

PATENT LICENSE

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# RESPONDING TO PATENT LICENSING AND INDEMNIFICATION DEMANDS

BY CHRISTOPHER M. NEUMEYER

Patent licensing demands can be extremely costly to resolve. Abbott Labs lost a \$1.67 billion infringement verdict this year. Microsoft lost a \$1.5 billion verdict in 2007 (overturned on appeal). Kodak lost a claim for \$910 million in 1991. Of course, those are worst case scenarios, but even average patent infringement actions can destroy a company's quarterly profits, or worse. A study by PricewaterhouseCoopers found the median patent infringement verdict from 2001 through 2007 was \$3.8 million. Even if the accused party prevails, costs of defending such actions can easily run into millions of dollars. Corporate counsel are therefore well advised to treat each notice of infringement, demand for licensing or customer's demand for indemnification of a patent dispute with the serious respect and attention that they deserve.

However, many licensing or indemnification demands are trivial or erroneous and can be disposed of at little or no cost.

## Evaluate the Claim

The first step is to evaluate whether a demand received by your company appears to pose a serious threat. Does the initial communication target your company specifically, or is it part of a mass-mailing to numerous potential targets? Is it addressed to a named individual or generically to the CEO or general counsel? Does it identify specific products alleged to infringe, or refer broadly to a vague category of products? Is it phrased as a cordial invitation to license patents for unspecified products, or as a firm notice of infringement and demand for licensing?

Who is the sender of the letter? A simple Google search can be surprisingly fruitful. Investigate the patent owner and named patents. Is it a large company with extensive patents, an IP licensing firm with a history of litigation or a sole inventor with one or two patents? Does it have a long list of licensees, who apparently felt it was wiser to license than fight, or is your company the first target?

Are the patents registered in a region where your company has substantial sales, imports or manufacturing of relevant products, or not? How many years are left on the term of the patents (for US patents, basically 20 years from the earliest application filing date)? Does an online search reveal whether the patents are widely derided as weak or invalid, or are seen as a threat to the industry? Have any courts issued significant claim construction rulings? Is the company presently tied up in litigation, so it may be hesitant to initiate further actions before the present litigation is resolved?

Is it true your company sells the accused product? It is surprisingly common for a patent owner's demand for licensing or a customer request for indemnification of such a claim to be mistaken in that respect. Contact your business unit to learn past and projected future sales volumes of the accused product in relevant markets. Confirm that the figures they provide correspond to only the regions covered by the named patents. For example, if the demand relates to US patents only, confirm that your business unit hasn't inadvertently provided you with global sales figures.

Consider tracing the life of the product that allegedly infringes the patent in question. Do you have assignments from the inventors and developers of the product? Do you have a Certificate of Origin that details all intellectual property components of your products and which of those components your company developed versus incorporating via assignments or licenses from others? Counsel who compile a book of details about the intellec-



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tual property of their company's products will be in a much stronger position to take immediate action if a claim of infringement is ever brought against such products.

If the product is end-of-life or volume is minimal, it may be possible to convince the patent owner to drop the matter without charging royalties or the cost of licensing may be inconsequential. If sales volume is large, the matter may be more serious. If the demand is a mass-mailing from a troll, it may be possible to dispose of the matter with just a letter or two.

### *Estimate Your Company's Potential Liability*

Try to estimate the cost of licensing. If it appears the demanding party intends to aggressively pursue its claim, the potential cost of licensing may be compared to the estimated cost of litigation, to help determine a rational course of action. Sometimes, despite strong convictions that a patent is invalid or is not being used by your company, if the demanding party is persistent and sales volume is minimal, it may be cheaper to license than fight. This is particularly true if the patentee has already filed a legal action against your company.

