

THE TECH CONTRACTS HANDBOOK

Software Licenses and Technology Services Agreements for Lawyers and Businesspeople

by David W. Tollen

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www.TechContracts.com

Form Contract

Confidentiality (NDA) & Assignment Agreement

You may use the form contract below, subject to the "Terms of Use" found at <http://techcontracts.com/html/privacy-policy.html>. In addition to the Terms of Use, PLEASE READ THE FOLLOWING DISCLAIMER BEFORE USING THE FORM CONTRACT:

The form contract below is general in nature and may not be sufficient for a specific contractual, technological, or legal problem or dispute. THE FORM IS NOT PROVIDED WITH ANY GUARANTY, WARRANTY, OR REPRESENTATION AS TO QUALITY OR SUITABILITY FOR ANY PARTICULAR PURPOSE. Publication of the form does not constitute the practice of law and is not legal counsel or advice. Neither the author nor the publisher of The Tech Contracts Handbook, nor anyone affiliated with the book's Website, is rendering a legal or other professional service. The form should not be relied upon as a substitute for consultation with an experienced attorney.

CONFIDENTIALITY & ASSIGNMENT AGREEMENT

This Confidentiality & Assignment Agreement (this "Agreement") is entered into as of _____, 20__ (the "Effective Date") by and between _____, a _____ ("Company"), and _____, an individual ("Provider").

RECITALS

In the course of providing technology-related services to Company, Provider may develop technologies related to Company's business and may receive Company's confidential information. The parties have agreed that any such technology will belong

to Company and that provider will maintain the confidentiality of any such information. Therefore, in consideration of the mutual covenants, terms, and conditions set forth below, the adequacy of which consideration is hereby accepted and acknowledged, the parties agree as follows.

TERMS AND CONDITIONS

1. Intellectual Property.

- (a) *Reporting of Inventions.* Provider will promptly disclose to Company all computer software programs, other works of authorship, formulas, processes, compositions of matter, databases, mask works, improvements, logos, symbols, designs, and other inventions that Provider makes, conceives, reduces to practice, or creates, either alone or jointly with others, during the period of Provider's engagement with Company (collectively, "**Inventions**"), whether or not in the course of such engagement, and whether or not such Inventions are patentable, copyrightable, protectable as trade secrets, or otherwise subject to intellectual property protection.
- (b) *Company Ownership of Work Product.* An Invention will be considered "Work Product" and will be Company's sole property if it fits any of the following three criteria: (1) it is developed using equipment, supplies, facilities, or trade secrets of Company; (2) it results from Provider's work for Company; or (3) it relates to Company's business or its current or anticipated research and development.
 - (i) *Work-for-Hire.* To the extent permissible under applicable law, Work Product will be considered work made for hire pursuant to the U.S. Copyright Act, 17 U.S.C. §101 et seq, and any foreign equivalent thereof.
 - (ii) *Assignment.* To the extent, if any, that Work Product may not be considered work made for hire, Provider hereby assigns to Company all of its ownership, right, title, and interest in and to all Work Product, including, without limitation: (A) all copyrights, patents, rights in mask works, trademarks, trade secrets, and other intellectual property rights and all other rights that may hereafter be vested relating to the Work Product, arising under U.S. or any other law, together with all national, foreign, state, provincial, and common law registrations, applications for registration, and renewals and extensions thereof; (B) all goodwill associated with Work Product; and (C) all benefits, privileges, causes of action, and remedies relating to any of the foregoing, whether before or hereafter accrued (including without limitation the exclusive rights to apply for such registrations, renewals, and/or extensions, to sue for all past infringements or violations of any the foregoing, and to settle and retain proceeds from any such actions).
- (c) *Backup License.* To the extent, if any, that this Section 1 does not provide Company with full ownership, right, title, and interest in and to the Work Product, Provider hereby grants Company a perpetual, irrevocable, fully-paid, royalty-free, worldwide license to reproduce, create derivative works from, distribute, publicly

display, publicly perform, use, make, have made, offer for sale, sell or otherwise dispose of, and import the Work Product, with the right to sublicense each and every such right.

- (d) *Prior Inventions*. Provider represents that Attachment A is a list of all Provider's Inventions prior to the Effective Date which Provider has not separately assigned to Company (collectively "Prior Inventions"), and that if Exhibit A is blank or not included, there are no Prior Inventions. Provider will not use any Prior Invention in Provider's work related to the engagement with Company without Company's prior written consent. To the extent that Provider does use or incorporate a Prior Invention in a product, service, or process created for Company, with or without Company's consent, Provider hereby grants Company a nonexclusive, perpetual, irrevocable, fully-paid, royalty-free, worldwide license to reproduce, create derivative works from, distribute, publicly display, publicly perform, make, have made, offer for sale, sell or otherwise dispose of, import, and use such Prior Invention, solely in conjunction with the product, service, or process in question, with the right to sublicense each and every such right.
- (e) *Moral Rights*. In addition to the foregoing transfers and allocations of rights, Provider hereby irrevocably transfers and assigns to Company any and all "moral rights" Provider may have in or with respect to the Work Product. Provider also hereby forever waives and agrees that it will never, even after termination of its engagement with Company, assert any of the following against Company or its customers, licensees, or sublicensees (direct and indirect): (i) any moral rights with respect to the Work Product; and (ii) any moral rights with respect to the Prior Inventions licensed pursuant to Subsection 1(d) above. "Moral rights" include any rights to claim authorship of or credit on a work of authorship, to object to or prevent the modification or destruction of a work of authorship, or to withdraw from circulation or control the publication or distribution of a work of authorship, and any similar right, existing under judicial or statutory law of any country or subdivision of a country, or under any treaty, regardless of whether or not such right is described as a "moral right."
- (f) *Further Assistance*. Provider will help Company obtain and enforce patents, copyrights, rights in mask works, trade secret rights, and other legal protections for the Work Product in any and all jurisdictions throughout the world. Provider will execute any documents Company reasonably requests for use in obtaining or enforcing such rights and protections. To the extent that such assistance occurs after Provider's engagement with Company, Company will compensate Provider at a reasonable rate for time and expenses spent at Company's request pursuant to this Subsection 1(f). Provider hereby appoints Company or its designated representative as Provider's attorney-in-fact to execute documents on Provider's behalf for the purposes set forth in this Subsection 1(f).

