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| C:\Users\DTollen\My ShareSync\Law Practice\Tech Contracts Academy\Admin\Identity\Logo\TCA_TM Logo_FINAL\PNG\Tech-Contracts-Academy-Logo_TM_Color_FINAL.png  <https://TechContracts.com/> | **THE TECH CONTRACTS HANDBOOK**  **Cloud Computing Agreements, Software Licenses, and Other IT Contracts for Lawyers and Businesspeople**  Second Edition  **by David W. Tollen**  (ABA Publishing - Intellectual Property Law Section of the American Bar Association; 2015) |

***Form Contract***

**Confidentiality (NDA) & Assignment Agreement**

***Employee (but Easily Modified for Other Individual Staff-Member); Broad Assignment/Ownership Transfer; One-Way NDA***

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**EMPLOYEE CONFIDENTIALITY AND ASSIGNMENT AGREEMENT**

This Employee Confidentiality and Assignment Agreement (this “Agreement”) is entered into as of \_\_\_\_\_\_\_\_\_\_\_, 20\_\_ (the “Effective Date”) by and between \_\_\_\_\_\_\_\_\_\_\_\_, a \_\_\_\_\_\_\_\_\_\_\_ (“Company”) and \_\_\_\_\_\_\_\_\_\_\_\_\_\_, an individual (“Employee”). This Agreement includes Attachments A and B attached hereto.

RECITALS

Employee is or will soon become an employee of Company. In the course of employment, Employee may develop technologies or other assets related to Company’s business and may receive Company’s confidential information. The parties have agreed that such technology and assets will belong to Company and that Employee will maintain the confidentiality of such information. Therefore, in consideration of Employee’s employment with the Company, in consideration of Employee’s compensation now and hereafter paid by Company, and in consideration of the mutual covenants, terms, and conditions set forth below, the adequacy of which consideration is hereby accepted and acknowledged by both parties, the parties agree as follows.

