UNDERSTANDING THE INTELLECTUAL PROPERTY LICENSE 2017

A COMPREHENSIVE REVIEW OF THE FUNDAMENTALS OF LICENSING

Chicago  
November 2-3

New York & Live Webcast  
November 6-7

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This is an approved New York transitional program
Companies continue turning to licensing because it offers valuable economic and strategic opportunities. Licensing can be used to gain access to intellectual property at a lower cost than by developing or purchasing intellectual property assets, and as a way of generating new sources of revenue out of existing intellectual property assets. Virtually every business today must confront licensing issues and, therefore, a solid base of knowledge about licensing has never been more important for companies and their counsel. This introductory course will give you an overview of how to negotiate and draft effective license agreements, whether you are the licensor or licensee. Experts in licensing will discuss different kinds of licensing agreements, and the business and legal issues related to them.

This program is designed for general practitioners, intellectual property specialists, corporate counsel and others who need to know the basics of how to license and protect their intellectual property.

**TOPICS INCLUDE**
- Negotiating tips and effective drafting techniques
- Fundamentals of a copyright license
- Important differences between patent and other technology licenses
- Key provisions and practical considerations in trademark licensing
- Understanding software and open source licenses
- Rights of publicity and entertainment licensing
- Issues that arise in licensing rights internationally
- Addressing antitrust issues
- Treatment of IP licenses under bankruptcy law
- How licensing can generate new revenue
- Hear from a litigator what happens when the agreement has to be enforced

**SPECIAL FEATURES**
- Instructive mock negotiation of a license agreement
- Earn one hour of Ethics credit
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, NASH, NB & WEB: Susan Progoff
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, NASH, NB & WEB: Susan Progoff
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: Amanda B. Weare
NY, ATL, IND, NASH, NB & WEB: Barry I. Slotnick
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, NASH, NB & WEB: Christopher R. Chase
SF & WEB: Bryan Thompson, Danika Vittitoe

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
CHI: Margaret M. Duncan
NY, ATL, IND, NASH, NB & WEB: Kristin Neuman
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, NASH, NB & 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: Champ W. Davis, Jr.
NY, ATL, IND, NASH, NB & WEB: David Rabinowitz
SF & WEB: Wendy Wen Yun Chang

5:00 Adjourn

“A very useful and informative training.”
– Megan Chang, Jones Day

“Excellent program. Loved the mock negotiation – very effective way to cover the material.”
– Todd Gwillim, Caterpillar Inc.

“One of the most useful PLI programs I have attended. Presentations and written materials were superior to PLI’s normally excellent offerings.”

“Great material.”
– 2016 Attendees
Morning Session:

9:00
INTERNATIONAL CONSIDERATIONS IN LICENSING
• How to approach the licensing of IP on a worldwide scale
• 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, NASH, NB & 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, NASH, NB & 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: Andrew E. Shipley

NEW YORK, SAN FRANCISCO, GROUPCAST LOCATIONS & LIVE WEBCAST
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, NASH, NB & 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, NASH, NB & 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
• 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
CHI: Marcelo Halpern

NEW YORK, GROUPCAST LOCATIONS & LIVE WEBCAST
2:30
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, NASH, NB & WEB: Ryan T. Colgan, Nicholas Vogt

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

3:30 Networking Break

3:45
MOCK NEGOTIATION OF A LICENSE AGREEMENT (NEW YORK – CONTINUED)
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• 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
CHI: Marcelo Halpern and Faculty
NY, ATL, IND, NASH, NB & WEB: Ryan T. Colgan, Nicholas Vogt
SF & WEB: Diana V. Sandoval, John Shinn, Karen Y. Spencer

4:45 Adjourn
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CHICAGO
November 2-3

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  - New York & Live Webcast
  - November 15, 2017

- **Open Source Software 2017 – From Compliance to Cooperation**
  - San Francisco & Live Webcast
  - December 20, 2017

- **Advanced Licensing Agreements 2018**
  - San Francisco
  - January 23-24, 2018
  - New York & Live Webcast
  - March 5-6, 2018
  - Chicago
  - May 10-11, 2018

- **Intellectual Property Rights Enforcement 2018**
  - New York & Live Webcast
  - January 25, 2018

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