

**Item 2.**

**License Checklist**



# License Checklist

## Patent, Technology and Software Licenses Conveying Rights in Board Intellectual Property

The Office of General Counsel requires that you use this Checklist as part of the process of review and approval of license and option agreements.

Please read the instructions before beginning.

*Check the boxes below if your answer to the question is YES.*

### A. Basic Contract Drafting Considerations

- 1. Did you begin with a standard or shell agreement in blank form, approved by the Office of General Counsel?
- 2. Did you or the licensee incorporate clauses from another agreement?
- 3. Did you or the licensee draft new clauses from scratch?
- 4. Does your draft contain clauses that seem irrelevant to this particular deal?
- 5. Does your contract have paragraphs that cross-reference other internal paragraphs?
- 6. Are you the only person in your department working on this agreement?
- 7. Does your agreement address the same issue in two or more places in slightly differing ways?
- 8. Does your transaction have an unusual background

or history?

## ***B. Intellectual Property, Policy and Guidelines Considerations***

- 1. Is there anything unusual about the Board's ownership of the licensed intellectual property?
- 2. Does the transaction involve inventor or Board equity ownership or inventor business participation in the licensee?
- 3. Has the licensee asked the Board to warrant anything other than our standard warranties about good title and rights to grant the license?
- 4. Has the licensee asked the Board to indemnify it for anything?

5. Are you or the licensee substantially revising either of the following sections?

Definitions

License

- 6. Have you or the licensee removed or significantly impaired any of the following rights or obligations?

Reversion of rights for failure to commercialize

Reimbursement for all patent expenses

Full indemnification for U.T. System and component institution

Right to publish scientific findings

Obligation to maintain confidentiality of unpatented technology

Right to share in sublicensee revenues

7. Which, if any, of the following extenuating circumstances may interfere with documenting this transaction such that *the document may not reasonably*

***be expected to meet normal expectations?***

- General time pressures (understaffing/workflow problems; requesting significant revisions late in process; pressure from other offices with related documents; pressure from licensee; date-sensitive technology)**
- Fragile licensee relationship**
- Faculty inventor unsupportive of efforts to conform documentation to normal expectations**
- Little or no leverage with reluctant licensee**
- Pressure to use an old agreement with the licensee to save time, even if the old agreement will not conform to current expectations ("They are used to seeing this language...")**
- The agreement, even though not conforming to current expectations, was approved previously by OGC**

Describe the agreement, for your reference.

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