TERMS AND CONDITIONS

1. **EMPLOYMENT.** The parties recognize and agree that this Agreement governs only its subject-matter and not all terms and conditions of Employee’s employment with Company. Employee recognizes and agrees that, unless another written contract between Employee and Company provides to the contrary: (1) his/her employment with Company is for an unspecified duration and constitutes “at-will” employment; and (2) his/her employment may be terminated at any time, with or without good cause or for any or no cause, at the option either of the Company or him/herself, with or without notice, except as prohibited by law.
2. **CONFIDENTIAL INFORMATION.** 
   1. Confidential Information Defined. “Confidential Information” refers to the following: (a) any Company proprietary information, technical data, trade secret, or know-how, including without limitation research, product plans, future products or services, customer lists, software, inventions, processes, formulas, other technology, designs, drawings, and hardware configuration information; (b) any Company document marked “confidential” or otherwise marked as sensitive; and (c) \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_. Confidential Information may include information from third parties for which Company is under an obligation of confidentiality, including without limitation consumer personally identifiable information. Notwithstanding the foregoing, Confidential Information does not include information that: (i) is in Employee’s possession at the time of disclosure; (ii) is independently developed by Employee without use of or reference to Confidential Information; (iii) becomes known publicly, before or after disclosure, other than as a result of Employee’s improper action or inaction; or (iv) is approved for release in writing by Company.
   2. Nondisclosure*.* Employee shall not use Confidential Information for any purpose other than to facilitate his/her duties as assigned by Company. Employee shall not disclose Confidential Information to any other third party without Company’s prior written consent and shall exercise reasonable care to prevent unauthorized disclosure of Confidential Information. Employee shall promptly notify Company management of any misuse or misappropriation of Confidential Information that comes to Employee’s attention. Notwithstanding the foregoing, Employee may disclose Confidential Information as required by applicable law or by proper legal or governmental authority. Employee shall give Company management 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.
   3. Retention of Rights. This Agreement 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.
   4. Exception & Immunity. Pursuant to the Defend Trade Secrets Act of 2016, 18 USC Section 1833(b), Employee is on notice and acknowledges that, notwithstanding the foregoing or any other provision of this Agreement:
      1. *IMMUNITY*. An individual shall not be held criminally or civilly liable under any Federal or State trade secret law for the disclosure of a trade secret that- (A) is made- (i) in confidence to a Federal, State, or local government official, either directly or indirectly, or to an attorney; and (ii) solely for the purpose of reporting or investigating a suspected violation of law; or (B) is made in a complaint or other document filed in a lawsuit or other proceeding, if such filing is made under seal.
      2. *USE OF TRADE SECRET INFORMATION IN ANTI-RETALIATION LAWSUIT*. An individual who files a lawsuit for retaliation by an employer for reporting a suspected violation of law may disclose the trade secret to the attorney of the individual and use the trade secret information in the court proceeding, if the individual- (A) files any document containing the trade secret under seal; and (B) does not disclose the trade secret, except pursuant to court order.
   5. PII. Employee shall not, without authorization, disclose or expose any individual’s personally identifiable information, whether or not such information constitutes Confidential Information, held by Company (“PII”). Employee shall comply with all Company policies, written or otherwise, regarding the protection and management of PII.
3. **INTELLECTUAL PROPERTY.**
   1. Reporting of Inventions. Employee shall 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 Employee makes, conceives, reduces to practice, or creates, either alone or jointly with others, during the period of his/her employment with Company (collectively, “Inventions”), whether or not in the course of employment and whether or not such Inventions are patentable, copyrightable, protectable as trade secrets, or otherwise subject to intellectual property protection.
   2. 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 Employee’s work for Company; or (3) it relates to Company’s business or its current or anticipated research and development.
      1. *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.
      2. *Assignment*. To the extent, if any, that Company does not own full right, title and interest in and to the Work Product pursuant to Subsection 3.2(a) above, Employee hereby assigns to Company all of his or her ownership, right, title, and interest in and to all Work Product, including, without limitation: (i) 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; (ii) all goodwill associated with Work Product; and (iii) 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 of the foregoing, and to settle and retain proceeds from any such actions).
   3. Backup License. To the extent, if any, that this Article 3 does not provide Company with full ownership, right, title, and interest in and to the Work Product, Employee 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. Exercise of Company’s rights pursuant to this Section 3.3 does not excuse any breach of Employee’s obligations pursuant to Section 3.2 above.
   4. Prior Inventions. Employee represents that *Attachment A* attached to this Agreement is a list of all Employee’s Inventions prior to the Effective Date which Employee has not separately assigned to Company (collectively “Prior Inventions”), and that if *Attachment A* is blank or not included, there are no Prior Inventions. Employee shall not incorporate any Prior Invention into the Work Product or otherwise use any Prior Invention in his/her work for Company without Company’s prior written consent.
