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Technology & IP Transactions

Technology & IP Transactions

Cross-border and domestic technology and intellectual property transactions have become standard practice for many businesses. To manage these transactions, businesses need experienced legal counsel that is well versed in negotiating and closing sales, licensing, technology research and development, and other agreements and that takes an approach that meets clients needs with the big picture in mind.

From the outset of every representation and every new matter, our Technology & IP Transactions practice group works with clients to understand the business goals and develop a strategy to further those goals. We focus on business transactions driven by intangible assets, technological assets, and intellectual property rights to help our clients structure and negotiate commercial IP agreements to minimize business and financial risks while achieving short- and long-term objectives.

Our team includes lawyers with decades of experience advising national and multinational clients operating in a wide range of industries and technologies. We lead negotiations and structure transactions driven by innovation or technological opportunities. These include joint ventures, strategic alliances, licenses, collaborations, and other strategic commercial agreements. We not only understand law and technology, we are experienced, practical deal lawyers who know how to structure, negotiate, and close complex transactions.

Moreover, we collaborate with other core practice groups at Chamberlain Hrdlicka including the Corporate, Securities, and Finance and Tax practices on all technology and IP aspects of public and private corporate transactions, including mergers and acquisitions, spin-offs, divestitures, joint ventures, and financings.

We bring the technological know-how to bear in all transactions unlike most general practice law firms, Chamberlain Hrdlicka has a full-service intellectual property group handling all manner of IP-focused transactions. Our IP lawyers hold scientific and technical degrees and have the comprehensive experience in IP prosecution, diligence, and litigation matters that affords us strategic insights into the technology, business, and legal issues involved in each IP-focused transaction. Whether the matter involves a single transaction or is part of a much larger deal, we can structure solutions to meet the client's objectives.

Our practice is unique in the diversity of our clients and the range of the work undertaken. Because we represent clients ranging from Fortune 100 companies to middle-market companies to growth-stage businesses, we see business arrangements from all perspectives and understand the diverse needs of all parties to a particular transaction.

Technology & IP Transactions, *Continued*

Mergers & Acquisitions

Our Technology & IP Transactions practice group works closely with Chamberlain Hrdlicka's Corporate, Securities & Finance practice group as advisers to public and private companies on all types of M&A transactions. The Technology & IP Transaction practice group focuses on identifying and structuring the unique technology and IP aspects of these corporate transactions, particularly in situations where the technology and IP aspects are a leading driver of the opportunities or risks relating to a deal. Our experience includes conducting due diligence and negotiating terms around all IP aspects, including patent, copyright, trademark, data, databases, and software.

We are also proficient at conducting intellectual property due diligence investigations in mergers and acquisitions for clients in all areas of technology, to identify IP risks that could result in undue exposure or that affect business valuation. We are as comfortable working on behalf of an acquisition target to assist an acquirer in performing its intellectual property due diligence with respect to the target as we are conducting intellectual property due diligence of an acquisition target on behalf of an acquirer. Whenever intellectual property assets are developed, acquired, sold or shared, Chamberlain Hrdlicka's lawyers have the technical and business experience to help with the transaction.

Joint Ventures & Strategic Alliances

We are experienced in helping our clients achieve their objectives through a broad range of collaborative arrangements among businesses, including joint ventures as well as complex contractual alliances. The success of these joint ventures and alliances depends largely upon the ongoing ability of the parties to work together, and our attorneys are skilled at fostering a cooperative relationship among parties during the negotiation process and know how to structure joint ventures and alliances to include incentives and safeguards to promote their long-term success. Our practice not only has significant IP, transactional, and tax experience, but also expertise in other disciplines that are necessary to structure these arrangements.

Software, Service & IT Deals

We represent clients in software-driven deals for solutions and platforms. This experience includes software development agreements, IT platform agreements, implementation and integration agreements, and managed services. We also have a broad range of experience working with software delivery models and cloud computing, including Software as a Service (SaaS) and Internet of Things (IoT).

