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NEGOTIATING AND DRAFTING LICENSING AGREEMENTS

PATENT, TRADE SECRET AND TECHNOLOGY LICENSING: KEY ELEMENTS

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I. Introduction

It will hardly come as news to you that we do have a new ball game in the field of intellectual property (IP) licensing. A simple, straight-forward plain-vanilla patent, trade secret or trademark license is practically a thing of the past; instead, complex and sophisticated hybrid agreements, option/license agreements; joint venture, corporate partnering, co-promotion or co-marketing arrangements; strategic alliances and consortium licensing (a la Sematech) are the order of the day.

And there are other very significant developments and trends in licensing attitudes and practices, in IP valuation and royalty setting or other quid pro quo choices, such as, e.g. cross licenses. And we have an entirely different antitrust climate where restrictions commonly found in license agreements are generally viewed as pro-competitive rather than anti-competitive and IP is considered property — as it should be — rather than a monopoly.

However, the basic principles as well as the key elements and terms of technology licenses will likewise be found in these modern-day sophisticated arrangements and, therefore, need to be kept in mind and mastered.

II. Licensing Case History — Gould Laser Patents

1. This licensing story played out in the eighties. But it is not ancient history at all. Invaluable lessons can be learned from the masterful licensing scheme of the Gould laser patents, as it illustrates important licensing concepts and ingenious licensing strategies. First and foremost, it shows that one can be very creative in crafting win-win license agreements and thereby resolve intractable controversies and disputes. As was stated by Tom Arnold:

> "(T)he various clause concepts are as keys upon a piano. Each may be played loudly, softly, staccato or with lingering resonance; and each may be played in solo melody or in chords with the others in infinite variety; they constitute a piano upon which infinite varieties of transactions can be played." (Tom Arnold, "Basic Considerations in Licensing", Les Nouvelles, v.15, p.171, 177, Sept. 1980)

2. Gould invented the laser during the late 1950's while a graduate student at the University of Columbia, but he was not taken seriously for decades. Now with hundreds of licensees and possibly more than $100 million in gross licensing revenue, he is recognized as a laser pioneer.

   Gould's early efforts to obtain patent protection for his invention were consistently rebuffed by the USPTO. Interferences were declared between his applications, the first of which was filed on April 6, 1959, and the applications of other companies.

A number of U.S. patents were, however, eventually issued to Gould, and three of these were broad, basic patents and commercially very significant. The first was U.S. Patent No. 4,053,845, entitled "Optically Pumped Laser Amplifier", which was issued on October 11, 1977. This patent covered most solid state lasers but before this patent could be licensed or asserted, three reexamination requests were filed in 1982 and in 1983. The reexamination certificate, confirming the patentability of all claims, was not issued until 1987, following protracted legal proceedings. Earlier filed patent infringement litigation against Control Laser Corp. in the Middle District of Florida, had been stayed pending the outcome of the reexaminations.

The second commercially significant patent that issued to Gould on July 17, 1979, U.S. Patent No. 4,161,436, was entitled "Method of Energizing a Material", and covered most uses of commercial lasers. As was the case with the preceding patent, multiple reexamination requests were filed in late 1982 with the patentability of all claims not confirmed until 1988. Again, extensive court proceedings were required before this favorable result was achieved.

U.S. Patent No. 4,704,583, entitled "Light Amplification Employing Collisions to Produce a Population Inversion", the third major Gould patent, did not issue until November 3, 1987. This patent, covering gas discharge lasers was only issued after a favorable CAFC decision the preceeding June.

The licensing effort for the Gould patents had initially been undertaken by Refac Technology, a New York City-based invention brokering and licensing company, with notable lack of success. It was not until Patlex Corp. took over this effort in the early 1980's that the licensing effort took off. Patlex secured public funding and engaged Richard Samuel, who had been working extensively on the Gould laser patents while a partner at the law firm of Lerner, David, Samuel et al, to take over active management of Patlex.

Since efforts to license the '845 Patent were relatively stymied by initially unfavorable decisions in the reexamination proceedings in the USPTO, coupled with a general unwillingness of lasers manufacturers to take a license before the Control Laser suit in Florida was completed, much effort was directed to licensing the '436 Patent to laser users. While a number of early user licenses, such as AT&T, GE, GM, and IBM involved conditional payments, payment schedules, payments based on laser usage, minimum and maximum payments and other non-standard features, the user licensing program quickly evolved into a standard format in which the laser user paid to Patlex a 6% royalty on the purchase price of all infringing lasers purchased from an unlicensed laser manufacturer. The licensed laser user paid nothing to Patlex for lasers purchased from a licensed laser manufacturer.

