

# UCL Institute of Brand & Innovation Law

## IP Transactions: Law and Practice

A five-day CPD course for IP Practitioners  
8 - 12 April 2019



# 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 2018

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

“The only course of this type  
- truly transactional law and  
practice”

“Fantastic course”

“Genuine speakers who are  
currently still practicing. Really  
enjoyed it”

“Outstanding course”

“Great job of allowing non-  
English lawyers [to] understand  
the issues”



**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](http://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)

## Course tutors

This year's tutors provisionally include:

**Michelle Blunt**, Partner, Baker McKenzie. Michelle is experienced in all aspects of commercial and transactional IP. She has significant depth of experience handling IP aspects of M&A transactions. She also regularly assists clients in a wide range of industries with IP advisory work, licensing, R&D and cost-sharing arrangements and regulatory and IP compliance advice. Michelle has a strong interest in tax aspects of intangibles and is a core member of Baker McKenzie's global taxation of intangibles practice group.

**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.

**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.

**Mark Lubbock**, Partner, Brown Rudnick. Mark is a partner in the IP group in the London office and specialises in the intellectual property, information technology, healthcare, e-commerce, data protection, outsourcing and commercial contracts practice areas.

**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, Taylor Wessing. Tim is a partner in the firm's IP/IT group, based in Cambridge. He heads the UK Life Sciences Regulatory group. 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 a social 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 8 April 2019

---

### **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
- 

## Tuesday 9 April 2019

---

### **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
- 

## Wednesday 10 April 2019

---

### **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 11 April 2019**

---

### **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: other laws affecting ICT – data protection, export controls, anti-bribery, e-commerce
- 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 12 April 2019**

---

### **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

- 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

---

## **Monday 13 May 2019**

---

Examination from 10.30 - 12.30am will be held at the course venue.



# THE CLASS SCHEDULE

## MONDAY

09:30  
Introduction to course

09:45 - 10.30  
Legal Analysis: confidential information and know-how

10.30 - 11.15  
Commercial Practice: preliminary agreements - CDAs, MOUs, term sheets, options, and other preliminary IP agreements

11.15 - 11.30  
Break

11.30 - 13.00  
Legal Analysis: What does this IP Document mean, what is its legal effect?

13.00 - 14.00  
Lunch

14.00 - 15.00  
Legal analysis: Ownership of IP and Types of IP Transactions

15.00 - 15.15  
Break

15.15 - 16.15  
Commercial practice: commercial joint ventures (contracts between two companies)

16.15 - 17.00  
Workshop: Academic research and licensing agreements

17:00 - 18.00  
Student preparation for next day's workshops

## TUESDAY

09:30 - 10.15  
Legal practice: Overview of Corporate Transactions for the IP Lawyer

10.15 - 11.00  
Legal analysis: Warranties, Representation and Indemnities

11.00 - 11.15  
Break

11.15 - 12.00  
Commercial practice: IP and commercial issues in M&A transactions

12.00 - 13.00  
Workshop: reviewing the outcome of due diligence investigations

13.00 - 14.00  
Lunch

14.00 - 14.45  
Commercial Practice: common negotiation points in IP warranties

14.45 - 15.45  
Workshop: negotiating IP warranties

15.45- 16.00  
Break

16.00 - 17.00  
Legal analysis: Assignments of IP and novation agreements

17:00 - 18.00  
Student preparation for next day's workshops

18:00 onwards  
Drinks reception

## WEDNESDAY

09.30 - 11.00

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

11.00 - 11.15

Break

11.15 - 12.15

Workshop: reviewing a patent and know-how licence agreement

12.15 - 13.00

Legal analysis: Competition Laws and IP Transactions

13.00 - 14.00

Lunch

### STREAM A - UNIVERSITIES

14.00 - 15:15

Technology Transfer .... Two sides of the story

15.15- 15.30

Break

15.30 - 16.30

Legal and Commercial Practice: Common Issues affecting the university and tech transfer sector

