

# Contents

<b>CHAPTER ONE OWNERSHIP OF TECHNOLOGY . . . . .</b>	<b>1-1</b>
1.1 Introduction to Intellectual Property . . . . .	1-1
1.2 Ownership Attributes of Intellectual Property . . . . .	1-1
1.2.1 Copyrights . . . . .	1-1
1.2.1.1 General . . . . .	1-1
1.2.1.2 Requirements for Copyright . . . . .	1-2
1.2.1.2.1 Originality . . . . .	1-2
1.2.1.2.2 Authorship . . . . .	1-3
1.2.1.2.3 Fixation. . . . .	1-3
1.2.1.2.4 Categories of Works . . . . .	1-4
1.2.1.2.4.1 Works Made for Hire. . . . .	1-4
1.2.1.2.4.2 Collective Works. . . . .	1-5
1.2.1.2.4.3 Derivative Works. . . . .	1-5
1.2.1.2.4.4 Joint Works . . . . .	1-5
1.2.1.2.4.5 Compilations . . . . .	1-6
1.2.1.3 Exclusive Rights of the Copyright Owner . . . . .	1-6
1.2.1.4 Formalities and Benefits of Federal Registration of Copyright . . . . .	1-7
1.2.1.5 Transfers and Assignments of Copyrights. . . . .	1-8
1.2.1.6 International Protection . . . . .	1-9
1.2.2 Trademarks, Trade Dress, and Trade Names . . . . .	1-9
1.2.2.1 Eligibility for Trademark Protection . . . . .	1-10
1.2.2.1.1 Distinctiveness . . . . .	1-10
1.2.2.1.2 Types of Marks. . . . .	1-11
1.2.2.2 Protection of Marks . . . . .	1-11
1.2.2.2.1 Infringement . . . . .	1-12
1.2.2.2.2 Unfair Competition . . . . .	1-12
1.2.2.2.3 Loss of Proprietary Rights to Trademarks . . . . .	1-12
1.2.2.3 Formalities and Benefits of Registration. . . . .	1-13
1.2.3 Patents . . . . .	1-14
1.2.3.1 General . . . . .	1-14
1.2.3.2 Requirements for Patent . . . . .	1-14
1.2.3.2.1 Subject Matter . . . . .	1-14
1.2.3.2.2 Novelty. . . . .	1-16
1.2.3.2.3 Utility . . . . .	1-17
1.2.3.2.4 Non-obviousness . . . . .	1-17
1.2.3.3 Exclusive Rights of Patent Owner. . . . .	1-18
1.2.3.4 Infringement . . . . .	1-18
1.2.3.5 International and Domestic Protection . . . . .	1-19
1.2.3.5.1 United States Law . . . . .	1-19