This effort to license laser users was designed to provide revenue to Patlex, but more importantly, to encourage the laser users to prevail upon the laser manufacturers to take a license directly from Patlex at a maximum royalty rate of 5%. Until, however, the outcome of the Control Laser litigation, this strategy had only limited success.

The Control Laser suit proceeded to trial in September of 1987 following the favorable conclusion to the reexamination of the '845 Patent earlier that year. In October 1987, the jury found that the '845 Patent was both valid and infringed. During the damages phase of the trial, which immediately followed, Patlex reached settlement agreements with Control Laser, and also with Quantronix, which had previously agreed in separate litigation to be bound by the outcome of the Control Laser suit.

The terms of these two substantially identical licenses, which became standard agreements, besides having significant payments for past infringement, included a 5% royalty for lasers infringing the '845 Patent. Lasers covered by the '436 Patent required a 3% royalty until reexamination of the '436 Patent was completed (which occurred in April 1988) and a 5% royalty rate thereafter. A step-up royalty rate was provided for gas discharge lasers under the '583 Patent with each licensee having the opportunity to select two gas discharge laser competitors to trigger royalty rate increases from the initial royalty rate of 2% to the final royalty rate of 5%. When one of the named competitors, namely, Coherent or Spectra-Physics, the two largest laser manufacturers and hold-outs, was either licensed or sued by Patlex, the rate increased to 3.5% and the final rate became effective when both named competitors were either licensed or sued. A multiple patents provision prevented the payment of more than one royalty where the royalty bases overlapped and another provision limited the royalty rate on foreign sales to 2%.

Following the licensing of Control Laser and Quantronix, the licensing activity began to accelerate and many other laser manufacturers and laser users quickly became licensees. Coherent and Spectra-Physics (then a subsidiary of CIBA-GEIGY) remained out of the fold until the fall of 1988.

The breakthrough came, first with Coherent, followed closely by Spectra-Physics, with the negotiation of volume breakpoints (or descending royalty rates), at which the royalty rates would be reduced from the standard rates as sales volume increased, as follows: $0-$15 million, 5.0%; $15-$20 million, 3.0%; $20-$25 million, 1.0%; and $25 million and above, 0.5%. Spectra-Physics' sales volume was far in excess of $25 million. These same volume breakpoints were, of course, offered to all existing licensees in accordance with the usual most favored licensee (MFL) provision of the licenses.

Most licensees paid a 5% royalty, since most licensees had U.S. sales under $15 million. Spectra-Physics' effective royalty rate was about 1.7% due to the volume breakpoint scheme. Since Spectra-Physics further negotiated caps on royalties and a lump-sum payment on "present value" terms, their total royalty obligations were discharged by a check in an amount of less than $10 million. This contrasted very favorably with litigation cost exposure of over $5 million. And, in case of defeat, a total royalty exposure of about $50 million. Although other licensees insisted on getting the "same effective rate" under the MFL clause rather than just the "same terms," no litigation ensued about this issue. In fact, when Amoco was allowed to partially "pay-up" their license and this deal was offered to other licensees, there were no takers.

3. This case history clearly illustrates the dynamic interplay of step-up royalty/MFL clauses and a descending royalty scheme, with the former inducing the smaller players to sign up when the bigger competitors — here Coherent and Spectra-Physics — are holdouts and thus have an additional competitive edge by not paying any royalties. And the descending royalty schedules entice the holdouts to take out licenses, inasmuch as their total royalty exposure is significantly reduced, e.g. down to about 1.7% in the case of Spectra-Physics.

   (This Licensing Case History is based partly on my own experience and materials and partly on a memorandum provided me for use in my IP Licensing/Technology Transfer classes by Albert Miller, former Patlex Director of Patent Operations.)

III. Assignment Rather Than an Exclusive License?

1. One of the more memorable and challenging licensing experiences I had in my whole career was when I had to go to Australia and New Zealand to chase down an elusive invention and an elusive inventor, owner and prospective licensor and had to come back with a signed patent application ready for filing in the U.S. and Canada, because we were running up against a publication statutory bar. And I had to bring back an executed exclusive license agreement, ready for execution by my management as well.

