

THE OSGOODE CERTIFICATE IN INTELLECTUAL PROPERTY LICENSING

ONLINE & IN-PERSON PROGRAM
September 25 - December 5, 2017

An expert faculty of over 15 senior legal and IP specialists will equip you with the knowledge and key strategies you need to effectively structure, negotiate and draft IP licenses, including:

- Online modules to reinforce key IP concepts
- Learn-by-doing drafting and negotiation workshops
- Personalized feedback

Register today at:
osgoodepd.ca/iplicensing

PROGRAM DIRECTOR
P. Bradley Limpert
Limpert & Associates

PROGRAM FORMAT
**A blend of online and
in-person learning**

LOCATION
Osgoode Professional
Development
1 Dundas St. West, 26th Floor
Toronto, ON



The Osgoode Certificate in Intellectual Property Licensing

Whether you're a lawyer in private practice or working within an organization in a legal or professional capacity, 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. Because an 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* certificate led by P. Bradley Limpert, 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 and industrial designs. 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 demonstrations and hands-on 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.

Who Should Attend?

- Lawyers who advise on IP licensing
- In-house counsel and executives managing IP licensing
- Contract managers and specialists
- Patent and Trademark Agents
- Technology transfer/commercialization professionals
- Venture Capital/Investment Analysts; Angel Investors

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This certificate program features:

- > **5 Online Primers in IP Fundamentals (choose 3 of 5)**
Available September 25, 2017
- > **3 One-day modules (In-person or by webcast)**
October 19 – November 16, 2017
- > **One-day skills workshop (In-person only)**
December 5, 2017

You Will Learn:

- The essentials of each type of IP
- How to identify underlying IP and chain of title issues
- Critical considerations for License Grant and Scope of Use Clauses
- Key issues in cross-border licensing
- The do's and don'ts of reps and warranties
- Indemnities and other remedies
- Avoiding common drafting mistakes in IP Licenses
- Key considerations when negotiating royalties and payment terms
- The impact of insolvency
- Understanding tax issues

Agenda

Online Primers IP Fundamentals

Available September 25, 2017

* Minimum of 3 of 5 primers required.

It is recommended that attendees view the Online Primers prior to Module One.

Successful licensing depends upon a sound knowledge of the principles that define the various intellectual property rights. These focused, online primers will cover the key elements of each of the main types of intellectual property most likely to be at issue in any licensing situation. View anytime from the convenience of your home or office.

- Key Patent Concepts
- The Elements of Trademarks
- The Essentials of Copyright
- Trade Secrets and Confidential Information
- Industrial Designs

Faculty

Jason Leung, Leung Law PC

Professor Carys Craig, Osgoode Hall Law School

P. Bradley Limpert, Limpert & Associates

Christopher Heer, Heer Law

Module One The Foundation of the License Agreement: The Grant Clauses

October 19, 2017
(In-person or by Webcast)
9:00 a.m. – 5:15 p.m. EST*

*Registration and Continental Breakfast begins at 8:30 a.m.

Identifying Underlying IP and Chain of Title Issues

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.

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

No matter which type of IP is being licensed, much of your 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 six presentations, the parameters of the grant and scope of license will be considered in detail, focusing on issues unique to each type of IP:

- Essential Issues in Grant and Scope of License
- Patent Rights Grant and Scope
- Copyright Grant and Scope
- Trademark Grant and Scope
- Trade Secrets and Confidential Information Grant and Scope, Data Licenses
- Industrial Design Grant and Scope

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

Utilizing samples from several different types of licensing agreements, presenters will demonstrate and discuss negotiation approaches and specific language examples for the license grant and scope clauses. Comparative drafting examples will be distributed and discussed.

Faculty

P. Bradley Limpert, Limpert & Associates

Jennifer MacInnis, Senior Director, Applied Research & Commercialization and Senior Legal Counsel, Ryerson University

Bob Tarantino, Dentons LLP

Keith Desjardins, Gowling WLG (Ottawa)

Jason Hannibal, Vice President, Legal and Contracts, Thales Canada Inc.

Andrea Kroetch, Smart & Biggar

Sheldon Burshtein, Blake, Cassels & Graydon LLP

Stephen Spracklin, Vice President, General Counsel and Corporate Secretary, Sandvine Inc.

