

IP Licensing in 2022



ORIGINAL PROGRAM DATE

July 15, 2022

AVAILABLE MEDIA TYPES

Video & Audio MP3

*Presented in partnership with WSBA
Intellectual Property Section*

REPORTING YOUR CREDIT

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DESCRIPTION

In this important annual update, you'll hear from colleagues and peers as close as Seattle and Kirkland and as far as Texas and London, all addressing current issues and key strategies in IP licensing. You'll also hear a report from a representative of the USPTO in Virginia.

AGENDA

1 The Unitary Patent, Unitary Patent Court & Licensing Implications

In this presentation, Mathys & Squire Partners Martin MacLean and David Hobson will discuss the imminent arrival of the Unitary Patent (UP) and Unitary Patent Court (UPC). The associated legislation will lead to the biggest changes to patent strategy in Europe for many years, and raises a host of new considerations for licensors and licensees. The aim of this presentation is to provide attendees with the necessary background to identify and pre-empt issues and confidently advise clients in the new "unitary" era of European patent law.

Dr. Martin MacLean - Mathys Squire, London, England

Dr. David Hobson - Mathys Squire, London, England

2 Compensation Considerations for Technology Licenses

The most important contractual language in technology IP licensing agreements are likely those provisions related to compensation - which lay out how payment is provided for the licensed intellectual property. In order to ensure that the contracting parties receive adequate economic value for the licensing deals they enter into, licensing attorneys must carefully negotiate and understand how compensation will be structured. This seminar will cover basic IP licensing compensation schemes such as royalties, equity, fixed payments and sublicensing income in IP licensing agreements, with a focus on patent and trade secret licensing in technology licenses.

Rahul Das - US Patent and Trademark Office, Alexandria, VA

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3 **Royalty Determination and Payment Structuring for Licensing and Litigation**

Royalty determination and payment structuring can be very challenging. Among the most challenging issues are finding the comparable market data and applying the data to your projects. Such issues can include: determining typical royalty rates, questions of license exclusivity, profit splits, types of payment structures. This data-driven and method-oriented session aims at helping you solve the real problems in your IP decision makings.

Dr. Jack Lu - IPMAP, LLC, Austin, TX

4 **How to Settle a Trademark Dispute: Licensing v. Coexistence**

Licensing and coexistence are two common ways to resolve trademark disputes. But each has its own risks and rewards. When should your client settle a matter by licensing its trademark? And what needs to go into that license to avoid loss of your client's trademark through naked licensing? When, on the other hand, does it make sense to settle through a coexistence agreement? And how can you avoid undermining future enforcement through that agreement?

Marc Levy - Seed IP Law Group, Seattle, WA

5 **Adding Value to IP Licenses Through Legal-Focused Provisions**

Attorneys often add the most value to licenses by carefully minding legal-focused provisions that are not part of the principal business arrangement, but that, nevertheless, can have a tremendous future impact on the client's business. This session will cover how some of the most significant such provisions can be structured, and their potential effects. Provisions addressed include ownership of new IP, control of IP, including enforcement and further licensing, indemnification and related limitations on liability and warranties, and choice of law/forum selection/dispute clauses.

Michelle LeCointe - Seed IP Law Group, Seattle, WA

6 **Supreme Court decisions on IP Licensing and their Impact on IP Licensing Practice**

The panel will discuss Supreme Court decisions related to IP licensing and how the decisions have impacted or might impact in-house counsel's practices.

Jeff Danley - Seed IP Law Group, Seattle, WA

Syed Abedi - Seed IP Law Group, Seattle, WA

Dr. Connie Wan - Seattle Gummy Company, Seattle, WA