



## **The Chemicals, Environment, Energy and Materials (CEEM) Committee**

**of LES South Africa**

presents

### **Cross Border Transfer or Licensing of Registered and/or Unregistered Intellectual Property – A South African Perspective**

**An Afternoon with Experts**

**31 August 2023**

#### **ABSTRACT**

- This panel will focus on a selection of matters that involve two key issues: (i) exchange control requirements for cross border IP transactions & (ii) situations involving cross border IP licenses and will address issues such as: Whether South African Exchange Control approval is required for out-licensing of SA-owned IP under Regulation 10(1)(c)
- Whether a subscription for a software-implemented services (e.g. cloud-based SaaS) would be deemed to be an “IP licence” for which this approval is required
- Related party transactions – the introduction of transfer pricing considerations
- Loop structures; tainted IP; and sale-and-leaseback scenarios
- Lump sum royalties vs recurring royalty payments which model is “better”?

The panel will be directed at legal, technical and financial executives alike.

#### **FACILITATOR**

Darren Margo – Margo® Attorneys, Inc.

#### **SPEAKER PANEL**

- Theo Doubell – Director/Partner & Patent Attorney – Bouwers Incorporated
- Dina Biagio – Partner, Spoor & Fisher, South Africa
- Dr. Madelein Kleyn – Chief Legal Officer of Omnisient (Pty) Ltd; and founder of Mad K IP Consulting (Pty) Ltd
- Jana van Zyl – Director, Dommissie Attorneys Inc.

## PROFILES

### Darren Margo

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| QUALIFICATION OBTAINED    | Admitted Attorney (Membership No.: 22119)                     |
| QUALIFICATION OBTAINED    | Registered Patent Attorney                                    |
| PROFESSIONAL REGISTRATION | Registered Tax Practitioner (Registration No.: PR-6073B88)    |
| PROFESSIONAL MEMBERSHIP   | South African Institute of Intellectual Property Law – Fellow |
| PROFESSIONAL MEMBERSHIP   | Member of the Licensing Executives Society – South Africa     |

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|-------------------------|--|
| INSTITUTION             | University of the Witwatersrand, Johannesburg  |
| QUALIFICATIONS OBTAINED | i. <b>BSc</b> (Chemistry; Applied Chemistry);<br>ii. <b>LLB</b> ; and<br>iii. <b>BSc</b> (Mathematics) |

Darren commenced his professional career qualifying as a patent attorney, specialising in the drafting & prosecution of patent applications, and conducting patent searches. He also prepared opinions on novelty and infringement matters in the fields of patent, design and copyright law. He soon found that his interest lay in the commercial aspects of intellectual property (“IP”), and he became involved in the drafting of commercial agreements having IP as basis (typically: licence agreements, supply and distribution agreements, assignment of copyright agreements, confidentiality agreements). Darren continued to immerse himself and practice in these areas when he joined Adams & Adams patent attorneys, before being invited to join Deloitte and Touche, where he was involved in the investigation and assessment of taxpayers’ technologies and activities, with an eye to maximising R&D income tax deductions.



Since then, he also advised the National Treasury, the SA Revenue Services and the Department of Science & Technology on issues of legislative drafting and interpretation in the Income Tax Act. Darren also has a particular interest in the exchange control issues that arise in transactions having IP as basis. He is actively involved in making regular submissions to and for the South African Institute Of Tax Professionals (SAIT).

The mainstay of Darren’s practice remains IP prosecutions. He attends to the registration and maintenance of high-profile trade mark, patent and design cases in South Africa and internationally. Darren prides himself on filing applications in the most unusual of territories: from Bhutan, to Cape Verde to Kazakhstan. Collectively, Darren has conducted technical and legal work for a number of clients across a spectrum of industries, including the pharmaceutical, petrochemical, electronics, explosives, cosmetics, weapons and telecommunications industries, amongst others.

## **SPEAKER PANEL – PROFILES**

### **Theo Doubell**

Theo Doubell is a chemical & metallurgical engineer and a practicing patent attorney, with B. Eng (Chemical & Metallurgical) engineering, obtained with an Anglo American Scholarship from the University of Stellenbosch, and B Proc. and LLB law degrees, obtained from the then Rand Afrikaans University (i.e. the University of Johannesburg).

