



Esempi pratici

Il contratto di licenza per brevetti e software

Relatore

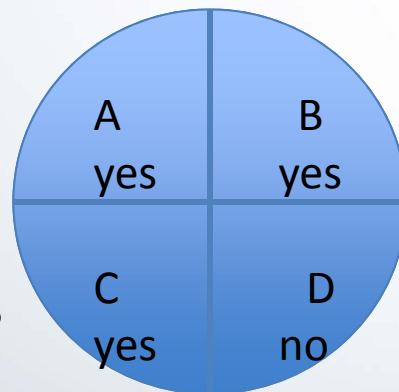
Corrado Borsano

Membro e Segretario del Consiglio Direttivo LES Italia

- Torino 22 Aprile 2015 -

LICENSOR

TERRITORY of PATENT RIGHTS



PATENT RIGHTS on PRODUCTS and processes and COPYRIGHT on SOFTWARE on processing system

LICENSEE

Is willing to have granted Licenses on PATENT RIGHTS and SOFTWARE

LICENSE AGREEMENT

(draft approved by the management of PARTIES to be revised by
Legal Directors of PARTIES)

The day of

By and between:

AAA S.p.A, an Italian Company having its registered office in
..... , Milan (Italy) hereinafter called LICENSOR

AND

BBB, a corporation of the State of (USA), having a
registered office at No Street, City of ,
State of (USA), hereinafter called LICENSEE,

WITNESSETH

«WHEREAS, LICENSOR by R&D work conducted developed and is the owner of any title and interest relating to the patent rights (and the know-how) covering the results of such R&D work».

«WHEREAS, LICENSEE has received from LICENSOR information and data of confidential nature, as per schedule(CONFIDENTIAL INFORMATION) on the results of the research with the view of examining the commercial merits thereof and deciding whether or not to acquire a license under said patents rights (and know-how) for the manufacture of the PRODUCTS in TERRITORY and the sale of the products so manufactured in the TERRITORY as defined below».

«WHEREAS, LICENSOR is the owner of the entire worldwide right, title and interest in and to the PATENT RIGHTS, as defined below>>;

«WHEREAS, LICENSEE wishes to manufacture PRODUCTS in the MANUFACTURING TERRITORY as defined in. Art below, by processes including inventions claimed in the PATENT RIGHTS and wishes to be granted the exclusive license under the PATENT RIGHTS to practice the patented inventions in the TERRITORY A for the manufacture of the PRODUCTS and the non-exclusive license to sell in the TERRITORY B the PRODUCTS so manufactured, and no license in TERRITORY C».

«WHEREAS, LICENSOR has developed a processing system, covered by the PATENT RIGHTS and the necessary computer SOFTWARE to implement the processing system, and LICENSOR is the owner of COPYRIGHT on computer SOFTWARE »;

«WHEREAS, LICENSEE is engaged in the manufacture and sale of and is willing to adopt a complete computer-controlled processing system for its sales and to this aim wishes to be licensed to establish and operate the PROCESSING SYSTEM and to be supplied, and licensed to use, the SOFTWARE developed by LICENSOR».

«PATENT RIGHTS» means any and all Patents and Patent Applications listed in schedule »

«PRODUCTS» means any products kinds and processing system covered by the PATENT RIGHTS, in the technical fields as defined in Attachment».

IMPROVEMENTS ? «IMPROVEMENTS» means any modifications capable of improving the PRODUCTS developed by LICENSOR to the point of commercial feasibility, subject to update of the PATENT RIGHTS, or which either party during the term of this Agreement is free to license to the other party».

«ACCOUNTING YEAR» means each period of twelve (12) consecutive calendar months beginning with January 1st of each calendar year during the term hereof; except that the first ACCOUNTING YEAR hereunder shall begin with the COMMENCEMENT DATE and end on the 31st day of December next following, and the last ACCOUNTING YEAR hereunder shall end upon the term of the ROYALTY PERIOD».

