

TABLE OF CONTENTS

CHAPTER 1

Introduction and Overview

§ 1.01	The Broad Range of Technology Companies	1-1
§ 1.02	The Scope of Legal, Business and Financial Issues . . .	1-3
§ 1.03	Terminology and Terms of Art	1-4
§ 1.04	Industry Volatility	1-5
§ 1.05	The Internet	1-6

CHAPTER 2

Entity Selection and Financing Issues for Early-Stage Ventures

§ 2.01	Overview	2-3
§ 2.02	Selecting the Right Legal Entity	2-4
	[1] Overview	2-4
	[2] Structural Alternatives	2-4
	[3] Considerations Regarding Tax Treatment and Liability	2-4
	[4] Putting It All Together	2-5
§ 2.03	Financing Alternatives	2-7
	[1] Stages of Financing	2-7
	[a] Seed Round	2-7
	[b] Series A Financing	2-8
	[c] Subsequent Financing Rounds	2-9
	[d] Initial Public Offering or Other Liquidity Event	2-9
	[2] Obtaining Funds; Selected Sources	2-10
	[a] Small Business Administration	2-10
	[b] Private Placements	2-11
	[c] Venture Capital	2-12
	[3] Importance of an Introduction	2-13
§ 2.04	Executive Summaries and Business Plans	2-14
	[1] How to Prepare an Effective Business Plan . . .	2-14
	[2] How to Prepare an Effective Executive Summary	2-15

§ 2.05	Valuation Issues	2-17
§ 2.06	Financing Term Sheets	2-19
	[1] Overview	2-19
	[2] Negotiation	2-19
	[3] Term Sheet Components	2-20
§ 2.07	Venture Capital Term Sheets	2-21
	[1] Overview	2-21
	[2] Checklist	2-21
§ 2.08	Importance of the Management Team	2-31
§ 2.09	Typical Terms: Definitive Venture Financing Agreements	2-32
	[1] Selected Subscription Agreement Considerations	2-32
	[a] Parties	2-32
	[b] Securities Issued	2-32
	[c] Representations and Warranties	2-32
	[d] Conditions Precedent	2-33
	[e] Affirmative Covenants	2-33
	[f] Negative Covenants	2-33
	[g] Registration Rights	2-34
	[i] Types of Registration Rights	2-34
	[ii] Requests for Registration	2-34
	[iii] Registration Expenses	2-35
	[iv] Limited Market Capacity	2-35
	[v] Piggyback Registration Rights	2-35
	[vi] Offering Procedures	2-36
	[vii] Transfer of Registration Rights	2-36
	[h] Other Considerations	2-36
	[2] Selected Stockholder Agreement Considerations	2-37
	[a] Vesting	2-37
	[b] Limits on Transferability	2-37
	[c] Repurchase of Shares	2-37
	[d] Consent to and Cooperation with Sale of the Company	2-38
	[e] Spousal Acknowledgment	2-39
	[3] Restated Certificate of Incorporation	2-39
	[a] Dividends	2-39
	[b] Liquidation Preference	2-40
	[c] Issuer Redemption Rights	2-41
	[d] Other Rights	2-41
	[i] Voting	2-41
	[ii] Conversion	2-41
	[iii] Right of First Refusal	2-42
§ 2.10	<i>Form: Short-Form Subscription Agreement (Issuer Favorable)</i>	2-43
§ 2.11	<i>Form: Convertible Preferred Stock Subscription Agreement (Investor Favorable)</i>	2-45

TABLE OF CONTENTS

vii

§ 2.12	<i>Form: Investor Rights Agreement (Investor Favorable)</i>	2-57
§ 2.13	<i>Form: Right of First Refusal and Co-Sale Agreement (Issuer Favorable)</i>	2-72
§ 2.14	<i>Form: Restated Certificate of Incorporation– Delaware (Pro-Investor)</i>	2-74.5
§ 2.15	<i>Form: Technology Company Pre-Investment Checklist</i>	2-86
§ 2.16	<i>Form: Outline for Technology Company Financing Proposal</i>	2-89
§ 2.17	<i>Form: Early Stage Company Financing Presentation Checklist</i>	2-92
§ 2.18	<i>Form: Financing Term Sheet: Convertible Preferred Equity</i>	2-95
§ 2.19	<i>Form: Angel Investor Commitment Letter for a Roll-Up Business</i>	2-104.1

CHAPTER 3

Confidentiality and Nondisclosure Agreements

§ 3.01	Introduction	3-2
§ 3.02	Protecting Confidential Information	3-4
	[1] Uniform Trade Secrets Act	3-5
	[2] Economic Espionage Act.	3-8
§ 3.03	Enforceability of Nondisclosure Agreements	3-10
	[1] Overview	3-10
	[2] Protectable Information Risk.	3-10
	[3] Temporal and Geographic Scope Risk	3-12
	[4] Statutory Preemption Risk.	3-13
	[5] Discovery Risk.	3-13
	[6] Antitrust Risk.	3-14
	[7] Nondisclosure Agreements in the Telecommunications Industry	3-14
§ 3.04	Selected Drafting Guidelines.	3-15
	[1] Enforceability Considerations	3-15
	[a] Scope.	3-15
	[b] Treatment of Confidential Information.	3-16
	[c] Temporal Duration and Geographic Scope	3-16
	[d] Mandatory Disclosure.	3-16
	[e] Return or Destruction of Confidential Information.	3-17
	[2] Other General Drafting Considerations.	3-17
	[a] No License	3-17
	[b] No Restriction on Normal Business Activities	3-17
	[c] Assignment	3-18

