

THE OSGOODE CERTIFICATE IN INTELLECTUAL PROPERTY LICENSING

ONLINE & IN-PERSON PROGRAM: 4 DAYS

October 9, 2018 – Module 1 (in-person or webcast)

October 23, 2018 – Module 2 (in-person or webcast)

November 6, 2018 – Module 3 (in-person or webcast)

December 5, 2018 – Module 4 (in-person)

Online Primers available On-Demand upon Registration

Do you have the skills and knowledge
you need to confidently negotiate and
draft IP licenses?

Join 20 senior legal and IP specialists in this intensive Certificate program – carefully structured to equip you with in-depth knowledge of licensing agreements and key strategies you need to effectively structure, negotiate and draft IP licenses, including:

- Essentials of each type of IP and the underlying considerations
- Avoiding common drafting and negotiating mistakes
- Negotiating royalties, payment and audit terms
- Critical issues - insolvency, tax, consulting agreements and cross-border licensing

Register today at:

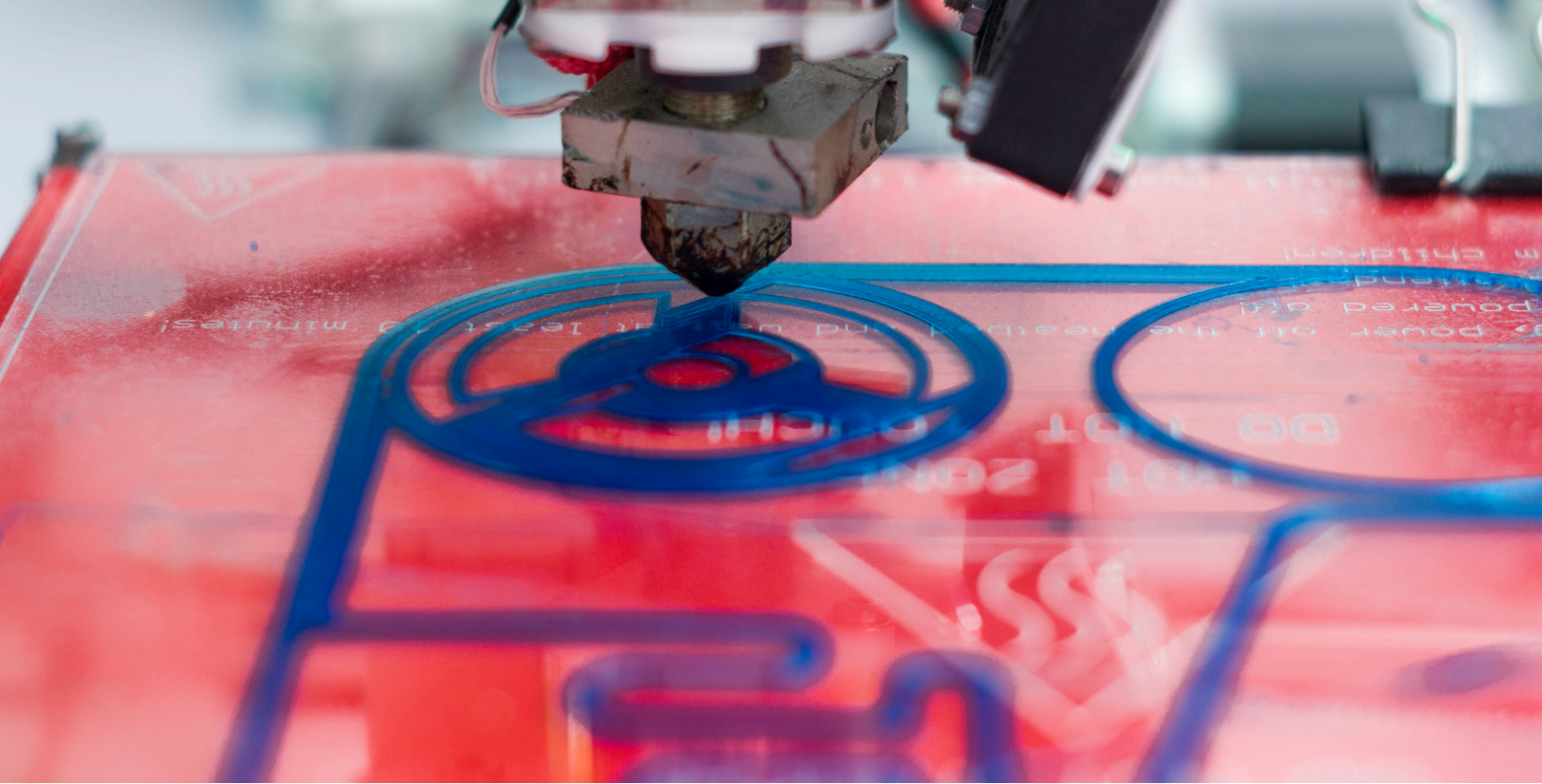
osgoodepd.ca/iplicensing

Program Director:

