

IP Licensing & Due Diligence

We routinely help clients protect and commercialize their intellectual property (IP) assets and provide due diligence on complex technology and IP transactions. We negotiate and draft IP licenses and transfers; provide strategic guidance on optimal structures for IP and IT transactions; and evaluate copyright, trademark, and patent portfolios and provide related due diligence activities in connection with IPOs, mergers and acquisitions, private equity investments, licenses, and other corporate transactions.

We provide strategic guidance on the full spectrum of IP and IT agreements, including:

- IP-driven joint ventures and strategic alliances
- Asset transfers
- Research, development, and cooperation agreements
- Software, Software as a Service, cloud service, and other IT service agreements
- Consulting agreements
- e-Commerce agreements
- Service and supply agreements
- University research agreements
- Clinical trial agreements

We also provide risk management counseling in connection with open source software agreements. Our team focuses on licensing, copyright, and other IP matters and includes attorneys with technical backgrounds and practical experience in computer programming.

Key Contacts

Becky Troutman

Areas of Focus

Sourcing

We have extensive experience assisting clients across a wide variety of industries in connection with IT sourcing transactions. We collaborate with our clients during the structuring and negotiation of their sourcing relationships in order to develop a customized and flexible contract structure designed to meet their objectives and then adapt as those objectives evolve. We work hard to understand our clients' business priorities, corporate structure and culture, internal capabilities, and the overarching IT strategic plan or initiative. We draw upon the extensive experience of other practice areas within the firm, including labor and employment, litigation, privacy and data security, and tax, as appropriate.

Transaction Due Diligence

We regularly conduct due diligence investigations related to IP assets for joint ventures, mergers and acquisitions, and other transactions. We work with the client to determine the appropriate scope of diligence review and analyze the target's IP and related agreements to determine what the client will obtain and to evaluate associated risk. We negotiate IP-related provisions of merger and stock and asset purchase agreements, as well as transition services, IP assignments, licenses, and other ancillary agreements. When IP is collateralized, we negotiate the IP provisions of security and credit agreements and handle perfection and release of security interests in intangibles, including recordation of appropriate documents in the states, U.S. Patent and Trademark Office, and U.S. Copyright Office.

Trademark & Copyright Licensing

The strength of our dealmakers and the technical know-how of our IP lawyers, backed by the power of our litigation practice, have proven to be a successful combination for our licensing clients. Our attorneys build value through the licensing of IP assets, delivering strategic advice tailored to each individual contract, and addressing relevant domestic and international issues quickly and efficiently.

Related Capabilities

Intellectual Property

Privacy & Data Security

Patent Litigation

Trademark Litigation, Prosecution & Brand Protection

Trade Secrets, Non Competes & Restrictive Covenants

Copyright-Infringement Litigation

Mergers & Acquisitions

ITC – Section 337

Labor & Employment

Tax

Technology, Media & Telecommunications

Recent Experience

GenNx360's Majority Investment in Whitsons Culinary Group

The Care Team's Acquisition of InTeliCare Home Health and Hospice

Related Insights & News

BLOG

Initiating an Informal Dispute on Amazon's Platform was Sufficient to Subject a Patentee to Personal Jurisdiction in Accused Infringer's Home State!

MAY 7, 2024

RECOGNITIONS

Winston & Strawn Trademark Team Recognized in the *WTR 1000* 2024 Rankings

FEBRUARY 6, 2024

NEWS

Robert Kang Selected as a 2023 Federal Circuit Bar Association Global Fellow

JANUARY 10, 2023

BLOG

Federal Circuit Limits Use of "Admitted Prior Art" in IPR Proceedings

MARCH 15, 2022

BLOG

Ubisoft is First Major Gaming Company to Embrace In-game NFTs: What Does This Mean for the Industry?

JANUARY 10, 2022

BLOG

Patents Joining the Hot NFT Market?

NOVEMBER 3, 2021

BLOG

NFTs and Their Role in the "Metaverse"

NOVEMBER 2, 2021

BLOG

Steam Bans NFT and Cryptocurrency Games: Implications and Ramifications for the Videogame Industry

NOVEMBER 1, 2021

BLOG

How NFTs Will Impact Ownership of Virtual Items in Videogames

OCTOBER 18, 2021

RECOGNITIONS

Winston Recognized in 2021 *IAM Patent 1000* Rankings

AUGUST 24, 2021

RECOGNITIONS

Winston Attorneys & Practices Recommended in 2018 Managing Intellectual Property

JULY 31, 2018

ARTICLE

Disputes Over Venue in Patent Litigation

APRIL 1, 2018