

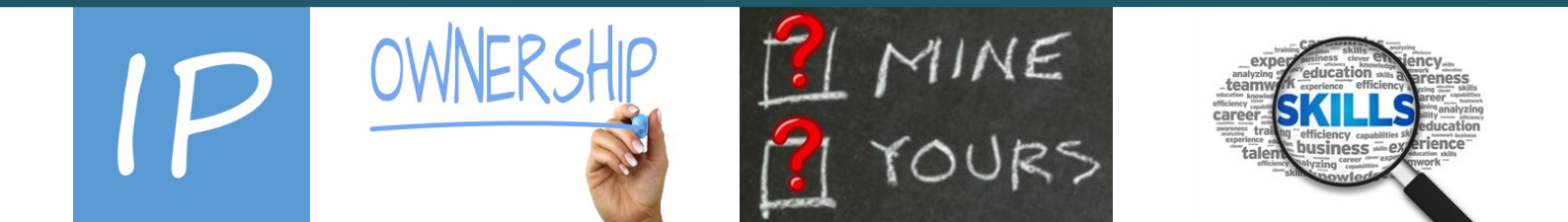
# Negotiating IP Ownership in JVs, Collaborations and R&D contracts

1 Day

Intensive

a workshop by Philip Mendes

Skills Development Workshop



Singapore

18 October 2019

Kuala Lumpur

21 October 2019

## About the Workshop

The ownership of intellectual property is often a controversial issue when negotiating:

- Joint Ventures
- Collaborations
- R&D Agreements.

Amongst the controversies:

- Should IP be owned by one party, or the other?
- Can IP rights to one party be negotiated instead of ownership?
- If so, what types of IP rights might be an acceptable substitute for IP ownership?
- What models to resolve IP ownership controversies are there?
- What are the advantages and disadvantages of particular models?

Sometimes parties agree to joint ownership in the expectation that joint ownership gives them equal and mutual rights.

But unharmonised joint ownership laws around the world affecting patents, copyright and confidential information more typically result in the parties having unequal rights. Often, joint ownership operates to the disadvantage of one joint owner, or even to the disadvantage of all the joint owners.

How should ownership of IP be allocated in collaborative research relationships?

- Should it be based on inventorship?
- Should it be based on whose IP is improved?
- Should ownership be based on the type or category of IP?
- Should ownership be joint?
- What models are available to allocate ownership in a collaborative research relationship?
- What influences one model being preferred over another?

This one day workshop focuses entirely on the controversial question of the ownership of intellectual property.

It will answer all these questions, and develop your knowledge and skills to negotiate this often controversial issue.

## Who is this Workshop for?

- All legal practitioners:
- Corporate counsel
  - Private practitioners.

## Your Presenter



Your presenter is Philip Mendes, an experienced IP professional who has negotiated intellectual property transactions for over 25 years with parties in over 25 countries. Philip has negotiated some of the largest intellectual property transactions arising from Australian research.

Transactions have been undertaken in all fields of science.

Philip has negotiated with multinational companies, Governments, large regional and national companies, down to small SMEs and start up companies.

Philip is an Adjunct Professor at Queensland University of Technology, where he teaches Management and Commercialisation of Intellectual Property. He has presented in excess of 200 licensing and intellectual property related workshops throughout Australia and Asia.

# Program

A detailed two page description of the program is available by clicking [here](#). Workshop highlights include:

## Joint ownership of IP, its unexpected commercial implications, what makes it unattractive - laws in specific countries considered:

Joint ownership of IP suggests that the joint owners have equal and mutual rights over the jointly owned IP. But unharmonised laws in different countries result in one joint owner being disadvantaged, or even all the joint owners being disadvantaged. Why joint ownership laws in other countries must be considered. Implications of joint ownership of patents, copyright, confidential information in various countries considered. Potential adverse financial and bargaining implications as a result of joint ownership. Recommendations for managing and dealing with joint ownership.

## IP Ownership models in JVs and collaborations :

Models for IP ownership in JVs and R&D collaborations – inventorship model; improvements model, category model, joint ownership model, joint venture company model. Criteria for selecting one model over another. Models for allocating joint ownership proportions between the joint owners

## IP Ownership and rights models in R&D Contracts

Models for IP ownership when contracting research and development with contract research organisations (for-profit companies), and non-for-profit universities, research institutes, and polytechnics. Factors influencing one model over another.

## Negotiating an alternative to IP ownership: Rights of First Refusal for a license and Options to Negotiate a License

How these are used in IP ownership negotiations. Their legal status considered in Singapore, Malaysia, United Kingdom, Australia, United States and Europe. Implications of unharmonised laws in relation to rights of first refusal and options to negotiate. Liabilities if obligations are breached. Adverse financial and bargaining implications of rights of first refusal and options to negotiate.

## Negotiating IP Ownership warranties

Customary warranties dealing with IP ownership in relation to different types of IP. Why different types of IP need warranties framed differently. When, how, and extent of qualifications to warranties. Approach to warranties in license agreements, collaboration agreements, and R&D agreements.

# Registration

## What registration includes

The Registration fee includes:

- attendance at the one day workshop
- detailed bound course materials that will be an ongoing reference resource
- a license to use the course materials
- lunch
- morning and afternoon refreshments.

## Registration fee

Public Sector Corporate Counsel (government, government agencies, universities, etc) (USD)	1st staff member	2nd staff member	3rd staff member	Each further staff member
Full registration fee	\$600.00	\$600.00	\$600.00	\$600.00
Group registration discount (10%, 20%, 30%)	-	-\$60.00	-\$120.00	-\$180.00
Total Registration Fee	\$600.00	\$540.00	\$480.00	\$420.00
If you need to catch a plane to attend our workshop, deduct 10% from the applicable fee above.				
Private sector corporate counsel and private sector practitioners (USD)	1st staff member	2nd staff member	3rd staff member	Each further staff member
Full registration fee	\$670.00	\$670.00	\$670.00	\$670.00
Group registration discount (10%, 20%, 30%)	-	-\$67.00	-\$134.00	-\$201.00
Total Registration Fee	\$670.00	\$603.00	\$536.00	\$469.00
If you need to catch a plane to attend our workshop, deduct 10% from the applicable fee above.				

## How to register

- [Click here](#) to register on line at the workshop website,
- Send an email to [joanne@opteon.com.au](mailto:joanne@opteon.com.au)



Visit us at [www.opteon.com.au](http://www.opteon.com.au)