

Advanced Licensing Agreements 2010

San Francisco, February 25-26, 2010

Live Webcast, February 25-26, 2010 — www.pli.edu

New York City, March 25-26, 2010

Chicago, April 26-27, 2010

Earn
One Full Hour
of Ethics
Credit

- *New:* Understand the Treatment of IP Licenses in Bankruptcy
- Comprehensive Coverage of Every Angle of Licensing: Patent, Technology, Trade Secrets, Copyright, Content, Trademark, Software, Strategic Alliances, Joint Development, Databases, Open Source, Litigation, Negotiation Skills and Tactics
- Tailor the Content to Your Needs with Breakouts:
 - Asia or Europe – Review Similarities and Differences between Domestic and International Licensing
 - Content or Technology – Participate in an Instructive Analysis and Mock Negotiation of a License Agreement

Do You Know There Are 5 Ways To Attend PLI's Programs? *See inside for details...*

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Why You Should Attend

Companies have always used licensing to obtain technology and content outside their core areas or at lower cost, and/or to monetize their own offerings. In the current era of falling budgets and the need to replace lost revenue, this has become more important than ever. Whether licensing patents, copyrights, trade secrets or trademarks, the ability to structure, draft and negotiate complex license agreements is critical to a successful transaction. This program is designed to address some of the more complex as well as practical issues that arise in drafting and negotiating IP licenses. The program will feature updates on current legal developments, best practices, negotiating frequently contested issues, identifying and avoiding common pitfalls, keeping the relationship on track, litigation planning and avoidance, and ethics. The speakers will illustrate both outside counsel and in-house perspectives.

What You Will Learn

- Learn how to draft patent and technology licenses
- Understand critical issues regarding software licensing and open source licenses
- Obtain pointers for strategic alliances and other joint development agreements
- Receive guidelines for trade secret licensing
- Analyze important issues in international licensing
- Get guidance on copyright, content, and trademark licensing
- Master negotiation strategies

Special Features

- In-depth panel discussion of a complex technology license
- In-depth mock negotiation of a complex content license
- Treatment of IP licenses in bankruptcy
- Earn ethics credit

Who Should Attend

This advanced program is focused on those who already have experience in the substantive area of intellectual property law, and who devote a substantial amount of their practice to licensing.

Sally M. Abel

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California

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Tercica, Inc.
Brisbane, California

Guy Heath

Nabarro LLP
London

Paul H. Arne

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Author, *Patent Licensing*
• *Strategy* • *Negotiation* • *Forms*
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Patrick J. Whalen

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PROGRAM SCHEDULE

DAY ONE: 9:00 A.M. – 5:15 P.M.

Morning Session: 9:00 a.m. – 1:00 p.m.

9:00 Introduction

SF, NYC, CHI & WEB: Ira J. Levy, Joseph Yang

9:15 Patent and Technology Licensing

- Avoiding the most frequently made mistakes
- Technology vs. IP vs. blended licenses
- Why patent licensing is different
- Understanding grant types and degrees of exclusivity
- Indemnification and change of control issues
- Negotiation strategies
- Comparing licensee and licensor perspectives

SF, NYC, CHI & WEB: Joseph Yang

10:15 Special Issues in Trade Secret Licensing

- Differences in protection from state to state
- Differences in enforcement from state to state
- Protecting the trade secret in case of unauthorized disclosure
- Drafting considerations and sample clauses
- Special considerations compared to licensing other IP asset types

SF, NYC & WEB: Peter J. Kinsella

CHI: Patrick J. Whalen

11:15 Networking Break

11:30 Copyright, Content, and Trademark Licensing

- Old media vs. new media, e-publishing and *Tasini* issues
- Digital rights management (DRM) and related issues
- Licensing rights in preexisting content vs. newly created content
- The latest on quality control considerations
- The latest on trademark licensing
- Sample licensing provisions
- Case law update and licensing implications

SF & WEB: Sally M. Abel, Kenneth M. Kaufman

NYC: Stephen G. Charkoudian,

Kenneth M. Kaufman

CHI: Kenneth M. Kaufman, Daliah Saper

1:00 Lunch

Afternoon Session 2:00 p.m. – 5:15 p.m.

