

TECHNOLOGY IP DUE DILIGENCE

Identifying, protecting and exploiting a company's most valuable assets in M&As, licensing, purchases and other collaborations

June 21-22, 2007 | Mandarin Oriental, San Francisco, San Francisco, CA

CO-CHAIRS:



Rajiv P. Patel
Partner
Fenwick & West LLP
(Mountain View, CA)



Kent Richardson
Vice President, Intellectual
Property
Rambus Inc. (Los Altos, CA)

INDUSTRY INSIGHTS FROM:

EMC Corporation

IBM Corporation

L-3 Communications MAPPS Inc.

Rambus Inc.

Tessera, Inc.

VantagePoint Venture Partners

...and many more

AVOID MISSED OPPORTUNITIES AND COSTLY MISTAKES BY LEARNING HOW TO:

- **ALIGN** due diligence strategy with business objectives
- **ASSEMBLE** a due diligence team of experts who can best assess potential problems
- **ENSURE** actual ownership of IP assets and their functionality
- **CRAFT** comprehensive representations, indemnifications and warranties that will **MINIMIZE** risks of infringement or potential litigation
- **USE** licenses to achieve business goals
- **ATTRACT** investors through good internal due diligence practices
- **CONDUCT** due diligence for e-business and Internet services
- **MERGE** acquired technologies without "infecting" existing technologies

Enhance your conference experience by attending our Master Class:

Overcoming Ownership and Licensing Challenges

Presented by Open Source and Standards Bodies Participation

June 22, 2007, 2:15 – 5:00 p.m.

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Failing to conduct a proper IP due diligence review can cost a company millions!

Because intellectual property assets are so central to extending a product's time on the market, warding off competitors, and producing a constant revenue stream, neglecting to detect problems with a potential partner's or acquisition target's IP could nullify the purpose of the transaction...and cost millions.

Protect the company's investments through effective due diligence reviews

American Conference Institute has been a leader in technology licensing conferences for years, and the pharmaceutical and biotech industries have come to rely on **ACI** for the premier IP Due Diligence event for their sector. Now, **ACI** brings its expertise in high-quality, expert-level intellectual property events to the general tech sector with **Technology IP Due Diligence**. Get the tools you need to evaluate fully the strengths and weakness of an IP portfolio, and learn how to overcome problems that the diligence uncovers.

Plus, enhance your conference experience by attending our Master Class on Overcoming Ownership and Licensing Challenges Presented by Open Source and Standards Bodies Participation. This comprehensive session will teach you how to understand the obligations imposed by open source and standards bodies, and how to work around them.

Register today

Don't miss this opportunity to hear from legal practitioners at the forefront of technology IP due diligence. Take this chance to network with colleagues from across the country and benefit from the extensive written materials prepared by the speakers especially for this conference. Register now to ensure your place at what's sure to be a sold-out event. Call **1-888-224-2480**, fax your registration form to **1-877-927-1563**, or register online at **www.americanconference.com/techpdiligence**.

AGENDA-AT-A-GLANCE

- Developing and Implementing a Due Diligence Methodology That Will Provide Accurate Evaluations of Risks and Rewards
- Assembling and Managing a Due Diligence Team That Can Detect Potential Problems
- Ensuring Functionality and Actual Ownership of IP Assets Before the Deal is Finalized
- Preventing Adverse Findings From Terminating the Deal
- Preserving the Attorney/Client Privilege and Ethical Considerations When Conducting Due Diligence
- Examining and Drafting Licenses to Effectuate Business Objectives
- Getting Your "IP House" in Order: Protecting Existing IP and Using IP Assets to Increase the Company's Worth
- What Venture Capitalists and Other Investors Look for in IP Portfolios
- Detecting and Overcoming New Due Diligence Concerns Presented by E-Business and Internet Services
- Detecting Integration Problems in the Course of Due Diligence

WHO YOU WILL MEET

In-house

Chief Intellectual Property Officers
Patent Counsel
IP Counsel
General Counsel

Law firm attorneys with practice areas in

Intellectual Property
Patents
Copyrights
Trademarks
Mergers & Acquisitions
Technology Transactions

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Benjamin Greenzweig
Director of Business Development, U.S.
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bg@americanconference.com

