

A must-attend
program for anyone
drafting or advising
on IP licenses

Structuring, Negotiating and Drafting Intellectual Property Licensing Agreements

This highly practical course will give you the knowledge and skills you need to handle all types of intellectual property licensing:

- Identifying the underlying IP and verifying the rights
- Negotiating the grant and scope of use clauses
- Term, termination and renewal of licenses
- Tips for negotiating and drafting license reps and warranties
- Royalties and payment terms
- Cross-border restrictions that could affect your license agreement
- Indemnities and remedies
- Practical business strategies
- Anticipating the impact of insolvency on license agreements

Plus! Optional Pre-Course Primer: *IP Fundamentals*

Course Leaders

P. Bradley Limpert, Cameron MacKendrick LLP
Michael Cannata, BOCA Advisory Services Inc.

Hear from top IP law practitioners and experienced counsel from:

Hewlett-Packard • Labatt • RIM • Magna • Ganz



DATES & TIME

October 5 - 6, 2010
8:30 a.m. - 5:00 p.m. EDT/EST

OPTIONAL PRE-COURSE PRIMER

October 4, 2010
1:00 p.m. - 4:30 p.m.

LOCATION

Osgoode Professional
Development Centre
1 Dundas St. W., 26th Floor
Toronto, ON

Conference
Webcast
Available



Structuring, Negotiating and Drafting Intellectual Property Licensing Agreements

**Do you have the skills
you need to confidently
negotiate and draft your
client's IP licenses?**

Whether you're an IP lawyer, commercial lawyer, IP portfolio manager or in-house counsel, protecting and exploiting intellectual property assets is a critical function for your company or client. When you negotiate and draft license agreements, whether you are the licensee or licensor, you need to know what to look for to anticipate problems, cover off key points and adequately protect your client's interests. And because a company's or organization's assets may include many different types of intellectual property – and since multiple types of IP often form part of a single licensing transaction – licensing IP can be challenging and complex. At the same time, mistakes can be very costly.

This intensive *Osgoode Professional Development* short course is carefully structured to cover all the key aspects of licensing agreements, while also addressing what you need to know about licensing each unique type of intellectual property: patents, trademarks, copyright, data and trade secrets. As well, you'll learn about key commercial and regulatory issues that can affect your licenses, cross-border pitfalls that can trip you up, and innovative strategies to maximize returns from licensing.

You'll hear from corporate licensing counsel from a variety of key industry sectors, as well as top intellectual property and licensing lawyers from private practice. Practical negotiation and drafting demonstration workshops will complement the lecture presentations, ensuring you get concrete examples, precedents, and practical tips. You'll also get comprehensive materials which will be a valuable reference when you return to the office.

Those who are newer to IP licensing or need a good, comprehensive refresher can choose to attend a half-day Pre-Course Primer, *IP Fundamentals*. This nuts and bolts session on key characteristics of various types of IP will enable you to get the most out of the main course.

Register now by visiting www.osgoodepd.ca, calling 416.597.9724 or 1.888.923.3394, emailing opd-registration@osgoode.yorku.ca or faxing 416.597.9736.

Course Leaders

P. Bradley Limpert, Cameron MacKendrick LLP

Michael Cannata, BOCA Advisory Services Inc.

Faculty

Sheldon Burshtein, Blake, Cassels & Graydon LLP

Michael MacNaughton, Borden Ladner Gervais LLP

Professor Carys J. Craig, Osgoode Hall Law School
York University

Matthew Rappaport, Managing Director
IP Checkups Inc., California

Keith Desjardins, Gowling Lafleur Henderson LLP
(Ottawa)

Alex Porat, Patent Counsel, Magna International Inc.

Brian W. Gray, Ogilvy Renault LLP

Rui Resendes, Executive Director, GreenCentre
Canada

Sunny Handa, Blake, Cassels & Graydon LLP
(Montréal)

Peter Ross, Peter Ross Consulting

Jason Hannibal, Commercial Counsel, IT Services
Research In Motion Limited

Stephen Spracklin, Deputy General Counsel
Law and Government Affairs, Hewlett-Packard
(Canada) Co.

Keith G. Hunt, Counsel to Labatt U.S.A and Labatt
Breweries of Canada

Glenn Tautrimis, Hallinan Tautrimis Inc.

