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## Licensing

As your key differentiator and driver of success, your intellectual property including patents, proprietary technology, brands, media, data and trade secrets is a critical component of any business transaction. Leveraging patents, trade secrets, or portions of an IP portfolio can often generate revenue streams, open new markets, or shut down competitors.

While your IP portfolio matures, building a strategy around when and how to potentially monetize your assets or settle disputes is important in mapping your IP lifecycle. Whether you consider the purchase, sale, or sharing of IP, or seek a restructuring, merger or acquisition, spin-off, or financing, it's critical to have a team by your side that understands not only the legal considerations of the deal, but also the nuances of your industry, business, and competition. Our team of lawyers will advocate relentlessly on your behalf through all stages of a transaction and during negotiations at the deal table.

Our intellectual property and technology transactions lawyers work closely with our clients to ensure that each client's intellectual property strategy is fully integrated with their business and legal goals. From the beginning, we make the process easier for you by handling due diligence around the IP involved, identifying and quickly resolving any critical legal or business issues before moving ahead to the next phase of the deal. We bring deep technical understanding and sharp business acumen to strategic transactions involving IP, maximizing the value of your intangible assets while minimizing risk to get the deal done on time and on budget.

We operate across practices and geographies to bring you a winning combination of experience and knowledge, including key collaborations with our corporate and tax practices. We also provide insightful counsel, rooted in significant experience, around the licensing of key assets across a number of technology areas, such as software, cloud computing, and clean tech, among others.

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 expertise in 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 for the impact of related areas of law on licenses including tax, antitrust, and bankruptcy laws.

**Patent**

## **Licensing, Continued**

We have extensive experience representing both patent licensors and licensees in patent licensing agreements. Our lawyers understand the business and legal issues from both perspectives, as well as from the perspectives of third parties who may have a vested interest in the license relationship, particularly suppliers and customers. In addition to negotiating definitive license agreements, our attorneys are experienced in negotiating other commercial arrangements that are often implemented alongside of patent licensing deals, including joint development agreements, supply agreements, and services/technical assistance agreements.

We also assist clients in strategically managing their patent portfolios to maximize the value of their technology, generate revenue, or gain competitive advantage. We work with in-house business units and legal teams to develop a comprehensive approach that integrates with the business goals and strategies, including by establishing patent licensing programs and by monetizing patents through various business models (e.g., joint ventures, divestitures, spin-outs, alliances, securitizations, synthetic royalties, royalty buy-outs and royalty interests).

### **Trademark & Brand**

We have extensive experience in trademark licensing matters and the broader areas of merchandising programs, intellectual asset management business models involving trademarks and trademark holding company initiatives. This experience includes significant transactions involving world-famous brands and all forms of trademark and related rights in a wide range of industries. Such transactions include licensing, joint ventures and strategic alliances, supply/distribution, co-branding, franchising, and marketing/promotion/advertising agreements. Our attorneys have also represented clients in the context of celebrity licensing and endorsements, and have a deep understanding of the legal issues relating to talent and rights of publicity.

In addition, we are often involved in the establishment of joint ventures and 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.

### **Copyright & Content**

We advise clients on financing, development and licensing arrangements related to all types of copyrighted material and published content, including software, television series and feature length films, video games, music, as well as online and print publications. In addition, we assist clients with licensing arrangements as resolutions to copyright infringement disputes and advise on copyright ownership interests in creative works.

### **Database & Database Agreements**

We represent clients in structuring and negotiating licensing agreements relating to data, databases, data analytics and data services as well as related infrastructure and processing arrangements. We help clients navigate the unique issues of deals in which data is an asset, and we advise on 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

## Licensing, *Continued*

regulations of key jurisdictions.

### Software

We represent clients in software-driven deals for solutions and platforms used in broader digital ecosystems. In addition to licensing agreements, we negotiate agreements that often accompany these licensing arrangements, such as agreements for software development, IT platforms, implementation and integration, and managed services. Our experience includes assisting clients with the licensing of source code under open source licenses. In addition, our attorneys are well versed in the broader concepts of shared services and converged infrastructure. We have a broad range of experience working with software delivery models and cloud computing, including on Software as a Service, Infrastructure as a Service, and Platform as a Service bases.

### Experience:

- Represented international oil and gas services company in negotiating patent and software license agreements.
- Represented oil and gas exploration & production company in negotiating software license agreements.
- 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 oil and gas equipment company in negotiating software license agreement.
- Represented oil and gas engineering company in negotiating research and development and intellectual property license agreement.
- Represented venture-backed home security company in negotiation of trademark co-existence agreements.
- Represented venture-backed online trading platform in negotiation of patent rights from a university.
- Represented venture-backed cleantech company in negotiation of license rights for patent portfolio from a university.
- Represented venture-backed medical diagnostics company in negotiation of license rights from a university.
- Represented defense-focused company in negotiation of license rights for patent portfolio from a university.
- Represented venture-backed consumer goods in acquisition of global trademark portfolio.
- Represented publicly-traded software company in evaluating potential patents for acquisition.
- Represented private equity firm in review of Securities Purchase Agreement for intellectual property related payment obligations.
- Represented private equity firm in due diligence review of investment target IP portfolio and licensing structure related to chemical technology.
- Represented international oil and gas services company in acquisition of digital analysis company.
- Represented international oil and gas equipment company in acquisition of oil and gas equipment company.