Module Two Common Clauses in all IP License Agreements

November 2, 2017
(In-person or by Webcast)
9:00 a.m. – 5:00 p.m. EST

Representations and Warranties in the License Agreement

This practical session will teach you the dos and don'ts of the reps and warranties section of your license agreement. Highly experienced counsel will share tips on getting the best possible protection, and ensuring you don't promise what you cannot give or miss an opportunity for fulsome disclosure.

IP Strategy

- Three Key Strategic Issues:
 - Freedom to Operate
 - Ability to Design/Create Around
 - Strength of the Rights
- Non-Practicing Entities: Trolls or Defenders of Justice?
- The Role of Complementary Assets
- Filing Strategies

Indemnities and Other Remedies: Constructing the Safety Net

- Risk allocation: what's fair, what's achievable
- Indemnity for breach of contract; personal injury and negligence
- The use and abuse of liquidated damages clauses
- Tips on using or refusing specified remedies

Demonstration: Negotiating and Drafting Indemnities

This demonstration will illustrate the Licensee and Licensor perspectives when negotiating indemnities clauses. Through varied examples, the parties' interests will be linked to specific language in the clauses. Precedents will be provided and discussed, and potential drafting pitfalls will also be highlighted.

Avoiding Common Drafting Mistakes in IP Licenses

This session will consider common drafting mistakes in relation to licenses for patents, copyright, trade secrets, trademarks and industrial designs. You will also learn how to identify and eliminate unwanted ambiguity in your license agreements.

Cross-Border Licensing: Key Issues

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. This session will provide an overview of some of these substantive and regulatory cross-border issues that Canadian professionals need to know, with an emphasis on transactions involving U.S. parties.

Faculty

Peter M. Ross, Ross, Mongeon, Covello & Co

Marcel Mongeon, Ross, Mongeon, Covello & Co

P. Bradley Limpert, Limpert & Associates

Alex Porat, General Counsel, Litens Automotive

Module 3

The Life and Death of Your Licensing Agreement

November 16, 2017

(In-person or by Webcast)

9:00 a.m. – 5:00 p.m. EST

Royalties and Payment Terms

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.

The Impact of Insolvency on the License Agreement

- The risks of disclaimer/repudiation of licenses in insolvency proceedings
- The treatment of executory and non-executory contracts
- The assignment of IP licenses during asset sales
- Potential Canada-US cross-border issues

Tax Issues and License Agreements

- Income Tax – Sales: What is the difference between capital and inventory, and how does this characterization affect vendors, purchasers and the IP?
- Income Tax- Licensing: How are licensors taxed? What are the tax implications for licensees?
- How does sales tax apply to sales proceeds and royalties?
- What is non-resident tax, and what does a Canadian licensor/licensee to non-residents need to know when negotiating a license agreement?

Despite All Best Intentions: Renegotiation and Dispute Resolution

- Factors in deciding whether, and when, to renegotiate
- Assessing your leverage, and tips for “pre-loading” your leverage at the drafting stage
- Alternatives to standard dispute resolution: partial termination, royalty stacking, other options and strategies
- Critical information you need to gather to support renegotiations

Term, Termination and Renewal of the License

- 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

Negotiation Techniques

- BATNA, ZOPA and other key negotiation concepts
- Positional vs. Win-Win Negotiating
- Negotiating Processes and Approaches
- Key Attributes of a Successful Negotiator

Consulting Agreements

- Default IP Ownership for Consulting Projects
- Resolving the Consultant-Client Tug of War over IP
- Evolving Business Models for Consultants

Faculty

Glenn Tautrimis, Director, Global Royalty Audits, Inc.

Paul Jones, Jones & Co. Law Office

John Birch, Cassels Brock & Blackwell LLP

Patrick Westaway, Sorbara, Schumacher, McCann LLP

P. Bradley Limpert, Limpert & Associates

Module 4

Drafting and Negotiation Workshops

December 5, 2017

(In-person attendance only)

9:00 a.m. – 5:15 p.m. EST

*NOTE: Because of the interactive nature of the day, **in-person attendance is required for this module.**

In Module 4, you will have an opportunity to put into action what you've learned. The day will feature two small group, interactive workshops, plus a presentation on Advanced Negotiation Techniques.

Drafting Workshop: Scope of License Grant and Termination

In this hands-on, small group workshop, you will have a valuable opportunity to receive personalized feedback from our expert faculty on your drafting skills. Prior to the module, you will be provided with a sample Scope of License Grant and Termination clause, and asked to re-draft and submit for discussion in the workshop.

*NOTE: Advance preparation is required for the drafting workshop.

