



UCL Institute of Brand & Innovation Law

IP Transactions: Law and Practice

A five-day course for IP Practitioners
15 - 19 April 2024



UCL

FOCUS ON IP TRANSACTIONS

Drafting, negotiating, interpreting and advising on intellectual property (IP) agreements requires a special set of legal skills. In addition to understanding relevant provisions of IP law, practitioners need to be familiar with a wide range of commercial law subjects, including personal property, contracts, competition, insolvency, tax, employment, and various areas of regulation, such as data protection and export controls. To advise effectively on IP transactions, it is also necessary to be aware of commercial practice in the relevant industry sector.

The mix of legal and practice issues that transactional IP lawyers face can be very different from those experienced by IP litigators or general company/commercial lawyers. Understandably, traditional IP law courses focus on a wide range of IP issues such as subsistence, validity, infringement and enforcement, and spend relatively little time on transactional aspects. Commercial law courses may use examples from the field of IP transactions, but tend not to focus exclusively on this area.

Our course has been designed to focus on the legal and practice issues that are directly relevant to transactional IP practitioners.

The course has a strong focus on the needs of practitioners who are in the early stages of a career in IP transactions. We have assumed that most people attending it will be qualified English solicitors and barristers, typically with between zero and two years' post-qualification experience, although more experienced practitioners are welcome. Other IP practitioners, including patent attorneys, trade mark attorneys and licensing executives, will find the course useful, provided they have an understanding of the basic elements of contract law and IP law, and have had some exposure to IP transactions. Overseas practising lawyers who wish to learn more about English law in this area, are also welcome.

FEEDBACK & AWARDS

IP Transactions Course

The legal aspects of the course focus on English law. We recognise that many IP transactions are international, and that practitioners often have to consider questions of non-English law, in consultation with overseas colleagues. For this reason, we have included a session on dispute resolution, including choice of law and jurisdiction and, in other sessions, we make occasional reference to differences under other systems of law. At the same time, we intend to avoid diluting the usefulness of the legal content by making it generically "international".

There are no formal entry requirements for the course, but it is designed for IP practitioners as described above. Applicants will be asked to provide a short CV that demonstrates their suitability for entry on the course, including that they are in legal practice in the IP field, and a short personal statement that indicates what they hope to achieve from attending it. We reserve the right to reject any application.

If the course is oversubscribed, we also reserve the right to select the students that we consider to be most suitable.

Learning Hours

29 learning hours

"I think it was pitched well for both those who may be working in a certain area and those who are not."

"The course was really fantastic and I thoroughly enjoyed it."

"I will thoroughly recommend this course to others in the future, including future IP lawyers at my firm."

"I had a fabulous time and took plenty away with me that I have used."

"I thought the organisation, course materials, quality of speakers and facilities were all excellent, many thanks!"

"I found it a very useful course and the course material a great reference guide."



UCL Provosts Teaching Award 2014:

CPD & Short Course Winner

THE TUTORS

Course director



Mark Anderson

Managing Partner, Anderson Law LLP
Visiting Professor, UCL Faculty of Laws

Author of
Technology Transfer (Bloomsbury, 4th edition, 2019)
Drafting Agreements in the Biotechnology and
Pharmaceutical Industries (Oxford University Press, loose-leaf)
Drafting Confidentiality Agreements (Law Society Publishing, 3rd
edn, 2014) and other texts on commercial and IP transactions
Founder of the IP Draughts blog:
www.ipdraughts.wordpress.com

Highly recommended for UK patent licensing by IAM Patent 1000
– Guide to the World's Patent Practitioners

Anderson Law LLP is ranked as a national leader in IP law by
Chambers Directory, and Mark is ranked for both IP and Life
Sciences.

