

THE OSGOODE CERTIFICATE IN INTELLECTUAL PROPERTY LICENSING

ONLINE & IN-PERSON PROGRAM

- 5 Online Primers (On Demand)
- 3 One-Day Modules (In Person or Webcast)
September 25 – October 23, 2019
- One-Day Skills Workshop (In Person Only)
November 28, 2019

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 and to carry-out more effective due diligence on IP assets, 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

Bradley Limpert
Limpert & Associates

Location

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



INTELLECTUAL PROPERTY
INSTITUTE OF CANADA
INSTITUT DE LA PROPRIÉTÉ
INTELLECTUELLE DU CANADA



The Osgoode Certificate in Intellectual Property Licensing

Register today at:

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

Reserve your place now to take advantage of this unique blended-learning opportunity to enhance your experience and learning:

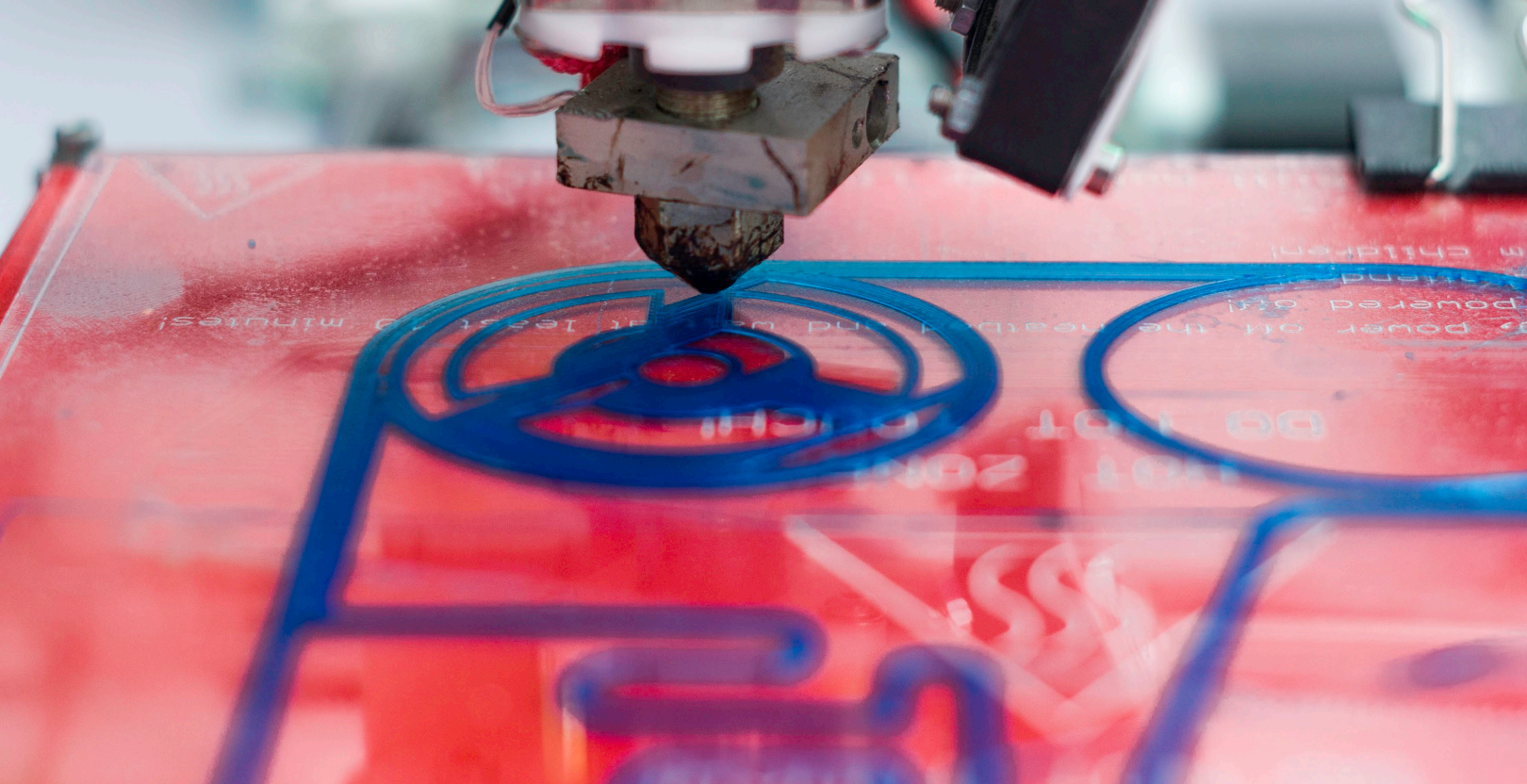
- 5 Online Primers (On Demand)
- 3 One-Day Modules of lectures and demonstrations (In Person or Webcast)
- A take-home drafting assignment to reinforce key concepts
- One-Day Skills Workshop (In Person only)

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.

Are you prepared?