### STREAM B - IP SECURITY

14.00 - 14.45

Legal analysis: charges and other forms of security over IP

14.45 - 15.30

Practice: Lending Against the Security of IP Assets

15.30- 15.45

Break

15.45 - 16.30

Workshop: negotiating the terms of an IP security

16.30 - 17.00

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

17:00 - 18.00

Student preparation for next day's workshops

## THURSDAY

09:30 - 10.15

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

10.15 - 11.15

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

11.15 - 11.30

Break

11.30 - 12.30

Workshop: negotiating a software supply agreement

12.30 - 13.00

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

13.00 - 14.00

Lunch

14.00 - 14.45

Legal Analysis: Other laws affecting ICT: Data protection, export controls, anti-bribery

14.45 - 15.30

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

15.30- 15.45

Break

15.45 - 16.15

Commercial practice: Open-Source Licensing

16.15 - 17.00

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

17:00 - 18.00

Student preparation for next day's workshops

## FRIDAY

09:30 - 10.00

Commercial practice: The Media Landscape

10.00 - 10.45

Legal analysis: IP Rights in Media Transactions

10.45 - 11.00

Break

11.00 - 12.00

Workshop: Key Clauses to Negotiate in Media Agreements

12.00 - 12.45

Legal analysis: Practical Tax Issues in IP Agreements

12.45 - 14.00

Lunch

14.00 - 15.15

Commercial practice: Dirty Little Tricks in IP Licensing  
[Interactive Session]

15.15- 15.30

Break

15.30 - 16.00

Wrap-up session: similarities and differences in IP transactions across different IP types and industry sectors; questions, answers and general discussion

16.00

End of Teaching Sessions

# ADMISSION & FEES

## Application Process

Applications should be made using the form overleaf.

Applications should be accompanied by:

- 1 A CV and the names of two professional referees. We do not ask for original degree certificates to be included, but may ask for them subsequently;
- 2 A short personal statement indicating what you hope to achieve by attending the course.

The application deadline is 28 February 2019, or earlier if we are fully booked before that date.

## The course fee is £2,950, plus VAT

The course fee covers all course materials, tuition and the examination fee, as well as refreshments and a light lunch on each day of the course.

Discounts are available to firms that either:

- a) sponsor the Institute of Brand and Innovation Law; or
- b) provide speakers for the course.

## Accommodation

For students who live outside London, a small number of rooms are available – at an additional charge – at The Goodenough Club from **Sunday 7 April through to Friday 12 April and includes breakfast and wifi**. These are small double rooms and the cost per night is £170 per night

The cost of this accommodation will be included in the final course fee invoice if you choose to take accommodation.

## Fee payment

Once you are accepted onto the course you will receive a form that needs to be returned, by 28 February 2019, confirming that you wish to take up the place, along with a passport photo and a non-refundable deposit of £600 +VAT (£720).

The remaining fees (£2350 +VAT = £2700), for which you will be invoiced in mid-February, must be paid in full by Friday 11 March 2019.

### *Fee deadlines:*

28 February 2019 Course deposit £600 + VAT

28 March 2019 Final course fees £2350 + VAT

Please return your completed application form, together with your CV (including the names of two professional referees), and a short personal statement as to what you hope to achieve by attending the course, to:

Lisa Penfold  
Events & CPD Manager  
UCL Faculty of Laws  
Bentham House  
Endsleigh Gardens  
London WC1H 0EG

Queries should be made to:

Lisa Penfold  
Telephone: 0203108 8508  
Email: [lisa.penfold@ucl.ac.uk](mailto:lisa.penfold@ucl.ac.uk)

# COURSE LOCATION

The course will be held at the UCL Faculty of Laws, Bentham House, Endsleigh Gardens, London WC1H 0EG

