

# BUCERIUS / UC HASTINGS SUMMER PROGRAM IN INTERNATIONAL INTELLECTUAL PROPERTY TRANSACTIONS

Hamburg, July 9 – 27, 2018

## Aspects of German Contract Law

Jens Pruetting

This unit will offer a brief overview of German Contract Law with particular attention paid to aspects of declaration of will, key principles such as the principle of separation and abstraction and an important case when a declaration of will is void. The second portion will introduce the subject and core concepts as they apply to the field of IP law. This unit will highlight problems of contracts that may pass licenses from one subject to another. In the field of IP law, this process is quite particular as the German treatment of copyright law is constructed primarily as a special part of tort law, which usually follows other rules and principles.

## Aspects of US Contract Law

Jeff Lefstin

This session will first briefly review the fundamentals of United States contract doctrines applicable to intellectual property licensing, emphasizing those doctrines characteristic of the common-law regime, and those especially significant in licensing contracts. It will then explore the limitations imposed on intellectual property licenses due to the relationship between Federal and State law in the United States, such as Federal intellectual property policy, antitrust, and bankruptcy.

## Aspects of US Patent Law

Jeff Lefstin

This session will cover the essentials of United States patent law, including the process of obtaining and adjudicating patent rights, the statutory requirements of patentability, claim interpretation, infringement, and remedies. More in-depth attention will be paid to the current state of patent-eligible subject matter and the exhaustion doctrine.

## A Comparative View of Trademark Law (EU; US)

Dana Beldiman

Following a very brief survey of the differences in fundamental trademark protection requirements in the EU and the US, this lecture will focus on cutting edge developments in trademark law, including protection of non-traditional marks, functionality issues, etc., and conclude with certain license considerations specific to transfers of trademark rights in the US.

## **Competition and Exhaustion Doctrines as Limitation to Licensing Licensing and Competition Principles (EU, US)**

**Theo Bodewig**

The principles of IP rights and competition are frequently seen as antagonistic. Technology transfer agreements, like patent licenses, normally contain clauses which restrain one party or both in competition. They therefore have to be checked against the antitrust regulations of the countries in which they are executed.

This session will explore the relationship of IP rights and competition and explain the regulation of competition law in the EU and parallel rules in US antitrust law.

## **Concepts of Licensing in a FRAND context**

**Andrew Lupu**

This session will focus on consortium licensing among industry participants and the need to address FRAND ("fair, reasonable and non-discriminatory") provisions in such licenses. As such licenses are routinely scrutinized by enforcement agencies and other watchdog groups for anticompetitive and other effects, it is imperative for the attorney practitioner to be aware of the current trends in enforcement and patent analysis, including the repercussions on any standard-setting organizations.

## **Conflict of Laws in International Agreements**

**Karsten Thorn**

This session deals with IP-related European rules on international jurisdiction and conflict of laws (existence and scope of IP rights, infringement, licensing). Where appropriate, a comparison with rules of other jurisdictions will be undertaken.

## **Copyright: Ownership, "work made for hire" and transfer of proprietary interest**

**Andrew Lupu**

This session will focus on current issues in intellectual property ownership for software, whether Commercial Off-The-Shelf (COTS) licenses, government-funded licenses, or for custom-developed software, as well as the United States copyright concept of "work made for hire" and the economic realities of such provisions. Based upon historic examples drawn from everyday practice experiences, the class will center on analytics of such relationships and the cost-benefits of each approach and associated negotiation concepts.

## **Copyright, Software and Relevant License Clauses**

**Dana Beldiman**

Software, one of the key building blocks of the modern world, is transacted as part of almost every license agreement. Software is commonly protected by copyright law. The lecture will discuss protectability of computer code under copyright laws in the EU and the US, the scope of permissible unauthorized use of computer code, as well as certain software-related license provisions of IP related transactions.

## **Drafting Principles**

**Lezel Roddeck**

This session will provide an introduction to and tips for effective drafting as well as practice drafting clauses. You will explore legal drafting language and style as well as principles of interpretation. Regarding the structure of a contract, you will work with definitions, the grant clause, law and jurisdiction and boilerplate clauses.