Theo is admitted to the High Court of South Africa and a member of the Law Society of the Northern Provinces; a fellow of the South African Institute of Intellectual Property Law (SAIIPL); a member and past President of the Licensing Society of South Africa (LES SA); a member of the International Federation of Intellectual Property Attorneys (FICPI), the International Trade Mark Association (INTA) and the International Licensing Society (LESI); a past committee member of LESI's standing committee on Intellectual Property Valuation and a member of the Expert Consultative Group on Valuation of Intangible Assets of the World Intellectual Property Organization (WIPO).

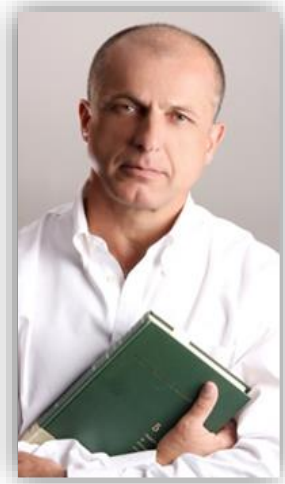
Theo has more than 30 years' experience in technology and intellectual property related matters and is recognized as an expert in the procurement, protection, enforcement and commercialisation of intellectual property internationally.

Theo has represented private, multinational and public entities, tertiary institutions and national governments in IP related matters.

Theo has advised on local and cross-border transactions, research & development programmes, listings, group restructurings, mergers, public-private partnerships, industry clustering, SA Reserve Bank approvals, tax write-offs and liquidations over a period of nearly three decades. During this time, Theo has also acted & appeared as expert witness concerning valuations and the quantification of damages in IP litigation.

Theo has participated in the drafting of both the Technology Innovation Agency Act and the Intellectual Property Rights from Publicly Financed Research and Development Act and their Regulations and has made various submissions and presentations to the Parliamentary Standing Committees on Science and Technology and Trade and Industry regarding these Acts and Regulations for various multinationals, LES SA and other interest groups.

He has delivered various papers, seminars and lectures, and has participated in numerous panel discussions and workshops locally and abroad, regarding all aspects of IP, including the SA National System of Innovation and its National R&D and IP Strategies and Systems, with stakeholders such as the SA Government (the DTI, DST, SARS and Treasury), the Organisation for Economic Co-operation and Development (OECD), the Pan African Intellectual Property Organisation (PAIPO), WIPO, the International Partnership for Hydrogen & Fuel Cells in the Economy, LESI and LES SA.



### Dina Biagio



Dina is a Patent Attorney with BSc (Physics), BSc (Elec Eng) and LLB degrees and a partner of Spoor & Fisher.

Qualified in 2002, Dina has over two decades of experience, primarily in commercial transactions relating to intellectual property, specifically in licensing; software subscription and reselling; intragroup ownership and licensing structures; compliance of IP transactions with exchange control regulations; benefit-sharing arrangements; IP audits, risk management and valuation. Dina has a keen interest in IP-related aspects of open source programming, cloud computing and software-as-a-service (SaaS); and exhaustion of rights.

Dina's experience in intellectual property transactions has been recognised by her peers, colleagues and clients, amongst others, in Chambers Global (2022-present), Legal 500 (2022-present), Best Lawyers (2022-present), World Trademark Review (2022-present) and Managing Intellectual Property IP Stars (2015-present).

Dina has contributed to numerous publications on IP in Business Transactions, including in Dean & Dyer: Intellectual Property Law in South Africa (Oxford University Press), 2014; Thomson Reuters' *Practical Law* and *Global Guide* and Lexology's *Getting the Deal Through*.

Dina is a lecturer and examiner for the Patent Examination Board, on the Trade Related Aspects of Intellectual Property Rights (TRIPS) and is a regular speaker on the commercialisation of intellectual property.