Of course, licensing payments come in various forms: a one-time lump sum payment, fixed annual fees, running royalties based on a percentage of sales, lump sum payments based on estimated future sales, or other options. Ask the demanding party what rate is being demanded and investigate rates agreed to by other licensees. Look for such information online, contact the legal departments of such licensees or request your business unit to inquire. In the end, regardless of the structure of payments, your management will likely want to know the cost per unit sold and how that rate compares to industry benchmarks.

Once you have some idea of the rate being demanded, try to assess how far back your company's liability may extend. Liability for past royalties is often more serious than future royalties, because with past royalties it may be too late for your company to factor such costs into its business strategies, such as designing around the patent, obtaining concessions from suppliers of infringing components, switching to non-infringing suppliers, passing the costs off on customers or setting aside money in reserve for such costs. On the other hand, when faced with potential future liabilities such options should be considered.

When does liability commence? Under US law, a patentee who prevails in an infringement lawsuit is entitled to recover damages only for acts of infringement that oc-

curred after it gave notice of infringement to the alleged infringer, either constructively, by marking products with the patent number, or by actual notice. Both the constructive and actual notice requirements tend to be strictly construed, but so long as the statutory requirements are met, the infringer may be held liable, regardless of whether it had actual knowledge of the patent. Filing a lawsuit for infringement constitutes sufficient notice, but only permits recovery of damages for acts of infringement that occurred subsequent to the filing. Consequently, most patentees will send a licensing demand letter with the intention of starting the clock running on potential damages.

When did your company first receive such a demand? Actual notice, under US law, requires an unequivocal accusation that a certain patent has been infringed by a specific accused product or device. While the notice doesn't

ing incriminating records and instruct your colleagues to do the same. Engineers and other non-lawyers may jump to hasty conclusions without understanding or considering all relevant issues and legal defenses. If an employee sends an email stating that, "we appear to be infringing the patent," that email will likely end up as plaintiff's Exhibit A if the case goes to trial.

Notwithstanding the above, once a company is put on notice regarding the potential for litigation, it has a duty to preserve all emails and other potential evidence. Under US law, sanctions ranging from adverse inferences and monetary penalties to default judgment, dismissal of claims and even criminal penalties have been awarded for spoliation of evidence. Nor are such sanctions reserved for just bad-faith, willful destruction of evidence. Even negligent spoliation, due to a company's failure to

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necessarily have to use the word "infringe," it is usually not enough to state merely that the patentee owns a broad portfolio of patents in a particular area or to simply offer an invitation to license. When evaluating whether a notice was sufficient, courts will examine only the notice itself; the infringer's knowledge is irrelevant to that determination (although it may be relevant for determining potential liability for enhanced damages, as discussed later). Even oral notice may be sufficient, provided it conveys the necessary information, although such notice will obviously face an evidentiary challenge. Investigate whether the notice was erroneously directed to a subsidiary rather than the parent company, or vice versa, or was otherwise misaddressed, as such mistakes can sometimes render a notice invalid. Finally, with respect to both actual and constructive notice, a presumption of laches will bar the patentee from recovering any damages for infringement that occurred more than six years prior to the filing of a complaint, unless the patentee succeeds in rebutting that presumption by offering evidence of the reasonableness of the delay or lack of material prejudice caused by the delay.

#### *Always Keep in Mind the Possibility of Litigation*

When discussing licensing demands with colleagues, consider discussing sensitive matters — such as potential infringement — only by phone or in person to avoid leav-

ing routine data deletion policies, may be grounds for sanctions. Consequently, you may wish to send periodic notices instructing colleagues involved in the case and your company's IT department, to refrain from deleting potentially relevant data.

Consider obtaining a non-infringement opinion from outside counsel. Based on US law, courts are authorized in their discretion to increase the damages in a patent infringement action up to three times the amount of damages assessed, usually based on a finding of willful infringement or bad faith. In determining willfulness, courts consider the "totality of the circumstances." While it is not decisive, one of the key factors courts will consider is whether the accused sought and followed competent legal advice, including obtaining an opinion on infringement or non-infringement. Of course, if outside counsel discretely informs you that based on a preliminary review it finds it is unable to provide a non-infringement opinion, that reluctance should be seriously factored in to your company's strategy deliberations.