## **EU Trademark Law**

**Alexandra von Bismarck**

Trademarks are one of the most valuable assets in a business. This session will cover the essentials of EU Trademark Law including requirements of registrability of EU trademarks and best filing strategies. The session will further focus on how to exploit and enforce your EU trademarks against infringers and will offer insights from practice on how to successfully manage a trademark portfolio in Europe.

## **IP Aspects of Technology Transactions**

**Allison Mages**

Technology is at the heart of today's business transactions and intellectual property plays a crucial role in making them successful. This session will provide an overview of how IP is dealt with in a variety of transactions, helping you recognize potential stumbling blocks and providing strategies to manage them effectively. We will discuss how IP rights are handled in the context of various transactions, including M&A activity and joint development agreements.

## **Legal Aspects of Licensing**

**Christian Stoll**

This session will provide an overview of the general structure of license agreements and the most relevant legal aspects of license agreements. Topics of this session will include the underlying principles of international license agreements, the most relevant provisions in license agreements, applicable law, license agreements in litigations and the relevant rules of antitrust and competition law. The session will include many practical examples to provide a good foundation for the program.

## **Licensing in Biotech**

**Jochen Dieselhorst**

Licensing deals in the biotech/pharma sector are one of the most complex and most valuable IP transactions. Due to the particularities of the biotech/pharma sector, certain standards have evolved to balance the development risk of the licensee with the potential value of the licensed drug candidate.

This session aims to give a practical insight into licensing and negotiation issues of biotech/pharma license deals. It will explain typical clauses to address these on the basis of a license deal template that will be handed out as part of the lecture.

## **Principles of Negotiation**

**René Pfromm**

This session provides you with the foundations of legal and business negotiations. You will receive a practical and easy-to-use toolkit for professional negotiations. Through interactive discussions, mini-exercises and a simulation, we will identify the main drivers for a successful negotiation outcome, assess the structural challenges and dynamics of negotiations and develop strategies and techniques for preparing and conducting negotiations, shaping the other side's perception, negotiating from a position of weakness and using (as well as defending against) negotiation tactics.

## **Negotiation (Demonstration)**

**Shin Iwata & Siegmar Pohl**

This session is by video link with San Francisco. Two practicing attorneys, specialized in international transactions, will lead the group through the negotiation of a cross-border license transaction between a German and a Silicon Valley company. The attorneys will each assume the roles of licensor and licensee, respectively. They will each seek to negotiate IP-related clauses that are favorable to their respective client, making appropriate arguments in support.

## **Practical Aspects of IP Licensing**

**Annemarie Bloß**

This session will highlight sublicensing and focus on deals with various typical constellations of IP license contracts in the daily work of an IP lawyer in a global law firm. This includes subject matters of license contracts, types of licenses as well as basic clauses when drafting license contracts. The course also addresses the treatment of IP license contracts in M&A transactions. Finally, a focus of the course is on the legal nature of sub-licenses and their fate in the event of the termination of main licenses.

## **Quality Control in Trademark Licensing**

**Arpan Banerjee**

This session will discuss quality control in trademark licensing. The presentation will focus on case law from the US (where quality control has emerged as a key licensing issue) as well as the UK and other Commonwealth jurisdictions. Based on case studies of multinational companies in India, the presentation will include a hypothetical to illustrate the relevance of quality control clauses in international licensing agreements."

## **Trademark Licensing: Case Law & Practice**

**Kristoff Ritlewski**

This session aims to provide insight into some of the specific trademark-related issues of licensing. We will cover the latest ECJ case law and review relevant legal provisions set out in the UTMR and other legal texts. Additionally, we will discuss provisions of standard trademark licensing agreements that practitioners should integrate (or oppose) when negotiating license deals. While previous sessions will have already covered some basics surrounding the technicalities of licensing, this session will be a good opportunity to review and repeat acquired knowledge in the light of trademarks cases.