8:30 Co-Chairs' Opening Remarks



Rajiv P. Patel
Partner, Fenwick & West LLP (Mountain View, CA)



Kent Richardson
Vice President, Intellectual Property
Rambus Inc. (Los Altos, CA)

8:45 Developing and Implementing a Due Diligence Methodology That Will Provide Accurate Evaluations of Risks and Rewards



Krish Gupta
Associate General Counsel, Intellectual Property
EMC Corporation (Hopkinton, MA)



Taraneh Maghame
Vice President, M&A and Government Relations
Tessera, Inc. (San Jose, CA)



Gerald F. "Jerry" Swiss
Partner
Foley & Lardner LLP (Palo Alto, CA)

Developing the methodology

- Determining when IP due diligence should be done
- Aligning the due diligence strategy with business objectives
 - establishing what the due diligence is meant to accomplish
- Adjusting the due diligence strategy based on the type of transaction that is being contemplated
 - financing
 - M&A
 - divestiture/spin-out
 - collaboration
 - in-license, co-development, co-promotion
- Using the information obtained through due diligence to meet business goals

Implementing the methodology in a due diligence review

- Understanding what the due diligence checklist should look like
 - sample checklists
- Requesting a list of IP assets
 - interviewing employees to confirm information provided by the seller
- Asking for cease and desist letters or letters from patent trolls
- Searching for existing licenses
- Making sure employee agreements correspond with the company's overall IP strategy

Tailoring due diligence efforts to different types of IP

Patents

- Basing the type of patent analysis needed on the importance of the IP to the business deal
- Assessing the competitive landscape
- Finding existing patents that the target technology may be infringing on
- Determining whether conducting a patent search is the best strategy
- Examining the claims set forth in the patent to ensure they provide adequate protection for the technology

Trademarks and Copyrights

- What brands survive and what factors cause a brand to survive?
- Franchise issues
- Dealing with IP assets consisting of copyrighted material

10:30 Morning Refreshment Break ☕

10:45 Assembling and Managing a Due Diligence Team That Can Detect Potential Problems



Daniel A. Crowe
Partner, Bryan Cave LLP (St. Louis, MO)



Patrick D. Ertel
Partner, Marshall, Gerstein & Borun LLP (Chicago, IL)

- Choosing the right counsel for the deal
 - getting in-house and/or outside IP counsel involved early on in the deal
 - finding outside IP counsel that has a realistic perspective
 - knowing if and when to get outside IP counsel involved
 - determining the role of outside IP counsel and communicating the company's needs accurately to them
- Strategies for identifying technology experts when the technology is unfamiliar to the acquiring company
- Dividing up the labor efficiently amongst the team based upon expertise
- Identifying and deploying technology tools to optimize speed, quality, and cost goals
- Keeping the lines of communication open between members of the team
 - methods for providing information to the team
- Helping the business people resolve the IP issues in order to move forward with the transaction
 - providing solutions beyond issue spotting
 - effectively communicating risk

11:30 Ensuring Functionality and Actual Ownership of IP Assets Before the Deal is Finalized



Emily Miao, Ph.D.
Partner
McDonnell Boehnen Hulbert & Berghoff LLP (Chicago, IL)



Tamsen Valoir, Ph.D.
Partner, Baker & McKenzie LLP (Houston, TX)

- Determining the ownership of IP
 - finding the owner of record
 - conducting a title search
 - using appropriate naming conventions
 - searching the chain of title
 - using sources that can shed light on ownership
 - PTO resources
 - Internet resources
 - ensuring that the target company can convey clear title
 - assignment of licenses to third parties
 - scrutinizing in-license and out-license agreements to ensure rights being acquired are consistent with the proposed transaction and business strategy
- Preventing inventor issues from interfering with ownership
 - transfer of rights
 - confusion as to who the inventor is
 - tracing assignment back to the inventor
 - reviewing employment contracts of inventors
 - identifying inventor obligations to third parties
 - reviewing inventor notebooks
 - investigating factual circumstances in which the inventor is operating
 - background searches of inventors
 - verification for each inventor
- Determining whether timely payment has been made of maintenance fees
- Assessing the impact of third-party rights on the acquiring company
- Substantiating claims of what the technology can do

- Employing a good interview process in order to get to the truth about the technology
 - understanding the technology to create a list of solid questions
 - obtaining different perspectives to help define the reality of the situation
- Uncovering malfunctions that may render the technology unusable
- Determining whether supporting technology is needed to make the acquired technology work
 - who owns the rights to the supporting technology?
 - how can the acquiring company use the supporting technology if necessary?