«NET SELLING PRICE» means:

a) NET SELLING PRICE of the LICENSED PRODUCTS sold to customers other than LICENSEE's ASSOCIATES shall be the price invoiced by LICENSEE to such customers with deduction only for:

i) quantity or prompt payment discounts;

ii) transportation, packaging and insurance costs borne by LICENSEE;

iii) taxes based directly on sales. turnover or delivery and applicable to individual invoices only;

iv) credits to customers and allowances for goods returned;

provided that evidence in support of such deductions shall be produced by LICENSEE at LICENSOR's request.

b) NET SELLING PRICE of the LICENSED PRODUCTS sold or otherwise supplied to LICENSEE's ASSOCIATES or consumed by LICENSEE or bartered or sold by it for other than cash shall be the average value of the NET SELLING PRICE, as defined under a) above, in the concerned ACCOUNTING YEAR.

c) NET SELLING PRICE in case no PRODUCTS are manufactured in the PLANT or in case no PRODUCTS are sold by LICENSEE to customs other than LICENSEE's ASSOCIATES, shall be the average unit-price for comparable quantities of similar products in during the concerned ACCOUNTING YEAR».

«ROYALTY PERIOD» means the period of time beginning on the FIRST OPERATION DATE and ending years thereafter.

«ASSOCIATE» means any Company or legal entity controlled by a PARTY or which controls a PARTY or which is under common control with a PARTY, such control being exerted, directly or indirectly by holding fifty per cent (50%) or more of the issued shares or of the voting power or by otherwise having the power to appoint the majority of the directors or the power to direct the business activity».

or

«AFFILIATE» means any legal entity the business policy and activity of which may be substantially influenced by a PARTY.

«TERRITORY» means TERRITORY A, TERRITORY B, TERRITORY C, as defined in schedule

«EFFECTIVE DATE» means the date of execution of this Agreement.

NOW, THEREFORE, in consideration of the premises and of the mutual understandings and obligations herein contained the parties hereto agree as follows.

The premises are considered an integral part of the present agreement.

«ART - THE GRANT

1 - LICENSOR hereby grants to LICENSEE and the AFFILIATE / ASSOCIATE:

i) the exclusive license under the PATENT RIGHTS to manufacture, have-made, sell, have-sold, and otherwise dispose of (operate, use, lease...) the PRODUCT in TERRITORY A;

ii) the non-exclusive license under the PATENT RIGHTS to sell, have-sold, and otherwise dispose of (operate, use, lease...), the PRODUCT in the TERRITORY B .

2 - LICENSEE and the AFFILIATE / ASSOCIATE shall refrain from:

a) manufacture, have-made, sell, have-sold, or otherwise dispose of (operate, use, lease...) PRODUCT, as well as pursuing an active policy of putting the PRODUCT on the market, in TERRITORY C.

3 – LICENSEE and AFFILIATE / ASSOCIATE shall not grant sub-licenses to third parties.

«Art. . . . - **CONSIDERATION**

1 -In consideration of all the licenses and rights granted under this Agreement, LICENSEE shall pay to LICENSOR:

i) a non creditable down payment of US Dollars (US \$) in installments which will become due:

a) US Dollars (US \$) days after the EFFECTIVE DATE

b)..... US Dollars (US \$) days after the START UP DATE, but in no event later than months from the EFFECTIVE DATE, and

ii) running royalties based upon a royalty rate equal to per cent (..... %) of the NET SALES VALUE or, whichever is higher, equal to US Dollars (US \$) per pound of all quantities of LICENSED PRODUCTS manufactured by LICENSEE during the ROYALTY PERIOD and, during or after the term of such period, sold, used or otherwise disposed by LICENSEE .

2 - Subject to the provisions of para .. 3 below, in no ACCOUNTING YEAR other the first and last ACCOUNTING YEAR, the running royalties payable under para .. 2 (ii) above shall be less than the sum of In the first and last ACCOUNTING YEAR the paid amount shall be not less than the prorated share of such minimum account.