P. Bradley Limpert
Limpert & Associates

Location:

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



Get Practical Tips, Knowledge & Strategies in areas including:

- The essentials of each type of IP
- How to identify underlying IP and chain of title issues
- Avoiding common drafting and negotiation mistakes
- The do's and don'ts of reps, warranties, indemnities and other remedies
- Critical considerations for License Grant and Scope of Use Clauses
- How to negotiate royalties, payment and audit terms
- The impact of insolvency and understanding tax issues

- Key issues in cross-border licensing

PLUS! You'll receive comprehensive materials, **precedents** and **templates** to use as valuable resources and reference guides.

Register today at:

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iplicensing](https://osgoodepd.ca/iplicensing)

Who Should Attend?

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

The Osgoode Certificate in Intellectual Property Licensing

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This unique Certificate features blended-learning to enhance your experience and learning:

- 5 Online Primers in IP Fundamentals
 - view any 3 of 5
- 3 One-Day Modules of lectures & demonstrations
 - In-Person or Webcast
- One-Day Skills Workshop
 - In-Person only

PLUS! You will apply your learning in a take-home drafting assignment to reinforce key concepts.

Licensing IP is challenging and complex - as an organization's assets include many types of IP, and since multiple types of IP often form part of a single transaction. As a lawyer in private practice or as a legal or business professional working within an organization, protecting and exploiting IP assets is a critical function for your company or client. Stakes can be high and mistakes can be very costly.

Whether negotiating and drafting IP license agreements as the licensee or licensor, you need to know what to look for to anticipate problems, cover-off key points and effectively protect your client's interests.

This practical, hands-on Certificate – delivered over 4 non-consecutive days – will give you the knowledge and skills you need to competently and confidently handle IP licensing matters. Featuring unique, skills-based **learn by doing workshops**, you will benefit from personalized feedback that will enable you to rapidly improve and refine your drafting and negotiating skills.

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

Program Director



P. Bradley Limpert

Limpert & Associates

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

Brad received the 2017 Award for Outstanding Contribution to Continuing Legal Education by Osgoode Professional Development.

He is also a Certified Licensing Professional, patent agent and part-time General Counsel & VP, Strategy and Planning at Psiphon Inc., with extensive experience in litigation and dispute resolution involving licensing transactions, as well as valuation and acquisition of technology assets.

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

He is the author of ***Technology Contracting***, published by Thomson Reuters, a leading Canadian looseleaf dealing with many types of licensing. **Special Offer:** Registrants will receive an exclusive offer for 50% off this textbook (hardcopy only, does not include subscription). Offer valid only during this program using a Thomson Reuters form to be distributed. [Learn more about this valuable book now.](#)

Program Faculty

John Birch, Cassels
Brock & Blackwell LLP

Professor Carys Craig,
Osgoode Hall Law
School

Keith Desjardins,
Gowling WLG (Ottawa)

Brian W. Gray, Brian
Gray Law

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

Christopher Heer,
Heer Law

Paul Jones, Jones & Co.
Law Office

Andrea Kroetch,
Smart & Biggar/
Fetherstonhaugh

Jason Leung, Leung
Law PC

P. Bradley Limpert,
Limpert & Associates

Nathaniel Lipkus,
Osler Hoskin & Harcourt
LLP

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

Marcel Mongeon,
Intellectual Property
Coach, Mongeon
Consulting Inc.

Peter M. Ross, Ross
Mongeon Covello & Co.

**Christopher
Runstedler,** VP &
General Counsel,
Magnet Forensics

Stephen Spracklin,
Legal Counsel,
Information Technology
and Intellectual
Property, City of
Mississauga

Bob Tarantino,
Dentons LLP

Glenn Tautrimis,
Director, Global Royalty
Audits, Inc.

