

**Workshop**

Licensing Master Class

**For Tech Transfer Offices****Level****Advanced****Duration****2 days** – 8.45am to 5.00pm.

Optional third whole day Licensing Game to implement and put into practice the learnings of the previous two days.

Program

A detailed description of the workshop program is below.

How this workshop helps tech transfer professionals

The Licensing Master Class goes well beyond licensing basics.

Its aims are to:

1. improve the licensing skills of participants
2. help them recognise licence terms and issues that are disadvantageous, and how to deal with them
3. expand their toolbox of solutions to controversial and complex licence terms, and
4. help them achieve better outcomes in their licence negotiations.

Every part of a licence is examined in detail, particularly the controversial and complex aspects of a licence that can sometimes result in impasse or stressful negotiations.

A major focus of the workshop is to examine options for dealing with these controversial and complex licensing issues so that at the end of the workshop participants have an expanded toolbox of solutions that they can draw upon.

This workshop is suitable for novice licensing professionals wanting to accelerate their skills building.

This workshop is also suitable for experienced licensing professionals wanting to hone their licensing skills.

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.

LICENSING MASTER CLASS – *Negotiating Controversial and Complex Issues*
 [Times are approximate. Please expect that the duration of breaks may be shortened throughout the day]

8.45	Arrive	
9.00	Term, Licensee and Affiliates. Scope of Licensed Rights	Term. Option to extend term, and its operation. Can “irrevocable” or “perpetual” licenses be terminated ? Implications of a license to “Affiliates” and managing the risks of such a license. Controversial issues arising in relation to exclusivity, conversion from exclusive to non-exclusive, shades of exclusivity. Controversies in relation to Field limitations. Models for their solution.
	Subject matter of license grant	Controversial issues in relation to what is licensed: patents, scope of improvements, boundary between improvements and new IP. Licensors seeking to own improvements created by licensees. Licensee’s rights to new IP that is not an improvement and how they may be secured: First Look Rights, First Refusal Rights. Case studies considered.
10.30	Morning Tea	
11.00	Sub-licensing	Controversial issues arising in relation to sub-licensing. When it should be subject to consent, when not. Limitations on the power to give or withhold consent. What can be taken into account in giving or withholding consent. Conditional consent. Term and lapse of a sub-license. Step in rights if license is terminated – sub-licensee stepping into the shoes of the license, or vice-versa.
	Protection of IP	Controversial issues arising in relation to patent prosecution responsibility, patenting decision making, patenting expenses, maintenance of patents. Different models for Field limited licenses, non-exclusive licenses, etc.
	IP Infringements	Controversial issues and different models to deal with prosecuting infringers, maintaining proceedings / defense, various tiers of treatment, decision making, expenses, sharing damages. Treatment of field licenses, exclusive licenses, and non exclusive licenses.
12.30	Lunch	
1.30	Practical Exercise	Participants are divided into groups and allocated into negotiation teams, either as a licensor, or as a licensee. A problem will present impasses between the licensor and licensee on access to improvements and new IP, as well as the special challenges arising from exclusive patent field licenses, in relation to decision making on patent prosecution, costs on patent prosecution, pursuing infringers, etc. Participants, in their negotiation teams will be challenged to find solutions to those impasses.
3.00	Afternoon Tea	
3.30	Report back on Practical Exercise	Teams report back on the practical exercise, and discussion.
	Warranties	Controversial issues arising in relation to warranties, warranties for different types of IP, and different types of licenses, how made, whether qualified, and if so, how qualified. Minimizing and managing risk in relation to warranties. How warranties differ from one type of technology to another type. Examples given.
	Risk related provisions	Controversial issues arising in relation to releases, indemnities, limitation of liability, product liability, insurance. Mitigating risk. Minimizing and managing risks. Benchmarks for these terms. Control of proceedings, and decision making.
5.00	Close	

