



INTELLECTUAL PROPERTY COMMERCIAL TRANSACTIONS

We assist clients in negotiating the license, acquisition or sale of IP, managing IP portfolios, performing due diligence audits, financing of IP-based commercial ventures, commercialization of IP portfolios through product development, distribution, and joint ventures and other corporate-related transactions involving IP.

IP Licensing/Sales

The firm's attorneys have experience involving matters on the forefront of legal issues

relating to the development, use, management, commercialization, and licensing of IP, including **patents, trademarks, copyrights** and **trade secrets, technology**, software and the Internet. For example:

Our attorneys have provided counsel to CIO's and technology executives for domestic and international software and hardware development. Experience includes enterprise implementations, licensing and contractual transactions, as well as information and data privacy issues. Clients have received counsel in technology development, strategic alliance, technology licensing, technology purchasing and supply agreements.

Technology, Computer and Software Law

Development, use, licensing and distribution of computer, software, Internet, IT and technology systems and products; computer software licensing and development projects; outsourcing of software and IT services; web-based software services; computer disputes; and IT and telecom contracts.

Internet-related Law

Matters relating to Internet business practices; data privacy (domestic and international laws); media and IP issues on the Internet; domain name issues; web-development and web-services and web-based business and e-commerce issues.

Media and Entertainment Law relating to IP Assets

Provides counsel for the creation, licensing, distribution, use and protection of IP, entertainment and media assets. Projects span print, film, radio, music, DVD, the Internet and multi-media.

Commercialization of IP Assets

We are able to assist clients with commercializing technology from a variety of public and private sources, through acquisition, licensing, and strategic partnering, counseling with respect to business plans, and private equity, venture capital and debt financing of IP-based ventures.

Performing Due Diligence Audits

When an entity decides to purchase the IP assets of another, a thorough due diligence audit should be conducted so as to reveal the intangible assets of a company, including any IP rights, as well as any potential liabilities. The due diligence search includes, but is not limited to:

- Researching and verifying the status of issued and pending IP
- Determining whether the seller is using IP currently not protected
- Determining whether there is active litigation with respect to the seller's IP
- Researching and reviewing issues relating to ownership of IP

Managing IP Portfolios

Obtaining the IP is the first step; taking measures to keep the IP in force is the next. In order to maintain the enforceability of one's IP, affirmative steps must be taken, such as:

- Payment of maintenance fees for issued U.S. patents and annuity fees for pending and issued foreign patents
- Filing appropriate declarations and renewals for registered trademarks and/or service marks
- Maintaining strict confidentiality standards for trade secrets

If one does not take the appropriate steps to maintain their IP rights, they essentially give away their rights to the world.

Establishing a Corporate IP Process

Ownership issues typically arise when an employee "invents" while employed by the employer. If the employee executed an assignment, the issue of ownership is clear: the employer owns the IP. However, if no assignment was executed, the line regarding ownership tends to blur, especially if the employee was hired to "invent", the employee invented at work using employer's equipment or there exist corporate documents regarding "future" assignments.

Regardless of whether a business entity IP portfolio consists of one piece of IP or 100, all business entities could benefit from establishing a corporate IP process wherein the ownership rights of the IP are clearly set forth for the benefit of the employer, as well as



the employees. We assist clients in establishing corporate IP processes, such as solidifying ownership rights, creating incentives for inventing and reducing employer liability, so as to permit the business to focus on conducting its business.

For questions or more information, please contact [Jon M. Gibbs](#), Chair of the firm's Intellectual Property Services Group