### Madelein Kleyn

Dr. Madelein Kleyn has more than 30 years experience as an international intellectual property practitioner, patent attorney and in-house legal corporate counsel for Sasol Limited for 17 years and Oro Agri (Pty) Ltd. Her experience span a broad industry base and covers petrochemical, agri, university technology transfer at Stellenbosch University and data industries. She is presently the Chief Legal Officer of Omnicient (Pty) Ltd a fintech start up specialising in privacy enhancing software and the licensing thereof. She is also the CEO and founder of Mad K IP Consulting (Pty) Ltd which core business is advisor services relating to IP strategy, IP protection mechanisms, commercial aspects of IP.



Madelein holds the following qualifications and registrations:

- BSc Chem Eng, BProc, LLB, LLM (Tax law), PhD (Commercial IP law)
- Attorney of the High Court of South Africa
- Registered South African patent attorney
- Registered Technology Transfer Professional

Her technical expertise includes petrochemicals, chemistry, process engineering, explosives, agriculture and software. Her main areas of IP expertise include deal negotiations, Due Diligence, IP Portfolio management, IP

policy and strategy development and implementation, data privacy and data monetisation. She regularly advises on corporate governance and IP risk management and specialises in drafting and advising on IP-related business transactions, and specialises in technology transfer and licensing. Her client base spans Europe, USA, Canada and South Africa.

She has authored and presented various articles, papers and publications on IP matters internationally specifically on technology and IP licensing and commentaries on national IP related legislation. She is the course co-ordinator of the Patent and Design LLM module at Stellenbosch University. She developed the course and lectures the module Technology Commercialisation at the Technical University of Ingolstadt, THI Business School, in Germany. She often trains at SARIMA and LES on IP matters. She is also a tutor and mentor for WIPO.

Since 2014 she is the co-editor of the International Pharmaceutical Law " publication which covers key pharmaceutical law topics in all of the major industrial countries and co-authors the South African Chapter of this publication. She is a member of the SAIPL (and also the editor of the SAIPL newsletter IP Briefs®. She is a member of INTA, SAIPL, ASTP, AUTM, CCASA, ACS and SARIMA ( Southern African Research & Innovation Management Association). She is also member of LES SA and a past president. She is a past chair of the LESI Patent and Technology licensing Committee and past Co-Chair of the Awards Committee. She is also Vice-President of LES International (for 2022-2024).

Dr Kleyn has in two consecutive years received the LESI President's acknowledgement award for her contribution to the technology licensing community. In 2019 she received the 2019 DSI/SARIMA award for distinguished contribution in innovation management. The technology transfer team at Innovus, which she led at the time, received the 2020 Award for Organisational Excellence in Innovation Management. These awards were initiated in 2014 to celebrate excellence in research and innovation management in Southern Africa, and to encourage growth and achievement in the field. The 2021 award considers excellence and achievements in the previous year, 2020.

Madelein was included in the *IAM Strategy 300 – The World's Leading IP Strategists since 2015 and featured in WTR300 World's leading trademark professionals since 2016. She has been acknowledged as a Global IP Leader by IAM 300 in 2022/3.*

### **Jana van Zyl**



Jana was admitted as an attorney in 2003 and joined Dommissie Attorneys in 2013 as a partner and lead member of the Compliance and Regulatory team.

Throughout her career, Jana has strived to build sustainable client relationships and create trust, whilst upskilling in different areas of law.

Initially, her practice focused on advising national retailers, credit providers, marketers and other large service providers on compliance with various consumer laws such as the National Credit Act, the Consumer Protection Act, the Electronic Communications and Transactions Act and the Protection of Personal Information Act.

Over the years, her practice has evolved to a wider field of commercial and transactional work in the Fintech space. At present, her focus is on transactional and structuring work, but also assisting clients with a wide range of commercial and operational agreements and compliance with regulatory requirements.

The diversification of her client base, together with her regulatory mindset, led to the decision to complete a Master's Degree in Tax Law at the University of Cape Town. This has allowed her to better service the needs of the firm's clients by supporting the international structuring offering with transfer pricing services.

Her focus is to provide peace of mind to clients. Understanding complex legislation is a real challenge for most clients who are mainly business orientated. Jana's ability to interpret and explain legislation on a practical level as it applies to a particular business model puts the client in a position to make an informed decision about risks. Her real value-add often lies in a product development role, based on the decisions that the client makes following advice on compliance considerations.