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9.00	Diligence Obligations in an exclusive license	The hardest part of a license to negotiate – diligence obligations upon a licensee: best endeavors; reasonable endeavors; commercialisation milestones; minimum sales obligations, and other minimum performance models. Consequences of failing to achieve diligence obligations. Case studies illustrating different models and the controversies and solutions that arose. Assessing the different models and their effectiveness.
	Competition law and anti-trust law	Recognising when specialist legal advice may be required from a competition lawyer. Overview of competition laws and anti-trust laws so far as they are relevant to licensing. Focus on US and European Union laws (and laws in the country where this workshop is presented, Australia, Singapore, Hong Kong, Malaysia, as the case may be). Permissible terms that will not risk contravention of competition laws. Dangerous terms that will. Consequences of a license that is not compliant with competition laws.
10.30	Morning Tea	
11.00	The financial terms of a license	An examination of 28 different types of royalty and other financial terms that may be employed in a license for maximum commercial return to the licensor. Types of licenses when they are likely to be encountered. A licensor's perspective, and a licensee's perspective on these terms. What royalties are calculated on. The financial terms in a strategic alliance, in addition to royalties, including loans, convertible notes, equity, purchase and lending of assets, and special terms in co-development and co-marketing relationships. Suspending royalty obligations. The impact of withholding tax, and how to deal with it in a license.
12.30	Lunch	
1.30	Confidentiality and publications	Controversial issues arising in relation to confidentiality, academic publishing, and treatment of students. Models for resolution of those controversies assessed and evaluated.
	Termination provisions	Controversial issues arising in relation to termination provisions including triggers for termination, rights on termination, obligations on termination.
	Governing Law in international licenses, and dispute resolution	Dispute resolution mechanisms. 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. How Governing Law can be made not to be a controversial issue
3.00	Afternoon Tea & negotiation	
3.30	Practical exercise	Participants are divided into groups and allocated into negotiation teams, either as a licensor, or as a licensee. A problem will present impasses between the licensor and licensee on diligence obligations, consequences of failing to comply, and termination triggers. Participants, in their negotiation teams will be challenged to find solutions to those impasses.
	Report back on Practical exercise	Teams report back on the practical exercise, and the outcomes of their negotiation.
5.00	Close	

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OPTIONAL THIRD DAY

LICENSING GAME

The objective of the optional licensing game is to give participants an opportunity to implement what they have learned during the workshop.

DAY 3: (optional)		
9.00	Introduction to Licensing Game and team allocations	Fact scenario distributed. Licensing game introduced. Participants divided into teams of 3 or 4 or 5. Concurrent negotiation take place to ensure that all participants are included.
9.20	Teams Strategy & Planning Meeting	Each team meets to consider the fact scenario, as either Licensor or Licensee, and their briefs. Team members identify the structure of the deal they want to achieve, formulate a strategy for the negotiation, and to achieve the objectives set out in their briefs. Philip Mendes offers guidance and comments during team strategy meetings.
10.30	Morning Tea	This is optional for participants. They often continue their strategy meeting during morning tea.
11.00	License Agreement Negotiation	The negotiation commences. Each team seeks to secure the license terms that their briefs require. To achieve the terms required, they will need to be inventive, lateral, and persuasive. Philip Mendes offers guidance and comments to teams during the negotiation.
12.30	Lunch	
1.30	License Agreement Negotiation continues	Negotiation continues. Additional dynamic problems arise in the course of the negotiation to simulate how negotiations occur in real life.
3.00	Afternoon Tea & negotiation	This is optional for participants. They often continue the negotiation during afternoon tea.
3.30	License Agreement Negotiation concludes	The negotiation wraps up and concludes at 4.00pm.
4.00	Discussion of Outcomes of Negotiation	The outcomes of the negotiation are discussed. Strategies employed are discussed, strategies that were well executed, as well as strategies that could improve. The outcome of the deal terms reached are also discussed.
5.00	Close & Optional drinks and awards	