Advanced Licensing Agreements 2015

• New: Review exhaustion considerations in licensing
• Receive practical and sophisticated guidance on structuring, drafting and negotiating effective licensing agreements
• Get a comprehensive update on key issues and recent developments in licensing

Special Feature:
• Choose from breakout sessions to meet your practice needs:
  – International licensing: (1) Asia or (2) Europe
  – (1) Licensing in the life sciences industry or (2) rights of publicity licensing
  – In-depth analysis of a complex license agreement: (1) content or (2) technology

San Francisco, January 28-29, 2015
Live Webcast, January 28-29, 2015 — www.pli.edu
New York City, March 9-10, 2015
Chicago, April 23-24, 2015

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Advanced Licensing Agreements 2015

Why You Should Attend
Intellectual property licensing continues to grow increasingly complex. The legal, regulatory and technical landscape is constantly evolving. Building and maintaining a successful and effective practice requires that practitioners stay sharp and current in a wide variety of key areas. Whether utilized to develop technology, expand or create market opportunities, or generate returns from existing assets, managing complex licensing transactions requires a broad and varied toolkit. Additionally, whether licensing patents, copyrights, trade secrets or trademarks, the ability to structure, draft and negotiate complex license agreements is critical to a successful transaction. This program is designed to address the more complex and practical issues that arise in drafting and negotiating IP licenses, as well as provide tips for specific industries. The program will feature updates on current legal developments, present case studies highlighting best practices, provide tactical guidance for negotiating frequently contested issues, and also provide a framework for identifying and avoiding common pitfalls, keeping the relationship on track, litigation planning and avoidance, and addressing ethics concerns. The speakers will illustrate both outside counsel and in-house perspectives.

What You Will Learn
• Best practices for patent and technology licensing
• Guidance for strategic alliances and other joint development agreements
• Pointers on copyright, content, and trademark licensing
• Guidelines for trade secret licensing
• Navigating issues in life sciences licensing
• Practice tips for rights of publicity licensing
• Addressing international licensing issues
• Accounting for litigation risks
• Managing indemnification issues
• Case law update
• Mastering effective negotiation strategies
• Special considerations raised by cloud computing

Special Features
• New: Addressing patent exhaustion in negotiations and drafting
• In-depth panel discussion of a complex technology license
• Mock negotiation of a complex content license
• Breakouts to meet your practice needs
• Earn one hour of Ethics credit

Who Should Attend
This advanced program is focused on those who already have experience in the substantive area of intellectual property law, and who devote a substantial amount of their practice to licensing.

What Past Attendees Have Said
“Great program. One of the best CLEs on licensing I have done. Thanks.”
– William Turok, Mandelbaum Salsburg

“Great topics. Great materials. Great speakers – all applicable, relevant materials that project well via web CLE.”
– Walid Moustafa, Accenture

“Thanks – learned a lot.”
– 2014 Attendee

“Terrific program. Focused, relevant, engaging, highly professional. Thanks!”
– 2014 Attendee

“Very timely and useful updates on all fronts.”
– Cathleen Butt, CSC

“I view the seminar every two years because it continues to have critical information on licenses and their negotiation.”
– 2014 Attendee

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Goodwin Procter LLP
New York City

Joseph Yang
PatentEsque Law Group, LLP
Menlo Park, California

Terence N. Church
Brown, Church & Gee LLP
San Jose and Walnut Creek, California

Tiki Dare
Managing Counsel
Oracle Corporation
Redwood Shores, California

Marcelo Halpern
Perkins Coie LLP
Chicago

Mark S. Holmes
C.E.O.
PatentBridge LLC
Menlo Park, California

Author, Patent Licensing
• Strategy • Negotiation
• Forms (PLI)

Kenneth M. Kaufman
Manatt, Phelps & Phillips, LLP
Washington, D.C.

