

영문 계약서: 자신있게 분석하기!

May 22, 2007

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Background



영문 계약서의 검토전

- 십계명
- FTA 협상 (미국, EU)
- 영어 독해 실력 (미국 변호사)

영문 계약서가 어렵게 느껴지는 이유?



- 기본적인 영어 독해 실력이 부족한 경우
- 알고 보면 쉬운 뜻인데 어려운 단어로 작성된 경우
- 일반적인 뜻과 약간 다르거나, 계약서에만 주로 사용되는 단어 사용하는 경우
- 단어 뜻에 더하여, 법적인 지식이 약간 필요한 경우

알고 보면 쉬운 뜻인데, 어려운 단어로 작성된 경우



Legalism

pursuant to

subsequent to

under the provision of

in the event that

- Material misstatement of fact ?

→ **Try Plain English**

Cf) **비슷한 뜻 중복 기재** : covenant and agree

Ordinary Alternatives

under, in accordance with

after

under

if

일반적인 뜻과 약간 다르거나, 계약서에만 주로 사용되는 단어 사용



- In consideration to
- Provided that / Subject to
- Shall / Will / May
- WITNESSETH /hereafter/therein
- Latin : pro rata, in lieu of ...
- Force majeure

단어 뜻에 더하여, 법적인 지식이 약간 필요한 경우



Indemnify

- I shall indemnify you.
- I shall indemnify, and hold you harmless.
- I shall defend, indemnify, and hold you harmless.

Governing Law

- This agreement shall be applied to in accordance with the laws of the State of New York.
- This agreement shall be construed, interpreted, and enforced in accordance with the laws of the State of New York.

계약서 검토전 실무 TIP



- 계약 상대방에 대한 정보를 최대한 입수할 것
 - 기업 / 대학 / 연구소
 - 지역적 특성 (미국, 일본, 유럽)
 - 산업 특성 (전자, 바이오, 화학)
- 계약문구검토보다 계약에서 얻고자 하는 것을 검토
 - 기술 이전
 - 신기술 개발
 - 특허권 확보
 - 제품 생산

영문 계약서의 기본 형식 (1/2)



- Fortune 500 IT Company - Sample NDA
- Form of Battle

- Case by case
- NDA (Non Disclosure Agreement)
CDA (Confidential Disclosure Agreement)
- JDA (Joint Development Agreement)
TEA (Technology Evaluation Agreement)
JEA (Joint Evaluation Agreement)
PDA (Product Development Agreement)
- LOI , MOU, Term sheet

영문 계약서의 기본 형식(2/2)



- Commencement (Contract Parties, Effective Date)
- Whereas Clause
- Consideration Clause
- Definition
- Confidentiality
- What to seek (License, Sale..)
- Termination
- Indemnity
- Governing law / Dispute Resolution

영문 계약서 주요 조항 검토 (NDA)



NDA

- 양사간의 신뢰를 기반
- 정보제공자가 일방인 경우 (One-way, Fixed)
 - Ambiguity : Resolve against Drafter
- 정보제공자가 양당사자인 경우 (Two-way, negotiable)

NDA 주요 조항 검토



- 계약 Effective Date (기재일(소급), 서명일)
- 당사자명 포함 범위 (정보 흐름 현황 파악)
대기업 ; 그룹 관계사(자회사), 공동개발자, 대리인
- 주고 받을 비밀 정보명 또는 프로젝트 (넓게, 좁게)
- 비밀정보 정의 방식 (모두, 표시 또는 주장한 것만)
- 정보 공개 범위 : Need to basis

NDA 주요 조항 검토

■ NDA 전문부 (1사 ; 일반적인 형식)



Non-Disclosure Agreement

This Agreement made and entered into this 10th day of December, 2005 by and between Idemitsu Kosan Co., Ltd., a company incorporated under the laws of Japan, having its principal place of business at 1-1, Marunouchi 3-Chome, Chiyoda-Ku, Tokyo, Japan (hereinafter referred to as "Idemitsu"), and SAMSUNG ELECTRONICS CO., LTD., a company incorporated under the laws of Korea, having its principal place of business at San #24 Nongseo-Dong, Kihung-Gu, Yongin-City, Gyeonggi-Do, KOREA, (hereinafter referred to as "SAMSUNG").

