

Contractual Matters & License Agreements

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Boğaziçi University

Deriş Avukatlık Ortaklığı

Deriş Patent ve Marka Acentalığı A.Ş.

SCENARIOS TO BE PREPARED AGAINST

YOUR BUSINESS PARTNER, DISTRIBUTOR, MANUFACTURER, LICENSEE OR SHAREHOLDER MAY BECOME ONE OF YOUR COMPETITORS?

- ▶ **ACKNOWLEDGEMENT OF LICENSOR'S RIGHTS**
- ▶ **UNDERTAKING TO RESPECT ALL OF LICENSOR'S RIGHTS**
- ▶ **NON-COMPETITION**
- ▶ **NON-DISCLOSURE**

A HASSLE FREE BUSINESS RELATION IS BEST ACHIEVED WHEN THE OPERATION IS;

- ▶ **SUSTAINABLE**
- ▶ **UNINTERRUPTED**
- ▶ **PREDICTABLE**
- ▶ **ORDERLY**

LICENSE AGREEMENTS SHOULD POSSIBLY BE CLEAR AND APPROPRIATELY FRAMED AS TO THE CONTEXT / INTENTION OF THE PARTIES...

THE WHEREAS PART SHOULD BE FRAMED AS TO THE INTENTION OF THE PARTIES:

- ▶ **WHY DO THE PARTIES DECIDE TO COOPERATE?**
- ▶ **WHAT DO THEY INTEND TO ACHIEVE?**
- ▶ **HOW DO THEY INTEND TO ACHIEVE THEIR AIMS?**

LICENSE AGREEMENTS SHOULD BE APPROPRIATELY FRAMED AS TO THE CONTENT...

- ▶ **SUBJECT OF THE LICENSE AGREEMENTS** : **IP RIGHTS** (PATENT, TRADEMARK, COPYRIGHTS, UTILITY MODELS, GEOGRAPHICAL INDICATIONS, PLANT VARIETIES, SEMI CONDUCTOR TOPOGRAPHIES)
CORPORATE TITLES, TRADE NAMES
TRADE SECRETS
KNOW HOW
- ▶ **THE FORM OF PROTECTION** : **REGISTERED/ NON-REGISTERED**
- ▶ **TYPE OF LICENSE** : **EXCLUSIVE/ SOLE/ NON-EXCLUSIVE**
- ▶ **GEOGRAPHICAL COVERAGE** : **TERRITORY/ REGION/ COUNTRY**
- ▶ **COVERAGE IN TERMS OF ACTIVITY** : **FIELD/ PRODUCT**
- ▶ **LICENSE FEE** : **VARIABLE ROYALTY/ LUMP SUM/ CROSS LICENSING**

PURSUANT TO THE NEW IP CODE;

- NO CANCELLATION OF PATENTS ON THE GROUNDS OF NON-USE
- SOLE SANCTION FOR NON-USE: COMPULSORY LICENSE
- PATENTS - REQUIREMENT OF USE: (ART. 130/2)
 - ▶ STATUTORY ALTERNATIVE DATES (NEWLY INTRODUCED) FOR PUTTING THE PATENT TO USE - WHICH EVER IS LATER
 - ▶ 3 YEARS FROM THE PUBLICATION OF THE DECISION TO GRANT OR
 - ▶ 4 YEARS FROM THE APPLICATION DATE (NEWLY INTRODUCED)

ACCORDING TO NEW IP CODE, IT IS POSSIBLE:

- ▶ TO OFFER FOR LICENSE A PATENT APPLICATION (ART. 128/1)
- ▶ TO REQUEST A COMPULSORY LICENSE FOR A PATENT APPLICATION (ART. 130/2)

THE NEW IP CODE MAINTAINS COMPULSORY LICENSE:

- ▶ **BY INTRODUCING THREE NEW GROUNDS: (ART. 129/1)**
 - **RESTRICTION OR BREACH OF COMPETITION RULES**
 - **EXPORTATION OF PHARMACEUTICAL PRODUCTS FOR ADDRESSING PUBLIC HEALTH NEEDS IN OTHER COUNTRIES**
 - **WHEN A NEW PLANT VARIETY CAN NOT BE DEVELOPPED WITHOUT INFRINGING A PATENT**
- ▶ **BY INTRODUCING ALONGSIDE THE COURTS A NEW BODY:**
“THE COMPETITION BOARD” (ART. 129/2) IN CASE OF RESTRICTION OR BREACH OF COMPETITION RULES

LICENSE AGREEMENTS SHOULD BE APPROPRIATELY FRAMED AS TO THE RIGHTS & OBLIGATIONS OF PARTIES...

▶ LICENSOR

- ▶ OBTAINING & MAINTANING IP RIGHTS
- ▶ MODIFYING & IMPROVING IP RIGHTS
- ▶ PROTECTION OF IP RIGTHS AGAINST MISUSE & INFRINGEMENT
- ▶ AUDIT OF THE QUALITY & QUANTITY
- ▶ OBJECTIVES & REQUIREMENTS : FIELD/
PRODUCT

▶ LICENSEE

- ▶ USING IP RIGHTS
- ▶ NOT TO COMPETE
- ▶ CONFIDENTIALITY
- ▶ DISCLOSING & SHARING IMPROVEMENTS
- ▶ NOT EXTENDING THE LICENSE SCOPE
- ▶ MEETING QUALITY & QUANTITY
- ▶ OBJECTIVES & REQUIREMENTS : FIELD/
PRODUCT

LICENSE AGREEMENTS SHOULD BE APPROPRIATELY FRAMED AND ENABLING AS TO THE LEGAL MEANS...

- ▶ FOR LITIGATION (OFFENSIVE/DEFENSIVE) PURPOSES
- ▶ FOR DISPUTE RESOLUTION
- ▶ FOR AN ORDERLY TERMINATION

THE TEXT OF THE AGREEMENT SHOULD POSSIBLY BE

**CONCISE
(NOT UNDULY LONG
AND COMPLICATED)**

**SO AS TO PERMIT AN
EASY READING AND
THOROUGH AND
CORRECT
UNDERSTANDING**

EXECUTABLE

EASILY MANAGABLE

TO THE EXTENT FEASIBLE, THE AGREEMENT SHOULD

- ▶ **PROVIDE LEGAL CERTAINTY**
- ▶ **AVOID INTERPRETATIVE ISSUES / UNCERTAINTIES**
- ▶ **BE LEGALLY ENABLING**

THANK YOU FOR LISTENING ...

CONTACT

Inebolu Sokak No 5 Deriş Patent BuildingKabataş/Setüstü 34427 Istanbul Turkey

P +90(212)252 61 22-23 +90(212)249 70 10-11 +90(212)292 60 00 (6 Lines)

F +90(212)293 76 76 +90(212)292 59 94 (3 Lines)

[E deris@deris.com.tr](mailto:deris@deris.com.tr)