

# THE OSGOODE CERTIFICATE IN INTELLECTUAL PROPERTY LICENSING

*“The professors and professionals are extremely knowledgeable and will be valuable assets moving forward.”*

Heather Boyd, Principal, Pillar IP, Inc.

Do you have the skills and knowledge you need to confidently negotiate and draft IP licenses?

Join senior legal and IP specialists in this intensive Certificate program – carefully structured to equip you with in-depth knowledge of licensing agreements and key strategies you need to effectively structure, negotiate and draft IP licenses and to carry-out more effective due diligence on IP assets, including:

- Essentials of each type of IP and the underlying considerations
- Avoiding common drafting and negotiating mistakes
- Negotiating royalties, payment and audit terms
- Critical issues: insolvency, tax, consulting agreements and cross-border licensing

Register today at:

[osgoodepd.ca/iplicensing](https://osgoodepd.ca/iplicensing)

## PROGRAM CHAIR

P. Bradley Limpert  
Limpert & Associates

## REGISTRATION OPTIONS

- 5 Online Primers (On Demand)
- 3 Live Online Modules  
October 19, 26 and  
November 9, 2022
- Skills Workshop Live Online\*  
November 30, 2022  
*\*Live attendance required*

*Can't make the date?*

*Registration includes 120-day unlimited, online access to the recorded program.*



# The Osgoode Certificate in Intellectual Property Licensing

Register today at:

[osgoodepd.ca/  
iplicensing](https://osgoodepd.ca/iplicensing)

Reserve your place now to take advantage of this unique opportunity to enhance your experience and learning:

- 5 Online Primers (On Demand)
- 3 One-Day Modules of lectures and demonstrations (Live Online)
- Modules drafting assignment to reinforce key concepts
- Skills Workshop (Live Online)\*

*\*Live attendance required*

Licensing IP is challenging and complex. An organization's assets include many types of IP, and since multiple types of IP often form part of a single transaction. As a lawyer in private practice or as a legal or business professional working within an organization, protecting and exploiting IP assets is a critical function for your company or client. Stakes can be high and mistakes can be very costly.

## Are you prepared?

Whether negotiating and drafting IP license agreements as the licensee or licensor, you need to know what to look for to anticipate problems, cover-off key points and effectively protect your client's interests.

This practical, hands-on Certificate – delivered online over 4 non-consecutive days – will give you the knowledge and skills you need to competently and confidently handle IP licensing matters and to carry-out more effective due diligence on IP assets. Featuring unique, skills-based **learn-by-doing workshops**, you will benefit from personalized feedback that will enable you to rapidly improve and refine your drafting and negotiating skills.

**NOTE:** It is expected that delegates will have some **background** in either **intellectual property** or **contract drafting**. If a delegate does not have any such background, the time required to complete the drafting assignment may be significantly increased. Visit [osgoodepd.ca/graduate-programs-and-courses/admissions-requirements/](https://osgoodepd.ca/graduate-programs-and-courses/admissions-requirements/) for English Language requirements.



## Get practical tips, knowledge and strategies in areas including:

- The essentials of each type of IP
- How to identify underlying IP and chain of title issues
- Avoiding common drafting and negotiation mistakes
- The do's and don'ts of reps, warranties, indemnities and other remedies
- Critical considerations for License Grant and Scope of Use Clauses
- How to negotiate royalties, payment and audit terms
- The impact of insolvency and understanding tax issues
- Key issues in cross-border licensing

**PLUS!** You'll receive beneficial electronic materials, **precedents** and **templates** that will act as valuable resources and reference guides.

*“This is an excellent program [and] all the information was very useful. It covers clauses and details that lawyers generally take for granted. There were a lot of practical examples used. For example, in the royalties section, it really helped to get an auditor's point of view. I believe this is extremely important for lawyers as it helps us understand the practical aspects related to payments.”*

Meenakshi Tewari, Sole Practitioner, Jham Law Office

## Who Should Attend

- Lawyers who advise on IP licensing
- In-house counsel, executives and professionals managing IP licensing
- Licensing and sales professionals
- Contract managers and professionals
- Patent Agents and Trademark Agents
- Technology transfer or commercialization professionals
- Procurement professionals involved with IP assets, software or licenses
- Venture Capitalists, Private Equity and Investment Analysts
- Angel Investors

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iplicensing](https://osgoodepd.ca/iplicensing)

# Drawing on the expertise and experience of leading IP lawyers and experts, including:

## Program Director



**P. Bradley Limpert**  
Limpert & Associates

Brad Limpert is a lawyer, patent agent and engineer. On behalf of his clients, he has obtained IP rights and licensed and litigated those rights. Brad has been recognized by IAM as one of the world's Top 250 Technology Lawyers & Patent Licensing Lawyers.

