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“Intellectual Property lies at the centre of the modern company's economic success or failure”

Lester Thurow : Economist

Trade marks & Brands

Patents & Inventions

Copyright

Designs

Database rights

Data Protection

Licensing and Franchising

Intellectual Property agreements

New Media Agreements such as directors and authors rights

Transactional Intellectual Property

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Top 10 Tips for Negotiating Licenses

by Kirsten Toft
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1.

Consider the type of licence that you are going to grant, e.g. exclusive, non-exclusive or sole licence and whether it should be limited by field of use and/ or territory.

2.

Consider carefully whether the Licensee will be able to sub-license to a third party and on what basis

3.

Consider asking a Licensee to enter into a non-disclosure / confidentiality agreement before disclosing any information.

4.

Have a clear licensing strategy as to who you are going to license to – consider whether you need to establish a clear advantage in the marketplace before licensing to competitors.

5.

Remuneration for a Licensor can be by way of a license fee or by way of royalties. Decide on what basis the Licensee will be expected to make payment.

6.

If you are providing a license of your technology consider if you will provide the Licensee with technical assistance and support and if you will charge for these services?

7.

Consider a clause dealing with ownership of any improvements in licensed technology.

8.

Duration of licence - how long will the licence last?

9.

Ensure the licence agreement clearly sets out the circumstances in which the arrangement may be terminated and consequences of termination.

10.

Consult specialist accountants or solicitors for advice on the value of your Intellectual Property and the terms of the licence agreement.