Essien Udokang, Baker
& McKenzie LLP

Patrick Westaway,
Sorbara, Schumacher,
McCann LLP

Register today at:

osgoodepd.ca/iplicensing

Agenda

Online Primers In IP Fundamentals

Minimum 3 of 5 Online Primers must be viewed for the Certificate On-demand.

We recommend that you view the Online Primers before Module 1.

Successful licensing requires sound knowledge of the principles defining various IP rights. These 5 Online Primers (1-hour each) focus on the key elements likely to be at issue in any licensing situation. View anytime online. Topics include:

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

Faculty

Professor Carys Craig, Osgoode Hall Law School

Christopher Heer, Heer Law

Jason Leung, Leung Law PC

P. Bradley Limpert, Limpert & Associates

MODULE 1

October 9, 2018 (in-person or webcast)
9:00 am – 5:15 pm EDT

The Foundation of Your License Agreement: The Grant Clauses

Identifying Underlying IP and Chain of Title Issues

Develop a sound approach to your IP licensing transaction, including an essential checklist to determine the precise nature, scope, validity, and ownership of the subject IP.

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

Regardless of IP type, your negotiating and drafting will focus on the scope of the license and the precise extent of the license grant. Expert faculty will guide you through the parameters of the grant and scope of license,

with specific sessions focusing on issues unique to each IP type.

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

Utilizing samples from various types of licensing arrangements, the faculty will demonstrate and discuss negotiation approaches and specific language examples for the license grant and scope clauses.

Take-Home Drafting Assignment: Distribution

The take-home drafting assignment will be distributed. This assignment is expected to take 3-4 hours to complete. It will be discussed during Module 2 and due the week after Module 3.

Faculty

Keith Desjardins, Gowling WLG (Ottawa)

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

Andrea Kroetch, Smart & Biggar/
Fetherstonhaugh

P. Bradley Limpert, Limpert & Associates

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

Christopher Runstedler, VP & General Counsel, Magnet Forensics

Stephen Spracklin, Legal Counsel, Information Technology and Intellectual Property, City of Mississauga

Bob Tarantino, Dentons LLP

MODULE 2

October 23, 2018 (in-person or webcast)
9:00 am – 5:00 pm EDT

Common Clauses in all IP License Agreements

Representations and Warranties in the License Agreement

A practical session on the do's and don'ts of

reps and warranties. 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

- 3 key strategic issues including: freedom to operate; ability to design/create around; strength of the rights
- Non-practicing entities: trolls or defenders of justice?
- 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
- Use and abuse of liquidated damages clauses
- Tips on using or refusing specified remedies

Demonstration: Negotiating and Drafting Indemnities

Faculty will demonstrate licensee/licensor perspectives in negotiating indemnities clauses, linking interests to specific language and highlight drafting pitfalls. Includes precedents.

Avoiding Common Drafting Mistakes in IP Licenses

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

International Licensing: Key Issues

Many IP licenses involve foreign entities and IP. Learn key issues when licensing with other jurisdictions, including regulatory restrictions and traps. Gain an overview of "need to know" cross-border issues, with an emphasis on civil law and Asian jurisdictions.

Take-Home Drafting Assignment: Discussion/Q&A

You will have the chance to clarify your questions on the drafting assignment as

distributed in Module 1. This assignment is expected to take 3-4 hours to complete and it will be due the week after Module 3.

Faculty

Paul Jones, Jones & Co. Law Office

P. Bradley Limpert, Limpert & Associates

Marcel Mongeon, Intellectual Property Coach, Mongeon Consulting Inc.

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

MODULE 3

November 6, 2018 (in-person or webcast)
9:00 am – 5:00 pm EST
The Life and Death of Your Licensing Agreement

Royalty, Payment and Audit Terms

Negotiating payment terms for the use of IP is complex. Licensors want to receive the compensation they expect and licensees don't want to overpay. This session will guide you through the various nuances.

The Impact of Insolvency on the License Agreement

- Why license rights don't fit the insolvency model
- Risks of disclaimer/repudiation of licenses
- Executory and non-executory contracts: does the distinction matter?
- Assignment of IP licenses during asset sales and potential cross-border issues

Tax Issues and License Agreements

- Income tax sales
- Income tax licensing
- How does sales tax apply to sales proceeds and royalties?
- Non-resident tax
- Cross-border planning

Despite All Best Intentions: Renegotiation and Dispute Resolution

- How to decide whether and when to renegotiate

- Assessing leverage and tips to "pre-load" leverage
- Alternatives to standard dispute resolution
- Critical information you need to support renegotiations
- ADR/Mediation/Arbitration

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

Negotiating 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

Drafting Assignment Deadline

The drafting assignment will be due the week after this Module 3.