2:00 Software Licensing

- Source code issues
- Representations, warranties and indemnification
- Revenue sharing and auditing
- Training and support
- Keeping the relationship on track

SF, NYC, CHI & WEB: Mark S. Holmes

3:00 Networking Break

3:15 BREAKOUTS

I. Analysis of a Content License Agreement

- Walkthrough and mock negotiation of a complex content license agreement by an expert panel
- Structuring IP rights allocation
- Negotiating multimedia rights
- Allocating merchandising rights
- Negotiating creative control issues
- Funding and royalty sharing considerations
- Interplay of technology and content issues for digital content

SF & WEB: Kenneth M. Kaufman,

Katherine C. Spelman, Mark G. Tratos

NYC: Rose Auslander, Kenneth M. Kaufman,

Jonathan Sirota

CHI: Kenneth M. Kaufman, Jessica L. Rothstein,

Katherine C. Spelman, Mark G. Tratos

II. Analysis of a Technology License Agreement

- Common pitfalls
- Confidentiality and trade secret issues
- Exclusivity
- Restricted fields of use
- Specifications
- Warranties and indemnification

SF & WEB: Lucy J. Billings, Mark S. Holmes,

Marc P. Schuyler

NYC: Melvin C. Garner, Mark S. Holmes,

Rory J. Radding

CHI: Clinton H. Hallman, Jr., Mark S. Holmes,

Sarah R. Iles

4:15 Strategic Alliances and Other Joint Development Agreements

- IP creation conflicts: Default laws vs. parties' intentions
- IP allocation: Joint ownership vs. field-based ownership vs. separate entity
- IP enforcement: Contractual provisions; unauthorized licensees; joinder requirements
- IP de-allocation: Facilitating or inhibiting separation; bankruptcy
- Interplay with IP asset management
- Corporate vs. university partners
- "War stories" from real life deals

SF, NYC, CHI & WEB: Joseph Yang

5:15 Adjourn

Please plan to arrive with enough time to register before the conference begins.
A networking breakfast will be available upon your arrival.

DAY TWO: 9:00 A.M. – 4:30 P.M.

Morning Session: 9:00 a.m. – 12:15 p.m.

9:00 **Database License Agreements/ Open Source Issues**

- Database protection under U.S. and EU law
- Key points in negotiating database licenses
- Recent developments in database protection and litigation
- Recent developments in legal enforceability of open source licenses
- Comparing popular open source licenses
- Patent issues in open source licenses

SF & WEB: Christian H. Nadan, Mark G. Tratos

NYC: Paul H. Arne, Jeffrey D. Neuburger

CHI: David G. Rickerby, Mark G. Tratos

10:00 **Litigation Planning for Licensing Lawyers**

- Warranties, indemnification and other frequently litigated provisions
- Pitfalls, and examples, of sloppy wording
- Contra proferentum and other contract interpretation doctrines
- Alternative dispute resolution
- Case law update
- Foreign litigants and/or venues

SF, NYC, CHI & WEB: Ira J. Levy

11:00 *Networking Break*

11:15 **BREAKOUTS**

I. International Licensing – Asia

- Similarities and differences between domestic and Asian licensing
- Common pitfalls for U.S. lawyers doing Asian deals
- Licensing in Asia
- Cultural issues in Asian transactions

SF, NYC & WEB: Naomi Abe Voegtli

CHI: Rory J. Radding

II. International Licensing – Europe

- Similarities and differences between domestic and European licensing
- Common pitfalls for U.S. lawyers doing European deals
- Licensing in Europe
- Cultural issues in European transactions

SF & WEB: Guy Heath

NYC: Jeremy Schrire

CHI: Sally Shorthose

12:15 *Lunch*

Afternoon Session: 1:15 p.m. – 4:30 p.m.

1:15 **Treatment of IP Licenses in Bankruptcy**

- Basic concepts relevant to transactions
- Restructuring vs. liquidation
- Protecting the licensee against licensor bankruptcy
- Protecting the licensor against licensee bankruptcy
- Different treatment for different kinds of IP
- Different treatment in the various circuits

SF & WEB: Suzzanne Ubland

NYC: Karen Artz Ash

CHI: Steve Jakubowski

2:15 *Networking Break*

2:30 **Negotiation Skills and Tactics**

- How to prepare for license negotiations
- How to use psychological tools as part of your negotiation strategy
- Consensus and bridge building
- Differences between integrative (“win-win”) and positional bargaining, and when to use each

SF & WEB: Donna Shestowsky

NYC: Harry Rubin

CHI: Marcelo Halpern

3:30 **Ethical Considerations in Licensing**

- Drafting in anticipation/avoidance of litigation
- What happens when a friendly deal turns litigious
- Deceit and candor
- Cross-border transactions
- Communications with adverse parties

SF, CHI & WEB: Ira J. Levy

NYC: David Rabinowitz

4:30 *Adjourn*

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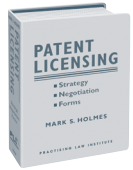
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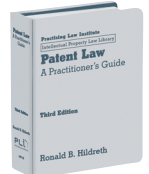


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