«Art. . . – CONSIDERATION - CTD...

3 - LICENSOR may terminate, after the term of each ACCOUNTING YEAR the exclusivity under paragraph above, if during the preceding ACCOUNTING YEAR the running royalties due under subparagraph .. I (ii) have not met the minimum under para .. 2 above and LICENSEE has not elected to pay the balance to such minimum .

4 - In the event LICENSEE is required by the laws of a country in which the PRODUCTS are manufactured, to withhold on income tax from the payments due to LICENSOR under this AGREEMENT, LICENSEE shall deduct the amount of such taxes from the payment to be made to LICENSOR and shall pay such taxes to the proper Governmental Authorities. LICENSEE shall send LICENSOR a certificate of receipt for such tax payments issued by the concerned government authorities.

«ART. . . -MINIMUM ROYALTIES

irrespective of the sales actually made by the Licensee, the minimum royalties payable to the Licensor shall not be less than :

..... in the first year

.....in the second year

.....in the third and each succeeding year that this Agreement subsists.

If the Agreement is in force for less than 12 months in any calendar year, the minimum royalty shall be reduced pro rata to the period of duration.

«ART. . . . - SOFTWARE LICENSE

1 - LICENSEE is hereby granted a non-exclusive, royalty-free license to use the SOFTWARE in object code only, the source code will not be available to LICENSEE. Such license is nontransferable, and only applicable to operate the PROCESSING SYSTEM.

2 - LICENSEE will not, without the prior written consent of LICENSOR, (a) copy, modify, compile, reverse compile or disassemble the Software, (b) use the Software for any purpose not contemplated by this Agreement, or in any way make the SOFTWARE or related Documentation available to any third party.

3 - Should any Updates be issued by LICENSOR, LICENSEE will be granted a nonexclusive, nontransferable, royalty-free right to use such Updates in connection with the Equipment, upon the same terms and conditions as apply to SOFTWARE. LICENSEE shall have the right to ask LICENSOR to set up a maintenance agreement for the maintenance of the SOFTWARE.

4 - LICENSEE recognizes that the copyright in the SOFTWARE (and any Updates), in whatever form it may be embodied, and specifically including, but not limited to, computer programs or modules thereof, whether expressed in source code or object code, and documents relating thereto, is owned by LICENSOR or used by LICENSOR under a license from a third-party copyright holder.

5 - LICENSEE recognizes that any violation of its obligations set forth in this Article would cause irreparable harm to LICENSOR and/or to LICENSOR's licensors, as the case may be, for which no award of money damages would provide an adequate remedy, and that, accordingly, in such event, LICENSOR and/or such LICENSOR's licensors will also be entitled to seek interim injunctive relief from a court of competent jurisdiction, and LICENSEE will be fully liable for the consequences of any such violation towards LICENSOR and such LICENSOR's licensors, as the case may be.

6 – At the termination of this Agreement, LICENSEE shall have the right to enter negotiations with LICENSOR for set up of a license agreement for continuing using the SOFTWARE. If the agreement will not be reached, and will not be unreasonably denied by LICENSOR, LICENSEE will stop using SOFTWARE and return all materials embodying SOFTWARE to LICENSOR or dispose of the same in accordance with LICENSOR's instructions.

«ART. ... – IMPROVEMENTS ?

1 - LICENSOR is available to keep PATENT RIGHTS updated about IMPROVEMENTS, subject to negotiations in good faith with LICENSEE to agree upon the conditions of new license conditions about IMPROVEMENTS, if LICENSEE so desires.

2 - LICENSEE agrees to inform licensor about improvements, further developments and technical information relating to the licensed article, whether patented or not, and to enter negotiations in good faith with LICENSOR to agree upon the conditions to grant him licenses, if LICENSOR so desires.