12:30 Networking Luncheon

1:45 Preventing Adverse Findings From Terminating the Deal



Taraneh Maghame
Vice President, M&A and Government Relations
Tessera, Inc. (San Jose, CA)

- Determining whether or not the adverse finding really is a deal killer
- Responding to letters from patent trolls in the midst of an acquisition
 - assessing the validity of the letter, the cost of fighting it, and the cost of settling
- Utilizing JDAs and other strategies for minimizing potential complications stemming from existing litigation
- Assessing the amount of escrows for actual and potential infringement claims
- Resolving risks through the proper drafting of representations, indemnifications and warranties
 - determining who should be responsible for the risks
 - drafting representations so as to reflect what is truly of value to the acquiring company
 - dealing with violations of representations, indemnifications or warranties after the deal is completed

2:45 Afternoon Refreshment Break

3:00 Preserving the Attorney/Client Privilege and Ethical Considerations When Conducting Due Diligence



Glen P. Belvis
Shareholder
Brinks Hofer Gilson & Lione (Chicago, IL)

- Weighing the risk of what privileged information should be disclosed and when in the course of the due diligence review
- Determining who will have access to privileged documents
- Under what circumstances is privilege considered waived when documents are shared?
 - assessing the risk versus the need to share documents to complete the deal
- Protecting privileged and confidential information in the event the deal falls through
- Evaluating the duty to investigate and report potential patent prosecution defects
- Considering the attorney's ethical duties to disclose
- Determining what to do with information obtained through dubious means
- Understanding the pitfalls of using due diligence activities in related litigation

4:00 Conference Adjourns to Day 2

8:15 Co-Chairs' Opening Remarks

8:30 Examining and Drafting Licenses to Effectuate Business Objectives



Dominique Babin
General Counsel, L-3 Communications MAPPS Inc. (Quebec, Canada)



Megan D. Dortenzo
Partner, Thompson Hine LLP (Cleveland, OH)



Earl J. LaFontaine
Shareholder, Brooks Kushman P.C. (Southfield, MI)

- Evaluating ongoing obligations under licenses
 - are agreements transferable?
 - will there be problems with assignments?
- Preventing a termination of the license as a result of the change in ownership
 - negotiating with the licensor when the buyer has the most leverage
- Examining expiration dates of material licenses to ensure that the seller is not potentially in breach
- Renegotiating royalty rates
- Resolving potential licensing problems created by spin-off technology
 - deciding when the purchaser needs a license to retain IP
 - how to handle third-party license rights that are necessary to both seller and purchaser
- Reviewing purchaser's licenses for potential conflicts with seller's licenses

9:15 Getting Your "IP House" in Order: Protecting Existing IP and Using IP Assets to Increase the Company's Worth



Michael L. Kiklis
Partner, Akin Gump Strauss Hauer & Feld LLP (Washington, DC)

Steve Soucar
Software Group Headquarters Division IP Law Counsel,
IBM Corporation (Somers, NY)

Wendy Haller Verlander
Partner, Wilmer Cutler Pickering Hale and Dorr LLP (Boston, MA)

Best practices for identifying underutilized assets and potential liability issues and cutting costs

- Conducting prior art searching to avoid infringement liability when investing in new products
- Obtaining appropriate opinions before new product launch
- Reviewing third-party and employment agreements
- Monitoring the status of existing patent applications and the products they cover
 - monitoring competitors' patents and their impact on a company's existing patents
 - monitoring competitors' products to align a company's patents accordingly
- Evaluating the importance of existing patents to the overall IP and/or business strategy
 - eliminating costly filing, prosecuting and maintenance fees for patents and applications that are no longer relevant to the company
 - strengthening your IP portfolio in the areas of business growth
 - obtaining defensive patents in the event you are sued