CONTENT

	1.2.3.5.2 International . . . . .	1-19
1.2.4	Trade Secrets and Confidential Information . . . . .	1-20
	1.2.4.1 General . . . . .	1-20
	1.2.4.2 Rights of Owner . . . . .	1-21
	1.2.4.3 Enforcement Issues . . . . .	1-22
1.3	Non-intellectual Property Rights—Ownership Status . . . . .	1-23
1.3.1	Rights of Privacy and Publicity . . . . .	1-23
	1.3.1.1 Endorsements . . . . .	1-23
	1.3.1.2 Morals Clause . . . . .	1-24
1.3.2	Domain Names . . . . .	1-25
1.3.3	Miscellaneous Property Rights . . . . .	1-25
	1.3.3.1 Mask Works . . . . .	1-25
	1.3.3.2 Vessel Hull Designs . . . . .	1-26
	1.3.3.3 Other Rights under Federal Law . . . . .	1-27
	1.3.3.4 International Rights . . . . .	1-28
1.4	Forms . . . . .	1-29
	Form 1-1 Copyright Office Form TX . . . . .	1-29
	Form 1-2 Copyright Office Form PA . . . . .	1-31
	Form 1-3 Copyright Office Form SR . . . . .	1-33
	Form 1-4 Copyright Office Form VA . . . . .	1-35
	Form 1-5 Copyright Office Form SE . . . . .	1-37
	Form 1-6 Copyright Office Form CA . . . . .	1-39
	Form 1-7 Assignment of Copyrights . . . . .	1-41
	Form 1-8 Document Cover Sheet for Recording Documents . . . . .	1-45
	Form 1-9 Employee Confidentiality and Invention Agreement . . . . .	1-47
	Form 1-10 Copyright Licensing Organizations and Publications Rights Clearinghouses . . . . .	1-50
	Form 1-11 International Copyright Relations of the U.S. . . . .	1-55
	Form 1-12 GA Application for Registration of Trademark or Service Mark . . . . .	1-64
	Form 1-13 GA Trademarks and Service Marks: Frequently Asked Questions . . . . .	1-65
	Form 1-14 Assignment of Registered Trademarks and Service Marks . . . . .	1-66
	Form 1-15 Assignment of Patent Application . . . . .	1-70
	Form 1-16 Assignment of Patent . . . . .	1-71
	Form 1-17 Notice of Exclusive Patent License . . . . .	1-72
	Form 1-18 Mutual Nondisclosure Agreement . . . . .	1-74
	Form 1-19 Customer-Advisory Group Nondisclosure Agreement . . . . .	1-77
	Form 1-20 Location Release . . . . .	1-79
	Form 1-21 General Image Release . . . . .	1-81
	Form 1-22 Testimonial Release . . . . .	1-83
	Form 1-23 FTC Guides Concerning Use of Endorsements and Testimonials in Advertising . . . . .	1-85

Form 1-24	Top-Level Domain Registries . . . . .	1-94
Form 1-25	Employee E-mail and Internet Use Policy . . . . .	1-96
Form 1-26	Domain Name Assignment . . . . .	1-99
Form 1-27	ICANN Dispute Resolution Policy . . . . .	1-102
Form 1-28	Copyright Office Form D-VH . . . . .	1-109
Form 1-29	Copyright Office Form MW . . . . .	1-111
Form 1-30	IP Rights Complaint for Customs Enforcement . . . . .	1-113

**CHAPTER TWO CUSTOM DEVELOPMENT AND/OR ACQUISITION OF EXCLUSIVE RIGHTS IN TECHNOLOGY . . . . . 2-1**

2.1	Defining Technology Needs . . . . .	2-1
2.1.1	Identifying Requirements . . . . .	2-3
2.1.1.1	The Business Need . . . . .	2-4
2.1.1.2	Defining a Technology Product . . . . .	2-5
2.1.1.3	The Technical Specification . . . . .	2-5
2.1.2	Identifying and Soliciting Relevant Technology/Vendors . . . . .	2-6
2.1.3	Project Management over the Life Cycle of the Technology . . . . .	2-8
2.1.4	Testing and Acceptance to Specifications . . . . .	2-9
2.1.4.1	Trying to Hit a Moving Target . . . . .	2-10
2.1.4.2	Change Orders . . . . .	2-11
2.1.5	The True Costs of Ownership . . . . .	2-11
2.1.5.1	Transaction Costs . . . . .	2-12
2.1.5.1.1	Third-Party Infringement . . . . .	2-12
2.1.5.1.2	Policing Licensees . . . . .	2-13
2.1.5.2	Practical Costs of Ownership . . . . .	2-14
2.1.5.2.1	Warranty and Maintenance . . . . .	2-14
2.1.5.2.2	Upgrades . . . . .	2-15
2.2	Internal Development . . . . .	2-15
2.2.1	Employment Agreements . . . . .	2-15
2.2.1.1	Enforceability . . . . .	2-16
2.2.1.2	Dispute Resolution . . . . .	2-16
2.2.1.3	Specific Provisions . . . . .	2-16
2.2.1.3.1	Nondisclosure . . . . .	2-16
2.2.1.3.2	Invention Assignment . . . . .	2-17
2.2.1.3.3	Noncompetition, Nonsolicitation, Noncircumvention . . . . .	2-17
2.2.2	Subcontractors and Outsourcing . . . . .	2-18
2.2.3	Human Resources Issues . . . . .	2-21
2.2.4	Clean Rooms—Proof of Creation . . . . .	2-21
2.2.5	Unintentional Infringement . . . . .	2-22
2.3	Acquisition of Third-Party Technology . . . . .	2-22
2.3.1	Request for Proposal . . . . .	2-22
2.3.2	Evaluating Proposals . . . . .	2-26

