



Representative License & Partner Transactions

The firm's capabilities are best exemplified by the array of clients that seek our sophisticated legal advice. The firm's attorneys have represented licensors and licensees, developers of technologies, and growth companies spanning a wide range of industries, in transactions with private and public companies.

Our attorneys have counseled clients in licensing, development and partner transactions in industries including software, telecommunications, internet and e-commerce, medical technologies, insurance, distribution, media & advertising, novelty consumer and others. Our experience in intellectual property protection, transaction structures, tax, distribution and revenue models, and in closing transactions is applied in many of the licensing and partner transactions we handle. Our attorneys understand the differing needs of both licensors and licensees, and the importance of maximizing potential revenue and opportunities through these types of transactions.

Whether a technology or Internet emerging company, distribution or service company, or established corporation with international operations, our effective representation in licensing and partner transactions will help grow your business. The following are some representative licensing and partner transactions handled by attorneys of the firm:

- Representation of a leading independent global supplier of subscriber-centric networks for mobile, fixed and converged telecommunications operators. The firm's representation has included negotiation and structure of a complicated inbound license of a \$50,000,000+ software and patent suite from a large publicly-traded UK based mobile network operator, the negotiation and structure of a major five-year multi-million dollar license, supply, and development contract for 'productized' versions of the software suite with international support and maintenance services to a local fortune 100 company, as well as complex multi-party source code escrow agreements. The company has been recognized in October 2007 as one of the leading U.K. tech firms, and its sale for \$140 million Euros was announced in January 2008.
- Representation of a software development and services company focused on efficient on-demand video advertising and media creation, in connection with a multi-million dollar enterprise license, services and support contract with a fortune +/- 100 national cable television company.
- Representation of a Microsoft Gold Certified Partner value added reseller (VAR) provider of vertical industry focused ERP software and services based on Microsoft Axapta/Dynamics, with a competency in both Microsoft Business Solutions and ISV/Software Solutions, concentrating on food and beverage and multi-channel retail industries. The firm's representation includes development of form enterprise license and support agreements for the client's applications created on the Microsoft platform, and ongoing representation in connection with new customer acquisition under these contracts.
- Representation of a Microsoft Gold Certified Partner independent software vendor (ISV) business process management company in the business process management industry focused on engineering design, development and licensing of dot-net business rules engine software that allows companies to quickly adapt to changes in their business environment via rapid development using business rules software, in its development of form enterprise license and support agreements for, among others, Fortune 500 businesses in the insurance and financial services industries.
- Representation of the leading software development company focused on the direct selling consumer products industry in connection with multimillion dollar license and hosting agreements. This engagement has included significant work in developing master agreements for development, licensing, hosting and support of software necessary to operate the entire business platform for our client's customers, as well as assistance in the structure of the business terms and components.
- Representation of software development firms in connection with negotiation of Microsoft Partner agreements.



Representative License & Partner Transactions

- Founding partners of the firm have represented a local classified advertising internet consortium in connection with license and partner deals in the real estate, auctions and cars verticals.
- The firm has provided legal counsel for the negotiation and preparation of network partner agreements with some of the largest sites on the Internet. Members of the firm have negotiated and prepared marketing, co-branding, private-label and advertising agreements and insertion orders for million dollar media transactions for Art.com, Spedia, and Yesmail with MSN, About.com, Amazon, MSNBC, Expedia, MapQuest, and other major Internet sites.
- Representation of a consumer gift company in structuring and negotiating a multi-million dollar license and purchase relationship with a Fortune 500 toymaker for certain software, trademark brands and products in connection with a new line of toys incorporating the client's products.
- Representation of a U.S. based software development company in its India business-operations-transfer development contract with another U.S. based firm.
- Representation of a nationwide medical imaging equipment remanufacturer and distributor in connection with the joint development and distribution of FDA-approved Chinese-manufactured medical imaging devices for cardiac and thyroid applications.
- Representation of a provider of reverse logistics services to health care and pharmaceutical companies in connection with their partner and vendor contracts, and services agreements.
- Representation of a national medical transcription services software company with international-based support in connection with the license of the company's software suite to and partner relationships with major hospitals and physicians' groups nationwide.
- Representation of a local provider of marketing and technology solutions for promotions and sweepstakes and a variety of other marketing applications, in connection with licensing of its software and response management solutions.
- Representation of a software development company focused on the direct selling consumer products industry in connection with multimillion dollar license and hosting agreements.
- Representation of a local education-oriented company focused on education of children and young adults in the area of financial literacy, in connection with partner and licensing agreements.
- Representation of a local online/bricks&mortar health insurance and benefits brokerage firm and platform provider in its negotiation and structure of Channel Partner Relationships with banks and affinity groups for private label use of the platform and related services.

The above transactions involved negotiation of, among other terms, scope of license grant provisions, royalty and payment terms, distribution channels, maintenance and support, representations and warranties, indemnities and structured allocation of risk, each of which are critical components of licensing and partner transactions. Counsel included, among other things, intellectual property protection, maximization of distribution channel structure, general transaction structure, due diligence, and data protection. The firm regularly assists clients in licensing and partner transactions of many types.

Each client's needs are unique. For some, negotiating advantageous provisions is key. For others, effective legal advice is crucial. Most often, a broad spectrum of concerns requires attention. However, no matter how diverse their legal needs, our clients turn to us for this common reason – detailed, creative and responsive consideration that translates into effective solutions at a fair cost.
