

UNDERSTANDING THE INTELLECTUAL PROPERTY LICENSE 2018

ESSENTIAL INTELLECTUAL PROPERTY
LICENSING CONCEPTS

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LICENSING INTELLECTUAL PROPERTY can offer a practical and efficient strategy for companies looking to expand into a new market, enhance an existing product line, reduce costs or accomplish other business goals. The IP under consideration for license could be a patent, copyright, or trademark, software or any combination of these properties.

As this approach becomes increasingly common across industries, counsel who are new to licensing IP must understand the complex range of issues that may arise when licensing a mix of intellectual property types.

This program is designed for intellectual property specialists, corporate counsel and general practitioners who are interested in learning how to license and protect various forms of intellectual property.

TOPICS INCLUDE

- **Negotiating tips and effective drafting techniques**
- **Key provisions and practical considerations in copyright and trademark licensing**
- **Key differences between patent and other technology licenses**
- **Understanding software and open source licenses**
- **Protection and enforcement issues in cross-border IP licensing**
- **Enforcing licenses – tips from an IP license litigator**
- **How licensing can generate new revenue**

SPECIAL FEATURES

- **Instructive discussion of a mock license agreement**
- **Earn one hour of Ethics credit**



FACULTY

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Kenneth D. Min

CHICAGO November 1-2

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Shaw Pittman LLP
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AGENDA DAY 1

A networking breakfast will be available each day upon your arrival.

Morning Session:

9:00

INTRODUCTION

CHI: **Marcelo Halpern**
NY, ATL, IND, MECH, NB, PHI, PITT
& WEB: **Bruce R. Ewing**
SF & WEB: **Joseph Yang**

9:15

TRADEMARK LICENSING

- Rationale for licensing
 - Fundamentals of a trademark license
 - Key provisions and practical considerations
- CHI: **Janet A. Marvel**
NY, ATL, IND, MECH, NB, PHI, PITT
& WEB: **Sarah Robertson**
SF & WEB: **Sally M. Abel**

10:15

COPYRIGHT LICENSING

- Rationale for licensing
 - Fundamentals of a copyright license
 - Key provisions and practical considerations
 - Creative Commons licenses
- CHI: **Lita Rosario**
NY, ATL, IND, MECH, NB, PHI, PITT
& WEB: **Helene M. Freeman**
SF & WEB: **Cydney A. Tune**

11:15 Networking Break

11:30

RIGHTS OF PUBLICITY AND ENTERTAINMENT LICENSING

- Rights of publicity
 - Celebrity licensing
 - Television and movie licensing
- CHI: **E. Leonard Rubin**
NY, ATL, IND, MECH, NB, PHI, PITT
& WEB: **Christopher R. Chase**
SF & WEB: **Kristina H. Dinerman,**
Bryan Thompson

12:30 Lunch

Afternoon Session:

1:45

PATENT AND TECHNOLOGY LICENSING

- Standard clauses and variations
 - Important differences between patent and other technology licenses
 - Defining the license scope (including fields of use and territorial limits)
 - Negotiating compensation (royalties, milestone payments, license fees, etc.)
 - Representations, warranties, and indemnities
 - Sub-licensing rights
 - Handling patent licensing issues in the context of joint development and software integration projects, including rights to improvements
 - Rights and responsibilities for filing, prosecution, maintenance, defense and enforcement of patent rights
- CHI: **Margaret M. Duncan**
NY, ATL, IND, MECH, NB, PHI, PITT
& WEB: **TBD**
SF & WEB: **Joseph Yang**

2:45

SOFTWARE LICENSING AND OPEN SOURCE LICENSES

- Source code versus object code licenses
 - Representations, warranties, indemnities and audit rights
 - Key open source licensing concepts and terms
 - License and open source compliance strategies
- CHI: **Steve Gold**
NY, ATL, IND, MECH, NB, PHI, PITT
& WEB: **Jeffrey D. Osterman**
SF & WEB: **A. Clifford Allen, Jason Buttura**

3:45 Networking Break

4:00

ETHICAL ISSUES IN LICENSING

- Candor and deceit
 - Communicating with an adverse party
 - Out-of-state practice and the unauthorized practice of law
 - Competence to handle negotiation
 - Application of rules in actual cases
- CHI: **Eugene Friedman**
NY, ATL, IND, MECH, NB, PHI, PITT
& WEB: **David Rabinowitz**
SF & WEB: **Cassidy E. Chivers**

5:00 Adjourn

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AGENDA DAY 2

A networking breakfast will be available each day upon your arrival.