«ART. . . – AUDIT

1 - LICENSEE shall within 30 days submit to LICENSOR copies of all invoices relating to the sale of PRODUCTS . LICENSOR shall send periodical bills to licensee for the royalties due. Payment of the billed royalties shall be made within 30 days from receipt of the bill.

2 - LICENSEE shall have the right to make preliminary payments for the royalties prior to final billing.

3 - LICENSOR shall have the right to inspect the books of licensee as far as they relate to the computation of the royalties.

4 - The inspection of the books can be done semi-annually in the months January and July.

5 - The right to inspect the books shall be excluded, if LICENSEE provides the report of a sworn accountant obligated to secrecy.

OR

1 - LICENSEE shall keep a special register in which he shall record the exact number of products manufactured by virtue of this Contract, the serial numbers marked on such products and any other information relevant for determining the amount of royalties payable.

2 - LICENSOR shall have the right by means of an accountant appointed by him and approved by the LICENSEE (such approval shall not be unreasonably withheld) to inspect these registers and :J examine whether they are consistent with the general accounts of the Licensee. The costs of such inspection and examination shall be borne by

«ART. . . . MARKING

- 1 - LICENSEE shall have the right to refer to the license with mention of the LICENSOR in the marketing of the PRODUCTS. Licensee promises to promptly submit to LICENSOR copies of all printed publications, in which the name of LICENSOR in conjunction with this license is utilized.
- 2 - LICENSEE shall attach the LICENSOR 's trademark on the licensed article as shown in Annex In addition a reference to the LICENSEE as the producer may be affixed.
- 3 - Alter the termination of this agreement LICENSEE shall not have the right to refer to the former license.

«ART. . . . QUALITY CONTROL

1 - LICENSEE is obliged to produce the licensed article with the same quality as the LICENSOR. LICENSOR shall have the right to control the agreed-upon quality and ask LICENSEE to stop the sale of products which are below standard. LICENSOR can exercise this right to control by personal inspection of the production.

2 - If LICENSEE does not comply with a demand of LICENSOR to avoid defects within a period of four weeks then LICENSOR has the right to immediately terminate this agreement.

3 - LICENSEE indemnifies licensor under any claims of third parties from product liability. The same applies with respect to advertising statements by the LICENSEE with respect to licensed article.

«ART. . . . - PATENT INFRINGEMENT GUARANTEE

1 - LICENSOR represents that to the best of its knowledge, information and belief the manufacture of the PRODUCT in TERRITORY A, and the sale or use of the PRODUCT so manufactured in TERRITORY A and B do not infringe any THIRD PARTIES patents therein issued prior to the date of signature of the AGREEMENT.

The PARTIES hereby agree that in the event of any notice or claim of infringement, or of the commencement of any suit or action for infringement of any such THIRD PARTIES patents which is based on the practice of the use or sale of the PRODUCT :

- a) LICENSEE shall promptly inform in writing LICENSOR;
- b) LICENSOR shall assist at its expense LICENSEE in the defense of such suit or action;
- c) neither LICENSOR nor LICENSEE shall settle or compromise any such suit or action without the consent of the other PARTY if the settlement or compromise obliges the other Party to make any payment or impairs its rights or licenses;

«ART. . . . - PATENT INFRINGEMENT GUARANTEE – CTD.....

d) LICENSEE, if so directed by LICENSOR, shall make such reasonable changes in the PLANT as may be required to avoid the alleged infringement, provided that LICENSOR accepts to extend the indemnification under para e) below to costs of the changes and to any loss or damages deriving to LICENSEE therefrom;

e) LICENSOR shall hold LICENSEE free and harmless from any payment of royalties or damages to THIRD PARTIES and any judicial expenses incurred by LICENSEE as a consequence of any judgement, award or settlement upon such infringement or alleged infringement;

f) LICENSOR's total liability under this Art shall not exceed per cent of the amount paid, or to be paid, by LICENSEE under para