   The invention had to do with a novel bovine parturition control method, which was invented by a veterinarian of a New Zealand dairy company and employed a pharmaceutical product of CIBA-GEIGY, namely, a long-acting gluco-corticoid (dexamethasone TMA). I did come back with a finished patent application, which I promptly filed upon return home in the U.S. and Canada, the only countries where veterinary methods could be patented and grace periods still permitted us to do so. And I also came back with an assignment with a provision for installment payments based on net sales of the parturition-inducing product. Why an assignment and not a license? I don't recall why I prepared an assignment. Perhaps it was intuition, because it was not until later that I learned of Tom Arnold's suggestion in his article on licensing that

> "what is perceived by the businessman as an 'exclusive license,' is best negotiated into the form of a patent assignment ... with rights to reversions of title if royalties are not paid ... because the exclusive license differs from assignments only in areas (like who sues infringer and has authority to compromise in settlement) which may be better borne by the party actively in the business than by the passive transferor of the technology." (Tom Arnold, *ibid.*)

Indeed, the New Zealand dairy company was merely a "passive transferor of the technology" and my company was going to have to do considerable additional R&D work to obtain the requisite government approvals for commercialization.

Relevant provisions in this assignment were as follows:

> (2) Assignor hereby sells, assigns, transfers and conveys to Assignee, its successors and assigns, its entire right, title and interest in and to the U.S. and Other Patent Rights, the same to be held and enjoyed by the Assignee for its own use and benefit as fully and entirely as this right, title and interest would have been held and enjoyed by Assignor if this sale, assignment, transfer and conveyance had not been made. At Assignee's expense, Assignor will from time to time, as and when requested by Assignee, execute, or have executed and deliver to Assignee such further instruments, make available to Assignee such further information in Assignor's possession, and do and have done such further acts as may be necessary or which Assignee may deem advisable in order to establish, perfect, or maintain in Assignee the entire right, title and interest in and to the U.S. and Other Patent Rights.
>
> .....
>
> (3)(a) In consideration of the sale, assignment, transfer and conveyance by Assignor to Assignee, and in full payment therefor, Assignee will, on or before March 31, 1983 and on or before March 31 in each year thereafter until the expiration of the last to expire of the patents included among the U.S. and Other Patent Rights, pay to Assignor, as an annual installment of the purchase price for the U.S. and Other Patent Rights, an amount equal to 1% of the Net Sales of Agreement Products made by Assignee and its licensees, if any, during the preceding calendar year; provided that in any event the amount payable to Assignor with respect to the calendar year 1984 and each subsequent year shall be not less than $10,000.
>
> .....

(6) Assignee may, on 30 days prior written notice to Assignor, terminate this Agreement by reassigning all right, title and interest in and to the U.S. and Other Patent Rights to Assignor.

2. Interestingly, a reversion or revestment clause in such an assignment can raise the issue of whether it is primarily a security device for assignor or creates a termination power in assignee. This happened in *Ortman v. Stanray* Corp., 168 USPQ 617 (7th Cir. 1971), where a dispute arose over the following provision:

"4. Assignor, on thirty (30 days advance notice to or from Stanray, shall be revested with the entire right, title and interest in and to the said patent rights if Stanray fails or refuses to make the payments to Assignor provided for in paragraph (2) hereof or if Stanray discontinues manufacturing or acquiring milling head inserts of the type disclosed and claimed in the said patent application Serial No. 812,320 for more than one (1) year."

In this case, payments were to be made for ten years or for the life of any patent that issued but assignee stopped payments after five years in the belief that the patent did not cover its product. An action for infringement and breach of contract ensued. While the lower court ruled in favor of assignee, finding the contract clear and unambiguous on its face, the Court of Appeals reversed and remanded for admission and consideration of relevant collateral evidence, proffered by assignor to show that the clause in issue was primarily a security device for assignor.

IV. Royalty Differentiation Between Exclusive and Non-exclusive Licenses

1. Misconceptions about royalties abound, e.g., licensors can charge what the traffic will bear, licensors can recoup their R&D expenses, the cost of the development of a technology is a big factor, there are royalty standards within each industry to go by, etc. None of this is necessarily true. Indeed, there is a limit to what a licensor can charge and very often it is the licensee's economics, not the licensor's that controls the royalty determination. First of all, when it comes to royalties less is more and greed rarely if ever pays off. At CIBA-GEIGY several agreements went south over the years because the royalties were too high, the profitability was not there and the deals could not be sustained in the end. On several other occasions, agreements had to be renegotiated for lower royalties for the same reasons.

