

# Technology Transactions

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Today's businesses are often built on a platform of technology and intellectual property (IP), and all businesses are creators, acquirers, sellers, and/or users of technology and IP assets. For technology and IP developers, acquirers, licensors, and sellers, the value of your assets will be heavily dependent on the quality of the legal documentation governing the development or transfer of those assets.

Our attorneys have a long history of involvement in business and regulatory issues associated with groundbreaking technologies and products and services that leverage IP, including:

- Software development and licensing;
- Telecommunications, including high-speed data services, Internet backbones, wireless communications services, and satellite-delivered services;
- E-commerce;
- Content (including music, video, data, radio, television, digital, and rights of personality) licensing and delivery;
- Brand management and franchising;
- Registration of IP rights;
- IP and data rights in government contracts;
- Use and distribution of medical devices;
- Professional services; and
- Creditor and security rights in IP.

Wiley's Technology Transactions Team services clients' business needs by seamlessly combining business law services with the legal skills and experience of attorneys from across the firm's core specialty areas. Our multidisciplinary approach involves members of Wiley's Corporate, Telecom, Media & Technology, Government Contracts, Intellectual Property, and Privacy practices. Our attorneys assist clients—large and small, public and private, domestic and international—with licensing and distribution of products and services, commercialization of new technologies, government IP and data rights, brand management, technology transfers and distributions, and mergers, acquisitions, and other strategic transactions (joint ventures, restructurings, etc.).

As special counsel, we structure and negotiate online alliances and agreements to create new markets and adapt IP rights to new media. Through our involvement with litigation and rule-making proceedings, we stand at the forefront of establishing new law and precedent applicable to the latest technologies and business models.

## Licensing and Distribution

Domestic and international licensing of IP—including patents, trademarks, trade secrets, and trade dress—is of ever-increasing importance. As businesses focus on maximizing technology, they exploit comparative advantages by separating the development from the marketing of many types of IP, and extend the domestic and international reach of brands and methods through franchising and similar activities. Our attorneys have extensive experience representing owners and users of IP in negotiating and documenting license agreements in a broad variety of fields, including communications, medical devices, pharmaceuticals, and transportation.

Wiley also has significant knowledge of the diverse and unique needs of both established and emerging IP, digital, and new media companies. We advise on a wide variety of IP matters related to the Internet and other new media—including webcasting, streaming, digital imaging, and the ownership and use of copyrights, trademarks, patents, and trade secrets. We represent varied owner and user interests in the licensing of diverse IP portfolios, including content, computer software, electronics technology, databases, biotechnology, certification marks, trademarks, and various trade secret technologies. We also provide legal audits of client websites and online practices, advise on development and maintenance of clients' Internet presence, and advise on online risk and privacy issues.

Our licensing and distribution experience includes the following types of matters:

- Representation of clients in the acquisition of customized and “off the shelf” software applications products, including negotiating service-level agreements, software escrow agreements, and hosting agreements.
- Representation of vendors in drafting and negotiating End User License Agreements and customized software development agreements, including “click” through and Internet-based license agreements and terms of use.
- Representation of customers and domestic and international vendors in documenting and structuring outsourcing arrangements, including application development, hosted applications, and entire business functions.
- Draft and negotiate professional services arrangements for vendors and customers, including vendors selling to U.S. government customers.
- Draft and negotiate patent, trademark, and copyright licenses, assignments, and security agreements.
- Draft and negotiate content agreements with major studios and content owners for radio, television, and Internet transmission and public performance arrangements.

- Draft and negotiate telecommunications and network services agreements.
- Draft and negotiate digital rights management agreements.
- Draft and negotiate branding and co-branding agreements, product distribution agreements, and all forms of franchise relationships.
- Draft and negotiate sales agent, value added reseller (VAR), product bundling, original equipment manufacturer (OEM), and other distribution arrangements on behalf of vendors.
- Draft and negotiate subcontracting arrangements for prime/sub government contractors.
- Provide strategic counsel to large software vendors on government data and IP rights, open source, indemnification, and IP protection issues.

### **Commercialization of New Technologies**

Starting with the commercial birth of the Internet in the early 1990s, and continuing with the rollout of new web-based products, new delivery channels, wireless communications, and the explosion of digital media delivery via the Internet and new devices, Wiley attorneys have worked with clients literally inventing new industries and addressing the legal challenges that are presented.

Our clients appreciate our out-of-the-box approach to legal issues raised by breakthrough products and services, as well as our pro-business, can-do attitude. We have assisted in the establishment of new laws, rules, and voluntary industry standards in IP registration and protection, data protection, and privacy. When pre-planning is unable to prevent litigation, we have represented clients in litigation and arbitration worldwide.

### **Government Data Rights**

Wiley's Government Contracts Practice is the leader in the licensing and protection of IP related to federal contracts, as well as in litigation over the misuse of such property. Members of that Group have co-authored two major textbooks on rights in technical data and computer software—the more recent of which (*Licensing Software and Technology to the U.S. Government*, 831 pp.) is the most current, comprehensive text on these subjects for both the U.S. Department of Defense (DOD) and civilian agencies.

Wiley also routinely represents clients in disputes with competitors involving theft or misuse of trade secrets, unfair competition, and violations of the Procurement Integrity Act.

### **Brand Management**

Wiley provides full-service brand management to a variety of domestic and international companies. Teamed with our Litigation practice, our attorneys specialize in licensing, protecting, and utilizing trademarks and other IP in all varieties of commercial and distribution arrangements. Because a brand often is a company's most critical asset, Wiley works to ensure the long-term profitability and security of our clients' brands and other vital IP assets.

