

**Workshop**

## Contract Law & Risk Management for IP Professionals

**Level****Intermediate****Duration****2 days** – 8.30am to 5.00pm.**Program**

A detailed description of the workshop program is below.

**How this workshop helps IP and tech transfer Professionals**

A large part of this workshop was designed and developed in collaboration with a large university's tech transfer office and research office and has since been extended.

The catalyst for the development of this workshop was the university's assessment that its staff engaged in negotiating IP transactions were better equipped to do so when they had knowledge of aspects of the contractual legal environment in which the negotiation was conducted.

Its staff needed this legal knowledge to be equipped to deal more effectively with some of the legal implications of what they encountered.

An IP professional needs to have a working knowledge of those laws which impact upon the IP transactions they will be involved in. This workshop is about those laws.

Legal implications and potential liabilities do not start when the drafting of a contract commences. They start much earlier. There are legal implications to consider when formulating how to deal with the other party to a transaction. Even earlier, there are legal implications when formulating a research or tech transfer proposal to put before potential collaborators or industry partners.

They start when the negotiation starts, and sometimes earlier, when seeking potential commercial partners.

In this workshop we look at numerous research, collaboration and tech transfer case studies, and at the laws impacting upon the IP professionals that deal with these transactions.

**Customisation**

The content of this workshop can be changed and customised to enable specific learning objectives to be achieved.

**Presenter**

Philip Mendes

**Delivery style**

Interactive workshop style.

Emphasis on discussion, participants asking questions, contributing their comments, and sharing their experiences. We find that this interactive workshop style keeps participants alert and achieves a more effective learning and skills building outcome.

**Materials**

Each participant receives a set of bound workshop materials which will be an ongoing reference resource.

**Certificate of Completion**

A Certificate of Completion is provided to each participant.

## CONTRACT LAW & RISK MANAGEMENT FOR IP PROFESSIONALS

<b>DAY 1:</b>		
<b>8.30</b>	<b>Welcome and Registration</b>	Overview of the day.
<b>9.00</b>	<b>An agreement to agree is not an agreement</b>	Sometimes we may want to defer negotiating an issue because we recognise that the best time to properly negotiate it is at a later time when the parties are better informed. Can you do this and still have a binding agreement? Recognising and avoiding an agreement to agree. Proper mechanisms to defer the negotiation and still have a binding agreement. Case studies drawn from university transactions.
<b>9.30</b>	<b>Is an option to negotiate a license or a right of first refusal to negotiate a license legally valid?</b>	Options to negotiate a license and rights of first refusal to negotiate a license are commonly employed provisions in a material transfer agreement, a research agreement, and a collaboration agreement. These are binding obligations in US, Europe and China. Can you be liable in those countries even if you are located outside those countries? Case studies drawn from university transactions.
<b>10.30</b>	<b>How to form a legal binding contract</b>	Legal requirements to validly form a contract. How contracts can be valid even if no money is paid under the contract. Difference between Deeds and Agreements. Are deeds necessary? Can an agreement do just as well? Case studies drawn from university transactions.
<b>11.00</b>	<b>Morning Tea</b>	
<b>11.30</b>	<b>Binding and Non-Binding Term Sheets</b>	A Term Sheet is not normally intended to be legally binding. What if the other party wants it to be? Implications of it being binding. Making sure that you're not bound earlier than you want to be. Case studies drawn from university transactions.
<b>12.00</b>	<b>Avoiding a proposal being legally binding</b>	A Proposal is not usually thought of as being something that could become binding. It's only the first step after all. But it can be. Implications. Avoiding a proposal becoming binding. Case studies drawn from university transactions.
<b>12.30</b>	<b>Unintended side oral agreements</b>	Usually you don't intend to be bound until the contract is signed. But along the way to getting there, you might have agreed to something orally, and you are bound by it. Recognising and avoiding unintended side oral agreements. Case studies drawn from university transactions.
<b>1.00</b>	<b>Lunch</b>	
<b>2.00</b>	<b>Authority to enter into a contract</b>	Do academic staff have authority to sign a contract? Do academic staff have the ability to contractually bind a university? Delegation. Agency. Acting outside authority - potential liabilities of delegates and agents. Case studies drawn from university transactions.
<b>2.30</b>	<b>Execution of a contract</b>	How contracts can be binding even if they are not signed. Examples in a university context. The mechanics of contract formation. How universities sign contracts. How companies sign contracts. How Government signs contracts. How CRCs enter into contracts. Is a witness necessary? Legislation allowing the formation of contracts electronically. Case studies drawn from university transactions.
<b>3.00</b>	<b>Contract Terms, including implied terms</b>	Oral contracts. Contracts partly written and partly in writing. Contracts that must be in writing to be valid. What are express terms. What are implied terms. In what circumstances can terms be implied. Rules for the implication of terms. Case studies drawn from university transactions.
<b>3.30</b>	<b>Afternoon Tea</b>	
<b>4.00</b>	<b>Certainty and Precision in what you agree</b>	The outcome of a negotiation – what is agreed – needs to be drafted with precision. The lack of precision means that the parties are not bound. How to recognise when you have achieved the necessary level of precision, and when you have fallen short. Case studies drawn from university transactions.
<b>4.30</b>	<b>To What Extent Can you disclose without a Confidentiality Agreement</b>	How far can you go in making disclosures of confidential information with no Confidentiality Agreement, without prejudicing patentability, and without prejudicing your commercial interests.

