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IP Issues in Business Transactions 2015

- **New Topic!** Open source and IP transactions
- **Updated!** Case study of due diligence in an IP transaction
- **Updated!** Clause-by-clause breakdown of a licensing transaction
- New legal issues across IP and how they are impacting transactions: Copyright, trademark, domain names, trade secrets and patents
- Monetization of IP assets
- Strategic alliances and joint ventures: Special considerations
- Making the most out of your intellectual property assets
- Social media, data and online assets in IP transactions
- **Interactive Ethics Feature!** Learn how to avoid ethical missteps in IP transactions

This is an approved New York transitional program

January 12-13, 2015

New York City

February 26-27, 2015

San Francisco

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IP Issues in Business Transactions 2015

Why You Should Attend

Intellectual property issues frequently arise in the context of a variety of transactions, and this program will allow you to gain an in-depth understanding of these special considerations while exploring the strategic role of IP in a company. Explore how to assess intellectual property as a strategic asset and how to monetize IP while avoiding costly mistakes. Additional topics include managing and reviewing an IP portfolio, clause-by-clause analysis of licensing agreements, valuation, and IP enforcement. Expert faculty will also review joint development and shared intellectual property ventures, due diligence issues, as well as share best practices. Covering issues that may arise across patent, trademark, and copyright law, this program is essential for all IP transactional attorneys.

What You Will Learn

- Overview of how intellectual property arises in the context of transactions
- Cutting-edge review: New issues impacting transactions related to copyright, trademark, domain names, trade secrets and patents
- Assessing what IP assets a business should own and how to monetize them
- Dos and don'ts of entering into strategic alliances and joint ventures
- Due diligence review based on a **hypothetical** scenario
- **Practice Points:** Breakdown of a licensing agreement
- Data and online assets in IP transactions
- **New topic!** Open source and IP transactions

Who Should Attend

This program is designed for corporate counsel, intellectual property attorneys, corporate attorneys, intellectual property asset managers, and others who need to know how to identify and address key intellectual property issues that arise in corporate transactions.

“Nice CLE with a broad range of professionals providing real-world experience.”

– John Johnson, Nelson Mullins Riley & Scarborough LLP

“Informative program.”

– Michelle C. Replogle, Winston & Strawn LLP

“Top notch program and presentations.”

– 2014 Attendee

“Excellent course and content – very on point for in-house counsel.”

– 2014 Attendee

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Program Attorney:
Seema Lal Meehan

Program Schedule

Day One: 9:00 a.m. – 5:00 p.m.

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

9:00

Overview: How IP Issues Arise in Business Transactions

- What qualifies as an IP transaction?
- Transactions involving significant and tangential IP components

New Legal Issues Impacting IP Transactions: Copyrights, Trademarks, Domain Names, Patents and Trade Secrets

- Adapting IP transactions to an evolving business environment
- Recent developments and how they have impacted transactions involving copyrights, trademarks, patents, and trade secrets
- Legislative developments

NYC: Andrew Baum, Clark W. Lackert, Eric A. Prager, Steven I. Weisburd

SF & WEB: David S. Almeling, Karen N. Ballack, Lothar Determann, J. Scott Evans

11:00 Networking Break

11:15

Case Study: Designing, Creating and Pruning an IP Portfolio

- Identifying the business case and creating an IP value chain
- Mining IP as a strategic asset
- Special considerations for handling non-core assets
- How to acquire and sell off IP
- Business acquisitions versus IP-only acquisitions
- Obtaining rights: Which ones must you acquire in order to achieve your business goals?
- Packaging assets together for sale
- Confidentiality issues

NYC: Melvin C. Garner, Gail H. Zarick

SF & WEB: Karen N. Ballack, Mark A. Valetti

12:30 Lunch

Afternoon Session: 1:30 p.m. – 5:00 p.m.

1:30

Development and Implementation of an IP Licensing Program

- Which IP should be selected for licensing?
- How do you assess business objectives? Protection of market share, price advantage in competition, revenue generation, and more
- The process, the license, and setting appropriate goals
- Leveraging litigation to encourage infringers to become licensees

NYC: Alfred R. Fabricant

SF & WEB: Mary A. Fuller (Invited)

2:30

Critical License Terms – A Clause by Clause Review

- Dissecting the terms of a license and understanding the business case
- An in-depth review of terms and clauses, including:
 - Payment terms
 - Term of the license
 - Grant back provisions
 - Cross licenses
 - First sale issues
 - Sublicensing and assignability
 - Quality control
 - Special issues raised by e-commerce and social media