Certified Licensing Professional™ and Registered
Technology Transfer Professional



The Rt Hon Professor Sir Robin Jacob QC

Sir Hugh Laddie Chair of IP Law at UCL
Director of the Institute of Brand and Innovation Law
President of the Licensing Executives Society (UK and Ireland)

This year's tutors provisionally include:

Gina Bicknell, Partner, Pinsent Mason. Gina has 20 years of experience in cross-border technology transactions, including joint ventures, complex licensing and other commercial arrangements, and IP and separation aspects of mergers and acquisitions. She works in many technology areas, but her particular expertise is in the pharmaceutical and chemicals industries. She also advises on IP protection strategies and data privacy matters. Previously, Gina worked at a top tier U.S. law firm, and in technology transfer offices in the U.S. and U.K. Gina also has many years of industry experience from her tenure as patent agent at a Fortune 500 American health care company.

Toby Crick, Partner, Bristows LLP. The primary focus of Toby's work is on technology, communications and outsourcing projects where he has acted on both the client and supplier side in sectors such as financial services, telecommunications and life sciences. Toby also advises on other complex commercial transactions and he has particular expertise on deals involving the use and exploitation of technology and intellectual property.

Dr Sam De Silva is a Partner in the Technology and Outsourcing practice at CMS Cameron McKenna Nabarro Olswang LLP. Sam specialises in complex and strategic technology projects acting for customers and suppliers in the private and public sector. Sam is the former UK representative on the EU Commission's Expert Group on Cloud Computing Contracts, the current UK representative on the IT Law Committee of the Bars and Law Societies of Europe (CCBE) and the past Chair on the Law Society's Technology and Law Committee (but still a committee member). Sam is an elected Trustee of The Chartered Institute for IT (BCS), is on the Council of the BCS and the Chair of the Legal Specialist Group of the BCS. Sam is named in the Who's Who of Information Technology 2022, Who's Who of Data Privacy and Protection 2022, and the Who's Who of Data Security 2022 as both a Global Leader and Thought Leader in those areas of law.

Natalie Ellerby, Partner, Baker & McKenzie. Natalie heads up Baker McKenzie's IP transactional practice in London and focuses on advising clients on IP-critical acquisitions and disposals including complex cross-border carve-outs, IP licensing matters, franchising

arrangements, intragroup IP reorganisations and joint venture and collaboration agreements.

John Enser, Partner, Head of Music, CMS Cameron McKenna Nabarro Olswang LLP. John provides commercial, regulatory and copyright law advice to clients active in all aspects of the media and communications business, particularly those offering music and audiovisual content via digital platforms. He has been at the forefront of new media developments for nearly 20 years, assisting clients to launch new and innovative services across a range of technologies, delivering originally to TV sets and latterly to PCs, mobile devices, tablets and all other forms of connected device.

Chris Shelley, Partner, Pennington Manches. Chris is a partner in the Oxford office who specialises in intellectual property and commercial law, and EU and UK competition laws. Chris is particularly known for his work in the life sciences, publishing and engineering sectors, and for universities, research councils and their spin-out companies. Described as 'outstanding', Chris is Highly Recommended for patent licensing in IAM 1000: The World's Leading Patent Practitioners.

Sally Shorthose, Partner, Bird & Bird. Sally provides a full range of intellectual property commercial advice and support to her clients, including licensing, partnering and exploitation agreements, research, development and marketing collaborations. She also frequently advises clients on regulatory and 'freedom to operate' matters, and manages significant due diligence matters. As a transactional intellectual property lawyer, she provides advice in relation to the protection and exploitation of a full range of IP rights, both in stand-alone transactions and as part of an acquisition, divestment or investment activity.

Tim Worden, Partner, Goodwin. Tim is a partner in the firm's IP/IT group, based in Cambridge. He regularly advises on licensing and partnering deals, R&D agreements, clinical trials agreements and a broad spectrum of regulatory matters. His expertise also includes advising on the IP and regulatory aspects of M&A transactions and venture capital investments. Tim also advises a range of technology companies on their technology licensing and commercial agreements.

STRUCTURE & TEACHING

Each day of the course focuses on a different market or practice area, provides instruction on legal and commercial topics that are relevant to IP transactions in that area, and gives an introduction to the IP agreements that are encountered.

The topics covered include IP aspects of mergers and acquisitions, information technology contracts, agreements in the life sciences sector, contracts with universities and government bodies, and agreements in the media and consumer goods sectors.