Brad received the 2017 Award for Outstanding Contribution to Continuing Legal Education by Osgoode Professional Development.

He is also a Certified Licensing Professional and part-time General Counsel & VP, Strategy and Planning at Psiphon Inc., with extensive experience in litigation and dispute resolution involving licensing transactions, as well as valuation and acquisition of technology assets.

Brad has advised on 500+ licensing transactions, in diverse areas such as biotechnology, software, industrial equipment, consulting methodologies, chemical engineering, Greentech and e-commerce.

He is the author of *Technology Contracting*, published by Thomson Reuters, a leading Canadian looseleaf dealing with many types of licensing.

## Program Faculty

**John Birch**  
Cassels Brock & Blackwell LLP

**Sarah Brouwer**  
Legal Counsel, CIPP/C, Septodont

**Keith Desjardins**  
Gowling WLG

**Andrea Kroetch**  
Stikeman Elliott LLP

**Jason Leung**  
Leung Law PC

**P. Bradley Limpert**  
Limpert & Associates

**Jennifer MacInnis**  
Senior Legal Counsel & Assistant Board Secretary,  
Office of the General Counsel and Board  
Secretariat, Toronto Metropolitan University

**Laila Paszti**  
Kirkland & Ellis LLP

**Stephen Spracklin**  
Legal Counsel IT Law, City of Mississauga

**Bob Tarantino**  
Dentons Canada LLP

**Glenn Tautrimis**  
Director, Global Royalty Audits, Inc.

**Essien Udokang**  
Senior Director, Legal Affairs,  
Retail Business, McKesson Canada

*“The heavy interactions and the amount of feedback and discussion was unparalleled. The role playing in the negotiations. The down to earth information about IP and the licensing of it sets the tone and foundation.”*

*“Excellent teachers, very pertinent and the scope of the program englobes everything important.”*

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# Agenda

## ONLINE PRIMERS IN IP FUNDAMENTALS

(On Demand)

**Minimum 3 of 5 Online Primers must be viewed for the Certificate. You will have access to all 5 Online Primers On Demand.**

*We recommend that you view the Online Primers before Module 1.*

Successful licensing requires sound knowledge of the principles defining various IP rights. These 5 Online Primers (1-hour each) focus on the key elements likely to be at issue in any licensing situation. View anytime online.

Topics include:

- Key Patent Concepts
- The Elements of Trademarks
- The Essentials of Copyright
- Trade Secrets and Confidential Information
- Industrial Designs

## MODULE 1

October 19, 2022

(Live Online)

8:30 a.m. – 5:00 p.m. ET

### The Foundation of Your License Agreement: The Grant Clauses

#### Drafting Assignment: Distribution

The drafting assignment completed between program modules will be distributed and discussed in Module 1. This assignment is expected to take about 3-4 hours to complete. It will be discussed again briefly during Modules 2 and 3, and it will be due by November 16, 2022.

#### Identifying Underlying IP and Chain of Title Issues

Develop a sound approach to your IP licensing transaction, including an essential checklist to determine the precise nature, scope, validity, and ownership of the subject IP.

#### The License Grant and Scope of Use Clauses: Critical Considerations at the Core of Your Agreement

Regardless of IP type, your negotiating and drafting will focus on the scope of the license and the precise extent of the license grant. Expert faculty will guide you through the parameters of the grant and scope of license, with specific sessions focusing on issues unique to each IP type.

#### Demonstration: Negotiating and Drafting the License Grant and Scope of Use Clauses

Utilizing samples from various types of licensing arrangements, the faculty will demonstrate and discuss negotiation approaches and specific language examples for the license grant and scope clauses.