Peter J. Kinsella
Perkins Coie LLP
Denver

Nader A. Mousavi
Sullivan & Cromwell LLP
Palo Alto

Christian H. Nadan
Vice President of Legal Services & Corporate Secretary
Actian Corporation
Redwood City, California

Marya Postner
Cooley LLP
Palo Alto

Robert Ranucci
Sr. Director, Business Development & Licensing
Cryptography Research, a division of Rambus
San Francisco

Jeremy Schrire
King & Wood Mallesons LLP
London

Marc P. Schuyler
Law Office of Marc P. Schuyler
Saratoga, California

Sarah Angela Solomon
Goodwin Procter LLP
San Francisco

Katherine C. Spelman
K&L Gates LLP
Seattle

Paul H. Arne
Morris, Manning & Martin, LLP
Atlanta

Karen E. Baruh, Esq.
VP Business & Legal Affairs, Content Distribution & Marketing
Viacom Media Networks
New York City

Natalie Bogdanos
General Counsel
ContracFect Corporation
New York City

Melvin C. Garner
Leason Ellis LLP
White Plains, New York

Marcelo Halpern
Perkins Coie LLP
Chicago

Oliver Herzfeld
Senior Vice President & Chief Legal Officer
Beanstalk New York
New York City

Mark S. Holmes
C.E.O.
PatentBridge LLC
Menlo Park, California

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Peter J. Kinsella
Perkins Coie LLP
Denver

Claudine Meredith-Goujon
Paul, Weiss, Rifkind, Wharton & Garrison LLP
New York City

Jeffrey D. Osterman
Weil, Gotshal & Manges LLP
New York City

Grace L. Pan
Orick, Herrington & Sutcliffe LLP
New York City

Lauren Rabinovin, Ph.D.
Associate General Counsel – Americas IP Litigation
Teva Pharmaceuticals
Horsham, Pennsylvania

David Rabinowitz
Morse & Singer LLP
New York City

Charan J. Sandhu
Weil, Gotshal & Manges LLP
New York City

Jeremy Schrire
King & Wood Mallesons LLP
London

Jonathan Sirotta
Sirotta Law Firm, P.C.
New York City

Mark G. Tratos
Greenberg Traurig LLP
Adjunct Faculty Member
University of Nevada Las Vegas
Boyd School of Law
Las Vegas

Jennifer S. Yoon
Sullivan & Cromwell LLP
New York City

Eleanor M. Yost
Goodwin Procter LLP
Washington, D.C.

Gail H. Zarick
Watson Site IP Counsel
IBM Corporation
White Plains, New York

Chicago

Themi Anagnos
Deputy General Counsel, Director of Intellectual Property for the Americas Continental Automotive
Deer Park, Illinois

Christopher A. Bloom
KBL Gates LLP
Chicago

Mary A. Carragher
Chief Counsel-Trademarks North America-Latin America
Mondelēz Global LLC
Deerfield, Illinois

Marcelo Halpern
Perkins Coie LLP
Chicago

Mark S. Holmes
C.E.O.
PatentBridge LLC
Menlo Park, California

Author, Patent Licensing
• Strategy • Negotiation
• Forms (PLI)

Lars S. Johnson
Senior Counsel, Global Operations
PepsiCo, Inc.
Chicago

Kenneth M. Kaufman
Manatt, Phelps & Phillips, LLP
Washington, D.C.

Peter J. Kinsella
Perkins Coie LLP
Denver

Marya Postner
Cooley LLP
Palo Alto

Robert Ranucci
Sr. Director, Business Development & Licensing Cryptography Research, a division of Rambus
San Francisco

David G. Rickerby
Boston Technology Law, PLLC
Boston

Jessica L. Rothstein
Goodwin Procter LLP
New York City

Catherine A. Sazdanoff
Vice President, Global Business Development Takeda Pharmaceuticals International
Deerfield, Illinois

Sally Shorthose
Bird & Bird LLP
London

Mark G. Tratos
Greenberg Traurig LLP
Adjunct Faculty Member
University of Nevada Las Vegas
Boyd School of Law
Las Vegas

Las Vegas

Greenberg Traurig LLP
Adjunct Faculty Member
University of Nevada Las Vegas
Boyd School of Law
Las Vegas

Lauren Rabinovin, Ph.D.
Associate General Counsel – Americas IP Litigation
Teva Pharmaceuticals
Horsham, Pennsylvania

Jennifer S. Yoon
Sullivan & Cromwell LLP
New York City

Eleanor M. Yost
Goodwin Procter LLP
Washington, D.C.