Oxana Iatsyk, Legal Counsel, Ganz

Michelle Wassenaar, Johnston Wassenaar LLP

R. Scott MacKendrick, Cameron MacKendrick LLP

Lee Webster, Osler, Hoskin & Harcourt LLP

Agenda

Pre-Course Primer - IP Fundamentals

Monday, October 4, 2010

Successful licensing depends upon a sound knowledge of the principles that define the various intellectual property rights. This focused half-day seminar will cover the key elements of each of the main types of intellectual property most likely to be at issue in any licensing situation.

12:30 Primer Registration Opens

1:00 Introduction and Overview

P. Bradley Limpert, Cameron MacKendrick LLP

- Overview of the types of IP rights you might encounter
- How various types of IP can be involved in a single transaction
- Key concepts: independent creation, similarity of work, validity

1:20 Key Patent Concepts

Michelle Wassenaar, Johnston Wassenaar LLP

- Preconditions for obtaining a patent: what makes something new? What makes something non-obvious? What is patentable, what isn't?
- Patents on: business methods, software, life forms, other
- Validity: what may make a patent invalid and unenforceable?
- Rights granted by a patent
- How to determine what a patent covers, and when it's infringed
- The impact of joint ownership

2:00 The Elements of Trademarks

R. Scott MacKendrick, Cameron MacKendrick LLP

- What can and can't be trademarked
- Trade name vs. trademark
- Registered vs. unregistered marks; the registration process
- Marking requirements in Canada and elsewhere
- Use and expungement
- Trademark infringement; "confusion" as key element in infringement
- Assignment of trademarks
- Ongoing responsibilities of the owner; monitoring use

2:45 Refreshment Break

3:00 The Essentials of Copyright

Professor Carys Craig, Osgoode Hall Law School
York University

- What does copyright protect? subject matter; idea vs. expression; special uses in software
- Term of copyright
- The scope of fair dealing exceptions to copyright infringement
- Copyright in compilations: *Robertson v. Thomson*
- The nature and limits of moral rights
- Neighbouring rights – how they arise, what you need to know
- Defences to copyright infringement

3:45 Trade Secrets and Confidential Information

P. Bradley Limpert, Cameron MacKendrick LLP

- What makes something a trade secret?
- Is there a difference between confidential information and trade secrets?
- Common law rules regarding trade secrets
- Have reasonable steps been taken to protect secrecy?
- The development of constructive trusts
- Contractual terms for secrets
- The role of fiduciary duties
- Duties of good faith or loyalty
- How confidentiality can be destroyed: public disclosure; independent creation; receipt from third parties; court orders/regulatory agencies
- Joint ownership of trade secrets

4:30 Primer Concludes

Day One: Tuesday, October 5, 2010

8:00 Registration and Continental Breakfast

8:30 Welcome from the Course Leaders

8:35 Identifying the Underlying IP and Verifying the Rights

P. Bradley Limpert, Cameron MacKendrick LLP

A sound approach to your IP licensing transaction starts before you begin any negotiations or drafting. This session will cover the essential checklist to review in determining the precise nature, scope, validity, and ownership of the IP that is at issue.

- Keeping IP rights and technology distinct
- Due diligence and verifying the IP— a checklist
- Confirming validity: patents; copyright; trademarks
- Confirming other IP rights: plant breeder rights; integrated circuit topographies; industrial designs
- Patents not yet issued: identifying applications
- Exploring the quality of applications or registrations
- Unregistered IP rights
- Assessing the breadth of the rights
- IP ownership: joint; public; collaboration; other scenarios
- Most favoured customer provisions
- IP rights existing in multiple jurisdictions

9:35 The License Grant and Scope of Use Clauses: Critical Considerations at the Core of Your Agreement

Regardless of which type of IP is being licensed, much of your negotiating and drafting attention will be focused on the scope of the license and the precise extent of the license grant. Some issues in the scope and grant of license are common to most licenses, while others are specific to the type of IP being licensed. In a series of presentations, the parameters of the grant and scope of license will be considered in detail, including specific sessions focusing on the grant and scope issues unique to each type of IP.