#### **Respond to the Demand**

Respond promptly in writing to most patent licensing demands. Begin by letting the sender know that your company takes the matter seriously and respects the intellectual property rights of others; however, your company will

presumably need to investigate and will require further information. Did the sender clearly identify the accused product or refer vaguely to certain types of products? As noted above, proper notice under US law requires an unequivocal accusation that a certain patent has been infringed by a specific accused product or device. If the sender failed to identify the specific patent or product, ask them to do so, including identifying all accused products by model number. Request a claim chart and copies of the relevant patents. Assure them you will look into the matter, but you look forward to receiving the requested information, which you will require in order to evaluate the request. If they imposed a deadline, consider requesting additional time to investigate the matter internally.

Often that will be the end of the matter. A large percentage of all patent licensing demands are mass-mailings by trolls who will not bother responding to requests for further information and often will not follow up on their first letter. Even with more legitimate demands, the accused will almost always benefit from delaying the matter as long as possible, obtaining further time and information, and putting the ball back in the sender's court, while at the same time appearing courteous and cooperative and demonstrating it is investigating the matter in good faith.

Respond to indemnification demands much in the same manner as licensing demands. Let the customer know your company appreciates its business, takes the matter seriously and intends to honor any legal obligations, but you will presumably require further information. If the customer failed to precisely identify the accused products, ask it to do so. Ask how many companies supplied it with the accused products and what percent your company supplied. Request claim charts or evidence of infringement, information concerning the proposed royalty rate, a copy of the proposed license agreement, to the extent available, a description of all communications with the patent owner and all actions taken in response to the claim. If a lawsuit is pending, request copies of all pleadings and an update on the status.

### **Seek to Pass the Buck if Possible**

Promptly explore whether your company may have relevant insurance. Most likely it will not, because patent infringement insurance is generally considered too costly to be worthwhile, but if your company does have such insurance you should promptly file a claim with the carrier.

In the event of customer demands for indemnification, investigate whether possible use of the patents by your

Let the customer know your company **appreciates its business, takes the matter seriously** and intends to **honor any legal obligations, but you will presumably require** further information.

Before responding to indemnification demands from customers, review any agreements that allegedly form the basis for such obligation.

- Is the agreement signed?
- If it contains an indemnification provision, what are the limitations?
- Are claims based on the customer's specifications or requirements excluded?
- Is the customer required to provide prompt notice and assist and cooperate in the defense?
- Does the agreement grant to the indemnitor the exclusive right to control the defense (something the customer will regret if your company is just one of several vendors and the customer is unable to grant that right as agreed)?
- Does the indemnification provision expressly include the obligation to pay the indemnitee's attorney fees; if not, many courts will deem them to be excluded.

company would be due to a process, design, materials or specifications provided or required by the customer. If so, check your company's sales agreements with the customer for relevant language: indemnification clauses often exclude claims based on such circumstances. Request that your business unit provide you with copies of all emails, contracts, specifications or other documents in which the customer may have imposed such requirements on your company. The customer may deny that infringement is due to reliance on such requirements, or is solely due to such requirements, but so long as a plausible argument exists that may be sufficient to resist the demand in good faith.

Make sure to distinguish your company's obligations to defend its customer, versus obligations to indemnify the customer for damages. You may find that your company has an obligation to defend but that the ultimate remedy to the customer is simply a repair, replacement

or refund related to the infringing product. Make sure to also distinguish contributory infringement activities by your customer that may have brought on the litigation and verify if your contracts state that your company will only be responsible for defense and indemnity to the extent your product, as supplied to the customer, was the cause of the infringement.

