

국제계약, 영문계약 실무 - 기술이전, 특허실시, 신제품 개발판매 계약서에서

상표라이선스 관련 계약 조항 샘플



0. TRADEMARKS.

10.1 Licensed Product Marks.

(a) LICENSEE and LICENSOR agree that (i) LICENSEE shall be responsible for the selection, registration and maintenance of all Trademarks which it employs in connection with the Commercialization of any Licensed Product in the Territory under this Agreement and (ii) LICENSOR shall be responsible for the selection, registration and maintenance of all Trademarks which it employs in connection with the Commercialization of any Licensed Product outside of the Territory under this Agreement;

provided that each Party shall use Commercially Reasonable Efforts to differentiate Licensed Products from products marketed as of the Closing by, for example, not utilizing any Trademark in connection with the Commercialization of any Licensed Product that would be confusingly similar to any Trademark utilized in connection with the Commercialization of products marketed as of the Effective Date but, provided further that, neither Party shall be obligated to utilize, or not to utilize, any Trademark if, in such Party's sole opinion, such utilization would (i) have a material adverse impact on Commercialization of such Licensed Product or (ii) result in material delay in achieving Regulatory Approval for Commercialization of such Licensed Product.

(b) Subject to Section 10.1(a), LICENSEE shall own and control all Trademarks which it employs in connection with the Commercialization of any Licensed Product in the Territory under this Agreement ("LICENSEE Licensed Product Marks") and shall pay all costs relating thereto.

LICENSEE shall have the right to brand the Licensed Products in the Territory using LICENSEE Licensed Product Marks it determines appropriate for the Licensed Products,

which may vary by country or within a country, and shall have the right, but no obligation, to use the LICENSOR Trademarks, subject to the license granted by LICENSOR to LICENSEE with respect to the LICENSOR TRADEMARKS pursuant to Section 10.1(c), on the labeling and packaging for Licensed Products in the Territory, and on all marketing, advertising and promotional materials associated with such Licensed Products (collectively the "LICENSEE Licensed Product Materials");

provided that LICENSEE shall not, and shall ensure that its Affiliates and Sublicensees will not, make any use of (i) the Trademarks or house marks of LICENSOR (including LICENSOR's corporate name) other than the LICENSOR Trademarks or (ii) any trademark confusingly similar to the Trademarks or house marks of LICENSOR (including LICENSOR's corporate name), in the case of both (i) and (ii), on any LICENSEE Licensed Product Materials. Subject to the license granted by LICENSOR to LICENSEE with respect to the LICENSOR TRADEMARKS pursuant to Section 10.1(c), LICENSEE shall own all rights in the LICENSEE Licensed Product Materials.

(c) Subject to the terms and conditions of this Agreement, during the Term of this

Agreement, LICENSOR hereby grants to LICENSEE a non-exclusive, royalty-free, sublicenseable license (i) to use LICENSOR Trademarks on all LICENSEE Licensed Product Materials in the Territory and (ii) to reproduce, prepare derivative works, distribute copies, perform, display and otherwise use LICENSOR Copyrights in connection with the exercise of the rights granted by LICENSOR to LICENSEE under the terms of this Agreement. All representations of the LICENSOR Trademarks that LICENSEE intends to use shall first be submitted to LICENSOR for approval (which shall not be unreasonably withheld or delayed) of design, color, and other details or shall be exact copies of those used by LICENSOR. All representations of the LICENSOR Trademarks that are used by LICENSEE shall comply with the reasonable usage guidelines provided by LICENSOR.

(d) During the Term, LICENSOR may make a written request to LICENSEE for permission to use the LICENSEE Licensed Product Marks in relation to Licensed Products in Korea. If LICENSEE consents to such use (such consent not to be unreasonably withheld), the Parties shall discuss in good faith the terms and conditions applicable to such use of the LICENSEE Licensed Product Marks, including any reasonable consideration payable with respect to such use. In the event that LICENSEE provides its consent and the Parties agree upon terms and conditions applicable to such use, all representations of the LICENSEE Licensed

Product Marks that LICENSOR intends to use shall first be submitted to LICENSEE for approval (which shall not be unreasonably withheld or delayed) of design, color, and other details or shall be exact copies of those used by LICENSEE, and all representations of the LICENSEE Licensed Product Marks that are used by LICENSOR shall comply with the usage guidelines provided by LICENSEE.

(e) Subject to Section 10.1(a), LICENSOR shall own and control all Trademarks which it employs in connection with the Commercialization of any Licensed Product outside the Territory and in Japan under this Agreement ("LICENSOR Licensed Product Marks") and shall pay all costs relating thereto.

LICENSOR shall have the right to brand the Licensed Products outside the Territory and in Japan using LICENSOR Licensed Product Marks it determines appropriate for the Licensed Products, which may vary by country or within a country, and on the labeling and packaging for Licensed Products outside the Territory and in Japan, and on all marketing, advertising and promotional materials associated with such Licensed Products (collectively the "LICENSOR Licensed Product Materials");

provided that LICENSOR shall not, and shall ensure that its Affiliates and sublicensees will not, make any use of (i) the Trademarks or house marks of LICENSEE (including LICENSEE's corporate name) or (ii) any trademark confusingly similar to the Trademarks or house marks of LICENSEE (including LICENSEE's corporate name), in the case of both (i) and (ii), on any LICENSOR Licensed Product Materials. LICENSOR shall own all rights in the LICENSOR Licensed Product Materials.

10.2 **No Challenge.**

(a) LICENSOR recognizes the exclusive ownership by LICENSEE of all LICENSEE Licensed Product Marks. LICENSOR shall not, either while this Agreement is in effect, or at any time thereafter, register, use or challenge or assist others to challenge the LICENSEE Licensed Product Marks. LICENSOR shall not attempt to obtain any right in or to any name, logotype, trademark or trade dress confusingly similar for the marketing, sale or distribution of any goods or products, notwithstanding whether such goods or products have a different use or are dissimilar to the Licensed Products.

(b) LICENSEE recognizes the exclusive ownership by LICENSOR of all LICENSOR Licensed Product Marks. LICENSEE shall not, either while this Agreement is in effect, or at any time thereafter, register, use or challenge or assist others to challenge the LICENSOR Licensed Product Marks. LICENSEE shall not attempt to obtain any right in or to any name, logotype, trademark or trade dress confusingly similar for the marketing, sale or distribution of any goods or products, notwithstanding whether such goods or products have a different use or are dissimilar to the Licensed Products.

10.3 **Proceedings.**

(a) Only LICENSEE will be authorized to initiate at its own discretion legal proceedings against any infringement or threatened infringement of any LICENSEE Licensed Product Marks.

(b) Only LICENSOR will be authorized to initiate at its own discretion legal proceedings against any infringement or threatened infringement of any LICENSOR Licensed Product Marks.

10.4 Domain Names.

(a) LICENSEE shall be responsible for the registration, hosting, maintenance and defense of any domain name based on the LICENSEE Licensed Product Marks. LICENSEE may at its sole and absolute discretion register in its own name or in name of others, host on its own servers or on Third Party servers, maintain and defend such domain names and use them for websites.

(b) LICENSOR shall be responsible for the registration, hosting, maintenance and defense of any domain name based on the LICENSOR Licensed Product Marks. LICENSOR may at its sole and absolute discretion register in its own name or in name of others, host on its own servers or on Third Party servers, maintain and defend such domain names and use them for websites.

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