

October 12 & 13, 2010, Toronto

Two-Day Event!

**Course Leader**  
Colleen Spring  
Zimmerman,  
Fogler, Rubinoff  
LLP



Andrew Jones,  
Sim & McBurney / Sim,  
Lowman, Ashton &  
McKay LLP



Christopher  
Cates,  
Bell Mobility Inc.  
/ Bell Canada



Carol Hitchman,  
Hitchman &  
Sprigings



Jason Bullen,  
Cassels Brock  
& Blackwell LLP



Derrick A.  
Novis,  
KPMG LLP



J. Fraser Mann,  
Miller Thomson  
LLP



Eileen  
McMahon,  
Torys LLP



Andrea Rush,  
Heenan Blaikie  
LLP



Neil Belmore,  
Belmore McIn-  
tosh Neidrauer  
LLP



as well as:

Steve Cimicata,  
Symcor Inc.

*"I left the event with a much greater understanding of IP/IT Transactions."*

*"Essential information!"*

*"10/10!"*

2<sup>nd</sup>

# Mastering IP & IT Transactions

## **Workshop Included: Managing IT & IP Disputes**

### participating organizations

Bell Mobility Inc. / Bell Canada  
Belmore McIntosh Neidrauer LLP  
Cassels Brock & Blackwell LLP  
Fogler, Rubinoff LLP  
Heenan Blaikie LLP  
Hitchman & Sprigings  
KPMG LLP  
Miller Thomson LLP  
Sim & McBurney / Sim, Lowman, Ashton & McKay LLP  
Symcor Inc.  
Torys LLP

### who should attend

Directors & Managers of IP, Vice-Presidents & Directors of Legal Affairs, Privacy Officers, IT Security Directors, CIOs, In-House Counsel, General Counsel, IP Lawyers and Trademark Consultants

### course highlights

- Gain a better understanding of the rapidly developing field of intellectual property law
- Learn how a well managed due diligence process can mitigate risks associated with IP transactions
- Explore best practices for drafting and structuring IP licensing agreements
- Examine the unique contract issues in cross-border licensing
- Hear about the latest techniques for negotiating and drafting software development and license agreements
- Explore best strategies for creating and implementing a privacy compliance program

## FACULTY

### COURSE LEADER

#### COLLEEN SPRING ZIMMERMAN

Colleen Spring Zimmerman is a partner of **Fogler, Rubinoff LLP**. Her practice is centred on IP. She is an adjunct professor of IP law at Osgoode Hall Law School at York University. She is recognized in Canada as a leading expert in IP by LEXPERT.

### CO-LECTURERS

#### ANDREW JONES

Andrew Jones, a partner of **Sim & McBurney and Sim, Lowman, Ashton & McKay LLP**, practices civil litigation with an emphasis on commercial disputes.

#### CHRISTOPHER CATES

Christopher Cates is a commercial lawyer practicing as in-house counsel for **Bell Mobility Inc.** and **Bell Canada**, specializing in IS/IT and telecommunications work.

#### CAROL HITCHMAN

Carol Hitchman of **Hitchman & Sprigings**, has been involved in a number of IP trials and appeals, along with numerous interlocutory injunction proceedings. She is a registered Canadian Patent Agent and Trade-mark Agent.

#### JASON BULLEN

Jason Bullen is a partner at **Cassels Brock** who practises in the Business Law Group.

#### DERRICK A. NOVIS

Derrick A. Novis is a Partner, Taxation Services, Canada at **KPMG LLP**.

#### J. FRASER MANN

Fraser Mann of **Miller Thomson LLP** practises primarily in the areas of technology and IP law. He has extensive experience with all aspects of procurement law, BPO and IP outsourcing transactions, licensing and agreements and telecommunication agreements.

#### STEVE CIMICATA

Steve Cimicata is Senior Counsel at **Symcor Inc.**

#### EILEEN MCMAHON

Eileen McMahon is the Co-Chair of **Torys'** IP and Food and Drug Regulatory Practices. She practises exclusively in the areas of IP and food and drug regulatory law.

#### ANDREA RUSH

Andrea Rush of **Heenan Blaikie** is a lawyer and a registered patent and trade-mark agent. She is consistently and repeatedly recognized as a leading IP specialist in Lexpert.