Does the alleged infringement arise from components purchased from suppliers? How many vendors supply the accused parts to your company presently and how many did in the past? What percent of the accused parts did each vendor supply? Obviously, you will want to focus first on the largest suppliers. Are any suppliers already licensed? Can your company shift to suppliers who are licensed or demand that unlicensed suppliers negotiate their own licenses with the patent owner? Have any suppliers signed agreements in which they provide intellectual property warranties or agreed to indemnify your company against patent infringement claims?

If the claim arises from parts supplied by vendors and they have agreed in writing to indemnify your company, send prompt notice and a request for them to confirm their obligations. If the suppliers ignore your request or deny responsibility, send periodic updates, informing them of the status, notifying them in advance regarding major strategic decisions and costs to be incurred in defending the matter (such as retaining legal counsel) and confirming your company's expectation that it will be indemnified by the supplier. Consider requesting the business unit to exert pressure, perhaps informing the suppliers that failure to comply with such obligations may adversely affect your company's future purchasing decisions.

If the relevant suppliers never signed any IP warranty or indemnification provision, don't give up. Many jurisdictions recognize an implied warranty of non-infringement in connection with sales of goods, such as those found at Section 2-312(3) of the Uniform Commercial Code and Article 42 of the United Nations Convention on Contracts for the International Sale of Goods. Admittedly, both of the above provisions are worded such that a skilled attorney should be able to find arguments to avoid the imposition of liability, but absent a contractual obligation they may be worth looking into. And, even without a

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sound legal basis, it still may be possible to force suppliers to sign an after-the-fact indemnification letter in exchange for continued business, particularly if your company's business unit helps to exert pressure. Always bear in mind, though, that a supplier's indemnification obligation is only good to the extent of its solvency.

### **Bring the Matter to a Satisfactory Conclusion**

Business solutions should always be considered. Discuss with your business unit whether it might be possible or advisable to design around the patents, phase out the relevant products or pass the cost of licensing off on customers. If such options are unavailable, look into legal defenses.

In addition to mitigating damages and possible work-around solutions, it is imperative that your company obtain some form of closure with regard to the claim. It is highly likely at some point in the future your company will have to discuss or disclose the efforts it makes to protect its intellectual property and the intellectual property of others (e.g., M&A transactions, trade secret litigation, etc.) — you should have a clear record of the allegation made against your company, your investigation into the substance of the claims and your ultimate determination along with the opinion of counsel, as to the validity and valuation of the claims, if applicable.

Might it be possible to invalidate the patent? For a patent application to be approved in the United States, the invention must be novel (ie., not disclosed in any prior art), non-obvious to persons skilled in the art, and the applicant must disclose all known prior art. Investigate the existence of any undisclosed prior art: not just patents and patent applications (domestic and foreign), but other publications or prior public use of the invention. At the time of the application, was the patent obvious to persons skilled in the art? Additionally, in the US the applicant must be the inventor, must cite the best mode, claims may not be too vague or indefinite, and other requirements. Consider retaining a patent attorney to look into such matters.

If potential grounds for invalidity exist, your company may consider filing a declaratory relief action to invalidate the patent, an application for re-examination (which is significantly cheaper but non-appealable), raise the matter as an affirmative defense if sued by the patentee, or simply refer to the potential invalidity during the course of settlement discussions.<sup>2</sup>

Has the patentee engaging in illegal licensing practices that might render the patent unenforceable? While patent rights are often characterized as a lawful monopoly, that's not entirely accurate, as antitrust violations *may* render a patent unenforceable. Under the doctrine of patent misuse, a patentee may be barred from recovering damages for infringement if the patentee refused to license the patent,

**Discuss with your business unit** whether it might be **possible** or **advisable to design** around the patents, **phase out** the relevant products, or **pass the cost** of licensing off on customers.

conditioned licensing upon purchasing separate products or licensing of other patents (tying), or made arrangements that effectively extended the term of the patent, thereby requiring royalty payments after the term of the patent expired. With respect to tying allegations, you will also be required to prove that the patent owner has “market power.” However, patent misuse may only be raised as affirmative defenses (i.e., as shield, not sword) and in most cases the patent will again be fully enforceable once the patentee ceases the prohibited practices.

