Structured, 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
- The impact of insolvency licenses
- Anticipating and resolving disputes within the agreement

Plus! Optional Pre-Course Primer: IP Fundamentals

Course Leader

P. Bradley Limpert, Ridout & Maybee LLP

Hear from top IP law practitioners and experienced counsel from:

Konica Minolta • Thales Canada • Eli Lilly • Litens Automotive

DATES & TIME

November 27 - 28, 2012
8:30 a.m. - 5:00 p.m. EDT/EST

OPTIONAL PRE-COURSE PRIMER

November 26, 2012
12:30 p.m. - 4:30 p.m.

LOCATION

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

Webcast Available

CPD
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. 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. You’ll learn about key commercial and regulatory issues that can affect your licenses, cross-border pitfalls that can trip you up, and how to anticipate and successfully resolve issues that arise within the licensing relationship.

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 solid, 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 Leader

P. Bradley Limpert, Ridout & Maybee LLP

Faculty

Sheldon Burshtein, Blake, Cassels & Graydon LLP
Professor Carys J. Craig, Osgoode Hall Law School
Keith Desjardins, Gowling Lafleur Henderson LLP
Brian W. Gray, Norton Rose Canada LLP
Jason Hannibal, Legal Manager, Thales Canada Inc.
David Heller, Ridout & Maybee LLP
Craig Hill, Borden Ladner Gervais LLP
Paul Jones, Jones & Co. Law Office
Jennifer MacInnis, Director, Industry Liaison and Commercialization, Ryerson University

Alex Porat, Patent Counsel
Litens Automotive Partnership

Stephen Spracklin, General Counsel & Corporate Secretary, Konica Minolta Business Solutions (Canada) Ltd.

Glenn Tautrims, Global Royalty Audits, Inc.

Michelle L. Wassenaar, Johnston Wassenaar LLP

Alonzo Weems, General Counsel and Corporate Secretary, Eli Lilly Canada
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.

12:00  Primer Registration Opens

12:30  Introduction and Overview
P. Bradley Limpert, Ridout & Maybee 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

12:45  Key Patent Concepts
David Heller, Ridout & Maybee 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

1:35  The Elements of Trademarks
Michelle Wassenaar, Johnston Wassenaar 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

2:15  Refreshment Break

2:30  The Essentials of Copyright
Professor Carys Craig, Osgoode Hall Law School
- 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
- The nature and limits of Moral Rights
- Neighbouring rights – how they arise, what you need to know
- Defences to copyright infringement

3:30  Trade Secrets and Confidential Information
P. Bradley Limpert, Ridout & Maybee 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
(A) Essential Issues in Grant and Scope of License
Jennifer MacInnis, Director, Industry Liaison and Commercialization, Ryerson University
- 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
- Particular issues in cross-licensing
- 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, Ridout & Maybee 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, Norton Rose Canada LLP
- Nuances of license rights granted: some more specific grants and restrictions
- The effect of business models on license grants
- Rights collectives – SOCAN, CMRA and others
- Key changes with new Copyright Act – mashups, UGC, and more
- Reproduction vs. “making available” rights
- 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; technical protection measures
- Impact of new fair dealing exemptions

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, Legal Manager, Thales Canada Inc.
- 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, General Counsel & Corporate Secretary Konica Minolta Business Solutions (Canada) Ltd.
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.

4:00 Term, Termination and Renewal of the License
Stephen Spracklin, General Counsel & Corporate Secretary Konica Minolta Business Solutions (Canada) Ltd.
- 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, November 28, 2012

8:30 Continental Breakfast

9:00 Representations and Warranties in the License Agreement
A practical session on 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.
Agenda

9:45 Cross-Border Licensing: Key Issues
Alonzo Weems, General Counsel and Corporate Secretary
Eli Lilly Canada
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, there are regulatory rules and restrictions that can be traps for unwary counsel. This session will provide an overview of some of these substantive and regulatory cross-border issues that Canadian counsel need to know, 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 for which to watch out
- Strategies for dealing with currency exchange rates
- Impact of transferring people, money, and data across borders