The course as a whole is designed to cover all the main types of IP (including patents, copyright, database rights, registered and unregistered designs, trade marks and confidential information), the main types of IP transaction (including licensing, assignment, sale of IP products, and IP aspects of corporate transactions), and various areas of commercial law that affect all kinds of IP transactions (including competition law, insolvency and tax).

A reading list is provided in advance of the course, so that students can start the course with a core knowledge of relevant IP and contract subjects.

An important aspect of the course is that it is both academically rigorous – to the standards that one would expect from a leading UK law faculty – and, at the same time, very practical in its focus.

Each day of the course includes:

- Lectures on the law. Each lecture is delivered by a lead speaker who is supported by a secondary speaker, who may comment on what the lead speaker is saying, provide examples from their own experience, and generally interact with the lead speaker;

- Discussions on legal and commercial practice, in a similar format to the lectures on the law; and
- Practical workshops in smaller groups, each led by an experienced practitioner, where we look at documents that are encountered in the area under discussion (eg draft agreements and due diligence reports).

The course will be information-rich – it will cover a considerable amount of material in the course of a week – but will also have a social side. We will allocate students to study groups that will have the opportunity, at the end of each day, to discuss the next day's practical workshops. We also plan to hold an online networking event that will provide students with an opportunity to meet their peers in other firms, and some of the speakers.

Approximately one week after the course finishes, there will be a two-hour exam, which will give students the opportunity to apply the information they have learnt to a selection of practical questions.

Students who complete the course and pass the exam will receive a **Certificate in IP Transactions** from the Institute of Brand and Innovation Law at UCL Faculty of Laws.

COURSE CONTENT

Monday 15 April 2024

THEMES:

Confidential information; preliminary agreements; creation of IP; dealing with disputes

Morning

- Legal analysis: confidential information and know-how
- Commercial Practice: preliminary agreements - CDAs, MOUs, term sheets, options, and other preliminary IP agreements
- Legal Analysis: What does this IP document mean, what is its legal effect?

Afternoon

- Legal analysis: Ownership of IP and types of IP transactions
 - Commercial Practice: commercial joint ventures
 - Workshop: academic research and licensing agreements
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Tuesday 16 April 2024

THEMES:

M&A; IP due diligence and warranties; IP assignments; novation agreements

Morning

- Legal practice: overview of corporate transactions for the IP lawyer
- Legal analysis: warranties representation and indemnities
- Commercial practice: IP and commercial issues in M&A transactions
- Workshop: reviewing the outcome of due diligence investigations

Afternoon

- Commercial practice: common negotiation issues in IP warranties
 - Workshop: negotiating IP warranties
 - Legal analysis: Assignments of IP and novation agreements
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Wednesday 17 April 2024

THEMES:

Patents; IP licensing; universities and life sciences OR IP Security

Morning

- Commercial practice: analysis of a licence agreement/ patents and other rights that protect biological and chemical products
- Workshop: reviewing a patent and know-how licence agreement
- Legal analysis: competition laws and IP transactions

Afternoon

Stream A:

More detailed look at IP in universities and life sciences

- Law and practice in the university/research sector
- IP aspects of university spin-out transactions
- Legal and Commercial Practice: Regulations affecting development and sale of pharmaceutical products

Stream B:

IP Security

- Legal analysis: Charges and other forms of security over IP
- Practice: Lending against the security of IP assets
- Workshop: Negotiating IP security

Open Session:

- Legal and Commercial Practice: law and jurisdiction, and Q&A session

Thursday 18 April 2024

THEMES:

Software copyright, database rights; ICT sector; IP issues in product supply

Morning

- Legal analysis: IP and quasi-IP that feature in ICT transactions
- Commercial practice: supply and licensing of IT products to a major customer
- Workshop: negotiating a software supply agreement
- Legal and commercial practice: managing IP in standards
 - risks, benefit, processes

Afternoon

- Legal analysis: data protection
- Commercial practice: open-source licensing
- Legal and commercial practice: IP pooling agreements
- Workshop: negotiation of open-source and domain name issues in the context of an IP-rich corporate transaction

