



Presented by
Management Forum

Drafting International Intellectual Property Agreements

11-12 July 2024
+ 14 November 2024

This course focuses on the drafting skills and legal and commercial issues to be considered when drawing up international IP agreements.



Format:
Live online, Classroom



CPD:
6 hours for your records



Certificate of
completion

Course overview

The world's national laws surrounding intellectual property have become more and more consistent over recent years but, whilst this is helpful to a large extent, it also sets the scene for numerous misunderstandings and disputes.

This practical course has been designed to focus on the drafting skills and legal and commercial issues to be considered when drawing up international IP agreements. If you are doing business in a complex multi-jurisdictional environment you need to know how to address difficult situations when designing and negotiating IP-related agreements in cross-border projects.

Learn about the different types of IP agreements and how to protect and exploit your rights to the best advantage for your business through carefully worded clauses. The use of practical exercises using example clauses will be worked through and discussed to embed and consolidate learning.

Key topics to be covered include:

- The legal framework for international IP agreements
- Dealing with patents, trade marks, trade secrets and domain names
- The dangers and opportunities of IP agreement templates
- Commercial expectations and industry sector differences
- Key terms, choice of law and jurisdiction
- Contentious IP contracts and dispute resolution
- Forbidden clauses – competition law issues
- Brexit-proofing your agreements

Benefits of attending

By attending this course you will:

- **Increase** your knowledge of the legal and commercial issues surrounding international IP agreements
- **Improve** your drafting skills by understanding the risks and opportunities
- **Benefit** from an update on the laws affecting international IP agreements
- **Review** competition law issues in relation to IP agreements
- **Understand** the potential impact of Brexit on your IP agreements
- **Consolidate** your learning with practical exercises on drafting clauses
- **Compare** and discuss your experiences with other delegates and the expert faculty

Who should attend?

This course has been specifically designed for:

- Patent attorneys
- In-house lawyers
- Legal executives
- Commercial and contracts managers
- Clinical and IP contract specialists
- Product development managers
- Research managers

And other professionals who are involved in drafting or managing commercial IP agreements.

Programme

Welcome and introduction to the course

- Summary of the topics to be covered

General Aspects of IP Agreements

- Types of IP
- General drafting tips
- Assignments vs licences

Types of licences

- Non-Exclusive, Exclusive, Covenant not to Sue
- Field of Use license, Cross license, Compulsory license
- Sublicences, 'Have Made' right, Foundary Agreements

Elements of the agreement - part 1

- Preamble
- Recitals
- Definitions

Elements of the agreement - part 2

- Grant Clause
- Reservations
- Releases
- Improvements

Practical exercise on drafting international IP agreements

Elements of the agreement - part 3

- Financial Terms
- Royalty Stacking
- Reporting
- Auditing

Elements of the agreement - part 4

- Representations and Warranties
- Assignment
- Term & Termination
- Choice of Law

Dispute resolution in agreements

- Choice of Forum
- Arbitration vs. Litigation
- Arbitration Clauses
- Other ADR (eg mediation, executive negotiation)

Practical exercise on drafting international IP agreements

Presenters



Brian Kacedon

Brian Kacedon, Partner at Finnegan and based in New York, is a recognized authority in IP transactions. He has drafted and negotiated hundreds of agreements across all technologies and is designated as a Certified Licensing Professional (CLP). Brian has also successfully litigated multiple lawsuits and arbitrations based on his extensive transactional experience.

Brian focuses on patent and technology licensing and litigation. In his transactional practice, Brian assists clients in conducting market assessments for their patents, conducts licensing negotiations, drafts licensing agreements, and participates in related litigations. He routinely negotiates and drafts complex license and collaboration agreements for both small and large pharmaceutical companies, many with total payments of hundreds of millions of dollars. Brian's experience includes setting up and directing international patent licensing and enforcement programs, including one that resulted in more than 500 license agreements.

Over the course of his career, Brian has drafted hundreds of patent, know-how, and software license agreements as well as joint development, collaboration, and settlement agreements for many industries, including pharmaceutical, medical device, software and consumer electronics. He has assisted several leading technology companies in negotiating and drafting licenses for wireless technologies, as well as navigated related standards-setting issues.

Brian has extensive experience litigating agreement disputes. He has appeared as counsel in multiple litigations and arbitrations, including a trade secret misappropriation, for clients in industries ranging from pharmaceuticals to semiconductors. Brian has also been retained as an expert witness relating to the interpretation of license agreements.



