

IP Transactions

IP Transactions — Structuring and Negotiating an Optimal Agreement

Intellectual property-based initial public offerings (IPOs) are at a new high, the volume and value of mergers, acquisitions, and licensing deals continues to rise, and for many businesses, intangible assets contribute nearly 80 percent of corporate value.

In this IP-focused business climate, companies turn to the attorneys of Marshall, Gerstein & Borun's IP Transactions Practice Group for clear reasons: we are scientists and engineers who understand our clients' technologies, learn their businesses, have a thorough understanding of the law, and are adept dealmakers.

Strategies tailored to the demands of business

At Marshall Gerstein, we understand that uncertainty has no place when negotiating a deal. We help clients develop sophisticated transaction strategies, stay abreast of rapidly changing legal issues, and create enforceable agreements for each unique IP transaction. We manage the details so clients can focus on achieving their business goals.

Our IP transactions team knows what it's like to be in our clients' shoes. A number of our attorneys have worked as general counsel, patent counsel, and technology transfer managers. Whether serving as virtual in-house counsel, providing a second set of eyes on a particular transaction, or simply brainstorming possibilities, this firsthand experience allows us to function as more effective legal advisors. As a result of the roles we play, we have a 360-degree view of transactions and understand how to get deals done efficiently while minimizing risk.

The real deal

On behalf of licensors and licensees, including non-profits, institutions and for-profit companies, our lawyers handle significant, groundbreaking transactions and first-of-a-kind deals from inception to closing. Our ability to develop thoughtful perspectives on key issues leads to more effective IP policy development, consultation on policy interpretation, and involvement in enforcement of policies and related contracts. Whether a contract needs restructuring or a dispute demands resolution, we are available when and where our clients require us.

Recognized for excellence

Marshall Gerstein's IP Transactions Practice Group is consistently ranked among the world's best. Recently, we were one of only three such practices to receive top national rankings in *Intellectual Asset Management (IAM)* magazine's *IAM Patent 1000—The World's Leading Patent Practitioners* — clear recognition of the value we bring to client transactions. A number of our attorneys hold leadership positions in key industry organizations such as the Association of University Technology Managers, Certified Licensing Professionals, the Licensing Executives Society, and the Licensing Executives Society International.

Scalable services

We work seamlessly with you to provide the mix of services you need, from leading high-visibility negotiations to counseling behind the scenes on matters that include:

- Developing deal strategy
- Drafting and negotiating IP-related transaction documents, whether deal-specific, master agreements, or broadly applicable templates
- Advising on agreement disputes, including conducting mediation and arbitration and brokering settlement contracts

- Performing thorough due diligence of IP assets and related agreements in connection with auditing, licensing, and M&A activities
- Counseling on employee agreements, policy considerations, and issues related to IP and governmental regulations
- Managing out-licensing portfolios

Representative matters

- **Multinational Client Seeks Help from Marshall Gerstein to Close First-of-its-Kind Deal with NIH Program**

We advised a multinational company in a groundbreaking transaction to acquire a drug candidate for a new sickle cell therapy — the first such deal to come out of the National Institutes of Health's (NIH) National Center for Advancing Translational Sciences Therapeutics for Rare and Neglected Diseases program.

- **Marshall Gerstein Advises Orion Genomics on Collaboration with Malaysian Palm Oil Board and Other IP Transactions**

We represent Orion Genomics and its affiliates in all ongoing intellectual property transactions, and recently completed a suite of agreements for collaboration with the Malaysian Palm Oil Board on the oil-palm genome, leading to identification of the gene responsible for oil-palm production.

- **Navigant Adds Global, Offshore Capabilities in Healthcare Sector with RevenueMed Acquisition**

We guided Navigant Consulting's general counsel on all IP-related aspects of the acquisition of RevenueMed. The transaction represented an opportunity for Navigant to strengthen its position as a leading provider of end-to-end revenue cycle business process management services and to expand its platform to include global, offshore capabilities for its clients.

- **Marshall Gerstein Helps Heartland Technology Partners Protect and Monetize Innovative Wastewater Treatment Technology**

We collaborated with Heartland Technology Partners (HTP) to negotiate finance agreements, prepare licensing agreements, complete patent applications, and draft options on green technologies that help prevent lakes and rivers from becoming polluted with wastewater from oil and gas drilling or other industrial processes.