## MODULE 2

October 26, 2022

(Live Online)

8:30 a.m. – 4:30 p.m. ET

### Common Clauses in all IP License Agreements

#### Drafting Assignment: Discussion/Q&A

You will have the chance to clarify your questions about the drafting assignment. This assignment is expected to take about 3-4 hours to complete. It will be discussed again briefly during Module 3, and it will be due by November 16, 2022.

#### International Licensing: Key Issues

Many IP licenses involve foreign entities and IP. Learn key issues when licensing with other jurisdictions, including:

- Significance of choice of law, forum and choice of venue
- Overview of “need to know” cross-border issues

- Regulatory restrictions and traps
- Impacts of different IP laws, competition laws, export controls, and sanctions

#### Representations and Warranties in the License Agreement

A practical session on the do’s and don’ts of reps and warranties. Highly experienced counsel will share tips on getting the best possible protection and ensuring you don’t promise what you cannot give or miss an opportunity for fulsome disclosure.

#### IP Strategy

- Focus will be on 3 key strategic issues: freedom to operate; ability to design/create around, and; strength of the rights
- Non-practicing entities: trolls or defenders of justice?
- Role of complementary assets
- Difficult decisions around prior art searching
- Filing strategies

#### Indemnities and Other Remedies: Constructing the Safety Net

- Risk allocation: what’s fair, what’s achievable
- Indemnity for breach of contract; personal injury and negligence
- Use and abuse of liquidated damages clauses
- Tips on using or refusing specified remedies

#### Avoiding Common Drafting Mistakes in IP Licenses

This session considers common drafting mistakes in licenses for patents, copyright, trade-secrets, trademarks and industrial designs. You will also learn how to identify and eliminate unwanted ambiguity in your licenses.

## Royalty, Payment and Audit Terms

Negotiating payment terms for the use of IP is complex. Licensors want to receive the compensation they expect and licensees don't want to overpay. This session will guide you through the various nuances.

### MODULE 3

November 9, 2022

(Live Online)

8:30 a.m. – 4:45 p.m. ET

## The Life and Death of Your Licensing Agreement

### Drafting Assignment Deadline

You will have a final chance to clarify your outstanding drafting assignment questions during this Module 3. The assignment is expected to take about 3-4 hours to complete and it will be due by November 16, 2022.

### Risks to Licensors and Licensees from Insolvency Proceedings

- Main types of insolvency proceedings
- Why contractual rights are no longer sacred: disclaimers and involuntary assignments
- The new statutory duty of good faith
- A quick primer on U.S. insolvency principles
- Best practices to minimize potential harm

### Tax Issues and License Agreements

- Income Tax: sales
- Income Tax: licensing
- How does sales tax apply to sales proceeds and royalties?
- Non-resident tax
- Cross-border planning

### Despite All Best Intentions: Renegotiation and Dispute Resolution

- How to decide whether and when to renegotiate
- Assessing leverage and tips to “pre-load” leverage
- Alternatives to standard dispute resolution
- Critical information you need to support renegotiations
- ADR/Mediation/Arbitration

### Term, Termination and Renewal of the License

- Determining the term of license
- Implied termination or renewal rights
- Termination mechanisms where there is a breach
- Winding-down provisions

### Negotiating Techniques

- BATNA, ZOPA and other key negotiation concepts
- Positional vs. win-win negotiating
- Negotiating processes and approaches
- Key attributes of a successful negotiator

### Consulting Agreements

- Default IP ownership for consulting projects
- Resolving the consultant-client tug-of-war over IP
- Evolving business models for consultants

### Demonstration: Negotiating and Drafting Indemnities

Faculty will demonstrate licensee/licensor perspectives in negotiating indemnities clauses, linking interests to specific language and highlight drafting pitfalls. Includes precedents.

### MODULE 4

November 30, 2022

(Live Online – *attendance is mandatory*)

9:00 a.m. – 5:00 p.m. ET

## Interactive Drafting and Negotiation Workshop

You will apply what you've learned and reinforce key concepts learned throughout the Certificate by working in interactive, small group workshops, and you will also observe an Advanced Negotiation Techniques presentation.

