

LICENSING BASICS

8.45	Arrive	
9.00	License or Assign?	What is a license. Risks of assigning IP for royalties and why you should always license instead.
	Term. Exclusivity. Field. Territory.	Term. Can “irrevocable” or “perpetual” licenses be terminated? Exclusivity. Non-exclusive licenses. Field limitations. Territory Limitations. Scope of Rights. Implications of a license to “Affiliates”
	Sub-licensing	How sub-licensing works. 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.
10.30	Morning Tea	
11.00	Step in rights	Step in rights if license is terminated – sub-licensee stepping into the shoes of the licensor, or vice-versa? Implications.
	Protection of IP	Patent prosecution responsibility, patenting decision making, patenting expenses, maintenance of patents. Different patent protection models and costs for Field limited licenses, patent costs for non-exclusive licenses, etc.
	IP Infringement	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 licensees
	Confidentiality, publications, students	Confidentiality, academic publishing, and treatment of students. Models for resolution of those controversies assessed and evaluated.
12.30	Lunch	
1.30	Financial terms of a license – the basics	Front-end loaded financial terms, back-end loaded financial terms. Royalty on sales, royalty on sub-license income. Up-front payments. Milestone payments. What royalties are calculated on. Minimum annual payments.
	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.
	Expiration and Termination	Expiration. Termination provisions and triggers for termination. Obligations after termination.
	Assignment and Novation	Differences between each. Different legal affect of each. When to use one instead of another. Consent to assignment.
3.00	Afternoon Tea	
3.30	Unique terms of non-exclusive licenses	The unique terms customarily included in a non-exclusive license. What does “most favoured nation” mean? Suspension of royalties if an infringer is not prosecuted, and when reinstated. Prosecution of patents. Costs of patent prosecution. Treatment of infringers.
	Unique terms of Inter-Institutional Agreements (which are effectively licenses)	An Inter-Institutional Agreement is a license between joint owners of IP, all of which are research organisations. They cannot commercialise “by committee” so the joint owners select one of their number to be the commercialisation lead and grant it a license. Unique terms of Inter-Institutional Agreements considered.
5.00	Close	

LICENSING – ADVANCED

8.45	Arrive	
9.00	The financial terms of a license – optimising royalty and other financial terms for the licensor	How royalties are tagged. Royalties payable only if an infringement test is passed v Royalties if a use test is passed. Getting royalties in countries where you have no patents. Reach through royalties on income enabled by the license. Optimising royalties by measuring the quantity of use of the IP. Royalties on bundled or combination products. Royalty stacking. Five royalty traps to avoid.
10.30	Morning Tea	
11.00	Dealing with demands to include Improvements and Future IP in the license	Avoiding these demands. How to deal with them when made. Boundary between improvements and New IP. Licensed for free or for additional royalties? Licensors seeking to own improvements created by licensees. Implications.
	Reserving research rights	Why licensors must retain the right to use for research purposes, and the right to sub-license collaborators. Inadequacy of licensors' statutory rights to use IP for research purposes.
	Diligence Obligations in an exclusive license – the hardest part of a license to negotiate. Models for Diligence Obligations	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.
12.30	Lunch	
1.30	What Non Lawyers must Know About Managing Risk, and Risk Allocation: Releases, limitations of Liability and Indemnities	Risk allocation refers to where risk will lie in an agreement. Research agreements, collaboration agreements and license agreements considered. Risk can be allocated differently in relation to different issues in an agreement. How risk is customarily allocated in research and license agreements. How releases, indemnities and limitations of liability implement the risk allocation that is negotiated. Case studies drawn from university transactions.
	Managing the risk of misrepresentation and misleading and deceptive conduct	You don't have to intend to misrepresent or mislead or deceive. How misrepresentations can arise, even unintentionally. Consequences of misrepresentation. How to manage and reduce the risk of misrepresentation. Case studies. Strategies to Minimise the risk of misrepresentation / misleading and deceptive conduct.
3.00	Afternoon Tea	
3.30	What Non Lawyers must know about the impact of competition rules upon License Agreement terms. Traps for the unwary	A checklist of license terms prohibited by competition laws in Australia (with which all licenses must comply) and competition laws in US and Europe (with which a license encompassing those territories must comply, eg a worldwide license). A second checklist of license terms that require an evaluation to determine if they contravene competition laws in Australia, US and Europe. Traps for the unwary.
	Governing Law need not be controversial	Implications of agreeing to governing law being the other party's country. How Governing Law can be negotiated without controversy.
5.00	Close	