Morning Session:

9:00

INTERNATIONAL CONSIDERATIONS IN LICENSING

- How to approach the cross-border licensing of IP
- Dealing with issues that specifically impact licenses with foreign entities
- Drafting considerations related to protection and enforcement of rights

CHI: **Anne S. Jordan**

NY, SF, ATL, IND, MECH, NB, PHI, PITT & WEB: **Lindsey J. Canning**

10:00

ANTITRUST ISSUES IN LICENSING

- Applicable antitrust standard: Per se violations versus rule of reason
- Distinguishing between horizontal and vertical licenses
- Particular restrictions in IP licenses
- Differences between the application of U.S. and EU antitrust law to IP licenses

CHI: **Jeffery M. Cross**

NY, SF, ATL, IND, MECH, NB, PHI, PITT & WEB: **Willard K. Tom**

11:00 Networking Break

CHICAGO

11:15

REGULATORY AND GOVERNMENT ISSUES IN IP LICENSING

- Licensing IP from the government: Required clauses, enforcement, march-in rights, and traps for the unwary
- Licensing IP to the government: Marking, monitoring, minimum rights, open source issues and remedies for infringement
- Impact of government preferences on licensing: Domestic manufacture, offshore R&D, and open source requirements at the state and federal levels

CHI: **Eric A. Aaserud**

NEW YORK, SAN FRANCISCO, GROUPCAST LOCATIONS & LIVE WEBCASTS

11:15

BANKRUPTCY ISSUES IN LICENSING

- Treatment of IP and IP licenses under bankruptcy law
- Consequences of your licensor, or licensee, going bankrupt
- Structuring IP transactions to take into account bankruptcy risk
- Negotiating tips to address the bankruptcy contingency
- Preserving IP rights in the face of bankruptcy

NY, ATL, IND, MECH, NB, PHI, PITT

& WEB: **Stuart M. Riback**

SF & WEB: **Lillian Stenfeldt**

12:15 Lunch

Afternoon Session:

1:30

LICENSE DRAFTING FOR LITIGATION

- Hear from a litigator what happens when the agreement has to be enforced
- How to draft boilerplate for the litigators
- A litigator's perspective on negotiating several common license provisions

CHI: **Stephen J. Rosenfeld**

NY, ATL, IND, MECH, NB, PHI, PITT

& WEB: **Bruce R. Ewing**

SF & WEB: **Ira Jay Levy**

CHICAGO

2:30

BANKRUPTCY ISSUES IN LICENSING

- Treatment of IP and IP licenses under bankruptcy law
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CHI: **Marcelo Halpern**

SAN FRANCISCO & LIVE WEBCAST

2:30

REGULATORY AND GOVERNMENT ISSUES IN IP LICENSING

- Licensing IP from the government: Required clauses, enforcement, march-in rights, and traps for the unwary
- Licensing IP to the government: Marking, monitoring, minimum rights, open source issues and remedies for infringement
- Impact of government preferences on licensing: Domestic manufacture, offshore R&D, and open source requirements at the state and federal levels

SF & WEB: **David S. Bloch**

NEW YORK, GROUPCAST LOCATIONS & LIVE WEBCAST

2:30

MOCK NEGOTIATION OF A LICENSE AGREEMENT

- Putting it all together; a simulated negotiation of a license agreement
- Drafting techniques and suggestions for specific clauses
- Explanation of the "real world" relevance of license provisions
- Pointers on negotiation techniques to develop compromises
- Identification of typical business terms

NY & WEB: **Ryan T. Colgan, Nicholas Vogt**

3:30 Networking Break

CHICAGO

3:45

PUTTING IT TOGETHER – THE FACULTY ANSWERS YOUR QUESTIONS

- Join the faculty in a spirited discussion of your toughest licensing questions
- Drafting techniques and suggestions for specific clauses
- Explanation of the “real world” relevance of license provisions
- Pointers on negotiation techniques to develop compromises

CHI: Eric A. Aaserud, Jeffrey M. Cross, Margaret M. Duncan, Eugene Friedman, Steve Gold, Marcelo Halpern, Anne S. Jordan, Janet A. Marvel, Lita Rosario, Stephen J. Rosenfeld, E. Leonard Rubin

NEW YORK, SAN FRANCISCO & LIVE WEBCASTS

3:45

MOCK NEGOTIATION OF A LICENSE AGREEMENT (NEW YORK – CONTINUED)

- Putting it all together; a simulated negotiation of a license agreement
- Drafting techniques and suggestions for specific clauses
- Explanation of the “real world” relevance of license provisions
- Pointers on negotiation techniques to develop compromises
- Identification of typical business terms

NY, ATL, IND, MECH, NB, PHI, PITT & WEB: Ryan T. Colgan, Nicholas Vogt
SF & WEB: Naomi Obinata, Tina Soriano, Joseph Yang

4:45 Adjourn

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November 5-6

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229 Peachtree Street NE
Atlanta, GA 30303-1601

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Ice Miller LLP
One American Square, Suite 2900
Indianapolis, IN 46282

MECHANICSBURG

Pennsylvania Bar Institute
5080 Ritter Rd.
Mechanicsburg, PA 17055

NEW BRUNSWICK

New Jersey Institute for Continuing
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One Constitution Square
New Brunswick, NJ 08901-1510

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Wanamaker Building, 10th floor, Suite 1010
Center City Philadelphia, PA 19103
(Juniper St. entrance, between 13th &
Broad Sts., opposite City Hall)

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PBI Professional Development
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339 Sixth Avenue, Suite 760
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December 5-6

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