CONTENT

- 2.3.3 Awarding a Bid . . . . . 2-27
- 2.3.4 Deliverables . . . . . 2-28
- 2.3.5 Embedded Third-Party Software . . . . . 2-29
- 2.3.6 Service-Level Agreements (SLAs) . . . . . 2-29
- 2.4 Technology Licensing Agreements . . . . . 2-31
  - 2.4.1 General . . . . . 2-31
  - 2.4.2 Scope of License/Ownership . . . . . 2-31
    - 2.4.2.1 Grant of Rights under License . . . . . 2-32
    - 2.4.2.2 Derivatives, Continuations, Divisions . . . . . 2-34
    - 2.4.2.3 Sublicensing and Third-Party Usage . . . . . 2-34
    - 2.4.2.4 Assignment . . . . . 2-35
    - 2.4.2.5 Restrictions . . . . . 2-35
  - 2.4.3 Warranty . . . . . 2-36
    - 2.4.3.1 Implied Warranties . . . . . 2-36
    - 2.4.3.2 Express Warranties . . . . . 2-36
    - 2.4.3.3 Disclaimer of Warranties . . . . . 2-37
  - 2.4.4 Miscellaneous Terms . . . . . 2-37
- 2.5 Forms . . . . . 2-39
  - Form 2-1 Business Needs Statement . . . . . 2-39
  - Form 2-2 Product Life-Cycle Policy . . . . . 2-43
  - Form 2-3 Cease-and-Desist Letter . . . . . 2-45
  - Form 2-4 Employee Confidentiality and Invention Agreement . . . . . 2-46
  - Form 2-5 Patent Assignment . . . . . 2-52
  - Form 2-6 Security Schedule . . . . . 2-56
  - Form 2-7 Sample Request for Proposal . . . . . 2-62
  - Form 2-8 Training Schedule . . . . . 2-78
  - Form 2-9 Insurance Schedule . . . . . 2-80
  - Form 2-10 Sample Patent-Technology License . . . . . 2-83
  - Form 2-11 Sample Clauses—Representations and Warranties  
for Software License . . . . . 2-88
  - Form 2-12 Sample Clauses—Miscellaneous Clauses for  
License Agreements . . . . . 2-91

**CHAPTER THREE COMPUTER HARDWARE AND PERSONAL  
PROPERTY ISSUES . . . . . 3-1**

- 3.1 Hardware-Only Purchases . . . . . 3-1
  - 3.1.1 Definitional Issues with Computer Hardware Transactions . . . . . 3-1
    - 3.1.1.1 Personal Computers . . . . . 3-2
      - 3.1.1.1.1 Configurations . . . . . 3-3
      - 3.1.1.1.2 Source of Supply/Channels of  
Distribution . . . . . 3-4
    - 3.1.1.2 Servers and Server Equipment . . . . . 3-5
    - 3.1.1.3 Testing and Acceptance . . . . . 3-6
  - 3.1.2 Pricing . . . . . 3-8
    - 3.1.2.1 Purchase Price . . . . . 3-8

3.1.2.2	Discounts . . . . .	3-9
3.1.2.3	Hold-Backs . . . . .	3-9
3.1.3	Payment . . . . .	3-9
3.1.3.1	Deposits . . . . .	3-10
3.1.3.2	Method of Payment . . . . .	3-10
3.1.3.3	Payment Disputes . . . . .	3-11
3.1.3.4	Taxes . . . . .	3-13
3.1.4	Title . . . . .	3-13
3.1.5	Documentation . . . . .	3-14
3.1.6	Training . . . . .	3-16
3.1.7	Maintenance . . . . .	3-16
3.2	Turnkey Systems and Equipment Resellers . . . . .	3-17
3.3	Forms . . . . .	3-20
3.3.1	Hardware Purchase Forms . . . . .	3-20
Form 3-1	Web-Based Terms of Sale . . . . .	3-20
Form 3-2	Simple Hardware Purchase Agreement . . . . .	3-26
Form 3-3	Simple Terms and Conditions for Hardware Sales . . . . .	3-32
Form 3-4	Personal Computer Specifications . . . . .	3-36
Form 3-5	Server Specifications . . . . .	3-41
Form 3-6	Purchase Money Security Agreement . . . . .	3-42
Form 3-7	Maintenance Services for Hardware . . . . .	3-55
3.3.2	Turnkey Systems and Reseller Forms . . . . .	3-71
Form 3-8	Simple Turnkey Hardware and Software Agreement . . . . .	3-71
Form 3-9	Master Turnkey Hardware and Software Agreement . . . . .	3-80
Form 3-10	Original Equipment Manufacturer (OEM) Agreement . . . . .	3-100