Conducting IP audits

- Scheduling routine IP audits
- Establishing the scope of the audit
- Implementing appropriate company procedures
- Assessing whether the company should increase or decrease IP protection in specific sectors of the business

Realizing the most value for IP assets

- Knowing the company's IP assets and their value in order to get the true worth of the company

- in preparation for litigation
- to use in licensing
- for investment purposes
- Control issues for targets
- Creating an exit strategy

10:00 Morning Refreshment Break

10:15 What Venture Capitalists and Other Investors Look for in IP Portfolios



James G. Gatto
Partner, Pillsbury Winthrop Shaw Pittman (McLean, VA)



Rajiv P. Patel
Partner, Fenwick & West LLP (Mountain View, CA)



Cynthia Ringo
Managing Director, VantagePoint Venture Partners (San Bruno, CA)

- What VCs are looking for in your patent estate when conducting due diligence
 - trends in the industry
 - risk assessment
 - adding value
- Differences between investor-side due diligence and mergers and acquisitions
 - focus on improving the portfolio for investor-side deals versus a mature portfolio for M&A
 - period of exclusivity
- Handling cost concerns
 - making use of company resources and previous diligence information
 - focus on potential deal-breaking issues first
 - keeping expectations in line
- Analyzing the complicated conflict concerns
 - no-contact rule
 - confidentiality issues
 - privilege issues
 - syndication
- How to present your IP assets when approaching a VC

11:00 Detecting and Overcoming New Due Diligence Concerns Presented by E-Business and Internet Services



Michael R. Graif
Partner, Venable LLP (New York, NY)

- Evaluating “online exposure”
 - reviewing policies and procedures for handling unauthorized posting of copyrighted materials
 - ensuring compliance with the DMCA safe harbor provisions
 - reviewing take-down requests and responses
 - reviewing terms of use and privacy policies
 - evaluating promotional materials and potential *Grokster* exposure
 - ensuring compliance with SPAM and phishing laws
- Addressing data privacy concerns
 - assessing procedures for collecting, handling and retaining personal information
 - reviewing privacy policies and terms of use
 - examining relevant federal and state statutes
 - complying with international data privacy laws

12:00 Detecting Integration Problems in the Course of Due Diligence

Henry W. “Hank” Jones, III
Law Offices of Henry W. Jones, III, (Austin, TX)

- Ensuring there are no legal restrictions to integrating newly acquired technology with existing technology before the deal is finalized
- Determining how quickly to integrate
- Deciding who will manage the integration
- Merging technologies without “infecting” existing technology
- Honoring outstanding vendor agreements
- Dealing with terminated products and product lines

12:45 Conference Concludes

MASTER CLASS

Overcoming Ownership and Licensing Challenges Presented by Open Source and Standards Bodies Participation

JUNE 22, 2007 (2:15 P.M. TO 5:00 P.M.)

(Lunch for Master Class participants from 12:55 P.M. – 2:00 P.M.)



Dr. Lothar Determann

Partner
Baker & Mackenzie (San Francisco, CA)

Henry W. “Hank” Jones, III
Law Offices of Henry W. Jones, III (Austin, TX)

The hidden risks from undisclosed open source software can have devastating consequences, from open source license compliance issues to infecting proprietary technology. Participation in standards bodies also raises unique questions about ownership of technology and compliance with licenses. This master class will guide you through the intricacies of open source and standards bodies participation. Learn how to detect hidden open source software and standards bodies’ licensing obligations and how to complete a transaction without letting these challenges spoil the deal.

Open Source

- Determining whether programs contain open source
- Examining the impact of open source licenses on the technology
 - what applications do those licenses have?
 - determining whether the buyer can live with the obligations imposed by the licenses
- Examining the SOX implications
- Averting the possibility of open source infecting existing technology
 - eliminating and/or rewriting open source code in order to integrate the technology with existing IP assets

Participation in Standards Bodies

- Determining whether a buyer is or has been a participant in a standards body
- Examining the obligations resulting from participation
 - licensing and disclosure requirements

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American Conference Institute presents

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MASTER CLASS:

Overcoming Ownership
and Licensing Challenges
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JUNE 22, 2007

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