WITNESSETH:

WHEREAS, Idemitsu has the right with respect to organic electro-luminescence material and transparent electrode material (hereinafter referred to collectively as the "Material"), and SAMSUNG is desirous of evaluating the Material used for organic electro-luminescence display device (hereinafter referred to as the "Evaluation"), and

WHEREAS, in consideration of the interest of SAMSUNG in evaluating the Material, Idemitsu is willing to supply the Material to SAMSUNG for the Evaluation, and to provide the information as deemed necessary for the Evaluation.

NOW, THEREFORE, the parties hereto agree and accept the following terms and conditions:

1. "Confidential Information" means:

NDA 주요 조항 검토

■ NDA 전문부 (S사, 약식)



NON-DISCLOSURE AGREEMENT ↵

↵

↵

This NON-DISCLOSURE AGREEMENT ("Agreement") is made and entered into September 1, 2006, by and between Samsung Electronics Co., Ltd, having a place of business at San #24, Nongseo-Dong, Giheung-Gu, Yongin-City, Gyeonggi-Do, Republic of Korea ("Samsung"), and Unidym, having a place of business at . ("Unidym")↵

↵

Both parties hereto agree as follows:↵

↵

1. Purpose of Agreement↵

↵

Both parties will exchange certain information and/or materials relating to the evaluation of the Unidym's CNT (Carbon Nano Tube) transparent conductor on the Samsung's display backplane. ("Purpose") This Agreement is intended to define the rights and duties of both parties with respect to such information as may be so exchanged. For the purpose of this Agreement, any party who receives any information shall be the "Recipient" with respect to that information and any party who discloses any information shall be the "Discloser" with respect to such information.↵

↵

2. Confidential Information↵

NDA 주요 조항 검토



- 비밀 보호 대상에서 제외 되는 것 (D사)

12. The obligation of nondisclosure and non-use shall not apply to any items which:

- a. are available to the public or become available to the public through no fault, unauthorized act or omission by the Recipient;
- b. are known by the Recipient at the time of disclosure, as shown by prior written records;
- c. are rightfully received by the Recipient from a third party without a duty of confidentiality; or
- d. are developed by or for the Recipient independent of the disclosure hereunder.

NDA 조항 검토 - 실무 TIP



- 비밀 유지 기간 : 1,3,5,10년
 - 기술 정보 수명 고려 : 특히 출원으로 공개되는지Cf. 비밀 정보를 주고 받는 기간
- 비밀 정보를 이용한 특히 출원 금지
예외적으로 출원 허용시는 IP 소유권 문제 검토
- Reverse Engineering 금지
- 준거법 : 종립 지역
- 분쟁 해결 : 중재 , 피소지 주의

NDA 조항 검토 - 실무 TIP

- 준거법 : 중립 지역 (C사)

ARTICLE 14 – APPLICABLE LAW

This Agreement shall be governed by and construed and enforced in accordance with the laws of the State of New York, United States of America, without regard to conflict of laws principles. Any proceeding to enforce, or to resolve disputes relating to, this Agreement shall be brought before a court of competent jurisdiction in the State of New York.

The parties hereby expressly waive any right to a jury trial and agree that any action, proceeding or counterclaim arising out of or from this Agreement shall be tried by a judge without a jury.

NDA 조항 검토 - 실무 TIP



▪ 분쟁 해결 : 중재 (피소지 주의)

- (1) Any controversy, claim or dispute between the parties, directly or indirectly, concerning this Agreement, including this arbitration clause, shall be finally settled by arbitration in San Francisco, California, before a single arbitrator.
- (2) Such arbitrator shall be selected, and such arbitration proceedings shall be conducted, in accordance with the rules of the International Chamber of Commerce.
- (3) Any decision or award of the arbitrator shall be final and conclusive on the parties to this Agreement; judgment upon such decision or award may be entered in any court having jurisdiction over the parties or assets; and application may be made to such court for confirmation of such decision or award, or for an order of enforcement, and for any other legal remedies that may be necessary to effectuate such decision or award.