#### NEIL BELMORE

Neil Belmore of **Belmore McIntosh Neidrauer LLP** has been recognized by L'Expert since 1999 and is one of eight leading IP litigators in Toronto of eight leading IP litigators in Toronto.

## COURSE PROGRAM

### THE LATEST DEVELOPMENTS IN IP LAW

Understanding the current state and latest developments in domestic and international IP law and enforcement activities will help you to avoid the growing threats and risks to your brands and marks when engaging in IP transactions. This session will examine the rapidly developing field of intellectual property law, focussing on recent judicial and regulatory developments in all major areas of IP.

- Latest developments in the law impacting patents, trademarks, copyrights and the law of secrets
- Specific licensing issues relating to trade-marks, patents and copyright
- Recent IP court decisions and their impact on IP licensing transactions
- Latest and most relevant topics in IP litigation

### DUE DILIGENCE FOR COMPLEX IP AND TECHNOLOGY TRANSACTIONS

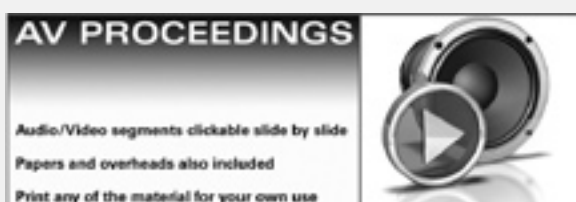
Conducting effective due diligence is critical to identify potential problems impacting the value of the deal. This session will examine key strategies and methods generally followed in respect of due diligence in IP and technology matters.

- Designing, implementing and analyzing the results of IP due diligence
- Stages of due diligence: legal and technical best practices
- Identifying IP products and services subject to the IP
- Determining nature of IP rights, territorial extent of coverage, validity of rights
- Title and ownership issues
- Key elements of a structured approach for verifying IP rights and litigation status
- Identifying relevant third-party technology and IP rights
- Resolving issues that are discovered in due diligence process
- Determining appropriate time and cost of due diligence

### SUPPLEMENTARY COURSE MATERIAL

Federated Press is now providing delegates with access to an innovative new database containing at least 25 interactive multimedia presentations by leading experts and approximately 20 hours of lectures on the topics covered by this course, including all slides and speakers' papers. See the list of presentations on page 4.

Delegates will also receive a trial subscription to the Business Law Channel, a much broader resource representing hundreds of hours of interactive multimedia lectures on leading edge Business Law topics as delivered at our many recent Business Law conferences and courses.



## DRAFTING COMPLEX LICENSING AGREEMENTS

This session will provide key considerations for securing successful negotiations, as well as drafting and structuring IP licensing agreements.

- Aligning the agreement with letter of intent/term sheet organizational goals and competencies
- Exploring joint ownership of IP
- Scope of agreement: case studies of “scope” gone right and “scope” gone wrong
- Assignability and sub-licensing issues
- Identifying third-party technology and IP rights
- Risk: areas of risk to address, who bears risk and why
- Royalty and other compensation issues
- Termination clauses and post-termination issues

## OUTSOURCING TRANSACTIONS

This session will discuss outsourcing to determine whether the assignment and access rights contained in the licensing agreement are consistent with the outsourcing transaction that is being contemplated.

- Asset ownership issues in outsourcing arrangements
- Protecting security and confidentiality in the agreement
- Licenses, proprietary rights, auditing rights and dispute resolution process
- Debunking the myth of benchmarking
- Practical and effective remedies for breach of contract, including service levels
- How to re-negotiate your current outsourcing agreement

## IP AND COMPETITION LAW: ANTITRUST RISKS

This discussion will examine how IP licensing may be restricted by statute, common or civil law relating to competition or misuse of intellectual property rights, and will consider ways to deal with these provisions.

- Impact of competition law on IP licensing
- When can civil or criminal liability arise in connection with licensing arrangements under the Competition Act
- Abuse provisions in IP statutes
- Dealing with increased international enforcement of antitrust issues

## SOFTWARE LICENSING TRANSACTIONS

This session will provide you with valuable checklists, techniques and tips for negotiating and drafting software development and license agreements.