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 and to carry-out more effective due diligence on IP assets. 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.



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 beneficial materials, **precedents** and **templates** that will act as valuable resources and reference guides.

“Tremendous content and presentation.”

Kevin Wentzel, Counsel, Pivotal Software, Inc.

Who Should Attend:

- Lawyers who advise on IP licensing
- In-house counsel, executives and professionals managing IP licensing
- Licensing and sales professionals
- Contract managers and professionals
- Patent Agents and Trademark Agents
- Technology transfer or commercialization professionals
- Procurement professionals involved with IP assets, software or licenses
- Venture Capitalists, Private Equity and Investment Analysts
- Angel Investors

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

Program Director



Bradley Limpert

Limpert & Associates

Brad Limpert is a lawyer, patent agent and engineer. On behalf of his clients, he has obtained IP rights and licensed and litigated those rights. Brad has been recognized by IAM as one of the world's Top 250 Technology Lawyers & 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 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.

Program Faculty

John Birch

Cassels Brock & Blackwell LLP

May Cheng

Osler Hoskin & Harcourt LLP

Professor Carys Craig

Osgoode Hall Law School

Keith Desjardins

Gowling WLG

Brian Gray

Patent and Trademark Agent,
Brian Gray Law

Jason Hannibal

Vice President, Legal and Contracts,
Thales Canada Inc.

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Dentons Canada LLP

Glenn Tautrims

Director, Global Royalty Audits, Inc.

Essien Udokang

Senior Director, Legal Affairs, McKesson Canada

Patrick Westaway

Sorbara, Schumacher, McCann LLP

Register today at:

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Agenda

ONLINE PRIMERS IN IP FUNDAMENTALS

(On Demand)

Minimum 3 of 5 Online Primers must be viewed for the Certificate. You will have access to all 5 Online Primers 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

MODULE 1

September 25, 2019

(In Person or Webcast)

8:30 am – 4:30 pm EDT

The Foundation of Your License Agreement: The Grant Clauses

Take-Home Drafting Assignment: Distribution

The take-home drafting assignment will be distributed and discussed in Module 1. This assignment is expected to take about 3-4 hours to complete. It will be discussed again briefly during Modules 2 and 3, and it will be due by November 6, 2019.

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.

MODULE 2

October 10, 2019

(In Person or Webcast)

8:30 am – 4:30 pm EDT

Common Clauses in all IP License Agreements

Take-Home Drafting Assignment: Discussion/Q&A

You will have the chance to clarify your questions about the drafting assignment, as distributed in Module 1. This assignment is expected to take about 3-4 hours to complete. It will be discussed again briefly during Module 3, and it will be due by November 6, 2019.

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

- Focus will be on 3 key strategic issues: freedom to operate; ability to design/create around, and; strength of the rights
- Non-practicing entities: trolls or defenders of justice?
- Role of complementary assets
- Difficult decisions around prior art searching
- 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.

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.

MODULE 3

October 23, 2019

(In Person or Webcast)

8:30 am – 4:30 pm EDT

The Life and Death of Your Licensing Agreement

Drafting Assignment Deadline

You will have a final chance to clarify your outstanding drafting assignment questions during this Module 3. The assignment is expected to take about 3-4 hours to complete and it will be due by November 6, 2019.

International Licensing: Key Issues

Many IP licenses involve foreign entities and IP. Learn key issues when licensing with other jurisdictions, including:

- Significance of choice of law, forum and choice of venue
- Overview of “need to know” cross-border issues
- Regulatory restrictions and traps
- Impacts of different IP laws, competition laws, export controls, and sanctions

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

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[osgoodepd.ca/
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MODULE 4

November 28, 2019

(In Person only)

9:00 am – 5:00 pm EST

Interactive Drafting & Negotiation Workshop

NOTE: Due to the interactive nature of the full-day workshop, in-person attendance is required 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 interactive, small group workshops, and you will also observe an Advanced Negotiation Techniques presentation.

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 Session: 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 and benefit from a master debrief and group discussion.

Registration Details

Fee per Delegate

\$2,995 plus HST

New Licensee (2016 – current): 50% off regular rate.

Fees include attendance, program materials, lunch and break refreshments. Group discounts are available. Visit www.osgoodepd.ca/financial-assistance for details about group discounts, special rates, job-grant funding and 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 completion of the **Osgoode Certificate in Intellectual Property Licensing** as follows: (1) View 3 of 5 Online Primers (2) Attend all 4 Modules (3) Complete/pass the take-home assignment (4) Participate in the workshops.

4 Convenient Ways to Register



Mail



Online



Fax



Call

Register today at:

osgoodepd.ca/iplicensing



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



PROGRAM TOTAL (Includes 3 Online Primers) – LSO (ON): 31h 25m CPD (28h 25m Substantive; 3h Professionalism)

ONLINE PRIMERS – LSO (ON): 3h CPD (1h Substantive per Primer, must view any 3 of 5)

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.

“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