	[d] Severability	3-18
	[e] Injunctive Relief	3-18
	[f] No Press Releases or Other Public Statements	3-18
	[g] Choice of Law	3-18
	[h] Additional Measures That Might Be Applicable in Certain Contexts	3-19
§ 3.05	<i>Form</i> : Negotiated Proposed Transaction Nondisclosure Letter Agreement (Target Company Favorable)	3-20
§ 3.06	<i>Form</i> : Mutual Nondisclosure Agreement	3-24
§ 3.07	<i>Form</i> : Service Provider Nondisclosure Agreement (Company Favorable)	3-28
§ 3.08	<i>Form</i> : Antitrust Related Guidance for Nondisclosure Agreements	3-32

CHAPTER 4

Term Sheets and Letters of Intent

§ 4.01	Introduction	4-2
§ 4.02	Foundational Questions	4-3
§ 4.03	Term Sheets	4-7
	[1] Definition	4-7
	[2] Purpose	4-7
	[3] When to Use Term Sheets	4-7
§ 4.04	Letters of Intent	4-9
	[1] Definition	4-9
	[2] Purpose	4-9
	[3] When to Use	4-10
	[4] Potential Advantages	4-11
	[5] Potential Disadvantages	4-11
	[6] Binding, Nonbinding, and Binding-in-Part Letters of Intent	4-13
§ 4.05	Selected Legal Considerations	4-14
	[1] Introduction	4-14
	[2] Risks	4-15
	[a] A Benchmark Case	4-15
	[b] The “Four Factor” Test	4-16
	[c] A More Recent Decision	4-17
	[d] The Importance of Clarity	4-18
§ 4.06	<i>Guidelines</i> : Letters of Intent	4-20
§ 4.07	<i>Workform</i> : Term Sheets and Letters of Intent	4-24
§ 4.08	<i>Form</i> : Letter of Intent: Joint Venture	4-28
§ 4.09	<i>Form</i> : Term Sheet: Joint Venture	4-34
§ 4.10	<i>Form</i> : Letter of Intent—Share Acquisition (Short Form)	4-39
§ 4.11	<i>Form</i> : Post-Letter of Intent or Term Sheet Due Diligence Request List	4-46

TABLE OF CONTENTS

§ 4.12 *Checklist: Post-Letter of Intent or Term Sheet Due Diligence (Short Form)* 4-58

CHAPTER 5

Joint Ventures and Strategic Partnering

§ 5.01 Introduction 5-3

§ 5.02 Development and Manufacturing Joint Ventures 5-5

[1] Overview 5-5

[2] Technology Considerations 5-5

[a] Intellectual Property Rights 5-5

[b] “Base” Technology Licenses 5-6

[3] Engineering Changes 5-7

[4] Rights of First Refusal 5-8

[5] Initial Fees and Minimum Commitments 5-9

[6] Ordering Protocols 5-9

[7] Foreign Exchange Risk 5-10

[8] Product Promotion and Training 5-11

[9] Defective Products 5-12

[10] Warranty 5-13

[11] Government Contracts 5-13

§ 5.03 Combined Software and Services Ventures 5-15

[1] Overview 5-15

[2] Order Details, Customer Data and Other Basic Information 5-15

[3] Description of Software Licensed 5-15

[4] Defining Limits of “Use” of Software 5-15

[5] Software License Restrictions 5-16

[6] Confidentiality 5-16

[7] Description of Services to Be Provided 5-16

[8] Alternative Provisions 5-17

[a] Acceptance Period 5-17

[b] Continuing Negotiations 5-17

[c] Exchange Option 5-18

[d] Financing 5-18

[e] Future Products 5-19

[f] Home Use 5-19

[g] Product Plans 5-19

[h] Related Entity 5-19

§ 5.04 Co-Marketing 5-21

§ 5.05 Explanation of Selected Software Marketing Services Agreement Provisions 5-23

[1] Finder’s Fee 5-23

[2] Development Incentives 5-23

[3] Recoupment 5-24

[4] Pricing 5-25

[5] Distribution Restrictions 5-26

[6] Exclusivity 5-26

	[7]	Support Obligations	5-27
	[8]	The Software License Agreement	5-27
§ 5.06		Explanation of Selected JTDTA Provisions	5-28
	[1]	Defining the Technology	5-28
	[2]	Project Management	5-29
	[3]	Antitrust Considerations	5-30
	[4]	Potentially Conflicting Arrangements	5-30
	[a]	Governmental Restrictions	5-30
	[b]	Cross-License	5-31
§ 5.06A		International Sales and Licensing	5-32
	[1]	Overview	5-32
	[2]	Selecting Foreign Distributors and Licensees	5-33
	[3]	Legal Requirements	5-33
	[4]	Sources of Information	5-34
	[5]	Record-Keeping and Disclosure	5-35
	[6]	International Tax Implications	5-35
	[7]	Executing Agreements	5-36
	[8]	Continuing Economic Incentives	5-37
	[9]	Protecting Intellectual Property Rights	5-37
	[10]	Relationship and Contract Compliance Monitoring	5-38
§ 5.06B		Subcontractors and Tooling	5-39
	[1]	Overview	5-39
	[2]	Back-Up Tooling	5-40
	[3]	“Tooling-as-Hostage”	5-40
§ 5.07		<i>Form: Software License, Implementation and Support Agreement</i>	5-43
§ 5.08		<i>Form: Software License and Development Agreement</i>	5-72
§ 5.09		<i>Form: Software Marketing Agreement (Short Form)</i>	5-84
§ 5.10		<i>Form: Software Marketing Agreement (Long Form)</i>	5-90
§ 5.11		<i>Form: Joint IPR Development Agreement</i>	5-118
§ 5.12		<i>Form: Hardware Distribution Agreement</i>	5-137
§ 5.13		<i>Form: Joint Venture Partners Exclusive License Agreement</i>	5-162
§ 5.14		<i>Form: IT Equipment Distributor Screening Questionnaire</i>	5-188
§ 5.15		<i>Form: Electronic Joint Venture Agreement</i>	5-193
§ 5.16		<i>Checklist: IPR Joint Venture Agreements</i>	5-214.14
§ 5.17		<i>Form: Toolworks Agreement (Short Form)</i>	5-214.22
§ 5.18		<i>Form: Hardware/Software Reseller Agreement</i>	5-215
§ 5.18A		<i>Form: Internet Reseller Agreement</i>	5-226
§ 5.19		<i>Form: License and Supply Agreement</i>	5-231
§ 5.20		<i>Form: Technology Solutions Marketing Agreement</i>	5-257
§ 5.21		<i>Form: Medical Device Distribution Agreement</i>	5-265