2. Actually, the cost to licensor of the development of the technology is not a factor. "The research and development costs of developing the TI (Technical Information) are sunken expenses expended by the licensor whether or not the TI is licensed and, therefore, should not be considered by the licensor in arriving at a suitable royalty." (Martin Landis, "Pricing and Presenting Licensed Technology", The Journal of Proprietary Rights, p. 18, 20, August 1991). The public's interest in buying a product and, thus, "the value of a technology in the marketplace is essentially unrelated to the cost of developing it ... except insofar as it aids estimation of the cost in time and money of the licensee's alternative," namely, competitive development of equivalent technology. (Tom Arnold, "1988 Licensing Law Handbook," Clark Boardman, Appendix C, p. 295, 308)

Now what about royalty standards in industry? Aren't there norms in each industry to go by? This is the common belief as there are figures often being bandied about as industry averages. In an article on "Patents for Sale: Evaluating the Value of U.S. Patent Licenses" (8 EIPR, 385, 389 1995), John Romary of Finnegan, Henderson in Washington, called industry average royalty rates "folklore" and "suspect as a royalty-rate guide." He pointed out, for example, that "a 5% running royalty for a non-exclusive license helps very little in evaluating an exclusive license on different, but related technology and a 1.5% running royalty on technology that can be effectively designed around is equally unavailing in pegging the value of a pioneer patent critical to the competitor." (*Ibid.*)

However, Romary allows as how such averages provide additional data points, and he lists for chemicals 1-5%, electronics 1-5%, computers 3-5%, consumer products 2%, pharmaceuticals 4-15%. He also states that these figures are based on the net sales price and a non-exclusive license and — note this —that a "20 to 50 per cent premium" and "as much as a 300 per cent premium ... in the pharmaceutical field" may be a reasonable average for an exclusive license. (John Romary, *id.* at 390)

3. In a licensing situation, that came to my attention a while back, I came across the statement that " based on research into the matter, it can be seen that there was generally, and consistently, a ratio of on the order of (*sic*) 2 to 1 in the royalty rates, as between exclusive and non-exclusive licenses, regardless of the specific subject matter."

   While it is generally realized that the exclusivity *vel non* is an important factor in royalty determination, quantification regarding the magnitude of this factor is harder to come by.

4. Anent factors to take into consideration in royalty setting, Tom Arnold discusses and tabulates "100 Factors Involved in Pricing the Technology License" in Appendix C of the above-referenced "1988 Licensing Law Handbook". Hence, it is a handy checklist, even though not all factors play a role in a given technology license deal. He groups them under the rubrics of intrinsic quality, protection and threats of protection, values brought to the table by the licensee, IP portfolios and market, competitive, risk, legal and government regulatory considerations, and it is clear from his discussion that among the most important and weighty factors are a) the stage of development of the subject technology (embryonic and untested v. tested and commercial), b) the strength of the IP rights (solid v. weak, easy to design around *vel non*), and c) the degree of exclusivity (exclusive v. non-exclusive), discussed above.

   And the fact that many other operative clauses in a technology license have economic weight, as for example, payment structures and schedules, MFL clauses, representations and warranties, etc., needs to be kept in mind, so that royalty setting is not the first task in licensing negotiations but the last one, one to be tackled after all the terms have fallen into place.

V. Conduct and Relationship Leading to Implied Licenses

1. Licenses may be granted not only by means of an express written agreement, be it a formal document or a letter agreement — the most common and best form — but also via an informal written agreement, an oral or parol agreement or an implied license as a consequence of conduct or relationship of the parties.

   A formal written agreement may become effective and enforceable even if the agreement is not executed and delivered, provided the terms are agreed to and an intent to be bound is shown. An informal written agreement, via e.g. informal correspondence or a letter of intent, is likewise effective and enforceable, if it is intended to be a prelude to a formal contract and if an intent to be bound in advance is exhibited or if a formal contract is viewed as a mere memorialization. If there is no such intent, no license enters into force until there is execution of a formal contract. Hence, it is advisable to evidence lack of intent by a special letter agreement to that effect.

2. An oral or parol agreement is difficult to enforce to begin with because of its nature, especially after passage of time, and, of course, is unenforceable if it is not to be performed within a year, is void if it falls within the statute of frauds, and is not effective if it is an assignment in legal effect against a subsequent assignee without notice.

   Conventional wisdom has it that if you don't have it in writing you don't have it or a "verbal agreement isn't worth the paper it's written on" (Samuel Goldwyn). On the other hand, McDonald has suppliers with whom they have been doing business with "for 40 years on the basis of a handshake, with nothing on paper." (The National Law Journal, p. B5, Feb. 3, 1997). But enforcing handshake agreements and letters of intent is difficult and risky, as can be seen from the case of *Fox News Network v. Time Warner*, (1997 W.L. 271720 (E.D.N.Y., May 16, 1997)), which raises the issue of when is a deal a deal. In connection with the merger of Time Warner and Turner Broadcasting in 1995, Time Warner needed an additional unaffiliated cable news service and hence negotiated with two news services, namely, MSNBC and Fox News. When Time Warner chose MSNBC over Fox, Fox sued, alleging that Time-Warner had assured Fox during their negotiations that they were in agreement and all details were set; but the court found that they never had reached an agreement, inasmuch as there was no clear evidence that they intended to be bound, had a meeting of the minds on all material terms and there was an unequivocal acceptance of those terms. Richard Tashjian with reference to the *Fox News* case also discusses the case of *Shann v. Dunk* (84 F.3d 73 2d Cir. 1996)) in his article "When is a deal a deal? A recent 2d Circuit decision established a framework for determining when negotiations have actually led to the creation of a contract." (The National Law Journal, p. B4, June 23, 1997) In the *Shann* decision, two types of preliminary agreements were summarized. Firstly, a "type I" agreement "where all essential terms have been agreed upon in the preliminary

