

# Technology License Agreement - Crucial Parameters

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# About Anand and Anand

## Our Transition : 90 to 100

- Heritage of 90+ Years
- Deal with IP in 90% of the world's countries
- Team of over **100** attorneys / engineers
- Strong leadership-26 Partners + 4 Directors and professional management

## Our Strength – Our People



- Diverse team of over 300 people - Lawyers, PhDs, IITians, MBAs, CAs
- International secondments / trainees

## Our Clients

- Few thousand clients including 8 out of the global **Top 10** brands by Interbrand
- Represent interests of innovators / right owners
- Act for industry leaders of almost all intangible dominated industries

## Our Presence

- Offices in Delhi, Noida, Chennai and Mumbai
- Mumbai Office practice merged with Khimani & Associates to create new entity "Anand and Anand & Khimani"
- Handling portfolios globally with specialized team for SAARC countries

# Practice Areas – IP 365°



COPYRIGHT



DESIGN



LITIGATION



PATENTS



TRADEMARK

- ADVERTISING AND PRODUCT LIABILITY
- ALTERNATE DISPUTE RESOLUTION
- ART LAW
- BIODIVERSITY
- BRAND STRATEGY
- COMPETITION LAW
- CONTRACTUAL & COMMERCIAL IP
- CUSTOMS

- ENFORCEMENT
- ESSENTIALITY EVALUATION
- FASHION LAW
- FRANCHISING
- GEOGRAPHICAL INDICATIONS
- IT & E-COMMERCE LAWS
- LICENSING
- MEDIA AND ENTERTAINMENT LAWS

- PACKAGING AND LABELLING
- PLANT VARIETY
- REGULATORY
- SPORTS LAW
- START-UP LAW
- TRADE SECRETS
- WHITE COLLAR AND IP CRIME

# Technology

- Technology
- Innovation
- Invention
- IPR

# Partnership Framework

- BOT (build–operate–transfer)
- BOOT (build–own–operate–transfer)
- BOO (build–own–operate)
- BLT (build–lease–transfer)
- DBFO (design–build–finance–operate)
- DBOT (design–build–operate–transfer)
- DCMF (design–construct–manage–finance)

# TT Agreement

- NDA
  - Confidential Information
  - Collaboration
  - R&D
- MTA- Material Transfer
- TTA
  - Technology Commercialization
  - License/Sale/Franchise/JV

- Internal transfer
- External transfer
  
- Scope of technology
  - Background IP
  - Foreground IP
  
- License
- Assignment
- User Facility Agreement
- Expertise

# Challenges

- Competing Internal Priorities
- Lack of Resources
- Bureaucratic constraints
- Solutions for valley of death technology



# Party Concerns

- Concerns of Licensor
  - Analysis/Assessment of business and objectives
  - Analysis of context
  - Identification/Assessment of potential licensee
- Concerns of Licensee
  - Costs
  - Sale
  - Market share
  - Profit margin

# Technology License

- 1 *The parties*
- 2 *Whereas clauses - Preamble*
- 3 *Definitions*
- 4 *The grant sections*
  - 4.1 *Rights granted*
  - 4.2 *License restrictions*
  - 4.3 *Reservation of rights*
  - 4.4 *Right to grant sublicenses*
  - 4.5 *Territory*
- 5 *Term*
6. *Relationship of parties*
7. *Assignment clause*
8. *Change in ownership*
9. *Modifications*

# Technology License

- *Confidentiality*
- *Work obligations*
- *Obligations of licensor*
- *Obligations of licensee*
- *Termination- grounds and implications*
- **Consideration**
- *Reports and auditing of accounts*
- *Representations/warranties/liabilities/indemnification*
- *Infringement*
- *Improvements*
- *Non-competitive clause*

# Technology License

- 10 Diligence
- 11 IP defined
- 12 Right of inspection; technical personnel
- 13 Remaining sections
- 14 Confidentiality
- 15 Export regulations; use of party's name
- 16 Arbitration – **Dispute Resolution Clause**
- 17 Termination
- 18 Force majeure
- 19 Assignment provision
- 20 Favored nation
- 21 Notices; integration; language; modifications; law; signatures
- 22 Annexures