CHAPTER 6

Selected Business Contracts

§ 6.01	Introduction	6-3
§ 6.02	Software Licensing	6-4
	[1] Modifications to Source Code	6-4
	[2] Work Product	6-4
	[3] License Restrictions	6-5
	[4] Customer Remedies; Exhibits	6-6
§ 6.03	<i>Form</i> : End User Software License Agreement	6-7
§ 6.04	Work-for-Hire Agreement	6-21
	[1] Title	6-22
	[2] Indemnification and Limitations	6-22
	[3] Statement of Work (SOW)	6-23
§ 6.05	<i>Form</i> : Independent Contractor Work-for-Hire Agreement	6-24
§ 6.06	<i>Form</i> : Source Code License Agreement	6-29
§ 6.07	<i>Form</i> : Outsourced Software Programming Agreement (Vendor-Favorable)	6-36
§ 6.08	<i>Form</i> : Outsourced Software Programming Contract (Customer-Favorable)	6-44
§ 6.09	<i>Form</i> : Software Licensing and Support Services Checklist	6-66
§ 6.10	Internet Hosting Agreements	6-71
	[1] Services Offered by ISPs	6-71
	[a] Hosting	6-71
	[b] Bandwidth	6-71
	[c] Client-User Services	6-71
	[i] Access; Technologies	6-71
	[ii] E-Mail	6-72
	[iii] Monitoring Services	6-72
	[iv] File Transfer Protocol	6-72
	[v] Intranet Interface	6-72
	[d] Transaction Services	6-73
	[e] Other Services	6-73
	[2] Related Contract Terms and Liability-Minimizing Steps	6-73
	[a] One Form; Many Services	6-73
	[b] Software License	6-73
	[i] Browser Software	6-73
	[ii] “Content-Creating” Software	6-74
	[iii] Runtime Code License	6-74
	[iv] Software Performance	6-74
	[c] Representations, Warranties, Indemnification, Editorial Controls and Policy	6-74

	[i]	Infringement	6-75
	[ii]	A Note on “Links” and “Frames”	6-75
	[iii]	Defamation	6-75
	[iv]	Suggestions	6-76
	[v]	Export Controls	6-76
	[vi]	Product Delivery	6-77
	[vii]	Viruses	6-77
	[viii]	Indemnification Caps	6-77
	[ix]	Intellectual Property Ownership	6-78
	[d]	Payment	6-78
	[c]	United States Government Restricted Rights	6-78
	[f]	Technical Requirements	6-78
	[i]	System Hardware	6-79
	[ii]	Access	6-79
	[iii]	Browser Software	6-79
	[g]	Payment Processor	6-79
	[i]	Credit or Debit Card Numbers	6-79
	[ii]	Merchant and Terminal IDs	6-79
	[iii]	Confirmation Information	6-80
	[h]	Alternative Access	6-80
	[i]	Change Orders; Additional Websites; Training	6-80
	[j]	Development Services	6-80
§ 6.11		<i>Form: Website Development Agreement</i>	6-81
§ 6.12		<i>Form: Website Hosting Services Agreement</i>	6-97
§ 6.13		<i>Form: Web Services, Software and Content Agreement.</i>	6-110
§ 6.14		<i>Form: Domain Name Assignment Agreement</i>	6-129
§ 6.14A		<i>Form: Electronic Medical Record Hosting Agreement.</i>	6-133
§ 6.15		<i>Form: Trademark and Domain Name Licensing Agreement.</i>	6-162
§ 6.16		Internet Strategic Alliances	6-166.2
	[1]	Introduction	6-166.2
	[2]	Key Business Issues	6-166.2
	[a]	Advertising	6-166.2
	[b]	Branding	6-166.2
	[c]	Development	6-166.3
	[d]	Liability	6-166.3
§ 6.17		<i>Form: Social Media Content Services Agreement (B2B)</i>	6-166.4
§ 6.18		Technology: System (Equipment) Lease	6-166.18
§ 6.19		<i>Form: Technology Equipment Lease</i>	6-166.19
§ 6.20		Selected Technology Industry Standards	6-166.23
	[1]	Open Standards	6-166.23

