

### WHO SHOULD ATTEND

- Technology Transfer Professionals • IP Asset Managers
- Intellectual Property Licensing Professionals • Investors
  - Inventors and Patent Owners • Research Directors
- Corporate Intellectual Property Attorneys • Business Leaders
  - Business Development Professionals
- CEOs, CFOs Directors of Emerging Companies

### TRUSTED SOURCES

Tech Transfer Central's reputation of providing the world's leading content via newsletters, distance learning and other resources, coupled with Certified Patent Value Analyst's unparalleled educational offerings for the business community, is second to none.



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To register for this virtual premier summit, visit

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# Best Practices for Monetizing Patents

A Virtual Summit

June 9, 2022 – 10:00 am - 5:30 pm ET



Brought to you by:





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## Program Overview

Your patent portfolio reflects decades of painstaking research and millions of dollars of investment, not to mention the cost of filing for and maintaining the patent. That's why it is so important to be fully prepared when it comes time to monetize your valuable patent assets.

This virtual summit event will take you through the gamut of options for optimizing the sale or licensing of your patents. Our expert panelists will:

- Guide you in preparing your patents for monetization
- Prepare you for negotiations
- Provide detailed advice on working with patent brokers
- Discuss what documents need to be prepared for each type of deal
- Reveal the motivations of buyers and licensees
- Assess patent value in exit strategies
- Explore monetization via litigation finance and sale of royalty streams
- Help you understand your post-sale obligations
- Assess the merits of selling versus licensing
- Explore patent pools and monetizing standard essential patents
- Assess the critical issues in spinning out start-ups
- Guide your deal term considerations

Even if you plan to hire a patent broker or lawyer to identify and negotiate with buyers and licensees, the insight and practical guidance from this program will help you to successfully negotiate agreements with these critical advisors.

The knowledge you'll gain from this information-packed program will have a direct impact on your patent monetization strategies and decisions – and will make a huge difference in the ultimate payout you receive.



## Event Schedule At-A-Glance

### 10:00am A Primer on Patent Monetization

Preliminary Steps to Monetizing Patents  
What to Expect When Working with Patent Brokers

### 11:00am A Primer on Spinning Off Technologies

### 11:45am Selling a Royalty Stream

### 12:15pm Preparing for Negotiations with Buyers/Licensees

### 1:00pm Monetizing Patent Through Exits

### 1:30pm Working with Contingency Lawyers and Litigation

#### Finance Companies in Patent Infringement Actions

Negotiating Contingency Fee Arrangement with Your Lawyer  
Negotiating with Patent Litigation Finance Firms

### 2:00pm Monetizing Standard Essential Patents

### 3:15pm Patent Pools for Complementary IP

### 3:45pm Deal Terms & Negotiating Strategies

### 4:30pm Patent Acquisitions from the Buyer's Perspective



## Overview of Sessions

### 10:00 am: A Primer on Patent Monetization

#### Preliminary Steps to Monetizing Patents

- Determining rights to sell
- Characteristics of appealing patent portfolios
- Rights seller wishes to retain
- Navigating through encumbrances on patents
- Continuing obligations of initial patentee/inventors
- Preparing documentation
- Managing seller's expectations
- Patent valuation reports

#### What to Expect When Working with Patent Brokers

- Due diligence period
- Duration of agreement
- Retainers, commissions, expense reimbursement
- Tails
- Client relationships
- Thresholds
- Preparation and ownership of sales materials
- Revoking preceding representation agreements
- Placing patents in the right legal entity
- Reducing the risk of invalidity attempts

**Panelists:** Erika Warner, VP – Brokerage Services, Tangible IP  
Alec Schibanoff, VP, IP Offerings  
Seth D. Levy, Partner, Nixon Peabody



## Overview of Sessions

### 11:00 am: A Primer on Spinning Off Technologies

- Identifying promising technologies and related IP
- Funding the spinoff
- Creating a holding entity
- Building management team
- Improving, testing and validating technologies
- Selling improved technologies

**Panelists:** Brad Larschan, CEO, Bastille, LLC  
Joe Runge, JD, Business Development Manager, UNeMed

### 11:45 am: Selling a Royalty Stream

- When to consider
- Potential advantages and disadvantages
- Assessing the financial pros and cons
- Valuation of future royalties
- Evaluating deal terms – key considerations
- Examples

**Speakers:** TBA



## Overview of Sessions

### 12:15 pm: Preparing for Negotiations with Buyers/ Licensees

- NDAs
- Conducting due diligence on buyers
- Facilitating due diligence
- The use of datarooms
- Roles of advisors in negotiations
- Method and timing of introductions to buyers
- Term-Sheets / Purchase Agreements
- Exclusive negotiating periods
- Offering an option to a buyer
- Sell or license options to consider

**Panelists:** Erika Warner, VP – Brokerage Services, Tangible IP  
Alec Schibanoff, VP, IP Offerings  
Paul J. Corson, Senior Director of Innovation, University of Utah

## Overview of Sessions

### 1:00 pm: Monetizing Patents Via Exits

Learn how private companies can best manage and position their patent portfolios to achieve maximum valuations when those companies get acquired or become public companies.