Does your company buy the accused products or relevant components from a licensed supplier, so the demand might be defeated by patent exhaustion or the “first sale” doctrine? As explained by the US Supreme Court in *Quanta v. LG Electronics, Inc.*, the “authorized sale of an article that substantially embodies a patent exhausts the patent holder’s rights and prevents the patent holder from invoking patent law to control postsale use of the article.” In other words, it is generally unlawful for a party to license a patent to one user then demand further royalties on the same patent from a downstream user. The Court also held in *Quanta* that sales of products that do not fully practice the invention can still trigger exhaustion when the products include essential features of the patent, and the “reasonable and intended use” of the product is to practice the patent.

Is it possible the demanding party may be using your company’s patents, so a cross-license may be demanded? While this could result in considerable savings in some cases, bear in mind that to succeed you will probably be required to provide compelling proof of infringement, by searching your counterpart’s product portfolio for relevant products, preparing claim charts showing use of your company’s patents, and presenting the cross-licensing option as a firm demand, not a mere invitation to license.

When responding to customer demands for indemnification, don’t be too fast to give in. The likelihood of being sued will likely be remote, as you should have some plausible defenses, such as failure to provide prompt notice of the claim, assistance with or control of the defense, there may be uncertainty over what the claim *arises from* and whether it *arises from* the customer’s specifications or requirements. Additionally, indemnification provisions are generally strictly construed, with

ambiguities construed against the drafting party, and some courts hold that no right to indemnification exists until the person seeking indemnification has had a judgment rendered against it or has paid the underlying claim. Moreover, when the underlying claim is not just a demand from a patent owner, but an actual lawsuit, the defendant may be hesitant to run up further attorney fees initiating another lawsuit against its supplier. Consequently, indemnification demands may be more likely resolved based on business concerns (i.e., your customer’s threat to cease purchasing) than on legal positions.

#### *Consider Cooperating with Others*

Has the patent owner pursued others in the industry? What is the status of their disputes? Consider making a few friendly phone calls to their legal departments, to discuss the matters, strategies employed, rates or other terms demanded and the nature and ballpark range of any settlement reached. While your counterpart may be unwilling to disclose precise settlement terms, one can often gain some general information through such discussions. Of course, the accuracy of such information can never be fully relied upon.

If you intend to share sensitive information with other companies, consider executing a joint defense or common interest agreement first, to preserve the confidentiality of such information, but take care to ensure the agreement is appropriate and well drafted. The joint defense or common interest privilege is merely an extension of the attorney-client privilege and the work product doctrine. For it to apply, communications must be to further a common defense, regarding an actual or threatened lawsuit and made with the expectation of confidentiality. The advantage of such an agreement is that it permits increased cooperation between similarly situated parties, but it does have potential disadvantages. Such agreements can lead to potential conflicts of interest and disqualifications of attorneys; and, disclosures made under the assumption they were privileged may not be protected if it turns out the privilege was not properly established or was waived. Keep in mind, too, that the privilege only protects the confidentiality of information with respect to outsiders to the agreement; in no way will it prevent use of information in litigation that may arise between members of the agreement.

If a legal action has been filed or is threatened against multiple parties including your company, consider entering into an agreement for joint representation by a single law firm. Such an arrangement permits helpful sharing of information, coordination and unification of strategy, minimizing of inconsistent positions and sharing of costs on common tasks relating to prior art, invalidity, unenforceability, experts, discovery, pleadings and other matters. Admittedly, it can be difficult reaching agreement on how to allocate costs among the parties, whether equally, based on sales volume, or some other method, and disagreements may arise concerning strategy or a party's reluctance to pay its share of the costs, but such challenges are often outweighed by the substantial benefits of such an arrangement. Moreover, the agreement should grant each of the parties the right to withdraw from the group or settle the matter as it sees fit.