TABLE OF CONTENTS

xiii

	[2] Non-Assertion of Intellectual Property Rights	6-166.23
	[3] Trademark License	6-166.24
	[4] Technical Standard; Development; Antitrust	6-166.24
§ 6.21	<i>Form</i> : License of Technology and Non-Assertion of Intellectual Property Rights	6-166.25
§ 6.22	Managing Exchange Rate Risk in Commercial Contracts	6-166.30
§ 6.23	<i>Form</i> : Exchange Rate Addendum	6-166.31
§ 6.24	<i>Form</i> : Offshore Manufacturing Services Agreement for Technology Hardware	6-170
§ 6.25	<i>Form</i> : Medical Hardware Sales, License, and Service Agreement.	6-189
§ 6.26	<i>Form</i> : Transition Services Agreement	6-202
§ 6.27	<i>Form</i> : Life Sciences Distribution and License Agreement	6-214
§ 6.28	<i>Form</i> : Technology Start-Up Incubator—License for Space	6-235
§ 6.29	<i>Form</i> : Comprehensive Cloud Services Agreement. . .	6-256
§ 6.30	<i>Form</i> : Mobile Application Development Agreement.	6-296
§ 6.31	<i>Form</i> : Music License for Application Development.	6-309

CHAPTER 7

Intellectual Property

§ 7.01	Overview	7-7
§ 7.02	Hypothetical IPR Scenario	7-9
§ 7.03	Copyrights	7-10
	[1] Items That Can Be Copyrighted	7-10
	[2] Selected General Principles	7-10
	[a] Original Works of Authorship	7-10
	[b] Tangible Medium of Expression.	7-12
	[c] Form of Expression.	7-12
	[d] Formulas	7-12
	[e] Limited Rights of Copyright Owner; First Sale Doctrine	7-13
	[f] Right of Termination.	7-15
	[g] Duration of Protection.	7-16
	[h] Employee, Contractor Works	7-16
	[3] Steps to Obtain Copyright Protection	7-17
	[a] Minimum Protection	7-17
	[b] Copyright Notice.	7-17
	[c] Works First Made Public Before March 1, 1989	7-17

	[d]	Resources	7-17
	[e]	Copyright Registration/Advantages . . .	7-18
	[f]	Registration Procedure	7-18
	[g]	Work for Hire	7-18
	[h]	Licensing; Derivative Works	7-19
	[i]	Website Creation.	7-19
	[4]	The Digital Millennium Copyright Act (DMCA)	7-20
	[a]	Introduction.	7-20
	[b]	Circumvention of Anti-Piracy Measures . . .	7-20
	[c]	Internet Service Providers.	7-21
	[d]	Ephemeral Recordings; Webcasters . . .	7-22
	[e]	Pre-Release Piracy of Copyrighted Material	7-23
	[5]	Computer Fraud and Abuse Act (CFAA) . . .	7-23
§ 7.04		Trademarks	7-24
	[1]	Items That Can Be Protected as Trademarks . . .	7-24
	[2]	Selected General Principles.	7-24
	[a]	Consumer Perspective.	7-24
	[b]	Service Marks	7-25
	[c]	Trademarks Versus Trade Names.	7-25
	[d]	First Sale Doctrine: Unauthorized Sale of Genuine Goods.	7-26
	[3]	Product Identification.	7-27
	[a]	Generic Marks.	7-27
	[b]	Descriptive Marks.	7-27
	[c]	“Merely Suggestive” Marks	7-28
	[d]	Fanciful or Arbitrary Marks	7-28
	[e]	Other Selected Characteristics	7-28
	[4]	Obtaining and Preserving Trademark Protection	7-28
	[a]	New Trademark	7-29
	[b]	Active Defense	7-29
	[c]	Awareness of Trademark Abuse.	7-29
	[d]	Generic Usage.	7-29
	[e]	Review of Literature.	7-29
	[f]	Proper Usage.	7-29
	[g]	Related Products	7-30
	[h]	Capitalization	7-30
	[i]	Registered Mark Sign	7-30
	[j]	Non-Registered Mark Sign.	7-30
	[k]	Use in Documents, Advertising Copy	7-30
§ 7.05		Trade Secrets	7-31
	[1]	Trade Secrets Defined	7-31
	[2]	General Principles	7-31
	[a]	Types of Information That Can Be Protected.	7-31

TABLE OF CONTENTS

	[b]	Flexibility Versus Low Level of Protection	7-32
	[c]	Maintenance of Secrecy	7-32
	[d]	Purposes of Security Procedures.	7-33
	[e]	Other Requirements	7-33
	[f]	Manager Responsibility	7-33
	[g]	Licensing; Derivative Works	7-33
[3]		State Law, the Inevitable Disclosure Doctrine and the Defend Trade Secrets Act	7-34
[4]		Steps to Obtain and Keep Trade Secret Protection	7-35
	[a]	Generally.	7-35
	[b]	Security Within Company Facilities	7-35
		[i] Physical Security of Building	7-35
		[ii] Visitors	7-35
		[iii] Off-Limits Areas	7-35
		[iv] Security Coordinators.	7-36
	[c]	Security in Business Dealings.	7-36
	[d]	Contractual Safeguards.	7-36
		[i] New Employees	7-36
		[ii] Former Employers	7-36
		[iii] Present Employees	7-37
		[iv] Retiring Employees or Those Whose Jobs Are Being Terminated.	7-37
	[e]	Workplace Controls.	7-37
		[i] Application of the Need-to-Know Principle	7-37
		[ii] Identification of Critical Data	7-38
		[iii] Restricted Distribution.	7-38
		[iv] Secure Filing	7-38
		[v] Computer Access	7-38
		[vi] Reproduction	7-39
		[vii] Destruction of Documents	7-39
	[f]	Emergencies	7-39
	[g]	Publications.	7-39
	[h]	Advertising and Distribution.	7-39
[5]		The Role of Security Coordinators	7-39
	[a]	Security Program	7-39
	[b]	Annual Compliance Program	7-40
	[c]	Annual Security Audits.	7-40
	[d]	Security Breaches	7-40
§ 7.06		Patents	7-41
	[1]	Patents Defined	7-41
	[2]	General Principles	7-41
		[a] Items That Can Be Patented	7-41
		[b] Usefulness.	7-41
		[c] Novelty	7-41