**CHAPTER FOUR    COMPUTER SOFTWARE AND INTELLECTUAL PROPERTY ISSUES . . . .    4-1**

4.1	Types of Computer Software . . . . .	4-2
4.1.1	Operating Systems . . . . .	4-2
4.1.2	Development Systems . . . . .	4-3
4.1.3	Application Systems . . . . .	4-4
4.1.4	Digital Databases . . . . .	4-6
4.1.4.1	Executables . . . . .	4-6
4.1.4.2	Digital Data . . . . .	4-7
4.1.4.3	Digital Compilations . . . . .	4-7
4.1.4.4	Digital Content . . . . .	4-8
4.2	Definition of Deliverable . . . . .	4-9
4.2.1	Description of the Product . . . . .	4-10
4.2.2	Documentation . . . . .	4-11
4.2.3	Maintenance and Upgrades/Updates . . . . .	4-13

CONTENT

- 4.2.4 Installation and Training . . . . . 4-15
- 4.3 Grant of License . . . . . 4-15
  - 4.3.1 Exclusive vs. Non-exclusive . . . . . 4-16
  - 4.3.2 Perpetual/Irrevocable vs. Limited Term/Revocable . . . . . 4-16
  - 4.3.3 Transferable vs. Nontransferable. . . . . 4-17
  - 4.3.4 Worldwide vs. Geographically Restricted. . . . . 4-17
  - 4.3.5 Royalty vs. Royalty-Free. . . . . 4-18
  - 4.3.6 Unrestricted vs. Field of Use. . . . . 4-18
  - 4.3.7 Licensed Rights . . . . . 4-19
    - 4.3.7.1 Use . . . . . 4-19
    - 4.3.7.2 Reproduction . . . . . 4-20
    - 4.3.7.3 Modification/Derivative Works . . . . . 4-21
    - 4.3.7.4 Public Performance and Display Rights. . . . . 4-21
- 4.4 Definition of User. . . . . 4-21
  - 4.4.1 Definition of Licensee. . . . . 4-21
  - 4.4.2 Limitations on Definition of User. . . . . 4-22
- 4.5 Pricing and Payment . . . . . 4-23
- 4.6 Delivery and Installation. . . . . 4-24
  - 4.6.1 Format/Media/Mode of Delivery . . . . . 4-24
  - 4.6.2 Associated Deliverables . . . . . 4-25
- 4.7 Testing and Acceptance . . . . . 4-25
- 4.8 Training. . . . . 4-26
- 4.9 Maintenance . . . . . 4-26
- 4.10 Representations and Warranties . . . . . 4-28
- 4.11 Indemnification. . . . . 4-29
- 4.12 Limitations of Liability. . . . . 4-29
- 4.13 Remedies. . . . . 4-31
- 4.14 Forms . . . . . 4-32
  - Form 4-1 EU Database Directive . . . . . 4-32
  - Form 4-2 Software Evaluation License . . . . . 4-49
  - Form 4-3 Software License Agreement (Purchase-Side). . . . . 4-52
  - Form 4-4 Downloadable Software License Agreement. . . . . 4-90
  - Form 4-5 Sample Purchase Order . . . . . 4-93
  - Form 4-6 Technical Support Services . . . . . 4-94
  - Form 4-7 Technical Support and Maintenance Schedule. . . . . 4-98
  - Form 4-8 Software Escrow Agreement . . . . . 4-102

