

Licensing & Technology Agreements

As technology has become central to daily life, technology and intellectual property have also become increasingly central to business agreements. Michael Best helps clients capitalize on crucial technology and IP assets through licensing, joint development, and other strategic alliances.

Our Licensing & Technology Agreements team offers a special blend of legal, business, and technical knowledge. By bringing together attorneys from our Intellectual Property and Corporate groups who consult with other practice areas as needed, we provide unified counsel on all facets of IP licensing and technology transactions.

Our work encompasses a wide array of agreements, policies, compliance audits, and litigation in fields such as:

Software and Information Technology

We counsel clients on licenses, contracts, and terms and conditions for software, software as a service (SaaS), and other cloud services, mobile apps, and websites. Our attorneys understand the information technology (IT), and we have extensive experience representing both buyers and vendors in a variety of software and IT service transactions. We have a wealth of experience in drafting, negotiating, and litigating IT-related matters, and we work with clients to understand their specific IT needs and implement focused and practical strategies to meet these needs.

Patents and Technology

We offer expertise combining legal, business, and technical knowledge to help clients best utilize their intellectual property and technology assets in commercial transactions. We regularly counsel clients on strategies designed to maximize the value of their properties through licensing. We assist emerging company licensees in finding professional management and obtaining third-party financing. Our services include: inbound and outbound patent and technology agreements; technology joint venture and partnering agreements; technology development agreements; manufacturing and supply agreements; university and federal lab collaborations; non-disclosure and material transfer

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agreements; and intellectual property asset acquisition and disposition.

Trademark Collaborations

We assist our clients with establishing, maintaining, protecting, and enforcing their rights in the United States and in more than 100 countries throughout the world. We assist with strategic planning, negotiation, due diligence, and hands-on program management. We also represent clients in connection with evaluating and negotiating licenses and assist them with complying with license terms and addressing claims of noncompliance.

Our team includes attorneys who are recognized as leading practitioners by business organizations and publications including *Chambers USA* and *The Best Lawyers in America*. Members of our team are active in the International Trademark Association; lead PLI, ACI, and Lorman continuing education seminars; and have taught at law schools.

Life Sciences

We assist clients with co-development and co-promotion strategic alliances, as well as research, licensing, and transfer of intellectual property related to drugs, medical devices, biotech, and other technologies. Our team works with clients at all stages of development and has the experience to help clients navigate the nuances of the regulatory environment. Our team includes FDA regulatory, IP, transactional, and finance attorneys, as well as scientists and engineers. We work together to address our clients' needs cross-functionally.

Our technical expertise includes a broad range of life sciences technologies, including chemistry, organic chemistry, biology, microbiology, genetics, cell biology, biomedical engineering, molecular biology, chemical engineering, and biochemistry.

On the technical side, many of our lawyers and professionals have advanced degrees and business experience in areas such as computer science, engineering, physics, chemistry, and biotechnology. We are also active in professional organizations such as the Association of University Technology Managers, Licensing Executives Society, and Intellectual Property Owners Association and regularly speak and comment on licensing issues.

Our in-house scientific and technical expertise stems in part from the firm's unique EDGE program, which provides internships for science and engineering students with highly developed research and analytical skills. EDGE interns collaborate with the firm's IP attorneys, scientists, and engineers to provide insight during, and before, the patent process. Those insights are proving more valuable than ever today, as many companies reduce their in-house research teams and rely more heavily on universities and start-ups to spur innovation.

Michael Best's licensing and technology clients span various industries. They include Fortune 500 companies, start-ups and emerging ventures, and more than 25 universities nationwide. Our attorneys have a wealth of experience in a variety of industries, including manufacturing, agribusiness, energy, life sciences, food and beverage, university technology transfer, and information technology. We advise on strategies designed to maximize the value of our clients' properties and licenses — and often, we help them make the business connections needed to succeed.

Experience

- Developed new template for university clients to utilize in all licensing deals
- Assisted start-up renewable chemical company in obtaining licenses necessary for freedom to operate
- Helped client negotiate licensing agreement with a large biotech company covering the sale and use of fluorescent dyes
- Represented licensor in multiple strategic licensing transactions to use intellectual property portfolio as part of biofuels production process
- Advised on complex license and exclusive supply agreement with Fortune 500 aerospace company, largely focusing on protection of client's technology and intellectual property

- Represented investor in portfolio company for \$300M license (plus royalties) to strategic partner. Payments include up-front license and milestone payments.
- Represented licensor in dozens of licenses to strategic partners for different fields of use for aggregate potential consideration in excess of \$50M (plus royalties).
- Represented licensor in \$120M (plus royalties) license to global pharmaceutical company. Payments include up-front license and milestone payments.
- Drafted CDA, MTA, consulting, research agreements, collaboration, and license agreements for several multinational pharmaceutical and diagnostic companies
- Drafted exclusive license agreement with manufacturing and services agreements for medical device company in a merger and spin-off
- Represented manufacturer in multi-million dollar software licensing audit
- Maintained license agreements for large international household appliance manufacturer with territories in (1) the U.S. and Canada only; (2) International regions only (namely Asian countries); (3) Global or "worldwide" regions; and (4) U.S. and Canada and specified international regions, including Latin America, EMEA, and Asian countries
- Represented clients in home appliance, food, kitchen accessories, and home décor industries in connection with preparing and negotiating trademark license agreements through the U.S., as well as Latin America, EMEA, and Asia
- Managed and implemented trademark license terminations and assisted with post-termination procedures
- Provided support to trademark holding company owning nearly 7,500 trademarks worldwide and licensing to over 120 related entities globally
- Managed royalty rationalization project for client's Latin America agreements to ensure consistent valuation and royalty submissions
- Managed royalty payment dispute with foreign licensee after license agreement expiration

- Managed counterfeiting and distributor disputes in connection with licensee's failure to maintain control of product