	[d]	Non-Obviousness	7-42
	[e]	Patent Exhaustion Doctrine.	7-43
	[f]	Patent “Durability”	7-43
	[g]	Formulas	7-44
	[h]	Lead Time	7-44
	[i]	Appropriate Protection	7-45
	[j]	Disclosure	7-45
	[k]	Shop Rights Doctrine	7-45
	[3]	Steps to Obtain Patent Protection	7-46
	[a]	Complex Procedures.	7-46
	[b]	Legal Counsel	7-46
	[c]	Widget Policy with Respect to Employee, Consultant and Contractor Creations and Inventions.	7-46
	[d]	Licensing; Derivative Works	7-47
	[4]	Infringement Analysis	7-47
§ 7.07		Information Held as a Fiduciary	7-50
	[1]	Selected Types of Information Subject to Fiduciary Law	7-50
	[2]	General Principles	7-50
	[a]	Standard of Care	7-50
	[b]	Law of Ideas	7-51
		[i] Property Theory	7-51
		[ii] Contract Theory	7-51
		[iii] Implied Contract Theory	7-51
		[iv] Quasi-Contract/Unjust Enrichment Theory	7-51
	[c]	Widget Policy with Respect to Suggestions	7-52
	[d]	Other Requirements	7-52
	[3]	Maintaining Confidentiality of Information Subject to Fiduciary Law	7-53
	[a]	Trade Secrets Procedures Applicable.	7-53
	[b]	Unauthorized Transfer	7-53
	[c]	“Ethical Wall” Measures.	7-53
	[d]	Suggestions Received	7-53
	[e]	Widget Information Held by a Third Party as Fiduciary.	7-53
§ 7.08		Intellectual Property as Collateral	7-55
§ 7.09		Mask Works.	7-56
	[1]	Defined.	7-56
	[2]	Protection of Mask Works.	7-56
	[3]	Scope, Duration of Protection	7-57
§ 7.10		Biotechnology	7-58
	[1]	Overview	7-58
	[2]	Scope of Biotechnology.	7-58
	[3]	Special Application of Intellectual Property Law to Biotechnology.	7-59

TABLE OF CONTENTS

	[a]	Overview	7-59
	[b]	Relevant Patent Law History	7-60
[4]		Inventorship	7-61
[5]		Utility	7-61
[6]		Obviousness	7-62
[7]		Enablement	7-63
[8]		Infringement	7-63
[9]		Biotechnology Licensing Example	7-64
§ 7.11		Intellectual Property and the Internet	7-66
	[1]	Overview	7-66
	[2]	Metatags and Trademark Infringement	7-66
	[3]	Internet File Sharing and Fair Use of Copyrighted Material	7-68
	[a]	Overview	7-68
	[b]	Fair Use	7-70
		[i] Purpose and Character	7-70
		[ii] Nature of the Work	7-71
		[iii] Portion Used	7-71
		[iv] Commercial Effect	7-71
	[c]	Historical Context: Fair Use and Changing Technology	7-71
		[i] Betamax	7-71
		[ii] Audio Home Recording Act	7-72
		[iii] RIAA v. Diamond	7-73
		[iv] No Electronic Theft (NET) Act	7-74
	[d]	Contributory Infringement	7-75
		[i] Intent and “Substantial Non-infringing Uses”	7-75
		[ii] Napster	7-76
		[iii] Peer-to-Peer Technology and the Digital Millennium Copyright Act	7-77
		[iv] <i>Grokster</i> : A Return to Intent	7-79
		[v] <i>Mega</i> : Offloading Liability to Users	7-80
	[e]	Practical Implications	7-81
	[f]	“Fair Dealing” and File Sharing in Foreign Countries	7-82
	[g]	3D Printing; Fair Use, Infringement and Safeguarding	7-85
		[i] Generally	7-85
		[ii] Copyright and Fair Use	7-85
		[iii] Trademark	7-86
		[iv] Trade Secret	7-86
		[v] Patent	7-87
[4]		Social Media	7-87
	[a]	Background	7-87
	[b]	Technology	7-88

	[c]	Commercialization	7-89
	[d]	Applicable Law; Generally	7-89
	[e]	Copyright Law	7-89
	[i]	Creative and Expressive Works	7-89
	[ii]	Obtaining Permission	7-94
	[f]	Creative Commons License	7-97
	[i]	Attribution/Noncommercial/ No Derivatives	7-98
	[ii]	Attribution/Noncommercial/ Share Alike	7-98
	[iii]	Attribution/Noncommercial	7-98
	[iv]	Attribution/No Derivatives	7-99
	[v]	Attribution/Share Alike	7-99
	[vi]	Attribution	7-99
	[g]	Defamatory Statements and the Communications Decency Act of 1996	7-100
§ 7.12		Economic Espionage Act of 1996	7-101
	[1]	Introduction	7-101
	[2]	Theft of Trade Secrets on Behalf of or for the Benefit of a Foreign Government	7-101
	[3]	Theft of Trade Secrets for Economic or Commercial Reasons	7-102
	[4]	EEA Definition of Trade Secrets	7-102
	[5]	Penalties and Other Provisions	7-103
	[6]	Elements Required for Conviction	7-103
	[7]	A Two-Edged Sword	7-104
§ 7.13		Agreement on Trade-Related Aspects of Intellectual Property Rights	7-106
	[1]	Overview	7-106
	[2]	Standards for Protection	7-106
	[3]	Enforcement	7-107
	[4]	Dispute Settlement	7-107
	[5]	Non-Discrimination Provisions	7-107
	[6]	Selected Standards of Protection	7-108
	[a]	Copyright	7-108
	[b]	Phonograms and Broadcasters	7-109
	[c]	Trademarks	7-110
	[d]	Geographical Indications	7-112
	[e]	Industrial Designs	7-113
	[f]	Patents	7-113
	[g]	Integrated Circuits	7-115
	[h]	Undisclosed Information	7-116
	[i]	Control of Anti-Competitive Practices	7-116
	[7]	Enforcement and Remedies	7-116
	[a]	General Obligations	7-116
	[b]	Civil and Administrative Procedures and Remedies	7-117

