Five Key Points

Confidentiality Agreement

1. Clearly stated Purpose (keep this in mind as relationship expands).

2. Treatment of oral or visual Confidential Information.

3. Ability to share Confidential Information with third parties, e.g., potential investors.

4. Customary exceptions.

5. Length of confidentiality obligation.

Material Transfer Agreement

1. Description of permitted uses (usually, a work plan is attached as an exhibit).

2. Obligation to report results.

3. Ownership of and rights to use and share results.

4. Ownership of and right to file patent applications.

5. Term of the agreement.

Service Agreements

1. Description of the services, which then define the permitted uses (usually, a work plan is attached as an exhibit).

2. Performance standards or guarantees.

3. Assignment of intellectual property rights.

4. Payment terms and impact of payment disputes on rights (be careful of contingent assignments).

5. Insurance and indemnification.

In-Licenses

1. Definition of Licensed Product, IP and Field of use.

2. Royalty term and basis for royalty obligations.

3. Restrictions on sublicensing and use of CROs.

4. Financial terms.

5. Assignability.

6. Diligence obligations.

Out-Licenses

1. Definition of Licensed Product, IP and Field of use.

2. Royalty term and basis for royalty obligations.

3. Financial terms.

4. Diligence obligations.

5. Grant-back rights.

Collaborations

1. Description of the roles and responsibilities of the parties.

2. Governance.

3. Financial terms.

4. Diligence obligations.

5. Ownership of and rights in intellectual property created.