

BUCERIUS / UC HASTINGS SUMMER PROGRAM: LICENSING TRANSACTIONS IN INTELLECTUAL PROPERTY

Hamburg, July 3 – July 21, 2023

DL-101 Online General Course on Intellectual Property WIPO Academy

Offered through the WIPO eLearning Center, this course provides an in-depth view of the fundamentals of IP law. It is composed of a series of modules treating the following topics:

- Copyright
- Related Rights
- Trademarks
- Geographical Indications
- Industrial Design
- Patents
- WIPO Treaties
- Unfair Competition
- Protection of New Varieties of Plants
- IP and Development - The WIPO Development Agenda

Algorithmic Licensing and AI: Technological and Legal Issues Dr. Stefan Dittmer

Algorithms and data can be incredibly valuable assets but the legal landscape surrounding these themes is fragmented at best. Innovations in AI add to the complexity. In this session, we will look at means of protection and licensing of algorithms and data, and legal pitfalls arising from the use of AI and perhaps other advanced technologies.

Conflict of Laws in International Agreements Prof. Dr. 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.

Drafting Principles Lezel Roddeck

This session is designed to help you develop strong drafting skills to create clearly enforceable contractual provisions. We will focus on the key principles of effective drafting, draft clauses without the aid of a precedent, and review clauses to identify drafting errors.

IP and AI-Generated Works

Prof. Ryan Abbott

AI is improving dramatically, including with respect to its ability to generate works that have been historically protectable by copyright and patent law. Yet, jurisdictions around the world are currently divided with respect to whether and how to provide protection for works generated without a traditional human author or inventor. This lecture will review the evolving international law on subsistence and entitlement to AI-Generated Works, and will address a number of the novel challenges AI presents to IP law and practice.

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.

IP Transactions Based on Blockchain and Smart Contracts

Zoi Michalopoulou

Blockchain, combined with smart contracts, is expected to revolutionize licensing transactions in intellectual property. After explaining the function and main characteristics of this emerging technology, this session will discuss practical examples of current, in part experimental applications: In particular, we will look at blockchain-based platforms, which promise secure licensing of digital content and use smart contracts to automate such transactions and standardize licensing terms and conditions. Thereby, we will focus on legal and technical opportunities as well as challenges. Topics of this session will include the relevance of the blockchain technology for the issue of digital exhaustion in copyright law, the potential of blockchain and smart contracts regarding the administration and enforcement of IP rights and possibilities to protect features of blockchains as IP.

IT and Cloud Projects - Legal Framework and Negotiations

Dr. Jacek Lagoni

This session will provide an overview of problems that attorneys may face while working on IT projects. You will have the opportunity to practice your (legal) skills in a simulated negotiation. There, we will show you negotiation techniques as well as typical issues raised during discussions about cloud services 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 and Collaboration Strategies for Legal Tech Business Models in Germany

Dr. Philipp Plog

An introduction to the various setups of challenges in the legal market chosen to navigate through marketing, regulatory and IP requirements for alternative legal services.

Licensing in Biotech

Dr. Philipp Dohnke

Licensing deals in the biotech/pharma sector are one of the most complex and most valuable IP transactions – which are gaining (even) more upwind in view of the rise of former niche technologies like mRNA or cell and gene therapies. 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 – taking into account themes and challenges which have emerged in context of the COVID-19 pandemic. 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.

Limitations on License Agreements

Prof. Dr. Dana Beldiman / Prof. Dr. Jeffrey Lefstin

While parties are generally free to choose the terms of their license agreements, the legal regime of most jurisdiction circumscribes that freedom to a greater or lesser degree. These limitations may arise from policies of the intellectual property laws, or from other bodies of law. This class will address some of the more important legal limitations on license agreements, including exhaustion and royalty structure, FRAND obligations, bankruptcy, and antitrust (US) or competition law (EU).

Non-Fundible-Tokens (NFTs) and the Revolution of the digital Arts Market

Stefan Papastefanou

"The introduction of Non-Fungible Token (NFTs), as part of the blockchain technology, promised to revolutionize the digital arts market and intellectual property rights law in the digital world. However, after an extremely sharp rise in 2021, the economic significance of NFTs has fallen equally sharply only a couple months later. To understand this development, it is important to understand what NFTs are able to achieve and where they fall short. This lecture explains the technical, economic and legal significance of NFTs, especially in the context of intellectual property law."

Open Source Licencing

Prof. Libby Toub

The lecture will focus on open source licensing. Students should expect to understand the following based on the lecture: key principles of open source technology, the origin of open source licensing, and open source from a technology attorney's perspective. You will discuss open source organizations, address licensing models, and review the text of popular open source licenses.

Patent Law and Licensing

Prof. Dr. Jeffrey Lefstin

This session will focus on two aspects of patent doctrine and practice that are of special importance for agreements to license technology across borders. It first considers doctrines of patent eligibility, which address what types of inventions may be the subject of patents. Standards of patent eligibility have diverged sharply between the United States and other jurisdictions in the last decade. As a result, key technologies in biomedicine and information technology are patentable in some jurisdictions but not others. Second, this session will address the concept of exhaustion, which limits the ability of licensors to control downstream uses of technology following an authorized use. Limitations imposed by exhaustion at both the national and transnational level will be explored.

Practical Aspects of Licensing

Dr. Annemarie Westpfahl

This session will address practical aspects and typical constellations of IP license contracts in the daily work of an IP lawyer. The session provides insights on important preparatory considerations of a lawyer before the actual drafting/negotiating work starts. The unit will then deal with practical and legal difficulties in the drafting and negotiating of license contracts accompanied by tips for practical solutions. The session also addresses the treatment of IP license contracts in M&A transactions. Finally, a focus of the session is on the legal nature of sub-licenses and their fate in the event of the termination of main licenses.

Principles of Negotiation

Michael Friedman

Negotiation is omnipresent in the professional life of a lawyer and business person. This session will present the topic of negotiation on an introductory level and attempt to outline a number of key aspects and principles. Particular focus will be placed on characteristics of effective negotiators, bargaining styles, value claiming (distributive negotiation) and value creation (integrative negotiation). The session aims to give you insight, tools and vantage points that will assist you in completing the negotiation you will undertake in conclusion of the summer program and in your further professional practice. The session will combine discussion, informal lecture and a variety of workshop-style activities.

Successful License Relationships

Dr. Ulf Marquardt

Drawing on extensive experience acquired with Nestlé and in private practice, Dr. Marquardt will talk about values that make licensing transactions develop into synergetic and long-term relationships, beneficial to all parties involved.

License arrangements can be an important tool to strategically contribute to the equity of a brand and the business of a company. To achieve this, considerations that go beyond the mere terms of a contract are essential. It is key to consider, for example, the overall business purpose of the transactions, the competencies of the partners, common goals and interests, and the pursuit of innovation while preserving a company's core competence. All these aspects are important during the preparation of a license relationship, during the negotiations and in the management of the relationship after signature.

Trademark Licensing: Case Law & Practice

Prof. Dr. 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. As an example for comparative aspects of international licensing this session will cover different approaches to the principle of exhaustion and how the drafting legal professional might react. 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.