TABLE OF CONTENTS

xix

	[c] Provisional Measures	7-119
	[d] Special Requirements for Border Measures	7-120
	[e] Criminal Procedures	7-122
[8]	Miscellaneous Provisions	7-122
	[a] Acquisition and Maintenance of IPR. . .	7-122
	[b] Transitional Arrangements	7-122
	[c] Protection of Existing Material.	7-123
§ 7.14	<i>Form</i> : Short-Form Patent License and Development Agreement	7-125
§ 7.15	<i>Form</i> : Simple Patent Use Analysis Worksheet.	7-131
§ 7.16	<i>Form</i> : Patent Dispute Cross-License Settlement Agreement.	7-134
§ 7.17	<i>Form</i> : Employee Policy for Information Security. . .	7-148
§ 7.18	<i>Form</i> : Collateral Assignment of IPR.	7-157
§ 7.19	<i>Form</i> : Trademark Use Guidelines.	7-164
§ 7.20	<i>Form</i> : Warranty, Authorized Dealer Disclaimer. . . .	7-169

CHAPTER 8

Selected Regulatory Considerations Affecting Technology Companies

§ 8.01	Overview	8-5
§ 8.02	Technology Exports: A Complex Maze of Regulation.	8-7
	[1] Overview	8-7
	[2] Regulatory Framework	8-8
	[3] Export Restrictions	8-9
	[a] Overview.	8-9
	[b] High Performance Computers (HPCs)	8-11
	[c] Multi-Lateral Arrangements	8-12
	[4] Exceptions	8-13
	[5] Export License Types and Term	8-13
	[6] Application Process	8-14
	[7] Denial and Appeal	8-14
	[8] Internal Compliance Program	8-15
	[9] Penalties.	8-15
	[10] Encryption Technology	8-15
	[a] Introduction.	8-15
	[b] Encryption Technology Explained. . . .	8-16
	[c] Changes to Export Regulatory Framework.	8-17
	[11] Reform Initiative	8-19
§ 8.03	Technology Imports—A Less Complex Regulatory Regime	8-20
	[1] Overview	8-20

REPRESENTING HIGH-TECH COMPANIES

	[2]	International Trade Commission (ITC)	8-20
		[a] Unfair Trade Practices	8-20
		[b] Anti-Dumping	8-20
		[c] Increased Imports	8-21
		[d] USMCA and Its Predecessor, NAFTA	8-22
		[e] Trade Act of 1974	8-22
		[f] General Investigative Authority	8-23
	[3]	Other Sources of Authority	8-23
		[a] Office of the United States Trade Representative	8-23
		[b] Threats to National Security	8-23
		[c] Trade Adjustment Assistance	8-24
		[i] Workers	8-24
		[ii] Businesses	8-24
§ 8.04		Foreign Investment in the United States	8-25
	[1]	Overview	8-25
	[2]	The Exon-Florio Amendment	8-26
		[a] Relevant Considerations in Initiating Executive Action	8-26
		[b] Committee on Foreign Investment in the United States	8-27
		[c] Selected Notice Requirements	8-27
		[d] Definitional Challenges Under the Act	8-28
		[e] Procedure	8-29
		[f] Completing an Exon-Florio Notice.	8-30
	[3]	Bureau of Economic Analysis: Reporting Requirements	8-31
		[a] Overview	8-31
		[b] Foreign Direct Investment	8-32
		[i] Form BE-13	8-32
		[ii] Exceptions to Filing	8-33
		[iii] Periodic Investment Reports	8-33
		[c] United States Direct Investment Abroad	8-34
		[d] United States Investment Intermediaries	8-35
		[i] “Fiduciary-Type” Intermediaries	8-36
		[ii] “Broker-Type” Intermediaries and Joint Venture Participants	8-36
	[4]	Penalties; Enforcement	8-36
§ 8.05		Foreign Operations by U.S. Companies	8-37
	[1]	Foreign Corrupt Practices Act	8-37
		[a] Overview	8-37
		[b] Accounting Standards	8-37
		[c] Anti-Bribery Regulations	8-39