#### *Seek a Favorable Forum for Resolution*

If litigation seems inevitable, there are several means of trying to steer the dispute to a more favorable forum. First, you may consider filing an action for declaratory relief, typically seeking judgment of non-infringement or patent invalidity. By initiating the litigation, you may select the court, perhaps obtaining a "home field" advantage, forcing the adversary to incur increased travel costs, and avoiding less desirable venues. Historically, apprehension of imminent litigation was required to support a declaratory relief action, which is why most demand letters are delicately drafted with the intention of providing notice of infringement sufficient to start the clock running on damages, but not quite threatening enough to create the apprehension of imminent litigation needed to support a declaratory relief action. In recent years, however, the requirements for filing such actions have been loosened, notably through the US Supreme Court's decision in *Medimmune, Inc. v. Genetech, Inc.*, and the Federal Circuit's decision in *SanDisk Corp. v. ST Microelectronics, Inc.* Not only is an express threat of litigation not required, but declaratory relief may now be proper even when a patentee expressly states that it does not intend to initiate litigation, so long as it engages in a course of conduct that shows a preparedness and willingness to enforce its patent rights.

The primary disadvantage of a declaratory relief action is its cost: It is still an expensive federal patent infringement lawsuit. Additionally, like any lawsuit, it may result in unwanted publicity and require disclosure of your company's sensitive business or technical information. Moreover, the hostile act of initiating litigation will likely decrease any hopes of a peaceful resolution. Consequently, you should also consider some form of alternative dispute resolution, such as arbitration or mediation.

Although arbitration, like litigation, is an adjudicative process, it tends to be faster and cheaper, as the process is less formal, discovery may be more limited, federal rules of evidence do not apply, the award will be final, binding and enforceable and the parties will have limited rights of appeal. Moreover, the parties to arbitration have more control over the process than in litigation, deciding the qualifications and number of arbitrators, the place of arbitration, applicable rules, substantive law and pre-hearing procedures. Finally, whereas judges and juries often lack considerable expertise in technology and IPR, with arbitration the parties can select a decision-maker who is familiar with the relevant issues.

Unlike arbitration, the goal of mediation is not to determine who is right or wrong, but to seek a business solution acceptable to all, through negotiation, compromise and creative problem solving. Your manage-

## What is a Reasonable Royalty Rate?

The successful plaintiff in a patent infringement lawsuit is entitled to recover damages adequate to compensate for the infringement, but in no event less than a reasonable royalty. A reasonable royalty is defined as that amount which a person, desiring to manufacture and sell a patented article, as a business proposition, would be willing to pay as a royalty and still be able to make and sell the patented article, in the market, at a reasonable profit. Of course, compelling a party to license through litigation is not the equivalent of arms-length negotiations among willing parties; the rate is expected to be higher when compelled through litigation. In setting a reasonable rate, courts will generally consider the 15 factors set forth in *Georgia-Pacific Corp. v. US Plywood Corp.*, 318 F. Supp. 1116 (S.D.N.Y. 1970), including royalties received by the patentee for licensing the patent; royalties received for comparable patents; the nature and scope of the license; whether the patentee freely licenses or seeks to maintain exclusivity; the commercial relationship between the parties; duration of the patent; profitability of products made under the patent; extent to which the infringer has made use of the patent; and advantages of the patent over prior art. One general rule of thumb (the "25% Rule") is to calculate patent royalties at 25 percent of the gross profit, before taxes, from sales of the relevant products. Obviously, the 25% Rule is a crude tool, and adjustments may be made such as deducting non-manufacturing operating expenses, to adjust the royalty rate downwards.




ment may question the wisdom of paying for mediation, when amicable negotiation has already failed to reach a solution. They may see it as throwing away additional resources in a futile process, when litigation is inevitable. But, such a view would be shortsighted. Skilled mediators use numerous techniques and strategies that may be unavailable to the parties alone and, when faced with imminent costly litigation, parties often seize upon the last grasp opportunity to bring the matter to a close during mediation.

