In the late 1990s, I began teaching a seminar at Hastings College of the Law (University of California at San Francisco) in technology and intellectual property licensing. I looked for a textbook to use in the course, but I could not find one. Useful practice-related materials were difficult to find, and many were outdated. So I began preparing material for a course reader. This text is the result of that work.

This text was originally written as a course book for my seminar. However, many lawyers in practice have asked me what materials they can read to learn intellectual property licensing, so I wrote this book also with a view to providing what I hope will be useful advice for practicing attorneys who are new to intellectual property licensing.

This text assumes that the reader has a basic knowledge of both contract law and intellectual property law. In the area of contract law, the most important things to know for the transactional practice are rules of contract interpretation. These are summarized in the text. Intellectual property law is a broad area consisting mostly of the law of patents, copyrights, trade secrets, and trademarks. Basic intellectual property concepts are summarized in the chapter on writing license grants. There are other areas of law that bear upon the licensing practice: antitrust, unfair competition, employment, tax, and bankruptcy, but you need not know any of these areas in depth to use this text.

This text represents a viewpoint on the practice of licensing that is not shared by all, so I should explain how my viewpoint was shaped by my practice. My practice is limited to the field of technology transactions, a large part of which is intellectual property licensing. Intellectual property transactions are more than simply licenses—they are business agreements. They often contain licenses of intellectual property, because technology companies that do business together often need to use each other’s technology, and this is accomplished through intellectual property licenses.

The viewpoint I mention above has mostly to do with the kind of drafting style and practice I use, both in this book and in my work. This style is based on the following ideas:
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• Get the business deal right. All else is secondary.
• Don’t over-lawyer any deal or you will kill it.
• Your clients should be able to understand the agreements they are signing.

Some lawyers will disagree with this style and outlook. This style is what works for my practice. I have spent much of my career representing technology start-up clients. Most start-up companies—at least at the outset of my representation—have little staff, no legal staff, and few resources. They need to sign transactional agreements quickly to book revenue, get financing, or attract press attention. Their principal aim is not to eliminate risk from an agreement—an aim more typical of larger companies that have deep pockets and are easy targets for litigation. Lawyers who represent start-ups are, in large part, business advisors. We are called upon to structure business deals and recommend what risks our clients should take—not to act as scribes and be sure that all risks are eliminated. When we are asked to identify risks, we need to make practical decisions about them, because our clients often have more experience in technology development than in business, and they rely on us to tell them what risks are worst, and what risks—even bad ones—are simply facts of business life for businesspeople in their position.

Finally, my practice has centered on software clients. In practical terms, this means that the examples I give will focus on this field. This might be different from some readers’ expectations in the sense that I do not focus on pure patent licensing, and I do not focus on traditional content licensing such as that practiced in the entertainment industry. I believe, however, that software licensing is a good baseline, because it is complex enough to invoke some of the most complex issues in the licensing practice. The principles in this book can handily be applied to other fields as well, but custom and practice will vary from the examples I present in this book. Also, while most attorneys in my practice do some mergers and acquisitions work, this book is not focused on that practice. However, some of the practice tips in this book are intended to help avoid problems in the merger and acquisition transactions that are likely to be the exit strategies for start-up clients.

I hope you find this text useful. I welcome your comments and suggestions, which you may send to me at hmeeker@heathermeeker.com. If you send a comment or question, please let me know the edition you are using (this is the third edition), and whether you are a student or a practicing attorney (and if the latter, your firm and practice area).

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