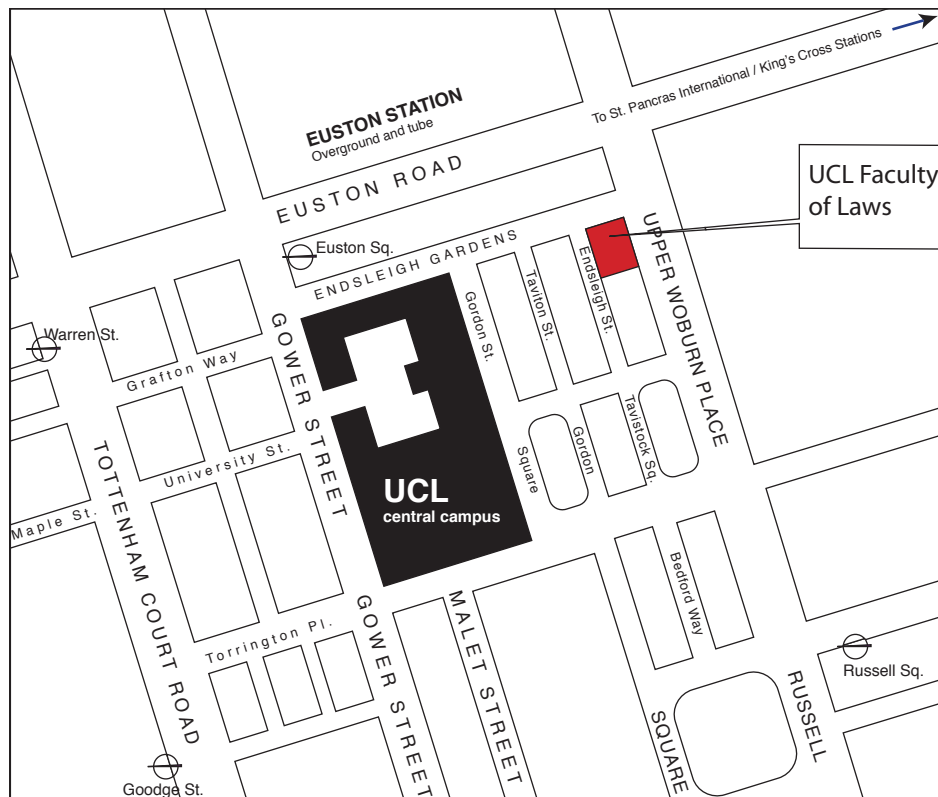
The Campus is well served by transport links with **Euston**, **King's Cross**, and **St Pancras International** overground train stations within 5 - 10 minute walk away.

Tube stations within easy walking distance of the Faculty are:

**Euston** (Victoria / Northern Lines)

**Euston Square** (Circle / Metropolitan / Hammersmith & City Lines)

**Russell Square** (Piccadilly Line)



# IP TRANSACTIONS: LAW AND PRACTICE 2019

## APPLICATION FORM

SURNAME			
FIRST NAME			
TITLE			
DATE OF BIRTH			
NATIONALITY			Do you require a visa? Yes/No (delete as appropriate)
Business Name			
Position			
Business Address			
Telephone		Mobile	
Email Address			
Accommodation	<input type="checkbox"/> I do not require accommodation <input type="checkbox"/> Please book accommodation for me at the Goodenough Club from: <input type="checkbox"/> Sunday 7 - Friday 12 April (5 nights) <input type="checkbox"/> Sunday 7 - Saturday 13 April (6 nights)		

OFFICE USE ONLY:	
Application received on:	
Admitted / Not Admitted on:	

Fee Payment

**Once you have been accepted onto the course** you will be invoiced for a non-refundable deposit of £720 (£600 + VAT) to secure your place. You will be invoiced for the outstanding course fees (less the deposit) which will be payable in full by Friday 28 March.

Please confirm the address/name that you would like your invoice sent should your application be successful:

Use my details above

Please use this Name and Address for the invoice

Contact name: \_\_\_\_\_

Firm: \_\_\_\_\_

Address: \_\_\_\_\_

VAT NO: \_\_\_\_\_

Accounts payable phone no: \_\_\_\_\_

Accounts payable email: \_\_\_\_\_

Data Protection

I agree to UCL processing personal data contained on this form or any other data which UCL may obtain from me or other people or organisations while I am applying for admission. I agree to the processing of such data for any purpose connected with my studies or my health and safety while on UCL premises, or for any other legitimate purpose.

To the best of my knowledge, the information on this application is accurate and complete.

Signature

Date

Have you included with your application form:

CV, including names of professional referees

personal statement

Please return this form to:

Lisa Penfold Events & CPD Manager

UCL Faculty of Laws

Bentham House, Endsleigh Gardens, London WC1H 0EG

You can also email a scanned copy of this form along with your personal statement to: [lisa.penfold@ucl.ac.uk](mailto:lisa.penfold@ucl.ac.uk)





# ibil



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

[www.ucl.ac.uk/laws/ibil](http://www.ucl.ac.uk/laws/ibil)