**CHAPTER FIVE TECHNOLOGY SERVICES/  
CONSULTING . . . . . 5-1**

- 5.1 Consulting Agreements . . . . . 5-1
  - 5.1.1 Definition of Services . . . . . 5-2
  - 5.1.2 Staffing by Consultant. . . . . 5-3
  - 5.1.3 Change Orders. . . . . 5-4
  - 5.1.4 Performance Obligations of Consultant . . . . . 5-5
    - 5.1.4.1 Location of Performance . . . . . 5-5

5.1.4.2	Use of Subcontractors . . . . .	5-6
5.1.4.3	Standard of Performance . . . . .	5-6
5.1.4.4	Knowledge Transfer . . . . .	5-7
5.1.4.5	Employer Obligations . . . . .	5-7
5.1.4.6	Periodic Reporting . . . . .	5-8
5.1.5	Payment Obligations . . . . .	5-8
5.1.6	Intellectual Property . . . . .	5-9
5.1.7	Movement of Employees between Vendor and Purchaser . . . . .	5-12
5.1.8	Confidentiality and Privacy Provisions . . . . .	5-12
5.1.9	Dispute Escalation/Resolution . . . . .	5-14
5.1.10	Transition Assistance . . . . .	5-15
5.2	Staff Augmentation versus Business Process Outsourcing . . . . .	5-16
5.2.1	International Considerations . . . . .	5-18
5.2.2	Staff Transitions . . . . .	5-18
5.2.3	Organizational Issues . . . . .	5-20
5.2.4	Documentation . . . . .	5-20
5.2.5	Service Levels . . . . .	5-21
5.2.6	Monitoring Compliance . . . . .	5-22
5.2.7	Services Performed at the Vendor Location . . . . .	5-22
5.2.8	Purchase of Vendor Equipment upon Termination . . . . .	5-23
5.2.9	Disaster Recovery . . . . .	5-23
5.2.10	Insurance . . . . .	5-26
5.3	Forms . . . . .	5-28
5.3.1	Consulting Forms . . . . .	5-28
	Form 5-1 Simple Consulting Agreement . . . . .	5-28
	Form 5-2 Master Consulting Agreement . . . . .	5-35
	Form 5-3 Subcontractor Agreement . . . . .	5-44
	Form 5-4 Assignment of IP Rights in Work Product . . . . .	5-50
	Form 5-5 Corporate Code of Conduct . . . . .	5-52
	Form 5-6 Insurance Requirements Schedule . . . . .	5-58
	Form 5-7 Change Order . . . . .	5-60
5.3.2	Staff Augmentation/Outsourcing Forms . . . . .	5-61
	Form 5-8 Master Outsourcing Agreement . . . . .	5-61
	Form 5-9 Data Management Outsourcing Agreement . . . . .	5-85
	Form 5-10 Document Retention Guide . . . . .	5-132
	Form 5-11 Emergency Management Guide for Business and Industry . . . . .	5-135
	Form 5-12 Checklist of Outsourcing Agreements . . . . .	5-202
<b>CHAPTER SIX INTERNET-BASED TRANSACTIONS . . . . .</b>		<b>6-1</b>
6.1	Web Development and Web Hosting . . . . .	6-1
6.1.1	Development of Web Content . . . . .	6-1
6.1.1.1	Purchaser Content . . . . .	6-2
6.1.1.2	Vendor and Third Party Content . . . . .	6-3
6.1.1.3	Vendor Tools . . . . .	6-3