## **Technology Transfers and Distributions**

Wiley assists our clients in assuring seamless distribution for a variety of technology products, including software, hard goods, and IP, amongst others. Our attorneys negotiate and draft license, sublicense, reseller, value-added, sales channel, integration, and OEM agreements on behalf of our clients, achieving protection of property rights and degrees of certainty in otherwise unpredictable markets.

Our attorneys also assist in the acquisition and sale of IP. We have specialized experience purchasing distressed IP assets out of bankruptcy.

## **Mergers, Acquisitions, and Other Strategic Transactions**

Wiley advises clients in structuring and documenting partnering and teaming arrangements, strategic alliances, joint ventures, financing and capital formation, mergers and acquisitions, executive compensation, and other matters related to structure, organization, growth, and operation. We have experience drafting and negotiating merger, acquisition, and sale agreements for IP/technology-based companies, and assets, teaming agreements, joint ventures, and reseller and referral arrangements for technology products and services. We also assist clients with financing, investment, and subscription transactions, as well as loans, security agreements, and related documents for investment in technology companies. In addition, we provide the full range of corporate, IP, and related services to startup technology clients, including venture formation and private equity financing.

## **Creditor and Security Rights in Intellectual Property**

Our attorneys have represented debtors, creditor committees, and other interested parties in the acquisition or disposition of assets from bankruptcy estates.

We assist our creditor clients in protecting their valuable relationships or assets in the event of a third-party bankruptcy. We have negotiated complex software source code and other escrow arrangements to protect the licensees' interests, including their business continuity, in the event of vendor bankruptcy or nonperformance.

## **Government Regulation and Legislation**

When existing law does not adequately address new technologies and business methods, those laws have to change. Wiley advocates client interests before federal and state legislative, administrative, and judicial forums around the country. For example, our attorneys use their experience on Capitol Hill and in the Executive branch and independent agencies to help members of Congress, from both political parties, write and mold legislation that works for the public interest as well as the business interests of clients.

Client success starts with an understanding of our clients' business and goals and proceeds using sound policy strategies, personal relationships, and an inside view of how policy is made. Many members of Wiley are veterans of the White House, Congress, Federal Trade Commission (FTC), Federal Communications

Commission (FCC), Department of Justice (DOJ), and the U.S. Supreme Court. Several others have managed political campaigns and drafted laws and/or regulations as staff members in Congress and other federal and state centers of power.

### **Wiley's Significant Global Experience**

Wiley often works in international and foreign venues to secure regulatory approvals and rulings for telecommunications and Internet companies. We follow the evolution of e-commerce regulations and liability law in the European Union (EU), Asia, Latin America, and Africa. The firm has substantial experience in assessing Internet telephony regulation and securing interconnection arrangements in more than 50 countries—a complex process that requires obtaining approvals from local regulators and entering into agreements with local firms in each jurisdiction.

Wiley also has been active in obtaining spectrum allocations for wireless operators and securing regulatory clearances for cable modem providers in many different jurisdictions.

In addition, we regularly advise clients on multinational legal developments occurring at the World Trade Organization (WTO) and other multinational entities, particularly on issues such as taxation, jurisdiction, privacy, and international selling and contracting.

### **Representative Experience**

The following are some of the representative matters with which our attorneys have assisted clients:

- Assisted a publicly held professional services company in evaluating and negotiating the outsourcing of its business processes and IT development/support functions to offshore vendors, which was valued at more than \$100 million. The business process outsourcing (BPO) transaction involved the transfer of human resources, finance, and accounting functions.
- Acted as lead outside counsel for a large wireless device manufacturer, drafting, and negotiating end user and professional services agreements in numerous deals across the country. This is a complex, nationwide effort to accomplish FCC mandated 800MHz rebanding.
- Documentation of a \$150 million loan secured by patents and other IP on behalf of lead investor in loan syndicate.
- Assisted a communications and electronics company in a \$825 million sale of an information systems group.
- Obtained an international enterprise license for application software for a financial institution.
- Assisted in numerous TV program acquisitions, website content licenses (including music, images, text, games, etc.), photography licenses, publishing deals, and architectural/design licenses.
- Represented a vendor in a \$25 million outsourcing agreement for a major U.S. airline carrier.
- Assisted with the application development and commercialization agreement between our client, a German software company, and its international partner.

- Assisted with a series of technology transfer, distribution and support agreements between a UK auto manufacturer and a Chinese manufacturer.
- Assisted a dozen television group owners in a spectrum relocation transaction involving hundreds of stations.
- Assisted a group owner in the conversion of more than 1,000 radio stations to HD Radio technology, including a licensing agreement, conversion commitment, and investment.
- Assisted a major defense contractor in a \$27 million acquisition of an electronic warfare systems business unit.
- Assisted a telecommunications solutions provider in an acquisition from a Canadian telecom company in bankruptcy of data and Internet operations serving Argentina, Brazil, Chile, Colombia, El Salvador, Mexico, and Panama.
- Assisted several large government contractors with audits of their intellectual property rights under existing contracts and joint ventures.
- Assisted a wireless communications joint venture in a \$108 million debt and equity financing in connection with construction, development, and operation of a personal communication service (PCS) network.
- Assisted a major long distance reseller in multiple financing, joint venture, and asset acquisition transactions including the acquisition of substantial technology and communications equipment.

## Contact Us

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