


Legal Perspectives on Forming an Emerging Company



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Forming an Emerging Company

- Selecting the Right Entity and Jurisdiction
- Structuring Company Ownership
- IP Issues & Hiring Employees
- Common Pitfalls During Formation
- AK Start-Up Package 
- Q&A

[Note: For the purposes of this discussion, assume that the company will seek financing at a “professional angel” level or above in the future.]

Selecting the Right Entity and Jurisdiction

- Limitation of liability for owners: Limited liability vs. unlimited liability
- Tax treatment of entity and owners
- Pass-through of profits and losses to owners
- Impact on exit strategies and liquidity options
- Formality and centralization of management structure and decision-making
- Choice of formation jurisdiction: Delaware vs. state of residence
- Choice will depend on expected investment source and exit strategy

Selecting the Right Entity and Jurisdiction

<u>Entity Type</u>	<u>Liability</u>	<u>Entity Level</u>	
		<u>Taxation</u>	<u>Management</u>
Sole Proprietorship	Unlimited	No	Direct
General Partnership	Unlimited	No	Decentralized
Limited Partnership	Limited for LP, Unlimited for GP	No	Centralized
Limited Liability Company	Limited	Elect Yes or No	Either
Corporation (C or S Corp)	Limited	Yes for C Corp, No for S Corp	Centralized

Selecting the Right Entity and Jurisdiction

- ***Institutional investors*** prefer C corporations
 - Investor familiarity with centralized management structure and formalities
 - Some private equity funds are precluded from investing in pass through entities for tax reasons
 - Full range of exit strategies or liquidity options not available to other entity types
 - Lower organizational and administrative costs than an LLC or LP
- ***Institutional investors*** prefer Delaware
 - Well-formed body of corporate law, including long-established principles in case law and ease of filing
 - Increased flexibility under Delaware law with respect to Board composition and corporate administration
 - National understanding of Delaware law among practitioners

Structuring Company Ownership

- Allocating ownership among the founders
- Types of equity interests
- Common stock versus preferred stock
- Contribution of IP and past services vs. future services to be rendered
- Valuing stock and options issued to founders and employees

Structuring Company Ownership: Founder's Stock

- Founder's Stock
- Vesting – General Structure
- 4 years on a monthly, quarterly or annual basis; one-year cliff
- Can be shortened in certain instances
- Buy back at cost upon termination of employment, death or marital dissolution prior to the end of the vesting period
- 83(b) Election
- Acceleration Issues: Termination & Change of Control
- Right of first refusal for sale to third parties
- The role of employment agreements

Structuring the Company: Capitalization Plan

	<u>Formation</u>		Series A Preferred (\$5 Million Pre-Money <u>\$5 Million Invested</u>)		Series B Preferred (\$15 Million Pre-Money <u>\$7.5 Million Invested</u>)		Series C Preferred (\$30 Million Pre-Money <u>\$10 Million Invested</u>)	
	<u>Shares</u>	<u>%</u>	<u>Shares</u>	<u>%</u>	<u>Shares</u>	<u>%</u>	<u>Shares</u>	<u>%</u>
Common (Founders)	2,500,000	100%	2,500,000	25%	2,500,000	16%	2,500,000	11%
Option Pool	---	---	2,500,000	25%	3,214,500	20%	4,000,000	18%
Series A Preferred	---	---	5,000,000	50%	5,000,000	31%	5,000,000	22%
Series B Preferred	---	---	---	---	5,357,250	33%	5,357,250	24%
Series C Preferred	---	---	---	---	---	---	5,619,083	25%
Total	2,500,000	100%	10,000,000	100%	16,071,750	100%	22,476,333	100%

IP Issues & Hiring Employees

- Non-compete/non-solicitation agreements with previous employer
 - Does one exist? If so, what is the “scope” of the restriction?
 - Is it enforceable?
 - Should you attempt to notify/negotiate right away?
- Continuing non-disclosure obligations from previous employer
 - Agreements with previous employer may restrict transfer of certain know-how and trade secrets?
 - Even without an agreement, common law trade secret obligations exist
 - What is the employee bringing with him? Files, computers, storage media, etc. spell trouble

IP Issues & Hiring Employees (cont.)

- Obtain a signed proprietary information and invention assignment agreement before commencing employment
 - Don't ignore any carve-outs – have someone technical review them
 - Get it as of “Day 1” – prior to disclosure of company confidential information
 - Consider appropriate, enforceable non-compete/non-solicitation (note state by state enforceability)
 - Beware of contractors who become employees – good time to clean-up IP ownership

IP Issues & Hiring Employees (cont.)

