

INTERNATIONAL LICENSING AND TECHNOLOGY TRANSFER: PRACTICE AND THE LAW

Author Guide

[A] Aim of the Publication

International Licensing and Technology Transfer: Practice and the Law provides an authoritative, single-source commentary on licensing in an international context. The publication is written by practitioners for practitioners, and provides many useful insights into both the law and practice involved in international licensing. The publication currently includes input and commentary from practitioners in over 20 countries.

Only *International Licensing and Technology Transfer: Practice and the Law* delivers:

- A Master Agreement to be used as a patent license template by parties entering into a licensor/licensee relationship
- Clause-by-clause commentary, both generic and on a country-by-country basis
- Insights into how clauses will likely be interpreted under the systems of the world's key jurisdictions
- An overview of the legislation, rules and policies regarding and affecting licensing on a country-by-country basis
- Step-by-step explanations of the stages involved in preparing to enter into and negotiating a license agreement, including an in-depth discussion of both licensor and licensee due diligence
- Methods for determining or reliably estimating the value of the intellectual property being licensed
- Coverage of the tax considerations associated with the structuring of an international license
- Insights into antitrust issues that licensing professionals need to take into account when drafting and negotiating an international license agreement

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[C] Outline

Please note that only Chapters 2, 5, 6 and 7 have country reports, the other chapters are updated by the Editors-in-chief.

CHAPTER 1. INTRODUCTION

CHAPTER 2. LICENSING INTELLECTUAL PROPERTY RIGHTS: LEGISLATION, REGULATION, DIRECTIVES AND POLICIES

1. What Legislation is Relevant to Intellectual Property and Licensing in the United States?
 - 1.1. Intellectual Property
 - 1.2. Antitrust
2. Licensing Intellectual Property rights in [name of the jurisdiction]

CHAPTER 3. PREPARING TO ENTER INTO AND NEGOTIATING A LICENSE

CHAPTER 4. INTELLECTUAL PROPERTY VALUATION AND ROYALTY DETERMINATION

CHAPTER 5. TAX CONSIDERATIONS IN STRUCTURING INTERNATIONAL LICENSING AND TECHNOLOGY TRANSFER

1. Overview of the Tax System
2. Taxation of Intellectual Property in [name of the jurisdiction]

CHAPTER 6. COMPETITION LAW

1. Introduction
2. Cross-Licensing, Patent Pools & Patent Settlements
3. Refusals to License
4. Enforcement of Intellectual Property Rights
5. Antitrust Analysis of Particular Restrictions in License Agreements
6. Price Issues in Intellectual Property Licenses

CHAPTER 7. PATENT LICENSES

- 7.1. Drafting Patent Licenses: Commentary and Sample Clauses
 - 7.1.1. Generally
 - 7.1.2. Contracting Parties: Confirming Identity and Basic Searches
 - 7.1.3. Recitals
 - 7.1.4. Definitions
 - 7.1.5. Grant of License
 - 7.1.6. Term
 - 7.1.7. Consideration
 - 7.1.8. Payments
 - 7.1.9. Taxes
 - 7.1.10. Performance
 - 7.1.11. Quality Control and Identification of Patents

- 7.1.12. Reporting
 - 7.1.13. Accounts and Records Audit
 - 7.1.14. Sub-licensing
 - 7.1.15. Improvements
 - 7.1.16. Most Favoured Licensee Clause
 - 7.1.17. Confidentiality
 - 7.1.18. Prosecution and Maintenance of Rights
 - 7.1.19. No Challenge Clauses
 - 7.1.20. Infringement by Third Parties
 - 7.1.21. Defence of Proceedings
 - 7.1.22. Representations and Warranties
 - 7.1.23. Limitation of Liability/Exclusion of Liability
 - 7.1.24. Indemnity/Insurance
 - 7.1.25. Dispute Resolution
 - 7.1.26. Termination
 - 7.1.27. Consequences of Termination
 - 7.1.28. Force Majeure
 - 7.1.29. Survival
 - 7.1.30. Governing Law and Jurisdiction
 - 7.1.31. Assignment
 - 7.1.32. Notices
 - 7.1.33. Entire Agreement
 - 7.1.34. Relationship of Parties
 - 7.1.35. Waiver
 - 7.1.36. Variations
 - 7.1.37. Severability
 - 7.1.38. Further Assurances
 - 7.1.39. Counterparts
- 7.2. Patent License Agreements

CHAPTER 8. OTHER AGREEMENTS

8.1. Patent and Know-How Transfer Agreement