- Licensing issues with open source software
- Risks in creating or using open source software
- Open source issues in software licensing
- Intellectual property infringement indemnities

## PRIVACY AND DATA SECURITY LAWS IMPACTING IP

This session will explore creating and implementing a privacy compliance program and its role in negotiating and drafting IP & IT agreements.

- Managing the conflict between IP protection and the protection of privacy
- Step to be taken to ensure privacy protection
- The state of the law of privacy and its impact on IP transactions
- Types of transactions giving rise to privacy concerns
- Recent case developments in privacy

## PREPARING FOR NEGOTIATION PROCESS: PRE-NEGOTIATIONS PLANNING

Getting IP and IT contractual relationships off on the right foot means effectively preparing for negotiations. This session will cover the essential steps of pre-contract negotiations.

- Establishing priorities and developing your business terms
- Identifying the stakeholders and determining who should be at the table
- Mapping negotiations and setting timelines
- Developing a negotiation strategy
- The use of background documents
- Establishing the risk profile of the transaction

## ANATOMY OF A CONTENT LICENSE FOR DIGITAL DISTRIBUTION

This presentation will operate from the perspective of the licensee when securing license rights from a media company licensing digital media assets. Specifically, this presentation will discuss:

- Identification of business models
- Complying with DRM & platform security requirements
- Assigning collective rights responsibilities
- Securing key marketing rights
- Structuring exclusivity & territorial restrictions
- Handling common warranty & indemnity issues

## NEGOTIATING CROSS-BORDER IP TRANSACTIONS

This presentation will examine the unique contract issues in cross-border licensing and look at the legal and business considerations of negotiating and drafting international IP licensing agreements.

- Types of foreign license agreements
- Special issues for cross-border technology transfers
- Dealing with the complexities of using, conveying and enforcing IP rights in a foreign country
- International infringement issues
- Differences in the IP laws between Canada and the US
- The impact of international treaties on IP transactions

## INTELLECTUAL PROPERTY PLANNING IN CHALLENGING ECONOMIC TIMES

This session will examine the structuring and use of IP holding companies and will also explore some exciting alternatives in Europe, which now offers low-tax regimes in which to hold IP.

- Intellectual property & Canadian taxation
- Tax planning strategies for holding IP offshore: the basics
- Compensation for existing technology
- Use of cost-share and other arrangements

## WORKSHOP

### MANAGING IT & IP DISPUTES

This interactive workshop will examine how to minimize the risk of future disputes and possible financial losses and the best way to resolve licensing disputes should they arise.

- Creating a dispute resolution mechanism
- Drafting and enforcing arbitration clauses and decisions
- Using self-help provisions to avoid litigation
- Perspectives of judges and arbitrators
- Hints and tips for litigation
- Settlement considerations

## MULTIMEDIA PRESENTATIONS

Your registration includes an interactive multimedia database comprising the following presentations from recent Federated Press courses and conferences. They are presented in their entirety with complete audio or video and accompanying slides. You may also purchase the multimedia proceedings of the course which will be available on CD-ROM 60 days after the course.

### Measuring the Performance of Service Providers

Simon Brown,  
PMMS Consulting Group North America Inc.

### Outsourcing Services

C. Ian Kyer,  
Fasken Martineau DuMoulin LLP

### IP Licensing Agreements: Patents, Trademarks, Copyrights, Data and Trade Secrets / Electronic Contracts

James T. Swanson,  
Burnet, Duckworth & Palmer LLP

### Tax Planning Through the IP Lifecycle

Gordon Zimmerman,  
Borden Ladner Gervais LLP

### Cross-Border IP Transactions

Brian D. Segal,  
Baker & McKenzie LLP

### Outsourcing Agreement Negotiations

Harry J. Ludwig,  
Macleod Dixon LLP

### IP Value Drivers: The Importance of Context

James L. Horvath & Steven Hacker,  
Deloitte & Touche LLP

### Optimizing SLAs: An In-House Counsel Perspective

Michael Case,  
CIBC

### Managing Intellectual Property in SLAs

Richard Owens,  
Blake Cassels & Graydon LLP

### Aligning IP with Corporate Strategy

Sandra Beauchesne,  
Bereskin & Parr LLP

### Negotiating and Drafting a Successful Outsource Transaction; Legal Aspects of Outsource Transaction; Building a Governance Framework