CONTENT

- 6.1.1.4 Logistics of Web Development . . . . . 6-4
- 6.1.2 Infrastructure Obligations . . . . . 6-5
- 6.1.3 Operational Issues . . . . . 6-6
- 6.2 Application Service Providers (ASPs) and Software as a Service (SaaS) Offerings . . . . . 6-9
  - 6.2.1 Service Description . . . . . 6-9
    - 6.2.1.1 Managed Applications . . . . . 6-9
      - 6.2.1.1.1 Vendor/Third-Party Applications Hosting . . . . . 6-9
      - 6.2.1.1.2 User/Third-Party Applications . . . . . 6-11
      - 6.2.1.1.3 Database Management . . . . . 6-11
    - 6.2.1.2 Managed Hosting . . . . . 6-12
    - 6.2.1.3 Managed Equipment/Infrastructure . . . . . 6-13
  - 6.2.2 Implementation Services and Schedule . . . . . 6-14
  - 6.2.3 Operational Issues . . . . . 6-15
  - 6.2.4 Training Schedule . . . . . 6-15
  - 6.2.5 Confidentiality . . . . . 6-16
  - 6.2.6 Transition Services . . . . . 6-17
- 6.3 Internet Considerations . . . . . 6-18
  - 6.3.1 Web Site Usage . . . . . 6-19
    - 6.3.1.1 End-User Considerations . . . . . 6-19
    - 6.3.1.2 Chatrooms/Message Boards . . . . . 6-21
    - 6.3.1.3 Meta-Tags and Trademark Issues . . . . . 6-21
  - 6.3.2 Corporate Internet Usage Issues . . . . . 6-22
    - 6.3.2.1 Internet Usage Policies . . . . . 6-22
    - 6.3.2.2 Privacy Issues . . . . . 6-23
    - 6.3.2.3 Digital Discovery Issues . . . . . 6-24
  - 6.3.3 Web-Based Contracting . . . . . 6-24
    - 6.3.3.1 E-Sign . . . . . 6-25
    - 6.3.3.2 Uniform Electronic Transactions Act . . . . . 6-25
    - 6.3.3.3 General E-Commerce Issues . . . . . 6-26
      - 6.3.3.3.1 Magnuson-Moss Warranty Act . . . . . 6-26
      - 6.3.3.3.2 FTC Mail or Telephone Order Merchandise Trade Regulation Rule . . . . . 6-26
  - 6.3.4 Cooperative E-Commerce . . . . . 6-27
    - 6.3.4.1 Linking and Framing . . . . . 6-27
    - 6.3.4.2 Co-marketing . . . . . 6-28
  - 6.3.5 Fiduciary/Fidelity Issues . . . . . 6-28
    - 6.3.5.1 BBBOnline® . . . . . 6-29
    - 6.3.5.2 TRUSTe® . . . . . 6-29
    - 6.3.5.3 VeriSign® . . . . . 6-29
    - 6.3.5.4 PayPal® . . . . . 6-30
    - 6.3.5.5 buySafe® . . . . . 6-30
- 6.4 Forms . . . . . 6-31
  - 6.4.1 Web Development Forms . . . . . 6-31



	Form 6-1	Web Development and Hosting Agreement . . . . .	6-31
	Form 6-2	Assignment Agreement . . . . .	6-53
	Form 6-3	Change Order . . . . .	6-58
	Form 6-4	Domain Name Provision for Contract . . . . .	6-60
	Form 6-5	Privacy Policy . . . . .	6-61
6.4.2		Web Hosting and ASP Forms . . . . .	6-65
	Form 6-6	Hosting Services Agreement—Vendor- Oriented—Click-Through . . . . .	6-65
	Form 6-7	Hosting Services Schedule (SLA) Addendum . . . . .	6-76
	Form 6-8	Equipment Schedule . . . . .	6-79
	Form 6-9	Acceptable Use Policy . . . . .	6-80
	Form 6-10	Web Hosting Agreement— Purchaser-Oriented . . . . .	6-82
	Form 6-11	Software Escrow Schedule . . . . .	6-102
	Form 6-12	Insurance Schedule . . . . .	6-113
6.4.3		Web Site Usage Forms . . . . .	6-115
	Form 6-13	Assignment of Copyright . . . . .	6-115
	Form 6-14	Trademark License . . . . .	6-118
	Form 6-15	Web Advertising Agreement . . . . .	6-127
	Form 6-16	Framing/Linking Agreement . . . . .	6-138
	Form 6-17	Internet Usage Policy . . . . .	6-141
	Form 6-18	Terms of Sale (Goods) . . . . .	6-144
	Form 6-19	Terms of Sale (Services) . . . . .	6-152
	Form 6-20	Downloadable Software License . . . . .	6-164

**INDICES**

Subject Index . . . . .	Index-1
Forms Index . . . . .	Index-7
Internet References Index . . . . .	Index-10