

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 LLP'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 strategies
- Devising contractual structures for a broad range of technologies including to address trade secrets and Artificial Intelligence (AI)
- 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

- **Guiding a Healthcare Organization Through Complex Licensing Agreement**
Marshall Gerstein represented a Top 15 Teaching Hospital in the U.S. and their research center which developed a technology platform to revolutionize cancer treatments by combining digital medicine and genomic data to drive real-time patient care decisions. Marshall Gerstein orchestrated the team, including co-counsel, to advise and execute the IP strategy and agreement considerations. Ultimately, Marshall Gerstein's ability to understand and allocate practical solutions for the complexities that arose with this matter allowed us to accomplish the client's goals.
- **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.

- **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.

- **Nutraceutical Client Acquired by World’s Leading Supplier**

Marshall Gerstein has been structuring the key intellectual property, supply, and distribution agreements for a major nutraceutical company, as well as providing patent prosecution and counseling on related IP matters. Our lawyers reviewed all existing licensing agreements and suggested approaches to streamline the licensing process. We created standard agreements that could be used for all products, and in various parts of the world. As the company grew, so did the need for advanced supply and license agreements to cover the use of their products, research, patents, and trademarks in the global marketplace. Working with our client, our lawyers negotiated and drafted these agreements for deals with pharmaceutical companies, global nutrition retailers, and suppliers around the world, including Pfizer, GNC, Iovate, Land Pharma Nutrition, NBTY, Ryusendo, Schiff Nutrition Group, Reckitt Benckiser (ENA) B.V., and Laila Pharmaceuticals, among many others. With our help on the IP aspects of the acquisition, the company is now part of the world’s leading supplier to the pharmaceutical, biotechnology, and specialty ingredients markets.

- **Marshall Gerstein Crafts Management Agreement Between FieldComm Group and PROFIBUS and PROFINET**

Marshall Gerstein serves as a strategic advisor to FieldComm Group, a global standards-based non-profit member organization concerning communication technologies for the process industries, including Field Device Integration (FDI) technology. Our attorneys drafted and negotiated an agreement between FieldComm and PROFIBUS and PROFINET.

- **Marshall Gerstein Advises Orion Biosains and Orion Genomics in Transactions for the Development and Commercialization of Palm Oil**

Orion Biosains Sdn. Bhd turned to Marshall Gerstein for the agreement support necessary to launch SureSawit™ SHELL gene DNA test, the first commercially developed gene assay for the oil palm industry. Using “DNA-based precision molecular agriculture,” Orion Biosains is aiming to give those who depend on palm oil production the opportunity to earn more through higher yielding trees. Marshall Gerstein also represents Orion Genomics, LLC, the parent company of Orion Biosains, in its other intellectual property transactions, including in connection with a suite

of agreements for collaboration with the Malaysian Palm Oil Board on the oil-palm genome. That collaboration led to important discoveries like the identification of the gene responsible for oil-palm production.

- **Joint Venture of Biopharmaceutical Entities with Clinical Stage Assets**

Marshall Gerstein transactional attorneys structured the intellectual property contribution and assignment components for the joint venture's formation and transactions. The team's deep knowledge of contracts of this type and the intellectual property enabled it to identify and integrate terms to address the full range of intellectual property critical to the success of the venture within tight time constraints to enable the deal to close on schedule.

- **Delivering Business-Critical Opinions for Multibillion-Dollar Client**

A long-standing client sought Marshall Gerstein's review of numerous settlement and license agreements. Marshall Gerstein did this review, analyzed the current case law, and provided an opinion on which of the competitor's patents were actually licensed. The importance of our analysis is extremely high given the risk of a future suit with the competitor.

- **Joint Venture in Materials Testing Industry**

Marshall Gerstein's transaction attorneys advised LASTRADA Partners, in the formation of its joint venture to provide software solutions for the U.S. construction materials testing industry, tailoring the venture's operating agreement to address nuances where core assets are intangible property, and developing the in-license to bring the German entity's software into the new venture. As a new joint venture formed for the U.S. market, it was important for LASTRADA Partners to have customer-facing contracts for its software and engineering services that didn't just provide strong protections for the company, but also were efficient for the staff to negotiate and terms fair for customers to accept.