   5. Moral Rights. In addition to the foregoing transfers and allocations of rights, Employee hereby irrevocably transfers and assigns to Company any and all “moral rights” Employee may have in or with respect to the Work Product. Employee also hereby forever waives and agrees that he/she shall never, even after termination of employment with Company, assert any moral rights with respect to the Work Product. “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.”
   6. Further Assistance. Employee shall 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. Employee shall execute any documents Company reasonably requests for use in obtaining or enforcing such rights and protections. To the extent that such assistance occurs after Employee’s leaves employment with Company, Company shall compensate Employee at a reasonable rate for time and expenses spent at Company’s request pursuant to this Section 3.6. Employee hereby appoints Company or its designated representative as Employee’s attorney-in-fact to execute documents on Employee’s behalf for the purposes set forth in this Section 3.6.
   7. Exception to Assignments. Employee is on notice and understands that the provisions of this Agreement requiring assignment of inventions to Company do not apply to any invention which qualifies fully under the provisions of California Labor Code Section 2870 (attached hereto as *Attachment B*). Employee shall advise Company promptly in writing of any Inventions he/she believes meet the criteria of California Labor Code Section 2870.
4. **OTHER EMPLOYERS, THIRD PARTIES, & TERMINATION OF EMPLOYMENT.**
   1. Former Employers & Disclosers. Employee shall not, during his/her employment with Company: (a) improperly use or disclose any proprietary information or trade secrets of any former or concurrent employer or other person or entity (collectively, any “Third Party”); or (b) bring onto Company’s premises any unpublished document or proprietary information belonging to any Third Party without such Third Party’s prior written consent.
   2. Returning Company Documents. Upon or before leaving Company employment, Employee shall deliver to Company, and not recreate or deliver to anyone else, all Confidential Information, as well as any and all devices, records, data, notes, reports, proposals, lists, correspondence, specifications, drawings, blueprints, sketches, materials, equipment, other documents or property, or reproductions of any foregoing, developed by Employee pursuant to employment with Company or otherwise belonging to Company or its successors or assigns.
   3. Notification of New Employer. In the event that Employee leaves Company’s employ, he/she hereby consents to Company’s notification of such new employer about Employee’s duties pursuant to this Agreement.
5. **MISCELLANEOUS.**
   1. Injunction. Employee agrees that breach of this Agreement 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.
   2. Survival. The rights and obligations of Articles 2, 3, and 4 above will survive any termination or expiration of this Agreement or of Employee’s employment with Company, as will any provision that must survive to fulfill its essential purpose.
   3. 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.
   4. 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 by an authorized representative in an explicit written waiver. No waiver of a breach of this Agreement will constitute a waiver of any other breach of this Agreement.
   5. Choice of Law & Jurisdiction: This Agreement will be governed solely by the internal laws of the State of \_\_\_\_\_\_\_\_\_\_\_\_, including applicable U.S. federal law, without reference to any conflicts of law principle that would apply the substantive laws of another jurisdiction to the parties’ rights or duties. The parties consent to the personal and exclusive jurisdiction of the federal and state courts of \_\_\_\_\_\_\_\_\_\_ [city or county], \_\_\_\_\_\_\_\_\_ [state]. This Section 5.5 governs all claims arising out of or related to this Agreement, including without limitation tort claims.
   6. Entire Agreement. This Agreement sets forth the entire agreement of the parties regarding its subject matter and supersedes all prior or contemporaneous writings, negotiations, and discussions with respect to such subject matter. Neither party has relied upon any such prior or contemporaneous communications.
   7. Amendment. This Agreement may not be amended except through a written agreement executed by authorized representatives of each party.

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

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| **\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ EMPLOYEE** | **\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ COMPANY** |
|  |  |
| \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_  (signature) | By: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_  (signature) |
| Date: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ | Name: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_  (print) |
|  | Title: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ |
|  | Date: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ |

**ATTACHMENT A**

LIST OF PRIOR INVENTIONS

Identifying Number

Title Date or Brief Description

Signature of Employee: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Print Name of Employee: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Date: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**ATTACHMENT B**

CALIFORNIA LABOR CODE SECTION 2870

EMPLOYMENT AGREEMENTS; ASSIGNMENT OF RIGHTS

(a) Any provision in an employment agreement which provides that an employee will assign, or offer to assign, any of his or her rights in an invention to his or her employer will not apply to an invention that the employee developed entirely on his or her own time without using the employer’s equipment, supplies, facilities, or trade secret information except for those inventions that either:

(1) Relate at the time of conception or reduction to practice of the invention to the employer’s business, or actual or demonstrably anticipated research or development of the employer.

(2) Result from any work performed by the employee for the employer.

(b) To the extent a provision in an employment agreement purports to require an employee to assign an invention otherwise excluded from being required to be assigned under subdivision (a), the provision is against the public policy of this state and is unenforceable.