

Best Practices in IP Licensing: How to Structure Deals and Avoid Pitfalls



ORIGINAL PROGRAM DATE

July 28, 2021

AVAILABLE MEDIA TYPES

Video & Audio MP3

*Presented in partnership with WSBA
Intellectual Property Section*

REPORTING YOUR CREDIT

This on-demand seminar was originally presented as a live webinar on July 28, 2021, in Seattle, WA. If you attended the live webinar and reported CLE credits, you cannot also report credits from watching or listening to this recording if repeated within your three year reporting period.

DESCRIPTION

There is no one-size-fits-all template for IP license agreements. With few exceptions, each one involves different parties trying to craft legal and business terms that address an ever-evolving technological landscape. Attendees of this seminar will hear from a diverse range of speakers familiar with negotiating these types of contracts in different settings. Speakers include, among others, global and U.S. licensing counsel at well-known companies and outside counsel experienced in the good (and bad) terms that often end up in IP agreements. The full-day program will cover:

- Deal terms and structures used to balance risk, the use of valuation as a negotiation tool, and the importance of appropriately balancing the financial terms when negotiating a license agreement
- Key transactional elements of a patent license agreement
- Impact of IP ownership and confidentiality and conflict issues from investments stemming from venture capital and corporate venture capital sources
- Spotting red-flag issues in European IP licenses and transactions

AGENDA

1 Spotting Red-Flag Issues in European IP Licenses & Transactions

This session will review sole, exclusive, and non-exclusive licenses (*Neurim v Mylan*) versus covenants not to sue. It will also cover the enforceability of restrictions based on national IP rights – territoriality and term as well as future and retrospective (confirmatory) assignments of IP, no-challenge clauses, and claw-back provisions. Finally, attendees will learn about the assignment of licensee improvements and something that is very relevant in light of recent events: licensing during a pandemic.

Martin MacLean – Mathys & Squire, London, England

Sean Leach – Mathys & Squire, London, England

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2 IP Licensing in Europe: Competition Law & Other Considerations

This session will consist of two parts. The first part will provide an overview of the interaction between patent licensing and EU competition law (anti-trust law). A primary focus will be the so-called 'block exemption regulation', which provides clear guidance as to acceptable and unacceptable license provisions and the associated 'do's' and 'don'ts' when drafting such agreements. The second part will focus on potential pitfalls when licensing other IP rights, such as trademarks, and how to avoid them.

David Hobson, Ph.D. - Mathys & Squire, London, England

Harry Rowe - Mathys & Squire, London, England

3 Employee Inventor Compensation

Chris Hamer - Mathys & Squire, London, England

4 In-House Counsel Perspectives on Licensing

A panel of in-house counsel will discuss licensing issues that cut across their different industries, best practices for working with business clients, and coordination with outside counsel. The presentation will include a guided Q&A moderated by John Wilson, partner at K&L Gates, followed by an open Q&A from the audience.

Caroline Bercier - Amazon, Seattle, WA

Alen Cisija - Seattle Seahawks, Seattle, WA

Janet Kim Lin, General Counsel for NCSOFT

Moderator: *John Wilson - K&L Gates LLP, Seattle, WA*

5 Intellectual Property & Web Scraping

As data becomes more valuable, it is becoming increasingly important to understand "web scraping," aka web harvesting or web data extraction, and its related intellectual property issues. This session will begin with a lawyer-friendly description of "what is web scraping?" and how it works. This talk will cover a variety of issues, including potential uses, benefits and impacts, case law, privacy concerns, and using web scraping to protect intellectual property.

Jared Lerner - Colgate-Palmolive Company, Morristown, NJ

6 Key Transactional Elements of a Patent License Agreement

This session will provide an overview of the topics that are typically negotiated heavily when drafting a Patent License Agreement, and why these topics are important to the licensor and the licensee for different types of licenses.

Rocco Adornato - Faurecia, Auburn Hills, MI