

Intellectual Property Transactions

Overview

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.

Services

- 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 IP 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 IP team works closely with the firm's business transactions group to ensure that all IP issues in corporate transactions are properly identified, addressed, and resolved.

Services

- Draft warranties and representations, as well as IP indemnifications appropriate to the specific deal
- Conduct IP audits and due diligence to uncover any weaknesses or gaps in chains of title, assignability of IP 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 IP 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.

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, IP protection and enforcement, rights review and clearance, union and guild matters, and data use and privacy matters.

Our team structures, negotiates, and drafts a wide array of commercial agreements in the following areas:

- **Interactive Entertainment/Gaming:** All types of agreements involving interactive entertainment and games for consoles, PC, mobile, virtual and augmented reality and other devices and platforms, including development, marketing, publishing, licensing, and distribution agreements.
- **IP and Technology Transactions:** IP licensing and technology-based agreements, including merchandise and trademark licensing, digital advertising, software development and licensing, software service and subscription based agreements (SaaS), software publishing and distribution, IT infrastructure, cloud computing and distribution, and hardware design and manufacturing.
- **Digital Advertising:** Advertising network advertiser and publisher terms of service, analytics and data use and sharing agreements, IOs and other partnership agreements with major advertisers (brand and performance), IAB terms and conditions, RTB programmatic ad exchange agreements, and ad platform technology licenses.
- **Digital Media and Distribution Platforms:** Licensing, distribution and streaming of media and entertainment content via various digital distribution and streaming platforms, including cloud gaming, electronic sell-through (EST), and video on demand (VOD).
- **Entertainment Content Acquisition and Licensing:** Content acquisition and license agreements with major film and television studios and other major content companies.
- **Athlete/Celebrity/Talent Rights and Professional Services:** Athlete, celebrity and talent rights and services related agreements, including name and likeness rights, voice-over and other performance and professional services, and endorsements.
- **Music:** Music licensing agreements with all major labels and publishers and rights and performance services agreements with numerous artists.
- **Network and Data Center Infrastructure:** Colocation, Network/POPs, IP transit, fiber and wavelength and other infrastructure and telecommunications agreements relating to the placement and operation of servers in network data centers, including data center leases.

Key Contacts



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Related Capabilities

RELATED INDUSTRIES

RELATED PRACTICES

- Banking, Commercial, and Consumer Finance
- Construction
- Health Care
- Real Estate
- Securities & Investment Companies
- Technology & Telecommunications

- Blockchain and Digital Currency
- Business Transactions
- Intellectual Property
- Intellectual Property Defense and Enforcement
- Intellectual Property Protection
- Media, Entertainment, Music and Sports
- Mergers and Acquisitions
- Nonprofit Organizations
- Technology
- Telecommunications
- Trade Secrets / Noncompete Litigation and Consulting