

**GWIIN**

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## **Licensing From Asia into the UK**

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# Introduction

- Who We Are
- What is Meant by Licensing
- Difference between Licensing and Assignment
- What can you Licence?
- Distribution and Agency
- Legal Issues
- Contractual Issues
- Risk Management

# WHO WE ARE

- Specialist Commercial Law firm in the City of London
- Consortium (Corporate Computer Consultants and Consulting First)
  - Legal work
  - Business consultancy
- Work closely with Inventors, start-ups, universities, spin-outs, charities, corporate organisations
- Office in London and Caribbean. Opening office in Cambridge
- Set up China-UK partnership - to establish similar partnerships in Singapore and the rest of Asia
- Areas of Law:
  - Intellectual Property
  - Licensing
  - Biotechnology
  - Corporate Finance
  - Technology Transfer
  - Franchising
  - Business Consultancy
  - Import/Export
  - Pharmaceuticals and Regulatory
  - Employment/Labour Law
  - Commercial Contracts
  - Outsourcing
  - Distribution/Agency Agreements
  - IT Consultancy
- Package for Businesses/investors wishing to establish businesses in the UK
- Copies of Brochures on our Stand

# What is Meant by Licensing?

- Authorising a third party to license your product, trade mark patent, know how:
  - Market
  - Sell
  - Manufacture
  - Distribute
- Quality provisions in Licence – e.g trade marks, how product to be manufactured?
- Find Licensor/distributor or agent in the UK
- Franchise
- Royalties
  - Negotiate levels of royalties
  - No fixed royalties

# What Can you License?

- In return for royalties - third party to license your product, IPR's (trade mark, copyright, design, patent, know how):
  - Licence Agreement – include all terms and conditions of licence
- Assignment – sale or outright transfer of your intellectual property rights in return for a fee
  - Valuation of IPR's
  - Agreement

# What Can you License?

- Intellectual Property Rights
  - Trade Marks – e.g logos, names and brands
  - Patents and Know-how – processes, trade secrets
  - Registered Designs – shape or contour of design applied to product
  - Copyright e.g. copyright in software
- Product

# Distribution Agreements

- Form of licencing
- Finding the right distributor
- Distribution Agreement
- Terms and Conditions of Sale
- Distributor is independent of Supplier
  - Manufacture in Asia and/or Europe
  - Export Costs
  - Registering name of product/brand in the UK – if name is available
  - Trade Marks – e.g. logos, names and brands
  - Patents and Know-how – processes, trade secrets
  - Registered Designs – shape or contour of design applied to product
  - Copyright e.g. copyright in software
- Product
- Performance criteria – distributor
- Terms of Distribution Agreement

# Agency Agreements

- Form of licencing
- Finding the right Agent
- Agency Agreement
- Terms and Conditions of Sale
- As Principal responsible for actions of agent
  - Manufacture in Asia and/or Europe
  - Export Costs
  - Marketing and/or sales – signing contract – principal/agent
  - Registering name of product/brand in the UK – if name is available
  - Trade Marks – e.g. logos, names and brands
- Payment of Commission
- Termination of Agency
  - Compensation
  - Indemnity



# Legal Issues

- Confidentiality Agreements
- Head of Agreements – non binding
- Exclusive or non-Exclusive Agreements
- Registration of IPR's
- Scope of the Licence
  - Terms
  - Termination
  - Warranties
  - Indemnity
  - Limitation of Liability
  - Infringement of IPR's
  - Improvements
  - Competition Law
  - Taxation
  - Territory
  - Jurisdiction

# Commercial Issues

- Who is going to be appointed
- Finding a lawyer
- Royalty payment –distribution or licensing agreement
- Distributor
  - Payment Structure
    - Quarterly payments
    - Statements
    - Audits
  - Samples
  - Quality controls
  - Performance Criteria
- Agent
  - Performance Criteria

# Risk Management

- Ownership of IPR's
- Packaging – register as design, trade mark
- Names and logos – register as trade marks
- Patents – Obtain patents before going into territory
- Use Symbols - ®, ™, ©
- Websites – Terms and Conditions drafted; notices; Assignment of IPR from designer to your business
- Insurance
- Insurance of IPRs

## Conclusion

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