

# INTELLECTUAL PROPERTY AS A TOOL IN TECHNOLOGY TRANSFER

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## Role of the Practitioner in Trademark Licensing and Technology Transfer Agreements

- I. Identify and protect the client's IP; development of IP portfolio and protection plan
- II. Conducting IP Due Diligence
- III. Risk Management: Review of Licensing Agreements ("LA") and Technology Transfer Agreements ("TTA") including advice on tax implications
- IV. Transacting and coordinating with government agencies (*i.e.*, DITTB /IPO; BIR; SEC)

## ***Creation of an IP Protection Plan***

- *What do I have? Is it adequately protected?* Ensure that all the IP generated and/or possessed are captured and protected
- *What do my competitors have? Am I at risk of being charged with infringement?*
- *Do I have a strategic plan to leveraging of these IP assets to increase revenues and identify new market opportunities?*

## ***Conducting IP Audit/IP Due Diligence***

- IP AUDIT:
- Determine what IP you have, what are used and what need not be maintained.
- Includes assessment of the value of IP for purposes of sale or valuation

## ***Review of LAs and TTAs***

1. In the Philippines: COMPLY WITH IP CODE PROVISIONS ON VOLUNTARY LICENSING
2. Identification of issues: legal, financial, technical

## ***Transacting with Government Agencies***

- i. Documentation, Information, and Technology Transfer Bureau (DITTB)
- ii. Philippine Intellectual Property Office (IPO)
- iii. Bureau of Internal Revenue (BIR)
- iv. Securities and Exchange Commission (SEC)



LICENSING EXECUTIVES SOCIETY  
INTERNATIONAL

Advancing the business of intellectual property globally



[www.lesi.org](http://www.lesi.org)



## WHAT IS LES ?

A premier global business association for licensing whose members, as individuals worldwide, are actively involved in business activities concerned with transfer of technology and intellectual property rights.

- An association of individual societies cooperating under one umbrella.
- The first society (LES USA) was founded in 1965.
- The latest society (LES Thailand) was admitted on 12 April 2015
- 33 Member Societies
- 85 Countries represented
- 10,000 Individual Members
- Worldwide





## MISSION OF LES

To function as a non-profit professional organization to broadly support LES Societies in their efforts on behalf of individual members by:

- Setting and promoting of ***consistent, high professional standards*** for licensing executives on a global basis
- Creating and maintaining various geographically based LES Societies with the necessary quantity and balance of local members
- Providing organizational leadership, coordination and advice
- Facilitating ***professional networking*** between the members of LES Societies
- Providing ***quality educational content*** to, and facilitating the sharing of educational content between, LES Societies
- To inform and interact with global organizations and policy forums concerning the economic significance and importance of licensing and other transfer of technology and intellectual property rights.



## Who are members of LES

- Managing Directors and Company Executives
- Small Business Entrepreneurs
- University Licensors and Campus Company Managers
- Venture Capitalists
- Inventors
- Accountants
- Scientists and Engineers
- Lawyers
- Patent and Trademark Attorneys
- Academics
- Government Representatives
- Technology Brokers and Consultants

## Benefits of Membership

- Networking
- Business Opportunities
- Education
- Common Issues / Experience
- Quarterly Journal - *les Nouvelles*
- International Membership Directory
- Access to LES websites
- Publications and Educational material
- National, Regional and International Conferences
- Licensing Courses
- Special Interest seminars and workshops



# INTERNATIONAL CONFERENCES

- LESI conference 10 – 15 April 2015 – Brussels
- LESI conference 2016 – Beijing
- LESI Conference 2017 – Paris
- LESI Conference 2018 – Yokohama



# Board of Directors 2014 - 2015

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## **Ad Hoc Committees (LESI)**

- **Global Technology Impact Forum**
- **Young Members Congres**

# Thank you

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