**Speaker:** Bao Tran, Founder, Patent Professional Corporation

### 1:30 pm: Working with Contingency Lawyers and Litigation Finance Companies in Patent Infringement Actions

- Negotiating Contingency Fee Arrangement with Your Lawyer
  - Exclusive review periods
  - Firm and partner selection
  - Retainers / expense sharing / splitting of proceeds
  - Shifting of success fees from sequential infringers
  - Handling of invalidity challenges and counterclaims
  - Authority to settle
  - Impact and distribution of treble damages
  - Compensating law firm when business arrangements result from assertion
  - Resignation and termination of law firm and potential related malpractice exposure
- Negotiating with Patent Litigation Finance Firms
  - Legal authority to operate
  - Representations and warranties
  - Extent of financing
  - Permissions and veto rights
  - Disclosure of party of interest
  - Interest and other expenses to the patentee
  - Legal exposures to finance firm and patentee

**Speakers:** Michael O'Shea, Founder, The O'Shea Firm  
Katherine Wolanyk, Managing Director, Burford Capital

## Overview of Sessions

### 2:00 pm: Monetizing Standard Essential Patents

- Definitions of standard essential patents
- Determining real essentiality
- Evaluating declarations
- Assessing enforceability
- Determining FRAND opportunities and obligations
- Understanding SEP monetization procedures
- Formulating royalty rates

**Speaker:** Adam Saxon, Senior Vice-President, Dominion Harbor Group

### 3:15 pm: Patent Pools for Complementary IP

- SEP and non-SEP pools
- Advantages and disadvantages of patent pools
- Identifying appropriate IP for pooling
- Typical structure and operation of patent pools
- Terms and royalty sharing structures

**Speakers:** Dean Skandalis, Senior Vice President of Global Licensing and Compliance, MPEG LA



## Overview of Sessions

### 3:45 pm: Deal Terms & Negotiating Strategies

- Residual rights & grant-backs
- Purchasing patents with cash, stock, other
- Sequencing of approaching infringers
- Orchestrating the sequencing of assertion efforts around the world
- Minimums
- Royalty structures
- Sublicensing
- Covenants not to sue
- Buy it now price
- Buyers asking for more time to gain insight into demand
- Best and final offers
- Monetizing very large patent portfolios
- Assertion-based monetization in China

**Speaker:** Louis Carbonneau, CEO, Tangible IP



## Overview of Sessions

### 4:30 pm: Patent Acquisitions from the Buyer's Perspective

- Identifying most receptive companies
- Reducing the risk of potential patent buyers moving to invalidate or bring declaratory judgments against proffered patents
- Attractive features of prior art, claims, patent families, remaining lives and dependent claims relative to independent claims
- Risk of evidence of infringement having been invalidly obtained
- Preferred valuation methods
- Attraction of expired patents in terms of enforceability for past infringement
- Linkage between forward citations and patent salability
- The merits of corporate buyers disguising their identity by retaining intermediaries
- Revealing the identity of secretive corporate patent buyers
- Differences in selling patents to privately-held corporate patent buyers versus publicly-traded patent buyers

**Panelists:** Marc Booth, Chief IP Officer, Acacia Research  
Michael Lubitz, Managing Director & Founder,  
Global Technology Transfer Group  
Adoram Shemesh, Intellectual Property Consultant, PulseIP

## Continuing Education Information

### CLP and CLE Credits Available

We submit CLE applications in your state (excluding NY, NJ, IL, LA & PA) for an additional \$150. Approval times vary per state and cover all attorneys in attendance. Application is not a guarantee of approval and attendance forms must be submitted following the program. Please refer to your state bar's distance learning regulations for further information.

### Registration Information

Online registration available by visiting:

[www.cpva.info](http://www.cpva.info)

Or by calling Neomi Barazani at  
609 919 1895 ext. 100

Or by emailing [neomi@bdacademy.com](mailto:neomi@bdacademy.com)

**Registration fee** is \$495

**Add this summit to your training library!**

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# Summit Chairman

David Wanetick, CEO, Certified Patent Valuation Analyst

David Wanetick is a world-renowned authority on valuing intangible assets, particularly patents. He prepares Patent Valuation Reports that are used to facilitate transactions such as capital raises, sales of companies, sales of patent portfolios and licensing agreements. His reports are instrumental in pricing transactions worth hundreds of millions of dollars. Mr. Wanetick's clients include Fortune 500 companies, emerging companies, private equity and venture capital funds, universities and government agencies.

He developed the Certified Patent Valuation Analyst designation. Mr. Wanetick has taught this world-renowned course all over the globe including in India, Israel, Thailand, Singapore, China, Hong Kong, Malaysia, Dubai, the Philippines, France, the Netherlands, Spain, the United Kingdom, Belgium, Denmark, Germany and Canada. Attendees include IP asset managers, licensing executives, tech transfer professionals, patent lawyers, patent examiners and inventors.

Mr. Wanetick is Managing Director at JD Merit, a boutique investment bank with an expertise in selling middle market companies in a wide array of industries to operating companies and to private equity funds and their portfolio companies. JD Merit is also active in effecting capital raises at the B round and beyond.

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