Plenary Presentation: Advanced Negotiation Techniques

Building on the Negotiation Techniques presentation delivered in Module 3, you will learn:

- Self-Assessment of Negotiation Techniques
- Techniques for Effective Negotiation
- Using Game Theory and Behavioural Economics in Your Negotiations

Tying it All Together: Mock Negotiation

Using a common fact scenario in conjunction with confidential facts for each party, you will work in small groups and engage in a mock negotiation representing the interests of either the vendor or customer. This is an interactive session in which you will receive feedback and guidance from an expert facilitator.

Faculty

May Cheng, Osler, Hoskin & Harcourt LLP

P. Bradley Limpert, Limpert & Associates

Brian W. Gray, Norton Rose Fulbright Canada LLP

Jennifer MacInnis, Senior Director, Applied Research & Commercialization and Senior Legal Counsel, Ryerson University

Stephen Spracklin, Vice President, General Counsel and Corporate Secretary, Sandvine Inc.

Essien Udokang, Baker McKenzie

Patrick Westaway, Sorbara, Schumacher, McCann LLP

Register today at:

osgoodepd.ca/iplicensing

Drawing on the expertise and experience of leading lawyers and experts, including:

Program Director



P. Bradley Limpert

Limpert & Associates

Brad Limpert is recognized by Intellectual Asset Management magazine of London, UK as one of the world's Top 250 Technology and Patent Licensing Lawyers.

He is also a Certified Licensing Professional, as well as being a lawyer and patent agent.

Brad has advised clients on over 500 Licensing Transactions, in diverse areas such as biotechnology, software, industrial equipment, consulting methodologies, chemical engineering, GreenTech, and e-commerce.

He also has extensive experience in litigation and dispute resolution in relation to licensing transactions, as well as valuation and acquisition of technology assets.

He is the author of *Technology Contracting* (published by Thomson Reuters), a leading Canadian looseleaf, which deals with many types of licensing.

Program Faculty

John Birch

Cassels Brock & Blackwell LLP

Sheldon Burshtein

Blake, Cassels & Graydon LLP

May Cheng

Osler, Hoskin & Harcourt LLP

Professor Carys Craig

Osgoode Hall Law School

Keith Desjardins

Gowling WLG (Ottawa)

Brian W. Gray

Norton Rose Fulbright Canada LLP

Jason Hannibal

Vice President, Legal and Contracts,
Thales Canada Inc.

Christopher Heer

Heer Law

Paul Jones

Jones & Co. Law Office

Andrea Kroetch

Smart & Biggar

Jason Leung

Leung Law PC

Jennifer MacInnis

Senior Director, Applied Research & Commercialization and Senior Legal Counsel, Ryerson University

Marcel Mongeon

Ross, Mongeon, Covello & C^o

Alex Porat

General Counsel, Litens Automotive

Peter M. Ross

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Stephen Spracklin

Vice President, General Counsel and Corporate Secretary, Sandvine Inc.

Bob Tarantino

Dentons LLP

Glenn Tautrims

Director, Global Royalty Audits, Inc.

Essien Udokang

Baker McKenzie

Patrick Westaway

Sorbara, Schumacher, McCann LLP

Certificate of Program Completion

You will receive an Osgoode Certificate upon completion of the program.

To receive the certificate participants must:

- (1) view 3 of 5 Online Primers
- (2) attend all 4 modules
- (3) participate in the drafting workshop and mock negotiation

Please note that modules 1-3 may be completed in person or by webcast. However, all registrants must attend module 4 in person.

Registration Details

Fee per Delegate

\$2,795 plus HST

Fees include attendance, program materials, continental breakfast, lunch and break refreshments. Group discounts are available. Visit www.osgoodepd.ca/groupdiscounts for details. Please inquire about financial assistance.

Program Changes

We will make every effort to present the program as advertised, but it may be necessary to change the date, location, speakers or content with little or no notice. In the event of program cancellation, York University's and Osgoode Hall Law School's liability is limited to reimbursement of paid fees.

Cancellations and Substitutions

Substitution of registrants is permitted at any time. If you are unable to find a substitute, a full refund is available if a cancellation request is received in writing 21 days prior to the program date. If a cancellation request is made with less than 21 days notice, a \$150 administration fee will apply. No other refund is available.

For Further Program-Related Information please contact:

Jessica Foster, Program Lawyer
at 416.673.4673 or email jfoster@osgoode.yorku.ca

Register today at:

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