contract, no disputed issues are perceived to remain, and a further contract is envisioned primarily to satisfy formalities" (84 F. 2d at 77) and, secondly, a "type II" agreement "where the parties recognize the existence of open terms, even major ones, but, having agreed on certain important terms, agree to bind themselves to negotiate in good faith to work out the terms remaining. In type II agreements, the parties do not bind themselves to conclude the deal, but only to negotiate in good faith toward conclusion within the agreed framework." (*Ibid.*)

According to Richard Tashjian:

> "The difference in consequences flowing from a breach of a type I agreement or a type II agreement can be significant. Under a type I agreement, a party is generally entitled to recover benefit-of-the-bargain damages. The damages flowing from a breach of a type II agreement, however, are not so clear. While some courts have awarded benefit-of-the-bargain damages, other courts have only awarded reliance damages on the theory that it would be unreasonable to assume that such an 'agreement to agree' would have ripened into a contract." (Richard Tashjian, *ibid.*)

3. Not infrequently, however, a license may come into being by implication through conduct and/or relationship between parties. Thus, implied licenses can arise from acquiescence and laches, where patent owners sit on their rights rather than enforcing them against infringers.

   The most common and best-known implied license is a so-called shopright arising from an employer-employee relationship. In a general employment and in the absence of an express agreement, requiring an employee to assign an invention made by him or her during the terms of employment (and afterwards pursuant to a trailer clause), an employer may acquire a shopright or an implied non-exclusive limited license to use such an invention for its own purposes and only for its own purposes, provided the invention was made on company time with company resources.

4. Even in a licensor-licensee relationship, an implied license may be acquired, although a licensee under one patent does not ordinarily or necessarily include an implied license under another patent. However, it may occur in the case of an unlicensed but indispensable patent as for example a dominant patent that issued to the licensor later or an earlier-issued dominant patent that is later acquired by licensor.

5. Likewise, in a seller-buyer relationship, where the seller sells an article or component for use in a patented method or combination, the buyer may acquire an implied license under seller's method or combination patent, although ordinarily the sale of an element of a patented method or combination carries no implied license.

   However, an implied license in a seller-buyer relationship requires clear implication, as is illustrated by the *Jacobson v. Cox Paving Co.* decision, where Jacobson sued Cox for infringement of Jacobson's rubber-asphalt paving material patent. Cox defended on the grounds that Jacobson had given him an implied royalty-free license by virtue of Jacobson's sale to Cox of a used asphalt-rubber distributor truck, which could be used to apply the patented asphalt-rubber material. Cox's president admitted that

he had paid Jacobson royalties for a single asphalt-rubber paving job recently and that the company had received a proposed patent license agreement and it had had several prior discussions with Jacobson regarding the payment of royalties. According to the court, there are two requirements to support an implied license and Cox failed on both counts: (1) The circumstances of the sale must plainly indicate that a grant of a royalty-free license should be inferred; and (2) the product must have no other non-infringing uses. When an equipment purchaser is notified at the time of sale of a requirement for a patent license, such express notice precludes the grant of an implied license under the patent. It was also shown that the truck, which was sold by Jacobson to Cox, could be, and had in fact been, used by Cox to apply conventional asphalt paving materials. This in combination with Jacobson's express royalty demands, according to the court, eliminated any basis for a finding of a royalty-free implied license running from Jacobson to Cox. (*Jacobson v. Cox Paving Co.*, 19 USPQ2d 1641 (D. Arizona 1991)).