Friday 19 April 2024

THEMES:

Copyright, trade marks, designs; media and consumer goods; content and brand licensing

Morning

- Commercial practice: the media landscape
- Legal analysis: IP rights in media transactions
- Workshop: key clauses to negotiate in media agreements
- Legal analysis: practical tax issues in IP transactions

Afternoon

- Trade Marks in Transactions
- Commercial practice: “Dirty little tricks in IP licensing”
- Wrap-up session: similarities and differences in IP transactions across different IP types and industry sectors; questions, answers and general discussion

Friday 3rd May 2024 - Exam

The course examination will be held online and should take no more than 2 hours to complete. You will have a 24-hour period in which to take the 2-hour exam so that it will fit within your work commitments.

CLASS SCHEDULE

MONDAY

09:30 **Introduction to course**
Mark Anderson and Prof. Sir Robin Jacob

09:45 **Legal Analysis: Confidential information and know-how**
John Hull (QMUL)

10:30 **Commercial Practice: Preliminary agreements - CDAs, MOUs, term sheets, options, and other preliminary IP agreements**
Mark Anderson

11:15 BREAK

11:30 **Legal Analysis: What does this IP Document mean, what is its legal effect?**
Mark Anderson

13:00 LUNCH BREAK

14:00 **Legal analysis: Ownership of IP and Types of IP Transactions**
Matthew Warren (Bristows)

15:00 BREAK

15:15 **Commercial practice: Commercial joint ventures (contracts between two companies)**
Cerys Wyn Davies (Pinsent Mansons)

16:15 **Small Group Workshop: Academic research and licensing agreements**
Matthew Warren, Cerys Wyn Davies, and Mark Anderson

17:00 Day one ends
Overnight: Preparation for next day's workshops

TUESDAY

09:30 **Legal practice: Overview of Corporate Transactions for the IP Lawyer**
Molly Woods & Louise Johnson (Ashurst)

10:15 **Legal analysis: Warranties, Representation and Indemnities**
Chris Bates (Ashurst)

11:00 BREAK

11:15 **Commercial practice: IP and commercial issues in M&A transactions**
Gina Bicknell (Pinsent Mason)

12:00 **Small Group Workshop: Reviewing the outcome of due diligence investigations**
Gina Bicknell, Ruth Arkley and Tim Worden

13:00 LUNCH

14:00 **Commercial Practice: Common negotiation points in IP warranties**
Tim Worden (Goodwin)

14:55 **Small Group Workshop: Negotiating IP warranties**
Gina Bicknell, Tim Worden, and Ruth Arkley

15:45 BREAK

16:00 **Legal analysis: Assignments of IP and novation agreements**
Ruth Arkley (Brown Rudnick)

17:00 Day two Ends
Overnight: Preparation for next day's workshops

WEDNESDAY

09.30 **Commercial practice: Analysis of a Licence Agreement/Patents and Other Rights that Protect Biological and Chemical Products**

Chris Shelley (Penningtons) and Sally Shorthose (Bird & Bird)

11.00 BREAK

11.15 **Small Group Workshop: Reviewing a patent and know-how licence agreement**

Chris Shelley, Sally Shorthose and Edmund Forey

12.15 **Legal analysis: Competition Laws and IP Transactions**

Edmund Forey (Penningtons)

13.00 Lunch

14:00 STREAM A - UNIVERSITIES

Technology Transfer Two sides of the story
Paul MacLennan (&Law)

15.00 Break

15.30 **Legal and Commercial Practice: Common Issues affecting the university and tech transfer sector**
Stephen Brett (&Law) and Louise Fullwood (Pinsent Masons)

14:00STREAM B - IP SECURITY

Charles Kerrigan (CMS)
Legal analysis: charges and other forms of security over IP

14.45 Practice: Lending Against the Security of IP Assets

15.30 Break

15.45 Workshop: negotiating the terms of an IP security

16.30 **Law and commercial practice: Law and jurisdiction, and Q&A session**

Mark Anderson (&Law)