- Beware of the Inevitable Disclosure doctrine
 - Under the “Inevitable Disclosure” Doctrine, a former employee of one company may be prohibited from working for a competitor of the previous employer based on the theory that the employee could not perform the duties of the new position with the competitor without relying on trade secrets obtained from the previous employer
 - Not all states apply the Doctrine
 - Application of the Doctrine does not require the former employee to have executed a non-compete agreement
- Trademarks, URLs and pre-formation IP assignments

Common Pitfalls During Formation

- Do it right the first time...your deal will follow the Company until it goes public or gets acquired
- Giving away the company – “too many promises”
- Guaranteed equity based on percentages rather than specific number of shares
- Granting stock options without a qualified plan – a tax liability for employees; cheap stock issues
- Selling common stock to investors instead of preferred stock
- Selling securities to unaccredited investors
- Failing to maintain adequate organizational records and capitalization
- Failing to ensure proper ownership of the IP (consulting agreements, PIAs)
- Too *many* agreements / Too *few* written agreements

AK Start-Up Package

- Incorporation, Organization and Qualification
 - Reservation of corporate name
 - Preparation and filing of Delaware Certificate of Incorporation
 - Preparation of Bylaws and Certificate of Secretary
 - Preparation of Action by Incorporator
 - Preparation of Organizational Board Consent regarding various organization and corporate governance matters
 - Preparation and filing of Form SS-4 Application for Employer Identification Number
 - Preparation and filing of qualification to do business as foreign corporation
 - Preparation and organization of corporate records and minute book
 - Preparation of Stockholder Consent
 - Preparation of form Indemnification Agreements for directors & officers
- Capitalization matters
 - Entry of capitalization data and corporate records into capitalization tracking software and corporate records database
 - Preparation of Founder's Restricted Stock Purchase Agreement for up to four Founders
 - Preparation of Stock Certificates for up to four Founders
 - Preparation of Memorandum re 83(b) Elections for Founders
 - Preparation and filing of state securities filings for stock issuances to Founders
 - Preparation of Stock Option/Stock Issuance Plan
 - Preparation of forms of Early and Standard Exercise Stock Option Agreement
 - Preparation of form of Stock Issuance Agreement
 - Preparation/filing of Form U-2 Uniform Consent to Service of Process

AK Start-Up Package

- Employment and Consulting Matters
 - Preparation of form of At-Will Employment Offer Letter
 - Preparation of form of Proprietary Information and Inventions Agreement
 - Preparation of Form of Independent Contractor Services Agreement

- Intellectual Property Matters
 - Preparation of form of Unilateral Nondisclosure Agreement
 - Preparation of form of Mutual Nondisclosure Agreement
 - Preparation of Assignment of Intellectual Property from Founders to the company
 - Preparation of Memorandum re Trademark Matters for a new company

- Consultations
 - One hour of advice on employment matters
 - One hour of advice on employee benefits matters
 - One hour of advice on protecting intellectual property
 - One hour of advice on venture capital term sheets

A Focus on Emerging Growth

ANDREWS KURTH LLP **Technology and Emerging Companies**

Andrews Kurth is a leading law firm for entrepreneurs, public and private emerging grown companies, and venture capital and private equity firms. Our practice comprises a dedicated team of attorneys in technology centers around the United States providing focused representation to public and private emerging growth companies and entrepreneurs as well as the venture capital and private equity firms that finance them. We take pride in having a practical, business-life approach to advising our clients, and we share their entrepreneurial spirit and drive. Our driven client service teams combine relevant experience with an understanding of a client's business and markets to provide efficient, cost-effective legal services and creative solutions with an outstanding degree of responsiveness.

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Matt Lyons is an Austin partner with Andrews Kurth, where he specializes in representing private and public emerging growth companies and entrepreneurial interests. He advises on all aspects of forming new businesses, raising capital, M&A, and securities laws & regulations. He also regularly counsels companies and their boards on corporate governance and executive compensation. Matt represents and maintains relationships with a number of prominent venture capital, private equity and investment banking firms.

Matt has consistently been named as one of the leading lawyers in Texas for the area of Technology: Corporate and Commercial in the Chambers USA Rankings. He also has been Martindale-Hubbell "Peer Review Rated" for Ethical Standards and Legal Ability. Matt has been named a "Texas Rising Star" in the area of Securities and Corporate Finance by Texas Super Lawyers and Texas Monthly Magazine. Matt received his undergraduate and law degrees from the University of Texas at Austin.