Regardless of what dispute resolution mechanism is being considered, be sure to obtain firm fee quotes or estimates from several lawyers and dispute resolution providers, as well as anticipated timelines and schedules of events. Share the details with management in advance and obtain written approval to minimize future internal disputes over costs. Also, before embarking on any dispute resolution process, consider discussing with management whether it might be prudent to issue a press release, send explanatory letters to customers, or engage in other forms of public relations.

## Resolving Demands Promptly and Easily

Every demand for licensing or indemnification should be treated as an extremely serious matter, to be handled with great care. Every such demand has the potential to result in litigation, treble damages, millions of dollars in attorney fees and orders blocking entry of your company's goods into key markets. If there is any doubt, outside counsel should be promptly consulted. However, by observing the above guidelines, it is surprising how many demands may be promptly and easily resolved at no cost.

In many cases, no further communications will be received after the initial demand. In other cases, the matter will be dropped after a few emails, or a license may be negotiated for a trivial sum. Even in the worst cases, which should be few, where your company sells or manufactures a high-volume product that appears to be infringing a strong and essential patent, there are usually abundant opportunities to negotiate a settlement for several years following the initial demand. 

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## ACC Extras on... Patents

### ACC Docket

- *Automated Analysis of the Patent Landscape (Feb. 2003)*. Traditional manual analysis of patent documents is not enough — current automated patent analysis tools can help you stay competitive. This article describes the tools available and how you can apply them. [www.acc.com/docket/autoanalysis\\_feb03](http://www.acc.com/docket/autoanalysis_feb03)
- *IP Due Diligence in Business Transactions: Develop Your Plan Now (Feb. 2003)*. In-house counsel understand the need for IP due diligence, but can fail to see the importance of its assets in many corporate transactions. This article offers a three-step process on how to develop a plan now to provide accurate and fast turnaround assessments later. [www.acc.com/docket/ipduedil\\_feb03](http://www.acc.com/docket/ipduedil_feb03)

### Sample Forms & Policies

- *Request for Indemnification for Patent Infringement (March 2006)*. A letter from a client to its distributor notifying the distributor that a patent infringement claim has been made against a product provided to it by the distributor. [www.acc.com/forms/idpatinfr\\_mar06](http://www.acc.com/forms/idpatinfr_mar06)
- *Patent and Technology License Agreement (March 2004)*. An agreement where a company licenses out its technology patents to another company, including provisions regarding the grant of license, sublicensing, ownership of enhancements, fees and royalties, warranties and other considerations. [www.acc.com/forms/ptech\\_mar04](http://www.acc.com/forms/ptech_mar04)

### Program Materials

- *501 – Avoiding Patent Litigation (March 2006)*. IP litigation specialists discuss strategies that can be used to assist in resolving patent disputes without resorting to litigation. [www.acc.com/501/avdpatlit\\_mar06](http://www.acc.com/501/avdpatlit_mar06)
- *Best Practices in Patent Litigation (Oct. 2008)*. A panel discussion on best practices for dealing with patent litigation in-house more efficiently, with emphasis on how recent court decisions and legislation may have an impact on your strategies. [www.acc.com/bp/patlit\\_oct08](http://www.acc.com/bp/patlit_oct08)
- *901 – Responding to a Patent Attack (April 2005)*. Information on how to respond to an attack on your company's patent. [www.acc.com/901/patent\\_apr05](http://www.acc.com/901/patent_apr05)
- *804 – Defending a Patent Infringement Case: Guiding Your Company through Unfamiliar Territory (Part 1 of 2) (Dec. 2007)*. This panel of patent litigation veterans draws from their experiences to help you better address your next patent case, from practical tips to new case law that will drive the cutting-edge of this important topic. [www.acc.com/804/patinfrin\\_dec07](http://www.acc.com/804/patinfrin_dec07)

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