### DRAFTING WORKSHOP AND ASSIGNMENT REVIEW: Scope of License Grant and Termination

In small groups, you will get personalized feedback on your drafting assignment from our expert faculty and discuss common drafting pitfalls and model drafting clauses.

### Instructional Session: Advanced Negotiation Techniques

Building on Negotiating Techniques delivered in Module 3, you will learn:

- Self-assessment techniques
- Techniques for effective negotiation
- Game Theory and Behavioural Economics for negotiation

### NEGOTIATION WORKSHOP: Tying it All Together (Mock Negotiation)

In small groups, you will engage in a mock negotiation representing either the vendor or customer. You will receive individualized support and feedback from an expert facilitator and benefit from a master debrief and group discussion.

Register today at:

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iplicensing](https://osgoodepd.ca/iplicensing)

# Registration Details

**Fee per Delegate: \$3,495 plus tax**

**Newly Licensed\*: 50% off regular rate plus tax**

*\*This fee applies to newly licensed professionals within the past 2 years*

Fees include attendance, electronic program materials, technical support and 120-day access to the program archive. Group discounts are available. Visit [www.osgoodepd.ca/group-discounts](http://www.osgoodepd.ca/group-discounts) for details.

## Financial Assistance

This program is eligible for OSAP funding. Federal and provincial job grants may be available. You may also apply for financial assistance with OsgoodePD. To learn more, visit: [www.osgoodepd.ca/financial-assistance](http://www.osgoodepd.ca/financial-assistance).

## Program Changes

We will make every effort to present the program as advertised, but it may be necessary to change the date, location, speakers or content with little or no notice. In the event of program cancellation, York University's and Osgoode Hall Law School's liability is limited to reimbursement of paid fees.

## Cancellations and Substitutions

Substitution of registrants is permitted at any time. If you are unable to find a substitute, a full refund is available if a cancellation request is received in writing 21 days prior to the program date. If a cancellation request is made with less than 21 days notice, a \$150 administration fee will apply. No other refund is available.

## For Further Program-Related Information, Please Contact:

Myrsini Zacharakis, Program Lawyer at 416-278-7721  
or email [mzacharakis@osgoode.yorku.ca](mailto:mzacharakis@osgoode.yorku.ca)


# Certificate of Program Completion

You will receive an Osgoode Certificate upon completion of the **Osgoode Certificate in Intellectual Property Licensing** as follows: (1) View 3 of 5 Online Primers (2) View Modules 1-2 (live online or via recorded archive) (3) Complete and pass the take-home drafting assignment (4) Attend and participate in Module 4 drafting workshop (live online). Module 4 **MUST** be done live online on November 30, 2022.

Register today at:

[osgoodepd.ca/iplicensing](http://osgoodepd.ca/iplicensing)

 **Email:** [osgoodepd@osgoode.yorku.ca](mailto:osgoodepd@osgoode.yorku.ca)

 **Phone:** 416 597 9724

 **Mail:** 1 Dundas Street West, 26th Floor, Toronto, ON, M5G 1Z3



OsgoodePD has been approved as an Accredited Provider of Professionalism Content by the LSO.



PROGRAM TOTAL (Includes 3 Online Primers) – LSO (ON): 31h 45m CPD (28h 45m Substantive; 3h Professionalism)

ONLINE PRIMERS – LSO (ON): 3h CPD (1h Substantive per Primer, must view any 3 of 5)



OsgoodePD programs may be eligible for CPD/MCLE credits in other Canadian and US jurisdictions. To inquire about credit eligibility, please contact [cpd@osgoode.yorku.ca](mailto:cpd@osgoode.yorku.ca).

This program is approved for LAWPRO Risk Management Credit.

The program assumes that delegates will have some **background** in either **intellectual property** or **contract drafting**. If a delegate does not have any such background, the time required to complete the drafting assignment may be significantly increased.

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*“Excellent knowledge. Great tips on the applications needed and the language used in each country. All are great at engaging class participation [and] I really enjoyed how they discussed what is ideal in negotiation and what actually happens [and] how the law is upheld and what the standard practises are in the real world.”*

**Vivian Punzalan**  
ProperVu Inc.