

Transactional Intellectual Property

<http://english.ktslaw.com.cn/practice-areas/intellectual-property/transactional-intellectual-property/>

Intellectual property continues to grow in importance worldwide, with geographic barriers to commerce dissolving as technology and communication systems evolve. Increasingly, intellectual property has become one of the most valuable and durable assets a company may possess. Recognizing and exploiting the value of such assets can mean the difference between surviving and thriving.

We have assisted clients in a range of industries with leveraging the value of their intellectual assets and assessing and valuing intellectual property obsolescence risks. Our attorneys are experienced in assisting clients with licensing, joint ventures, recapitalization, mergers and acquisitions, and technology transfer agreements. We have counseled on pre- and post-transaction issues including division of customers and territories, and non-compete agreements.

We work collaboratively with our clients to understand and support their business goals. Once we have identified the value-drivers for our client, we will help them assess whether the intellectual property position will support or detract from those drivers and assist our client in refining their deal strategy.

[ACQUISITION DUE DILIGENCE](#) ^[1]

Pure IP due diligence: This due diligence includes ascertaining the scope of coverage of the target's patents, the validity and enforceability of such patents, identifying key competitors and their key patents, examination of existing license agreements and disputes, identifying government rights, status of trademark use and enforcement, cataloging existing know-how among key employees and much more.

Typical issues we see include: IP not assigned by founders or contractors; unlimited indemnity, narrower scope of protection than advertised or cover only discontinued products; already licensed to competitors of acquirer.

IP and related due diligence: In addition to the IP due diligence, we can review IP related agreements to identify indemnity obligations, which contracts are terminable upon acquisition, etc. We've integrated our skilled corporate attorneys with our renowned intellectual property attorneys to provide a unique and valuable service not readily found in the market. This can provide efficiencies in the review.

Complete due diligence: With our skilled corporate attorneys, we can do any other aspect of the due diligence for the project as well. We've integrated our skilled corporate attorneys with our renowned intellectual property attorneys to provide a unique and valuable service not readily found in the market.

Assistance we provide includes:

- Identifying the structure of the proposed transaction
- Reviewing the extent of the exclusivity of the intellectual property assets in the marketplace
- Isolating potential exposure to liability
- Advising on licensing options
- Counseling on tax implications

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LICENSING [2]

The firm has extensive experience representing both intellectual property licensors and licensees in connection with transactions, joint ventures and merchandising programs. We represent technology developers and owners who wish to commercialize their intellectual property, as well as businesses that require cutting-edge solutions to improve current business processes or to support new business offerings. We have structured strategic plans for licensors that maximize their benefit, while protecting the integrity and value of the brand. We have found creative solutions that balance the quality control concerns of a technology or brand owner with the licensee's ability to operate its business effectively.

We assist throughout the licensing cycle, from assessing the assets, to developing strategy, to carefully crafting the agreements and effectively managing the relationship. We are experienced in highly specialized areas such as open source software, privacy and security issues and competitive bidding. Many of our attorneys have significant experience in particular industries and are familiar with the unique issues impacting those industries.

PATENT VALUATION [3]

Our patent valuation practice combines legal, technical, financial and industry analysis to provide clear and realistic input for our clients looking to buy, sell or license patent portfolio assets, as well as to optimize their own patent portfolios.

We have developed an analytical framework that starts with broad-based product, technology and strategic research and aligns it with our legal analysis of patent claim elements. Based on this alignment, we conduct one or more quantitative analyses depending on our client's particular situation or proposed transactions. Our approach provides more insight and is more useful than automated programs that rely on facile metrics, such as the number of times a patent is cited by other patents, since mere statistical tools avoid claim-level analysis entirely. For example, statistical tools do not inform a potential buyer if the claims in a patent cover obsolete technology.

Our patent valuation team is part of one of the largest and most respected patent prosecution and litigation practices in the U.S. We have technical backgrounds in a wide array of relevant fields, as well as transactional attorneys well-versed in market trends and experienced in closing patent-related business deals of all types. Our in-house research staff provides efficient support. We also maintain a broad and deep network of subject matter experts, financial analysts and international affiliates to assist with particular aspects of each engagement.