Anthony D Del Monaco

Anthony Del Monaco, Partner at Finnegan's, practice involves all facets of intellectual property law in a wide spectrum of technologies. He focuses on patent litigation, primarily before U.S. district courts and the U.S. International Trade Commission (ITC), and arbitrations. His practice also includes inter partes reviews (IPRs), opinions of counsel, patent and trademark portfolio development, and complex licensing issues.

Anthony's litigation experience is expansive. He has been admitted *pro hac vice* to practice in, for example, the District of Nevada, District of Delaware, and Eastern District of Texas. He has also participated in over a dozen ITC investigations and appeared in over a half dozen ITC hearings. He has had key responsibilities in all aspects of litigations, from the initial pleading stage through discovery, motions, claim construction, and trial. Anthony has experience working with a broad range of technologies, including mechanical, electrical, medical devices, commercial devices, automotive components, and gaming.

Aside from litigation, Anthony provides strategic guidance to clients on infringement, validity, and enforceability issues, along with post-grant proceedings and licensing negotiations. He has given lectures on intellectual property law around the world, including in the United States, Asia, Europe, and the Middle East.

Anthony currently serves as an associate adjunct professor at American University Washington College of Law, where he teaches a course on intellectual property practice at the ITC. During law school, Anthony spent a semester externing for Judge Arthur J. Gajarsa at the U.S. Court of Appeals for the Federal Circuit. Before practicing as a lawyer, he worked as an environmental engineer and project management expert in the wastewater treatment and construction industries, respectively.

Presenters



Cara Regan

Cara Regan is an Associate at Finnegan, Henderson, Farabow, Garrett & Dunner, LLP. She works on patent and trade secret litigation at every stage, from the strategic decision to file a proceeding through appeal. Her experience includes district court and International Trade Commission (ITC) actions; post-grant challenges at the Patent Trial and Appeal Board (PTAB); and appeals at the U.S. Court of Appeals for the Federal Circuit, where she clerked.

Cara has been involved in district court proceedings, ITC investigations, contentious proceedings before the U.S. Patent and Trademark Office (USPTO), and appeals. She has experience with pre-suit due diligence, discovery, depositions, claim construction, summary judgment motions, *Daubert* motions, and post-trial briefing, as well as with managing related PTAB proceedings and pursuing appeals. She also assists clients in evaluating infringement risks and negotiating license agreements. Her technical expertise encompasses a wide range of technologies, including medical devices, software, mobile phones, laptops, automobiles, and consumer products.

Course dates

11-12 July 2024

Live online

13:30-17:00 **UK (London)** (UTC+01)

Course code 13681

GBP **599**

EUR **859**

USD **979**

14 November 2024

Classroom

London

Course code 14043

GBP **599** ~~699~~

EUR **839** ~~979~~

USD **934** ~~1,090~~

Until 10 Oct

How to book



Online:

ipi.academy/1593

Alternatively contact us to book, or if you have any queries:



Email:

info@ipi.academy



Phone:

[+44 \(0\)20 7749 4749](tel:+442077494749)

Discounts

- Booking more than one delegate on any one date qualifies for a **15% discount** on the second and subsequent places.
- Most events qualify for an **early booking discount** prior to 6 weeks before the course date. Be sure to check on our website, where the latest discounts will be shown.

Further information

Fee

The fee includes all meals and refreshments for the duration of the course (for venue-based courses) and a complete set of course materials (provided electronically). If you have any particular requirements, please advise customer services when booking.

Please note

IPI Academy (and our training partners) reserve the right to change the content and timing of the programme, the speakers, the date and venue due to reasons beyond their control. In the unlikely event that the course is cancelled, we will refund the registration fee and disclaim any further liability.

Terms and conditions

The rest of our terms, the event cancellation policy and the terms and conditions are on our website, please visit ipi.academy/content/terms-and-conditions

Reviews



Overall, the webinar was interesting and well structured and the speaker well-prepared and competent.



Antonia Cavedon
Assistant Contracts Officer
European Space Agency
Nov 11 2020



The speakers are very knowledgeable, they explained complex issues very clearly and the use of practical examples helped to better understand the topics discussed..



Melissa Medina
Patent Assistant
Bavarian Nordic AS
Nov 11 2020



The slides and their presentation were very clear and concise.



Julie Sommer
Patent Specialist
Valneva Austria GmbH
May 16 2019



The course fulfilled my expectations. Knowledgeable speakers and a nice atmosphere.



Kim Den Hertog
Trademark Counsel
adidas International Marketing BV
May 16 2019

Run this programme in-house for your whole team

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IPI
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IPI Academy is a training initiative of Falconbury and Management Forum; leading providers of industry training for over 30 years, based in the UK.

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