6. Finally, in a business relationship, conduct, as for example, close cooperation on an innovative project can give rise to an implied license. Witness the recent case *of Wang Laboratories v. Mitsubishi Electronics* (41 USPQ2d 1263 (Fed. Cir., 1997)) — a case of the unwritten patent license. In this case, Wang's James Clayton invented the basic memory module, known as a SIMM (single in-line memory module). Wang was not a components manufacturer and did not want to develop and manufacture SIMMs. Rather, it wanted companies like Mitsubishi to make SIMMs in large quantities so that SIMMs could be used economically in Wang's computers. But memory manufacturers did not want to make Wang's design until they knew that the SIMM would be a general standard in the industry. Wang began to convince the Joint Electronic Device Council (JEDEC) to adopt the Wang SIMM as an industry standard, which JEDEC did. In the meantime, Wang had been talking with Mitsubishi to convince it to enter the SIMM market in a big way so that prices would come down. Mitsubishi complied and Wang began buying Mitsubishi's SIMMs. Wang then asserted its patents, which it also had obtained in the meantime, against the industry that it had created. It sued everybody, including Mitsubishi. The whole industry opted to settle rather than fight, with Wang issuing more than 40 licenses at a royalty rate of 3%. The one major holdout was Mitsubishi. Mitsubishi felt betrayed, inasmuch as Wang had induced Mitsubishi to enter the field, had encouraged it to spend millions of dollars on research and development, had hidden the fact that it was seeking patent protection, and now was suing Mitsubishi for doing exactly what Wang had asked it to do. Moreover, Wang had clearly gotten a free ride on SIMMs, since Mitsubishi had not charged its costs for engineering SIMMs to Wang, and Wang was able to charge lower prices. Given this behavior pattern of strong inducement by Wang leading directly to Mitsubishi's entry into the field, the court concluded that Mitsubishi had an implied license under Wang's patents.

   This case shows that the formerly infrequently used and often unsuccessful implied-license defense, where a court must scrutinize the entire course of conduct between the parties to determine whether a license was created in the absence of a written document, can be successful.

VI. Other Important Topics in Technology Licensing

While the above sections deal with some major challenges, opportunities and problems in technology licensing (patent, trade secret or hybrid patent/trade secret licenses), there are many others, some of which will be briefly commented on in this section, based in part on Brunsvold & O'Reilly, Drafting Patent License Agreement, Fourth Edition, BNA 1998, which I use as the "Bible" in my Licensing/Technology Transfers classes.

1. Ways to protect licensees from third-party dominant patent risks.
Not infrequently, a licensee finds the exercise of the license blocked or impeded due to the existence or issuance of a third-party patent, mostly a dominant patent, a patent on a component or subcombination, or a patent one is aware of and rules out as being infringed but later turns into a threat due to a novel interpretation of the claims or claims scope or a novel (twisted) doctrine of infringement by the patentee (as has happened in my experience). Thus, this may occur in spite of rigorous due diligence prior to the conclusion of the license.

   For its protection in such a situation, licensee should negotiate a hold-harmless clause with licensor and pursuant to this clause licensor would get licensee another license, provide a non-infringing alternative or defend an infringement suit (but not open-endedly). It could also be a cost-sharing arrangement, if any royalties have to be paid by licensee to the third-party patentee or if it comes to an infringement suit. As a last resort renegotiation of the royalty provision in the first license is a possibility. We had once a 12% royalty-bearing license with Party A. When subsequently we had to pay 6% to another "dominant" patentee, we were able to renegotiate or offset the 12% royalty to 6%, so that our total royalty exposure remained at 12%.

   In another case, technical people had concluded a trade secret agreement (without the benefit of IP counsel), which was woefully inadequate for several reasons, e.g. silent on exclusivity and confidentiality obligations, and in particular on facing up to an imminent third-party patent issuance, which I was already aware of.

   I, as a licensee, was then able to include a provision, which I was able to successfully assert later, that no further payments apart from the down payment would be due if the technology in question turned out to be covered by a dominant patent.

   And for the benefit of Licensor, it should be pointed out that Licensor should not represent and warrant that the licensed subject matter "does not infringe any valid rights of any third party" (as was suggested in a recent issue of the Intellectual Property Strategist) because licensor can't foresee what licensee will do and evaluate the risk nor can licensor foresee, what submarine patents or other secret pending patents might issue. All licensor can represent and warrant is that it is not aware of any patents of others that would be infringed.

2. Better alternatives for the common "Best Efforts" clause.
Best efforts clauses are routinely written into agreements. A "best efforts" clause to the effect that ABC "shall exercise its best efforts to exploit the Licensed Products," is useless as a device for the protection of licensor where licensee's performance is unexpectedly low or inadequate. The above clause led to litigation once, in which I served as an expert witness.

It is dubious language that courts can interpret strictly or loosely as merely stating a theme rather than a course of conduct. Use of such language as "reasonable diligence consistent with the interests of the business" or "'Best Efforts' shall mean those efforts which a reasonably prudent person knowledgeable of such matters would consider desirable, necessary or commercially reasonable to further the intentions of the Parties hereunder" would be preferable or, better yet, statements of objective, quantitative criteria of performance or requirements for minimum annual royalty payments. Best of all are such mechanisms as conversion from exclusive to non-exclusive status or a termination power if specified levels of performance or annual minimums are not maintained. Of course, a lumpsum up-front payment would obviate the problem completely. In an assignment with installment payments, reversion of all right, title and interest to assignor is, of course, the remedy of choice for below-par performance.