Faculty

John Birch, Cassels Brock & Blackwell LLP

P. Bradley Limpert, Limpert & Associates

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

Glenn Tautrimis, Director, Global Royalty Audits, Inc.

Patrick Westaway, Sorbara, Schumacher, McCann LLP

MODULE 4

December 5, 2018 (in-person only)
9:00 am – 5:15 pm EST
Drafting & Negotiation Workshops

NOTE: The interactive nature of this workshop requires in-person attendance for this Module 4.

Over one intensive, hands-on day, you'll apply what you've learned and reinforce key concepts learned throughout the Certificate by working in small group, interactive workshops, and by observing a presentation on Advanced Negotiation Techniques.

DRAFTING WORKSHOP & ASSIGNMENT REVIEW: Scope of License Grant and Termination

In small groups, you will get personalized feedback on your drafting assignment from our expert faculty and discuss common drafting pitfalls and model drafting clauses.

Instructional Presentation: Advanced Negotiation Techniques

Building on Negotiating Techniques delivered in Module 3, you will learn:

- Self-assessment techniques
- Techniques for effective negotiation
- Game Theory and Behavioural Economics for negotiation

NEGOTIATION WORKSHOP: Tying it All Together (Mock Negotiation)

In small groups, you will engage in a mock negotiation representing either the vendor or customer. You will receive individualized support and feedback from an expert facilitator.

Faculty

Brian W. Gray, Brian Gray Law

Jason Leung, Leung Law PC

P. Bradley Limpert, Limpert & Associates

Nathaniel Lipkus, Osler Hoskin & Harcourt LLP

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

Stephen Spracklin, Legal Counsel, Information Technology and Intellectual Property, City of Mississauga

Essien Udokang, Baker & McKenzie LLP

Registration Details

Fee per Delegate

\$2,995 plus HST

Fees include attendance, program materials, lunch and break refreshments for each of the 4 days of the program. Group discounts are available. Visit www.osgoodepd.ca/group-discounts 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:

Alexandra Karacsony, Program Lawyer at 647-999-8796
or email akaracsony@osgoode.yorku.ca

Certificate of Program Completion

You will receive a Certificate upon successful completion of the **Osgoode Certificate In Intellectual Property Licensing**

REQUIREMENTS

- 1. Complete 3 Online Primers**
5 Online Primers in IP Fundamentals will be available on-demand (1 hour each). You must view any 3 of the 5. Viewing history will be checked.
- 2. Attend all 3 One-Day Modules (In-Person or Webcast)**
October 9, 2018 – Module 1; October 23, 2018 – Module 2; November 6, 2018 – Module 3
- 3. Successfully complete a take-home drafting assignment**
- 4. Attend and Participate in the One-Day Skills Workshop (In-Person)**
December 5, 2018 – Module 4

4 Convenient Ways to Register



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Online



Fax



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Register today at:

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OsgoodePD has been approved as an Accredited Provider of Professionalism Content by the LSO.



Eligible CPD Hours - LSO (ON): 32h 30m CPD Hours (29h 30m Substantive, 3h Professionalism);

This program is approved for LAWPRO Risk Management Credit.



OsgoodePD programs may be eligible for CPD/MCLE credits in other Canadian and US jurisdictions. To inquire about credit eligibility, please contact cpd@osgoode.yorku.ca.

“Excellent knowledge. Great tips on the applications needed and the language used in each country. All are great at engaging class participation [and] I really enjoyed how they discussed what is ideal in negotiation and what actually happens [and] how the law is upheld and what the standard practises are in the real world.”

Vivian Punzalan, ProperVu Inc.

“Tremendous content and presentation.”

Kevin Wentzel, Counsel, Pivotal Software, Inc.

“This is an excellent program [and] all the information was very useful. It covers clauses and details that lawyers generally take for granted. There were a lot of practical examples used. For example, in the royalties section, it really helped to get an auditor's point of view. I believe this is extremely important for lawyers as it helps us understand the practical aspects related to payments.”

Meenakshi Tewari, Sole Practitioner, Jham Law Office