Agenda

(A) Essential Issues in Grant and Scope of License

Lee Webster, Osler, Hoskin & Harcourt LLP

- The form of license: exclusive vs. non-exclusive vs. sole
- Restrictions on territory and/or products produced
- Issues and considerations in sub-licensing
- Assignment of IP rights
- Rights in future-created IP
- Rights to sue for past infringement
- Particular issues in cross-licensing
- Prosecution and maintenance of rights during the agreement term
- Obligations of the licensee: sales, marketing, and other obligations
- How to spot competition/anti-trust issues that might arise
- Implied licenses: pre-existing or co-existing

10:15 Refreshment Break

10:30 (B) Patent Rights Grant and Scope

P. Bradley Limpert, Cameron MacKendrick LLP

- Field of use for patents
- Implied licenses: how they can arise
- Foundry rights: limiting the licensee's right to make for third parties
 - conditional sales
 - special problems with "have made" rights
- Impact of first sale doctrine
- Patent marking requirements
- Patent abuse under the IPEG's
- Different ways to define "improvements"

11:10 (C) Copyright Grant and Scope

Brian W. Gray, Ogilvy Renault LLP

- Licensing of derivative works
- Private copying
- Neighbouring rights
- Access/portal vs. content use licenses
- Derivative works
- Impact of the presence of open source content
- Moral rights
- Digital rights management, digital rights information, and Fair Dealing

12:00 Luncheon

1:00 (D) Trademark Grant and Scope

Keith Desjardins, Gowling Lafleur Henderson LLP (Ottawa)

- Quality control
- Audits and samples
- Co-branding and cross-licensing
- Sub-licensing of the trademark
- Termination
- Records management

1:40 (E) Trade Secrets and Confidential Information Grant and Scope, Data Licenses

Jason Hannibal, Commercial Counsel, IT Services, Research In Motion Limited

- Categories of information
- Protecting trade secrets; licensing trade secrets; sub-licensing
- The impact of a licensee's disclosure
- Permissible uses of licensed information
- Auditing and monitoring the use of information
- The impact of the licensor's public disclosure
- Actions on termination
- Key aspects of a data license
 - EU approaches to data that you need to know: the EU Data Directive
 - determining what IP rights may attach to data: possessory? contractual? copyright? statutory?
 - what causes of action might you have?

2:25 Refreshment Break

2:40 Demonstration: Negotiating and Drafting the License Grant and Scope of Use Clauses

Sheldon Burshtein, Blake Cassels & Graydon LLP

Stephen Spracklin, Deputy General Counsel, Law and Government Affairs, Hewlett-Packard (Canada) Co.

Utilizing samples from several different types of licensing agreements, presenters will demonstrate and discuss negotiating approaches and specific language examples for the license grant and scope clauses.

4:00 Term, Termination and Renewal of the License

Stephen Spracklin, Deputy General Counsel, Law and Government Affairs, Hewlett-Packard (Canada) Co.

- Determining the term of license
- Implied termination or renewal rights
- Termination mechanisms where there is a breach
- Winding down provisions: dealing with inventory on hand; decommissioning factory equipment; other wind-down issues
- What breaches can be cured?
- Special termination events

5:00 Day One Adjourns

Day Two: Wednesday, October 6, 2010

8:00 Continental Breakfast

8:45 Representations and Warranties in the License Agreement

Keith G. Hunt, Counsel to Labatt U.S.A and Labatt Breweries of Canada

A practical session on the do's and don'ts of the reps and warranties in your license agreement. Experienced counsel will share tips on getting the best protection, and ensuring you don't promise what you can't give.

- Details and tips on the key representations: ownership; IP validity; non-infringement; enforceability; good standing
- What is meant by "to the knowledge of"?

Agenda

- Obtaining good and clear title
- Reps and warranties to consider disclaiming
- Special issues where a party is a public or quasi-public entity

9:30 Cross-Border Licensing: Key Issues

Sunny Handa, Blake Cassels & Graydon LLP (Montréal)

With many IP licenses involving non-Canadian entities and intellectual property, it is important to be aware of some of the issues that can arise when licensing in or out of other jurisdictions. In addition, regulatory rules and restrictions can be traps for unwary counsel. This session provides an overview of some of these issues, with an emphasis on transactions involving U.S. parties.