In the absence of a best-efforts clause, an obligation to employ best efforts has generally been implied where the only consideration for grant of a license are royalties. The courts have found it necessary to imply a covenant to employ best efforts as a matter of law when the contract would otherwise lack mutuality of obligation and be inequitable.

However, in the *Permanence Corp. v. Kennametal, Inc.* (15 USPQ 2d 1550 6th Cir, 1990)) decision, the court held that where licensee had paid a substantial lumpsum and an advance on royalties when it took out the license and again when it permissibly converted the non-exclusive license to an exclusive license, no best efforts need be implied, because licensor had protected itself against the possibility that licensee would perform poorly.

3. What the all-important grant clause should and should not contain.
The grant clause is the most important clause in a license agreement. A typical basic grant clause might have the following five elements:
1) A grants (or agrees to grant or grants and agrees to grant)
2) a (non) exclusive (or sole) license under certain IP Rights
3) to make, have made, use, offer to sell, sell or import Licensed Products (or to practice Licensed Methods)
4) throughout the territory
5) for the duration of the Agreement.

Typically, however, such modifiers as "indivisible," "irrevocable" and/or "non-transferable" are inserted before "(non) exclusive license" in boilerplate fashion. This is inadvisable. The term "indivisible", for instance, will take away the right "to have made", which normally is implied and included in the term "to make," when it is not specifically recited. Ambiguity may result. It might also rule out the right for subsidiaries and affiliates to operate under the license. Many a dispute and lawsuit were caused by this phraseology. Nor does the term "irrevocable" belong into the grant clause. Conditions, if any, of revocability should be recited in the termination clause. The "non-transferable" language, if found in the grant clause, would not grant any right to assign or sublicense and would be ambiguous if assignment or sublicensing rights are recited. While the phraseology "nontransferable, except for the assignability provisions of Article X hereof" would cure this defect, it still should best be left out.

As regards the bundle of rights to be granted (element 3), it is preferable to track the statutory language. Other terms that are often added, e.g. "lease," "dispose of", etc. may lead to a restrictive reading because of the general rule that inclusion of one means the exclusion of the other.

Anent the territory of the license, the right to sell in foreign countries goes with a grant of a U.S. license, as a general rule, except in countries where there are foreign counterparts. But in light of frequent litigation, this issue is still quite unsettled. In *Mid-West Conveyor Co. v. Jervis Webb Co.* (39 USPQ 2d 1754 (10th Cir. 1996)), the following provision was construed as a grant of a world-wide license:

> Webb hereby grants to Mid-West and Mid-West hereby accepts a non-exclusive non-transferrable license to manufacture, use and sell, or have manufactured for use and sale by Mid-West, power and free conveyor systems incorporating any invention disclosed and claimed in the licensed patent (U.S. Patent No. 4,616,570) and such conveyor system being hereinafter referred to as a licensed systems.

Even the following clause was hotly contested in this regard:

> Licensor hereby grants and agrees to grant to Licensee a sole license under Licensed United States Patent Rights to make, have made, use, and sell Licensed Products throughout the U.S. during the term of this agreement.

I was an expert witness in an arbitration proceeding involving the above clause. However, there was a settlement without a clearcut decision.

However, *Elliott Co. v. Lagonda Mfg. Co.* (205 F. 152 (W.D.Pa. Apr. 30, 1913), where defendant was licensed to manufacture, use and sell to others "for use" throughout the U.S., the court unsurprisingly held that this language limited the defendant to selling "for use" in the U.S.

4. How to draft a trouble-free MFL clause.
An MFL clause is a frequent bone of contention in my experience and in light of the number of lawsuits in this area. It is a very important clause in non-exclusive licenses, as we saw in the Gould Laser Patent Case History. Licensees should negotiate MFL clauses to extend identical terms or to refrain from granting to subsequent licensees more generous terms, as there is no law or rule that requires licensor to do. Licensor, on the other hand, can include a so-called negative MFL clause in given situations.

A general or overly broad MFL clause, however, can be troublesome to licensor, if special circumstances arise, e.g. a license arising from a settlement or litigation. Hence, it is advisable a) to stay away from vague phrases (such as, "other terms and conditions," b) to include escape clauses or exceptions, e.g. settlements, and c) to give licensee the right to terminate and negotiate the license,if a subsequent licensee has been overly favored. Thus, it is important that an MFL provision, in order to reasonable protect licensee without excessively restricting licensor, be limited to royalty or other money terms. It is also important to provide for license to give prompt notice to licensee, whenever more favorable money terms are granted to a subsequent licenser and require licensee to accept

such new terms within, say, 30 days.