TABLE OF CONTENTS

	[i]	Elements of Prohibited Activities	8-39
		[ii] Exceptions	8-40
		[iii] Penalties	8-41
	[2]	The OECD Anti-Bribery Convention	8-41
§ 8.06		The Internet and Its Regulation	8-43
	[1]	Fundamentals of Internet Technology	8-43
		[a] National Service Providers	8-43
		[b] Internet Service Providers	8-43
		[c] Servers	8-43
		[d] Flexibility	8-43
		[e] The User’s Perspective	8-44
		[f] Websites and Domain Names	8-44
		[g] Web Pages	8-44
		[h] Continuing Growth of Internet	8-44
	[2]	Domain Name Registration	8-44
	[3]	Anticybersquatting Consumer Protection Act	8-45
	[4]	Uniform Domain Name Dispute Resolution Policy (ICANN)	8-47
	[5]	Tasting, Kiting and Front Running	8-49
	[6]	Privacy and the Internet	8-52
		[a] Scope	8-52
		[b] Internet Privacy Policies	8-52
		[c] Federal Legislation	8-53
		[d] European Union; The GDPR	8-54
		[i] General Principles	8-55
		[ii] Right to Be Forgotten	8-57
		[iii] Compliance Certification	8-58
		[e] CANSPAM Act of 2003	8-59
		[f] California Website Vulnerability Disclosure	8-60
	[7]	Interfacing with Other Areas of the Law	8-60
		[a] Export Controls	8-60
		[b] Trademarks and Domain Names	8-61
		[c] Fair Use	8-61
		[d] Links and Frames	8-61
		[e] Policing Content	8-63
§ 8.07		Contract Execution	8-64
	[1]	“Shrink-Wrap”/“Click-Wrap”	8-64
	[2]	The Electronic Signatures in Global and National Commerce Act and the Uniform Electronic Transactions Act	8-64
§ 8.08		Antitrust Considerations	8-68
	[1]	Overview	8-68
	[2]	Antitrust Analysis of Competitor Collaboration	8-69

	[3]	Antitrust Implications of Licensing Intellectual Property	8-72
	[4]	The Hart-Scott-Rodino Antitrust Improvements Act of 1976	8-76
	[a]	Overview	8-76
	[b]	Reporting Requirements	8-77
	[i]	Commerce Test	8-77
	[ii]	Size of Transaction Test	8-77
	[iii]	Size of Person Test	8-77
	[iv]	Changing Thresholds	8-77
	[c]	Reporting Exceptions	8-78
	[d]	Selected Filing Procedures	8-78
	[e]	Waiting Periods	8-80
	[f]	Required Filings and Disclosures	8-80
	[i]	Summary of Hart-Scott-Rodino- Specific Information	8-80
	[ii]	Item 4(c) Internal Requests	8-83
§ 8.09		Bankruptcy and Licensing of Intellectual Property	8-85
	[1]	Overview	8-85
	[2]	Executory Contracts	8-85
	[3]	Licenses as Property Transfers	8-87
	[4]	Trademarks	8-88
	[5]	Bundled Rights	8-89
	[6]	Assignment	8-90
§ 8.10		Electronic Waste and the Environment	8-94
	[1]	An Emerging Problem	8-94
	[2]	European Union Regulations: The WEEE Directive and RoHS	8-94
	[a]	Overview	8-94
	[b]	“Take-Back” Requirements	8-96
	[c]	European Union Member-Nations	8-97
	[d]	Selected Exceptions and Limitations	8-97
	[e]	Implications Beyond Europe	8-98
	[3]	Selected Industry Responses	8-98
§ 8.11		Electronic Health Records	8-100
	[1]	Overview	8-100
	[2]	Professional Liability	8-100
	[3]	Confidentiality	8-101
	[4]	Reliability	8-101
§ 8.12		Legal Ethics, Professional Responsibility, and the Internet	8-103
	[1]	Selected Ethical Issues	8-103
	[2]	Attorney Websites	8-104
	[3]	Online Establishment of Attorney-Client Relationships	8-105
	[4]	Protection of Information	8-107
§ 8.13		<i>Form</i> : Sample Exon-Florio Notice for Technical Widget Related Acquisition	8-110

TABLE OF CONTENTS

xxiii

§ 8.14	<i>Form: Foreign Corrupt Practices Act (FCPA)— Sample Corporate Policy for Technology Company</i>	8-119
§ 8.15	<i>Form: Sample Hart-Scott-Rodino Act Item 4(c) Memoranda</i>	8-124
	[1] Long Form	8-124
	[2] Short Form	8-125
§ 8.16	<i>Form: Sample Website Privacy Statement</i>	8-126

CHAPTER 9

Employees and Independent Contractors

§ 9.01	Introduction	9-3
§ 9.02	New Employee Agreements	9-4
	[1] Enforceability	9-4
	[2] “Reasonableness”	9-5
	[3] Noncompetition Covenants	9-6
	[a] Termination	9-6
	[i] Termination Without Cause	9-6
	[ii] Petition	9-7
	[b] Confidentiality	9-7
	[c] IPR Covenants	9-8
	[d] At-Will Employment	9-8
	[e] Miscellaneous Provisions	9-8
§ 9.03	Employment Agreements	9-10
	[1] Termination	9-10
	[2] Outside Business Activities	9-11
	[3] Compensation	9-12
	[4] Noncompetition, Confidentiality and Disclosure of Inventions	9-12
	[5] Dispute Resolution	9-12
§ 9.04	Independent Contractors	9-14
	[1] Overview	9-14
	[2] Subcontractors	9-14
	[3] Independent Contractor	9-15
	[4] Protecting IPR	9-19
	[a] Trade Secrets	9-19
	[b] Works for Hire	9-19
	[5] Nondisclosure, Noncompete and Non-Solicitation Agreements	9-20
	[a] Overview	9-20
	[b] Noncompete Agreements	9-21
	[i] Generally Unenforceable in Some Jurisdictions	9-22
	[ii] Enforceable Subject to Exacting Standards	9-22
	[iii] Reasonable Restrictions	9-24