17:00 Day Three Ends

Overnight: Preparation for next day's workshops

THURSDAY

09:30 **Legal analysis: IP and quasi-IP that feature in ICT Transactions**

Adrian Toutoungi (Taylor Wessing)

10.15 **Commercial practice: Supply and Licensing of IT Products to a Major Customer**

Sam De Silva (CMS)

11.15 BREAK

11.30 **Small Group Workshop: Negotiating a software supply agreement**

Sam de Silva and Adrian Toutoungi

12.30 **Legal Analysis: Data protection**

Faye Harrison / Hannah Crowther (Bristows)

13.10 LUNCH

14.00 **Commercial Practice: Cloud deals, licensing rights of use and data protection and other ICT-impacting Regulations in practice**

Adrian Toutoungi and Sam De Silva

14.45 **Legal and commercial practice: Managing IP in standard - risks, benefit and processes applicable to standard essential patents**

Adrian Toutoungi (Taylor Wessing)

15.30 BREAK

15.45 **Commercial practice: Open-Source Licensing**

Adrian Toutoungi (Taylor Wessing)

16.15 **Small Group Workshop: Negotiation of Open Source and Domain Name Issues in the Context of an IP-Rich Corporate Transaction**

Adrian Toutoungi, Sam De Silva

17:00 Day Four Ends

Overnight: Preparation for next day's workshops

FRIDAY

09:30 **Commercial practice:**

The Media Landscape

Tomos Jones (Reed Smith)

10.00 **Legal analysis:**

IP Rights in Media Transactions

John Enser (CMS)

10.45 BREAK

11.00 **Small Group Workshop:**

Key Clauses to Negotiate in Media Agreements

Tomos Jones, John Enser and Sam Oustaiannis

12.00 **Legal analysis:**

Practical Tax Issues in IP Agreements

Ruth Burstall (Johnson & Johnson Innovation) & Salli McElligott (Baker & McKenzie)

13:00 LUNCH

14:00 **Trade Marks in Transactions**

Natalie Ellebery (Baker & McKenzie)

14.45 **Commercial practice:**

Dirty Little Tricks in IP Licensing [Interactive Session]

Jeff Skinner (London Business School)

15.30 BREAK

15.45 **Wrap-up session:**

Similarities and differences in IP transactions across different IP types and industry sectors; questions, answers and general discussion

Mark Anderson (&Law)

16:00 End of Course

ADMISSION & FEES

Application Process

Applications should be made using the form online at:
<https://www.ucl.ac.uk/laws/events/2024/apr/ip-transactions-law-and-practice-2024>

You can make your application online and email the following to Lisa Penfold (lisa.penfold@ucl.ac.uk) to complete your application:

- 1 A CV and the names of two professional referees;
- 2 A short personal statement indicating what you hope to achieve by attending the course.

The application **deadline is 31 January 2024, or earlier if we are fully booked before that date.**

The course fee is £3950

The course fee covers all course materials, tuition, lunches and refreshments throughout the course and the examination fees.

Discounts of 15% on the fees are available:

- a) firms that sponsor the Institute of Brand and Innovation Law; or
- b) firm that provide speakers for the course
- c) UCL alumni

Fee payment

You will be invoiced for the full course fees when you return your confirmation form.

What to send and where to send it

- ▷ completed application form online at:
<https://www.ucl.ac.uk/laws/events/2024/apr/ip-transactions-law-and-practice-2024>

Please email these documents to lisa.penfold@ucl.ac.uk

- ▷ CV (including the names of two professional referees), and;
- ▷ a short personal statement as to what you hope to achieve by attending the course.

Course confirmation:

When you have been accepted onto the course and received your letter confirming your place, please return your course confirmation form to lisa.penfold@ucl.ac.uk within 14 days.

Queries should be made to:

Lisa Penfold

Email: lisa.penfold@ucl.ac.uk

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UCL Institute of Brand &
Innovation Law
UCL Faculty of Laws
Bentham House
Endsleigh Gardens
London WC1H 0EG

www.ucl.ac.uk/laws/ibil