2. Nondisclosure.

- (a) *Confidential Information*. "Confidential Information" refers to the following items Company discloses to Provider: (i) any document Company marks "Confidential"; and (ii) any information Company orally designates as "Confidential" at the time

of disclosure, provided Company confirms such designation in writing within ____ business days. Notwithstanding the foregoing, Confidential Information does not include information that: (A) is in Provider's possession at the time of disclosure; (B) is independently developed by Provider without use of or reference to Confidential Information; (C) becomes known publicly, before or after disclosure, other than as a result of Provider's improper action or inaction; or (D) is approved for release in writing by Company.

- (b) *Nondisclosure Obligations.* Provider will not: (i) use Confidential Information for any purpose other than _____ (the "Purpose"); or (ii) disclose Confidential Information to any other third party without Company's prior written consent. Provider will promptly notify Company of any misuse or misappropriation of Confidential Information that comes to Provider's attention. Notwithstanding the foregoing, Provider may disclose Confidential Information as required by applicable law or by proper legal or governmental authority. Provider will give Company prompt notice of any such legal or governmental demand and reasonably cooperate with Company in any effort to seek a protective order or otherwise to contest such required disclosure, at Company's expense.
- (c) *Injunction.* Provider agrees that breach of this Section 2 would* cause Company irreparable injury, for which monetary damages would not provide adequate compensation, and that in addition to any other remedy, Company will be entitled to injunctive relief against such breach or threatened breach, without proving actual damage or posting a bond or other security.
- (d) *Termination and Return.* The obligations of Subsection 2(b) above will terminate _____ after the Effective Date. Upon termination of this Agreement or upon Company's written request, Provider will return all copies of Confidential Information to Company or certify, in writing, the destruction thereof.
- (e) *Retention of Rights.* This Section 2 does not transfer ownership of Confidential Information or grant a license thereto. Company will retain all right, title, and interest in and to all Confidential Information.

3. **Warranty.** Provider warrants that the Work Product is and will be its original work, created without participation of any third party (but not necessarily without Company's participation), and that Provider has and will have the right to grant the intellectual property and other rights set forth in Section 1 above without the further consent of any person or entity.

4. **Survival.** The provisions of Sections 1 through 3 above will survive any termination or expiration of Provider's engagement Company and of this Agreement.

5. **Miscellaneous.**

- (a) *Notices.* Notices pursuant to this Agreement will be sent to the addresses below, or to such others as either party may provide in writing. Such notices will be deemed received at such addresses upon the earlier of (i) actual receipt or (ii)

* *The Tech Contracts Handbook*, on page 82, erroneously uses the word "might" where this form uses "would."

delivery in person, by fax with written confirmation of receipt, or by certified mail return receipt requested.

(i) For Provider: _____.

(ii) For Company: _____.

- (b) *Independent Contractors.* The parties are independent contractors and will so represent themselves in all regards. Neither party is the agent of the other and neither may bind the other in any way.
- (c) *No Waiver.* Neither party will be deemed to have waived any of its rights under this Agreement by lapse of time or by any statement or representation other than (i) by an Authorized Representative (as defined below) and (ii) in an explicit written waiver. No waiver of a breach of this Agreement will constitute a waiver of any prior or subsequent breach of this Agreement. (An "Authorized Representative" is _____.)
- (d) *Choice of Law & Jurisdiction.* This Agreement will be governed solely by the internal laws of the State of _____, without reference to such State's principles of conflicts of law. The parties consent to the personal and exclusive jurisdiction of the federal and state courts of _____, _____.
- (e) *Severability.* To the extent permitted by applicable law, the parties hereby waive any provision of law that would render any clause of this Agreement invalid or otherwise unenforceable in any respect. In the event that a provision of this Agreement is held to be invalid or otherwise unenforceable, such provision will be interpreted to fulfill its intended purpose to the maximum extent permitted by applicable law, and the remaining provisions of this Agreement will continue in full force and effect.
- (f) *Execution in Counterparts.* This Agreement may be executed in one or more counterparts. Each counterpart will be an original, but all such counterparts will constitute a single instrument.
- (g) *Construction.* The parties agree that the terms of this Agreement result from negotiations between them. This Agreement will not be construed in favor of or against either party by reason of authorship.
- (h) *Entire Agreement.* This Agreement sets forth the entire agreement of the parties and supersedes all prior or contemporaneous writings, negotiations, and discussions with respect to the subject matter hereof. Neither party has relied upon any such prior or contemporaneous communications.
- (i) *Amendment.* This Agreement may not be modified except (i) by Authorized Representatives (as defined in Subsection 5(c) above) of each party and (ii) in a written contract signed by both parties.

IN WITNESS THEREOF, the parties have executed this Agreement as of the Effective Date.

COMPANY

PROVIDER

By:

By:

(signature)

(signature)

Name:

Name:

(print)

(print)

Title:

Title:

Attachment A: Prior Inventions

[insert]