영문 계약서 주요 조항 검토 (JDA)



JDA

- 양사간의 공동 목적을 달성하고자
- NDA이후 단계로 진행
- 계약서 형태는 NDA보다 훨씬 다양하게 형성
- 계약 담당자는 기술에 대한 이해 필수

JDA 주요 조항 검토



- 정의 조항 : 기술 분야 및 IP 분야 정의 필수
- 양도 조항 : 상대가 작은 기업(Start-up)인 경우, M&A 가능성 고려 필수
- 보증 조항 (As-is)
 - 개발 결과가 성공하지 못한 경우, 책임여부
- 비용 지불시, 지불 방법 및 조건

JDA 주요 조항 검토



- 정의 조항 : 기술 분야 및 IP 분야 정의 필수 (N사)

1.12 “Fundamental Patent” means a patent that (a) claims use of material, other than crystalline-based material, as a transistor or electrical switching circuit element, and (b) is not a continuation, continuation-in-part, divisional or foreign counterpart of any Background IP.

1.19 “Nanostructure Technology” means Technology (as defined below) relating to semiconductors, metals, semimetals and insulators formed as shape or size controlled nanowires having at least one cross-sectional dimension of less than 500 nm; material interfaces that make direct or indirect contact to such nanowires (including, without limitation, surface chemistries, surfactant chemistries, electrical, optical and/or magnetic contacts and integration component methodologies); and any films, laminates, or composite matrix materials incorporating such nanowires.

JDA 주요 조항 검토

- 보증 조항 : 기술 / 특허 (제3자) / PL (N사)



10.1 By Nanos.

Nanos shall indemnify, defend and hold harmless Sharp, its officers, directors, affiliates, employees and agents (the "Sharp Indemnified Parties") against any claim of infringement of third party trade secrets, copyright or patents arising of (a) the use of the Nanos Collaboration IP and/or Nanos Background IP within the terms and conditions of this Agreement

JDA 주요 조항 검토

▪ 기타 표현

ANNEX 1

CDT proposes that the targets for the project, **on a best effort basis**, are as follows:

Material development targets

Cf. Milestone payment

8. JOINT DEVELOPMENT WORK PROTOCOLS

8.1 It is an overriding principle of this Agreement that **information shall be free-flowing as between the parties** hereto with respect to the Joint Development Work activities and the achievement of the Development Milestones and, for such purpose, all of the necessary engineers of both IG and SE shall be made available to the Joint Development Work.

Cf. need to know



JDA 조항 검토- 실무 TIP



- **공동 개발 과정에서 나온 소유권 분배**
 - 기술을 나누어서, 소유권을 나누고, 무상 라이선스
 - 전체 소유권을 공동 소유
 - 출원 절차 및 비용 분담 결정
- **SOW (Statement of Work) : 개발 일정**
Deliverable : 개발 결과물 (중간 결과물 포함)
→ 계약 범위에 중대한 영향을 끼침, 정량적 기재 필요
- **제품 개발의 경우, 공급 조건 (특히, 가격 제한)**
 - Price, Quality, Quantity
 - Right to first refusal
 - 독점 공급 기간

JDA 조항 검토- 실무 TIP



- **공동 개발 과정에서 나온 소유권 분배**
 - 기술을 나누어서, 소유권을 나누고, 무상 라이선스
 - 전체 소유권을 공동 소유
 - 출원 절차 및 비용 부담 결정

If K obtains any patent or any other intellectual property right (collectively "Patents") on such invention, K shall grant Idemitsu a non-exclusive, worldwide, royalty-free license under the Patents for the life of the Patents.

K shall grant a third party which Idemitsu designates a license under the Patents for the life of the Patents, terms and conditions of the granting license shall be negotiated with Idemitsu, K, and the third party.