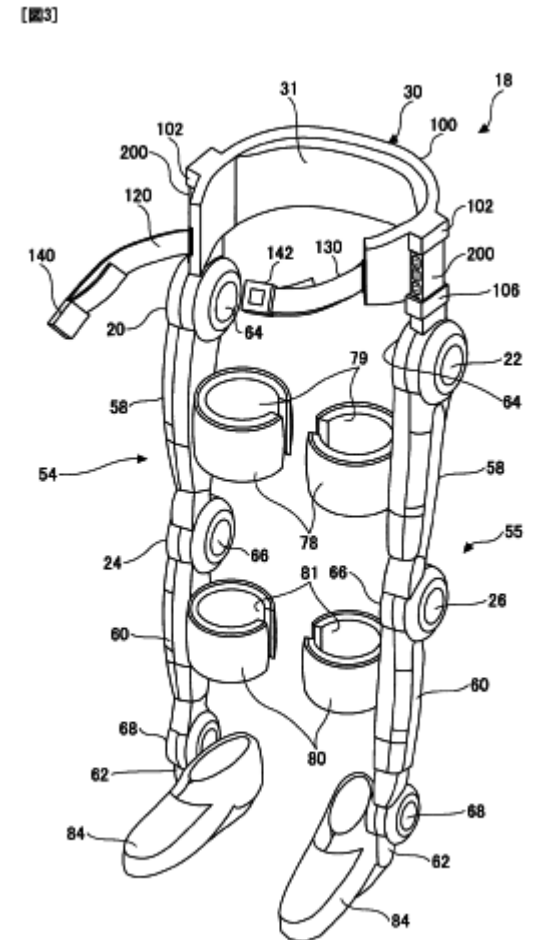
# Robotics Invention

- Professor Sankai invented a cyborg-type strap-on robot suit that can expand and improve human physical capability
- Robot suit, dubbed HAL™ for “Hybrid Assistive Limb”, enables elderly people to perform everyday tasks with which they would otherwise struggle- walking, climbing stairs or lifting heavy objects.
- On-going R&D of the HAL robotic suit takes place at the Institute of Systems and Engineering Mechanics in the University of Tsukuba.
- Potential also for rescue support operations, the entertainment industry, labor intensive factory operations and related businesses.



# IP- PCT/JP2009/066364

- Tsukuba University's Industrial Liaison and Cooperative Research Center (ILC) is involved in managing and conducting patent applications for the university's patent-worthy research outcomes, including the ones from Cyberdyne and Professor Sankai's lab. Starting from 2010, the ILC has also initiated a project for utilizing intellectual property.
- Professor Sankai owns the patents of some of his inventions all by himself, while for some others the patents are jointly owned with the University of Tsukuba
- Names "Robot Suit" and "Robot Suit Hal" in the United States. The name of his company, Cyberdyne, is also registered with the United States Patent and Trademark Office (USPTO). All of them, including "Hybrid Assistive Limb" and "HAL" are trademarks or registered trademarks under Japanese trademark law.



# Commercialization

- The robot suit is commercialized by Cyberdyne Inc., a university spin-off venture firm aiming to utilize accomplishments by Professor Sankai's laboratory.
- Cyberdyne engages in R&D of the HAL robot suits on the one hand, and is involved in production, leasing and sales of the suits on the other. Cyberdyne is supported by the University of Tsukuba through ILC's "Research Projects for Promoting University-Industry Cooperation" and "Projects for Supporting University Spin-offs".
- Cyberdyne undertook mass production, marketing and distribution of the HAL robot suit as per demand.

# Partnerships

- Cyberdyne entered an agreement with **Odense municipality** in Denmark
- Odense to test HAL suits in a rehabilitation unit run by the city's Elderly and Handicapped care agency.
- Due Diligence for Cyberdyne to choose Denmark: Denmark is focusing on the development of welfare technology
- Cyberdyne intends to make Denmark its European hub, to expand operations in other European countries.
- Cyberdyne also signed a memorandum of understanding with **Karolinska Institute** and **Karolinska Institute Danderyds Hospital** for R&D collaboration on further improvement of the robot suits



# Important

- All information in writing with back up
- Due Diligence
- Contract draft
- Stages
- Complete picture – aligned with vision and policy

# THANK YOU

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