- The significance of choice of law in licensing agreements
- Cautions: local laws not excluded by a choice of law clause
- Considering the impact of different IP laws in different jurisdictions
- Checklist of export controls and embargos to watch out for
- Strategies for dealing with currency exchange rates
- Impact of transferring people, money, and data across borders

10:30 Refreshment Break

10:45 Practical Business Strategies for Effective Licensing

Michael Cannata, BOCA Advisory Services Inc.

Matthew Rappaport, Managing Director, IP Checkups Inc., California

Rui Resendes, Executive Director, GreenCentre Canada

Alex Porat, Panel Counsel, Magna International Inc.

- Using technology to facilitate licensing
- Steps for identifying in and out licensing opportunities
 - assessing freedom to operate
 - matching patents and market opportunities
 - identifying gaps in technology and IP portfolios
- Best practices in “carrot” licensing – licensing new technology and know-how
- Tips and strategies for “stick” licensing – licensing to infringers
- Patent litigation as a means to a licensing settlement: a U.S. perspective
- Emerging models for patent litigation financing

12:00 Luncheon

1:00 Indemnities and Other Remedies: Constructing the Safety Net

Oxana Iatsyk, Counsel, Ganz

- Identifying your potential liabilities
- Risk allocation: what’s fair, what’s achievable
- The impact of statutory provisions
- Limitations on damages
- Approaches to limits on liability
- Should indemnities be capped?
- Indemnity for breach of contract; personal injury; negligence
- The use and abuse of liquidated damages clauses
- Tips on using or refusing specified remedies

1:30 Demonstration: Negotiating and Drafting Indemnities

Oxana Iatsyk, Counsel, Ganz

P. Bradley Limpert, Cameron MacKendrick LLP

Presenters will demonstrate licensee and licensor perspectives in negotiating indemnities clauses. Through varied examples, the parties’ interests will be linked to various specific language. Precedents will be provided and discussed, and potential drafting pitfalls will also be highlighted.

2:45 Refreshment Break

3:00 Royalties and Payment Terms

Glenn Tautrimis, Hallinan Tautrimis Inc.

Peter Ross, Peter Ross Consulting

Licensors want to ensure they receive the compensation they expect, and licensees don’t want to overpay. There are many aspects to consider when negotiating payment terms. This session will help guide you through the many and potentially varied nuances in compensation for the use of IP.

- Royalty factors: scope of intellectual property, cost savings, significance of benefits, industry standards
- Specifying the royalty base: gross sales, net sales, units sold or produced
- Special problems with defining the royalty base: advances; bundled transactions; non-cash consideration; loans, share purchases
- Royalty stacking: when licenses are required for enabling, blocking, or third party patents
- Royalty audits
 - royalty audit clauses: what is needed, what is practical, what is enforceable
 - harnessing the effective power of royalty audits
- “Royalty free” licenses: what you need to know
- Other approaches to royalties: minimum royalties; escalating royalties
- Other compensation apart from royalties: milestone payments; initial fees
- What happens if a patent becomes invalid?
- The impact of third party infringement

4:00 The Impact of Insolvency on the License Agreement

Michael MacNaughton, Borden Ladner Gervais LLP

- Why license rights don’t fit the insolvency model and the possible consequences for licensors and licensees
- Can you make them fit through the use of trusts, security interests or co-ownership interests?
- Canada-U.S. differences in insolvency scenarios: the fate of source code
- Dealing with intellectual property rights in insolvency: contract repudiation; contract assignment
- Recent legislative activity: changes to the *Bankruptcy and Insolvency Act* and the *CCAA*

4:45 Program Concludes

Registration

Please complete all registrant information.

"Fantastic introductory course on IP licensing. Thoroughly enjoyed." (2008)

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Fees include attendance, program materials, continental breakfast, lunch (course only) and break refreshments. Group discounts are available for both on site and webcast participants. Visit www.osgoodepd.ca for details. Please inquire about financial assistance and CLE credits.

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Approved in accordance with the requirements of the **LSUC Certified Specialist** program (pending), **Barreau du Québec**, **BC CPD** and **NY CLE Board** (for transitional and non-transitional lawyers). **Note:** NY CLE Credits are not available for webcast participants. BC CPD webcast participants must contact us for further information.

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Program Changes

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