JDA 조항 검토 - 실무 TIP



▪ IP 분배 - Claim (M사)

Independent of the fact of which employees of which party (i.e., Merck and/or XYZ) made a Project Invention, title in and to any Project Invention in the field of Materials shall be solely owned by Merck. Merck shall be entitled to apply for Project IPR under those Project Inventions at its sole discretion.

If Project IPR in the field of Materials solely owned by Merck contains patent claims directed to Devices comprising Materials, Merck hereby grants to XYZ a non-exclusive, worldwide, cost-free license with the right to grant sublicenses for such Devices.

For the sake of clarity, this license does not include the right to make or have made Materials.

JDA 조항 검토- 실무 TIP



- 제품 개발의 경우, 공급 조건 (특히, 가격 제한)
 - Price, Quality, Quantity
 - Right to first refusal
 - 독점 공급 기간

JDA 조항 검토- 실무 TIP



▪ 공급 조건 관련 (S사)

3.1 H shall purchase the first System, subject to E's meeting requirements agreed among the parties prior to delivery, such requirements at least include the conditions of price, quality, specification and timeline.

3.2 In return for H contribution in the development of the System, E agree not to sell the System to any other companies before the end of March 2007 or six (6) months after acceptance of the system by H, whichever is the earlier.

3.3 E shall give H a right of first refusal to purchase the System from April 1, 2007.

영문 계약서의 일반 조항

- Termination (C사)
 - 일방 또는 양방, 치유기간 등
 - 계약 목적 달성 불가시 일방 해제권

This Agreement shall terminate upon the earlier of successful completion of the Evaluation Project or the second anniversary of the Effective Date of this Agreement, unless further extended by written agreement of the Parties.

Each Party may terminate this Agreement earlier by thirty (30) days written notice to the other Party.

Upon request or terminate of this agreement **L** shall return all unprocessed SiOG samples to **C**.

Upon termination pursuant to this Article 9, the Parties shall be relieved of all obligations under this Agreement, except for their obligations in Article 3 – Confidential Information and Article 4 - Ownership and Rights in Intellectual Property .

영문 계약서의 일반 조항



- Notice

All notices required or permitted to be given under this Agreement shall be in writing in the English language and shall be given by registered airmail letter or by telecopy to the addresses shown below or to such other addresses as the parties may designate in writing.

Notices given by telecopy shall be deemed to have been received on the day following its dispatch and notices given by registered airmail letter shall be deemed to have been received seven (7) days after mailing.

Cf. Date of mailing

영문 계약서의 일반 조항

- Entire Agreement (C사)

This Agreement, including the appendices, constitutes the entire agreement and understanding between the parties hereto and supersedes all prior discussions, negotiations, agreements, representations, understandings and commitments with respect to the subject matter herein, including the Confidentiality Agreement between the Parties having an effective date of August 3, 2004.

The provisions of said Confidentiality Agreement shall remain in effect with respect to disclosures made by the Parties prior to the Effective Date.

No modification or extension of this Agreement shall be effective or binding unless made in a writing specifically referencing this Agreement and executed by duly authorized representatives of the parties.

영문 계약서의 일반 조항

- Force Majeure - Except for the payment of money

Force Majeure shall be defined as any war, riot, fire, storm, heavy snow, earthquake, accidents, acts of God where nature strikes, labor disputes, or other causes preventing performance which are beyond the party's control.

If either party to this Agreement is prevented by Force Majeure from performing any obligation, such party shall immediately give the other party notice of that fact.

The party prevented from performing its obligation shall be entitled to extend without penalty the time of its performance by a period of delay attributable to the Force Majeure.

As soon as the Force Majeure ceases to affect the party's ability to perform, such party shall give notice to the other party and resume the performance of its obligations under this Agreement.

In the event that a Force Majeure preventing S's performance lasts one (1) month or more, C shall have the right to terminate this Agreement.

Wrap Up



- **영문 계약서의 검토 요령**
: 영문 계약서가 어렵게 느껴지는 이유?
- **영문 계약서의 기본 형식 (Sample)**
- **영문 계약서의 주요 조항 검토 (실무 Tip 포함)**
: NDA, JDA

감사합니다