Daniel Paul,  
Davis LLP

### Managing Intellectual Property in Outsource Transactions

Kari L. Becker,  
Shell Canada Limited

### Due Diligence in Intellectual Property Licensing

Gordon J. Zimmerman,  
Borden Ladner Gervais LLP

### Licensing Emerging Technologies

Marcel D. Mongeon,  
McMaster University

### IP License Agreements

Martin P.J. Kratz,  
Bennett Jones LLP

### Valuing Trademarks and Brands

Ken Goodwin,  
PricewaterhouseCoopers LLP

### Patent Valuation Methodology and Issues

Brian W. Gray,  
Ogilvy Renault LLP

### Tax Treatment of the Sale and Acquisition of IP

Lorne Saltman,  
Cassels Brock & Blackwell LLP

### IP Development Tax Strategies

Kay Leung,  
Heenan Blaikie LLP

### Valuation of Technology-Related IP

James L. Horvath & Steven Hacker,  
Deloitte & Touche LLP

### Tax Treatment and Valuation of the R&D Investment

Dave Sabina,  
MEUK Corporation

### Multi-Jurisdictional Patent Litigation

Donald H. MacOdrum,  
Lang Michener LLP

### Developments in International Patent Law

John Orange,  
Blakes, Cassels & Graydon LLP

### Patent Litigation Strategies

Dino P. Clarizio,  
Bennett Jones LLP

### Patent Outsourcing

Jeffrey H.M. Charuk,  
Larial Proteomics Inc.

**Registration:** To reserve your place, call Federated Press toll-free at 1-800-363-0722. In Toronto, call (416) 665-6868 or fax to (416) 665-7733. Then mail your payment along with the registration form. Places are limited. Your reservation will be confirmed before the course.

**Location:** Metropolitan Hotel, 108 Chestnut Street, Toronto, Ontario, M5G 1R3

**Conditions:** Registration covers attendance for one person, the supplementary course material as described in this document, lunch on both days, morning coffee on both days and refreshments during all breaks. The proceedings of the course will be captured on audio or video. Multimedia proceedings with all slides and handouts can be purchased separately on a CD-ROM which will also include the course material.

**Time:** This course is a two-day event. Registration begins at 8:00 a.m. The morning sessions start promptly at 9:00. The second day ends at 4:00 p.m.

**Cancellation:** Please note that non-attendance at the course does not entitle the registrant to a refund. In the event that a registrant becomes unable to attend following the deadline for cancellation, a substitute attendee may be delegated. Please notify Federated Press of any changes as soon as possible. Federated Press assumes no liability for changes in program content or speakers. A full refund of the attendance fee will be provided upon cancellation in writing received prior to September 30, 2010. No refunds will be issued after this date. Please note that a 15% service charge will be held in case of a cancellation.

**Discounts:** Federated Press has special team discounts. Groups of 3 or more from the same organization receive 15%. For larger groups please call.

Payment must be received prior to October 5, 2010

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Toronto: (416) 665-6868

Fax: (416) 665-7733

## TO REGISTER FOR MASTERING IP & IT TRANSACTIONS

Name \_\_\_\_\_  
Title \_\_\_\_\_ Department \_\_\_\_\_  
Approving Manager Name \_\_\_\_\_  
Approving Manager Title \_\_\_\_\_  
Organization \_\_\_\_\_  
Address \_\_\_\_\_  
City \_\_\_\_\_ Province \_\_\_\_\_ Postal Code \_\_\_\_\_  
Telephone \_\_\_\_\_ Fax \_\_\_\_\_ e-mail \_\_\_\_\_  
Please bill my credit card:  AMEX  VISA  Mastercard  
# \_\_\_\_\_ Expiration date: \_\_\_\_ / \_\_\_\_  
Signature : \_\_\_\_\_  
Payment enclosed:  Please invoice. PO Number: \_\_\_\_\_

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## REGISTRATION COSTS

NUMBER OF PARTICIPANTS:   
COURSE: \$1975  
COURSE + PROCEEDINGS CD-ROM:  
\$1975 + \$175 = \$2150  
PROCEEDINGS CD-ROM: \$599  
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and follow the normal registration process