10:45 Refreshment Break

11:00 Despite All Best Intentions: Renegotiation and Dispute Resolution
P. Bradley Limpert, Ridout & Maybee LLP
Alonzo Weems, General Counsel and Corporate Secretary
Eli Lilly Canada
- Factors in deciding whether, and when, to renegotiate
- Assessing your leverage, and tips for “pre-loading” your leverage at the drafting stage
- Using innovative drafting provisions to anticipate and head off disputes
- Alternatives to standard dispute resolution: partial termination, royalty stacking, other options and strategies
- Critical information you need to gather to support renegotiations
- Do you have room to renegotiate?
- Alternatives to courts and arbitration: self-help clauses, reciprocity

12:00 Luncheon

1:00 Indemnities and Other Remedies: Constructing the Safety Net
Alex Porat, Patent Counsel, Litens Automotive Partnership
- 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

1:30 Demonstration: Negotiating and Drafting Indemnities
Presenters include:
Alex Porat, Patent Counsel, Litens Automotive Partnership
- Should indemnities be capped?
- Indemnity for breach of contract
- Indemnity for personal injury and negligence
- The use and abuse of liquidated damages clauses
- Tips on using or refusing specified remedies

2:45 Refreshment Break

3:00 Royalties and Payment Terms
Glenn Tautrims, Global Royalty Audits, Inc.
Paul Jones, Jones & Co. Law Office
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
Craig Hill, 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

4:45 Program Concludes

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To register visit www.osgoodepd.ca, call 416.597.9724 or 1.888.923.3394, email opd-registration@osgoode.yorku.ca or fax 416.597.9736.
### Registration

**Intellectual Property License Agreements**

<table>
<thead>
<tr>
<th>Option</th>
<th>Description</th>
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<tbody>
<tr>
<td>Course plus Primer</td>
<td>$1695 plus 13% HST for a total of $1915.35.</td>
</tr>
<tr>
<td>Course Only</td>
<td>$1495 plus 13% HST for a total of $1689.35.</td>
</tr>
<tr>
<td>Primer Only</td>
<td>$400 plus 13% HST for a total of $452.</td>
</tr>
</tbody>
</table>

**Fee Per Delegate**

- Course plus Primer: $1695 plus 13% HST for a total of $1915.35.
- Course only: $1495 plus 13% HST for a total of $1689.35.
- Primer only: $400 plus 13% HST for a total of $452.

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.

**Interested in Custom and In-house Programs?**

Osgoode Professional Development also offers many of its programs in-house and can customize some programs to your specific needs. If you would like further information, please contact Heather Gore, Program & Business Development Lawyer, at 416.597.8847 or custom@osgoode.yorku.ca or visit www.osgoodepd.ca.

**CPD Credits**

- LSUC (ON)CPD (experienced and new member): 14.25 CPD hours (14.25 substantive, 0.0 professionalism) for the course, 4.0 CPD hours (4.0 substantive, 0.0 professionalism) for the primer; also approved with the Barreau du Québec, BC CDP, Law Society of New Brunswick, Northwest Territories, Nunavut, PEI, Saskatchewan and Manitoba for 13.25 credit hours (3.75 credit hours for the primer) for CPD requirements; the NSBS CPD for 14.0 credit hours (4.0 credit hours for the primer); the New York CLE Board for 15.5 credit hours (4.5 credit hours for the workshop) in the Area of Professional Practice for transitional and non-transitional lawyers. Eligible for CLE/Insurance Premium Credits Program offered by the Law Society of PEI and for Alberta CPD credit with the Law Society of Alberta. Questions? E-mail: cpd@osgoode.yorku.ca or refer to the program website.

**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 (less $75 administration fee) is available if a cancellation request is received in writing 14 days prior to the program date. No other refund is available.

**Dates & Times**

- November 27 - 28, 2012
  - 8:30 a.m. - 5:00 p.m. EDT/EST
- Optional Pre-Course Primer
  - November 26, 2012
  - 12:30 p.m. - 4:30 p.m.

Please arrive a half hour early for sign-in and material pick-up.

Dress is business casual.

**Location**

Osgoode Professional Development
Downtown Toronto Conference Centre
1 Dundas St. W., 26th Floor
Toronto, ON M5G 1Z3

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**4 Convenient Ways to Register**

1. **MAIL** your registration form to:
   - Osgoode Professional Development
   - Downtown Toronto Conference Centre
   - 1 Dundas St. W., 26th Floor
   - Toronto, ON M5G 1Z3

2. **ONLINE** at
   - www.osgoodepd.ca

3. **FAX** your registration to
   - 416.597.9736

4. **CALL US** at 416.597.9724 or 1.888.923.3394