

A two-day practical programme

8-9 May 2008 • London

CPD DAY



Understanding and Drafting International Technology Licensing Agreements

Providing key legal and commercial skills essential to secure a successful agreement

Key topics include:

- Strategies for maximising the value of your technology through licensing
 - Tactics to securely protect your technology
 - Current competition regulations
 - Special issues for joint venture agreements
 - Understanding and drafting the key provisions of the agreement
 - Techniques for effective dispute resolution
- PLUS:** Practical drafting sessions to illustrate best practice techniques

APPLIED PRACTICAL TRAINING FOR LEGAL AND CONTRACTS PROFESSIONALS

'Diverse attendees – interaction and input from different backgrounds'

Steve Pollitt, Business Development Manager, WorleyParsons

11 CPD hours

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the Bar Accredited



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Why you should attend

Licensing out is frequently used as a method for enhancing penetration into new industrial sectors and geographical markets.

Licensing in enhances production capabilities and to increase ranges of products offered.

Therefore, it's important that you get it right. This programme has been developed to give an intensive and practical briefing on all the key factors to be taken into account when entering into international technology licensing agreements to ensure a successful agreement and avoid costly dispute.

By attending this programme, you will:

- **Gain** a comprehensive understanding and appreciation of licensing as a key element of international business expansion
- **Learn** how to structure a licensing strategy and choose what to license
- **Explore** undertaking due diligence for licenses and identify what key issues to look for
- **Master** drafting the key pre-contract issues and general contract terms through practical workshop sessions
- **Find out** about the types of royalty structures that are available and how to draft the correct terms into your contract
- **Get-to-grips** with the complex competition regulations that govern technology licensing agreements
- **Understand** the special issues that arise when you are licensing to and from joint ventures
- **Hear** more about the strategic and contractual issues of entering into licensing alliances with academic institutions
- **Learn** how best to deal with disputes when deals go wrong

Who should attend?

- In house lawyers
- Commercial and contract managers
- Business development managers
- Licensing executives

MULTIPLE BOOKING
DISCOUNT **SAVE 10%**

See booking form for details.

The programme

Day One 8 May 2008

0900 Registration and refreshments

0930 Chair's introduction

0945 Introduction: Licensing – A key element of international business expansion

- Why license at all?
- Why license out?
- Why license in?
- Seek and find your licensee
- Where is your licensor?
- Satisfaction for all parties
- Intellectual property rights
- The business of licensing
- Creation of the activity
- Management of the operation
- Different forms of transfer

Arun Singh, OBE, international lawyer, Grundberg Mocatta and Rakison LLP

1030 Refreshments

1045 Structuring a licensing strategy/choosing what to licence

- Assessing what is available for licensing
- Determining the main market prospects
- Approaching the key players in the market
- Planning the deal parameters to do business

Colin Hunsley, Colin Hunsley Intellectual Property Services, Formerly Vice President and Global Director, Licensing, Support & Assertion, BTG (British Technology Group)

1130 Due diligence for licences and other transactions

- Finding out what you would like to know
- What can be achieved
- What can you do cost-effectively
- What people tend to do

Arun Singh

1215 Questions and discussion

1230 Lunch

1345 Technology licensing and IPR

- Implications in technology licensing agreements
- Protecting IPR in technology licensing
- Steps to be taken

1430 PRACTICAL WORKSHOP: Drafting international technology licensing agreements

Delegates will be divided into groups to address pre-contract issues, negotiate Heads of Agreement and Confidentiality Agreements

Arun Singh

1545 Refreshments

1600 Drafting and understanding royalty terms

- What different royalty structures are available?
- Defining royalty bearing products
- Royalty rates – is there any guidance?
- Royalties and standards
- Factors influencing calculation
- Duration of payments
- Policing of payments

Laura Anderson, Partner, Bristows

1645 Licence management

- Daily management
- Audits
- Definition of licensed product
- Termination
- The problem areas

Katharine Ray, Manager, Licensing Support & Agreement Compliance, BTG International Ltd

1730 Close of Day One

IN-HOUSE TRAINING

Interested in this course for your contracts or legal department?

Please contact Caroline Glen on +44 (0)20 7729 6677 or email caroline.glen@falconbury.co.uk

Day Two 9 May 2008

0900 Refreshments

0930 **Contractually dealing with legal liability under the licence**

General remarks with regard to opposing interests to licensor and licensee with regard to:

- Liability
- Different types of defects:
 - Defect of title – defects as to quality
 - Different possibilities for clauses with regard to the above mentioned defects
 - Other ways to solve liability (insurances etc.)

Dr Heinz Goddar, Partner, *Boehmert & Boehmert, Munich*

1015 **Competition regulations and technology licensing agreements**

- EU and UK competition law
- Recap of basics
- Purpose and structure of TTBER
- Treatment of different types of restriction
- Market shares in this context
- Why bother with it?