NYC: Steven I. Weisburd (Moderator); Kenneth K. Cho, Eleanor M. Lackman, Jonathan M. Seiden

SF & WEB: Tessa J. Schwartz (Moderator);

Christian H. Nadan, E. Lynn Perry, Thomas F. Villeneuve

3:45 Networking Break

4:00

Shared or Jointly Developed IP

- How collaboration with another company creates new business opportunities or business challenges
- Joint venture versus strategic alliances
- Using program IP: Rights of partners and/or collaborators
- Termination and dissolution: IP ownership issues following the collaboration

NYC: Audra A. Dial, Angela J. Grayson

SF & WEB: Michael S. Rabson (Invited)

5:00 Adjourn

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

Day Two: 9:00 a.m. – 5:00 p.m.

Morning Session: 9:00 a.m. – 12:15 p.m.

9:00

Open Source in Transactions

- Open source in M&A deals
- Due diligence in open source: Code, internal processes to monitor, inventory of what is being used
- Terms and conditions, reps and warranties
- What if the open source is bad? How do you remediate?
- In a licensing transaction, what are the red flags of which to be aware?
- Internal audit processes
- Palamida and Black Duck scans: Are there less costly options for clients?

NYC: Jeffrey D. Neuburger

SF & WEB: Lothar Determann, Bruce Perens

10:00

IP and Related Issues Concerning Data, Social Media and Online Assets

- Data: What is it legally? Who owns it? How can it be transferred? What special risks does it pose?
- Allocations of risks and burdens related to breaches: What are the company's duties and obligations to secure data?
- Restrictions pertaining to use of personal data
- Doing business on the web: What business activities call for new items or requests on the due diligence checklist (e.g., social media, e-contracting, e-communicating)?
- What kinds of changes should be made to standard acquisition agreements?

NYC: Holly K. Towle

SF & WEB: Susan Lyon-Hintze

11:00 Networking Break

11:15

Licensing and Bankruptcy Issues in IP Transactions

- Preserving rights following a licensor's bankruptcy filing
- Structural solutions, such as assignments and licenses back, or escrows of source code and other materials in the context of a licensor bankruptcy
- Licensor termination or prevention of assumption or assignment of an agreement following a licensee's bankruptcy filing
- Limitations on licensee rights under the bankruptcy code
- Drafting recommendations for licensors and licensees
- Acquiring IP from bankrupt and other distressed sellers
- International bankruptcy law applying to IP licenses

NYC: Debra A. Dandeneau, Jeffrey D. Osterman

SF & WEB: Speakers to come

12:15 Lunch

Afternoon Session: 1:30 p.m. – 5:00 p.m.

1:30

Negotiating the Deal: Due Diligence of IP Assets

Using a hypothetical deal as the basis of conversation, a panel of experts will address due diligence issues as they relate to copyright, trademark, and patent practice areas.

- Why is the client doing the deal?
- What is important to the deal and what are the potential IP risks?
- The due diligence plan and related time constraints
- Developing a plan to prioritize review of IP issues
- Identifying sources to be interviewed and outside sources for additional information related to the IP
- Litigation review
- Contract review

NYC: Christopher M. Cerrito (Moderator);

Tsan Abrahamson, Judith L. Church, Brian J. Powers

SF & WEB: Tsan Abrahamson, Marjorie M. Goux, Mark A. Valetti

2:45

IP Issues for In-House Counsel

- Managing with solicited and unsolicited proposals
- Non-disclosure agreements and invention assignment agreements
- Independent contractors, works for hire (and other common misunderstandings)
- Compliance with licenses

NYC: Carolyn Edgar

SF & WEB: Jae Kim

3:45 Networking Break

4:00

Avoiding Ethics Issues in IP Transactions

- Potential unlicensed practice of law
- Ethical obligations relating to non-clients
- When are conflicts unwaivable?
- Attorney misconduct and duty to report

NYC, SF & WEB: Eric A. Prager

5:00 Adjourn

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Advanced Trademark Law Annual Review 2015
March 24, 2015 – New York City and Live Webcast

Advanced Copyright Law Annual Review 2015
March 25, 2015 – New York City and Live Webcast

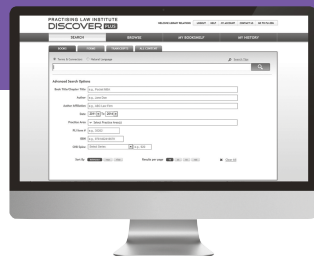
IP Monetization
April 29, 2015 – New York City and Live Webcast

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