

# NANOTECHNOLOGY LICENSING

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Breakfast Roundtable

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# WHAT ARE YOU LICENSING?

- PATENTS
- TRADE SECRETS
- EXISTING V. FUTURE
- IMPROVEMENTS V. NEW DEVELOPMENTS

## LICENSE GRANT

- FIELD OF USE – AVOID GIVING LICENSE FOR ALL FIELDS
- TERRITORY – WHERE DO YOU HAVE PROTECTION?
  - BE CAREFUL ABOUT CUTTING OFF ABILITY TO GRANT ADDITIONAL LICENSES
- EXCLUSIVE V. NONEXCLUSIVE

## IP RIGHTS

- HOW ARE IMPROVEMENTS HANDLED?
  - MADE BY LICENSOR
  - MADE BY LICENSEE
    - OWNERSHIP BY LICENSOR
    - LICENSE BACK TO LICENSOR
    - NO RIGHTS BACK TO LICENSOR

## WARRANTIES

- GIVE WARRANTY AS TO RIGHT TO GRANT THE LICENSES
- AVOID OTHER WARRANTIES
  - (a) NON INFRINGEMENT
  - (b) SUFFICIENCY OF RIGHTS
  - (c) PRODUCT PERFORMANCE

## INDEMNIFICATION

- MUST BE TIED ONLY TO PRODUCTS DISTRIBUTED
- UNDERSTAND POTENTIAL LIABILITY
  - BEWARE OF INDEMNIFICATION FOR SMALL COMPONENT OF LARGE PRODUCT