IPI Academy

MANAGEMENT forum

*Presented by*
**Management Forum**

# IP Due Diligence & Freedom to Operate in Practice

**4 June 2024**
+ 23-24 September 2024, 4 December 2024

This intensive one-day course will give you many insights into the best practice of organising and conducting an efficient and thorough IP due diligence project.

**Format:**
Classroom, Live online

**CPD:**
6 hours for your records

Certificate of completion

# Course overview

A properly conducted due diligence search can lead to many opportunities for both buyers and sellers, including long-term relationships and new business synergies, and this intensive one-day course will give you invaluable insight into the best practice of organising and conducting an efficient and thorough IP due diligence project.

Attending this event will ensure that you know how to mitigate the risks involved and will give you practical advice on balancing internal resources and outside expertise to the best advantage. The programme will help you understand the vital aspects of an FTO analysis from a US and EU perspective.

You will also benefit from the experience of the expert faculty during the discussion session and get the solutions you need to your questions.

**Key topics to be covered include:**

- Types of IP due diligence
  - Mergers and acquisitions
  - Sale of IP assets
  - Freedom to operate (FTO)
- Best practices for organising an IP due diligence project
  - Developing comprehensive checklists
  - Aligning project scope with business goals
- Parts of a due diligence evaluation
  - Evaluating the patent portfolio
  - Mitigating the risks
  - Communicating results
- Focus on FTO projects
  - Best practices for when to do and how to do an FTO analysis
  - Validity and infringement analysis: US and European perspectives
  - US options for dealing with blocking patents
  - Dealing with FTO risks: never black and white

## Benefits of attending

By attending this one-day intensive seminar, you will:

- **Gain** practical advice from highly rated experts on how best to prepare for your due diligence and FTO projects
- **Learn** to identify when due diligence and FTO projects are desirable and how to determine what the scope should be
- **Improve** your understanding of the risks around ownership and learn how to minimise these risks
- **Communicate** due diligence results effectively while protecting confidential and privileged information
- **Understand** your obligations if the deal doesn't go through
- **Be prepared** for the FTO questions that will be raised by your client/company when they want to use new technology or expand existing technology
- **Understand** which FTO questions you should ask to make the most of your time and budget
- **Discuss** best practices for setting up and conducting a thorough analysis
- **Gain** valuable insight into infringement and validity analysis in Europe and the US
- **Take away** practical advice on leveraging the European and US systems to your advantage
- **Learn** to evaluate, minimise and communicate risk effectively

## Who should attend?

- Patent attorneys
- In-house lawyers
- Business development executives/managers
- IP and patent managers
- Licensing executives
- Trade mark attorneys

# Programme

**Best practices for organising and conducting an IP due diligence project**

- Understanding the business goals
- Practical issues regarding accessing information
- Privilege and confidentiality issues
- Developing a comprehensive due diligence checklist to determine project scope under different deal conditions and budgets
- Awareness of relevant US IP issues frequently encountered
- Potential pitfalls when involving company's technical persons: a list of 'do nots'

**In-house perspectives on conducting IP due diligence and FTO projects**

- Role of IP – risk factor, nice to have or deal driver?
- Coordination of the projects within various business units
- Balancing internal resources with expertise of outside counsel
- Impact of IP due diligence and FTO projects on IP awareness within the business units

**Mitigating the identified risks**

- Real examples will be used to illustrate the types of risks that generally arise and how to restructure or end a deal having significant risks
  - How much risk is too much?
  - What if you are asked to make the deal happen even if the risk is high?
  - Can you mitigate that risk?

**Communicating results and post-deal issues**

- Confidentiality obligations if the underlying deal does not go through
- Handling negative information
- Obligations that remain if the deal is successful
- Practical aspects of file retention

**Vital aspects of an FTO analysis – US perspective**

- Tactics for recognising the products and processes to be cleared
- Timing and scope of the project
- Defining the search – common pitfalls
- Validity and infringement analysis – tactics for 'triage' on the FTO search results
  - US perspectives on relevant legal issues
- Cost-effective approach for dealing with potentially problematic or 'blocking' patents
  - US perspectives on relevant legal issues

**Vital aspects of an FTO analysis – EP perspective**

- Strategies for analysing whether EP infringement and validity issues in FTO context
- Recognising the risks in different EP jurisdictions
- EP options for dealing with competitor patents
- Best practices for EP counsel and in-house teams

**FTO from the perspective of a licensing company**

- Selection and prioritisation of technologies for FTO
- Interaction of FTO and trade secrets

# Presenters

**Tim May**

4 Jun 2024
23-24 Sep 2024
4 Dec 2024

Timothy May is a partner in the Washington, DC office of Finnegan LLP. He has over 20 years experience in the field of US patent law, with significant experience counselling clients on software patent matters. Tim currently manages the patent portfolios for several European clients in various software, medical device and electrical and mechanical technologies. He regularly speaks on software patent issues. Prior to joining the firm, he served as a Patent Examiner at the US Patent and Trademark Office, where he examined applications involving digital and software technologies. From 2006 to 2011, Tim was located in the firm's European office and continues to work with many European clients.

