Pursuant to Sale

Plus, many, many more!

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Form 10.04A
Royalties Under Pending Patent Application

Form 17.02E
Alternative Venue Provision