Gail H. Zarick
Watson Site IP Counsel
IBM Corporation
White Plains, New York

Program Attorney: Tamara C. Kiwi
Day One: 9:00 a.m. – 5:00 p.m.

Morning Session: 9:00 a.m. – 12:45 p.m.

9:00
Introduction
SF, NYC, CHI & WEB: Ira Jay Levy, Joseph Yang

9:15
Patent and Technology Licensing
• Avoiding the most frequently made mistakes
• Technology vs. IP vs. blended licenses
• Why patent licensing is different
• Understanding grant types and degrees of exclusivity
• Indemnification and change of control issues
• Negotiation strategies
• Comparing licensee and licensor perspectives
SF, NYC, CHI & WEB: Joseph Yang

10:15
Copyright, Content and Trademark Licensing
• Impact of digital distribution and media on licensing issues
• Structuring the acquisition of rights in content: licenses vs. assignments and works made for hire
• The latest developments involving copyright termination of transfers and licenses
• Licensing rights in preexisting content vs. newly created content
• Licensing for social media and user-generated content
• Key contract issues and negotiating points in content licenses
• The latest on quality control considerations
• Advanced considerations in trademark and brand licensing
• Sample licensing provisions
• Case law update and licensing implications
• Implementing a brand licensing program
SF & WEB: Tiki Dare, Kenneth M. Kaufman
NYC: Oliver Herzelf, Claudine Meredith-Goujon
CHI: Mary A. Carragher, Kenneth M. Kaufman

11:30 Networking Break

11:45
Software Licensing
• Source code issues
• Representations, warranties and indemnification
• Revenue sharing and auditing
• Training and support
• Keeping the relationship on track
SF, NYC, CHI & WEB: Mark S. Holmes

12:45 Lunch

Afternoon Session: 1:45 p.m. – 5:00 p.m.

1:45
BREAKOUTS
I. Analysis of a Content License Agreement
• Walkthrough and mock negotiation of a complex content license agreement
• Structuring IP rights allocation
• Negotiating new media rights
• Allocating merchandising rights
• Negotiating creative, business and technology control issues
• Funding and royalty-sharing considerations
• Interplay of technology and content issues for digital content
SF & WEB: Kenneth M. Kaufman, Katherine C. Spelman, Mark G. Tratos
NYC: Karen E. Baruh, Ira Jay Levy, Jonathan Sirota
CHI: Kenneth M. Kaufman, Jessica L. Rothstein, Mark G. Tratos

II. Analysis of a Technology License Agreement
• Walkthrough of key technology license provisions
• Common pitfalls
• Confidentiality and trade secret issues
• Exclusivity
• Restricted fields of use
• Specifications
• Warranties and indemnification
SF & WEB: Mark S. Holmes, Marc P. Schuyler, Gillian Thackray
NYC: Melvin C. Garner, Mark S. Holmes, Gail H. Zarick
CHI: Mark S. Holmes, Lars S. Johnson

2:45
BREAKOUTS
I. International Licensing – Asia
• Similarities and differences between domestic and Asian licensing
• Common pitfalls for U.S. lawyers doing Asian deals
• Local law issues to be aware of
• Cultural issues in Asian transactions
SF & WEB: Robert Ranucci
NYC: Grace L. Pan

II. International Licensing – Europe
• Similarities and differences between domestic and European licensing
• Common pitfalls for U.S. lawyers doing European deals
• Local law issues to be aware of
• Cultural issues in European transactions
SF, NYC & WEB: Jeremy Schrire
CHI: Sally Shorthose

3:45 Networking Break

4:00
BREAKOUTS
I. Licensing Issues in the Life Sciences Industry
Topics will vary by city, and may include:
• Research plan
• Due diligence
• Transitioning pharmaceutical products/programs
• Monetary considerations (e.g., royalties, product returns, etc.)
• IP rights considerations (e.g., ownership, licenses, retained rights, patent term extensions)
• Clinical stage vs. commercialized products
• Government rights and approvals (e.g., march-in rights, clinical trials, FDA approvals)
• Deal structures and governance
SF & WEB: Marya Postner, Sarah Angela Solomon, Elaine C. Stracker
NYC: Natalie Bogdanos, Lauren Rabinovic, Jennifer S. Yoon
CHI: Marya Postner, Catherine A. Sazdanoff

