20 Pitfalls in Patent Licensing

TOPICS
- Traps in exclusive and non-exclusive licenses
- Wrong definitions, wrong point of reference
- License-back-clause pitfall, free cross-license pitfall
- Price reduction trap, payment for know-how, issues with royalty payment, indemnification trap
- General pitfalls to avoid
- Mock Negotiation

YOUR SPEAKERS

Michael H. Baniak
Chief IP Counsel Global,
EOS North America,
Novi, Michigan (USA)

Dr Alfredo Barona, LL.M.
Legal Counsel,
Robert Bosch GmbH,
Stuttgart (Germany)

Florian Lindner
IP Licensing Specialist, Legal Counsel,
EOS GmbH, Krailling/Munich (Germany)
Aims and objectives

In patent (and trade secret) licensing contracts, there are basically two major areas where mistakes and missteps can occur: legal handicraft mistakes and business misjudgments. While legal handicraft mistakes result in a contract not expressing what was or may have been intended by the parties, business misjudgments waste potential, at least for one party, and can lead very early to a bad end in that specific business relationship. Either sort of mistake will be costly no matter what.

This seminar thus focuses on 20 clearly identifiable pitfalls which anyone involved in IP licensing should know, and be able to avoid. (The speakers may even include some bonus pitfalls, if you are good!) Some may appear quite obvious. They should be, but wait! A deeper dive reveals even more nuances to be considered.

The speakers shall share their many decades of experience, covering hundreds and hundreds of IP licenses that they have crafted, analyzed, litigated, and learned from.

Who should attend?

You are tasked with negotiating and drafting patent license agreements and would like to avoid the most common pitfalls? Then this course is intended for you. Knowledge of patent law is required. This course is especially interesting for those working in IP, patent, legal, R&D and business development departments and in private practice as patent attorneys and attorneys-at-law.

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About your speakers

As the Chief IP Counsel Global for EOS, an international company engaged in the additive manufacture industry, Mike has provided counsel on, and negotiated and written, hundreds of technology transfer agreements and arrangements of virtually all types. He has been listed among IAM 250 World’s Leading Patent and Technology Licensing Lawyers.

Alfredo is a German qualified lawyer working for Bosch for over 13 years. He started at the Intellectual Property Department where he was responsible for negotiating and drafting all kinds of IP agreements. After a four years stay in the Compliance Department where he primarily built up the compliance team for a Bosch business division, he now mainly advises on IP aspects in sales agreements with automotive customers of Bosch within the Legal Department.

Florian is a German Counsel Lawyer and Senior Licensing Counsel. For several years, he has been negotiating and drafting patent licenses at EOS. Before, he gathered experience in a patent exploitation agency.
Your agenda

13 May 2020, 09:00-17:00

Wrong Definitions, Wrong Point of Reference
• Wrong definition of technical scope of license (1)
• Wrong point of reference for licensing product (2)

Traps in Exclusive Licenses
• Bear in mind the difference between exclusive and sole license (3)
• Neglecting safety clauses (4)

Traps in Non-Exclusive Licenses
• Not having most favored nations clause as licensee (5)
• No means to attack patent violator (6)

Price Reduction trap, Payment Issues, Indemnification Trap
• Leaving loopholes for licensee to reduce price for license product in unfair way (7)
• Scope of the license does not equal the scope of obligation to pay royalties: are you licensing rights you don't need, or even have? (8)
• Licensee’s business model gets ruined because 3rd party IP rights have to be licensed-in later (9)
• Paying for know-how in case patent is shaky (10)
• The licensor agrees to indemnify the licensee against patent infringement: yes, but really? (11)

License-Back-Clause Pitfall
• No license-back-clause for improvements by licensee, what about those improvements by licensor? (12)

Free Cross-Licenses with Companies outside Europe - Pitfalls
• Not evaluating value of patents, potential tax fraud (13)

General Pitfalls to Avoid
• Arbitration clauses: good, bad and ugly (14)
• No termination for the licensee, especially if licensing for know-how and trade secrets (15)
• Unattractive business model for licensee in the long run (16)
• Assignment clauses: 'what do you mean you just got acquired by my biggest competitor?' Or, 'what do you mean I can't transfer this to my acquirer?' (17)
• 'Licensing out technology supposed to be exclusive (18)

Wasting precious time
• Wrong approach in dealing with inexperienced parties (19)
• Unclear responsibilities and lack of organized proceeding (20)

Mock Licensing Negotiation in Groups
• One side tries to take advantage over the other party: Real bad draft of licensing contract for the other side.
REGISTRATION FORM

Yes, I will attend

☐ 20 Pitfalls in Patent Licensing
   13 May 2020 in Heidelberg

☐ Yes, I agree that FORUM Institut may inform me about events by:
   □ email; and/or □ telephone.
   I may withdraw my consent at any time.

Name

Position, department

Company

Street

Post code, city, country

Tel. no./Fax no.

E-mail

Contact person at office

Date, signature

Date and venue

Wednesday, 13 May 2020 in Heidelberg
09:00-17:00

Heidelberg Marriott Hotel
Vangerowstr. 16 · 69115 Heidelberg
Tel. +49 6221 908-0 · Fax +49 6221 908-660

Fee

€ 1,090.00 (+ German VAT)

The fee includes course documentation (including free download) as well as refreshments, lunch and a certificate. You will receive an invoice as well as confirmation.

CANCELLATION POLICY

Our general terms and conditions (as of 1 January 2016) apply and are available upon request. We can send them to you at any time. Alternatively, you can access them online at www.forum-institut.com/t&c

YOUR CONTACT

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