An exemplary MFL clause can be found in the standard Patlex/Gould laser patent license. It was scrutinized by licensees but did not result in any lawsuit. It reads:

> ARTICLE XII — MOST FAVORED LICENSEE
>
> If subsequent to the Effective Date of this Agreement another manufacturer of lasers, laser systems, or Low or High Power Laser Tubes similarly situated to LICENSEE is granted a license by PATLEX which provides to said another manufacturer a combined royalty rate and royalty base materially more favorable to said another manufacturer with respect to any of the Licensed Patents than that provided herein to LICENSEE for lasers, laser systems and Low or High Power Laser tubes sold or leased in the United States, then LICENSEE may, at its option, adopt the subsequent license in its entirety, mutatis mutandis, as of the effective date of such subsequent license. PATLEX shall notify LICENSEE of any such subsequent license and provide LICENSEE an opportunity to exercise the option provided herein.

A comprehensive and excellent article on this subject appeared earlier this year in Les Nouvelles. *See* Patrick O'Reilly and Michael Morin, "Troubles for Most-Favored Licensees," Les Nouvelles, V.xxxIII, No. 1, p. 26, March 1998.

5. Dealing with the inescapable uncertainly principle of contract drafting. This is a two-pronged principle, based on a semantic dilemma and on human frailty. The former is due to the existence of undefined terms, terms that are incapable of definition and the fact that few terms are universally understood to have a single meaning as, for example, "public domain," "line of business,", etc. An attempt at definition may often merely substitute one uncertainty for another one. Still, stiff definitions are very important and that is why the Definition section is the second most important section in any license agreement.

   The second prong is based on human frailty, i.e., the imperfection of human intelligence and attentiveness. Press of business is also a contributory factor. This problem which can be mitigated more easily than the semantic dilemma, leads to three defects: a) ambiguity: imprecise boundaries, two possible meanings, different from vagueness, e.g., "residence", b) excessive vagueness, e.g., "indivisible", and c) unclear modifiers, the most common and most dangerous, e.g. "a license under patent applications other than design patent applications filed before July 1, 1995".

VII. Additional Clauses Needing Close Attention

A typical technology license requires negotiation and drafting of several, if not many, additional explicit clauses, which are also very important and need meticulous attention. To name but a few:

— Definitions —the second-most critical clause in licenses, as pointed out above in connection with the inescapable uncertainty principle, whether it is alphabetical or hierarchical, precising or stipulative.

— Confidentiality — crucial where trade secrets are involved but excepting situations where a) the trade secret is already in the public domain, b) enters the public domain without fault of licensee, c) is disclosed to licensee by a third-party who has a right to make such disclosure or d) was already independently developed by licensee; putting a limit of years on licensee's confidentiality obligation is a must.
— Improvements — whether to be "granted back" by licensee to licensor or to be "granted forward" by licensor to licensee where they continue their R&D, a narrow, precise definition, preferably tied to the scope of the patent claims and in non-exclusive form, is requisite.
— Sublicensing rights — especially important in exclusive licenses for practical and legal reasons because absent such a clause which cannot be implied, no further licenses can be granted by either party, even if it is desirable to do so. (See the exhaustive discussion of this topic in the following article: Julie Schwartz, "Antitrust Issues Can Arise When Sublicensing," Les Nouvelles, v.XXXII, No. 3, p. 153, Sept. 97)
— Termination — this third most important element is a multipronged concept, where each prong needs to be defined separately, inasmuch as a license never terminates over night, since different rights and obligations of the parties, such as, making reports, paying accrued royalties, auditing books, returning documents, maintaining secrecy, etc., continue after termination. (See Patricia Schreck, "The Importance of Termination Clauses in License Agreements," The Licensing Journal, p. 5, August 1997)

VIII. Conclusion

The above discussion of key elements in technology licenses, such as, patent, trade secret, or perhaps most often, hybrid patent/trade secret licenses, has demonstrated, on the one hand, that truly lasting win/win agreements can be crafted to solve even completely intractable situations by combining available licensing clauses in ingenious ways or designing and fashioning novel clauses, like playing music on a piano.

On the other hand, lessons to be learned from the above cases are that it is risky to copy boiler-plate clauses from different agreements blindly and to rely on implication when it comes, e.g., to best efforts or MFL clauses, representations and warranties, rights to have made rather than merely make, rights to sell in foreign countries, sublicensing rights, etc. Express provisions that, e.g. sublicensing rights are or are not granted, an MFL clause is or is not included, are by far preferable, if not requisite.

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