

CRAFTING PATENT LICENCE AGREEMENTS

4 December 2007, Conf. No. H12-3407

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If you have NOT received confirmation seven days after registering, please contact Registration Department.

REGISTRATION INFORMATION

Dates

4 December 2007 Start: 09.30 – Finish: 17.00

Registration & Coffee 09.00

Venue

The Rembrandt Hotel, 11 Thurloe Place, London SW7.

Directions

Opposite V&A Museum.

Nearest Underground station: South Kensington.

Map available on Website under Hotels and Venues.

Accommodation

A limited number of bedrooms have been reserved at The Rembrandt Hotel, 11 Thurloe Place, London SW7, at a special rate of £123.41 (superior) inc. English breakfast, £144.69 (executive) inc. English breakfast. All +17.5% VAT – subject to availability.

Hotel Tel: +44(0)20 7589 8100.

Hotel Fax: +44(0)20 7225 3363.

Email: reservations_rembbrandt@sarova.co.uk

All bookings should be made directly with the hotel quoting Management Forum and your credit card number.

Fee

£545 +17.5% VAT. The fee includes course documentation as well as mid-session refreshments and lunch. Invoice and confirmation will be forwarded to you.

10% Early Bird discount if you book before:

9 October 2007 and tick this box .

(Discount only applies to full delegate rate).

Conference No. H12-3407

Discounted Rates

Available on application for personnel from non-profit making organisations and registered charities.

Group discount available on request.

Cancellation Policy:

Over 14 days prior to the Seminar: Cancellation fee of £75. 7/14 days prior to the Seminar: 50% of the fee.

Fewer than 7 days or if no notification received:

Registrant liable to pay FULL seminar fee.

NB: Cancellations must be received in writing by lesley@management-forum.co.uk.

In the event of circumstances beyond its control, Management Forum reserves the right to alter the programme, the speakers, the date or the venue.

Early booking recommended

CRAFTING PATENT LICENCE AGREEMENTS

Basic principles and best practice

- **Crafting Words to Represent ‘the Business Deal’**
- **Addressing both the Legal and Practical Concerns**
- **European Issues**
- **US Issues**
- **International Issues**
- **Ethics**

With:

Bradley Hulbert McDonnell Boehnen Hulbert & Berghoff, Chicago

Hayley French Novartis International AG, Basel

4 December 2007

The Rembrandt Hotel, London

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OBJECTIVE

A well-crafted patent licence agreement is fundamental to monetising a patent or ensuring a lasting settlement of an infringement assertion. The unique nature of patents and patent law, together with interplay of patents with antitrust, accounting, enforcement and international law issues, typically make drafting a proper patent licence a challenging exercise, even for those with substantial experience.

This course provides a clause-by-clause analysis of the key elements in a well-crafted patent licence agreement. It consistently stresses the dual goals of meeting practical, business objectives while establishing a logical and enforceable legal framework. Concrete, textual examples of patent licence provisions are stressed throughout the seminar.

WHO SHOULD ATTEND

Patent professionals and other all those responsible for drawing up or overseeing patent licence agreements. Experienced licensing professionals will gain fresh insights. Professionals with less experience will learn a framework for analysing the relevant issues in a patent licence and become better at both recognising subtle problems and drafting optimum solutions.

ATTENDANCE LIMITED – EARLY REGISTRATION RECOMMENDED

This limitation, a unique feature of all MANAGEMENT FORUM seminars will give participants the opportunity for a thorough discussion of the complex issues to be covered by the programme.

Law Society Accreditation – 5½ hours

Please quote ref. CJA/MAFO.

SPEAKERS

Bradley Hulbert is a partner in McDonnell Boehnen Hulbert & Berghoff LLP, a 75-lawyer patent law firm in Chicago. He has crafted hundreds of successful patent license agreements and is the Chair-Elect of the High Tech Sector of the Licensing Executives Society (US and Canada). He is also an adjunct professor of law and Director, Academic and Professional Program Development, at the Chicago-Kent Law School.

Hayley French moved to her present post at the Basel headquarters of Novartis International AG in Switzerland in August 2007, having formerly been an associate in the Life Sciences group of Bird & Bird, London. After obtaining a PhD in microbiology and an MSc in intellectual property she then joined University College London Ventures for five years and was responsible for the commercialisation of inventions in the Life Sciences sector. Prior to joining Bird & Bird, she worked at the Centre for Applied Microbiology and Research (CAMR) as Head of Legal Affairs. She is a Board member and Chair of the Website Committee for the Licensing Executives Society (LES) Britain and Ireland and Vice Chair of the European Committee for LES International.

DOCUMENTATION

Delegates will receive a course material folder containing comprehensive documentation provided by the speakers, which will be a valuable source of reference for the future.

A Certificate of Attendance for Professional Development will be given to each participant who completes the course.

PROGRAMME

▶ Basic Tenets

- Choose the type of licence: Exclusive/non-exclusive licence; covenant-no-to-sue, cross-licence, sub-licence, implied licence, shop right; foundry rights
- Draft language that is brief but complete: Avoid unhelpful ambiguities

SHORT EXAMPLES OF BOTH VAGUE AND CLEAR LANGUAGE

▶ Representing ‘the Business Deal’

- Preamble; recitals
- Definition of patented product/method
- Grant clause
- Reservations
- Release
- Payment and royalty options
- Reach-through clauses and rights to improvements
- Escalation provisions
- ‘Follow-up’ and accounting issues

SHORT EXAMPLES OF BOTH CARELESS AND EFFECTIVE LANGUAGE

▶ Addressing the Legal Concerns

- Indemnification
- Representations and Warranties
- Best efforts requirements
- Assignment of a licence
- Consequences of patent exhaustion

- Bankruptcy implications
- Most favoured licensee provision
- Termination
- Future Modification
- Confidentiality

SHORT EXAMPLES OF HOW TO HANDLE COMMON CONCERNS

▶ European Issues

- Treaty of Rome
- Articles 30, 36, 81 and 82 on the restriction of trade
- European Commission and Court of Justice

▶ US Issues

- Controlling licensee repudiation after *MedImmune*
- Misuse and antitrust considerations
- Marking requirements
- Options for Alternative Dispute Resolution

▶ International Issues

- Official language
- Choice of law
- Forum for enforcement and litigation
- Export Control regulations
- ‘Gray market’ controls

COMPARISONS OF ETHICAL AND IMPROPER ASSERTIONS

- Puffing and material misrepresentations during negotiation