«ART - PATENT RIGHTS PROSECUTION AND MAINTENANCE

1 - LICENSOR shall exert reasonable diligence in prosecuting any Patent Application included in the PATENT RIGHT, in defending such application against oppositions filed by third Parties and shall pay any taxes and renewal fees, for the maintenance of all the Patents included in the PATENT RIGHTS. Provided however that LICENSOR shall not be required to maintain in force patents that, in the light of new circumstances, are found, in LICENSOR 's opinion, to be invalid. Under such circumstances, LICENSOR shall give notice to LICENSEE of its intention to abandon the concerned Patent. Reasonably prior to any action or omission which may result in the loss of the Patent, and shall, upon written request of LICENSEE, assign the Patent to LICENSEE. LICENSOR may reserve to itself a non-exclusive fully paid-up irrevocable license and right, including the right to grant sublicenses, to practice any invention claimed in the assigned patent».

«ART - CONFIDENTIALITY

- 1 - This agreement article supersedes the previous obligation to confidentiality signed between the parties on.....
- 2 - Each Party agrees:
 - to maintain in confidence the CONFIDENTIAL INFORMATION, and any information defined as confidential in writing by a party , and not to disclose it to any of its employees other than those who have a need to know, making them aware of and bound to the confidentiality restrictions provided in this Agreement;
 - not to disclose CONFIDENTIAL INFORMATION and any information defined as confidential in writing by a party, to any third party, whether person or organization, including sub- or main contractors, or customers of such Party, without the prior written consent of the other Party;
 - not to use or copy said CONFIDENTIAL INFORMATION and any information defined as confidential in writing by a party, in any manner whatsoever, directly or indirectly, except for the purposes described in the preamble above, without the prior written consent of the other Party.
- 3 - Each Party shall protect such information from disclosure to third parties with at least the same degree of care as such Party exercises to protect its own information of similar type and importance.

«ART - CONFIDENTIALITY – CTD

4 - The obligation of confidentiality shall not apply or shall cease to apply to any information that a Party can demonstrate to the reasonable satisfaction of the other Party:

- a) was known to the receiving Party prior to its receipt;
- b) is or becomes publicly available without breach of this Agreement;
- c) is received from another party without an obligation of confidentiality to the disclosing Party and without breach of this Agreement;
- d) is disclosed by the disclosing Party to another party without an obligation of confidentiality;
- e) is developed independently by employees of the receiving party not having access to such information;
- f) is disclosed in connection with a judicial proceeding requiring such disclosure.

5 - The obligations of this Article shall be respected by the parties for a period of ... years from the signature of this Agreement, and shall survive any possible previous term of termination of the present agreement for whatsoever reason caused.

«ART - MOST FAVORABLE CONDITIONS

If, at any time during the term of this Agreement, an agreement shall be entered into by LICENSOR with any third party, which affords such third party a license for the use of PATENT RIGHTS on terms which are more favorable than the terms of this Agreement, LICENSOR shall promptly advise LICENSEE of such agreement and LICENSEE shall thereafter, at its election, be entitled to the benefit of such more favorable terms, subsequent to the date of execution of such other agreement, provided, however, that in such event, LICENSEE shall at the same time accept all other provisions, terms, conditions and limitations included in said Agreement whether or not they are directly related to such more favorable terms»

«ART - SETTLEMENT OF DISPUTES

Both PARTIES shall mutually consult in good faith and settle amicably in the spirit of cooperation any and all matters not specified in the AGREEMENT or questions arising in connection with the interpretation or implementation thereof. Each dispute arising in connection with the AGREEMENT, which cannot be settled amicably within (...) months from and after the date of either PARTY's notification, in writing, to the other PARTY of the dispute specifying the details thereof, shall be settled by arbitration in accordance with the International Chamber of Commerce Arbitration rules as at present in force.

