

특허실시, 기술이전, 라이선스 영문계약서에서 진술보증, 면책조항 관련 실무적 포인트

몇 가지 + 면책조항 INDEMNIFICATION, INSURANCE, LIMITATION OF LIABILITY 계약

조항 샘플



실무적 포인트

- **진술 및 보증 조항 Rep. & Warranty**
 - 소유권/license 허여권 보증 (○)
 - 계약대상 IP 의 권리 유효성 보증 (적법 등록유지 ○, 절대적 유효성 ×)
 - 제 3 자의 지재권 비침해 보증 (고의침해 ○, 기타 △)
- **면책 Indemnification**
 - 지재권 침해 claim 시 면책규정은 license, 공동연구발 계약협상에서 쟁점이 많은 규정
 - 특허를 제외한 copyright 등 기타 권리에 대해서는 indemnification 을 대부분 수용하는 편이나, 특허에 대해서는 면책보장의 수용이 어려운 경우가 많음.

- 전세계 특허의 사전조사는 현실적으로 불가능하고, 고의적으로 copy 한 경우가 아니더라도 유사성이 존재하는 한 침해를 구성
- 반면, 저작권 등의 경우는 제 3 자의 저작물을 copy 한 경우가 아니라면, 독자개발에 의해 발명/발견된 경우는 유사성이 존재하더라도 침해를 구성치 않음.
- 고의침해 경우(punitive damage 대상이 됨) - 무제한 배상 보장 가능
- 기타 지재권 침해 claim 경우 - 지불금액 총액 한도내에서 합의가 합리적
- 제외: - 허여 용도 외 사용, 제공기술/제품의 임의 수정, 제공 외 기술/제품과 결합, 합성 등으로 인해 침해가 발생한 경우

계약조항 영문 샘플

23. INDEMNIFICATION; INSURANCE; LIMITATION OF LIABILITY.

23.1 **General Indemnification** by Licensor. Licensor CyDex shall defend, indemnify and hold Licensee Hospira and its Affiliates and Sublicensees, and each of their respective directors, officers, agents and employees, harmless from and against any and all losses, judgments, damages, liabilities, settlements, penalties, fines, costs and expenses (including the reasonable costs and expenses of attorneys and other professionals) (collectively "Losses") incurred as a result of any claim, demand, action or other proceeding (each, a "Claim") by a Third Party, to the extent such Losses arise out of: (a) the manufacture, use, handling, promotion, marketing, distribution, importation, sale or offering for sale of

Captisol by CyDex, its Affiliates or any of their agents, or (b) CyDex's breach of this Agreement, including without limitation any of its representations and warranties set forth in Section 8, or (c) any negligent or willful misconduct by CyDex or its Affiliates or any of their respective distributors, officers, directors employees or agents, in each case to the extent that such Losses are not due to Hospira's or any of its Affiliates' or Sublicensees', or any of their respective directors', officers', agents' or employees' breach of this Agreement or negligence or willful misconduct.

23.2 **General Indemnification** by Licensee. Licensee Hospira shall defend, indemnify and hold Licensor CyDex and its Affiliates, and each of their respective directors, officers, agents and employees, harmless from and against any and all Losses incurred as a result of any Claim by a Third Party, to the extent such Losses arise out of: (a) the manufacture, use, handling, promotion, marketing, distribution, importation, sale or offering for sale of the Finished Product by Hospira, its Affiliates and Sublicensees, or (b) Hospira's breach of this Agreement, including without limitation any of its representations and warranties set forth in Section 8, or (c) any negligent or willful misconduct by Hospira or its Affiliates or any of their respective distributors, officers, directors employees or agents, in each case to the extent that such Losses are not due to CyDex's or any of its Affiliates' or any of their

respective directors', officers', agents' or employees' breach of this Agreement or negligence or willful misconduct.