5.00	<b>Do you have a duty of disclosure to the other party</b>	You know something that the other party does not know which may affect its attitude or decision making. Do you have to disclose it? Even if it is contrary to your own interests? Are there consequences if you don't? Case studies drawn from university transactions
5.30	Close	

<b>DAY 2:</b>		
9.00	<b>Misrepresentation, and misleading and deceptive conduct under Australian Consumer Law</b>	You don't have to intend to mislead for there to be a liability. How misrepresentations can arise, even unintentionally. Consequences of misrepresentation. How to manage and reduce the risk of misrepresentation. Case studies. Provisions of Australian Consumer law that apply to university contracts. How these work. Implications. Case studies drawn from university transactions.
10.30	Morning Tea	
11.00	<b>What non-lawyers need to know about negotiating risk allocation: releases, indemnities, and limitations on liability</b>	Risk allocation refers to where risk will lie in an agreement. Research agreements, collaboration agreements and license agreements considered. Risk can be allocated differently in relation to different issues in an agreement. How risk is customarily allocated in research and license agreements. How releases, indemnities and limitations of liability implement the risk allocation that is negotiated. Case studies drawn from university transactions.
12.30	Lunch	
1.30	<b>Terms that benefit third parties</b>	Overview of law about contract terms that seek to confer a benefit on third parties. States and Territories where such terms are valid. States and Territories where they are not. Implications for universities.
2.00	<b>Sub-contracting, assignment, novation</b>	Differences between each. Different legal effect of each. When to use one instead of another. Consent to sub-contracting and assignment. Meaning of consent not to be unreasonably withheld. Case studies drawn from university transactions.
2.30	<b>Alternative Dispute Resolution</b>	Alternatives to litigation. Dispute notification and mandatory cooling off. Negotiation of dispute. Assistance to resolve including conciliation and expert determination. Arbitration, advantages and disadvantages.
3.00	Afternoon Tea	
3.30	<b>Governing Law</b>	Choice of governing law. International treaties and bilateral agreements dealing with enforcement. Implications of agreeing to governing law being a country other than your own country. Taking away the controversy.
4.00	<b>Termination</b>	How and when to terminate an agreement. Usual termination models.
4.30	<b>Damages &amp; injunctions</b>	The consequences of breach. All about damages. All about Injunctions.
5.00	<b>Legal terminology and what they mean</b>	"Consent not to be unreasonably withheld" "Good faith" "Acting reasonably" "Best endeavors" "Material" etc. These are terms often used. What do they legally mean? Are they meaningless? The implications of employing them? Case studies.
5.30	Close	