«ART – TERMINATION

1 - In the event of failure of either PARTY to fulfil any obligations hereunder, unless such failure is otherwise excused by or subject to other provisions of this AGREEMENT, the other PARTY may give notice to the defaulting PARTY of its intention to terminate the AGREEMENT as of a date not earlier than sixty (60) days from the date of mailing of notice, and if the PARTY notified does not in good faith and with due diligence remedy said default within said (...) days period, then this AGREEMENT shall terminate at the end of said (...) days period.

2 - The AGREEMENT shall automatically terminate in case LICENSEE becomes bankrupt or seeks protection under bankruptcy or similar laws.»

«ART – DISCLAIMER

LICENSOR makes no representation, warranty or guarantee, either express or implied for and shall not be liable for any loss, expense, claim, or damages arising out of and LICENSEE agrees to hold LICENSOR harmless from any loss, expense, claim, or damages from injury to or death of persons or damage to property, whatever the cause may be, arising out of the implementation of this Agreement ».

«ART - LIABILITY LIMITS .

1 - The total financial liability of LICENSOR under the provisions of this AGREEMENT shall not exceed the per cent (..... %) of all the payments to be made by LICENSEE to LICENSOR under this Agreement.

2 - LICENSOR liability at law or otherwise howsoever arising in connection with or as a result of the performance of the AGREEMENT is specifically limited as provided in the AGREEMENT. In no event shall LICENSOR its employees, agents, subcontractors, consultants, suppliers, and their personnel, be liable for any special indirect or consequential damages, whatsoever, meaning to including therein but not by way of limitation any delay or loss of time, or for loss of profit or products .»

«ART. ... - FORCE MAJEURE

No failure by either PARTY to carry out or observe any of the stipulation or conditions of this AGREEMENTS shall give rise to any claims against the PARTY in question or be deemed a breach of this AGREEMENT if such failure or omission arises FORCE MAJEURE.

«ART. . . . – ASSIGNMENT

1 - LICENSEE by written notice served on LICENSOR, may assign the AGREEMENT to any ASSOCIATE, and to any successor in business (in the field of ...), of LICENSEE, provided that the assignee accepts by notice of even date served on LICENSOR any still outstanding obligation of LICENSEE under the AGREEMENT and the assignee accepts to guarantee the performance thereof.

2 - Subject to paragraph 1, any assignment by either PARTY of the AGREEMENT to THIRD PARTIES shall be conditional to the other PARTY's previous written approval provided that LICENSOR shall assign this agreement, subject to all obligations, to a successor to substantially all of the business of LICENSOR».

OR

The License is not assignable and the LICENSEE shall not assign his rights or obligations thereunder to a third party. Without prejudice to the generality of the foregoing, the LICENSEE shall not without the consent of the LICENSOR bring the License into the assets of a company.

«ART REGISTRATION OF THE AGREEMENT

Either party shall be entitled to register the License if such registration is permissible under the law of the country or countries in respect of which the License is granted. The LICENSOR shall give the LICENSEE any powers and authorization necessary for this purpose. The expenses of registration shall be borne by the party desiring to register the License.

«ARTINDUSTRIAL REALISATION AND COMMERCIAL EXPLOITATION

1 - The LICENSOR does not warrant that the PATENT RIGHTS are capable of industrial realization nor shall he be responsible for the consequences of any failure so to realize them. If the LICENSEE fails to achieve the invention's industrial realization within a period ofthe LICENSOR is entitled to terminate the Agreement and recover damages.

2 - The LICENSOR does not warrant that the invention is capable of commercial exploitation, the risks of such exploitation being assumed solely by the LICENSEE.

«ART TERM

1 - This license agreement shall have a duration of years, beginning with the date of the agreement, and then is extended year by year, unless one of the parties terminates the agreement with at least a three months' notice.

2 – Subject to paragraph 1, this license agreement will terminate naturally at the end of validity of the patent or patent application of PATENT RIGHTS expiring latest.

«ART – APPLICABLE LAW

This agreement shall be governed by the law of



Licensing
Executives
Society

Italia

Corrado Borsano

GRAZIE!

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