



## LICENSING

# Brand Protection

Barnes & Thornburg attorneys have significant experience in licensing and related transactions that allow clients to maximize the value of their trademarks, patents, copyrights, trade secrets and brands.

Our IP attorneys- experience spans many industries and includes advising universities and other clients on patent licensing programs, joint ventures, technology transfer and other cooperative research and development agreements. On the trademark side, we work with clients on such endeavors as logos, domain names, word marks, brand enhancements, license back, and the formation of trademark holding companies.

We also help clients define their business objectives and goals and develop the right strategy to achieve them, whether they wish to minimize taxes, prepare for an initial public offering (IPO), source additional funding rounds, sell their business, or strengthen succession and estate planning. With their knowledge of both the technology and the law behind it, our attorneys also assist with cross-licensing, materials transfer, asset sale, franchising and domain name and website content license.

Clients turn to us to help with licensing transactions and to:

- Evaluate the assets involved
- Anticipate what could change or go wrong in the relationship
- Prepare or revise the agreement
- Help negotiate the transaction
- Develop systems to administer agreements and keep track of ongoing obligations

## Industries and Products

## Why Barnes & Thornburg?

Finding new ways to help clients identify solutions and new business opportunities, across industries, is at our core. We are, at times, more than lawyers, we are advisers bringing new ideas to light. We understand what keeps you up at night and work collaboratively to find practical and creative solutions, at the heart of business.

## RELATED PRACTICES

Intellectual Property

We have assisted clients in licensing transactions involving a wide variety of industries and products:

## **Software**

- Development
- Mobile app
- Software, platform, infrastructure, data as a service (SaaS, PaaS, IaaS, DaaS)
- Managed/hosted services
- End-user agreements
- Terms of use and privacy policies
- Open source

## **Information Technology**

- Website development and operation
- Databases
- E-commerce
- Bioinformatics

## **Medical, Biotech and Chemical**

- Pharmaceuticals
- Medical devices
- Physician office management
- Electronic medical records
- Medical transcription
- Immunoassays and other diagnostics
- Animal cell lines
- Monoclonal antibodies
- Plant, seed and other genetic material
- Nutritional supplements
- Nanochemistry technology
- Polymers and other plastics
- Teleradiology

## **Creative Works and Rights**

- Website content and design
- Musical compositions and recordings
- Designs
- Film and photography
- Sculpture, painting and fine art
- Books and maps

- Rights of publicity
- Sponsorships and endorsements
- Publishing

## **Manufacturing**

- Railroad products and services
- Industrial equipment
- Beverage making equipment
- Consumer products
- Sports equipment
- Furniture and furniture components
- Food products and manufacturing methods

## **Business and Financial**

- Stock market trading
- Banking
- Business methods
- Franchises

## **Recent Projects**

Our attorneys frequently collaborate across different areas to develop effective strategies for our clients. Recent examples of projects we have handled include advising clients on:

- Licensing key chemical synthesis patents and know-how from several universities and the government to create a clear path to market exclusivity for coatings technology
- Licensing manufacturing methods and trademark assets out of bankruptcy
- Forming an IP holding company for closely held business owner's estate planning and tax reduction
- Moving software IP to isolate it from the operating company and possible litigation
- Licensing start-up company's baby-related medical product to a manufacturer/distributor in separate market channels to increase sales
- Cross-licensing patents to settle litigation
- Expanding market penetration by licensing trademarks in an alternate marketing channel
- Expansion into new geographic markets to avoid carrying manufacturing or shipping cost burdens
- Extending product line by licensing in complementary products
- Accelerating market entry by licensing in key know-how
- Licensing out non-targeted uses of technology to increase revenues

- Joint venturing with another company to combine technology development capabilities
  - Outsourcing unprofitable aspects of product manufacturing
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