II. Rights of Publicity Licensing
• "Natural" vs. statutory rights
• Lifetime vs. postmortem rights
• Rights of publicity in "identifiable objects" symbolizing a persona
• Rights of publicity releases
• Liability for violating a right of publicity
• Differences compared to copyrights and rights of privacy
SF, NYC, CHI & WEB: Mark G. Tratos

5:00 Adjourn
Morning Session: 9:00 a.m. – 12:30 p.m.

9:00
Litigation and Case Law Issues for Licensing Lawyers
• Strategic drafting considerations to account for litigation risks
• Pitfalls, and examples, of sloppy wording
• Impact of recent cases on drafting and negotiating
• Arbitration and other dispute resolution considerations
• Case law update
SF, NYC, CHI & WEB: Ira Jay Levy

10:00
Strategic Alliances and Other Joint Development Agreements
• IP creation conflicts: Default laws vs. parties’ intentions
• IP allocation: Joint ownership vs. field-based ownership vs. separate entity
• IP enforcement: Contractual provisions; unauthorized licensees; joinder requirements
• IP de-allocation: Facilitating or inhibiting separation; bankruptcy
• Interplay with IP asset management
• Corporate vs. university partners
• “War stories” from real-life deals
SF, NYC, CHI & WEB: Joseph Yang

11:00 Networking Break

11:15
Exhaustion Considerations in Licensing; Indemnification

Exhaustion Considerations in Licensing
• Modern case law - Quanta, Tessera, Kueing, Lifescan, Helferich
• Unconditional vs. conditional sales
• Does exhaustion apply on a patent-by-patent or claim-by-claim basis?
• Is consideration (“first SALE doctrine”) required?
• Contracting best practices in light of exhaustion
SF & WEB: Nader A. Mousavi
NYC: Jeffrey D. Osterman, Charan J. Sandhu
CHI: Christopher A. Bloom

Indemnification
Topics will vary by city, and may include:
• Overlaps/differences between R&W and indemnification
• Is “hold harmless” broader than “indemnify”? 
• How patent guarantees are riskier than non-patent guarantees
• Carve-outs (e.g., modifications, combinations or decisions by the licensee)
  – What if the deliverable is intended for incorporation into a larger system?
  – What if the deliverable is intended to be further modified?
  – What if the deliverable is a design but the licensee makes the implementation choices?
• Tradeoffs vs. liability caps
• Litigation handoff when liability cap is exceeded
SF & WEB: Terence N. Church
NYC: Eleanor M. Yost
CHI: Themis Anagnostis

12:30 Lunch

Afternoon Session: 1:30 p.m. – 4:45 p.m.

1:30
Open Source Issues and Cloud Computing

Open Source Issues
• Recent developments in legal enforceability of open source licenses
• Comparing popular open source licenses
• Patent issues in open source licenses
SF: Christian H. Nadan
NYC: Paul H. Arne
CHI: David G. Rickerby

Cloud Computing
• What is cloud computing?
• Differences between SaaS, PaaS, and IaaS
• Overview of cloud computing legal issues
• Special contract issues raised by cloud computing arrangements
SF, NYC, CHI & WEB: Peter J. Kinsella

2:30
Negotiation Skills and Tactics
• How to prepare for license negotiations
• How to use psychological tools as part of your negotiation strategy
• Consensus and bridge building
• Differences between integrative (“win-win”) and positional bargaining, and when to use each
SF, NYC, CHI & WEB: Marcelo Halpern

3:30 Networking Break

3:45
Ethical Considerations in Licensing
• Drafting in anticipation/avoidance of litigation
• What happens when a friendly deal turns litigious
• Deceit and candor
• Cross-border transactions
• Communications with adverse parties
SF, CHI & WEB: Ira Jay Levy
NYC: David Rabinowitz

4:45 Adjourn

Please plan to arrive with enough time to register before the conference begins.
A networking breakfast will be available upon your arrival.
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