	[iv] Overbroad Restrictions	9-26
	[c] Non-Solicitation Agreements	9-26
[6]	The Fair Labor Standards Act Exemption	9-27
[7]	Reductions in Force	9-28
	[a] Overview	9-28
	[b] Post-Termination Payments	9-29
	[c] Protection from Claims	9-29
§ 9.05	Stock Options in Employee Compensation	9-30
	[1] Overview	9-30
	[2] Qualified Stock Options	9-30
	[3] Nonqualified Stock Options	9-32
	[4] Stock Appreciation Rights (SARs), Phantom Stock, and Similar Equity Participation Interests	9-34
§ 9.06	Employee Stock Ownership Plans (ESOPs)	9-35
§ 9.07	Federal Securities Law	9-37
§ 9.08	Workplace Privacy	9-38
	[1] Telephone Monitoring	9-38
	[2] Computer Monitoring	9-38
	[3] E-mail and Voice Mail	9-39
	[4] Employee Expectations of Privacy	9-39
	[5] Employee Background Checks	9-39
	[a] Overview	9-39
	[b] Criminal Records	9-40
	[c] Education Records	9-41
	[d] Credit Reports	9-41
	[e] Driving Records	9-42
	[f] Disclosure to Prospective Employers	9-42
§ 9.09	Social Responsibility	9-44
	[1] Overview	9-44
	[2] Electronic Industry Code of Conduct (EICC)	9-44
§ 9.10	Practical Guidance: Drafting the Stock Option Plan	9-46
	[1] IRS Section 162 Compensation Limitations	9-46
	[2] Plan Term	9-47
	[3] Option Pool	9-47
	[4] Authorized Share Adjustments	9-48
	[5] Attributes of the Option Grant	9-48
	[6] Vesting	9-49
	[7] Mechanics	9-49
§ 9.11	<i>Form</i> : Employee New-Hire Agreement	9-51
§ 9.12	<i>Form</i> : Employment Agreement with Commentary	9-56
§ 9.13	<i>Form</i> : Employee Stock Option Plan (General)	9-63
§ 9.14	<i>Form</i> : Non-Employee Grantee Stock Option Plan	9-72
§ 9.15	<i>Form</i> : Employee Option Grants	9-82
§ 9.16	<i>Form</i> : Non-Employee Option Grants	9-91
§ 9.17	<i>Form</i> : Employee Option Grantee Informational Memorandum	9-98

TABLE OF CONTENTS

xxv

§ 9.18	Form: Non-Employee Option Grantee Informational Memorandum	9-105
§ 9.19	Checklist: Restrictive Covenants	9-111
§ 9.20	Form: Employee Retention Agreement.	9-113

CHAPTER 10

Selected Issues for the Public Technology Companies

§ 10.01	Introduction	10-2
§ 10.02	Stakeholder Litigation	10-4
§ 10.03	Mandated v. Elective Disclosure	10-5
	[1] Overview	10-5
	[2] Elective Disclosure and the Securities Exchange Act	10-5
	[3] Elective Disclosure and Securities Exchange Regulations	10-7
§ 10.04	“Soft Information” Disclosures	10-8
	[1] Overview	10-8
	[2] “Bespeaks Caution” Doctrine	10-8
	[3] The Private Securities Litigation Reform Act	10-9
	[a] Cautionary Statements	10-10
	[b] Oral Forward-Looking Statements	10-11
§ 10.05	Practical Guidelines Regarding Disclosures	10-13
	[1] Written Disclosures	10-13
	[2] Website, Social Media and Other Electronic Disclosures	10-14
	[3] Oral Disclosures.	10-14
§ 10.06	Federal Securities Actions in State Courts	10-16
	[1] Overview	10-16
	[2] Securities Litigation Uniform Standards Act.	10-17
§ 10.07	Analyst and Earnings Calls	10-19
	[1] Overview	10-19
	[2] Liability Under the Exchange Act.	10-19
	[3] Liability in Connection with Analyst Forecasts	10-20
§ 10.08	Potential Liability Under Other Provisions of the Federal Securities Laws	10-23
	[1] Overview	10-23
	[2] Officers, Directors, and Certain Shareholders	10-23
	[a] Forms 3, 4 and 5 Under the Exchange Act.	10-23
	[b] Schedule 13D Under the Exchange Act.	10-24
	[c] Schedule 13G Under the Exchange Act.	10-24
	[d] “Insider” Issues Under the Exchange Act	10-25

	[e]	Short-Swing Profits Under Section 16(b) of the Exchange Act . . .	10-27
	[f]	Short Sales Under Section 16(c) of the Exchange Act	10-29
	[3]	Selected Internal Compliance Procedures . . .	10-29
	[a]	Restricted Stock	10-29
	[b]	Maintaining Confidentiality	10-29
	[c]	General Considerations: Transactions with the Company	10-30
	[4]	Conclusion	10-31
§ 10.09		<i>Form</i> : Selected Risk Factors Disclosure—Software Company	10-32
§ 10.10		<i>Form</i> : Illustrative Selected Risk Factors—Telecommunications Company	10-45
§ 10.11		<i>Form</i> : Insider Trading Policy Memorandum	10-52
§ 10.12		<i>Form</i> : Insider Trading Policy	10-58
§ 10.13		<i>Form</i> : IPO Client Memorandum	10-62
§ 10.14		<i>Form</i> : Memorandum Selected Public Company Obligations	10-79
§ 10.15		<i>Form</i> : Insider Trading in Company Securities Memorandum	10-90
§ 10.16		<i>Form</i> : IPO Time and Responsibility Schedule	10-101
§ 10.17		<i>Guidance</i> : Selected Risk Factors—Foreign E-Commerce Issuer	10-111

GLOSSARIES

1.	Selected Technical Terms	G-3
2.	Selected Telecommunications Industry Terms	G-25
3.	Selected Media Terms	G-37
INDEX	I-1