

# IP Licensing Strategies & Transactions - Creating Real Value From Your Technology Portfolio



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# Panel Introductions

**Moderator:**

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**Panelists:**

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# Welcome to Foley's Session on Creating Real Value From Your Technology Portfolio

In this panel, we will address:

- Reasons for licensing your technology portfolio
- Knowing and determining what you have available to license
- Getting corporate support for a licensing program
- Identifying potential licensing partners
- Reaching out to potential licensing partners
- Managing the relationship with a license partner
- Do's and don'ts in venture funding
- Top tips for licensing success
- Factors for establishing an appropriate royalty



## Reasons for Licensing Your Technology Portfolio

- Revenues offset manufacturing costs to increase profit margins
- Making the technology an industry standard
- Accessing the licensee's distribution and sales networks in other markets
- Reducing operations risk of entering a new market



## Reasons for Licensing Your Technology Portfolio

- Reduced R&D efforts/costs by access to licensee-developed improvements
- Obtaining cross-license of important technology owned by competitors
- Increasing brand recognition and value of trademarks
- Distinction between the licensing models of “trolling for fees” and a “mutually beneficial exchange”



## Know What You Already Have (Or Plan to Obtain) to License

- How to identify the scope of your technology portfolio and assess its strength and value in the relevant marketplace
- If looking to create or enhance a portfolio, where to look
- How to decide what portions of your portfolio you're willing to license to others and when
- How important is an IP Audit, and what are the key elements to consider



# Know What You Already Have (Or Plan to Obtain) to License

- How to balance costs of creating/protecting new IP with a limited budget
- Undertake “patent mapping”
- Undertake “patent mining”



# Getting Corporate Support for a Licensing Program

A licensing strategy may only be as effective as the willingness of the company to pursue and support it

- What factors need to be considered and presented for acceptance and buy-in
- What factors to consider in evaluating whether to license exclusively or non-exclusively
- What key attributes should a licensing team or licensing infrastructure contain





# Identifying Potential Licensing Partners

- How to identify potential license partners
- Should you target a particular niche or field
- What are the characteristics to look for in a license partner
- What are the characteristics to avoid in a license partner
- Should you look locally or globally



# Reaching Out to Potential Licensing Partners

- What is an effective strategy for reaching out to potential licensing partners
- How to present yourself or your company to potential licensing partners



## Managing the Relationship with a License Partner

- What are the important aspects of managing the relationship with a potential or actual license partner
- How to avoid or resolve misunderstandings between the parties
- What groundwork should you establish early in the relationship to keep it going smoothly in the long run



# Top Tips for Licensing Success

- Top three tips for a successful licensing relationship
- Top three pitfalls to avoid in a licensing relationship
  - Inadvertently creating implied licenses
  - Inaccurate or incomplete definition of licensed rights and/or products
  - Antitrust issues
  - Patent exhaustion
  - Incorrect royalty base assumptions



# Top Tips for Licensing Success

- Omitting performance requirement in an exclusive license
- Omitting the right to conduct audits
- Omitting requirements for licensees to mark products
- Omitting ownership terms for improvements



# Factors for Establishing an Appropriate Royalty

- What to consider
- What to avoid



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