**Andy Spurr**

4 Jun 2024
23-24 Sep 2024
4 Dec 2024

Andy Spurr is a patent attorney at Canon Europe, specialising in software related inventions with a particular focus on video encoding and standard essential patents. Before joining Canon, Andy spent 8 years at a private practice IP firm where he worked with numerous software start-ups, advising on how to best leverage their IP to create commercial value.

**Tim Whitfield**

23-24 Sep 2024
4 Dec 2024

Tim Whitfield is a partner with Powell Gilbert LLP. He advises clients in contentious IP matters across all IP rights with a strong focus on patent litigation and strategy, across a wide range of technologies, especially disputes having an international element in the pharmaceutical sector. He represents clients in cases before the English Courts and the European Patent Office. He has very extensive experience of advising clients on the co-ordination of international patent litigation strategy including in the pharmaceutical, medical devices and electronics fields. Tim also advises on related issues arising from international technology standards, patent pools and licensing, as well as pharmaceutical regulatory issues and SPCs. Tim also has experience of patent portfolio due diligence projects, contentious design right issues and trade mark infringement disputes.

# Course dates

| | | |
|---|---|---|
| **4 June 2024** | **Classroom**<br>London<br>*Course code 13701* | GBP **599** ~~699~~<br>EUR **869** ~~1,009~~<br>USD **993** ~~1,149~~<br>**Until 30 Apr** |
| **23-24 September 2024** | **Live online**<br>13:00-17:30 **UK (London)** (UTC+01)<br>*Course code 13889* | GBP **499** ~~599~~<br>EUR **719** ~~859~~<br>USD **823** ~~979~~<br>**Until 19 Aug** |
| **4 December 2024** | **Classroom**<br>London<br>*Course code 14082* | GBP **599** ~~699~~<br>EUR **869** ~~1,009~~<br>USD **993** ~~1,149~~<br>**Until 30 Oct** |

## How to book

**Online:**
ipi.academy/2377

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

**Email:**
info@ipi.academy

**Phone:**
+44 (0)20 7749 4749

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

# Reviews

★★★★★

**Very interesting and inspiring course and very good speakers!**

**Maria Alessandra Alisi**
INT. PROP. & COMP. INTELLIGENCE MANAGER
Angelini Pharma S.p.A.
Sep 26 2022

---

★★★★★

**Excellent training. The fact that several caselaw and practices were confronted (US, UK , EPO, DE) and also some speaker working in the industry, other working in IP firm. It was enriching to have those different point of view.**

**Marie Guilmard**
Industrial Property & Trademarks Manager
AXENS
Sep 26 2022

---

★★★★★

**it was a good mixture of different aspects of this rather complex issue**

**Paul Barbic**
Treibacher Industrie AG
Dec 1 2021

---

★★★★★

**All the speakers seemed well prepared and gave good presentations. Overall, this course was excellent in providing knowledge about different types of DD and FTO in the main jurisdictions and how to practically conduct such tasks. Very good speakers, updated and good course material.**

**Synnøve Flister**
European Patent Attorney
Zacco Norway AS
Nov 14 2019

## Run this programme in-house for your whole team

Coming to IPI Academy for your in-house training provides an all-inclusive service which gives you access to a wide variety of content, learning platforms and delivery mechanisms as well as your own personal training adviser who will work with you from the initial enquiry through to feedback and follow-up after the programme.

With over 600 trainers, all practitioners and experts across a huge range of fields, we can provide the training you need, where you need it, when you need it, and at a price which suits your budget. Our approach to tailored learning and development consists of designing and delivering the appropriate solution for each client.

For your FREE consultation and to find out more about how we can work with you to solve your training needs, please contact our training advisers:

**ALEKSANDRA BEER**
**Tel:** +44 (0)20 7749 4749
**Email:** inhouse@ipi.academy

**YESIM NURKO**
**Tel:** +44 (0)20 7749 4749
**Email:** inhouse@ipi.academy

IPI Academy

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

10-12 Rivington Street
London EC2A 3DU

ipi.academy
**Tel:** +44 (0)20 7749 4749
**Email:** info@ipi.academy