Collaboration and Development Agreements

We have extensive expertise advising clients on collaboration agreements to develop or commercialize new technologies, products and services. Building on our experience with joint ventures and strategic alliances, our attorneys have advised clients on collaboration contracts that require anticipating different future business and legal issues. In addition, our group advises on ancillary agreements stemming from these arrangements, including supply, distribution, reseller and commercialization agreements.

Licenses

Technology & IP Transactions, *Continued*

We have extensive experience representing both licensors and licensees of IP assets in complex, high-value transactions that cover worldwide IP rights. These matters include license arrangements involving patents, trademarks, copyrights, data, and software. We have experience with licenses with complicated aspects, such as for mission-critical technology or IP with significant commercialization potential. We recognize the driving business and legal interests of both the owners/licensors as well as the licensees, which are frequently aligned but occasionally diverge. We are also skilled at identifying and planning with respect to the impact of related areas of law on licenses including tax, antitrust, and bankruptcy laws.

Trademark Deals

We have unique experience in transactions driven by brand assets. Our attorneys have been involved in the establishment of complex corporate transactions where the core asset of the relationship is a brand licensing arrangement. We also represent clients in straight brand license transactions. Our attorneys understand the key business considerations for licensors, which can include brand integrity and minimum commercialization goals, and the considerations for licensees building a business line on a licensed brand asset. We also have experience in bankruptcy law issues that affect brand licenses.

Data and Database Agreements

We represent clients in structuring and negotiating agreements relating to data, databases, data analytics, and data services as well as related infrastructure and processing arrangements. These agreements include M&A, joint venture, and strategic alliance activity driven by data-driven products and services.

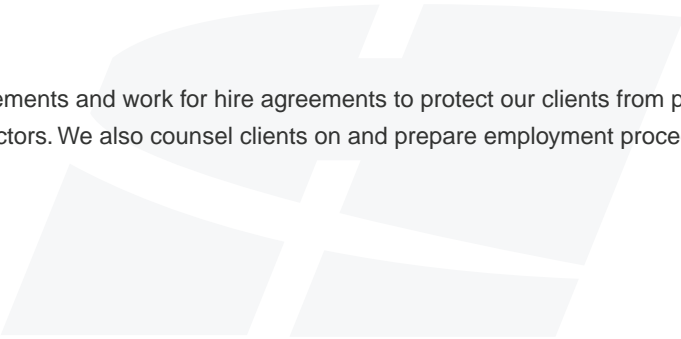
These transactions present unique issues given the nature of data as an asset, the contours of IP protection for data and databases, and the expanding universe of laws governing the collection, security, use, sharing, distribution and disposal of certain types of data, in some situations with criminal penalties attached. As part of structuring data-driven relationships and allocating attendant risk, we counsel clients on the policy frameworks, laws, and regulations of key jurisdictions.

IP Monetization & Securitization

We represent participants in monetization transactions driven by intangible assets. Such monetization transactions are usually highly bespoke matters, involving innovative structures at the intersection of finance, corporate law and IP law. Chamberlain Hrdlicka brings the necessary corporate, tax, and IP experience needed for these complex transactions. Our past deals have included IP asset sale/purchase transactions, IP holding companies, patent pools/trusts, and IP-focused investment funds. In addition, we work with our securitization practice in whole company and IP-based securitizations.

Employee and Independent Contractor Agreements

We also have experience negotiating non-compete agreements and work for hire agreements to protect our clients from potential misuse of IP by both employees and independent contractors. We also counsel clients on and prepare employment procedural handbooks and company policies concerning IP issues.



Technology & IP Transactions, *Continued*

Experience:

- Represented energy equipment company in negotiating an IP License Agreement.
- Represented international energy services company in negotiating patent and software license agreements.
- Represented energy exploration & production company in negotiating software license agreements.
- Represented private equity firm in review of Securities Purchase Agreement for intellectual property related obligations.
- Represented international energy services company in negotiating a Joint Research Agreement with a University.
- Represented pipeline construction and repair product manufacturer in patent and trade secret license dispute.
- Represented marine gas transportation services company in negotiating a patent license agreement.
- Represented international offshore energy equipment company in negotiating software license agreement.
- Represented energy technology engineering company in negotiating research and development and intellectual property license agreement.