Jennifer Pierce, Partner, *Charles Russell*

1100 Refreshments

1115 **Special strategies for licensing to and from joint ventures and alliances**

- Why license to/from a combined entity?
- Getting to know your licensing partner
- Understanding the scope of the licence
- Turning due diligence into drafting

Dr Heinz Goddar

1200 **Termination of agreements**

- Grounds for termination
- Termination for breach of contract
- Termination for other cause

- Post-termination rights and obligations
- Impact on sub-licences

Iain Stansfield, Partner, *Olswang*

1245 Lunch

1400 **PRACTICAL WORKSHOP: Drafting international technology licensing agreements – to include:**

- General terms
- Key terms
- Grant
- Type of exclusivity
- Territory
- Technical assistance
- Payments
- Improvements
- ‘Best endeavours’ – ‘best efforts’

Arun Singh

1530 Tea

1545 **CASE STUDY: Entering into licensing alliances with academic institutions – strategic and contractual issues**

- Science and profit: partners or enemies?
- Academic research, innovation and creating value
- Industry-academia cooperation, specific nature and problems/solutions
- University inventions – who owns what?
- Steering the project
- Results and achievements for both parties
- Creating spin-off companies

Dr Anne Lane, Executive Director, *UCL Business PLC*

1630 **Questions and discussion**

1700 Summary/close

Seminar leader

Arun Singh OBE, is an international lawyer at Grundberg Mocatta and Rakison LLP he was formerly a partner and Head of Commercial Law at KPMG Legal. Arun is cited and ranked in Chambers Guide of the World's Leading Lawyers. He concentrates on international investment, joint ventures, licensing of technology, research and development, M&A, energy, outsourcing and corporate governance in developed and emerging markets (including Asia and the Middle East), and also handles international legal risk management matters. He advises a range of international organisations.

Seminar speakers

Laura Anderson is a Partner in the London office of Bristows. Laura specialises in non-contentious intellectual property matters and has experience of a broad range of commercial arrangements relating to the development and exploitation of intellectual property rights, including patents, know-how, trade marks, copyright and related rights, database rights and design rights.

Dr Heinz Goddar is a German Patent Attorney and European Patent and Trademark Attorney. Partner of Boehmert & Boehmert and of Forrester & Boehmert, with his office at Munich. Heinz has a technical background (as well as PhD degree) in physics and physical chemistry. He is one of the senior partners of his firm and is particularly involved in international patent and licensing matters, including litigation and arbitration. He is an Associate Judge at the Senate for Patent Attorneys Matters at the German Federal Court of Justice and a Senior Advisor to the German Industrial Investment Council (IIC), Berlin, with a specific responsibility for IIC Life Sciences and Chemicals. He teaches patent and licensing Law in Institutions across the world. He is a past President of LES International and of LES Germany.

Colin Hunsley is a Licensing Consultant and was formerly Vice President and Global Director, Licensing, Support & Assertion, BTG (British Technology Group). He joined BTG in 1988 to develop the medical device business, building on the earlier successes with MRI and Dental Cements. Colin led a variety of teams negotiating with major companies such as Pfizer, Johnson & Johnson, Stryker, GE and Bausch & Lomb to successfully complete multi-million dollar deals. As a result, Colin has considerable experience in commercialising new technologies through pulling together strong teams of professionals.

Dr Anne Lane is Executive Director of UCL Business PLC. She has a first degree in Applied Biochemistry from Liverpool Polytechnic and a PhD from University College London. After two post-doctoral fellowships at UCL and Harvard Medical School, she spent the next three years at RTP Pharma in Montreal working on out-licensing drug delivery products and took an Executive MBA at the Molson Business School. On returning to the UK in 2000, Anne returned to UCL and joined UCL Ventures as a Senior Licensing Executive in the biotechnology/healthcare areas.

Jennifer Pierce is a Partner in the London office of Charles Russell where she works in the intellectual property, charities/not for profit, media and entertainment, technology, telecoms, pharmacy and publishing business groups. She deals with intellectual property (patents, designs, copyright, database right, trade marks), confidential information, competition law and IT/Internet law. Jennifer is a contributor to the *Trade Mark Handbook* of the Chartered Institute of Patent Agents and the Institute of Trade Mark Agents. Jennifer is on the Council of Licensing Executives Society, Britain and Ireland and Co-Chair of the Society's Healthcare Committee.

Katharine Ray heads a small team, which manages all BTG's 160 licence agreements. She joined BTG International Ltd in 1990 and set up the licence compliance system which involves relationship building, reporting progress of licensees, managing the forecasting and collection of over £40M revenue from BTG's patent licences. Katharine has run internal training programmes aimed at improving the effectiveness of BTG's licences. She is a member of the Licensing Executive Society.

Iain Stansfield is a Partner in the Intellectual Property Group of Olswang. Iain specialises in commercial transactions involving the development, protection and exploitation of intellectual property. These include research and development, licensing, merchandising and endorsement agreements and publishing agreements. Iain also advises on general commercial matters, such as PR and marketing services arrangements, agency, distribution, technology supply and service arrangements (including IT projects). He is also experienced in the fields of brand, character and design protection and licensing.

Book now for

5812/

Understanding and Drafting International Technology Licensing Agreements

Yes I wish to attend:

 8-9 May 2008, London

Ref: 1071

For more than two delegates please photocopy this booking form

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DATE AND LOCATION

This two-day training course will be held on:

8-9 MAY 2008
**Grange Holborn Hotel, 50-60 Southampton Row
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FEE

The full fee for this programme is **£1049 + VAT = £1232.58/ €1549 + VAT = €1820.08** and includes all written material, lunch and refreshments.

HOW TO REGISTER AND PAY

A VAT invoice and booking confirmation will be sent within 7 days, please contact us if you have not heard anything after that time. Payment can be made by credit card, by bank transfer (for bank account details please see payment details section of booking form) or by cheque made payable to Falconbury Ltd and posted to the address above. VAT no. 770008751. **Any questions please contact Customer Services on +44 (0)20 7729 6677. ALL PAYMENTS MUST BE RECEIVED IN ADVANCE OF THE EVENT**

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MULTIPLE BOOKING DISCOUNTS

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ACCOMMODATION

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Always read the small print

CANCELLATIONS AND TRANSFERS: Once we have received the booking form the places are confirmed. Any cancellations received 14 days or more before the date of the course will be charged a 10% administration fee. After that date the full course fee will be charged.

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