

Technology & Intellectual Property Transactions

Overview

Our technology practice encompasses transactions ranging from the simple to the complex, including nondisclosure agreements, evaluation, and beta test agreements; cloud computing and application service provider agreements; software licensing, maintenance, implementation, and training agreements; software, content, and data subscription agreements; hardware acquisition and maintenance agreements; professional services and consulting agreements and work assignments; website development, hosting, and maintenance agreements; marketing and distribution agreements; and agreements involving digital signatures, digital certificates, and electronic contracting.

We advise and counsel on every type of technology transaction at each stage of the contracting process. This includes developing and issuing requests for proposals, evaluating submitted proposals and participating in the vendor selection process, drafting the documentation, negotiating the terms and conditions, and closing the transactions. We also counsel clients on post-closing compliance issues and represent them in technology-related legal actions.

Our services include:

- Software development and licensing arrangements
 - End-user license agreements (EULAs), app licenses, evaluation of open-source software
- Nondisclosure agreements (NDAs), noncompetition agreements, work-for-hire agreements
- Internal intellectual property policies
- Website terms of use and privacy policies
- Patent, trademark, and copyright licensing arrangements
- Technology and know-how licensing and royalty agreements
- IP assignments and ownership changes

- Marketing, reseller, and distribution agreements
- R&D, teaming, and collaborative research agreements
- Evaluation of government-funded patent and technical data rights

Licensing

Carlton Fields takes a business-driven approach to licensing opportunities, finding creative and efficient ways to ensure our clients' licensing transactions match their business needs given a practical and reasonable assessment of the risks and potential returns. Members of our team have extensive prior work experience in technology-driven businesses, making them particularly qualified to understand our clients' businesses and ensure that their licensing transactions make sense. Our services include:

- Information technology contracting for businesses investing in mission-critical IT systems and services, whether cloud-based, internally hosted, or custom-developed.
- Patent, trade secret, and know-how licensing, including acquiring new and innovative technologies for product development, technology transfer licensing transactions with research and educational enterprises, monetization of intellectual property portfolios, and dispute resolution.
- Trademark licensing for merchandising, venue naming, and other business opportunities.
- Source code licensing and open source licensing for enhanced solution development productivity.
- Structure and negotiate technology-driven joint ventures, distribution and reseller agreements, and joint research agreements.

Intellectual Property in Corporate Transactions

Our intellectual property team works closely with the firm's business transactions group to ensure that all intellectual property issues in corporate transactions are properly identified, addressed, and resolved. We possess extensive business legal affairs experience and have served as outside general counsel for these companies throughout their life cycles, overseeing and handling a wide variety of legal matters, including startup, formation and organizational work, commercial and transactional, corporate and M&A, seed and VC financing, real estate, litigation, HR and employment, intellectual property protection and enforcement, rights review and clearance, union

and guild matters, and data use and privacy matters. Our services include:

- Draft warranties and representations, as well as intellectual property indemnifications appropriate to the specific deal.
- Conduct intellectual property audits and due diligence to uncover any weaknesses or gaps in chains of title, assignability of intellectual property assets, or other potential issues that could affect the deal's outcome, and advise our clients accordingly.
- Assist with valuation of our clients' intellectual property assets preparatory to sales, acquisitions, or refinancings.
- Participate in the refinancing and investment stages in the event there is collateralization of the intellectual property assets, including filing and recording security interests in those assets both domestically and internationally.
- Handle all manner of sales and marketing agreements and issues, including vetting proposed advertising, advising on and preparing sweepstakes rules, and preparing domestic and international distribution and co-marketing agreements.
- Prepare software licenses, VAR and reseller agreements, merchandise license agreements, and related agreements.

Digital Media, Entertainment, Interactive Gaming, and Technology

- We represent innovative startups and emerging growth companies in the digital media, entertainment, gaming, and technology (including software, hardware, and internet) industries. Read more about our capabilities in [media, entertainment, music, and sports](#).

Experience

- Representing retail store technology vendor in licensing and software as a service negotiations worldwide.
- Drafting and maintaining online agreements for e-commerce sites, service providers, and active websites.
- Creating custom mobile app license agreements and privacy policies for informational apps, navigation apps, shipping apps, and others.

- Drafting distribution, co-development, and partnering agreements both for domestic and international deals.
- Negotiating and drafting computer licensing and technical support agreements for a national developer of network management software.
- Drafted purchase and licensing agreements for custom software developed by the engineering department of a nationally recognized educational institution.
- Prepared applications for trademarks and service marks for the name, player uniforms, and logotypes of a Major League Baseball franchise.

Our Team

Key Contacts



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