23.4 **Procedure.**

(a) The person intending to claim indemnification under Section 9 (an "Indemnified Party") shall promptly notify the other party (the "Indemnifying Party") of any Claim in respect of which the Indemnified Party intends to claim such indemnification, and a reasonable explanation of the basis for the Claim and the amount of alleged Losses to the extent of the facts then known by the Indemnified Party. (Notwithstanding the foregoing, no delay or deficiency on the part of the Indemnified Party in so notifying the Indemnifying Party will relieve the Indemnifying Party of any liability or obligation under this Agreement except to the extent the Indemnifying Party has suffered actual prejudice directly caused by the delay or other deficiency.) The Indemnifying Party shall assume the defense thereof; provided, however, that if the Indemnifying Party assumes the defense, the Indemnified Party shall have the right to employ counsel separate from counsel employed by the Indemnifying Party in any such action and to participate in the defense thereof, but the

fees and expenses of such counsel employed by the Indemnified Party shall be at the sole cost and expense of the Indemnified Party unless the Indemnifying Party consents to the retention of such counsel or unless the named parties to any action or proceeding include both the Indemnifying Party and the Indemnified Party and a representation of both the Indemnifying Party and the Indemnified Party by the same counsel would be inappropriate due to the actual or potential differing interests between them. And provided further that, if the Indemnifying Party shall fail to assume the defense of and reasonably defend such Claim, the Indemnified Party shall have the right to retain or assume control of such defense and the Indemnifying Party shall pay (as incurred and on demand) the fees and expenses of counsel retained by the Indemnified Party.

(b) The Indemnifying Party shall not be liable for the indemnification of any Claim settled (or resolved by consent to the entry of judgment) without the written consent of the Indemnifying Party (which shall not be unreasonably withheld or delayed). Also, if the Indemnifying Party shall control the defense of any such Claim, the Indemnifying Party shall have the right to settle such Claim; provided, that the Indemnifying Party shall obtain the prior written consent (which shall not be unreasonably withheld or delayed) of the Indemnified Party before entering into any settlement of (or resolving by consent to the

entry of judgment upon) such Claim unless (A) there is no finding or admission of any violation of law or any violation of the rights of any Third Party by an Indemnified Party, no requirement that the Indemnified Party admit fault or culpability, and no adverse effect on any other claims that may be made by or against the Indemnified Party and (B) the sole relief provided is monetary damages that are paid in full by the Indemnifying Party and such settlement does not require the Indemnified Party to take (or refrain from taking) any action.

(c) Regardless of who controls the defense, the other party hereto shall reasonably cooperate in the defense as may be requested. Without limitation, the Indemnified Party, and its directors, officers, advisers, agents and employees, shall reasonably cooperate with the Indemnifying Party and its legal representatives in the investigations of any Claim.

23.5 **Insurance**. CyDex will procure and maintain, at its own expense, for the duration of the Agreement, and for [*] thereafter if written on a claims made or occurrence reported form, the types of insurance specified below with carriers rated [*]. Best or like rating agencies:

a. Workers' Compensation accordance with applicable statutory requirements and shall provide a waiver of subrogation in favor of Hospira;

b. Employer's Liability with a limit of liability in an amount of not less than \$[***];

c. Commercial General Liability including premises operations, products & completed operations, blanket contractual liability, personal injury including fire legal liability for bodily injury and property damage in an amount not less than \$[***];

d. Commercial Automobile Liability for owned, hired and non-owned motor vehicles with a combined single limit in an amount not less than \$[*];

e. Excess Liability including product liability with a combined single limit in an amount of not less than \$[*];

f. Commercial Crime or Fidelity Bond in an amount of not less than \$[*] including an endorsement for Third Party liability without the requirement of a conviction.

g. Cargo Legal Liability insurance covering all risks of physical loss or damage to cargo handled by CyDex. The limit of liability shall not be less than \$[*].

23.6 **Limitation of Liability.** EXCEPT FOR (1) PERSONAL INJURY, INCLUDING DEATH, (2)

TANGIBLE PROPERTY DAMAGE, (3) EACH PARTY'S INDEMNIFICATION OBLIGATIONS, (4) DAMAGES ARISING OUT OF AN INTENTIONAL BREACH OF THE CONFIDENTIALITY OBLIGATIONS HEREIN, (5) DAMAGES ARISING OUT OF CYDEX'S BREACH OF SECTION 2.4, AND (6) DAMAGES FOR WHICH CYDEX IS RESPONSIBLE PURSUANT SECTION 3.6, 3.7 OR 6.4.

국제계약, 영문계약, 계약분쟁, 손해배상, Claim, License, R&D 제휴계약

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